

## **PATENTS ACT 1977**

**IN THE MATTER OF** a reference under  
section 12(1)(a) by British  
Telecommunications plc in respect of US  
Patent Application No 08/525,729 and  
Canadian Patent Application No 2,158,850

### **DECISION**

1. This decision relates to an uncontested reference to the Comptroller under section 12 of the Patents Act 1977 as to who is entitled to be granted patents in the USA and Canada in respect of an invention made in the UK. The background was set out in the reference and supported by exhibits filed with the reference, and as none of this has been contested I shall accept it all as a true statement of the facts.
  
2. US Patent Application No 08/525,729 and Canadian Patent Application No 2,158,850 are national phase applications in the USA and Canada respectively corresponding to an international application, GB94/00430, made under the Patent Co-operation Treaty (PCT) and claiming priority from a European Application No EP93302383.0. The PCT application request named Mrs Margaret Gaved and Mr James Hawkey as inventors. It identified British Telecommunications plc (BT) as the applicant save for the USA where, in accordance with US law, the inventors were named as applicants. A power of attorney was signed by both Mrs Gaved and Mr Hawkey permitting Mr Leng, BT's patent agent, to act in respect of the PCT application.
  
3. When the PCT application entered, or was about to enter, the national phase in the USA and Canada, BT requested each of the inventors to sign three documents:
  1. A declaration and power of attorney permitting attorneys in the American firm of

Nixon & Vanderhye to prosecute the US patent application before the US Patent and Trademark Office.

2. An assignment assigning the inventors' rights in the US application to British Telecommunications plc, and

3. An assignment assigning their rights in the Canadian application to British Telecommunications plc.

Copies of these documents have been supplied to this Office with a letter from BT received on 22 December 1997. (The letter is incorrectly dated 21 July: that should obviously be 21 December.)

4. Mrs Margaret Gaved signed all three documents but Mr James Hawkey did not. Some protracted correspondence between BT and Mr Hawkey ensued, at the end of which Mr Hawkey refused to sign the documents unless he was paid US\$5000. BT were unwilling to pay up because they considered they had a legal right to the invention in the first place and therefore had no obligation to pay Mr Hawkey anything. The refusal to sign makes it appear that Mr Hawkey is part owner of both patent applications.

5. To remedy this situation, on 5 March 1997, BT filed the present reference under section 12(1)(a). They ask the Comptroller to authorise their Head of Intellectual Property, Dr M Jewess, to sign the three documents specified above. They also request costs. Mr Hawkey has not filed a counterstatement opposing the reference nor has he replied to correspondence from the Patent Office and in these circumstances I will, as indicated above, rely on the uncontested facts as set out in the statement and exhibits in reaching a decision.

6. The relevant part of section 12 reads:-

(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.

7. As concluded by the Hearing Officer in *Cannings United States Application [1992] RPC 459* this section of the Act gives the Comptroller the powers to determine the ownership of the invention of a PCT application in another country such as the USA, subject to other relevant provisions of the Act and in particular the requirements of sections 39, 43 and 130.

8. Section 39 reads:-

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.

9. The relevant parts of section 43 read:-

(2) Sections 39 to 42 above shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say -

- (a) he was mainly employed in the United Kingdom; or
  - (b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in the United Kingdom to which the employee was attached, whether or not he was also attached elsewhere.
- (3) In sections 39 to 42 above and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee.

10. The relevant definitions in section 130 read:-

"employee" means a person who works or (where the employment has ceased) worked under a contract of employment or in employment under or for the purposes of a government department or a person who serves (or served) in the naval, military or air forces of the Crown;

"employer" in relation to an employee, means the person by whom the employee is or was employed;

11. The unchallenged statement and accompanying exhibits establish to my satisfaction that, at all relevant times, Mr Hawkey was an employee of York University within the terms of sections 43 and 130 and that he made his contribution to the invention during the course of his normal duties as an employee of that university, whilst working under a research contract agreed between the university and BT. The contract ran from 27 May 1991 until 30 April 1992 and Mr Hawkey was employed under this contract, by York University, from 14 October 1991 to 31 December 1991 and from 13 January 1992 to 10 February 1992. By virtue of section 39(1)(a) Mr Hawkey's share in the invention would belong to York University. However the research contract specifies that every invention resulting from work under the contract shall be vested wholly in the ownership of BT, and consequently the rights in the invention belong to BT.

12. I find therefore that, under the provisions of section 39, BT is entitled to the invention in

both the US and Canadian applications, and I now need to consider what relief is appropriate. I am satisfied that BT have given Mr Hawkey ample opportunity to sign the three documents and he has refused to do so. In a similar situation, the Hearing Officer in *Cannings' United States Application* authorised the referrer to sign on behalf of an uncooperative party, having established that an assignment signed in this way would be acceptable to the US Patent and Trademark Office for the purpose of establishing rights in the US. BT say that Canada and the USA have similar provisions relating to patent applications, and in the absence of any evidence to the contrary I shall assume that such an order would also be acceptable to the Canadian Patent Office.

13. Therefore I hereby authorise Dr M Jewess, the Head of Intellectual Property at BT, to sign on behalf of Mr Hawkey:

1. a declaration and power of attorney permitting the American firm of Nixon & Vanderhye to prosecute the corresponding US patent application,
2. an assignment of US rights to BT in respect of US Patent Application No 08/525,729, and
3. an assignment of Canadian rights to BT in respect of Canadian Patent Application No 2,158,850

in the form in which these documents were provided to this Office save for any necessary adjustments to reflect differences between the position as it was when the documents were drawn up and the position as it is now. For the avoidance of doubt, I should say that the possible adjustments I have in mind are such as may be necessary to reflect changes of address, the fact that Margaret Gaved has already signed them, the fact that the US and Canadian applications now have numbers, and similar matters.

14. Since the referrers have succeeded in their reference they are entitled to an award of costs. Accordingly I award them the sum of £200 as a contribution to their costs and order

that this sum be paid to them by Mr Hawkey.

15. Under the Rules of the Supreme Court, any appeal from this decision should be lodged within 6 weeks.

Dated this 13th day of February 1998

P HAYWARD

Superintending Examiner, acting for the Comptroller

**THE PATENT OFFICE**