

THE PATENTS ACT 1977

IN THE MATTER OF a reference under  
Section 8(1) by Salex Acoustic  
Materials Limited in respect of  
Patent Application No 9109498  
(Serial No 2257941) in the name of  
Acoustech Limited.

0/95/94

**DECISION**

Patent Application No 9109498 was filed on 2 May 1991 by Acoustech Limited ("Acoustech"), naming Martin Jonathan Ford as inventor, and was published as 2257941 on 27 January 1993. It relates to acoustic attenuating material consisting of two layers, one of a dense thermoplastic material and the other having threads showing on at least one face, the layers being pressed together and heated so that they bond together.

On 27 August 1993 Salex Acoustic Materials Ltd ("Salex") referred to the Comptroller under section 8(1)(a) the question of whether they owned the rights in the application in suit. Although the patent application subsequently lapsed because no request for substantive examination was filed within the prescribed period, this does not terminate the reference in suit.

The reference was accompanied by a statement, copies of which were sent to Acoustech in accordance with rule 7(2). At the same time, Salex were asked in accordance with rule 112 to provide a number of documents referred to in the statement. Copies of the documents were subsequently supplied and were sent to Acoustech, and they were given two months for the filing of a counter-statement under rule 7(3). No response was filed by Acoustech within that period and a further official letter was sent stating that unless the Patent Office heard from Acoustech within 14 days, it would treat the reference under section 8(1) as unopposed. Nothing was heard from Acoustech and a further official letter was then sent confirming to

both sides that the Office was treating the reference as unopposed and that the potential opponents, Acoustech, had forfeited their right to take any further part in the proceedings.

Subsequently a letter was received from Baker Tilly, a firm of chartered accountants, stating that they had been appointed joint liquidator to Acoustech and enquiring about the status of the patent application in suit. The Office replied, summarising the position, and Baker Tilly responded stating that they did not propose to take the matter any further and that "there will be no more returns filed in respect of this patent application". The matter then came before me for a determination of the reference under section 8(1).

In their statement, Salex state that they are a subsidiary of Salex Group Limited and are involved in manufacturing and selling, *inter alia*, acoustic lagging materials. They are a sister company of Sound Attenuators Limited which is the registered proprietor of an earlier British Patent No 2146298 (*sic* - actually 2146289). The statement goes on to say that the named inventor of this earlier patent was Alan John Franks, who was the Joint Managing Director of Salex, and that both Salex and Sound Attenuators Limited have made extensive sales of acoustic attenuating material made in accordance with this earlier patent under the trade name "Mufti-lag". It is then stated:

"In or about December 1990/January 1991, the said Alan John Franks invented an improvement over the existing "Multi-lag" (*sic*) material."

The statement goes on later to state:

"Further in or about January 1991 the said Alan John Franks instructed one Paul Absolon an employee of Salex to carry out tests on a heated platten press to determine whether Mr Frank's concept was practically feasible and to determine the optimum conditions for production ... . The tests were successful. A decision was made to make a patent application for the new process.

On or about 17 January the said Paul Absolon handed in a written description of the process to the suggestions scheme run by the parent company, Salex Group Limited,

in which he claimed the idea as his own. He was reprimanded for this. Shortly after this, due to re-organisation Mr Absolon was made redundant. Prior to his leaving Salex he was instructed by Mr Franks to draft a description of the new material and the method of making it suitable for submission to Salex's patent agents to enable them to draught a patent application."

The statement then states that Mr Absolon's employment ended on or about 28 February 1991 and goes on:

"On precise dates unknown to Salex but between about February 1991 and May 1991, Mr Absolon disclosed to Mr Ford of Acoustech all the information he possessed concerning the work done at Salex in respect of the new material being developed there. Acoustech applied for a patent on or about 2 May 1991 under application no. 91049498.7 (*sic*) which is the application in suit. Mr Ford is named as the inventor thereof."

Having recited claim 1 of the patent application in suit, the statement continues:

"The said invention of claim 1 was made by the said Mr Franks in that it was his invention to use a dense thermoplastic layer, in particular a polychlorinated polyethylene material as an acoustic barrier material together with a layer comprising non-woven glass fibres quilted together, the layer having threads showing on at least one face thereof, placing the two layers in a hot platten press to bond the layers together by means of the softening of the thermoplastic layer with the result that it interpenetrates the fibres or threads of the second layer.

Claims 2 to 8 and 10 to 14 are dependent on claim 1. The inventions, the subject of the said claims were made by Mr Franks as aforesaid. In particular, it was Mr Franks who invented the use of a polychlorinated polyethylene material as the acoustic barrier layer and which may optionally contain a high density filler material such as barium sulphate.

Claims 9 and 15 claim respectively a method of manufacturing an acoustic attenuating material and the material per se substantially as described with reference to the drawings the said inventions were made by Mr Franks. Paragraph 13 hereof [which recites claim 1 of the patent application in suit] is repeated. Insofar as claims 10 to 14 are dependent on claim 9, the said inventions the subject of the said claims were made by Mr Franks."

In the light of the statement, the Office wrote to the referrers indicating that the papers had been referred to a hearing officer and that in accordance with rule 7(7) the hearing officer required clarification of two points in order to assist him in determining the matter. First, although the statement stated that Mr Franks was the "Joint Managing Director" of Salex, it was silent as to the basis on which Salex claimed to be entitled to the invention, *eg* by virtue of Mr Franks' employment or otherwise, and the basis on which entitlement was claimed would therefore need to be made clear. Second, the statement did not clearly indicate or establish the extent to which Mr Franks was or was not the inventor of all the matter disclosed, and all the inventions claimed, in the application in suit and that accordingly, there was doubt over the scope of the order being sought which would need to be resolved.

Subsequently, in a letter received on 11 May 1994, Salex replied enclosing a statutory declaration by Mr Franks. Although it had already been decided that the reference was to be treated as unopposed, copies of Mr Franks' declaration were sent to Acoustech in Liquidation, % Baker Tilly, and to the named inventor in the application in suit, Mr Ford, giving them a further opportunity to intervene. No reply was received from either and further official letters were then sent to Acoustech and to Mr Ford indicating that the reference was to be treated as unopposed and that they had forfeited their right to take any part in the proceedings.

In his declaration, Mr Franks confirms the allegations of the statement, and states that he was employed by Salex as its Managing Director from 1 March 1986 and that his function under the terms of his employment included invention of improved acoustic materials for his employer. Mr Franks also states:

"Because I was Managing Director of Salex I had a special responsibility to develop new products for the company. All inventions made by me relating to the Company's products clearly belonged to my employer."

After analysing the specification of the application in suit in detail, Mr Franks also states:

"In summary, the whole of the patent application, including the Claims therein, represents a description of the manufacturing process and method of manufacture which I invented in January 1991 except that the final paragraph of description, lines 25 to 30 of page 4 of the application, describe a material as a further example which utilises PVC coated glass scrim. I do not believe that utilising the method in connection with such a material would be practical since the PVC in the cloth would melt."

In this connection, although the final reference to coated glass scrim is not as clear as it might be, and the reference to lines 25 to 30 does not appear to be correct given that the reference to PVC coated glass scrim is in lines 31 and 32, I take it that what Mr Franks is saying is that he is the inventor of all the matter disclosed in the patent application in suit with the sole exception of the use of PVC coated glass scrim as the fire/gas resistant layer, as described in the last sentence on page 4 of the application.

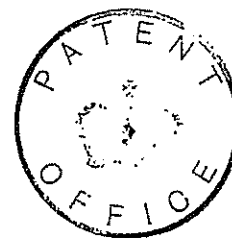
On that basis, and in the absence of any opposition to the reference, I am satisfied, and find, that Alan John Franks was the inventor of all the matter disclosed in the patent application in suit other than that disclosed in the last sentence on page 4 of the application, and that, by virtue of Mr Franks' employment as Managing Director of Salex, Salex alone is entitled to the grant of a patent for Mr Franks' invention.

Since however the patent application in suit has irretrievably lapsed, the only remedy available, and the order I hereby make under section 8(3)(c) and in accordance with rule 10, is that Salex Acoustic Materials Limited may, within three months from the day on which the time for appealing from this decision expires without an appeal being brought or, if an appeal is brought, from the day on which it is finally disposed of, make a new application

for a patent for the whole of the matter disclosed in Patent Application No 9109498 other than that set out in the last sentence on page 4 of the application, and that any application so made shall be treated as having been filed on the date on which Application No 9109498 was filed, namely 2 May 1991.

Any appeal against this decision must be lodged within 6 weeks from the date of the decision.

Signed this 1 day of September 1994



**Dr P FERDINANDO**

Superintending Examiner, acting for the Comptroller.

**THE PATENT OFFICE**