

**PATENTS ACT 1977**

01145/93

IN THE MATTER OF Applications GB9007952.6

(Serial No 2244247) and PCT/GB91/00543

in the names of Graham Brooks

and Michael Harold Cope

and

IN THE MATTER OF five references by

Graham Brooks and Michael Harold Cope

under sections 8, 10, 12 and 13

**DECISION**

These proceedings are all closely related and concern a dispute about who made the invention and who has rights in the two patent applications. British application No GB9007952 was filed on 7 April 1990 and published as GB2244247A on 27 November 1991. International application No PCT/GB91/00543 was filed on 8 April 1991 claiming priority from the GB application and was published as WO91/15385 on 17 October 1991. Both were filed in the names of Graham Brooks and Michael Harold Cope who are named as joint inventors. The PCT application has entered the regional phase as a European application and the GB application has received its first substantive examination report under section 18(3).

In a preliminary decision dated 11 June 1993 I held that all five proceedings should be consolidated with the evidence on any one being taken into account for all others. I also held that the proceedings initiated by Mr Cope under sections 8(1)(b) and 12(1)(b) were not well founded. These references were based on inappropriate subsections of the Patents Act, but it was accepted on behalf of Mr Brooks that I had jurisdiction under sections 10 and 12(4) to make any necessary orders in favour of Mr Cope. Accordingly, the matters that are before me are as follows:

1. the application under section 13(3) by Mr Cope made on 10 September 1991 in which he asks firstly that the comptroller order that he be named as sole inventor,

secondly that the comptroller issue a certificate that Mr Brooks ought not to have been named as inventor and that he rectify any undistributed copies of the application, thirdly such other relief as the comptroller sees fit and lastly costs. Mr Brooks opposed the application in a counterstatement filed on 7 January 1992.

2. the request under section 10 by Mr Brooks made on 14 January 1992 seeking that the comptroller direct that the application proceed in his sole name, such other order or relief as the comptroller deems right and proper and, lastly, costs. Mr Cope opposed the request in a counterstatement filed on 13 April 1992.

3. the reference under section 12(4) made by Mr Brooks also on 14 January 1992 seeking analogous relief for the PCT application as for the GB application. Mr Cope opposed the reference in a counterstatement filed on 13 April 1992.

The initial evidence filed by Mr Cope consists of a statutory declaration made by him on 5 November 1992 with two exhibits and a statutory declaration made by him on 10 November 1992 with 23 exhibits. That by Mr Brooks consists of a statutory declaration made by him on 2 September 1992 with three exhibits, a statutory declaration made by him on 8 September 1992 and a statutory declaration dated 10 March 1993 by Mr Brooks' patent agent, Mr Funge together with three exhibits.

In my preliminary decision I found that much of the evidence was not in an acceptable form and gave an opportunity for formal versions of the informal evidence to be filed. I also admitted two further statutory declarations made by Mr Cope on 19 May 1993, each with an accompanying exhibit.

Both parties took the opportunity to formalise some of their evidence. Mr Brooks filed a statutory declaration made by him on 28 June 1993 with one exhibit and a statutory declaration by a Mr Martin Lister on 29 June 1993 with one exhibit. Mr Cope filed statutory declarations sworn by the same Martin Lister on 9 June 1993, by Miss Wendy Tarrant on 8 June 1993, by Mr Gordon Booth on 9 June 1993 and by his son Mr Shaun Cope on 9 June 1993.

The matter came before me at a hearing on 14 and 15 October 1993 at which Mr H Funge appeared on behalf of Mr Brooks and Mr Cope represented himself.

The invention relates to a wheel clamp particularly for a motor car. The clamp has a frame which stands against one side of a car wheel and a pair of chains each of which is fixed at one end to the top of the frame and can be looped round the other side of the wheel to be connected at its other end to the lower part of the frame. A cover plate is locked over the frame to deny access to the points of securement of the chains to the frame. The GB application discloses just one embodiment in which the free end of each chain is connectible to the frame by engaging in a notch in one end of a respective strip mounted between its ends on a rotatable bar. The cover plate presses against the other end of the strip to rotate it and so tension the chains. The PCT application has the same disclosure as the GB application, plus one additional embodiment in which the notched strips are dispensed with and the free ends of the chains engage pins on the rotatable bar. The bar has a depending weighted strip which rotates it to tension the chains. Upper and lower "cover bars" (links) extend between the chains on the opposite side of the wheel to the cover plate to prevent them being pulled apart and so off the wheel.

It is not in dispute that at the time the invention was made Mr Brooks was working for Circle Contract Hire, a company selling ex-contract hire commercial vehicles, and Mr Cope operated his own business, Payless Services in Greater Manchester. They first met when Mr Brooks took a vehicle for repair to Payless Services. This was in October or November 1989 according to Mr Brooks or January 1990 according to Mr Cope. A good relationship developed between them in which Mr Brooks was offered, but declined, work with Payless Services, and they discussed other business possibilities. Mr Brooks introduced the idea of a wheel clamping business for operation on private vehicle parks and, on Thursday 22 March 1990, Mr Brooks went to Middlesbrough to buy a commercially available clamp, the "Denver Boot", paid for by Mr Cope. Mr Brooks returned that afternoon with a "Denver Boot" to Mr Cope's premises.

With the help of Mr Shaun Cope, they tested the Denver Boot the same day, and found it awkward to use. Mr Cope said he was not going into business with it and a sort of challenge

was thrown down by Mr Brooks to Mr Cope to design a better clamp. It is agreed that Mr Cope spent time whilst Mr Brooks was not present on the Thursday and Friday sketching various designs. Both parties accept that he produced two designs which are markedly different from the invention and appear as drawings A and B in Exhibit MHC5 to Mr Cope's statutory declaration of 10 November 1992.

The invention was made over the next few days, between 22 March and the following Tuesday 27 March, when they both visited a firm of blacksmiths, Luke Lister, to arrange for a prototype to be made.

Mr Cope's version of events is that he produced a further drawing which forms the basis of the invention. A copy of this appears in the lower half of Exhibit MHC6 and the original was produced before me at the hearing. It is shown to a larger scale as drawing C of Exhibit MHC5. Mr Cope also explained in the witness box how he had progressed from designs A and B to C by pointing out that all three use the concept of having straps going around the wheel in several places. Mr Cope says that he showed this to Mr Brooks on Friday 23 March and agreed with Mr Brooks that they must get it made up. Mr Brooks knew of Luke Lister and visited that company by himself on the following Monday to ask if they could produce a wheel clamp from drawings. The two of them returned the next day with the drawing and discussed details and arranged for a clamp to be made. This was collected on the Friday 30 March.

Mr Brooks' version is that the idea of using straps to wrap around the wheel came to him over the weekend of 24/25 March, probably on the Monday morning, whilst watching his wife put on her bra. A cigarette packet he was holding gave him the idea of the frame for the clamp. Mr Brooks says he then went to Luke Lister's on his way to work on the Monday and discussed the idea with them in terms of a cigarette packet and bra without any drawings and obtained a rough price of £85-£125 for making one. He then told Mr Cope of his idea and the two of them went to Lister's the next day.

The difference between the two versions boils down to whether Mr Cope made the relevant drawing on the Friday and showed it to Mr Brooks or whether Mr Brooks came up with the idea over the weekend and told Mr Cope of it on the Monday.

Mr Shaun Cope and Miss Tarrant both say that they saw Mr Cope making sketches on the Thursday and Friday. Miss Tarrant confirmed that these included the drawing in Exhibit MHC6. Mr Mark Lister confirmed that drawing MHC6 was shown to him on the Tuesday, 27 March 1990 when Mr Cope and Mr Brooks both came to his premises. Mr Lister's evidence at no point contradicts Mr Cope's version of events, but is not fully consistent with that of Mr Brooks. In particular, Mr Lister testified that, on his first visit on the Monday, Mr Brooks did have a drawing "like a headstone shape" on a cigarette packet, but denied that the clamp was discussed in any detail or that a price was given on the first visit. Mr Lister said however that he received many short enquiries of the kind that Mr Brooks made on the Monday, and usually no work resulted from them. Mr Brooks also said that his discussions at Lister's on the Monday were mainly with Mr Lister's father Brian Lister. Accordingly I do not regard the inconsistencies between Mr Brooks' and Mr Lister's accounts as decisive.

Another witness was Mr Gordon Booth, whose employer Mr Worthington set up a company called Lateral Innovations Ltd with Mr Brooks in or after September 1990. Mr Booth's evidence is that he was asked to make a clamp to Mr Brooks' instructions, but Mr Brooks could not describe the clamp in sufficient detail. He therefore formed the opinion that Mr Brooks could not have designed or invented the clamp. Mr Brooks told me from the witness box that Mr Booth was no friend of his, and could be expected to do him no favours. Mr Booth's declaration itself is certainly couched in terms suggesting some ill will towards Mr Brooks, but it is unchallenged, and I accept that Mr Brooks was unable to offer much more help to Mr Booth than to show him the patent drawings. It is possible however that Mr Brooks made the invention but took little interest in the subsequent work, for instance to dimension the clamp so that it fitted anything from a Mini to a Range Rover.

Mr Brooks' evidence is however let down in two crucial respects which he could not satisfactorily explain at the hearing. Firstly, he categorically states in paragraph 21 of his statutory declaration of 2 September 1992 that the drawing (Exhibit MHC6) "was made by

me and not by Mr Cope" whereas he was equally explicit in the witness box that he did not make that or any other drawing. In the witness box he also said he could not remember drawings being produced "even in our meeting at the blacksmiths". His explanation for this conflict was that

"at the time I made this statement [in his statutory declaration] I was obviously very confused in what I was saying . . . . . I could not draw something that was in my head it was too abstract".

Secondly, it was accepted that Mr Brooks had written an application for an award under the DTI's SMART scheme (Small firm Merit Award for Research and Technology), part of which was included in Exhibit MHC12 to Mr Cope's statutory declaration of 10 November 1992. In it he wrote

"Well he did it - Mike [ie Michael Cope] designed and produced the most simple only two component wheel clamp".

I asked Mr Brooks at the end of his long spell in the witness box how this could be reconciled with his claim to have made the invention himself. He said that Mr Cope had been involved with modifications to the original design and that

"I'd have to make Mike look as though he was making a lot more contribution than he really was".

It is these two conflicts in Mr Brooks' evidence that satisfy me that I should accept Mr Cope's account of the making of the invention. I am prepared to believe that Mr Brooks may have had some idea whilst watching his wife dress of wrapping straps around a vehicle wheel, but I do not believe that he reduced it to a practical design, either on paper, or in his head. It is accepted that Mr Cope drew the original of Exhibit MHC6, and I am satisfied that it was prepared solely by Mr Cope developing his ideas from drawings A and B of Exhibit MHC5, and that this drawing was the one used to explain the invention to the blacksmith so that a prototype could be made.

The prototype included modifications to the original drawings, in particular the use of chains rather than wire and the provision of the pivoting notched strips to engage the free end of

the chains. These modifications were developed in discussion between Mr Lister and Mr Cope, who disagree with Mr Brooks' evidence that he also participated. The prototype was collected on Friday 30 March, and after being shown to patent agents (which I shall return to later), it was taken to Mr Cope's premises for testing. It proved unsatisfactory because the chains could be pulled off the wheel. A modification suggested by Mr Brooks was to cross the chains behind the wheel, but this was also unsatisfactory. A further modification, suggested by Mr Cope, was to use a chain link between the two chains. This modification was notified to the patent agents in time for it to be included in the GB application.

Further modifications were made which appear in the PCT application, and it was accepted at the hearing by Mr Funge that they had been developed by Mr Cope. It therefore follows that I find that the invention in both the GB and the PCT applications was made by Mr Cope and that he alone is entitled to be named as inventor in the two applications.

Having decided that Mr Cope is the sole inventor, I need to decide whether the rights in the two patent applications belong to him alone or to some other person. Section 7(2) of the Patents Act 1977 provides:

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 any 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.

Mr Cope will therefore be the owner of the patent rights unless there existed an agreement under which some other person became so entitled. It is not in dispute that at the time the invention was made, in the last week of March 1990, Mr Cope and Mr Brooks were on very good terms, and had a working relationship which, they expected, would endure and would be profitable. Having picked up the prototype clamp from Messrs Lister on Friday 30 March, they carried it a little way along Heaton Lane, Stockport to the offices of McNeight & Lawrence, patent agents, and had an interview with Mr John Lawrence of that firm about patenting the clamp. Mr Lawrence does not give evidence, but Mr Cope and Mr Brooks agree that they were asked whose name the application should be in, that Mr Brooks answered that it should be in both their names, and that Mr Lawrence interpreted that as meaning that they should be named as joint inventors and as joint applicants. Consideration was also given to putting the application in the name of a company that it was assumed they would set up, but the decision was that it should be in their own names.

It is accepted that the agreement between them was oral, but I have no doubt, mainly because of the transaction that I have just related at the offices of McNeight & Lawrence that its terms included an agreement that the rights in these inventions would be held jointly. Mr Funge's submission on behalf of Mr Brooks was that the agreement, based on Mr Brooks being the inventor, was conditional on Mr Cope putting £15,000 in cash into the business, and that since the condition was not satisfied, the agreement became void.

Mr Cope agrees that in the early days before the invention was made and they were only thinking of a local clamping business using the Denver Boot he was to provide some cash. But he says that after making the invention they decided to consider country-wide franchising of the invention and he realised he would not be able to provide the larger amount of financing required and so they went for a jointly guaranteed overdraft. He agreed to provide some equipment, but not cash. He regarded Mr Brooks' contribution as being his joint guarantee of the overdraft and his marketing and sales experience.

A portion of a business plan submitted to Barclays Bank was produced as Exhibit MHC12 to Mr Cope's statutory declaration of 10 November 1990. But this does not help decide the



nature of the agreement between the two as it is incomplete and there is nothing to indicate the terms finally settled between them and the bank.

There was much discussion as to when Mr Brooks first thought of franchising. Mr Brooks maintains in his statutory declarations that he had discovered the "Denver Boot" was clumsy prior to buying one and had suggested to Mr Cope a franchising operation would be commercially successful if he could come up with a simple wheel clamp, but he did not have suitable design at this stage. He says that his papers on this have been removed from his office at WCSS. But he was much less certain under cross-examination as to when he had the idea of franchising and Mr Cope is clear that, prior to the invention, they intended going into business using the "Denver Boot" to operate a commercial clamping service to clamp illegal parking in vehicle parks. I do not think it matters for present purposes when franchising was decided upon. There is no doubt that this was one of Mr Brooks' contributions to the venture, and supports Mr Cope's case that he wanted Mr Brooks as a partner because of his marketing skills. It is accepted that Mr Cope offered Mr Brooks a share in Payless Services before the invention was made, and it is clear that Mr Cope regarded Mr Brooks' business acumen very highly. In my judgment, the basis of the agreement between them at the time the invention was made was that Mr Cope provided the technical expertise, including the invention, and also the bulk of the finance, whereas Mr Brooks provided the sales and marketing expertise.

Much evidence was given, both in written and oral form, of the continuing ill-will and consequential litigation between the parties since the liquidator was called in, but I do not consider that it has helped me to discover the terms of the agreement between them.

I am satisfied however that the agreement was made on the false premise that Mr Cope and Mr Brooks would put the exploitation of the invention on a satisfactory business basis. Relations between them in fact broke down as soon as trading started, and trading ceased after little more than a month. In these circumstances I consider that justice requires that so far as possible the assets of the venture are returned to their original owner, and I answer the principal question posed in these proceedings by finding that the owner of the rights in patent applications GB9007952.6 and PCT/GB91/00543 is Michael Harold Cope.

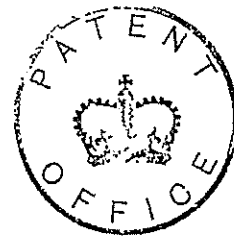
Under s13(3) I certify that Mr Graham Brooks ought not to have been mentioned as joint inventor for the GB application GB9007952. 6. I direct that any undistributed copies of the published patent application shall be amended by reprinting the front page to show Michael Harold Cope as the sole inventor.

Under s10 I direct that the register for GB application 9007952.6 be amended to name Michael Harold Cope as sole inventor and sole applicant and that future correspondence concerning the application be sent to him or his appointed agent. I further direct that the name and address of Graham Brooks be struck out from Part iii of Patents Form 1/77 and that the form be amended in Part iv to identify Michael Harold Cope as the sole inventor.

I understand the PCT application has entered the regional phase as EP0524255 and that my findings above will be sufficient to enable Mr Cope to take appropriate action for that application under Article 61 of the European Patent Convention. I was not given any information as to whether the PCT application has entered the national phase in any of the national designated states, but if it has, this decision may well be sufficient to enable Mr Cope to establish his rights in those countries. I will however consider any application by Mr Cope for specific orders for particular countries.

Mr Cope has succeeded in his claims, except for those under sections 8(1)(b) and 12(1)(b) and Mr Brooks has failed in his. In all the circumstances I consider that £1000 is an appropriate sum for me to award as a contribution to Mr Cope's costs, and I direct that Mr Brooks pay this sum to him.

Dated this 18 day of November 1993



**W J LYON**

Superintending Examiner, acting for the Comptroller

**THE PATENT OFFICE**