

**PATENTS ACT 1977**

0/149/92.

IN THE MATTER OF a reference  
to the Comptroller under Section 8(1)  
by CLAREHILL PLASTICS LIMITED in  
respect of UK Patent Application number  
8617021.4 in the name of DONALD HAMILL

**DECISION**

**BACKGROUND**

1. The application in suit was filed on 12 July 1986 naming Donald Hamill both as applicant and inventor and giving Messrs Fitzpatricks as agents and address for service. It progressed through the normal stages of search and examination, being published on 27 January 1988 and resulting in the grant of a patent in the name of the original applicant on 3 April 1991.
2. This reference under Section 8(1) was filed on 30 January 1991 by Clarehill Plastics Ltd (the "referrers") stating that, at the time of filing of the application Donald Hamill was an employee of that company, and claiming entitlement to all rights and ownership in the application by virtue of Section 39(1). Following the grant of the patent the reference was treated as having been made under Section 37 by virtue of the operation of Section 9 of the Act.

**SUBJECT MATTER OF THE PATENT**

3. The patent relates to a moulded plastic vessel, eg a storage tank, where the sidewall has an integrally moulded compression coupling member for connecting pipes thereto. The member is strengthened by a sleeve of material stiffer than that of the member (eg copper or brass) to prevent the transmission of coupling-tightening torque to the vessel wall.

## THE FACTS

4. In support of their statement the referrers have filed two statutory declarations, one dated 12 September 1991 in the name of Mrs Mary K Gracey the managing director of Clarehill Plastics Ltd and the other dated 28 August 1991 in the name of Ewan Stuart Bewley, of Messrs Fitzpatricks, (the "agents") who dealt with the application for the patent in suit up to the time of its grant and who are acting for the referrers in the present proceedings.

5. In reply, Mr Hamill (the patentee) has filed a letter dated 6 May 1991, which has been treated as a counterstatement. In it, the patentee confirms that the application was made in his name and states that he paid the fees to the agents. He further states that the invention occurred before he had any involvement with the referrers.

6. The patentee has not filed any evidence in support of his counterstatement, although Exhibit 1 to the evidence of Mr Bewley on behalf of the referrers contains two letters from solicitors who acted for the patentee at one time and which expand upon the patentees position on this matter (letters from Rory McShane & Co dated 23 July 1990 and 26 September 1990). The only point of dispute on the pleadings therefore is that the referrers say that the patentee made the invention during the course of his employment with them, whereas the patentee says that he made the invention before that period of employment.

7. Mrs Gracey's evidence is that the patentee had a verbal contract of employment as technical development manager with the referrer (paragraph 2) commencing on 1 August 1985 (paragraph 7) and shortly after starting work (paragraph 4) was provided with a job description (Exhibit 1) which is undated but identified the duties as inter alia "improving existing products to solve technical and costing problems" and to "modify size and features of existing range in order to extend range on offer". The company has about 17 employees (paragraph 3) and it appears from Exhibit 1 that the management structure involved other members of the Gracey and Hamill families.

8. She continues (paragraph 8) that the patentee was instructed to design a tank outlet and this work led to an application for the patent in suit (paragraphs 9 and 10). The design and the patent application are stated to have been carried out in consultation with Mrs Gracey. It was decided "for good strategic commercial reasons" (not identified) (paragraph 15) to file the application in the name of the patentee with the intention of subsequent assignment to the referrers. The patentee also made the initial "interim" payment to the agents although it is stated (paragraph 12) that he was previously put in funds for this purpose by the referrers.

9. Mrs Gracey states in this connection (paragraph 12) that "the Company understood that because the Patent Application was to be filed in the employee's name then the interim payment to Fitzpatrick's must be made directly by the employee." Exhibit 1 to Mr Bewley's declaration refers to an invoice for this initial payment made out to "Clarehill Plastics Ltd". All further payments to the agents are stated (paragraph 14) to have been made by the referrers "in the belief that the Patent Application belonged to the Company".

10. The patentee's employment with the referrers was terminated on 30 November 1986 "after a period of several weeks absence from work without explanation" (paragraph 7) and thereafter the matter of assignment "was overlooked" (paragraph 15).

11. Mrs Gracey concludes her declaration by saying that the referrers do not dispute inventorship (paragraph 16).

12. Mr Bewley gives evidence that he was the agent responsible for the prosecution of the patent in suit from 23 February 1989 and is the agent responsible for the present proceedings. He submits as Exhibit 1 correspondence with the agents in relation to the application.

## CONCLUSIONS

13. The onus on the referrers is to establish that the conditions set out to Section 39(1) are satisfied, namely

- a. that the invention was made in the course of the normal duties of the patentee or of other duties specifically assigned to him by the referrers, and the circumstances are such that an invention might reasonably be expected to result from carrying out his duties, or
- b. that the invention was made in the course of the patentee's duties and the patentee had a specific obligation to further the interests of the referrers' undertaking.

14. No evidence regarding the business of the referrers has been provided beyond their notepaper (a specimen of which features in the exhibit to Mr Bewley's declaration) from which it can fairly be deduced that their business is primarily in producing moulded plastic containers of various types including storage tanks.

15. As technical development manager in such a Company whose job description includes "improving existing product to solve technical....problems" it is fair to assume that the patentee would be expected to produce technical improvements in relation to moulded plastics storage tanks. The invention of the patent in suit clearly relates to such an improvement.

16. The patentee has not denied that he was an employee of the referrers at the date of making the application but alleges that the invention was conceived before his employment by the referrers. Mrs Gracey states in paragraph 8 of her declaration that the invention was conceived as a result of an instruction from her during the patentee's period of employment, and the patentee's own solicitor's letter of 23 July 1990 (Exhibit 1 to the declaration of Mr Bewley) acknowledges that "the invention was developed during the time that he (the patentee) was employed as General Manager of Clarehill Plastics Ltd." The patentee's employment with the referrers commenced in August 1985, according to Mrs Gracey, and the first recorded approach by the patentee to the agent was in a letter from the agents dated 30 May 1986 referring to a visit by the patentee on 22 May 1986. The application for the patent in suit was made about one year after the patentee became an employee of the referrers.

17. The referrers' evidence is in my opinion credible, and I accept it as establishing that the invention was made by the patentee in the course of his normal duties as the referrers'

employee, and is the sort of invention that might be expected to result from carrying out his duties. I therefore find that the invention belongs to the referrers.

18. The relief sought by the referrers is the transfer to them of rights in the application. Since the application has now matured into a patent, the appropriate order, which I hereby make, under Section 37(2)(a), is that the referrers Clarehill Plastics Ltd be registered as the sole proprietors with the present patentee Donald Hamill remaining as inventor.

19. I award the referrers Clarehill Plastics Ltd the sum of £250 as a contribution to their costs and direct that this sum be paid to them by the patentee Donald Hamill.

Dated this 24 day of August 1992



**W J LYON**

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE