

## **PATENTS ACT 1977**

IN THE MATTER OF references under sections 8, 12 and 37 by Brian Williams in respect of GB Application 9520478.0 in the name of West Glamorgan County Council and various foreign applications claiming priority therefrom in the joint names of Neath and Port Talbot County Borough Council and the City and County of Swansea.

### **DECISION**

#### **Introduction**

- 1 These proceedings involve one individual and three local government authorities. The individual is:

Brian Williams (“Mr Williams”)  
The inventor and claimant.

The authorities are:

West Glamorgan County Council (“West Glamorgan”)  
Mr Williams’ employer at the time the invention was made and when the GB Application was filed. It disappeared under the local government reorganisation in 1996.

Neath and Port Talbot County Borough Council (“Neath/Port Talbot”)  
City and County of Swansea (“Swansea”)  
Created by the reorganisation of 1996 and assuming the responsibilities of the former West Glamorgan County Council. Neath/Port Talbot became Mr Williams’ employer after the reorganisation. Neath/Port Talbot and Swansea are the defendants in this action.

- 2 The proceedings relate to a GB Patent Application No. 9520478.0 filed on 6 October 1995 in the name of West Glamorgan, and to a European Patent Application No. 96932733.7 and several foreign applications arising from an international application filed on 7 October 1996 under the Patent Cooperation Treaty as PCT Application No. PCT/GB96/02454. The PCT application claimed priority from the GB application, but as it was filed after the local authority reorganisation it was made in the joint names of Neath/Port Talbot and Swansea rather than West Glamorgan. The foreign applications are in Canada No. 2233940, in Japan 9-514811, in Norway No. 9801544, in the USA No. 09/051101, and in New Zealand No. 319230. (I observe that in the evidence, though not in the statement of case, there is a reference to an Australian application, No. 9671408, also having resulted from the PCT application.)

- 3 Mr Williams is seeking that the Comptroller make such determinations and orders to ensure that the European and all the foreign applications should proceed in his name as sole applicant and sole proprietor, and also that he was entitled to the grant of a patent in respect of the GB application. He is also seeking costs.
- 4 Following the usual evidence rounds, including disclosure of certain documents by the defendants at the request of the claimant, the hearing took place before me on 21 February 2001. Ms J Reid instructed by Briffa and Co. appeared as counsel for the claimant, Mr Williams, and Mr J Abrahams instructed by Messrs Mewburn Ellis appeared as counsel for the defendants, Neath/Port Talbot and Swansea.

### **The invention**

- 5 The GB application is concerned with a more effective system for dispensing salt, grit or the like on roads to prevent icing. (For simplicity, I shall just refer to “grit” and “gritting”.) The method monitors the location of one or more gritting vehicles and controls the disbursement of grit in dependence on a pre-determined gritting requirement at that location. The requirement may be determined by using eg the predicted temperature at that location derived from a forecast thermal map. The latter may be used to predict which stretches of road will be at or below freezing and control the gritting so that grit is only dispensed on those stretches. The control may also determine the rate at which grit is dispensed so that, for example, more grit may be applied where lower temperatures are predicted. The control may be automatic or via a human operator, or automatic with a human override.
- 6 The location of the or each vehicle may be monitored by a Global Positioning Satellite (“GPS”) or Differential GPS system. This information may also be used to determine the route of the vehicle, eg by generating instructions for the driver. The location information may be recorded in order to generate an archive of gritting performance.
- 7 It is acknowledged that thermal mapping has already been used for assessing where to grit, and also that position monitoring is known. Thus it would appear that it is the combination of vehicle location monitoring with the regulation of grit dispensing in accordance with a predicted need for grit at the given location that is the essence of the invention in the GB application.
- 8 The GB application was terminated with no claims having been filed. A better indication of the scope of the invention may be inferred from the PCT application which was published as WO97/13926 and has the following independent claims:

1. A gritting method in which a vehicle including gritting apparatus travels along a route and disperses grit, or other material adapted to prevent or reduce ice formation, on the route in accordance with a gritting routine, the method comprising the steps of

progressively determining and monitoring the location of the vehicle along the route using a positioning system to generate monitored position data

substantially continuously or regularly;

comparing, using an information processor, the monitored position data with stored route information comprising data indicative of varying location-dependent gritting requirements for the route, and

generating a gritting instruction in dependence on the comparison, to control one or more adjustable parameters of the grit dispersion in a manner appropriate to the gritting requirements at the vehicle's position.

19. A gritting control arrangement comprising

(a) a positioning system for determining and monitoring the location of a gritting vehicle on a route, to provide corresponding position data;

(b) an information processing arrangement adapted to receive said position data and comprising

a route information store for data indicative of variable location-dependent gritting requirements along a route;

means for comparing current said position data with the stored route information and determining one or more corresponding grit dispersion parameters appropriate for a current location of the gritting vehicle, and

means for generating a gritting instruction for controlling gritting apparatus in accordance with said one or more dispersion parameters.

### **The history of events**

9 By and large, there is little dispute between the two sides about the history of events. Mr Williams was an employee of West Glamorgan from 1974 until its disappearance as a result of the local government reorganisation in Wales in 1996. From 1989 to 1992 his job title was Assistant Engineer (Policy & Programmes) and, at least during the latter part of that period, he worked in the Maintenance Management Section, which was responsible for highway maintenance and repairs. In April 1992, the Section was restructured and Mr Williams' post was redesignated and regraded as Team Leader (Policy & Programmes). At some time in the following 12 months, as a result of the introduction of a policy of compulsory competitive tendering, the Maintenance Management Section was divided into a Service Management Group ("SMG") and a Highways Maintenance Unit ("HMU"). The SMG was responsible for preparing schedules of highway maintenance and repair work, and the HMU was responsible for commissioning the work either through direct labour employed by the council or through outside contractors. Mr Williams was employed in the SMG and one of his responsibilities was the winter roads maintenance programme. In particular, he was concerned with the programme of gritting of roads to prevent icing. As such, he was responsible for ensuring that the programme was effective and efficient.

- 10 In his duties with West Glamorgan in the late 1980s Mr Williams was involved with the installation of two weather monitoring stations as part of a system known as Icelert. This system was introduced by the Welsh Office for monitoring weather conditions at given points along motorways and trunk roads. Mr Williams' involvement with the installation extended merely to the provision of concrete bases for the stations and the provision of the necessary services such as electrical power and telephone links. Information from these stations was relayed to a base station in County Hall.
- 11 Also in the late 1980s, West Glamorgan were considering introducing a system for thermal mapping of their road network. This involved recording the temperature and other weather conditions at a number of locations across the region, and extrapolating the information, using information from an initial survey of the whole network, to generate a temperature map in order to identify roads likely to be affected by icing. This would enable a more accurate identification of those roads that required gritting. West Glamorgan commissioned a thermal mapping exercise of their road network from a company called Thermal Mapping International Ltd ("TMI"), established by the University of Birmingham and which later became Vaisala TMI Ltd ("Vaisala"). Subsequently, Vaisala offered a gritting route optimisation service as well as a forecast thermal mapping system, which, as the name suggests, involved using the information from the various monitoring stations together with general weather forecasts to predict a thermal map of the network, thus anticipating which roads would need gritting.
- 12 Mr Williams says he had the idea of combining the forecast thermal mapping with a system of controlling the dispensing of grit based on tracking the position of the gritting vehicle some time in 1993. Mr Williams himself puts the date as in or around July to October, and the defendants in their counterstatement contest that only to the extent that they claim that there were further technical developments between then and the dates on which the patent applications were filed. The basic elements of the system are disclosed in a memo dated 25 October 1993 from Mr Williams to his superior in the SMG, so the basic invention had certainly been made by that date. Equally, Mr Williams does not deny that having disclosed his idea to his employers, he was asked by them to spend time developing the idea both for their own use and for possible general commercial use.
- 13 Eventually, following discussions with patent agents, the GB Application was filed on 6 October 1995 in the name of West Glamorgan County Council. As I have mentioned above, West Glamorgan disappeared under the local government reorganisation in April 1996, and its responsibilities were split between Neath/Port Talbot and Swansea. Thus the subsequent PCT Application, which was filed on 7 October 1996, claiming priority from the GB Application, was in the names of Neath/Port Talbot and Swansea, and named Mr Williams as inventor. Following the reorganisation, Mr Williams was given the post of Network/Programme Manager, working for Neath/Port Talbot.
- 14 There is one other point that needs to be noted. In 1993, the same year in which he came up with the basic invention, Mr Williams met a Mr Steve Austin of Systems Guidance Limited, a company which specialised in systems for warehousing or fleet management using tracking such as GPS systems. Mr Austin had been discussing the possible use of his company's GPS systems by West Glamorgan for tracking their

vehicles. Mr Williams says he discussed the use of GPS systems and in particular the communications aspect with Mr Austin, though he maintains that he had already had the idea of using GPS for controlling gritting operations before meeting Mr Austin.

### **The law**

- 15 The present proceedings include references made under sections 8 and 12 of the Patents Act 1977. I do not think I need to recite the sections here. It is sufficient to note that each of them allows a person (here, Mr Williams) to refer to the comptroller the question of whether he is entitled to be granted, alone or with any other persons, any patent for the invention or has or would have any right in or under any such patent or patent application. The comptroller is required to determine the question, and may make such order as she thinks fit to give effect to the determination. Section 8 is concerned with entitlement to GB patents and section 12 with entitlement to foreign and convention patents.
- 16 Section 8 only operates before grant, and thus the proceedings also included a reference under section 37 - which applies to GB patents after grant - to cover the eventuality that the EP Application arising from the PCT Application might be granted with a GB designation before the action was determined, thus giving rise to a granted EP(GB). In the event this has not occurred so there is no need to consider section 37 any further. Section 12 also only applies if the reference is made before grant and I am assuming, from the absence of any comment to the contrary, that the applications in question had not been granted at the time the reference was filed.
- 17 The defendants are opposing this claim on the basis that, although Mr Williams is the inventor, ownership of the invention lies with them by virtue of section 39 of the Act. For that reason I will recite here sub-sections (1) and (2) of section 39. Section 39(1) 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.*

and section 39(2) reads:

*Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.*

## **Evidence**

- 18 The evidence for Mr Williams consists of two statutory declarations by himself, with supporting documentary exhibits. The evidence for the defendants consists of statutory declarations from Robert Francis Polden (“Mr Polden”) and Ronald Dolbear (“Mr Dolbear”), each with supporting documentary exhibits. Mr Polden was employed by West Glamorgan from 1976 until the reorganisation in 1996, since when he has been employed by Swansea. He was Mr Williams’ senior manager at least from 1983 until the demise of West Glamorgan. Mr Dolbear was employed by West Glamorgan in their Finance Department from 1974 until the reorganisation. After the reorganisation he was employed by Neath/Port Talbot in their Highways and Engineering Department.
- 19 All three of these witnesses were cross-examined on their evidence. They all struck me as honest and helpful witnesses, making clear when their recollection might be imperfect. At times, Mr Williams was clearly trying to work out in his mind where the questioning might be leading before answering. Nevertheless, I felt that he was always giving an honest answer, and not trying to invent an answer that might best suit his case. I also felt that the evidence given by all three was mutually consistent, even though counsel tried to argue that it wasn’t - where they differed, it was, I feel, only in their interpretation of events, not in the events themselves, and it is for me to interpret these events.

## **Mr Williams’ duties**

- 20 Both section 39(1)(a) and 39(1)(b) only bite if the invention was made in the course of the employee’s duties, so first I need to decide the nature of Mr Williams’ duties at the relevant time, ie in 1993.
- 21 At this time Mr Williams was, as I have said, in the Service Management Group (SMG) with the job title of Team Leader (Policy & Programmes). It is common ground that he did not routinely have a team to lead, though staff were sometimes delegated to assist him with particular jobs. In matters relating to highways maintenance, the SMG was the client and the Highways Maintenance Unit (HMU) was responsible for commissioning the necessary work. It was intended that within this structure, the SMG would act as a knowledgeable client. By this, it is understood that it would not be a passive client, merely setting work schedules for which the HMU would be responsible, but would actively monitor and review the performance of commissioned work, to ensure that the work was carried out properly and efficiently. Further than this, it would also look at latest developments in technology with a view to introducing them into the maintenance programme where appropriate.
- 22 Mr Williams has submitted his job description as Team Leader (Policy & Programmes)

in the SMG. The duties and responsibilities identified are:

- (1) The development of co-ordinated policies for all aspects of the Department's work in conjunction with service providers, including standards and levels of service.
- (2) In conjunction with service providers, the preparation of "needs assessed" preparation pools and forward programmes of improvement of schemes and maintenance work, in accordance with budget provision and forecasts.
- (3) The maintenance and monitoring of performance in achievement of the programmes, including co-ordination between providers.
- (4) The development of an integrated programme planning system covering all service provider work.
- (5) Any other duties that may, from time to time, be instructed by Senior Management.

23 In his second statutory declaration, Mr Williams has set out at length an explanation of his actual duties and responsibilities as he understood them. In essence, he says he was responsible for drawing up programmes and schedules of work, eg the annual maintenance programme, checking for problems or anomalies in the programmes, liaising with service providers in the preparation of future programmes, and monitoring and reviewing the performance of programmes. This is consistent with his job description and Mr Polden's evidence does not challenge this to any significant degree, so I accept it as a fair summary. It is common ground that amongst the tasks to which these duties applied was the winter maintenance programme.

24 Although Mr Williams was at pains to play down the extent to which his technical qualifications were relevant when under cross-examination, I have no doubt that he needed technical knowledge in order to do his job. I recognise, however, that the evidence of his involvement in technical projects points to the fact that his direct technical contribution was limited. For example, his part in the installation of the Icelert monitoring stations was confined to the provision of the concrete bases and the supplies of the necessary power and communications services. Again, with regard to the construction of salt barns, which were large storage structures for the salt used in gritting roads, Mr Williams was merely responsible for ensuring that the selected sites were sufficiently sized to provide room for the barn as well as the necessary access. I also note that both these projects were carried out prior to the formation of the SMG. Nevertheless, I am satisfied that when he was working in the SMG, he needed technical knowledge to understand the items in the programmes he was drawing up and to spot any problems. I am also satisfied that, bearing in mind that the SMG was expected to operate as a knowledgeable client, his work required him to keep abreast of developments in technology, as well as what was being done in other councils, including in particular the winter maintenance programme.

## **The arguments**

- 25 For the moment I will take the “invention” whose ownership I need to consider to be the basic idea of combining vehicle location monitoring with the regulation of grit dispensing in accordance with a predicted need for grit at the given location, as disclosed by Mr Williams to his employers late in 1993. I will consider the implications of the subsequent development of the idea later.
- 26 Section 39(1)(a) and (b) provide three instances in which an invention made by an employee belongs to his employer, there being two alternatives in 39(1)(a). All three of these provisions were argued before me. To satisfy the terms of section 39(1)(a) the invention either has to be made in the course of the employee’s normal duties (the first alternative), or in the course of duties outside the employee’s normal duties but specifically assigned to him or her (the second alternative), and in both cases the circumstances have to be such that an invention might reasonably be expected to result from those duties. Section 39(1)(b) requires the invention to be made in the course of the duties of the employee and because of the nature of those duties and the particular responsibilities arising therefrom, the employee has a special obligation to further the interests of the employer’s undertaking.
- 27 All three provisions require the invention to be made in the course of Mr William’s duties. I have already considered what those duties were, and there can be no doubt that the invention was directly relevant to those duties. I am sure Mr Williams only came up with new winter gritting methods because his job involved responsibility for the winter gritting programme, and in my view that is enough, in the present circumstances, for the invention to be “in the course of his duties”.
- 28 There was some argument as to whether the invention was made in office hours or outside those hours. From the evidence and Mr Williams’ cross-examination, I suspect that there was a bit of both involved because Mr Williams said he worked on the idea in his mind for some time. I do not, though, believe that “in the course of his duties” should depend upon whether the flash of inspiration came the moment before Mr Williams stepped out of the office front door or the moment after. Almost everyone will at times chew over work-related issues outside their official working hours, and it would be absurd if the ownership of any invention depended on pinning down the exact moment at which the idea occurred. In short, then, I am satisfied the invention meets the common “in the course of his duties” requirement of all three provisions in section 39(1), and I must now look at the other requirements in each provision.
- 29 I will consider the provisions in reverse order. With regard to section 39(1)(b), Mr Abraham’s argument for the defendants centred around a personnel bulletin introduced as evidence at the hearing. This document, from West Glamorgan, gives details of a new staff suggestion scheme. Mr Abrahams drew attention to the fact that the scheme specifically excluded those who, like Mr Williams, were on “Principal Officer” scales because they were expected to have “bright ideas”, and suggested that this put them into the category of those having a special obligation within the terms of section 39(1)(b). I do not accept this argument, since it seems to me to be saying that any employee-inventor whose duties meet the requirement of section 39(1)(a) that “an invention might reasonably be expected to result from the carrying out of his duties”



would automatically fall within the terms of section 39(1)(b).

- 30 “Special” obligation means what it says - something “special” over and above the obligation any employee has to his employer and indeed over and above the obligation that everyone falling within section 39(1)(a) - eg someone employed on research - will have. This part of section 39 is most commonly applied to directors, and whilst I would not suggest that it is confined to directors alone, I do not believe that Mr Williams’ duties put him in this category. I also observe that the bulletin in question predates the events of this case by several years, and neither Mr Williams nor Mr Polden had a clear recollection of the document. Consequently, it does not make a very convincing document for establishing “special obligation”, even if I had not reached the above conclusion. I am aware that the document was sprung on the claimant at the hearing and so he did not have an opportunity to deal with it properly. However, in view of my conclusion, I do not need to consider it further.
- 31 Turning now to the second limb of section 39(1)(a), “specifically assigned” duties must be duties outside the employee’s “normal” duties, so this limb cannot embrace Mr Williams’ normal responsibility for the winter maintenance programme. The only evidence of anything being specifically assigned to him that might be regarded as outside his “normal” duties, was the development of his inventive idea into a workable scheme. Since this was quite clearly after the basic invention was made, I agree with Ms Reid’s argument that this cannot bring the making of the invention into this limb of section 39(1)(a).
- 32 So now I consider the first limb of section 39(1)(a), and the first question I must address is what were Mr Williams’ “normal” duties? There is no argument that the winter maintenance programme was part of his responsibilities, so this responsibility was clearly part of his normal duties. As I have already indicated, I am satisfied that the invention must have come to him as a result of his considering the effectiveness of the road gritting programme, so it necessarily follows that the invention came about when he was in the course of his normal duties. But this is not the only requirement that must be satisfied. Section 39(1)(a) also requires the circumstances to be such that an invention might reasonably be expected to result from the carrying out of the duties.
- 33 Ms Reid argued that because the council had had to seek legal advice in 1998 on its *vires* with regard to obtaining a patent, inventing cannot have been part of Mr Williams’ duties. This argument is not consistent with the evidence. According to Mr Dolbear’s evidence, the issues on which advice was sought were connected with the legality of Neath/Port Talbot investing in and commercially developing the project, and also the position of Swansea. They were not seeking advice on whether they could patent the invention or exploit it within the council. In any case, as Mr Abrahams correctly argued, “invention” in the context of section 39 is not restricted to patentable invention. Thus, this point does not establish whether an invention might be expected to arise from Mr Williams’ normal duties one way or the other.
- 34 Mr Abrahams argued that Mr Williams’ job was to think of ways to improve road maintenance for the Council. This is true, but only to the extent that he was expected to keep abreast of technical developments and spot those that might be of benefit to the Council. In his evidence, Mr Polden stated that a particular role of the SMG was “to

monitor and review and propose changes (including technical changes) if apparent improvements became available” and Mr Williams’ role would be in accord with this. There is nothing in this to suggest that Mr Williams and/or the SMG were themselves supposed to develop new technology that might be useful to the Council. An invention is not reasonably expected solely as a result of keeping abreast of the latest developments.

35 Of course, around the relevant time - and as part of his duties - Mr Williams was also discussing with Systems Guidance Limited the possibility of using GPS systems to track West Glamorgan’s vehicles generally. That is a clear example of looking at a technical development that might benefit the Council. Although Mr Williams asserts that he had already had the basic idea of using GPS to control gritting operations, I am not prepared to rule out the possibility that his involvement with Systems Guidance Limited was a trigger for the invention. However, to argue that in coming up with the invention Mr Williams was doing no more than spotting a technical development - viz the use of GPS for vehicle tracking - that could benefit the Council is to belittle the invention. This was not simply a case of spotting that something on the market could be useful to the Council; rather, it required a technical development in its own right, at least at the conceptual level, in making the step from what was already available to the invention.

36 Mr Abrahams also argued that a part of Mr Williams’ duties was to keep costs down and that the invention was aimed at reducing costs. I accept Mr Williams’ submission that the invention was not predominantly about reducing costs - it was just as much about improving quality and reducing liability. But leaving that to one side, the fact that he may have been expected to look for ways of reducing costs may reinforce that this was in the course of his normal duties, but it does not mean that the invention was “reasonably expected”. Mr Abrahams drew my attention to a passage in *Harris’ Patent [1985] RPC 19* on page 35, which Falconer J approved as a proposition of law. It reads:

37 “If an employee makes an invention by applying his mind to problems experienced by his employer and if part of his duty is to apply his mind to those problems, then that set of circumstances is within section 39(1)(a);”

In my view, however, this is not applicable here, because Mr Williams was not being asked to apply his mind to a technical problem as was the case in *Harris*; indeed, there was no “problem” in the sense that there was in *Harris*.

38 As I have mentioned above, Mr Abrahams pointed out that section 39 refers to “invention” not “patentable invention”, and he argued that this caught Mr Williams because he was expected to come up with ideas. I do not accept this argument, because even if “invention” is broader than “patentable invention”, it is not as broad as “idea”.

39 Mr Abrahams also laid great stress on the fact that Mr Williams’ job required technical qualifications and technical knowledge. Mr Polden in his evidence says, for example, that Mr Williams:

“... devoted a substantial part of his time to keeping abreast of technical

developments in the winter maintenance field. This was in particular by reading journals and other literature, and attending various conferences and seminars around the UK to take note of developments which were afoot, and the way other local councils were doing their winter maintenance.”

I accept that Mr Williams’ duties did require technical knowledge, but that is not enough to conclude that his duties were “such that an invention might reasonably be expected to result”, even allowing for the fact that he was expected to come up with ideas. The technical qualifications specified for his job were largely needed so that he could understand the issues he was dealing with, rather than for creating solutions himself. In this connection, Mr Williams pointed out that he did not in any case have the necessary computer and software skills to develop that aspect of his invention. That may well be true, but he did not need those skills to come up with the basic idea of his invention, so I attach no weight to this point.

- 40 Mr Abrahams also argued that it would be rare for an invention to meet the “course of normal duties” test and not belong to the employer, saying that he was unaware of any case in which this had been found. Whatever may or may not emerge if one were to make a detailed analysis of all past cases, I cannot accept this argument. It is tantamount to saying that the second part of section 39(1)(a) is redundant. The structure of section 39(1)(a) clearly envisages that something could meet one test and not the other. He also argued that the policy of the law is that innovations in copyright, design right and other intellectual property created by an employee belong to the employer, and section 39 should provide a very limited exception in the case of inventions. I fail to see how this principle can be deduced from the wording of the law; on the contrary, section 39(2) implies the opposite.
- 41 Mr Abrahams argued that the fact that Mr Williams’ job description did not change when he was told to develop the invention shows that inventing was always part of his duties. This is nonsense; on the defendants’ own admission, he was being given a special task, as envisaged by subparagraph (5) of his job description. He did not have that task at the time he made the invention..
- 42 Finally, Mr Abrahams also drew attention to the memo drafted by Mr Williams on 25 October 1993, suggesting that it referred to a problem being presented to Mr Williams who then effectively provided a solution by means of his invention. I do not think this memo helps at all. As this was written after the invention had been devised, it does not establish that Mr Williams devised the invention in response to this problem being put to him.
- 43 I conclude that, whilst the invention arose out of his normal duties, the nature of Mr Williams’ normal duties were not such that an invention might reasonably be expected to result from the carrying out of those duties. His role and that of the SMG was not to come up with solutions to technical problems. It was, rather, a matter of being aware of the latest technical developments, and where appropriate, adopting new methods and equipment so that work commissioned by the Council could be carried out in the most effective manner.

### **Other aspects of the disclosure in the patent specification**

44 I have so far only concerned myself with the basic invention as disclosed in 1993. In considering entitlement, one usually has to look not just at the broad invention but also at where all the subsidiary features came from, since entitlement to these may be different. However, in the present case, neither side has even made submissions on subsidiary features, let alone provided any evidence on their origin. I observe that although the council invested in the development of the invention after Mr Williams had the initial idea, they have not argued that any inventive contribution arises in this period. On the contrary, Mr Abrahams was emphatic that entitlement to patents fell to be determined solely on the basis of what took place before then. He was relying on subsequent events only to demonstrate what Mr Williams' duties had been leading up to the event. Indeed, he went out of his way in cross-examination to persuade Mr Williams that once one had a view of Figure 1 of the PCT Application, anyone with the right expertise could make the invention. On this basis, my conclusion on the basic idea must be extended to the whole contents of the patent applications.

### **Conclusion**

45 Accordingly, I find that the invention as disclosed in the GB and PCT applications does not fall within any of the categories set out in section 39(1). By virtue of section 39(2), I therefore find that the invention so disclosed belongs to Mr Williams and the references under sections 8 and 12 succeed. In other words, I find that Mr Williams alone is the owner as between him and his employers of any patents or patent applications relating to the invention.

46 This leaves the question of what orders I should make to give effect to my findings. The original GB patent application has lapsed, and as none of the remaining applications are domestic, the form of order may not be straightforward. At the hearing, Mr Abrahams seemed confident that, should I find in favour of Mr Williams, his clients would be able to agree a suitable form of wording with the other side, so it was agreed at the hearing that I would give the parties an opportunity to reach an agreement on a suitable order. Accordingly, I allow a period of six weeks from the date of this decision for the parties to come back either with an agreed order or submissions on what the order should contain. I am allowing a generous length of time in the hope that it will give the parties plenty of opportunity to reach agreement. If they cannot agree, I will consider how to proceed in the light of any submissions received.

### **Costs**

47 Both parties agreed that costs should follow the event and should be on the comptroller's normal scale. As this action was launched before 22 May 2000, the old scale applies. Mr Williams has been totally successful in this claim, so I order that the defendants pay him the sum of £900 towards his costs in the case.

## **Appeal**

- 48 As this decision is not on a matter of procedure, the appeal period is six weeks commencing from the date of this decision.

Dated this 22<sup>nd</sup> day of May 2001

**P HAYWARD**

Divisional Director acting for the Comptroller

**THE PATENT OFFICE**