

PATENTS ACT 1977Mr P Hayward
3Y46

IN THE MATTER OF

a reference under Section 37

and an application under Section 13

by Robin Brian Leslie Warner

in respect of patent number GB 2233740

in the name of Dairy Pipelines Limited

*Denniey 25/6/97**Inventorship / entitlement***DECISION****Introduction**

1. Patent application GB9009682.7, entitled "valve unit", was filed on 30 April 1990 by Dairy Pipelines Limited ("Dairy Pipelines"), naming as sole inventor Mr Alan Sutton; it was subsequently published as GB 2233740. On 22 April 1993, Mr Robin Warner filed Form 2/77, referring to the comptroller under section 8 of the Patents Act 1977 ("the Act") the question whether he is entitled to be granted a patent for the invention described and claimed in the patent application or has or would have any right in or under any patent so granted or any application for such a patent. Following an official letter pointing out that the relief sought elsewhere in the accompanying statement went beyond that available under section 8, he also filed Form 6/77 making application under section 13 for a certificate to the effect that Mr Sutton ought not to have been mentioned as an inventor and that Mr Sutton's name should be replaced by Mr Warner's.

2. The patent application was granted on 15 September 1993, so that, by virtue of the operation of section 9, the reference under section 8 was treated as being one under section 37. By agreement, that reference and the application under section 13 were treated as consolidated, to be dealt with together.

3. These and other procedural complications resulted in a number of amendments being made to the statement and counterstatement which, for the avoidance of doubt, I formally allow. From the amended pleadings, I find myself asked to determine:

- 1) the inventor of the invention described and claimed in the patent in suit;
- 2) the entitlement to the patent in suit;
- 3) costs.

4. These matters came before me at a hearing on 5 December 1996, at which Mr Warner appeared in person, and Mr Colin Birss, instructed by Keith W Nash & Co, appeared as Counsel for Dairy Pipelines.

The Evidence

5. In support of his case, Mr Warner filed two affidavits as evidence in chief and one statutory declaration as evidence in reply. Dairy Pipelines' evidence in chief consisted of respective statutory declarations by Mr Alan Sutton, the named inventor and former managing director of Dairy Pipelines; Mr Dennis Stanley Burchell, technical manager of Dairy Pipelines; and Mr Colin Lock, a regional director employed by Professional Personnel Consultants Limited. There was some dispute following Mr Warner's evidence in reply, and in response a further statutory declaration by Mr Sutton was filed. There was no dispute between the parties as to the admissibility of the extra evidence stage, and for the avoidance of doubt I formally admit all of the written evidence filed.

6. It was pointed out at the hearing by Mr Birss that Mr Warner's address to me in parts verged on oral evidence, no doubt due to Mr Warner's unfamiliarity with legal proceedings. In coming to my decision, I have been conscious of this, and have been careful to restrict myself to matters brought out by the written evidence, or accepted by Mr Birss. That said, had I strayed from that proper course I doubt that I would have reached a different conclusion.

The Patent

7. For the purposes of my decision I do not need to consider the invention or subject matter of the patent in particular detail. The invention relates to a valve unit for permitting or preventing communication between two pipelines. In various fields in which fluid products are conveyed along pipelines, there is sometimes a requirement to be able to mix or prevent mixing of the products. The requirement can be satisfied by providing communication between two pipelines through an openable and closable valve, but problems with leakage can be difficult to overcome, especially if the fluid pressure in one pipeline is substantially higher than in the other. A valve unit intended to provide a solution to this problem is specifically described in the patent in suit with reference to a single drawing. Claim 1, the only independent claim apart from an omnibus claim, reads as follows:

“A valve unit for permitting or preventing communication between two pipelines, comprising two valve members mounted for independent movement towards and away from one another on a valve axis, a valve seat having two opposed seating surfaces against which the respective valve members can close when moved towards one another, separate, independent spring means acting on the valve members whereby the valve members are each urged towards their closed positions, two cylinder and piston arrangements acting on the respective valve members for opening the valve at the respective valve seats, the two cylinder and piston arrangements being arranged as coaxial sub-assemblies on the same side, in the axial direction, of the valve seat, and means controlling the supply of fluid to the two cylinder and piston arrangements, to enable the cylinder and piston arrangements to be operated simultaneously.”

8. This valve unit has been called by both sides in these proceedings a “mix-proof valve” and although that term does not appear in the patent specification, it is convenient and I shall adopt it.

Inventorship

9. Section 7(3) of the Act defines "inventor" in the following terms:

"In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly."

10. It is therefore necessary for me to decide who was the actual deviser of the invention disclosed in the patent in suit. I might add that since Mr Sutton is the named inventor under the patent, the onus lies on Mr Warner, as the applicant under section 13, to show, on the balance of probabilities, that he was the actual deviser of the invention.

11. It is not in dispute that Mr Warner was employed as a senior draughtsman by Dairy Pipelines between January 1987 and March 1992. It is also common ground that during that time he produced a number of technical drawings, one of which formed the basis of the drawing of the patent. It is the circumstances and chronology which are at issue.

12. Mr Warner's position as set out in his first affidavit is as follows. He alleges that the invention of a mix-proof valve was made by him between April and June 1987. Shortly after he had joined Dairy Pipelines Mr Sutton asked him to look at the valves of competing companies. Mr Sutton had just been to the USA and had seen various valves, in particular, believed Mr Warner, a double butterfly valve used in place of a block and bleed valve as a cheap alternative at that time. Mr Warner carried out a complete review of competitors' valves, noting their good and bad points. The main problem with all of them was that pressure would cause them to open and attempts were made to circumvent the problem by using balanced areas and heavy springs. Following the review, Mr Warner set about designing his own mix-proof valve. It was, he says, his own sole decision to put together opposing valves which were operated independently but could be operated together.

13. Mr Warner embodied his new valve in a rough undated sketch for which he was solely responsible. That valve was a composite of a number of valves. He later made a first

legitimate (which I take to mean formal) drawing of one of the valves and the date on that drawing is 26 August 1987. Mr Warner admits that the original sketch is undated but says it must have been drawn earlier than 26 August 1987. He recalls discussing the sketch with Mr Sutton in August 1987 when he came to look at it on the drawing board; Mr Sutton made some comments on minor points and said that he would like the spacing between the spindles made as small as possible. At no time before Mr Warner was inspired to conceive the idea of a mix-proof valve as shown in the original rough sketch drawing, nor when Mr Warner showed that sketch drawing to Mr Sutton, was it put to Mr Warner that Mr Sutton had had the idea or that anything had emanated from him in any way. Mr Sutton made, alleges Mr Warner, no contribution to the mix-proof valve. It is Mr Warner's belief that on 2 January 1989 a first legitimate (formal) drawing of the mix-proof valve was made by him. This was some 18 months after his first formal drawing of one valve from the range depicted on the original (rough) sketch.

14. Dairy Pipelines' position is principally set out in Mr Sutton's first declaration. At the time of Mr Warner's appointment he held the position of Technical Director, which *inter alia* included overall responsibility for new product development, and as a consequence he was always on the look-out for possible new innovations. In the Spring of 1987 (and from his diary, a page of which is exhibited, he sees it was 1 April) he and Mr Burchell visited the Romford Brewery to discuss the supply of valves and fittings by Dairy Pipelines for a new plant to be built there. During the discussion the subject of block and bleed valves came up. Mr Sutton explains that such valves are also referred to as "no-mix" or "mix-proof" valves. At the time Dairy Pipelines did not have such a valve within its range and it became clear from discussion during the visit that it would be sensible for the company to design such a valve to include within its range. During the discussion references were made to other manufacturers but the discussion centred on problems experienced in practice with such valves.

15. Mr Sutton says that during the return journey from Romford, he and Mr Burchell discussed matters which had arisen during the day and in particular talked around the subject of a mix-proof valve. Mr Sutton recalls suggesting to Mr Burchell that from a conceptual point of view a valve which included opposed valve seats so that overpressure in either

pipeline would only have the effect of assisting closure rather than in any way assisting in lift-off could be the solution the industry was looking for. It was agreed that they would look into the possibility of incorporating this concept into a new valve with a view to making and testing a prototype. Shortly (as he recalls it, within a day or so) after the visit to Romford Brewery, Mr Sutton discussed the proposal for opposed valve seats with Mr Warner, who by then had been with the company for some four months, and Mr Sutton had every confidence that as a design draughtsman Mr Warner would be able to engineer this idea into a new product. Some time later he looked at some preliminary sketches produced by Mr Warner incorporating his idea. Referring to the undated sketch drawing, Mr Sutton identifies one figure (which he calls figure "A") of a mix-proof valve which incorporates opposed valve seats and independently operable valve closures, such as he had envisaged during his discussion with Mr Burchell on 1 April 1987 and subsequently relayed to Mr Warner as the idea to be developed. Mr Sutton's account is supported by Mr Burchell in his declaration in many respects, in particular in relation to their visit to the Romford Brewery and the discussion the two of them had on the return journey.

16. I am thus faced with two conflicting versions of events, and without the benefit of cross-examination to test the evidence. In these circumstances, I must take the best view I can of the evidence, which means I need to consider among other things areas of inconsistency in each side's evidence and the presence or absence of objective corroboration.

17. Much of Mr Warner's case hinges on when the various drawings on the undated sketch were made. The undated sketch is in fact a sheet having a number of separate parts or drawings. Several exhibits in the evidence of both sides show this sketch or sheet, at least in part. I think it was accepted though that exhibit A to Mr Warner's statutory declaration includes the full sketch and it is to this version that I am referring in this decision when I speak of the undated sketch or sheet. The drawings on the right-hand side of the undated sheet are concerned with the mix-proof valve of the invention, whilst the drawing at the centre of the sheet and those on the left-hand side are concerned with other valves. As Mr Warner made clear at the hearing, it is his contention that a formally dated version of the drawing of the other valve at the centre of the undated sheet, identified as PD0074 and exhibited by Mr

Warner, was produced on 26 August 1987, and therefore that all of the drawings on the undated sheet must necessarily have been made before that date. Formal drawings of two versions of the mix-proof valve which is the subject of the invention were made. The first of these is identified as PD0342 and is dated 2 January 1989; the second, identified as PD0373, is dated 30 March 1989. PD0373 is largely the same as the drawing contained in the patent specification.

18. There is I think no dispute, and I am prepared to accept, that Mr Warner produced all the drawings on the undated sketch and that the three formal drawings identified by number above were indeed produced by him on the dates printed on them. The difficulty lies in establishing links between those dates and that to be accorded to the undated sketch drawing sheet, or more especially to the individual parts or drawings it contains. There is for example some dispute about the sequence in which the parts of this undated sheet were drawn. Mr Warner submitted that the presumption must be that those parts of this drawing which were formalised as PD0074 must have been made before the date of that formal drawing, namely 26 August 1987.

19. Mr Birss, on the other hand, drew my attention to the differences between the undated drawing of the mix-proof valve and the first of the two formal drawings of it (PD0342), with the later (PD0373) being much more like the undated one, particularly in the presence and positioning of microswitches and solenoid valves in the respective drawings. In other words, he was suggesting, as had Mr Sutton in his first declaration, that the layout shown in PD0342 looks to be a retrograde step from the layout in the undated drawing. His deduction from this was that the design which is drawn in the undated sketch is a design intermediate the two for which there are dates which, since these dates were in early 1989, torpedoes the suggestion that the undated drawing of the mix-proof valve was something that was drawn nearly a year and a half previously. Mr Birss also submitted that inferences could be drawn from differences in underlining and spacing between different drawing parts in the undated sketch which implied that the sequence of drawing was not as suggested in evidence by Mr Warner, and that the sketch fell between the dates of PD0342 and PD0373. Mr Warner, in reply, said that the differences in microswitch and solenoid layout were to be ascribed to his taking

account of the capabilities of the machinery available, and disputed Mr Birss's underlining and spacing points.

20. At the hearing Mr Warner said that he produced the mix-proof valve sketch on the right of the undated sheet first, and after Mr Sutton's visit to America he then added particularly the version second to the left, the manual stop valve. Mr Birss argued that there is no way, from looking at the piece of paper carrying the undated sketch, that I can appreciate that the manual stop valve was drawn after the pressure release valve. In other words, said Mr Birss, because you can date one thing, does not mean you can date everything else. Later at the hearing, Mr Warner repeated his point about the relative timings of the undated drawings of the mix-proof and manual stop valves, but to the detriment of his case, I think. He said that the commonality of parts on the rough sketch shows that all of this range of valves (in the undated sketch) was thought of at the same time, and that the whole sketch was produced initially as a whole piece. However, he immediately contradicted this by saying that this was except for the manual valve which was added later; and he also said he then altered the other one further on the left which was also produced later. Without regarding the content of this statement as formally in evidence in relation to the dating of the various parts of the undated drawings, I believe it is indicative of an inconsistency in Mr Warner's reasoning: one moment he seems to suggest I should regard all the drawings on the undated sheet as having been made at once, then he seems to be saying they were not.

21. What is quite clear to me is that I cannot without evidence assume that all the drawings on the undated sketch were made at the same time, and that on the evidence available to me I should not do so. Thus, even if I were to accept Mr Warner's position that the formal drawing of the valve of PD0074 was pre-dated by its counterpart on the undated sketch sheet, this would not help me in dating the mix-proof valve sketches on the same sheet. As to the dating of those sketches, despite the availability of the dated formal versions PD0342 and PD0373, I do not find myself able on the evidence to decide when the sketches were drawn. In short, I can find nothing sufficiently persuasive in the evidence and submissions put to me which would allow me, on the balance of probabilities, to ascribe a date to the undated

drawing and in particular to that part of it which relates to the mix-proof valve of the invention.

22. Mr Birss pointed to aspects of Mr Warner's evidence which he said cast doubt upon the reliability of Mr Warner's recollection. First, he highlighted Mr Warner's statement in his first affidavit that he made the invention, and the undated drawing, between April and June 1987, shortly after joining Dairy Pipelines and just after Mr Sutton had been to the United States of America. Mr Sutton in his first declaration, on the other hand, says that he did not visit the United States of America in 1987 prior to the issue of his visa. He exhibits copies of pages from his passport which show a visa dated September 1987 and a US Immigration stamp dated 26 September 1987. This, Mr Birss said, is objective evidence demonstrating that the US visit must have been at that time of year, namely September 1987. Faced with this evidence, Mr Warner rejoined in his statutory declaration that "Mr Sutton's declaration refutes my approximate dating of original sketch based on my *assumption* that it was made after his visit to America" (my emphasis). Mr Birss pointed out that Mr Warner's first affidavit did not say he was making an assumption anywhere, but he then admits it was. Mr Birss said that key evidence from Mr Warner is in a paragraph which is now admitted to contain assumptions, and is therefore open to doubt.

23. A further point made by Mr Birss was in relation to the timing of the review of products made by Mr Warner. Mr Warner in his first affidavit says Mr Sutton asked him to do this just after he had been to the United States. Mr Sutton's evidence too is that this review was prompted by his visit to the United States. However, Mr Sutton's passport establishes that that visit was in September 1987. As Mr Birss pointed out, if Mr Warner had made the invention after that review, it could not have been in April to June 1987 as the review, on the evidence, was not until after the US visit in September. At the hearing, Mr Warner said the review was conducted before Mr Sutton's visit to America, a submission which is contrary to his sworn written evidence. He went on at the hearing to say:

"In that respect my first statement was in error because when I made that I felt that the two had been around the same time. But it was purely just a case of a failure on my

part to remember exactly whether they were together or not.”

24. This admission does not encourage confidence in the accuracy of Mr Warner’s recollections. It might though be said, as Mr Warner did at the hearing, that his only confusion was that he had thought Mr Sutton’s visit to America was earlier than in fact it was.

25. Mr Birss also pointed to what he said was an inconsistency between the date said by Mr Warner to be when the invention was made, and a letter from Mr Warner's professional advisers, which states that he undertook the survey of competitors' products “at or about one year after commencement of his employment”, which was in January 1987. This would make it later than the time of April to June 1987 said by Mr Warner in his declarations, but roughly consistent suggested Mr Birss with the timing of Mr Sutton's visit to the USA. Taken with the doubts about the reliability of Mr Warner's recollection introduced by the debates about the possible dating of the undated drawing and Mr Sutton's visit to America, Mr Birss's submission, as I understand it, was that I should give less weight to the evidence of Mr Warner. He submitted that since documentary evidence on Dairy Pipelines' side had been produced which has caused Mr Warner to admit to assumption and doubtful recollection, and since Mr Sutton's evidence is only definite where he is sure, and that he admits when he is not, then Mr Sutton's version should be more persuasive, particularly as it is corroborated by the declaration of Mr Burchell.

26. On the other hand, Mr Warner attempted to cast doubt on Mr Sutton’s evidence as follows. Mr Warner has no recollection of being asked by Mr Sutton to develop the detailed construction of a valve Mr Sutton had already envisaged. At the hearing he argued that normal drawing office procedure would have entailed a formal drawing office request sheet to be produced, perhaps with written calculations, for him to produce such a detailed drawing, if Mr Sutton's version was correct. He has no recollection of receiving such a formal written request or calculations from Mr Sutton, and neither has Mr Sutton put forward such a request or calculations in evidence. Mr Warner did put forward in evidence his own calculations, but these were not expanded upon or explained at the hearing, and I find myself unable to derive any significant help from them. He also asserted that it is significant that the undated drawing

includes both the mix-proof valve and others which are said to be part of a range of valves. He said at the hearing that if he had been asked to produce a drawing of a mix-proof valve, then that is all he would have done and it would have been a proper drawing and would show no extra figures of a range of valves as the undated sketch does.

27. I have carefully considered these points made by Mr Warner about Mr Sutton's evidence. I note the lack of evidence of a formal request for a drawing to be produced, but in the absence of evidence to show that this was standard practice, I cannot give this much weight. Neither can I draw much from the assertions of Mr Warner that Mr Sutton did not provide calculations. While these points throw a contrary view on Mr Sutton's evidence they do not show up his testimony as being inconsistent or incorrect.

28. On balance I tend to agree with Mr Birss's view of the evidence. Mr Warner's evidence is inconsistent in places and he admits to assumption and at least one failure of memory, so that his position that he made the invention in April to June 1987 is subject to some uncertainty. By contrast, Mr Sutton's evidence is supported by diary and passport extracts and the date and content of a conversation on 1 April 1987 when he said he came up with the idea of the invention are corroborated by Mr Burchell. As I said earlier, the onus in the application under section 13 is on the applicant, Mr Warner, to show that he was the actual deviser of the invention. On the basis of the evidence he has submitted, I find myself unable to conclude that Mr Warner has discharged that onus. Accordingly, I find that Mr Sutton should remain the sole named inventor.

29. I should add that evidence was put in regarding the possibility at one time of Dairy Pipelines agreeing to the naming of Mr Warner as inventor. Indeed, the evidence shows that a "without prejudice" offer was made to Mr Warner. Mr Birss, at the hearing, made the point that the making of this offer was a commercial decision, and not necessarily any admission. Although Mr Birss did not take issue with the admissibility of this "without prejudice" offer in evidence, I feel that I should be very circumspect in drawing conclusions about Mr Warner's inventorship from it. In any event, even if admissible, it would not persuade me to depart from the conclusion I have already reached.

30. Although I shall return to it under entitlement, I should also acknowledge in regard to inventorship that evidence was submitted in respect of Mr Warner's terms, conditions and job description. However, that evidence, such as it was, did not point me to the facts surrounding the devising of the invention, and especially who did that, and again I find it no help in resolving that issue.

Entitlement

31. The right to apply for and obtain a patent is governed by section 7 of the Act, subsections 2 and 4 of which read:

"(2) A patent for an invention may be granted -

- (a) primarily to the inventor or joint inventors;
- (b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;
- (c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned;

and to no other person."

"(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under

subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled."

32. Sections 7(2) and 7(4) make clear that an inventor named under a patent is presumed to have the entitlement in it unless there is an over-riding enactment, law, treaty or agreement. Since I have already found that Mr Warner should not be named as inventor, it follows that he derives no entitlement to the patent through section 7(2)(a). In these circumstances the onus is then on the referrer under section 37, Mr Warner, to demonstrate that he has an entitlement under section 7(2)(b). In this respect I accept Mr Birss's submission that the evidence provides no basis at all for a determination that Mr Warner has any entitlement by virtue of section 7(2)(b) since it contains no indication of any agreement which might override the statutory position of section 7(2)(a).

33. For completeness I should note that evidence was submitted which concerned Mr Warner's position and role within the company. There were produced in Mr Sutton's evidence two different poor copies of a job description, annotated in manuscript, which Dairy Pipelines said applied to Mr Warner. Parts were unclear including the date. Mr Warner, on the other hand, said that he had never seen, much less accepted, this job description. He said at the hearing that the job description was irrelevant since he was not bound by it and did not see it. He says he never signed any terms or conditions. Mr Birss accepted that he did not sign them but argued that they are put forward by Mr Sutton as being the terms and conditions that applied to Mr Warner. Evidence was also put in regarding Mr Warner's role in discussions with a patent agent and in an internal meeting.

34. On the basis of this evidence I believe I would find myself unable to determine whether the exact job description applied to Mr Warner, or indeed what his duties, normal or otherwise, precisely were. However, that exercise is in any case unnecessary and would only be so if I had found Mr Warner had been the deviser of the invention and needed in consequence to decide whether that invention belonged to him or his then employer. Since I have not been persuaded that he, rather than Mr Sutton, was the inventor, that question does

not fall to be considered, and the matter of his duties and job description is irrelevant to my decision.

35. Thus, I find that Mr Warner has not discharged the onus on him and that his reference under section 37 therefore fails.

Summary

36. Having carefully considered all the evidence and submissions, for the reasons given above I refuse the application under section 13 that Mr Warner be named as inventor under the patent in place of Mr Sutton, and in respect of the reference under section 37 I find that Mr Warner has not shown himself to have any right in or under the patent.

Costs

37. Both sides asked for and addressed me as to costs. Following long-established practice, costs in proceedings before the Patent Office are not intended to compensate parties for the expense to which they may have been put, and are generally awarded on the basis of a published scale. Mr Birss alluded to an offer made without prejudice save as to costs to Mr Warner in 1995 as justifying more than the usual scale of costs, were Dairy Pipelines to be successful.

38. In the event, they are successful, but I am not persuaded that I should, in this case, depart from the usual scale. I therefore direct that the referrer, Mr Warner, pay the opponents, Dairy Pipelines Limited, the sum of six hundred pounds (£600) as a contribution to their costs.

Appeal

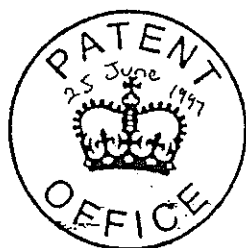
39. Since this is a decision other than on a matter of procedure, any appeal shall be filed within six weeks from the date of this decision.

Dated this 25th day of June 1997



S N DENNEHEY

Superintending Examiner, acting for the comptroller



THE PATENT OFFICE