

PATENTS ACT 1977

IN THE MATTER OF a reference under
section 12 (1)(a) by Dr Mary Catherine
Ambrose Griffin in respect of PCT
Application No. WO 97/15633 in the
names of Xaar Limited, J P Tatum and
J Woods

DECISION

1. This decision relates to a reference to the Comptroller under section 12 (1)(a) of the Patents Act 1977 as to who is entitled to be named as inventors, and as applicants for the purposes of the United States of America, of International Patent Application PCT/GB96/02589 ("the PCT application"), which designates Brazil, Canada, China, Japan, Republic of Korea, Mexico, Russian Federation, Singapore, the United States of America and 17 European states (including the United Kingdom) via the European Patent Convention ("EPC"). The reference was initially contested, but once the referrer had provided her evidence the opponents decided to contest it no further. It now falls for me to decide on the basis of the papers before me.

2. The PCT application, which is entitled "Ink jet printer dispersion inks", was filed on 22 October 1996, claiming priority from GB 9521673.5 ("the priority application ") dated 23 October 1995, and was published by WIPO on 1 May 1997 with the number WO 97/15633. The priority application, which was filed in the name of Xaar Limited ("Xaar") with no inventors being named, was terminated before publication on 15 November 1996. The PCT application has now entered the national phase and I am aware that a European patent application no. EP 0857196 based on the PCT application exists. As far as the PCT application is concerned, the applicant identified for all states except the US was Xaar, with John Philip Tatum ("Tatum") and Jill Woods ("Woods") named as inventors. In accordance with US law, Tatum and Woods were named as applicants for the purposes of the US only.

3. The referrer is Dr Mary Catherine Ambrose Griffin ("Griffin") who held the post of Chief Chemist with Xaar, which is a Cambridge based company concerned with the development of new technology for ink-jet printers, from 1 August 1992 until 7 March 1996 when she was made redundant. She managed Xaar's Ink Department, which carries out most of Xaar's research and development work on inks for ink jet printers. Thus she was employed by Xaar at the time the GB priority application was made but not at the time the PCT application was made.

4. Stephenson Harwood, acting as agent for the referrer, filed a statement of case together with the reference on 7 October 1997, asking for the Comptroller to declare that the referrer is a co-inventor and that she should be named as a US applicant, and asking for costs. On 2 February 1998, Mathys & Squire, patent attorneys, acting for all the opponents, namely Xaar, Tatum and Woods, filed three counterstatements, which are identical in content, from the three opponents in which they refute that the Comptroller should make such declarations and also ask for costs. Evidence in chief was filed on behalf of the referrer on 18 May 1998, comprising solely one statutory declaration by the referrer. A request was made on 29 June 1998 by the opponents that part of one paragraph of this statutory declaration should be treated as confidential. This request was allowed and an amended version of the statutory declaration was placed on the open part of the file.

5. J.A.D.Cropp ("Cropp"), a patent attorney with Mathys & Squire, who normally deals with the developments of Xaar's ink department, wrote to the Patent Office on 11 September 1998 saying that, now that Xaar had had a sight of Griffin's evidence, which at no time was put to it before before these proceedings were precipitately initiated by Griffin, Xaar had discussed the evidence with the co-inventors, had taken advice and had decided to leave the matter to the determination of the Comptroller. Cropp requested that, since the opponents were not contesting the proceedings, no award of costs should be made. I note that Cropp pointed out in this same letter that he took issue with a statement in Griffin's statutory declaration that "Mr Cropp generally discouraged me from trying to agree who should be named as inventor before the PCT applications were to be filed, because of the likelihood of amendments to the claims" saying that he "simply advised that it was not necessary to record the name(s) of the inventors

until some 12 months after filing". This statement by Cropp explains why no inventors were named at the time the GB priority application was made. Otherwise the contents of the referrer's evidence has not been contested and I shall regard it as a true statement of the facts.

6. In reply to the opponents' letter of 11 September 1998, Stephenson Harwood wrote to the Patent Office on 5 October 1998 asking that an award of costs should still be made to the referrer, pointing out that Griffin had spent considerable sums in pursuing the proceedings, particularly in drawing up her evidence, and saying that she had first made representations to Xaar in May 1996, that her representations had been dismissed out of hand at that time and that she had been left with no alternative but to initiate the proceedings. Stephenson Harwood also asked in their letter that the Comptroller should consider departing from the normal scale of costs and award exceptional costs, because as well as Griffin being involved with legal fees she had also been deprived of consultancy fees she could have earned in the time taken and had suffered emotional stress.

7. Cropp takes issue with this, saying in a letter dated 13 October 1998 that he believes that it is appropriate to award no costs but that should the Comptroller be minded to make an award as to costs it would be appropriate, in the light of the conduct of the parties, to make an award to the opponent company. In this letter of 13 October 1998 it is confirmed that the referrer did indeed approach the opponent Xaar in May 1996, but it is refuted that, at any time prior to the commencement of this action, Griffin gave a clear, reasoned account of why she believed herself to be an inventor of the PCT application. A set of correspondence with Griffin regarding inventorship and dating from May 1996 was enclosed with the letter. Cropp claims on behalf of the opponents that, as soon as Griffin's evidence was properly considered and advised upon, Xaar sought, very properly, to bring the matter expeditiously, and with as little expense to either party as possible, to a conclusion.

THE RELEVANT LAW

8. This reference has been brought under section 12 of the Patents Act which governs

disputes over entitlement *inter alia* to PCT applications. Subsection (1)(a) and (3) read as follows:

12 - (1) At any time before a patent is granted for an application in pursuance of an application made under the law of any country other than the United Kingdom or under a treaty or international convention (whether or not that application has been made)-

(alone (a) any person may refer to the Comptroller the question whether he is entitled to be granted or with any other persons) any such patent for that invention or has or would have any right in or under such patent or an application for such a patent

(b).....

order And the Comptroller shall determine the question as far as he is able to and may make such as he thinks fit to give effect to the determination.

(3) Subsection (1) above in its application to a European Patent and an application for any such patent, shall have effect subject to Section 82 below.

The relevant parts of Section 82 read as follows:

82 - (2) Section 12 above shall not confer jurisdiction on the comptroller to determine a question to which this section applies except in accordance with the following provisions of this section.

section (3) This section applies to a question arising before the grant of a European Patent whether a person has a right to be granted a patent, or a share in any such patent, and in this "employer-employee question" means any such question between an employer and an employee, or their successors in title, arising out of an application for an application for a European patent for an invention made by the employee.

are (4) The court and the comptroller shall have jurisdiction to determine any question to which this section applies, other than an employer-employee question, if either of the following conditions are satisfied, that is to say

(a) the applicant has his residence or principal place of business in the United Kingdom, or (b).... and also in either of these cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom.

(5) The court and the Comptroller shall have jurisdiction to determine an employer-employee question if either of the following conditions is satisfied, that is to say -

(a) the employee is mainly employed in the United Kingdom, or (b)....

and also if in either of these cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom or, where there is such evidence.....

9. The Patent Cooperation Treaty ("PCT") does not specify who is entitled to be granted any patent resulting from an international application because this is left to the laws of each designated state (or, in the case of regional treaties such as the European Patent Convention, the provisions of the relevant convention). I have been provided with no evidence with regard to the laws of the nine countries individually designated although I am aware of some of the requirements of the laws and procedures of the United States of America. I am also aware of the EPC requirements and how they apply to the 17 European states designated there under in the PCT application.

10. The EPC states in articles 59 and 60 that -

"A European Patent Application may also be filed either by joint applicants or by two or more applicants designating different contracting States."

and-

"The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee the right to a European Patent shall be determined in accordance with the law of the State in which the employee is mainly employed;....."

Article 62 deals with the right of the inventor to be mentioned and says:-

"The inventor shall have the right, vis-à-vis the applicant for or proprietor of a European patent, to be mentioned as such before the European Patent Office."

11. Section 7(2)&(3), section 13(1) and section 39 of the UK Patents Act 1977 determine entitlement to a UK patent, the right to be mentioned as inventor, and employees inventions.

Subsections 2 and 3 of Section 7 determine who can be granted a patent and read:

7 - (2) 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 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 the making of 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 so mentioned; and to no other person.

(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.

Section 39 sets out the right to employees' inventions, reading-

39 - (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.

I note that Griffin's attention was drawn by Xaar, in a letter dated 17 June 1997, to the provisions of Section 39.

And, section 13 (1) of the Patents Act determines the right to be mentioned as inventor, stating that -

"The inventor or joint inventors of an invention shall have the right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be mentioned in a prescribed document."

ENTITLEMENT

12. Griffin states in her statutory declaration that she, as chief chemist at Xaar, was responsible for the direction of the chemical aspects of Xaar's research and product development, her areas of responsibility including R & D work on the production of inks suitable for Xaar printheads, and that Xaar's ink department acted under her technical and scientific direction. She states that Mr Tatum was her deputy in the ink department from the summer of 1994 and that Dr Woods also worked to her and she sums up the reasons why she should be named as co-inventor and co-applicant in the final paragraph of her statutory declaration, which reads:

"In summary, in view of the fact that it was I who perceived how Dr Woods' finding, namely that Uravar FN5 increased the RMV (receding meniscus velocity) of ink, related to the work done by Mr Tatum on the addition of sulphonic acids to inks, and that it was I who appreciated the significance of the fact that Uravar FN 5 was a phenolic resin and that Dr Woods' findings might extend to other phenols, I believe that I made an inventive contribution towards the subject matter of the application. Consequently, I should be named as an inventor of the application along with Dr Woods and Mr Tatum and named as co-applicant of the US application. Accordingly, I request that the Comptroller grant my application."

I also note that Griffin makes the point in the penultimate paragraph of her declaration that the PCT Application was made after she had left Xaar and that, consequently, she was not present to remind Cropp or anyone at Xaar of her contribution to the invention. She claims however that, although at the time of a meeting attended by herself, Cropp, Tatum, Woods, and Xaar's patent manager to finalise ideas about filing a priority application for the invention (GB 9521673.5), no discussion was held, in line with the normal method of proceeding with a

priority application, with Cropp as to who should be named as inventors, although she says that she drew the attention of Woods and Tatum immediately after the meeting to the fact that she would be expected to be named as inventor on any PCT application filed as a result of the priority application, and that they did not raise any objection. She also acknowledges that Cropp probably did not appreciate the role she had played in the development of the invention.

FINDINGS AND HOW THEY ARE TO BE GIVEN EFFECT

13. The contents of this statutory declaration by Griffin have not been contested, save for the above mentioned comment by Cropp about the timing of the naming of inventors. Under the circumstances I therefore find, from the details set out in her statutory declaration, that Griffin has made a contribution to the actual devising of the invention which is the subject of the PCT application and thus that she has the right to be named as a co-inventor.

14. Since I have determined that Griffin contributed to the actual devising of the invention disclosed in the PCT application I now have to consider what order, if any, I should make under Section 12(1) to give effect to my determination. I will consider the case of each designated country in turn.

15. Firstly I will consider the United States of America. Although no evidence has been presented in this case about the laws and procedures of the United States of America I am aware that when a PCT application enters the US National phase, the inventors are named as applicants, each inventor being required to sign a declaration that he is the first and joint inventor (where there is more than one inventor) and that he has reviewed and understood the specification of the application. I am also aware that it is also common practice for the inventors, at the same time as signing the declaration, to execute an assignment assigning their rights in the application to the persons entitled to the grant of the patent, for registration at the United States Patent and Trade Mark Office (USPTO). As concluded by the Hearing Officer in *Cannings United States Application [1992] RPC 459*, section 12 of the Patents Act gives the Comptroller powers to determine the ownership of an application following the PCT route in pursuit of a patent in the USA, subject to other relevant provisions of the Act. Thus, with

regard to any patent application or patent arising in the US from the PCT application in suit, I order that an application shall be made to the Commissioner of the USPTO for correction of inventorship, to name Griffin as an inventor/applicant, in addition to Tatum and Woods, and that Dr Griffin shall, at the same time as declaring that she is a joint inventor and has reviewed and understood the specification, execute an assignment assigning her right in such a US patent to Xaar.

16. As far as the other eight individually designated countries are concerned, I have not been supplied with any evidence regarding the national laws of these countries and so I am unable to decide whether this would be an appropriate case for the Comptroller to assert his jurisdiction under section 12 and make an order as far as these eight countries are concerned. I therefore decline to make any order giving effect to the findings of the fact mentioned with regard to any patents arising in Brazil, Canada, China, Japan, Republic of Korea, Mexico, Russian Federation and Singapore from the PCT application .

17. As far as EP application no. EP 0857196 arising out of the PCT application is concerned, I need to take account of section 82 of the Act to which, by virtue of section 12(3), section 12(1) is subject. Section 82 confers on the comptroller the jurisdiction to determine "employer-employee" questions arising out of an application for a European patent for an invention made by the employee. At the time of the making of the invention Griffin and the other two co-inventors were employed in the UK, and the applicant, which I note is Xaar Technology Limited, rather than Xaar Limited, also has its principal place of business in the United Kingdom at the same address in Cambridge as Xaar Limited. No written evidence has been provided that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom. These circumstances satisfy me that the comptroller has the jurisdiction to determine the matter in respect of the European application arising out of the PCT application.

18. I have already referred to Article 62 of the Convention which establishes the right of the inventor to be named before the European Patent Office. Rule 18 of the Regulations to the Convention states that:-

"(1) The person designated as the inventor shall be mentioned as such in the published European patent application and the European patent specification.

(2) In the event of a third party filing with the European Patent office a final decision whereby the applicant for or proprietor of a patent is required to designate him as the inventor, the provisions of paragraph (1) shall apply."

19. In view of my finding as to inventorship, and although I have no jurisdiction directly to order the addition of Dr Griffin's name to the European application, it is open to Dr Griffin to take the action stipulated in paragraph (2) of Rule 18, citing this decision.

COSTS

20. Since Dr Griffin has succeeded in her reference she is entitled to costs unless an overriding factor can be shown to exist. The opponents have drawn my attention to the conduct of the referrer and have indicated that since they have not contested the proceedings no award of costs should be made. Although it is true that they are now not contesting the reference, a counterstatement was however filed by them and the referrer was placed in the position of having to file evidence. I also have to take on board that the referrer has asked that the normal scale of costs awarded by the comptroller should be departed from and exceptional costs awarded.

21. As regards the conduct of both parties, it is not contested that Griffin was employed by Xaar at the time the invention was made, that she contributed to the actual devising of the invention, that when the priority application was filed no inventors were named, in accordance with normal practice of Xaar and its patent attorneys, and that she was made redundant by Xaar after the filing of the priority application and before the filing of the PCT application, when two inventors, but not Griffin, were named. I consider that it is the duty of an employer when filing a PCT application, and indeed when filing any patent application which, at the filing date, it is intended should proceed to grant, to take the utmost care to ensure that all their employees and past employees who contributed to the actual devising of the invention are named as inventors.

22. The opponents have provided me with a set of correspondence with Griffin regarding inventorship. Xaar denies that at any time prior to commencing this action did Griffin give a clear, reasoned account of why she believed herself to be the inventor of the invention of the PCT application. Griffin claims that she first made presentations in May 1996 but that her claims were dismissed out of hand at that time and she was left with no option but to initiate these proceedings. The opponents agree that Griffin did approach them in May 1996. I note that in correspondence dated 17 May 1996 from Thompsons, solicitors, acting for Griffin, to Xaar regarding a settlement of an employment issue following her redundancy earlier that year, inventions are mentioned and it is stated that an application ("Occluder") had been filed in the UK in the summer of 1995, that it was due to be filed as an international application, and that when that was done Griffin should be named as an inventor.

23. A further claim that Griffin should be named as inventor of the "Occluder" application is made in her letter of 14 February 1997 to Mr Hartwell of Xaar, in which she says that she does not yet know whether she has been mentioned as an applicant in the "Occluder" application but that she should be mentioned as inventor with respect to all claims covering the use of phenols in ink-jet ink formulations. On the face of it this "Occluder" application is not one and the same as the priority application which was filed, not in the summer 1995, but in October 1995 and entitled "Ink jet printer dispersion inks", and I note that there was no specific mention of an application with the title "Ink jet printer dispersion inks" in the Thompsons correspondence of 17 May 1996.

24. The set of Griffin correspondence is concerned largely with two other PCT applications PCT/GB95/02501 (Dewetting Velocity Application) and PCT/GB95/02041 (One step Non Wetting Coating application) both naming Griffin as an inventor, but mention is also made in letters dated 4 April 1997 and 17 April 1997, from Cropp to Xaar and from Xaar to Griffin respectively, to the "Occluder" application.

25. In the 4 April letter from Cropp the "Occluder" case is given the number "M&S Case 18666" and it is stated that it was important that the basic "Occluder" case be filed on the same day, October 23, 1995, as the international application on the "Dewetting case" because

examples developed in the "Occluder" case were also suitable for supporting the "Dewetting" case and were included in the international "Dewetting" application. This same letter from Cropp also states that "The "Occluder" case was directed to improving the length of period of continuous printing that can be obtained with a dispersion ink of the kind containing a dispersant having acid or basic groups before the nozzle plate has to be cleaned or replaced. The solution was to include in the ink a compound containing groups which would neutralise the acid or basic groups of the dispersant."

26. In the 17 April letter from Xaar to Griffin, which in part related to the question raised by Griffin concerning the inventorship of the "Occluder" application, it is stated that "A file note dating from the time you left the company indicates John Tatum and Jill Woods to be the inventors" of the "Occluder" application, that Cropp had been consulted and that his reply, namely his letter dated 4 April, set out why Griffin's name had not been included in the list of inventors for the "Occluder" application. In his letter of 4 April 1997, Cropp merely gives reasons why there are examples common to both the "Dewetting" international application and the "Occluder" case and indicates that Griffin not being named as inventor is consistent with this. It does not seem to me that Cropp's explanation about the examples sufficiently addresses the question of whether or not Griffin is a co-inventor of the "Occluder" case. That Cropp probably did not know of Griffin's involvement is acknowledged by Griffin.

27. In my investigations I have also perused the files of the priority application and the PCT application. Claims 1 of both the priority application and the PCT application read-

An ink jet dispersion ink containing a dispersant having basic or acid groups and a non-destabilising amount of a neutraliser for said groups.

This claim is consistent with the definition of the "Occluder" case given by Cropp in his letter dated 4 April 1997. Moreover, the priority application gives as the applicants reference the number JADC/BMM/18666 and this again fits with the number given in Cropp's letter of 4 April 1997. Thus, I consider that an incorrect filing date for the "Occluder" case is given in the 17 May 1996 letter from Thompsons and I am convinced that the priority application and the PCT application are the "Occluder" case.

28. Thus although Griffin did not spell out in May 1996, or at any other time prior to the filing of this reference, as much detail in connection with her claim to inventorship as she does in her statutory declaration, nevertheless it is clear that Xaar 's attention was drawn to Griffin's claim to inventorship prior to the PCT application being filed on 22 October 1996 and it seems to me that Xaar did not take adequate care to ensure that all the inventors were identified. There is no indication that the other two co-inventors Tatum and Woods were consulted prior to the PCT application being filed although it seems that they were in a position to know that Griffin had contributed to the actual devising of the "Occluder" invention. I note that in their counterstatements both Tatum and Woods deny that Griffin is a co-inventor, although these denials would seem to be negated by Cropp's letter of 11 September 1998 in which he states that the opponents are not contesting these proceedings.

29. Accordingly I have decided, taking the conduct of both parties into consideration, that the referrer should be awarded costs.

30. I have not been persuaded by the comments made on behalf of the referrer by Stevenson Harwood that the circumstances are such in this case that I should depart from the standard scale. However, I do consider that I should take into account that Dr Griffin will be involved in additional expense to give effect to the order that I have made. Accordingly, I order Xaar to pay Dr Griffin £500 as a contribution towards her costs.

APPEAL

31. As this decision does not relate to matters of procedure, under the Rules of the Supreme Court any appeal must be lodged in 6 weeks.

Dated this 7th day of December 1998

D L WOOD

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE