

PATENTS ACT 1977

BLO/014/88

IN THE MATTER OF a reference  
under Section 12(1)(a) by  
Brian Hugh Turner in respect of  
European Patent Application 85305434.4

DECISION

European Patent Application 85305434.4 is an application in the name of Clifford Sidney Bundy. It specifies as inventors the said Mr Bundy and also Brian Hugh Turner. The application was filed on 30 July 1985, and based on an earlier GB application; it was published on 19 February 1986.

This reference under Section 12(1)(a) was filed on 20 August 1987 and accompanied by a Statement of Case. Mr Bundy was given, by Rule 7(3) of the Patents Rules 1982, the customary three months, later extended by one month, to file a counterstatement.

The extended period expired on 19 February 1988 without reply, and an invitation to submit observations as to why the Comptroller should not treat the referral as undefended, expired also without reply on 30 March 1988. The referral must therefore be regarded as undefended, that is, the facts as stated by the referor must be assumed to be correct. It therefore falls to me to determine the matter on that basis.

The relevant Sections of the Patents Act 1977 read 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; or

(b) .....

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.

(2) .....

(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."

"82.-(1) .....

(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."

The relevant, comparable, Articles (60 and 61) of the European

Patent Convention read as follows:

"Article 60

Right to a European patent

(1) The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee the right to the European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has his place of business to which the employee is attached."

"Article 61

European patent applications by persons not having the right to a European patent

(1) If by a final decision it is adjudged that a person referred to in Article 60, paragraph 1, other than the applicant, is entitled to the grant of a European patent, that person may, within a period of three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition annexed to this Convention:

- (a) prosecute the application as his own application in place of the applicant,
- (b) file a new European patent application in respect of the same invention, or
- (c) request that the application be refused."

The facts in this case, as outlined in the reference and the

statement, which I accept, are these:

Mr Turner's full name is Brian Hugh Turner, and he lives at Firs House, Berrow Green, Martley, Worcester WR6 6PL, England. The European Patent Application, which relates to building panels, currently stands in the name of Clifford Sidney Bundy, with Mr Bundy and Mr Turner named as co-inventors. Mr Turner worked with Mr Bundy in the development of building panels from about January 1984 to November 1986. In July 1984 Mr Turner became an employee, later co-Director of Cantonbury Limited, a Company of which Mr Bundy was a director. The Company ceased to trade in November 1986. Mr Bundy acknowledged the joint responsibility of Mr Turner for devising the panels by instructing his patent agents to name Mr Turner as co-inventor in the original British Patent from which the European Application claims priority. Mr Turner was also named as co-inventor in the European Patent Application. Further, in a letter dated 20 November 1986, Mr Bundy acknowledged that Mr Turner, as co-inventor, was entitled to half the benefit of the patent. Notwithstanding the reference on the Designation of Inventor form to Mr Bundy having acquired the right as applicant by virtue of an agreement, Mr Turner did not agree to Mr Bundy being sole applicant and having sole right to the grant of a European patent.

On the basis of these facts, Mr Turner seeks an order directing that he be entered as co-applicant with Mr Bundy in respect of European Patent Application No 85305434.4.

Now the statement of case does not make clear if the question at issue is an employer-employee question. Given the varying relationship between the referor, Mr Turner, and Cantonbury Limited as outlined above it is not clear whether the question of jurisdiction is to be determined by Section 82 subsection (4) or (5). However, since on the one hand Mr Turner resides in

Worcester, and on the other hand Cantonbury Limited had its place of business in London, I am satisfied that the Comptroller has jurisdiction either under Section 82(4)(a) or alternatively under Section 82(5)(b). I am also satisfied that the Comptroller has jurisdiction under Article 60 EPC, and is the appropriate authority under Article 1 of the Protocol on Recognition to the European Patent Convention, and that the United Kingdom has notified the European Patent Office as required by Article 1, paragraph 2 of the Protocol.

As I have indicated, I have accepted the stated facts as correct. In particular I accept that Mr Turner is indeed co-inventor of the panel, and did not agree to Mr Bundy being sole applicant for the European Patent. Since Article 60 of the Convention states that "the right to a European patent shall belong to the inventor", I decide that Brian Hugh Turner is entitled to be entered as co-applicant in respect of European Patent Application No 85305434.4.

Dated this 14<sup>th</sup> day of June 1988.

W J LYON

Superintending Examiner, acting for the Comptroller.

