

0/34/91

PATENTS ACT 1977

IN THE MATTER OF

Patent Application No 8625132.9
(Serial No 2195131) in the name of
Cange Controls Ltd and Raymond E'Tere

DECISION

This is a request for directions under section 10, which provides:

"10. If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the comptroller may, on a request made by any of the parties, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require."

In this case, Cange Controls Ltd seek directions that:

- i. Mr E'Tere should assign his interest in the application to them, so that the application can proceed to grant on the basis of amendments agreed between them and the examiner.
- ii. Cange Controls should grant to Mr E'Tere a free non-assignable, non-revocable licence under the resulting patent.

The application was made on 20 October 1986 by Peter Westwood and Raymond E'Tere, naming themselves as inventors. The applicants claimed priority from their application no 8601678, dated 23 January 1986, which also named them as inventors. There is no dispute about the inventorship of the invention (which is entitled "Plastic roof tile with interlocking batten").

Mr Westwood's interest in the application was assigned to Cange Controls Ltd by an assignment dated 4 December 1986, registered at the Patent Office in February 1987. The application was published, and proceeded to substantive examination, with Withers & Rogers acting as agents for the applicants Cange Controls Ltd and Mr E'Tere.

In March 1988, Withers & Rogers advised the Office that Mr E'Tere had withdrawn their authority to act on his behalf, so a copy of the first substantive examination report was sent to Cange Controls Ltd (c/o Withers & Rogers) and to Mr E'Tere at his registered address in Bournemouth. The report resulted in individual, and different, applications by the two applicants to amend the application, Mr E'Tere's being filed on 28 October 1988 and Cange Controls Ltd's on 31 October.

I can pass over attempts that were made to resolve the inconsistencies in the two requests to amend by saying that they were unsuccessful. Cange Controls Ltd offered to adopt Mr E'Tere's request to amend, but the examiner has reported that those amendments would not have been acceptable. In the meantime, it became impossible to contact Mr E'Tere and on 17 May 1990, the request under section 10 was filed. I should record also that the time

set by Rule 34 of the Patents Rules for putting the application in order was extended by twelve months by a decision of a Principal Examiner acting for the Comptroller.

The statement of case filed on behalf of Cange Controls Ltd in these proceedings sets out the history of the application, the inability of the two applicants to agree on the prosecution of the application, and finally the inability of Cange Controls Ltd and Withers & Rogers to contact Mr E'Tere. The Patent Office has written to Mr E'Tere in these proceedings at his registered address in Bournemouth, and at addresses that he was thought to be at in Bradford and Alfreton.

In consequence, the formal position is that no counterstatement has been filed on Mr E'Tere's behalf, there appears to be no prospect of contacting him in the foreseeable future, and it is necessary to give directions that will enable the application to be examined and if appropriate, for a patent to be granted.

Section 10 allows me to give directions

"for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes"

It seems to me that the minimum relief that I could give in this case is to allow any amendments proposed by the only applicant in communication with the Office to be considered. If acceptable amendments can be formulated, that would allow a patent to be granted to the two applicants jointly. That would potentially limit the exploitation of the invention, because in practice, if the two patentees are not in communication with one another, licences cannot be granted under the patent.

I am therefore satisfied that it would be right to allow Cange Controls Ltd to become the sole applicant. They propose in their statement of case that this should be done by directing Mr E'Tere to assign his interest in the application to them. I do not believe that it is necessary or desirable to do that. If the application proceeds in the sole name of Cange Controls Ltd, and a patent is granted to them, they would then have the rights of the legal proprietor of the patent. Mr E'Tere, or his successors in title, might well have rights in equity or for example under section 37 by virtue of his position as joint inventor, and I see no need to extinguish them.

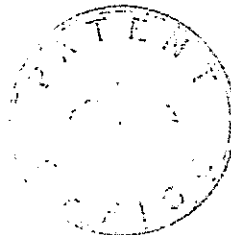
I understand that the relief sought by Cange Controls Ltd is based on that granted by the Comptroller in Pelling & Campbell's Application (unreported, 1987 and 1988). However in that case a hearing was held at which both co-applicants appeared; a direction was given that they should execute an agreement on certain principles; and the Comptroller subsequently imposed terms in relation to particular clauses where the co-applicants had been unable to agree. In the present case, where Mr E'Tere cannot be contacted, but is acknowledged to be an inventor, it seems to me to be unnecessary than to do more than give directions that will enable the application to be examined and (if a patent is granted) for the patentee to be able to exploit the invention.

Accordingly, the only direction I need give is that the application should proceed in the name of Cange Controls Ltd. The request for a direction that Cange Controls Ltd should grant a

licence to Mr E'Tere might be appropriate if (as in Pelling & Campbell) the co-applicants were to be the parties to an agreement. There is no reason to suppose that Mr E'Tere wants a licence for his own use, so I think it would be more appropriate to regard this particular request as an undertaking to the Comptroller by Cange Controls Ltd to grant a free licence to Mr E'Tere if he should ask for one. Such a licence need not be assignable, and need not include any right to grant a sub-licence; nor is there to be implied any undertaking by Cange Controls Ltd to maintain the patent in force.

Dated this 6 day of March 1991

W J Lyon
Superintending Examiner, acting for the Comptroller



PATENT OFFICE