

## **PATENTS ACT 1977**

IN THE MATTER OF international patent application PCT/GB 98/00136 in the name of Carbury Herne Limited

and

IN THE MATTER OF a referral under section 12 by James Richard Jackson

### **DECISION**

1. International application PCT/GB 98/00136 (hereafter "the international application") was filed at the Patent Office as receiving office on 15 January 1998. It was subsequently published on 23 July 1998 with the number WO 98/32018. It claims priority from GB 9700759.5 (filed 15 January 1997), to which I shall refer hereafter as "the priority application". I understand that the international application has subsequently matured into various national and regional phase applications including an application before the European Patent Office.

2. Carbury Herne Ltd (hereafter "CHL"), in whose name the international application stands, are a company in liquidation. The applicant in the present proceedings, James Richard Jackson (hereafter "Mr Jackson"), was involved in an earlier dispute with CHL over entitlement and inventorship of the priority application.

3. In those earlier proceedings under sections 8 and 13, I found Mr Jackson to be a joint inventor of the priority application, and that in consequence he ought to have been regarded as a joint applicant of that application. While no specific remedies were available to him in view of the priority application's unpublished and terminated status, my decision dated 28 March 2000 made it clear that my findings of fact could be used to support a potential reference under s.12 in respect of the international application.

4. Mr Jackson duly filed a reference under s.12 on 7 April 2000 asking the comptroller to determine that he should be named an inventor, and should be made a joint applicant, of the international application and of any other applications which claim priority from the priority application. His statement of case sought an order to that effect with costs.

5. No counterstatement on behalf of CHL was filed. However following an exchange of correspondence, the Office was notified by Mr Jackson in a faxed letter dated 26 June 2000 that the parties had reached agreement on joint ownership of the priority application and the international application. A copy of this agreement, which is dated 26 June 2000, was supplied with the said fax. A letter dated 26 June 2000 from Messrs Edward Geldard, solicitors for the receivers, confirmed that they had no wish to contest the relief sought by Mr Jackson save that they reserved the right to make representations as to costs. Mr Jackson, by fax dated 30 July 2000, confirmed that he would not be pursuing any request for an award of costs.

### ***Order***

6. Article 2.3 of the agreement between the parties authorises Mr Jackson, should he so desire, to instruct the agents Kemp & Co to take the necessary steps to record him as a joint inventor and applicant of the international application. In these circumstances there is no need for me to make a specific order which purports to have a direct effect on foreign rights, and indeed it would be inappropriate for me to do so in the absence of evidence as to the effects of such an order under the laws of each foreign jurisdiction in question. I am however able to make a declaration of rights confirming what has been agreed between the parties, and shall now do so.

7. Accordingly, in the light of the agreement reached between the parties, I hereby declare that James Richard Jackson is a joint inventor of, and is jointly entitled to, international application PCT/GB 98/00136 (publication number WO 98/32018) and any other applications claiming priority from UK patent application GB 9700759.5. This declaration may if necessary be used in support of any request to the International Bureau, the European Patent Office or foreign national authorities in support of an application to amend ownership and/or inventorship details in respect of any application as identified in this paragraph.

### ***Costs***

8. As agreed between the parties, I make no order as to costs.

### ***Termination of proceedings***

9. These proceedings are now terminated.

### ***Appeal***

10. This being a decision other than on a procedural matter, the period for appeal is six weeks.

Dated this 4<sup>th</sup> day of August 2000

**G M BRIDGES**  
**Divisional Director, acting for the Comptroller**

**THE PATENT OFFICE**