

BLO/045/90

PATENTS ACT 1977

IN THE MATTER OF a reference
under Section 12(1)(a) by
Travenol Laboratories Limited
in respect of European (UK)
Patent Application No 87302244.6

FINAL DECISION

On 26 April 1990 I issued an interim decision in which I concluded that Travenol Laboratories Limited, the Referror, is entitled to sole rights and is entitled to be granted a patent for the invention which is the subject of European (UK) Patent Application No 87302244.6 and that Michael John Howarth, who was named as one of the inventors, has no rights in the invention and is not entitled to be granted alone or with any other persons a patent in respect of the invention.

In arriving at my conclusion I explained that considerable difficulty had been experienced in obtaining any reply from Mr Howarth during the course of the proceedings and I considered that he should be given a further opportunity to comment. I therefore allowed both parties a period of 30 days in which to make representations.

No communication has been received either from Travenol Laboratories Limited or from Mr Howarth. Accordingly I confirm the finding which I reached in my interim decision which hereby becomes final.

Dated this

18 day of June 1990



P J HERBERT

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

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Interim Decision.

BLO/045/90

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IN THE MATTER OF a reference
under Section 12(1)(a) by
Travenol Laboratories Ltd
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Patent Application No 87302244.6

INTERIM DECISION

European Application No 87302244.6 designating the United Kingdom, was filed on 17 March 1987 in the name of Travenol Laboratories Limited and named as inventors Graham Hellen, Michael John Howarth and Harry Hayes, all having addresses in the United Kingdom. The application claimed priority from GB application 8606626 filed on 18 March 1986.

This reference by Travenol Laboratories under Section 12(1)(a) was filed on 26 April 1988 together with a statement of case. It is made clear in the statement that GB 8606626 was abandoned but, prior to publication of the invention, equivalent applications were made in a number of territories, including Norway, Denmark and Finland, although in these three territories the equivalent applications did not claim priority from the GB application.

The Laws of the three territories apparently require that there is filed in the local patent office an assignment document signed by the inventors. Two of the inventors Graham Hellen and Harry Hayes have signed appropriate documents but the third, Michael John Howarth, for reasons which have not been specified, refused to sign. In the absence of Mr Howarth's signature, the Referrers require for the validation of the application made in Norway, a decision of the Comptroller that they are entitled alone to the grant of a patent for the invention the subject of this referral.

The notification of these proceedings required under Rule 7 of the Patent Rules 1982 was sent individually to the three inventors at the addresses last known to the Referrors and shown on the front page of the European Application. In all cases no reply was received. At this stage I would observe that some of the early correspondence to Mr Howarth may possibly have been incorrectly addressed, but I am satisfied that appropriate steps were taken at a later date to notify him at the correct address of these proceedings.

A further attempt was made to elicit a reply from Mr Howarth after the period for filing the counterstatement had expired but without success.

If Mr Howarth had given some indication that he did not wish to be a party to these proceedings or if the Comptroller had been satisfied that Mr Howarth was at least aware of the proceedings, then the Office could have regarded the action as being uncontested and the facts as set out by the Referror in his statement would have been assumed to be correct.

Although the reference in the statement to Mr Howarth's refusal to sign an assignment document and the subsequent correspondence between the Office and the Referror's agent suggest that Mr Howarth may well be aware of the foreign applications and the current proceedings, it seems to me that I must consider the possibility that he is not.

If there is a possibility that Mr Howarth is entitled to any rights in the invention, then it would be wrong for the Comptroller to reach any decision which would diminish those rights without first hearing argument on his behalf. It cannot be ignored, however, that if Mr Howarth considers that he has any such entitlement, he has shown a lack of diligence in seeking to enforce it. On the other hand, if the Referror is indeed entitled to the rights in the invention (and I will return to this later), then the Referror is being prevented

from exercising his right to obtain patent protection in Norway through Mr Howarth's failure to sign the appropriate document.

It is a most unsatisfactory situation that the Comptroller should be required to come to a conclusion in the absence of evidence from all of the parties but, equally, it cannot be right that the Referror should be denied the opportunity of obtaining patent protection.

In seeking to resolve this issue, I have referred to the Rules of the Supreme Court and in particular to Order 15 Rule 6(1) which reads as follows:

"No cause or matter should be defeated by reason of the misjoinder or non-joinder of any party; and the Court may in any cause or matter determine the issues or questions in dispute so far as they affect the rights and interests of the persons who are parties to the cause or matter".

In the circumstances of this case and having regard to this Rule, I consider that the Comptroller has an inherent jurisdiction to reach a finding as sought by the Referror.

The facts of the case are set out in the Referror's statement, and indicate that the Referror is prepared to support these facts by the filing of evidence should I decide that to be necessary. However it would seem to me to be putting the Referror to further expense and inconvenience to require such evidence to be filed and, in the absence of any communication from Mr Howarth, I propose to proceed on the basis that the facts in the statement of case are true.

Paragraphs 8 to 10 of the statement are particularly relevant in determining the question of entitlement to patent protection for the invention which is the subject of this referral. These paragraphs explain that Mr Howarth was employed as a product manager with Travenol, the Referror, in

the field in which the invention was made and that the invention was made during such employment jointly with Mr Hayes and Mr Hellen. The statement goes on to say that Mr Howarth signed a secrecy agreement assigning his rights to Travenol in any invention made during his employment by Travenol, in Travenol's time or with the company's materials or facilities and claims that the invention was made within the terms of both Section 39(1)(a) and Section 39(1)(b) of the Patents Act 1977 which read as follows:-

"39 - (1) Notwithstanding anything in any rule of law, any invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purpose of this Act and all other purposes if -

(a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking."

My understanding of all this is that I am being asked to confirm the existing position concerning ownership of the invention which is that Mr Howarth does not appear to have any rights in the invention, those rights subsisting in Travenol alone. I conclude, therefore, that in reaching this decision I am not diminishing Mr Howarth's rights, which was the concern I expressed earlier, but that Mr Howarth, as a result

of his various agreements with Travenol, did not have any rights in the first place. In the event that Mr Howarth considers this conclusion to be wrong it is, of course, open to him to challenge the decision.

There has been some correspondence between the Patent Office and the Referrors as to what is the true subject matter of the referral and whether the Comptroller in the circumstances, has jurisdiction in the areas raised by the statement. It is incumbent upon me therefore to consider this issue before making a final determination on the reference under Section 12.

Although a finding is sought in connection with a patent application in Norway, a document which I have not seen, I am satisfied that the invention which is the subject of this reference is all of the matter contained in EP Application 87302244.6 entitled 'Parenteral administration apparatus'. That this must be right is borne out by the heading to the Referror's statement which reads "In the matter of Patent Applications abroad based on European (UK) Patent Application No 87302244.6" (my underlining) and in the letter from the Referror's Agent dated 14 February 1990 which states that "The subject matter of this application (that is, the Norwegian application) is the same as that of European (UK) patent application 87302244.6 which has the same disclosure".

I am also satisfied, although I do not propose to recite all of the provisions, that Chapter II of Part II (Articles 58-62) of the European Patent Convention and the Protocol thereto on jurisdiction and the recognition of decisions in respect of the right to the grant of a European Patent (Protocol on Recognition), provide that the present reference can be decided under the law of the United Kingdom.

The relevant law in the United Kingdom is, of course, Section 12 of the Act under which this reference has been made and the relevant sub-sections of which are as follows:

"12 - (1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made) -

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent;

..... and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination

"(3) Subsection (1) above, in its application to a European patent and an application for any such patent, shall have effect subject to section 82 below."

Since I have already concluded that this reference is concerned with an invention which is the subject of an application for a European Patent, Section 12(3), which I have quoted above, directs my attention to Section 82 of the Act, the relevant subsections of which are as follows:

"82(2) Section 12 above shall not confer jurisdiction on the comptroller to determine a question to which this section applies except in accordance with the following provisions of this section.

(3) This section applies to a question arising before the grant of a European patent whether a person has a right to be granted a European patent, or a share in any such patent, and in this section "employer-employee question" means any such question between an employer and

an employee, or their successors in title, arising out of an application for a European patent for an invention made by the employee.

(4) The court and the comptroller shall have jurisdiction to determine any question to which this section applies, other than an employer-employee question, if either of the following conditions is satisfied, that is to say -

- (a) the applicant has his residence or principal place of business in the United Kingdom; or
- (b) the other party claims that the patent should be granted to him and he has his residence or principal place of business in the United Kingdom and the applicant does not have his residence or principal place of business in any of the relevant contracting states;

and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom.

(5) The court and the comptroller shall have jurisdiction to determine an employer-employee question if either of the following conditions is satisfied, that is to say -

- (a) the employee is mainly employed in the United Kingdom; or
- (b) the employee is not mainly employed anywhere or his place of main employment cannot be determined, but the employer has a place of business in the United Kingdom to which the employee is attached (whether or not he is also

attached elsewhere);

and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom or, where there is such evidence of such an agreement, if the proper law of the contract of employment does not recognise the validity of the agreement."

A further complication in this case is that Mr Howarth is no longer employed by the Referror and it may be open to argument as to whether the matter to be decided is an "employer-employee question" and whether the jurisdiction conferred on the Comptroller to decide the matter by virtue of Section 82(2) derives from Section 82(4) or Section 82(5).

It seems to me that I need not resolve this argument because if it is not an employer-employee question, then the jurisdiction is to be found in Section 82(4)(a) since the Referror's principal place of business is in the United Kingdom and, if it is such a question, then the jurisdiction is to be found either in Section 82(5)(a) by virtue of the employee being mainly employed in the United Kingdom or in Section 82(5)(b) by virtue of the employer having his place of business in the United Kingdom to which the employee is attached. In neither case is there written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom.

For the reasons I have given earlier, I have felt it necessary in the circumstances of this case to set out at some length my reasons for concluding that the Comptroller does indeed have the necessary jurisdiction.

Having satisfied myself on the question of jurisdiction, I find, as I have indicated previously, that the Referror,

Travenol Laboratories Limited, is entitled to sole rights in the invention and is entitled to be granted a patent for the invention which is the subject of European (UK) Patent Application No 87302244.6, and that Michael John Howarth has no rights in that invention and is not entitled to be granted alone or with any other persons a patent in respect of that invention.

In making this finding I am aware that I have not gone as far as the Referror would have liked according to his agent's letter of 13 July 1989 in that I have not reached any conclusion with regard to the Referror's entitlement to patent protection in respect of the invention in Norway. The reason for this is quite straightforward. In these proceedings the Comptroller has not had before him any of the documentation concerning the invention which is the subject of the application in Norway.

If the application in Norway is indeed concerned with the same invention as EP(UK) Application No 87302244.6 as stated by the Referror and to which I have found that he is entitled, then it seems to me that it is for the Referror to satisfy the Norwegian authorities on this point.

I am conscious of the fact that the Comptroller is required under Section 101 of the Act to offer any party an opportunity of being heard before deciding any issue adversely to that party. No communication has been received from Mr Howarth in connection with these proceedings and it may well be that no communication will be received; nevertheless I consider that he should be given a further opportunity to do so.

I therefore order that this decision should be communicated both to the Referror, Travenol Laboratories Limited, and to Michael John Howarth at the address given in connection with EP(UK) Application No 87302244.6 and that, in the absence of representation from either party within 30 days of the date of this decision, it will then become final.

Although the Referror asked for an award of costs in his statement, I decline to make any order in this respect.

Dated this 26 day of APRIL 1990



P J HERBERT
Superintending Examiner, acting for the Comptroller

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