

BLO/1135/89

PATENTS ACT 1977

IN THE MATTER OF a reference to the Comptroller under Sections 8, 12 and 37 in respect of patent application PCT/GB 85/00581 in the name of the Secretary of State for Defence

DECISION

Somewhat unusually the reference has been made by the applicant, who in this case is the Secretary of State for Defence. The reference appears to have arisen out of a perceived need in the Ministry of Defence (Procurement Executive) to clarify the position with regard to inventions made by their employee research workers. It is therefore something of a test case for them. By opposing the direction sought under the reference, Mr D S Robertson, Mr P S Born, and Mr I M Young, who are the inventors named in the application and who are employees of the MoD(PE), have become a party to these proceedings.

At the hearing before me on 22 September 1989 the referor was represented by Mr J B Edwards, a patent officer employed by the MoD(PE), and the inventors were represented by Mr I M Young.

Under the reference the referor seeks a direction from the Comptroller that

- (i) The invention described in the application belongs to the Secretary of State for Defence under Section 39.
- (ii) The invention was made in the course of the normal duties of the inventors
- (iii) The invention was made in the course of the duties of the inventors and, at the time of making the invention, because of the nature of their duties and the particular responsibilities

arising from the nature of their duties they had a special obligation to further the interests of the Secretary of State for Defence.

In opposing the making of any such direction, the inventors ask the Comptroller to decide

- (a) Whether they are entitled to any rights of ownership or part ownership;
- (b) Whether they have any rights to financial compensation for their efforts;
- (c) Whether it was their skill, imagination and knowledge beyond the sphere of their normal duties which led to the invention.

The questions asked by the inventors under (a) and (c) above may be subsumed under my determination of the reference made by their employer, but the question posed under (b) seems to me to be quite inappropriate to these proceedings and I decline to deal with it.

It is agreed between the inventors that they should be regarded as having contributed equally to the making of the invention and should be treated as equals in respect of any rights in the invention or patent application to which they may be entitled.

Before proceeding to the substantive issues, I should say a word or two about the manner in which pleadings and evidence have been presented in this case. The office apparently took the view that there was no dispute between the parties on the relevant primary facts, only on the inferences to be drawn from those facts, and adopted a rather informal approach by allowing, with the agreement of both parties, some of the material produced as evidence to be in unsworn form. Perhaps because of this informal approach the evidence and pleadings on both sides became somewhat intermingled, a result which has not been entirely helpful to me in considering the case,

though I am sure that everyone concerned acted with the best of intentions.

The specification of the application opens by saying that the invention relates to luminescent ceramic plates capable of luminescing when irradiated by electrons, X-rays, ultra-violet rays or gamma rays. Such plates are said to be useful as cathode ray tube (CRT) faceplates, thermoluminescent plates, or scintillators. The specification discusses prior art types of CRT faceplate and their disadvantages when used with a high energy electron beam to produce a high intensity output. Further prior art discussion is concerned with the use of thermoluminescent (T/L) plates as an alternative to X-ray film, a latent image produced by exposure to X-rays being converted to visible light by heating the plate and the emitted light, which is of low intensity, being detected by means such as a photomultiplier. Another known use of luminescent plates referred to is as a sheet of scintillator material for X-ray film to enhance the image.

The invention described as having application to all these areas comprises a luminescent ceramic plate consisting of a finely powdered luminescent material bonded into water glass and formed into a ceramic. The main claim is directed to such a luminescent plate and there are subsidiary claims to such a plate formed as a CRT faceplate, a T/L plate, an X-ray scintillator, and a method of making the plate. The specification also describes various ways in which a T/L plate according to the invention may be scanned to retrieve a latent X-ray image, eg to produce a video recording.

It is clear to me that, at the time the application was filed, the principal area of invention was regarded as being the use of water glass as the binder in a luminescent ceramic plate. As it happens, I do not think it is necessary for me to try to identify any other inventions disclosed in the application and I need say no more than that the particular concern of the inventors as I understand it lies in the use of the main

invention in T/L imaging and detection of radiation by scintillation.

It is not in dispute that each and every new invention which may be disclosed in the application was devised by the inventors named. It is also not disputed that all three inventors are experienced research workers who have been employed at the RSR Establishment of the MoD(PE) since well before the events leading to the filing of patent application No 8431838 on 17 December 1984 took place. Application No 8431838 is the priority document on which the application in suit was based. Although the latter application contains matter which is additional to that contained in the earlier application, no particular significance is placed by the inventors on that additional matter. As Mr Young put it, such additional matter provides some extra flesh on the earlier application. Both parties agree, and I accept, that, as regards the making of any invention disclosed in the application in suit, the relevant period to be considered is from September 1983 to December 1984.

Whether any invention made by the inventors during that period belongs to the inventors or to their employer falls to be determined under the provisions of section 39 which reads:-

(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes 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.

- (2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

It is therefore necessary for me to determine what were the duties of the inventors over the relevant period.

Neither side has produced documentary evidence in the form of pre-arranged lists of duties or programmes of research for the period in question, but the referor has produced relevant job descriptions for the three inventors, these being extracts from annual confidential reports written on the inventors by senior officers, the job descriptions having been written by the inventors themselves and detailing the nature of the work done by them during the year covered by the report.

From February 1983 to January 1984 Mr Robertson who was the leader of the section in which Mr Born worked, described his work in general terms as the identification, preparation development and exploitation of new electronic materials and under that heading had made new materials available inter alia for CRT's and X-ray imaging applications (potential market value £35m). During the following year 1984-1985 Mr Robertson spent substantial amounts of his time on the development of advanced light emitting ceramic CRT faceplates and the development of a new X-ray imaging system. From April 1983 to March 1984 Mr Born was involved with new work concerned with

thermoluminescence and with X-ray scintillator crystals. In the year 1984-85 the bulk of Mr Born's time was spent on T/L imaging plates and alternative CRT faceplates (high intensity). Mr Young was in a different section to Messrs Robertson and Born but various sections, including Mr Robertson's, were able to call upon Mr Young's expertise in his particular field. From September 1983 to August 1984 part of Mr Young's work was on X-ray scintillator materials.

I regard this evidence as clearly establishing that over the relevant period the three inventors were using their employer's time and facilities for work on topics closely related to those covered in the patent application, and I am unable to accept that this could have been done to the extent it clearly was and in the full knowledge of line management without there having been at least implicit official approval for the work. In fact Mr Young admitted that line management not only knew of the work the inventors were doing on those topics but approved it. I must therefore conclude that all the work done by the inventors during the relevant period was in the performance of their duties.

I now have to decide whether or not those duties were the normal duties of the inventors.

Mr Edwards, for the referor, argued that science grade research staff at the RSRE, a category into which the inventors in this case fall, were given a fairly free hand in deciding what research work they would carry out, and that, besides working in established areas of research, they were expected, as part of their normal duties, to produce proposals for new lines of research. Mr Young, for the inventors, agreed they had a fairly free hand within an approved programme of research. He also accepted that they had a brief as part of their official duties to do research into potentially new areas to be adopted. However, he then sought to establish that there is a distinction to be drawn between "official" duties and "notmal" duties. According to Mr Young,

"normal" duties could only be defined succinctly as "work done as related to a programme approved by our employer which receives support - financial and manpower - as required by our employer", whereas "official" duties were to be defined as "something which one did during work time and what one was paid for". It was Mr Young's contention that activities forming part of their "official" duties might not be part of their "normal" duties. In particular he argued that the preliminary work done by the inventors on luminescent ceramics for at least some of the uses disclosed in the application was not and never became part of an approved programme of work.

For my part I can see no distinction between the "official" duties and the "normal" duties of the inventors in this case. It has been made quite clear to me that the inventors worked on thermoluminescent ceramics during the relevant period and that the work they did was done with the knowledge and approval of their superintendent. The fact that the work was only in the nature of preliminary tests to indicate the potential value as a subject for allocation to an approved research programme which never came to fruition is, to my mind, of no significance whatsoever. I would go further and say that Mr Young's definition of "official" duties is not a bad definition of "normal" duties as I understand the expression to be used in section 39(1)(a).

The inventors have also asked the Comptroller to decide whether it was their skill, imagination and knowledge beyond the sphere of their normal duties which led to the invention. All I can say in answer to that is that the evidence really does not address the point, there being nothing in it which would enable me to make a comparison between the level of those attributes actually applied and the level required in the course of performing normal duties.

As a result I conclude that any invention contained in the patent application was conceived by the inventors in the course of performing their normal duties. Moreover, it is my

view that by the very nature of the sort of research work undertaken by the inventors in the performance of those duties, an invention might reasonably be expected to result from that work.

At the hearing it was argued by Mr Edwards, apparently in support of his general submission that the invention belongs to the Secretary of State for Defence by virtue of section 39(1), that because the inventors were assigned to particular sections their duties had been specifically assigned to them. That may well be so in common parlance, but as I read section 39(1)(a), where it refers to "duties outside his normal duties, but specifically assigned to him", the phrase "specifically assigned" must refer to duties which are not the standard or everyday duties on which the employee is normally employed in his particular post. Hence, in my opinion, by assigning an employee to a particular post, the standard or everyday duties of that post become his normal duties. If that were not so there would be no such thing as "normal duties" and it would make a nonsense of the wording of section 39(1)(a).

I accept Mr Edwards' submission that all Secretaries of State represent one and the same legal entity and that the MoD(PE) has a wider interest than military or defence needs, as exemplified by work undertaken by RSRE for the Department of Trade and Industry, which in part funds RSRE, and the much publicised work done by RSRE on liquid crystals. Also, as part of Mr Robertson's job as section leader was the exploitation of new electronic materials, which I take to include the identification of potential uses for such materials, it seems to me that the employer in this case can not be said to have had no interest in having proposals for uses of thermoluminescent ceramics brought to his attention. I consequently reject the inventors' argument that it could not have been part of their normal duties to carry out the preliminary tests on those materials merely because their employer did not approve an ongoing programme of research in

relation to those materials and their possible uses.

Turning now to the determination of the third question put by the referor, it seems to me that there must be a distinction between the meanings to be given to paragraphs (a) and (b) of section 39(1). The nub of that distinction as I see it lies in the words "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."

Having gathered as much guidance as I can from the judgement of Falconer J in Harris's Patent RPC 1985 p 19 to which I was referred, I have come to the conclusion that the status of the inventors was such that the obligation to their employer which they held was no more than that which has been effectively admitted by them, namely to do their best to produce inventions relevant to the interests of their employer, and in my view that does not constitute "a special obligation to further the interests of their employer's undertaking" as used in paragraph (b) of section 39(1).

It follows from my findings above that by virtue of section 39(1)(a) any invention disclosed in the patent application in suit belongs solely to the referor and since he made that application for a patent there is no need for me to make any order or direction under any of sections 8, 12 and 37.

Neither party has asked for costs and so I make no award.

Dated this 6th day of November 1989

K E PANCHEN

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE
KEPAAT

