

23.12.85

PATENTS ACT 1977

IN THE MATTER OF Patent
Application 8325818 in the
name of Andras Szucs

and

IN THE MATTER OF a reference
to the Comptroller under
Section 8 by GKN Kwikform
Limited.

DECISION

Reference is made to the Comptroller under Section 8 by GKN Kwikform Limited (hereinafter referred to as GKN or the referrers) of the question whether they are entitled to any rights in an invention disclosed in application number 8325818 in the name of A. Szucs (hereinafter referred to as the applicant).

At the hearing before me on 28 October 1985 Mr B Thorpe appeared as agent for the referrers and the applicant appeared in person.

Application 8325818 was filed on 27 September 1983 but by virtue of Section 15(5) has been taken to be withdrawn by failure to file, by the end of the relevant prescribed period, one or more claims, an abstract and a request for preliminary examination and search. However, it is to be noted that the applicant has filed on 21 September 1984 a second application 8424000 containing similar but not identical subject-matter and claiming priority from the earlier application, this later application being published on 9 May 1985 with the Serial No. 2147344A.

In order that the points at issue in these proceedings may be more readily appreciated it is necessary to explain in some detail the matter in application 8325818. Thus it discloses constructions of

a structural beam, and connectors for joining together overlapping beam ends. Each beam, of which the overlapping ends of two are shown in Figure 2 filed with the specification, is of modified I - form and comprises a web 21 extending perpendicularly between flanges 22, 23 which extend to a lesser extent on one side of the web 21. The specification states that the beam is so constructed that its shear centre lies on said one side of the web between the web and the extremities of the flanges on that side, but this would appear to be a statement of the inevitable result of forming the beam asymmetrically as described, and therefore I do not regard it as imposing any further limitation.

The shorter portions of the flanges are substantially thicker than the longer portions and these are divided by T-section slots 24, 25 into outer and inner limbs, the latter being designated 26, 27. These slots may be used to accommodate connectors to join overlapping ends of beams to provide a support of required length, or to connect to a support stool for the beam.

Although no claims were filed on application 8325818, an indication that the invention was regarded as lying with the beam can be obtained from a paragraph in the opening description in the following terms:

"According to the present invention there is provided a structural beam whose cross section includes a web extending perpendicularly between flanges at its opposed ends, each said flange extending to a lesser extent on one side of the web than on the other side of the web and such that the shear centre of the beam lies between said one side of the web and the extremities of the flanges on that side."

The applicant was employed by GKN Mills Building Services Ltd (formerly known as Mills Scaffold Co Ltd) from 1 September 1969 until his employment was terminated due to redundancy in 1983, his date of release being 16 September 1983 which was shortly after the company changed its name to GKN Kwikform Ltd on

2 September 1983. The precise nature of his duties, i.e. his job description, at the commencement of his duties is not clear but he signed an agreement dated 13 July 1971, Exhibit TP2, in which he acknowledges that all inventions and designs made by him in the course of his employment by Mills Scaffold Co would be the sole and exclusive property of the Company and that the Company would be entitled to the sole benefit thereof and of patent, registered designs and like rights therefor. In 1980, the applicant was appointed to the post of Engineering Development Manager, a post in which he remained until the termination of his services. A Job Description, said to relate to this latter appointment and referring specifically to the development of new products, is exhibited at TP3, but there is no evidence to show that Mr Szucs was aware of its contents whilst he was employed by GKN.

In their Statement under Rule 7(1), the referrers allege that during 1982 and in early 1983 the applicant was working on an extruded aluminium beam suitable for use in formwork but, for policy reasons, this was not proceeded with by GKN and no patent or design protection was sought in respect of the beam. It is further alleged that on 13 August 1984 the applicant sent to GKN Patents and Licensing Department an unsolicited disclosure which was understood by GKN to be a document (Exhibit BT1) identical with the specification and drawings (no claims) filed with application 8325818 on 27 September 1983. In a letter dated 15 August 1984, Exhibit BT3, the applicant disputed that any parts the material were the property of GKN but at the hearing he conceded that a beam of similar configuration to that shown in Figures 1 to 5 of those drawings was the property of GKN. For his part Mr Thorpe acknowledged that GKN had no interest in the connectors for joining two beams together.

In the light of this admission by Mr Szucs my task in these proceedings is limited to that of determining what form of order would be appropriate in the particular circumstances.

In their statement, the referrers had requested that the Comptroller should decide whether, under Section 8(1)(a) they should be entitled to be granted alone a patent for the whole or part of the matter disclosed in application 8325818. They also requested, under Section 8(1), appropriate orders if that application is abandoned or if any subsequent application is made for the same invention before these proceedings are terminated.

They have also requested orders under Sections 8(2) and 8(3).

The relevant parts of these Sections read as follows:

"8. - (1) At any time before a patent has been granted for an invention (whether or not an application has been made for it) -

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or

(b) (not reproduced);

and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.

(2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below, -

(a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;

(b) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly;

(c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred;

(d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order."

If the comptroller orders the application to be refused or amended to exclude the matter in dispute, subsection (3) provides that the comptroller may order that the referrer may make a new application for the relevant matter which is treated as having been filed on the date of filing the earlier application.

Prior to the hearing the referrers were informed in the official letter of 15 August 1985 that as application 8325818 had been treated as withdrawn before publication there could be no relief under Section 8(2) or 8(3) in respect of that application and that only relief under Section 8(1) could be considered at the hearing.

However, at the hearing, Mr Thorpe pointed out that Sections 8(2) and (3) refer to an application being "withdrawn", that Section 15 says that an application "shall be taken to be withdrawn", and that the official letter had used the expression "treated as withdrawn". He speculated as to whether these all meant the same or whether Sections 8(2) and 8(3) were referring only to a

positive withdrawal by an applicant. I gave an interim view that no difference of meaning was intended by the slightly different wording and that whether withdrawal was a positive action or merely passive, its effect was exactly the same. Having reviewed that opinion I see no reason to change it, and I hereby confirm the statement in the official letter.

That being so, the remainder of this decision will be confined to a consideration of the position under Section 8(1). Clearly, since application 8325818 is withdrawn, it is not possible to order that the application shall proceed in the name of another person or that it shall be amended. In the present circumstances it appears to me that I can only attempt to set out what I regard as the cross-sectional shape of beam in which the referrers have admitted rights,

Mr Szucs admission was specifically in respect of the beam shown in Exhibit CCF1. This beam has a cross-section similar to that disclosed in Figures 1-5 of 8325818 but with the minor differences that, in the beam shown in the Exhibit, (a) a longitudinal groove is provided adjacent the free extremity of each of the longer portions of the flanges and (b) the inner limbs (26, 27, using the reference numerals on the figures of 8325818) of the shorter portions of the flanges are thinner than the outer limbs of those portions, whereas in 8325818 these inner and outer limbs are shown as having the same thickness. These differences have no significant effect on the overall cross-sectional form of the beam and I therefore ignore them.

Having established that the beam in question is in effect that disclosed in Figures 1 to 5 of application 8325818 it would have been of assistance had the shape been defined in claims, but as I have said, there are none. In their place we have the passage in the opening description of the specification which I have quoted earlier, and in addition there is a copy of a claim (Exhibit BT9) drafted by Mr Thorpe early in 1983 before the policy decision by GKN not to apply for patent protection, but having

giving these careful attention I do not find that they provide me with a useful basis for the definition required in these proceedings.

I have therefore formulated my own definition which is that the cross-sectional form of the beam can be described as being of modified I-shape, the modification consisting of making the flanges at the ends of the central web extend to a greater extent on one side of the web than on the other, each shorter flange consisting of two spaced parallel elements forming a slot between them, and the free ends of these elements being inturned to form narrower openings into the slots.

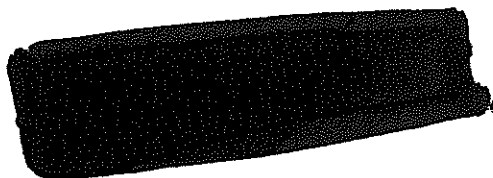
Mr Szucs sought to persuade me that I should take into account questions of patentability but Mr Thorpe referred me to the unreported decision in the case of Northern Engineering Industries plc and Drillcon Industries Ltd (Great Britain) (available in the Science Reference Library under reference 0/67/85). In this decision, of which Mr Szucs had been notified in advance, the Hearing Officer held that "there is no provision for questioning validity in proceedings under Section 8(1)", a finding with which I respectfully agree and intend to follow.

In my opinion, such questions are relevant to whether a patent could be obtained for a beam having the form outlined above, but are not germane to the present issue of entitlement.

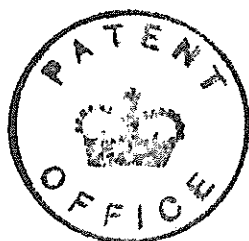
In the result therefore I find that the referrers are entitled to a declaration that "a beam having a cross-sectional form of modified I-shape, the modification consisting of making the flanges at the ends of the central web extend to a greater extent on one side of the web than on the other, each shorter flange consisting of two spaced parallel elements forming a slot between them, and the free ends of these elements being inturned to form narrower openings into the slots, was devised by the applicant, Mr Szucs, whilst in the employ of GKN, or their predecessors, and by virtue of his terms of contract is the property of GKN."

Having regard to all the circumstances of the case, I award the referrers, GKN Kwikform Ltd, the sum of four hundred pounds (£400) as a contribution towards their costs and direct that this sum be paid to them by the applicant, Mr Andras Szucs.

Dated this 23rd day of December 1985



D C L BLAKE
Superintending Examiner, acting for the Comptroller



PATENT OFFICE