

PATENTS ACT 1977

IN THE MATTER OF applications under rules 110(4) and 100(2) of the Patents Rules 1995 and a reference under section 8(1) concerning patent application No GB 9820519.8 in the names of Harry Robinson and Laurence Antony Brooks

DECISION

Introduction

- 1 Application No GB 9820519.8 entitled “ Improvements in driving heads for fasteners”(“the 98 application”) was filed on 22 September 1998 in the joint names of Harry Robinson and Laurence Antony Brooks and claimed priority from GB application number 9721039.7 (“the 97 application”) filed on 6 October 1997. The applicants were not at that time professionally assisted. The 98 application proceeded to preliminary examination and search, and was published on 7 April 1999 as No GB 2329947 A.
- 2 However, no reply was received to a letter issued by the Patent Office on 21 September 1999 reminding the applicants that a request for substantive examination needed to be filed on Form 10/77 by 7 October 1999 if the application were to continue. The application was therefore treated as withdrawn and its termination was advertised in the Patents and Designs Journal on 19 January 2000.
- 3 On 5 October 2001 the patent agents Harrison Goddard Foote (“the agents”), who were now acting for the applicants, filed Form 10/77 together with a request under rule 110(4) of the Patents Rules 1995 to extend the period for its filing. Rule 110(4) reads:

“Without prejudice to paragraph (3) above, a time or period prescribed in the rules referred to in that paragraph may, upon request made on Patents Form 52/77, be extended or further extended if the comptroller thinks fit, whether or not the time or period (including any extension obtained under paragraph (3) above) has expired; and the comptroller may allow an extension, or further extension, under this paragraph on such terms as he may direct and subject, unless he otherwise directs, to the furnishing of a statutory declaration or affidavit verifying the grounds for the request.”
- 4 The request was accompanied by statutory declarations from Mr Brooks and Mr Robinson, and from a Mr Brian Hayes. The essence of the case put forward in these declarations is that:
 - in September 1998 Mr Brooks, who was about to visit South Africa, instructed Mr Robinson to file an international application under the Patent Cooperation Treaty (“PCT”) claiming priority from the 97 application;
 - Mr Robinson, who had no understanding of patent matters, inadvertently filed a new United Kingdom application in their joint names (the 98 application) in

addition to the PCT application (No PCT/GB98/02932);

- Mr Robinson mistakenly thought that Mr Brooks was receiving copies of all correspondence and would take any action needed, and so did not inform Mr Brooks about the filing of the '98 application; and

- in consequence Mr Brooks did not become aware of it until it was cited against a later international application (No PCT/GB01/01404) in the name of Uni-Screw Limited.

- 5 The Office did not accept that a case had been made out for the exercise of discretion under rule 110(4) and wrote accordingly to the applicant's agents on 3 December 2001. The Office's view, based on the precedent case of *Heatex Group Ltd's Application* [1995] RPC 546, was that the applicants had failed to show a continuing intent to proceed with the application: Mr Brooks could have had no intentions at all, and Mr Robinson - the only other person in a position to take decisions - chose not to do so but was not prevented from filing Form 10/77 due to any unforeseen circumstances which would justify an extension of time.
- 6 The agents replied on 13 December 2001 pressing their case. However, with this reply, and as an alternative to the action under rule 110(4), they launched entitlement proceedings under section 8(1) of the 1977 Act in the name of Mr Brooks on the basis that Mr Brooks was effectively not an applicant of the '98 application, which he had not authorised, and was therefore entitled under section 8(3) to file a new application in the joint names of himself and Mr Robinson having the same date as the '98 application.
- 7 The agents' letter of 13 December was accepted as a statement of case in the section 8(1) proceedings. In subsequent correspondence Mr Robinson made clear that he did not intend to file a counter-statement and consented to the filing of a new application as proposed by Mr Brooks.
- 8 There being no dispute *inter partes* arising out of the section 8(1) reference, it was accepted by the Office and the agents that the reference should be determined together with the application under rule 110(4). The agents having first been given an opportunity to consider a number of underlying legal issues on which I wished to be addressed (including whether there was any irregularity in procedure in or before the Office which ought to be rectified under rule 100 of the Patents Rules 1995) the matter came before me at a hearing on 3 April 2002. Mr Mark G F Lunt of Harrison Goddard Foote, Mr Brooks and his colleague Mr Anthony Williams were present for the applicants, and Mrs Christine Farrington represented the Office.
- 9 I also gave Mr Lunt an opportunity after the hearing to comment on the decision in *Pilat's Application* (BL O/139/02) which had issued one day before the hearing.

The facts of the case

- 10 Before considering the various heads under which relief is sought, I must outline in some detail the unusual - and at some points quite baffling - chain of events which has led to the loss of the '98 application and the wish, nearly two years after its termination,

to revive it. Whilst there are areas of uncertainty, I find that a broadly consistent narrative emerges from the statutory declarations filed with the application under rule 110(4), the subsequent correspondence, and the further explanation offered at the hearing. This is set out below, and is on that basis that my decision is founded.

- 11 I should say that, having considered the explanations offered by the two co-applicants, I find that of Mr Brooks to be a consistent and convincing account of what he thought and did at the relevant time. However, I am far from convinced by Mr Robinson's account, mainly because it leaves unexplained so many things that cry out for explanation. Mr Robinson freely admits that as a book publisher he has no understanding of patents matters, and that he has little memory of the relevant events and cannot explain why he took certain actions which he accepts that he must have taken. He also says that most of his papers have been lost or destroyed following a flood at his home. Mr Robinson did not attend the hearing and I am satisfied from the explanations given by Mr Lunt and Mr Brooks at the hearing about their discussions with him that this would have done little to elucidate matters.
- 12 The invention of the 97 and 98 applications relates to a system in which a single driving element may be used for transmitting torque to a range of sizes of fasteners via stepped axially aligned recesses of constant cross-section in the fastener heads. The applicants are agreed that Mr Brooks is the inventor and the person responsible for technical development, and that (despite being named as inventor on the 98 application) Mr Robinson in fact made no technical contribution, his role being to market the product.
- 13 Mr Brooks had filed the initial 97 application in their joint names. In September 1998, realising that he would be in South Africa at the time the priority year expired, he instructed Mr Robinson to file a PCT application claiming priority from the 97 application. He gave Mr Robinson a completed PCT request form which he had signed and suggested that a friend, Brian Hayes, assist him in his dealings with the Patent Office.
- 14 Although their accounts do not agree on the precise sequence of events, it is not disputed that in September 1998 Mr Robinson and Mr Hayes paid two visits to the Office. At the first visit they were left with the impression that because the 97 application had no claims a PCT application could not be filed, but that they could "buy time" to file it by "extending" the 97 application. At the second visit they discussed what needed to be done to get the PCT application off the ground; Mr Hayes took notes and filled in a PCT request form for Mr Robinson as far as possible, but thereafter took no further part in the proceedings.
- 15 Time could perhaps have been bought by leaving the 97 application to lapse and filing a new UK application *taking its own filing date*, thus starting the clock for a new priority year, but this is not what was done. At one of the meetings, on 22 September 1998, a new UK application (the 98 application) was filed, with a specification including claims which Mr Hayes would appear to have re-drafted for Mr Robinson, *but still claiming priority from the 97 application*. It was therefore ineffective to buy any extra time for filing a PCT application, which Mr Robinson filed by post on 29 September 1998. This application, No PCT/GB98/02932, was treated as withdrawn on 28 January 1999 for failure to pay fees.

- 16 The request for grant (Form 1/77) for the 98 application named Mr Robinson and Mr Brooks as joint applicants, but was signed only by Mr Robinson in the absence of Mr Brooks. Mr Robinson was named first, apparently for the reason that Mr Brooks was not present, and Mr Robinson's name and telephone number were given under the section of the form asking for details of the person to contact in the United Kingdom. This differs from the 97 application, where Mr Brooks was the first-named applicant and the contact.
- 17 Unfortunately, Mr Brooks fell seriously ill whilst in South Africa and returned to the UK on 25 September 1998; he accepts that because of this and other personal difficulties he did not follow up the progress of the patent applications as assiduously as perhaps he should have done. This might not have mattered if Mr Robinson had kept him informed, but Mr Robinson does not appear to have told Mr Brooks anything about the new UK application. Despite giving his name and telephone number on Form 1/77 as the person for the Office to contact about the 98 application, Mr Robinson says he thought that Mr Brooks would also receive copies of correspondence and would take all decisions concerning the patent application, as he had done with the 97 application. In fact, where (as in this case) no address for service is given on Form 1/77, the practice of the Patent Office is to correspond only with the applicant whose name and address is first named on Form 1/77, in this case Mr Robinson.
- 18 However, following a telephone conversation with the Patent Office on 2 October 1998, Mr Robinson would appear to have posted a cheque to enable preliminary examination and search to take place, the necessary form (Form 9/77) being made up in the Office. Notwithstanding the lack of a signature on Form 1/77 from Mr Brooks, no objection was raised as a result of the preliminary examination. The search report was sent to Mr Robinson on 20 January 1999, followed on 9 March 1999 by the Office's standard letter advising that the application would be published on 7 April 1999. Mr Robinson has no recollection of any of these matters.
- 19 On 16 and 17 March 1999, someone purporting to be Mr Brooks telephoned the Patent Office and asked for the application to be withdrawn from the publication cycle. The caller was advised that this was not possible and that he should put his arguments in writing if he wished to pursue the matter. This resulted in a letter dated 19 March in the name of, and signed by, Mr Robinson. The salient parts of this letter read:

“When I was asked to visit the Patent Office it was in connection only for a P.C.T. to our GB patent. It would seem that my P.C.T. request was placed by your office as an extension to the GB Patent, which is not what I wanted or requested. The screw has now been modified and re-presented and a new patent issued, and to file the old Patent would present a serious problem for us,

I take the “new patent” to be application PCT/GB01/01404, but no patent has yet been granted on this application.

- 20 On the evidence before me I accept that Mr Brooks did not make the telephone calls and Mr Robinson did not draft the letter. Mr Brooks was in hospital undergoing a lung biopsy on 17 March 1999. Mr Robinson accepts that he signed the letter but states that

he did not write it, as the style is not his and he would not have understood what was written. He suggests - and I accept it is possible - that the interventions may have been made by a friend, Mr Jeff Hughes, who was staying with him at the time and had access to his papers and computer. Mr Hughes had taken a considerable interest in the project, much to the annoyance of Mr Brooks. (The evidence submitted by Mr Robinson includes an e-mail from Mr Hughes with his recollection of events, which admits his presence on the scene but not the above interventions.)

21 The Office wrote on 1 April 1999 explaining that the 98 application would be published on 7 April 1999. Thereafter nothing further was heard from the applicants, and no response was received to the Office's warning letter of 21 September 1999 that a request for substantive examination was due and that the application would be treated as withdrawn if it was not received. The termination of the application was eventually announced in the Patents and Designs Journal on 19 January 2000.

22 I should also explain the situation leading up to the filing of application No PCT/GB01/01404. On 12 November 1998, shortly after his return from South Africa, Mr Brooks, together with Mr Robinson and Mr Anthony Williams, set up a limited company, Uni-Screw Limited, with themselves as directors. In a separate agreement on 11 December 1998 it was agreed to file a new patent application based on modifications which Mr Brooks had made to the original design since 1997.

23 However, it seems that Mr Brooks and Mr Williams were under the mistaken impression (possibly having been told by Mr Hayes) that the original invention was unprotected because the 97 application had lapsed, and the PCT application had either lapsed or never been filed because of a problem with claims. At the hearing I expressed surprise that, at a time when the whole direction of the project was under fundamental reconsideration, Mr Robinson had not explained that the 98 application and the PCT application No PCT/GB98/02932 had both been launched, and that fees now needed to be paid on the latter if it were not to lapse. Mr Brooks and Mr Williams were adamant that this was indeed the case.

24 A further UK application was filed in February 1999 but allowed to lapse. Application No GB 0008569.6 for the modified invention was filed on 7 April 2000 by the agents (who were now acting for Mr Brooks and Mr Robinson) followed on 30 March 2001 by application No PCT/GB01/01404 claiming priority from it. The publication of the search report on this application citing the 98 application alerted Mr Brooks for the first time to the latter. The 98 application was only cited as background art, rather than as relevant to novelty and inventive step. However it appears that this may underestimate its significance and that it may in fact overlap with the PCT application to prevent protection being obtained for some of the embodiments disclosed in the latter - hence Mr Brooks' wish to revive the 98 application in order to get protection for these embodiments at least in the United Kingdom.

Analysis

25 I turn now to the various heads under which the applicants seek relief. In the skeleton arguments submitted before the hearing, Mr Lunt set out his view of the interplay between rule 110(4) and section 8. As he saw it, if Mr Brooks had no intentions concerning the application he could not be regarded as a true applicant and could bring

an action under section 8. However if section 8 did not apply because Mr Brooks was already an applicant, then he could not unwillingly or unwittingly be deprived of intentions, and had he known about the 98 application when it had been published, he would have kept it alive, because failure to do so would undermine his patent position.

Rule 110(4)

26 On the matter of what Mr Brooks and Mr Robinson intended, it will be helpful to refer to the decision of the Comptroller in *Heatex Group Ltd's Application* [1995] RPC 546, which set out certain principles underlying the exercise of discretion under rule 110(4). These are conveniently set out in the headnote to the report as follows, and will bear repetition:

“(1) The scheme of the Act and Rules was to provide a satisfactory degree of certainty for third parties as to whether an application or patent had lapsed

(2) The basic principle was that an applicant should not suffer loss of rights through unforeseen circumstances where there was a continuing intention to proceed with the application or patent. To allow extensions on the basis of a change of mind would be wrong.

(3) The question was whether a decision not to proceed had been taken by the person authorised at the relevant date to take decisions as to the fate of the application.

(4) It would be wrong to disregard the decision because the decision-making process seemed flawed or deficient.”

27 The decision in *Heatex* is of course not binding on me and does not limit the broad discretion given to the Comptroller under rule 110(4). Nevertheless the views expressed by the hearing officer in that case have proved strongly persuasive in subsequent applications under rule 110(4) which have come before the Office, and it is right that I should take them into account as appropriate to the facts of the present case. Who then, if anyone, was authorised to take a decision on whether or not to file Form 10/77 in order to keep the application alive once it had become published and once the Office had issued its reminder on 21 September 1999 that the form was due; and was a decision actually taken?

28 Of the two applicants clearly only Mr Robinson was in a position to take action, and to that extent must be regarded by analogy with *Heatex* as the person “authorised” to make any decisions at the relevant time

29 As to whether a decision had been made, Mr Lunt sought to distinguish the present case from *Heatex*, and from the later decisions of the Comptroller in *Meunier's Application* (BL O/013/01) and *Pilat's Application* (BL O/139/02), on the grounds that in all of these a positive decision had been made not to take a procedural step which was necessary to proceed with a UK application. In the present case, Mr Lunt argued that no positive decision had been taken by either of the co-applicants: Mr Brooks because he was unaware of the existence of the application, and Mr Robinson because he thought Mr Brooks was taking all the decisions. As Mr Lunt put it, there could be no change of intent because there was never any desire to have the application in the first place.

- 30 Following on from this Mr Lunt suggested that if I were minded to exercise discretion under rule 110(4) I could proceed in one of two ways. The first way would be to replace the requirement in *Heatex* for a “continuous underlying intention” by a requirement for no positive decision to have been taken to abandon the application: this would meet the concern that there should have been no change of mind, without penalising an applicant who was in the unusual position of being unaware of an application that had been filed in his name.
- 31 The second way would be to infer the continuing underlying intention on the grounds that had Mr Brooks known of the 98 application he would either have had a continuing intention to prosecute or would have abandoned the application at a time when it would not prejudice later applications. Mr Lunt accepted that this was difficult to square with the situations in *Meunier* and *Pilat*, where it could be said that the applicant in each case would have had an underlying intention to proceed with the UK national phases of their international applications had they known the circumstances of the European regional phase that they had elected to pursue. However, again Mr Lunt fell back on the lack of a positive decision not to proceed with the UK application as the distinguishing factor.
- 32 I am in agreement with Mr Lunt that Mr Robinson can hardly be said to have taken any positive decision not to file the Form 10/77 and so abandon the application. All the evidence and correspondence points to him simply ignoring most of the correspondence that came his way in the expectation that Mr Brooks would be receiving it and dealing with it.
- 33 Neither though do the facts point to any clear and continuing line of intention to keep the application in being. As I pointed out at the hearing, Mr Robinson did not entirely leave it all to Mr Brooks. However, insofar as Mr Robinson took any action, it was sporadic, largely at the promptings of others and seemingly without any very clear strategy in mind. Thus whilst he showed some intent to keep the application going by naming himself rather than Mr Brooks as the contact when filling out the application for the 98 application and sending a cheque to pay the fee for preliminary examination and search, his last positive action was to sign a letter indicating that the application was not intended and ought if possible not to be published. Although this could be interpreted as a break in any chain of intention, it does leave open the question of what Mr Robinson would have intended once it was found that publication was inevitable.
- 34 As regards Mr Brooks, much of Mr Lunt’s argument is of necessity hypothetical, hinging on what he might or might not have done if he had known about the 98 application. I think the best that can be said is that if he had known about it he would have kept it in being as long as was necessary for it not to prejudice any other patent applications which he was pursuing. However, in the light of the decisions of the Comptroller in *Meunier* and *Pilat* (which again are not binding on me but whose reasoning I accept) what needs to be established is whether there was intention *to keep the 98 application in being*, not simply whether there was intention *to obtain patent protection in the UK*. In both these cases, an applicant, having positively elected to obtain patent protection in the UK by way of the European regional phase of an international application and not the UK national phase, was not allowed to revive the latter route when he became aware that the European route had failed for the UK

because of mistakes made by his patent agent.

- 35 I very much doubt that, if Mr Robinson had fully briefed Mr Brooks in November or December 1998 around the time that Uni-Screw Limited was being set up, Mr Brooks would have wanted to keep the 98 application in being. Mr Brooks' attempt, once he became aware of it, to resuscitate the 98 application is entirely understandable but I do not think that it helps me to establish continuing intention in respect of this particular application - very much the reverse since the application was not wanted in the first place.
- 36 Having found neither continuing intention to keep the application alive nor any positive decision to abandon it, I can gain little guidance from *Heatex* other than the need for public certainty as to whether an application has lapsed. Mr Lunt has urged me to bring the case within the *Heatex* principles by requiring simply the absence of a positive decision to abandon the application, but I do not think that this alone is enough.
- 37 *Heatex* teaches that where a positive decision has been taken not to proceed, it is not appropriate for the exercise of discretion under rule 110(4) to look into whether the decision-making process was flawed or deficient. However, where no decision at all was made I believe I must satisfy myself that the applicants acted with proper diligence and care. Just as it would be "a massive assault" on public certainty" (to quote the words of the hearing officer in *Heatex*) for an application to be revived if a clear decision has been made to abandon it, there will in my view be a similar assault if an application were to be revived where the applicant was in some way culpable in allowing it to lapse in the first place without taking any decision. Such conduct would not justify the exercise of discretion.
- 38 I am mindful of the hearing officer's expressed view in *Heatex* that the Comptroller's discretion under the equivalent of rule 110(4) at that time is not intended to be so tightly circumscribed as that applying to restoration of a patent under section 28. Nevertheless, and without wishing to speculate upon where the differences might lie, I do not think the circumstances of this case warrant the exercise of discretion under rule 110(4).
- 39 Even making allowances for Mr Robinson's lack of knowledge of patent matters and the rather loose nature of the arrangement with Mr Brooks, I have to say that I consider Mr Robinson's lack of action to be inexcusable. I can certainly understand that he would expect to leave fundamental decisions on patent matters in the hands of Mr Brooks. However, I find it extraordinary that having filed a UK application which he knew was not what Mr Brooks wanted, he did not *at any time* tell him what he had done, or, when he continued to receive correspondence, check whether Mr Brooks was also receiving it. I cannot avoid the conclusion that Mr Robinson was utterly out of his depth, and took what little action he did without even trying to think through the consequences. As he admits in his statement, he was "quite oblivious" to the effects of the patent applications that he had filed, and I think this puts it in a nutshell. Conduct of this nature cannot justify the exercise of discretion.
- 40 Also, I cannot accept that, having expressly named himself rather than Mr Brooks on Form 1/77 as the contact for the 98 application, he should necessarily then have

expected the Patent Office also to send Mr Brooks copies of documents. As I have explained, it is in fact the Office's practice to send documents only to the first-named applicant (in this case Mr Robinson) where no address for service is given and two or more joint applicants are named on Form 1/77. At the hearing it was suggested that the Office practice should have been made clearer to Mr Robinson, but I do not consider that the Office should have been expected to foresee that one joint applicant might not keep the other aware of what he had done in his name. Mr Robinson, if he had given the matter some thought, might have wondered why correspondence should go to both applicants when he had not received anything on the 97 application (where Mr Brooks was named first).

41 Turning to Mr Brooks' role, I accept that he could not have foreseen the full extent of the consequences that would ensue from leaving matters in the hands of Mr Robinson whilst he was in South Africa. I also accept that Mr Brooks had no intention in the matter of the filing of the 98 application, and I have considered above the consequences of that. However, I consider that Mr Robinson was perfectly entitled under section 7(1) of the Act, which allows any person to make an application for a patent alone or jointly with another, to file the 98 application in their joint names, even if it required the signature also of Mr Brooks to comply with formal requirements. Mr Robinson was then the only one of the applicants who was in a position to keep the application going. I therefore consider that I must look to Mr Robinson's actions and omissions, rather than what Mr Brooks might have intended had he known about the application, in order to determine whether discretion should be exercised.

42 I therefore decline to exercise discretion under rule 110(4) to allow the late filing of Form 10/77. However I have mentioned above some hitches in the processing of this application by the Patent Office, and I should therefore consider what relief, if any, is available under rule 100 of the Patents Rules 1995.

Rule 100

43 First, there is the suggestion apparently made to Mr Robinson and Mr Hayes by one of the persons they spoke to in the Patent Office that they could "extend" the 97 application to buy more time to file a PCT application. On the face of it this is clearly incorrect, but Mr Lunt accepted at the hearing that Mr Robinson and Mr Hayes might simply have misunderstood what they had been told, since a refiling of the 97 application without any claim to priority from it would indeed have bought time.

44 The person to whom Mr Hayes says they spoke has since left the Office and so I do not have her side of the story. I do not think that there is sufficient information before me to reach any conclusion one way or the other on the balance of probabilities. I do not therefore propose to consider the matter further.

45 Of more significance is the error made by the Office - and this is greatly regretted - whereby the lack of signature by Mr Brooks on Form 1/77 was not picked up during the preliminary examination of the 98 application for formal matters. This has had the consequence that the application was sent on for publication without referring the matter to the applicants. As Mr Lunt accepted at the hearing, it is quite likely that Mr Robinson would have done nothing if the Office had written to him, but at least the

application would not then have been published to serve as prior art in relation to the later PCT application. If Mr Robinson had contacted Mr Brooks, the applicants would have been better in a better position to consider their overall patent strategy.

46 At this point it will be helpful to set forth the terms of Rule 100. This reads:

- “(1) Subject to paragraph 2 below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct.
- (2) In the case of an irregularity or prospective irregularity -
 - (a) which consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968 as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;
 - (b) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and
 - (c) which it appears to the comptroller should be rectified,the comptroller may direct that the time or period in question shall be altered but not otherwise.
- (3) Paragraph (2) above is without prejudice to the comptroller's power to extend any times or periods under rule 110 or 111. “

47 Mr Lunt argued the case on the basis of rule 100(2), the irregularity under section (a) thereof being the failure to comply with the period specified in the Rules for filing Form 10/77 to request substantive examination. I am satisfied in view of rule 100(3) that my consideration of this failure under rule 110(4) does not preclude me from looking at the matter afresh under rule 100(2).

48 I am also satisfied that under section (b) of rule 100(2) the error is capable of rectification under rule 100(2). Paragraph 14.04.20 of the Office's published "Manual of Patent Practice" explains that each applicant should sign Form 1/77 and that objection will be raised to a missing signature. Rule 16(1) requires the request for grant to be made on Form 1/77, the format of which is prescribed by the Patents Rules 1995 and includes the wording "Signature" and "Date" *once* under the rubric "I/We request the grant of a patent on the basis of this application". It seems to me that, even if this falls short of a clear statutory obligation to furnish *all* signatures as distinct from just one, there is at the very least an established and published practice which applicants are entitled to expect the Office to follow.

49 However section (b) also requires the failure to be attributable wholly or in part to the error, and I am not satisfied that this is the case. I think it fair to say that the publication of the specification on 7 April 1999 would probably not have happened if the Office had picked up the lack of signature, and that the publication put the applicants in a position where they needed to decide whether or not to file Form 10/77 so that the application could proceed. It seems to me that this was a decision which the applicants needed to make in the light of all the circumstances, including the state of

play as regards the modifications to the invention which Mr Brooks was working on. This decision was effectively shelved by Mr Robinson's failure, as the man in a position to do something, to file Form 10/77 or to make any enquiries when the Office reminded him on 21 September 1999 that the form needed to be filed. I do not think that the failure to file that form can be attributed to the Office's error, regrettable though that error is.

50 Even if I am wrong in my conclusion on section (b) I am not satisfied under section (c) of rule 100(2) the Office's error should be rectified by now allowing the application to proceed, given that Mr Robinson had been alerted to a possible problem by whoever it was that wrote the letter of 19 March 1999 (which he took it upon himself to sign without reference to Mr Brooks), but thereafter took no action to deal with any of the subsequent correspondence from the Office or to raise the matter with Mr Brooks.

51 I therefore conclude that the failure to file Form 10/77 cannot be rectified under rule 100(2). Although Mr Lunt did not raise the possibility, it seems to me that rule 100(1) gives me the power to rectify the failure of the Office to carry out its established procedures concerning signature of Form 1/77 on such terms as I think fit. However, I do not think it would be appropriate for me to use this power to go any further than giving an opportunity to supply the missing signature, and certainly not to revive an application which, as I have found above, was allowed to lapse for reasons to do with Mr Robinson's failures rather than those of the Office.

52 I therefore conclude that there is no irregularity in procedure in or before the Patent Office which should be rectified under rule 100.

Reference under section 8

53 This has been put forward on the basis that the filing of the 98 application was not authorised by Mr Brooks and that, as he could have had no intentions concerning it, he was entitled to dissociate himself from it and regard it as a filing in the name of Mr Robinson alone. On that basis it is argued that there is a question concerning entitlement which it is proper for the Comptroller to determine under section 8(1). The relief sought is the filing of a new application under section 8(3) in the name of both Mr Brooks and Mr Robinson, taking the date of filing of the 98 application. Mr Robinson does not contest the reference.

54 The relevant parts of section 8 read:

“(1) At any time before a patent has been granted for an invention (whether or not an application has been made for it) -

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

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

“(3) Where a question is referred to the comptroller under subsection (1)(a) above and -

- (a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;
- (b) any such application is refused under subsection 2(c) above before the comptroller has disposed of the reference (whether the reference was made before or after the publication of the application); or
- (c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference, but after the publication of the application;

the comptroller may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 76 below, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.”

55 As no patent has been granted for the invention of the 98 application, it is argued that an action under section 8(1) is appropriate, and the decision in *Secretary of State for Defence v Young and Chatwin* (BL O/174/01) is put forward as an example of a case where a new application was allowed to be filed under section 8(3) where an earlier application had been refused.

56 In response to matters on which I asked to be addressed, Mr Lunt made the following points, which I accept:

- the lack of authorisation referred to on the part of Mr Robinson related to the situation between himself and Mr Brooks rather than the entitlement under section 7(1) of any person to file a patent application; and

- even though there was no dispute between two parties, it was still possible for them to refer a question to the Comptroller for determination, as was the case in *Greater Glasgow Health Board's Application* [1996] RPC 207.

57 However it seems to me that for the Comptroller to make a determination under section 8(1), there must in view of the wording of that section be some question to be settled as to whether Mr Brooks has a right in the 98 application or an entitlement to be granted a patent on it.

58 I am doubtful whether at bottom there is really any such question underlying this reference. As I have said above, in view of section 7(1) I see nothing to have prevented Mr Robinson from filing the 98 application in the joint names of himself and Mr Brooks, and I consider that the application as filed was effectively in their joint names. I accept that the application was formally defective for want of a signature by Mr Brooks, but I do not think that this carries the consequence that Mr Brooks was not an applicant and had no rights in the application as filed.

59 I do not therefore consider that I should make any order under section 8. It seems to

me illogical for Mr Brooks to claim that he had no rights in the 98 application as filed but that he should have rights in an identical “successor” application under section 8(3). It also seems to me that any such application would simply enable the applicants to circumvent the failure of the application under rule 110(4) and I do not think that can be right.

60 Mr Lunt made the point that if no relief is available under section 8, Mr Brooks is in a worse position through having been named as a co-applicant than he would have been if Mr Robinson had simply gone ahead in his own name. Clearly if Mr Robinson had no rights at all in the invention, and was effectively stealing something which belonged only to Mr Brooks, the way would have been clearer to give relief to Mr Brooks *alone* under section 8. However I think the case argued before me has tended to neglect the fact that Mr Robinson as much as Mr Brooks is entitled to the invention, and so I do not think it would *necessarily* follow that if Mr Robinson had gone ahead with the 98 filing in his own name it would have been any more appropriate to allow a new application to be filed. However these are hypothetical questions, and it is not for me to rule on these. What relief was available in any particular case would depend very much upon the particular facts.

Other considerations

61 Mr Lunt drew my attention to a point arising from *Pelling and Campbell's Applications* (BL O/134/87), a decision relating to an order under section 10 of the Act settling a dispute between joint applicants, that the Comptroller ought to implement the purpose of the Act in the most equitable manner that he can, and that as Mr Lunt put it at the hearing “the most equitable situation is that we must be able to get Mr Brooks’ patent application back”.

62 I do not think there is anything in *Pelling and Campbell* which is of direct assistance to me and Mr Lunt agreed that there was no ongoing dispute between Mr Brooks and Mr Robinson that would call section 10 into play. As to the general point concerning the equity of the situation, whilst I recognise and sympathise with the difficulties that Mr Brooks has been labouring under, the application is not his alone. No suggestion has been made that Mr Robinson is not entitled to a share in it, even though he made no technical contribution. I cannot therefore overlook what Mr Robinson did or did not do. Nor can I overlook the interests of public certainty as to whether an application is in force.

63 I would also make the point that Mr Brooks’ difficulties stem from the decision to entrust the filing of the initial PCT application to Mr Robinson, rather than to seek proper professional assistance. I cannot therefore entirely absolve him from responsibility for what happened and allow him simply to walk away from the wreckage, even though I accept that what happened could hardly have been foreseen in its entirety.

Conclusion

64 I decline to exercise discretion under rule 110(4) or rule 100 to allow the late filing of Patents Form 10/77 to enable application No GB 9820519.8 to proceed, and I make no

order in respect of the reference under section 8. The application therefore remains terminated.

65 In the light of this conclusion it is not necessary for me to make any finding as to the terms appropriate for the protection of third parties, or to give any direction in respect of the incorrect designation of Mr Robinson as an inventor. However, the former matter was argued at the hearing, and I therefore state that if I am wrong in my findings under rule 110(4) or rule 100, I believe it would be appropriate if the application were revived under either rule for terms to be imposed for the protection of third parties in accordance with the usual practice of the Office. Terms would then be imposed from the date that termination was advertised in the Patents and Designs Journal (19 January 2000) to the date that the application under rule 110(4) was similarly advertised (20 January 2002). Mr Lunt accepted that this would be appropriate.

66 Although the possible assignment, if it could be revived, of the 98 application to Uni-Screw Limited was mentioned at the hearing, the matter was not argued. I therefore make no finding as to whether Uni-Screw Limited and/or its other co-director Mr Williams are entitled to any share in the application or the invention.

Costs

67 Costs are not usually awarded in ex parte proceedings before the Comptroller and no costs are sought in respect of the reference under section 8. I therefore make no order for costs.

Appeal

68 This not being a procedural matter, the period for appeal is six weeks.

Dated this 14th day of May 2002

R C KENNEL
Deputy Director acting for the Comptroller

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