PATENTS ACT 1977

IN THE MATTER OF
a reference under section 12
by AEA Technology plc
in respect of PCT Application No PCT/GB 95/01236
and US Patent Application No 08/608247

FINAL DECISION

1. This reference under section 12(1)(a) of the Patents Act 1977 was filed by AEA Technology plc ("AEA") in respect of a patent application made under the Patent Co-operation Treaty ("PCT"), which is application No PCT/GB 95/01236, and a patent application made in the United States, which is application No US 08/608247. The PCT application, which was published on 6 September 1996 as WO 96/27070, and also apparently the US application which has yet to be published, both named Peter Arne Read and Hugh Malcolm Bourne as inventors.

2. Following a hearing, I issued an Interim Decision dated 3 February 1999. In paragraph 70 of the Interim Decision, I summarised my conclusions as follows:

- in relation to invention (i), namely a method for treating an oil well by providing within the well one or more elements comprising an insoluble porous inorganic material containing a chemical treatment agent (PCT claim 1), and such elements themselves (PCT claim 9), Mr Read was the sole inventor before he joined AEA, and hence that the entitlement in it belongs to him;

- in relation to invention (ii), namely a method as in (i) in which the porous material comprises particles arranged to form a tubular filter bed (PCT claim 3), Mr Read was the sole inventor before he joined AEA and therefore that the entitlement in it belongs to

him, except that, for reasons I have explained, AEA has the entitlement in this method when using pre-assembled units (PCT claim 4);

- in relation to invention (iii), namely a method as in (i) wherein a formation through which the well extends is subjected to a fracturing treatment with high pressure fluid and proppant particles, at least some of the proppant particles being the said elements (PCT claim 6 and US claim 1), Mr Read and Mr Bourne were joint inventors while Mr Read was employed by AEA, and hence that the entitlement in it belongs to AEA.

3. Faced with some difficulty in deciding what would be the most appropriate form of Declaration or Order to make to give effect to my findings, and consistent with the wishes expressed at the hearing by Counsel, I gave the parties an opportunity to negotiate an agreement between themselves, and failing that an opportunity to make submissions to me on the form of Order or Declaration I should make. I also deferred consideration of costs until the issue of my Final Decision.

4. After some exchanges of correspondence on this reference and a related reference by Mr Read, the Office received a letter of 6 July from Eversheds on behalf of AEA, enclosing a letter of 2 July from Murgitroyd & Company on behalf of Mr Read. I noted the contents of both letters and in particular the facts that AEA and Mr Read have settled their dispute, that each party proposes to withdraw its respective reference with the other party's consent, and that under the terms of the agreement reached by the parties in both references, each party will bear its own costs. However, it was not clear to me that I could immediately approve the withdrawal of the present reference for the following reasons.

5. The reference launched by AEA had been the subject of a hearing and an Interim Decision, in which I had made certain findings as to inventorship and entitlement. It was my preliminary view that I must conclude those proceedings with a Final Decision, and that that Decision must be able to be read consistently with my findings in paragraph 70 of the Interim Decision. For this reason, I needed to know how the agreement between the parties apportions, singly or jointly, entitlement in the applications in suit as between AEA and Mr Read. I was

concerned to ensure that the public will be left in no uncertainty as to the entitlement in the applications in suit at the conclusion of the proceedings. My view was reported to the parties in an official letter of 14 July and comments invited on it.

6. In a faxed letter dated 28 July, Eversheds replied:

> "This matter has been settled between the parties on confidential terms, These terms are such that the Register at the Patent Office is correct. Murgitroyd & Company have agreed the terms of this letter and confirm this."

7. The remark about "the Register at the Patent Office" is not entirely clear to me given that this reference is concerned with a PCT and a US application. Nonetheless, I believe it is sufficiently clear that the intention of the parties is that the agreement between them does not disturb the inventorship or entitlement position as it stood at the commencement of these proceedings, and therefore that I should dispose of the reference on that basis.

8. In the light of the letters from the parties of 28, 6 and 2 July, I note and allow the withdrawal of this reference, making no award of costs and leaving no matters outstanding, with the result that AEA remain as applicants and Peter Arne Read and Hugh Malcolm Bourne remain as named inventors of the applications in suit.

Dated this 30th day of July 1999

S N DENNEHEY
Divisional Director, acting for the comptroller

THE PATENT OFFICE