

PATENTS ACT 1977

BLO/101/96

IN THE MATTER OF a reference under
Section 12 by Kedah Limited in respect of
Patent Application No WO 91/17222 in
the name of Kitelane Limited

DECISION

International (PCT) patent application No 91/GB/00691 entitled "Ball Pen Inks" was filed on 30 April 1991 claiming priority from earlier UK patent application No GB 9009662 which had itself been filed on 30 April 1990. The earlier UK application was later published on 27 November 1991 as GB 2244280 and the PCT application was published on 14 November 1991 as WO 91/17222. Whilst the earlier UK application was filed in the name of Thomas Hanrahan as sole applicant and inventor and subsequently assigned to Kitelane Limited ("Kitelane") on 26 October 1990, the PCT application, although still naming Mr Hanrahan as inventor, was filed in the name of Kitelane for all designated Countries except for the USA where Mr Hanrahan was the named applicant.

On 5 June 1992, Kedah Limited ("Kedah") referred to the Comptroller under Section 8(1)(a) the question whether GB 9009662 should proceed in their name instead of that of Kitelane. In the event, neither Kitelane nor Mr Hanrahan nor a further firm by the name 'Francois-Charles Oberthur' (which it would appear was by that time the owner of Kitelane) filed any Counterstatement in the entitlement proceedings, which were consequently treated as uncontested.

In a decision dated 12 January 1994, the Hearing Officer found that the particular invention disclosed in application GB 9009662 had its origins in an earlier unpublished UK application GB 8319258 filed by a company called Stratabord Limited ("Stratabord") and disclosed to Mr Hanrahan in 1984 with a view to licence negotiations with the company Gestetner Limited for whom he was, at that time, an employee. Stratabord subsequently ceased trading and Kedah had purchased an assignment from the Treasury

Solicitor of all of the residual assets of Stratabord inclusive of the benefit of the invention the subject of GB 8319258. The Hearing Officer thus held that the referrers Kedah had established their entitlement to the particular invention disclosed in GB 9009662, although not to the invention as broadly set out in claim 1 of that application which omitted an essential feature of the earlier invention of GB 8319258. The omitted feature was the presence in the claimed ink composition of a fatty acid oil component. Pursuant to that finding, he had an order under Section 8(2)(a) that application GB 9009662, restricted to compositions containing a fatty acid oil, should proceed in the sole name of Kedah and that a Mr Harry Grenville Clewer (the inventor named in GB 8319258) should be named as sole inventor. The application thereafter proceeded in that manner and was subsequently granted on 28 September 1994.

On 6 March 1996, Kedah have now further referred to the Comptroller under Section 12(1) the question of entitlement as regards PCT application WO 91/17222 which corresponds exactly in content to GB 9009662 from which it derives priority. In their Statement of Grounds they contend that, since the Comptroller has already determined by virtue of the decision in respect to GB 9009662 that Kedah is entitled to the invention disclosed in the PCT application and that the earlier assignment of the invention to Kitelane was null and void, the matter can only be seen as *res judicata* between the parties or that in the alternative Kitelane and/or Mr Hanrahan are estopped from contending to the contrary pursuant to the doctrine of issue estoppel.

Kedah are seeking an order that they are entitled to the invention the subject of WO 91/17222 not, it would appear, because they want to take on that application themselves, but rather as explained in a letter dated 15 May 1996 from their patent agents Hulse & Co. to provide evidence to take before the European Patent Office ("EPO"). It would appear that the EPO have cited WO 91/17222 against a similar European application filed by Kedah and that a decision in their favour as regards entitlement may be a key element in an attempt to cause the EPO to declare the PCT application to be an invalid or improper publication such as to be discounted when considering the validity of the Kedah European application. There is now some urgency in their request because the EPO have set an expiry date of 14 June 1996 for response in this regard.

Having regard to the prior decision and the fact that the subject matter of WO 91/17222 is identical to that of GB 9009662 as filed, an Official letter was issued on 16 April 1996 to Kitelane at their last known Paris address and to Mr Hanrahan in the following terms:

"Your attention is drawn to the enclosed copy of a reference and a statement made under Section 12 of the Patents Act 1977 seeking an order that Kedah Limited are entitled to the invention the subject of International (PCT) application number WO 91/17222.

It is the position of the referrer that following the decision of the Comptroller in respect of corresponding UK application number 9009662.9 (from which the PCT application derives priority) that the proprietors are estopped from contesting this reference since the issue between the parties has, in effect, already been determined.

The preliminary view of the Office is that this is the case and that the new reference in relation to the PCT application should be determined in line with that of the priority application without fresh reconsideration of the issue.

You are given one month from the date of this letter to comment on or contest this opinion, failing which the case will be referred to a hearing officer for a decision.

A copy of this letter is being sent to the referrers."

A response dated 29 April 1996 was received from the Paris address in the name of the firm 'Francois-Charles Oberthur' (said in the earlier action to be the owners of Kitelane) to the effect that Kitelane had been wound up in 1995 and that, as a consequence, they did not wish to oppose the decision of the Comptroller. No response was received from Mr Hanrahan himself.

It, thus, now falls to me to make a formal decision in this issue.

As previously noted, PCT application WO 91/17222 is word-for-word identical to GB 909662 as filed, and I am content that the issue between the parties is thus identical in regard to both the prior reference under Section 8 and the present reference under Section 12.

Thus, in line with the earlier decision I find that in the case of International (PCT) application No WO 91/17222, the referrers Kedah Limited have established their entitlement to the particular invention disclosed, in so far as it relates to ink compositions containing a fatty acid oil, and that the true and sole inventor of that invention was Harry Grenville Clewer. It follows that any assignment of the invention to Kitelane Limited is without effect since no proper title was vested in the declared inventor Mr Thomas Hanrahan in the first place. Whilst my finding would extend to any corresponding European or national applications for the same invention and originating from the PCT application, there has been no evidence that any such further applications in fact exist.

In the circumstances of this case, I make no order as to costs. Any appeal from this decision must be made within six weeks of the date of the decision.

Dated this 21 day of May 1996

G M BRIDGES

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE