

BLO / 036/95

PATENTS ACT 1977

IN THE MATTER OF references under
Sections 8 and 12 by Trevor Davis
in respect of International
Patent Application No PCT/GB92/01959
in the name of Ecoprogress Ltd

DECISION

This patent application, made under the provisions of the Patent Co-operation Treaty on 26 October 1992, claims priority from British Patent Application No 9124527.4 dated 19 November 1991, and designates 30 individual countries in which the applicants seek patent protection. It also designates two regional patent granting authorities, namely the European Patent Office and the African Intellectual Property Organisation. The international application was published on 27 May 1993, and is now believed to be under consideration as separate national and regional patent applications by the relevant authorities. For example, the application is under consideration in the United Kingdom where it was re-published under Serial No 2275873 on 14 September 1994.

These references under sections 8 and 12 of the Patents Act 1977 were made by Mr Davis on 27 April 1994. Mr Davis's principal claim is that he is entitled to a 5% share in the ownership of the rights in the application by virtue of an agreement with the proprietor dated 27 August 1993. The proprietor filed a counterstatement on 9 September 1994 denying the existence of the agreement.

Mr Davis has also commenced proceedings in the High Court by writ dated 29 April 1994, accompanied by a statement of claim pleading the same facts as in the section 8 and 12 proceedings. The proprietor (the first defendant in the action) served a defence on 13 June 1994 denying Mr Davis's claim.

The proprietor's counterstatement in these proceedings also includes a request that the comptroller should either stay the proceedings or decline to deal with the matter because the

issues are the same as those in the action. In reply, Mr Davis submits that the Comptroller can decide the issues more quickly and more cheaply than the High Court, and that he commenced the High Court proceedings only as a precautionary measure.

The parties were informed in an official letter dated 8 December 1994 that the comptroller's provisional view was that this was a case where he should decline jurisdiction because

".. it would appear wasteful for the two actions to proceed in parallel, and since the claim in the High Court action includes a claim (for damages) which the Comptroller cannot deal with, it would be most convenient for the Court to deal with the entire dispute."

The letter invited further submissions and said that a hearing would be appointed at the request of either party. Neither party has asked for a hearing on the preliminary point but Mr Davis has repeated his preference for the comptroller to deal with the matter.

The relief that Mr Davis seeks in the action consists of:

- a. A declaration of his interest in the application, and his right to an assignment.
- b. An order for specific performance of the assignment.
- c. An injunction against licensing or otherwise dealing in the patent rights.
- d. An injunction against infringing the patent rights.
- e. Damages for breach of contract.
- f. Damages for interference in contractual relations.
- g. £15,000 plus interest.
- h. Interest, costs and other relief.

It will be seen that items (a) and (b) correspond to Mr Davis's claim in the proceedings before the comptroller, and items (c) to (g) are matters outside the comptroller's jurisdiction. Mr Davis's request for the comptroller not to decline jurisdiction is enlarged upon in letters from his agents dated 14 October 1994 and 9 January 1995, and in a letter dated 6 January 1995 received directly from Mr Davis. In the October letter, the reasons are stated to be that the action is unlikely to be set down for hearing before March 1995, and that any licences granted by the proprietor will be of doubtful validity. The January letters refer to the

comptroller's obligation to maintain the register of patents up to date, and the presumption that the legislature did intend him to determine disputes about the ownership of patent rights. I accept both these points from the January letters, though of course sections 8 and 12 do expressly provide for jurisdiction to be declined in appropriate cases. In addition, the point is made that it is not clear when the action will be heard, that Mr Davis is not actively pursuing the action, and that he would be happy to deal with the ownership dispute before the comptroller, and the claim to damages (by implication later) in the High Court, where he would hope to get a summary judgment in his favour.

The timetable in the proceedings before the comptroller is laid down in Rule 7 of the Patents Rules. The next stage would be for Mr Davis to file evidence in support of his case. Thereafter the rules allow the proprietor two months in which to file evidence in answer and Mr Davis would then have a further two months to file evidence in reply. Although the initial two month period runs from 9 September 1994 when the counterstatement was filed, Mr Davis has not submitted his evidence in chief, nor has he suggested a date when it would be filed. I do not criticise him for this - where a procedural dispute arises it is normal for the parties and the Office to assume that the timetable laid down by the rules is suspended - but it suggests to me that if the matter remains before the comptroller a hearing will probably not be held before September, and a decision will not be issued before October. I do not consider that urgency is a factor in favour of retaining jurisdiction.

In conclusion, as provided for under sections 8(7) and 12(2), I decline to deal with these references. In the circumstances I make no order for costs.

Dated this 20 day of February 1995

W J LYON

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

