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## **PATENTS ACT 1977**

IN THE MATTER OF an application under  
Section 13(1) by Thomas Benton Banks and  
Michael Lynn Vandemark in respect of Patent  
Application No 2228125 in the name of  
Hallmark Cards Inc

## **DECISION**

Patent Application No 8927726.3 in the name of Hallmark Cards Inc was filed on 7 December 1989 claiming priority from US application 07/282013 of 8 December 1988 which was subsequently granted as US Patent No 5036472. The application named Stephen Philip Buckley, Richard Albert Robinson, John Hoyt Hurlburt, Kurt Albert Pfahl and Arthur Eugene Doerflinger as inventors and was published as Application No 2228125 on 15 August 1990.

Application under section 13(1) of the Patents Act 1977 was made on 14 January 1993 by Thomas Benton Banks and Michael Lynn Vandemark declaring that they were inventors of the invention which is the subject of the patent application in suit and accordingly had a right to be mentioned as such in accordance with the terms of section 13(1). The application was accompanied by a statement under rule 14(1) of the Patents Rules 1990 to which was attached a copy of a verified statement of the originally named inventor prepared for use before the US Patent Office. This states inter alia:

"On 26 August 1992, during the course of preparing a preliminary statement and various preliminary motions for the pending interference proceeding, patentees' attorneys became aware that Thomas Benton Banks and Michael Lynn Vandemark are joint inventors of the claimed invention. Prior to that time, patentees counsel was unaware of Banks and Vandemark's contributions to the inventions disclosed and

claimed in the various applications and applicants failed to understand the substance of the contributions by Banks and Vandemark [sic]. Consequently, their names were inadvertently omitted from the application and the issued patent.

Patentees' counsel was unaware of Banks and Vandemark's inventorship because of a misconception held by the joint inventors. Banks and Vandemark were supervisors of various Hallmark employees among whom are the other originally named joint inventors at Hallmark. Unfortunately, Banks and Vandemark believed that supervisors in general are not considered joint inventors. Consequently, they felt that the nature of their positions precluded them from being considered joint inventors. Accordingly, they failed to apprise counsel of the integral role they played in the inventive process. As a result, Vandemark and Banks were not named as joint inventors when the application was filed.

The omission of Banks and Vandemark was not the result of purposeful conduct. Instead, the omission was the result of error which occurred without deceptive intent on the part of the patentees or their attorneys. It was simply an oversight. Accordingly, patentees hereby request that Thomas Benton Banks and Michael Lynn Vandemark be added and named as joint inventors of United States Patent No 5,036,472 issued 30 July 1991."

In accordance with rule 14(2) copies of the application under section 13(1) and the accompanying statement with attached verified statement were sent to Hallmark Cards Inc, Stephen Philip Buckley, Richard Albert Robinson, John Hoyt Hurlburt, Kurt Albert Pfahl and Arthur Eugene Doerflinger under cover of official letters dated 16 February 1993.

None of these recipients has entered opposition to the application as allowed by rule 14(3). In the absence of any such opposition, I am satisfied that Thomas Benton Banks and Michael Lynn Vandemark are joint inventors of the invention which is the subject of the patent application in suit and therefore have a right to be mentioned in accordance with the terms of section 13(1).

I accordingly direct under rule 14(5) that an addendum slip mentioning Thomas Benton Banks and Michael Lynn Vandemark as joint inventors be prepared for the published application for the patent.

Signed this 2 day of JUNE 1993



LESLIE LEWIS

Principal Examiner, acting for the Comptroller

