

PATENTS ACT 1977

IN THE MATTER OF a reference under
Section 37 by Precast Micro Injection Pile
Technology Limited in respect of Patent No
2189533 in the name of Precast Micro
Injection Pile SDN BHD

DECISION

1. Application No 8624515 was filed in the name of Heng Beng Lam ("Lam") on 13 October 1986 claiming priority from Application number 8605652 filed 7 March 1986. By virtue of an assignment dated 22 October 1986 lodged at the Patent Office with Form 21/77 on 9 January 1987, the application proceeded in the name of Precast Micro Injection Pile SDN BHD ("PMIP-SB"), and was published as GB2189533 on 28 October 1987. (The name of PMIP-SB was subsequently changed to Posada Holdings (M) SDN BHD ("Posada"). On 10 March 1989, a reference was made to the Comptroller under Section 8 of the Patents Act by Precast Micro Injection Pile Technology Limited ("the referrers", "PMIP-TL"), seeking an order that the application should proceed solely in the name of the referrer, and requesting that prosecution of the application be stayed until the question of ownership was resolved. Notwithstanding this latter request, the application proceeded to grant on 8 November 1989. The referrers were thus informed by the Office that the reference would be treated as proceeding under Section 37 which refers to questions of entitlement after grant.

2. In their statement, the referrers draw attention to an agreement between Lam, the referrers (under their former name of Estepona Limited), Underwater Technology International Limited and PMIP-SB, and an associated assignment between Lam and Estepona Limited and purporting to assign all rights in several patent applications including the two UK applications to Estepona Limited. Both the agreement and the assignment were executed on 29 June 1987. The agreement contains assurances that the parties covenant and agree to do all such acts and execute all instruments necessary to enable each party to perform his covenants and obligations under the agreement.

3. As the referrers point out, in order to give effect to the assignment between Lam and Estepona, a re-assignment of the applications from PMIP-SB to Lam is required. Despite their efforts, the referrers say that they have been unable to obtain the necessary assignment from Lam. As a result, they commenced proceedings against Lam and Posada in the Malaysian High Court and obtained an injunction against Lam and Posada to restrain them from doing anything inconsistent with the agreement. The proceedings in Malaysia culminated in the issue of a consent order dated 17 October 1997 declaring that the referrers are the lawful assignees of *inter alia* the patent in suit, and ordering the plaintiffs and defendants before the court in Malaysia to execute all necessary deeds of assignment and transfer and to apply to the appropriate authorities to have the relevant assignments recorded. Whilst the court actions were being resolved, action under Section 37 was stayed. At the time the decision to stay was taken, no counterstatement had been filed.

4. There is no evidence that the necessary deeds have been executed, thus it would now seem appropriate to revive the Section 37 proceedings. This action was foreshadowed in a letter to both parties sent on 20 April 1998, wherein the Patent Office proposed, subject to any comments by either party, to decide the issues on the papers filed, *ie* in the absence of any counterstatement. A month was given for any comments, and that period expired without any comments being received.

5. Sections 37(1) and (2) of the Patents Act are as follows:

(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question -

(a) who is or are the true proprietor or proprietors of the patent,

(b) whether the patent should have been granted to the person or persons to whom it was granted,

or

- (c) *whether any right in or under the patent should be transferred or granted to any other person or persons;*

and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.

(2) Without prejudice to the generality of subsection (1) above, an order under that subsection may contain provision -

- (a) *directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;*
- (b) *directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;*
- (c) *granting any licence or other right in or under the patent;*
- (d) *directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.*

6. The patent currently stands in the name of Precast Micro Injection Pile SDN BHD as a result of an assignment from the original applicant and inventor Heng Beng Lam. Although the above-mentioned agreement and assignment between *inter alia* Lam and the referrers were executed before the patent was granted, the necessary enabling documents, required to re-establish Lam as owner/applicant before he could then assign the application/patent to the present referrers, were not executed, so the later assignment could not take effect. It follows, therefore, that the patent was correctly granted in the name of Precast Micro Injection Pile SDN BHD.

7. It is the referrers' case that their entitlement arises out of this later assignment. The necessary enabling documents are still not to hand, so they rely upon the consent order of the Malaysian High Court which adjudges without doubt that the referrers are the lawful assignees of the present patent. I am prepared to accept that order as sufficient evidence on which to act.

8. Thus, I determine, under Section 37(1)(c) that the rights in the invention should be transferred to the referrers, Precast Micro Injection Pile Technology Limited. In order to effect this transfer, I direct that there be an entry made in the register recording the assignment of the invention to the said referrers.

9. The referrers have also requested a contribution towards their costs. However, in effect this reference has been uncontested to the extent that the patentees never filed a counterstatement. In the circumstances therefore, I make no order for costs.

10. This decision being on a substantive matter, under the rules of the Supreme Court, any appeal against it must be filed within a period of 6 weeks.

Dated this 19th day of November 1998

D L Wood

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE