

0/96/97

PATENTS ACT 1977

Mr P Hayward  
3Y46

IN THE MATTER OF an application  
under Section 13(3) and a reference  
under Section 37(1) by Kevin Bowden  
in respect of Patent No. 2270629 in  
the name of BNOS Electronics Ltd.

Hayward 6/6/97  
Discovery

PRELIMINARY DECISION

1. Patent No GB 2270629 was granted on 1 February 1995 in the name of BNOS Electronics Ltd, ("BNOS" or "the patentee") naming Peter Thomas Dearman, Howard Alfred Buckenham, Kevin Bowden, Andrew Sharpe and Damon Andrew Cookman as inventors. On 25 September 1995, Kevin Bowden ("the applicant") referred to the comptroller under section 37(1) the question who is the true proprietor of the patent. On 5 March 1996, Mr Bowden further applied to the comptroller under section 13(3) for a certificate that Messrs Buckenham, Sharpe, Cookman and Dearman, ought not to have been mentioned as inventors. Mr Bowden asserts that he is the only inventor (or possibly he and Mr Dearman together are the only inventors) and that the patent should name him alone as proprietor.

2. BNOS opposed both the reference and the application. After the usual rounds of pleadings and evidence, the applicant sought the agreement of the patentee to discovery of four categories of documents. The patentee in a letter of 13 February 1997 agreed to limited discovery of one category of documents but queried the relevance of or need for either the whole or a part of each of the other categories. In response, the applicant made a formal request to the comptroller in a letter of 26 February 1997 for discovery of all four categories of document, now modified in some respects.

3. This request came before me at a preliminary hearing on 8 May 1997 where the applicant was represented by Mr David Gibbins of Needham and Grant. The patentee did

not attend, but it has maintained its opposition to the request on the basis of its letter of 13 February.

4. The principles governing discovery in proceedings before the comptroller are well established. As the precedents make clear, they mirror the principles followed by the High Court as set out in Order 24 of the Rules of the Supreme Court. Thus *Merrell Dow Pharmaceuticals Inc's (Terfenadine) Patent [1991] RPC 221* confirmed that it is appropriate for the comptroller to order discovery if the documents concerned relate to matters in question in the proceedings and their disclosure is necessary to dispose fairly of the proceedings (or reduce costs - though that is not relevant here). However, as was made clear in *Molnlycke AB v Proctor and Gamble Ltd (No 3) [1990] RPC 498*, I have discretion to refuse to order discovery, one condition in exercising that discretion being that the value of the material to the applicant must be balanced against the burden to the opponent in discovering it.

5. For further guidance on how to decide whether a document relates to matters in question, Mr Gibbins referred me to *Compagnie Financière du Pacifique v Peruvian Guano Co (1882) 11 QBD 55*, quoted with approval in *Merrell Dow*. In that case Brett L J said a document relates to the matters in question if it is reasonable to suppose it contains information which may directly or indirectly enable the applicant either to advance his own case or damage that of his opponent. I accept this. However, the categories of document to be discovered must not be so wide or nebulous as to amount to "fishing discovery" as discussed for example in *British Leyland Motor Corporation v Wyatt Interpart Co Ltd [1979] FSR 39*.

6. Mr Gibbins was prepared to make strong representation and appeal to a wider range of authorities, in the apparent belief that because it has often been said that discovery is relatively uncommon in actions before the Patent Office, a more stringent test is applied here. I do not think that the relative rarity of discovery before the Office is because a different test is applied, but because the issues commonly dealt with here do not result in the need for discovery. This is confirmed in *Merrell Dow* where Aldous J said at page 223:

- "It is not normal in proceedings before the Comptroller for there to be discovery and experience has shown that discovery has not been necessary in most cases which, in the past, have come before him. No doubt this has been because complex questions on infringement and validity normally come before the court."

I consider the precedents I have discussed above establish the principles clearly, and do not feel the other cases to which Mr Gibbins referred me assist further.

### **The Substantive Issues**

7. In order to determine whether the categories of document requested to be discovered relate to a matter in question, it is necessary to assess them against the substantive issues which arise in the case.

8. The invention concerns a resuscitator or portable breathing apparatus for patients suffering from a heart attack or other life-threatening condition. Portable resuscitators commonly comprise a "hand piece", constituting a body of the resuscitator, which is attached to a face mask. Oxygen is delivered to the face mask through the hand piece from a separate source such as an oxygen cylinder. Mechanisms are provided to control delivery of the oxygen, typically including an automatic cycling mechanism to provide on/off delivery, to cyclically inflate the lungs of a patient who is not breathing. A manual valve, for use in another mode, is operated by a trigger lever for example, which allows the operator manually to control the supply of oxygen to the patient. In prior devices, these mechanisms were relatively bulky and one or more of them were located and operated separately from the hand piece. The invention consists in housing together in the hand piece, an automatic cycling mechanism, a manual control valve, and a switch over valve to allow the operator to switch between cyclic and manual delivery.

9. The events in the development of the invention appear to be broadly as follows. Mr Bowden and Mr Dearman worked on resuscitators for a company called Neotronics, Mr Bowden in sales and marketing and Mr Dearman as a design engineer. Mr Dearman left Neotronics, developed a new delivery valve and in early summer of 1990 built a

prototype which was considerably smaller than the normal size. He offered it to Neotronics who were not interested. Mr Bowden left Neotronics in July 1990 and soon afterwards initiated discussions with Mr Dearman about the possibility of developing a resuscitator using Mr Dearman's delivery mechanism located in the hand piece. It is a major point at issue whether it was Mr Dearman's or Mr Bowden's idea to incorporate all the elements into the hand piece.

10. In any event, together, they approached BNOS and secured agreement for them to develop and market such a resuscitator. At this stage the other named inventors, who are the managing director and two employees of BNOS, became involved. Their precise role is disputed. In particular, the applicant disputes whether they had a technical input into the development of the resuscitator, or if they did, whether it was germane to the invention claimed in the patent.

11. A PCT application from which the present GB patent derives, was made in April 1992 naming BNOS as applicant and the five individuals as inventors. The patentee asserts that Mr Bowden (and the other inventors) agreed to the application being made in their names and that there was an agreement under which Mr Bowden received remuneration (a royalty) from BNOS in recognition of his contribution. Mr Bowden says he did not consent to the patent application being made, and did not enter into any royalty agreement with BNOS, or receive any remuneration in respect of the patented resuscitator from them.

12. The substantive issues therefore relate broadly to i) whether Mr Bowden or Mr Dearman was the originator of the main inventive concept, ii) whether the other three inventors made any technical contribution, and iii) what agreement, if any, was made between the five named inventors and BNOS in respect of the invention.

#### **The discovery order requested**

13. Returning to the categories of document in respect of which discovery is sought, the applicant's letter of 26 February 1997 requests "... the discovery of documents which are

or have been in the possession, custody or control of either party of the types set out in the schedule attached to this letter ... ", and the schedule runs as set out below. In it, "The Opponents" are the patentees and "The Applicant" is Mr Bowden:

"1. Documents relating to the alleged agreements between the Opponents and the Applicant and between the Opponents and Peter Thomas Dearman for the payment of royalties to the Applicant and Peter Thomas Dearman referred to in paragraph 7 of the Declaration of Howard Alfred Buckenham made herein on 28th October 1996, and being:

- (a) any written agreement or any document containing or recording the terms of the said alleged agreements;
- (b) any correspondence, notes, memoranda or the like recording or referring to the terms of or performance of the said alleged agreements; and
- (c) invoices, receipts, accounts or other documents recording or relating to the payment of royalties pursuant to the said agreements.

2. All notes, minutes, memoranda, correspondence or other documents relating to:-

- (a) the meetings referred to in paragraphs 2 and 5 of the said Declaration of Howard Alfred Buckenham or the matters discussed in the said meetings; and
- (b) the reaching of the design referred to in the first sentence of paragraph 4 of the said Declaration of Howard Alfred Buckenham, and/or the contributions of individual inventors referred to in the last sentence of the said paragraph 4.

3. All documents relating to the applications made by the Opponents in the United

States and Canada for patent protection claiming the same priority as the patent in suit in these Applications, including all affidavits, declarations or correspondence relating to said applications.

4. All documents record or relating to the part played by Lewis Associates in reaching the design referred to in paragraph 2(b) above."

14. I need to explain some points in respect of this schedule. The meetings referred to in category 2(a) are a series of meetings between Messrs Bowden and Dearman, and Messrs Buckenham, Sharpe and Cookman of BNOS after Mr Bowden and Mr Dearman had approached BNOS and secured their agreement to develop, manufacture and market the resuscitator, and during which it is common ground that arrangements for the development of the resuscitator were advanced. The design referred to in category 2(b) is "the design which was described and illustrated in the initial UK Patent Application and in the PCT Application which resulted in the grant of the patent." In category 4, I take the words "... All documents record or relating ..." to mean "... All documents recording or relating ...". Also in category 4, the company, Lewis Associates, with which the category is concerned, is mentioned in the patentee's evidence in reply where it is said to be an industrial designer which during the collaboration between Mr Bowden, Mr Dearman and BNOS, produced models of the resuscitator to the pattern of Mr Dearman's prototype.

15. Before considering the categories, I should comment on the reference in the request, to discovery of material in the possession custody or control of "either party". The applicant can not sensibly have discovery ordered in respect of material in its own possession and when I asked Mr Gibbins about that at the hearing, he confirmed that the applicant's request was limited to material in the possession custody or power of the other side. Proceeding on that basis, I will take each of the four categories in turn.

#### **Category 1. Documents relating to royalty agreements**

16. The interest in these agreements arises from Mr Bowden's wish to show that he was

independent of BNOS, and that he received no remuneration from them in respect of the invention. The most directly relevant is the alleged agreement between Mr Bowden and BNOS. Mr Gibbins explained the background, that the patentee said it derived the right to apply for a patent in Mr Bowden's name from the fact that he was employed, or at least received either a consultancy fee or a royalty from them. His argument in a nutshell is that if there was no remuneration agreement in existence between BNOS and Mr Bowden for his work on the patented resuscitator, BNOS could not, on that basis, derive any automatic right to apply for a patent in his name. Any documents relating to royalties would therefore go to the existence or otherwise of a remuneration agreement and to the right of BNOC to apply for a patent in Mr Bowden's name. I accept this and agree that such documents would clearly relate to one of the matters in question. I am also satisfied it is necessary for them to be brought forward in order to dispose of the question fairly since they may well shed light on one of the central, and keenly disputed substantive questions, in respect of which there is presently little but allegations in the affidavits. Indeed the patentee has not objected specifically to discovery of this material.

17. So much for Mr Bowden's position. Category 1 also covers documents relating to Mr Dearman's relationship with BNOS. The patentee has objected to discovery of these documents as being irrelevant. In essence, it says that if the applicant's version of events is right, Mr Dearman was not an inventor so the terms of any agreement with BNOS are irrelevant, whilst if the patentee's version is right the terms are still irrelevant because Mr Dearman does not dispute that his rights have been transferred to BNOS. I do not feel this argument is sound. Firstly, any such documents would certainly go to the question of whether the patentee's version is right or not. Secondly, they would also relate to the matter of Mr Bowden's relationship with BNOS, because the patentee asserts that both Mr Bowden and Mr Dearman were subject to royalty agreements in respect of the inventive resuscitator. Thus Mr Dearman and Mr Bowden were in comparable positions with respect to BNOS, and evidence in respect of one may shed light on the other. I therefore consider that this material also meets the criteria set out in *Merrell Dow*.

18. There remains the question of discretion. However, I consider the three sub-categories of document set out in the schedule define an appropriate limitation on the

material to be discovered, such that its discovery would not be likely to impose an undue burden on the patentee. I will therefore order discovery in respect of all of the category 1 documents.

### **Category 2. Documents relating to team meetings and the team design process**

19. This category has two limbs. The first, in sub-category (a), covers documents relating to meetings held between Mr Bowden, Mr Dearman and the BNOS representatives. The patentee has agreed in the letter of 13 February 1997 to "limited discovery" of this limb. However it is not clear in what respect the patentee considers the sub-category should be limited and I will therefore consider the request on its merits, and decide whether I should apply any limitation.

20. The main substantive point at issue regarding inventorship, appears from the evidence filed to be whether it was Mr Bowden or Mr Dearman who contributed the idea of incorporating all the elements into the hand piece. This is the main thrust of the invention as claimed and it seems to be common ground that this idea had been established by them before they approached BNOS. Documents in this sub-category would not assist in addressing that point since they relate only to events that took place after BNOS became involved. Nevertheless, it is a subsidiary question whether the remaining three named inventors, Messrs Buckenham, Sharpe and Cookman made a technical contribution. I am satisfied that such documents would be pertinent to the assessment as to who is entitled to be named as an inventor, and consequently would relate to a matter in question. Also, in view of the conflict of affidavit evidence, I accept that disclosure of any such documents would be necessary to dispose of the issue fairly.

21. As to the question of limitation of the sub-category, in my view, it is already appropriately limited to matters surrounding the meetings, and discovery of documents as proposed would not appear to be unduly burdensome to the patentee. I will consequently order discovery of this sub-category and do not consider it necessary to apply any further limitation to the range of material requested by the applicant.



22. The second limb, (b), of category 2 covers documents relating to the reaching of the design of the patented resuscitator and the contributions of the individual inventors. The patentee had asked in the letter of 13 February 1997 for an explanation as to why these should be discoverable. Mr Gibbins explained that the purpose of requesting discovery of such documents was to provide further evidence as to who among the named inventors were responsible for which elements or features in activities outside the team meetings.

23. I agree that documents falling within category 2(b) providing evidence as to the authorship of individual elements of the design relate to matters in question, and that their disclosure is necessary to dispose fairly of the proceedings. However as it stands this sub-category is unjustifiably broad in that it is not limited to material which may provide evidence as to authorship. The sub-category covers notes, minutes, memoranda, correspondence and other documents relating to (i) the reaching of the relevant design, and (ii) the contributions of the individual inventors to that design. I have no problems with (ii), but I am at a loss to see what documents could fit (i) but not (ii) and yet still provide evidence as to authorship. Accordingly, I will order discovery in respect of (ii) but not (i). Again, I do not feel that the burden of discovering this material will be excessive having regard to its potential value to the applicant.

### **Category 3. Documents relating to the prosecution of related US and Canadian patents**

24. This category is drawn very widely and covers without limitation: "All documents relating to the applications made by (the patentee) in the US and Canada ...". Mr Gibbins explained at the hearing that the intention was in fact to elicit any material containing statements made by the patentee about inventorship or entitlement in the course of the prosecution of patent applications in the US and Canada. He accepted that the category as presently drafted, was drawn too widely, and that it should be limited to material relating to inventorship and entitlement to apply for a patent. It was his view that any such material might shed light on inventorship and entitlement in respect of the present patent.

25. In the original request for discovery in the applicant's letter of 31 January 1997, the

wording of this category had been limited to "All documents *on the public prosecution files ...*" (my emphasis) and thus contained nothing but publicly available material. As presently drafted, it purports to cover other material as well. When I asked him about this, Mr Gibbins accepted that most of the material on the patentee's prosecution files which was not available on the public files would be privileged and therefore immune from production. However, he argued that it was possible there were documents not publicly available and not privileged which might contain material relevant to inventorship or entitlement. For example, he said, the patentee might have written to a third party for some reason about what it was doing in the US and Canada. I consider this to be too speculative. The chances of such documents existing is low, and even if they do exist the chances of them revealing information not revealed by other discovered documents is equally low. I do not therefore feel that the likely advantage of discovering such documents outweighs the burden on the patentee in finding them. I will therefore decline to order discovery in respect of these documents as a matter of discretion.

26. Thus the third category now effectively comes back to a request for discovery of material on the public prosecution files. Setting aside for the moment whether this material would comply with the *Merrell Dow* criteria, I have reservations about ordering discovery in respect of material which is publicly available. Mr Gibbins argued that it was common practice for discovery to include documents already in the public domain, or indeed, already in the possession of the applicant, and I am sure it is true that a collection of documents brought together from different sources and at different times, held by a party for his own purposes, may often include publicly available material which falls to be discovered along with rest. However, that is a different matter from ordering discovery of a class of documents all of which are known from the outset to be already available to the applicant from a public source, where the source is known to the applicant, and the material could have been obtained by him at any time. There seems to be no reason to place the burden of discovery on the patentee when the applicant could as easily have obtained the material himself. Consequently, I will exercise my discretion and decline to order discovery of this publicly-available material either. I do not therefore need to decide whether this material satisfies the *Merrell Dow* criteria.

#### Category 4. Documents relating to the part played by Lewis Associates

27. Lewis Associates ("Lewis") is mentioned in a copy of Mr Buckenham's affidavit from another action which is exhibited to Mr Gibbins' Statutory Declaration in the patentee's evidence in reply, at paragraph 13 of exhibit DJSG 2. Lewis is said to be an industrial designer which in November 1990, a few months after the start of the Bowden/Dearman/BNOS collaboration, produced models of resuscitators to the pattern of a prototype which had been produced by Peter Dearman.

28. Mr Gibbins argued that, while on the papers, there was nothing to suggest that Lewis had contributed anything to the inventive process, its actual involvement remained to be determined and was a relevant issue since Mr Buckenham had decided to name, as inventors, certain parties who had been involved, but had decided not to name any of the parties involved as a result of Lewis's activities. It is a matter in question whether Messrs Buckenham, Sharpe and Cookman (and, on Mr Dearman's evidence, Mr Bowden) were properly named as inventors. It was therefore relevant to discover any documentation relating to Lewis's involvement in order to bring forward as much information as was available to shed light on the question of inventorship.

29. Whilst I do not feel this argument carries quite as much weight as those in respect of categories 1 and 2, I believe it is still sufficient to justify discovery under the *Merrell Dow* criteria, and do not feel it will place an undue burden on the patentee. I will therefore order discovery of this material.

#### Summary

30. I therefore order discovery of documents in the patentee's possession, custody or control in categories 1, 2 and 4 of the schedule accompanying the applicant's letter of 26 February 1997, with the limitation that sub-category 2(b) is to be restricted to "the contribution of individual inventors referred to in the last sentence of paragraph 4 of the declaration of Howard Alfred Buckenham to the design mentioned in the first sentence of that paragraph". I decline to order discovery of the material in category 3.

31. Neither side has commented on the timetable-required for any discovery. In the absence of such comments, I will set the following timetable:

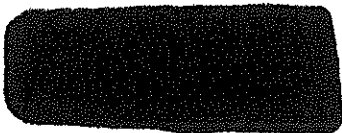
- The patentee should supply a list of the relevant documents to the applicant within 14 days of this decision, offering the applicant a reasonable opportunity at some stage during the following 7 days to inspect and take copies of the documents.
- The applicant will then have a further 4 weeks (taking him in all to 7 weeks from today) to file further evidence relating to it.

However, if either side feels this timetable is unreasonable, they are at liberty to come back to me.

32. I will defer a decision on costs until the substantive hearing.

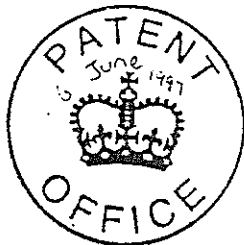
33. Since this is a procedural issue, under the Rules of the Supreme Court any appeal should be lodged within 14 days.

Dated this 6<sup>th</sup> day of June 1997



**P HAYWARD**

Superintending Examiner, acting for the comptroller



**THE PATENT OFFICE**