PATENTS ACT 1977

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IN THE MATTER OF a reference under Section 8(1)
by Malcolm Withnall
in respect of patent application no GB 2242556 A
in the name of Shop-A-Long Bingo (Midlands) Limited

FINAL DECISION

In an interim decision dated 9 September 1993, following a hearing on 9 July 1993, I found that Mr Withnall had established his claim to be an inventor of the invention which is the subject of the application in suit. Mr Withnall had neither attended nor been represented at the hearing, and I decided in my interim decision to invite further submissions on three matters. In the event, submissions on behalf of Mr Withnall have been made by his patent agents Craske & Co, in their letter dated 1 December 1993. Lawrence Shaw, as patent agent for Shop-A-Long Bingo (Midlands) Limited has confirmed by letter dated 24 November 1993 that they will not be making submissions. I shall deal now with the three matters taking due account of the submissions that have been received.

The first matter was whether Mr Withnall wished to contend that he was the sole inventor. This arose because the printed patent specification contained drawings that should not have been included, and Mr Withnall, who, as I have said, was not at the hearing, might have been misled by that. In their submissions Mr Witnall's agents have said that he is content to be named as a joint inventor. In the absence of any other submissions on the point, I find that the invention was made jointly by Malcolm Withnall and the originally named inventor Wyatt James Stanley.

The second matter was referred to in my interim decision in the following terms:

> "The second concerns the form of order I should make in relation to the ownership of the GB application. If I should find that the referrer and opponent both have a right in the GB application, I can envisage that an order made under section 8(2)(a) of the form sought by the referrer that the GB application should proceed jointly in

the names of the referrer and the opponent might in practice prove unsatisfactory to both parties. When I raised this point at the hearing Mr Shaw indicated that there is no relationship between the parties and that such an order would probably be uncomfortable to both. He speculated that if I found a joint entitlement to exist, one party might try to buy the other out."

Rights in patent applications are created by section 7(2) of the Patents Act 1977, which provides:

"A patent for an invention may be granted -

(a) primarily to the inventor or joint inventors;

(b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of making the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;

(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned;

and to no other person".

The true owners of these patent rights will therefore be Mr Withnall and Mr Stanley jointly unless subsection (b) or subsection (c) applies. The application was however made by Shop-A-Long Bingo (Midlands) Limited, who name Mr Stanley as sole inventor and claim on the Statement of Inventorship filed with the application to be entitled to apply "by virtue of our employment of the said inventor". (In fact it is Mr Stanley's name that is given as the applicant's name on the Statement of Inventorship, but I regard that as an obvious error, and take it to be a claim by Shop-A-Long Bingo (Midlands) Limited to Mr Stanley's invention.) This claim to Mr Stanley's rights in the invention is not in dispute in these proceedings, but it does not follow that it would be right simply to add Mr Withnall as a proprietor jointly with Shop-A-Long Bingo (Midlands) Limited. If Mr Withnall had been recognised as an inventor at the outset, the application would have had to be made jointly by Mr Withnall and

Mr Stanley, unless both of them consented to an assignment to Shop-A-Long Bingo (Midlands) Limited. Mr Stanley's interest in the invention is governed by section 39(1), which provides that in the circumstances mentioned

> "... an invention made by an employer shall, as between him and his employer, be taken to belong to the employer.....".

Section 39 has no impact on Mr Withnall's rights, which it seems to me are to have the patent granted to himself and Mr Stanley jointly, unless he agrees otherwise.

Mr Withnall's agents have confirmed that he is content for an order to be made that the application in suit should proceed in joint names, though they do not say whether it should be jointly with Mr Stanley, or jointly with Shop-A-Long Bingo (Midlands) Limited. In the absence of any other submission, I therefore direct that the application in suit should henceforth proceed in the joint names of Mr Stanley and Mr Withnall only. I recognise that this could cause problems in relation to the further prosecution of the patent application, because they will need to agree on a reply to the examiner's report under section 18, which issued on 14 June 1993, specifying a reply period of six months. In case they cannot agree, I point out that an application may be made to the Comptroller under section 10 to seek appropriate directions.

The third matter was whether any consequential action is neede in relation to a corresponding international application, no PCT/GB91/00216, published as patent specification no WO 91/12595 A1, which also relates to the invention of the application in suit. Mr Withnall's agents have submitted that in view of the interim decision and the contents of the PCT application, a similar order should be made in respect of the PCT case. However, at the hearing, as I noted on page 14 of my interim decision, Mr Shaw accepted that should I make a finding in favour of Mr Withnall there would be consequential changes in the PCT application.

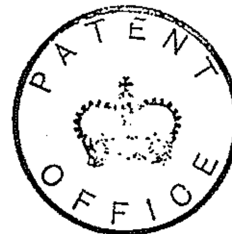
As I also noted in my interim decision, the PCT application is not mentioned in any of the papers submitted by either party in respect of the present reference under section 8. In view of the limited submissions I have received on this point, I do not believe it would be appropriate for me to take any action in relation to the PCT application. The findings that

I have made in relation to the invention might form a sufficient basis for amendments to the PCT application, but if not, it is still open to Mr Withnall to make a formal reference under section 12 of the Act.

Finally, in my interim decision I reserved the two parties' applications for costs. Mr Withnall has sustained his claim, but this has been in my judgment a more straightforward case than most, and moreover Mr Withnall did not incur the expense of the hearing. In these circumstances I award him the sum of £250 as a contribution to his costs and direct that this be paid to him by the present applicants for the patent Shop-A-Long Bingo (Midlands) Limited.

This being a substantive matter, the time within which an appeal may be lodged is six weeks from the date of this decision.

Dated this 14 day of December 1993



W J LYON
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE