

PATENTS ACT 1977

IN THE MATTER OF an application under Section 13(3) by Turpins Packaging Systems Limited in respect of Patent No 2252949 in the name of Turpins Packaging Systems Limited

DECISION

Patent Application No 9122852.8 was filed on 28 October 1991 in the name of Sleeveit Systems Limited, claiming priority from Application No 9023431. The application was published on 26 August 1992 under Serial No GB 2252949A. The granted patent was published on 10 November 1993. Both the published application and the granted patent named Steve King and Brian Nicholson as inventors. A change in the patent applicants' name from Sleeveit Systems Limited to Turpins Packaging Systems Limited was registered on 7 October 1992.

Application under section 13(3) of the Patents Act 1977 was made on 21 July 1993 by Turpins Packaging Systems Limited. They declared that Steve King ought not to have been mentioned as inventor of the invention and applied for a certificate to that effect in accordance with section 13(3).

The application was subsequently accompanied by a statement under rule 14(1) of the Patents Rules 1990 filed on 13 September 1993 in which it was stated:

"2. By virtue of a Form 7/77 filed in October 1991, the following are named as the inventors on the Application:

Steve King

Brian Nicholson

3. The Applicant requests the Comptroller to issue a certificate to the effect that Steve King ("King") is not an inventor or a joint inventor in respect of any invention the subject matter of the Application.

4. Brian Nicholson ("Nicholson") was, at the time of making of the invention the subject of the Application, employed by the Applicant as a design engineer.

5. King was, at the time of making of the invention the subject of the Application, responsible for sales and marketing for the Applicant.

6. The Priority Application had been prepared as a matter of urgency by Peter Dummett ("Dummett") of Dummett Copp & Co ("the Agents") in response to a fax message from King dated 24 October 1990, which described the new design of sleeving machine. The new design was to be exhibited on 30 October 1990. The draft specification for the Priority Application was faxed by the Agents to King for his comments on 26 October 1990. The Agents requested details of the inventors, but the Applicant did not at that time supply these details, and because of the urgency in getting the Priority Application on file, the Agents did not follow up this omission.

7. The Priority Application fell due for completion in October 1991. Dummett discussed this with Michael Freeman ("Freeman"), the Chairman of the Applicant, by telephone on 29 September 1991. Freeman instructed the Agents to file a Formal Application in the UK. The question of inventorship was not raised at this time because Dummett did not at that time remember that the question of inventorship had not been resolved at the filing of the Priority Application.

8. In the course of preparing the Form 7/77 for the Application, Dummett asked his secretary to check in the file for the names and addresses of the inventors. She reported that those details had not been supplied, and Dummett asked her to speak with King, who had been the initial point of contact for the Agents in respect of the invention.

9. As a result of the information given, the Form 7/77 was completed as detailed in paragraph 2 above.

10. The Application was posted to the Patent Office by the Agents; it received a filing date of 28 October 1991.

11. The Application relates to a new design of sleeving machine. This design was conceived by Nicholson, who supervised the building of a prototype machine. Nicholson was the only design engineer employed by the Applicant at the time the invention was made, and no-one else was involved in the making of the design. King was not involved in any way with the invention, or with the design and building of the prototype until it had reached the stage where it was ready to be demonstrated to potential customers.

12. The question of inventorship was not raised again until the Agents sent a copy of the published application to the Applicant on 28 August 1992. The Managing Director of the Applicant, Mr Woods ("Woods") and Freeman realised for the first time when they read the published application that King had been wrongly named as an inventor.

13. Woods then instructed the Agents to seek to remove King's name as an inventor for this application. This instruction was made as soon as possible after the Applicant realised the error.

14. The Applicant therefore requests the Comptroller to grant the certificate requested, namely that Steve King is not an inventor or a joint inventor in respect of any invention the subject matter of British Patent Application number 9122852.8; and that he order that the Register and any patent granted on the Application be rectified to delete King as an inventor."

Evidence in support of the applicants' case in the form of statutory declarations from Thomas Ian Peter Dummett, Michael Allen Freeman and Brian Nicholson was also filed on

13 September 1993. These declarations state that Steve King was not an inventor of the invention and that he did not possess the necessary technical skills.

In accordance with rule 14(2), copies of the application under section 13(3) were sent to Steve King and Brian Nicholson under cover of official letters dated 4 August 1993. The statement was subsequently sent with further letters dated 1 October 1993 together with copies of the applicants' evidence.

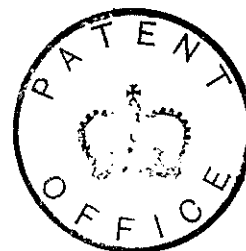
Neither of these recipients has entered opposition to the application as allowed by rule 14(3). In the absence of any such opposition, I am satisfied that Steve King ought not to have been mentioned as inventor of the invention which is the subject of the patent in suit.

This decision serves as a certificate, issued in accordance with section 13(3), to the effect that Steve King ought not to have been mentioned as inventor for the published application of the patent and the granted specification of the patent.

Signed this 7 day of February 1994



LESLIE LEWIS
Principal Examiner, acting for the Comptroller



THE PATENT OFFICE