

PATENTS ACT 1977

IN THE MATTER OF a reference under section 12 by Philip Trevor Slack and an application under section 13 Simon Philip Slack in respect of international application No PCT/GB00/02176 in the name of Joshua Charles Michael Haigh

INTERIM DECISION

Introduction

- 1 International application No PCT/GB00/02176 entitled “Inducing curls in fibres” was filed on 6 April 2000 in the name of Joshua Charles Michael Haigh (“the defendant”), who was also named as the sole inventor. The application claimed priority from three United Kingdom applications dated 10 July 1999, 18 January 2000 and 23 March 2000. It was published under No WO 01/04395 A1 on 18 January 2001.
- 2 The above reference under section 12 and application under section 13 were filed on 1 August 2001. A common statement of case was filed on 15 August 2001 followed by a brief supplemental statement on 17 August 2001. After protracted correspondence concerning a request for confidentiality in respect of one of the appendices to the statement, which ultimately was not pursued, on 8 March 2002 the Office invited the defendant to file a counter-statement.
- 3 The agents for the defendant wrote on 5 June 2002 saying that they had no instructions to file a counter-statement, and understood that the proceedings would be treated as unopposed. The Office in consequence wrote to both parties on 5 July 2002 proposing, subject to any comments within 14 days, that it would indeed treat the proceedings as unopposed and would decide the matter on the papers on file. No reply has been received from either party, and I will therefore decide the matter on the papers.

The claimants’ case

- 4 The patent application in suit is concerned with inducing curls into spun synthetic fibres prepared by extruding filaments of the synthetic material from a spinneret, drawing them to the required denier, and chopping to the required length. Claims 1, 18 and 26 of the application, to which the claimants specifically draw attention, read as follows (excluding reference numbers to figures):
 - “1. A method of making fibres with a curl comprises (*sic*) causing continuous filaments to pass a heated member whereby a temperature differential across the filaments is induced and subsequently taking lengths of fibre from the filaments whereby the fibres have a curl as a result of the temperature differential having been induced.
 18. A method as claimed in any preceding claim comprising causing the filaments to pass a further member that is cool relative to the heated member after the filaments have passed

the heated member.

26. A method as claimed in any preceding claim comprising causing the filaments to pass an additional member cooler than the heated member prior to the filaments passing the heated member.”

The heating induces a temperature differential across the filaments which are under tension as they are pulled through the subsequent processing apparatus. When they are cut into fibres this tension is released and the unheated portions contract to produce a curl.

- 5 The salient facts of the case as stated by the claimants in paragraphs 1-18 of their statement and in their supplemental statement may be summarised as follows. PTS and SPS had both worked in the manufacture of filaments and fibres for many years, and PTS had been trying during the 1990s to find a way of inducing curls into extruded synthetic filaments. In 1994, whilst working as a consultant, he was able to achieve this by means of a specific design of orifice in the spinneret, which is disclosed in international patent application No PCT/GB96/02512. (This application was published on 17 April 1997 as No WO 97/13898 and names SCS Consultancy Services as applicant and PTS as inventor).
- 6 PTS entered into a working arrangement with Extrusion Systems Limited (“ESL”), of which SPS was a director, to make equipment based upon this development (although the arrangement did not materialise into a full licence agreement). ESL exhibited a machine embodying PTS’ inventions, designated the “Autocrimp”, at an exhibition in Milan in 1995, following which they entered into a contract on 30 March 1996 with a German firm, Teutofillfaser GmbH, to supply an “Autocrimp” machine. According to paragraph 11 of the main statement the machine supplied did not perform to expectations, and was modified in 1997, the modifications being devised by SPS, who was familiar with the machine and the contract and was acting for ESL. However that paragraph concludes with the sentence “The modifications were carried out to the TFF machine by a Mr Ken Pease, at the request of ESL in 1996.”.
- 7 The modifications are stated in paragraph 11 to comprise the leading of the filaments from the spinneret, after passing a cooling air knife (which forms part of the unmodified machine), over a cooling bar, then over a heating bar to heat one side of the filaments, and then over a second cooling bar to cool the heated side of the filaments.
- 8 According to paragraph 13 of the main statement, ESL went into receivership in 1998 and was wound up soon after, and PTS purchased all of the intellectual property remaining in ESL appertaining to “self crimping fibre” including any rights arising from work done by SPS. A copy of the agreement by which this was purportedly effected - about which I will say more later - is provided as Appendix 8.
- 9 Upon a visit to the firm of F Drake of Golcar Limited (“F Drake”), with a view to buying some equipment after the firm had gone into receivership in 2001, PTS saw that the firm possessed an induced curl fibre making line (the “Leo Spring” line) including the same modifications that SPS had made to the “Autocrimp” machine. He was told that it was patented. The claimants allege that the defendant was a director of F Drake

at the time the patent application in suit was filed.

- 10 Shortly after this visit, Paul Jansen, the German agent who had acted as negotiator between ESL and Teutofillfaser for the supply of the “Autocrimp” machine, telephoned PTS to suggest that he should buy the “Leo Spring” equipment from Drake. The claimants allege that Mr Jansen had done a lot to promote the use of “Autocrimp” machinery and fibres in Germany, and was the agent in Germany for F Drake at the time of the contract. They believe that he continued as F Drake’s agent until the firm went into receivership. In response to PTS’s question as to how F Drake had become involved in making induced curl fibres, Mr Jansen said that he had taken the designs and know-how of Teutofillfaser’s machine, including the above modifications, to F Drake who had simply adopted them to make the “Leo Spring” equipment.
- 11 In paragraphs 19-20 of the main statement the claimants allege that only claims 1, 18 and 26 are original compared with common general knowledge in the art, and that the remaining claims are directed to features of common general knowledge and are in some cases absurd or irrelevant. They also allege that the concluding generalisations in the description mean that the defendant does not know what he is alleged to have invented.

Analysis and conclusions

- 12 The proceedings are unopposed, and so I take it that the defendant accepts the facts of the case as outlined above. Even so I consider that on the papers the statement is in some crucial respects incomplete or ambiguous, with the result that the claimants have not sufficiently proved their case on either entitlement or inventorship.

Entitlement

- 13 The above mentioned copy agreement at Appendix 8 is an assignment to PTS of *inter alia* the intellectual property rights in the “Autocrimp” system and improvements thereto, although no details of any specific improvements are given. The assignment is made not by Extrusion Services Limited but by Extrusion Systems (Leeds) Limited (“ES Leeds”) as sole owners of the rights in question, and is signed by both parties. It is also signed by Drakes Engineering Services Limited as warrantor that ES Leeds are sole owners, although I note that this company has the same address as ES Leeds and the same signatures, both apparently with the surname “Drake”, are given on its behalf. It is not stated what relationship, if any, there is between the warrantors and either ES Leeds or F Drake of Golcar.
- 14 If the details of ESL and ES Leeds given in, respectively, Appendix 5 of the main statement (the Teutofillfaser contract) and Appendix 8 are compared, it will be seen that, although both are (or were) based at Drighlington, West Yorkshire, their addresses and company numbers are different. These two companies therefore appear to be distinct entities and, although ES Leeds assign as sole owner of the rights in question, without further details it is not clear to me what rights ES Leeds actually obtained from ESL.
- 15 Indeed it is not clear to me what rights ESL themselves actually had in the “Autocrimp”

system and machinery and its modifications and improvements. The basic concept originated from PTS, and the unmodified Teutofillfaser machine is broadly similar to the arrangements disclosed in the examples in the above mentioned specification No WO 97/13898 . No mention is made in the statement of whether any patent has been granted on this international application (and if so to whom), or whether ESL obtained any rights in or under the invention by virtue of the working arrangement described in paragraph 9 of the statement. I note that both ESL and the named applicants in WO 97/13898, SCS Consultancy Services, give their address as West Street, Drighlington, but again it is not stated what relationship, if any, there is between these entities.

- 16 Further, although the modifications which are at the heart of this dispute are alleged to have originated from SPS “acting for ESL” (paragraph 11 of the statement), it is not clear in what capacity SPS was acting when he made them. It is not stated whether he was still a director of ESL by then, and although he is apparently named (as Simon Slack) in paragraph 5.8 of the Teutofillfaser contract, this is for the provision of his services to train Teutofillfaser in the use of the system. It is therefore not clear whether ESL obtained any rights by virtue of the improvements made by SPS.

Inventorship

- 17 In any case, it is not clear to me what exactly SPS has invented. The modifications described in paragraph 11 of the main statement do indeed correspond to the arrangement shown in Figure 1 of specification No WO 01/04395, the bars being referenced as 18A, 16 and 18 respectively. These features correspond to claims 1, 18 and 26 of the application in suit.
- 18 However, the supplemental statement includes two Appendices, 6A and 7A, comprising drawings of the modified and unmodified machine prepared by SPS from his own knowledge and information. If these are compared, it will be seen that the differences consist of the addition of members described as a “heated contact plate” and a “chilled recooling plate” corresponding to features 16 and 18, and the omission of a heating oven further down the processing chain. No modification corresponding to the first cooling bar or plate 18A is shown: although the filaments are passed around a chilled contact pipe or roller before reaching the heated plate, this feature was already present in the unmodified machine (as is also apparent from the details and drawings of the unmodified machine shown in Appendices 4, 5 and 6 accompanying the main statement). The use of a cold roller or a cylindrical or flat cold surface in this way is described in the “Autocrimp” specification WO 97/13898, for instance at page 8 and in Example 1.
- 19 Although this might be taken to suggest that SPS invented at least the heating member which is the invention described and claimed in the application in suit, the position is somewhat confused by the concluding sentence of paragraph 11 of the statement which I have quoted above, which sits oddly with the remainder of the paragraph. What it does not to my mind make clear is whether “the request of ESL in 1996” was the request which led to the work allegedly done by Mr Slack, or whether it was a separate request to Mr Pease who may in consequence have made some contribution of his own to the modifications.

Paragraphs 19-20 of the main statement

- 20 It is not clear to me what the claimants are trying to establish by these allegations, and I do not in any case think that I need to place any reliance on them. If they are intended as a comment on validity or patentability, then that is not a matter for determination in entitlement proceedings. If they are intended to show that the defendant lacks any entitlement, I cannot see anything in the drafting of the claims and description from which this might be inferred. I observe that (i) whether or not the claims in question relate to conventional features, these features are not claimed independently; and (ii) the passages referred to in the description, even if unclear in meaning, seem to be nothing more than “catch-all” paragraphs of the type frequently employed when drafting patent specifications. I am surprised, though I place no weight on it, that the claimants appear to be suggesting that claim 43 lacks originality, since it is a claim to apparatus whose features correspond the steps of the method recited in claim 1.

Subsequent procedure

- 21 In the event, even though the proceedings are unopposed, I do not consider that the facts put forward by the claimants are sufficient for me to find in their favour, either on entitlement or on inventorship. However, many of the difficulties would seem to arise from the association of the claimants with a number of companies whose inter-relationship is unclear, and I believe it appropriate in the particular circumstances to give them an opportunity to clarify the matters which I have mentioned above.

- 22 I therefore give the claimants a period of **four weeks** from the date of this interim decision to file an amended or supplementary statement and/or evidence clarifying:

- how ESL became entitled to the rights in the modified “Autocrimp” system and machinery;

- how ES Leeds then obtained these rights from ESL;

- what modifications to the Teutofillfaser machine were made by SPS and in what capacity; and

- whether any inventive contribution was made by Mr Pease,

failing which I will issue a final decision finding against the claimants.

- 23 If an amended or supplementary statement or evidence is filed, then, even though the proceedings are at present unopposed, the defendant will be given an opportunity to comment and to file a statement and/or evidence. Further directions will then be given as to the subsequent procedure.

Relief sought

- 24 The relief which the claimants ask for is that the application should proceed in the name of PTS as sole applicant and that SPS should be named as the sole inventor, in each case instead of the defendant. I will defer determination of this until the issue of a final

decision in these proceedings. However, I observe that the defendant's agent in his letter of 5 June 2002 states that to the best of his knowledge, the application "has not been implemented in any national or regional countries". If this means that it has not entered any national or regional phase under the Patent Cooperation Treaty, the period normally prescribed for such entry will by now have expired for most, if not all, designated national and regional phases. *In that event, unless it can be revived under the appropriate national or regional law, the international application will fall to be treated as withdrawn, and this may well limit the relief available under sections 12 and either 13(1) or - see below - section 13(3).*

25 I also observe that the application under section 13 has been made under section 13(1), which relates only to the right to be mentioned as an inventor. If, as is the case here, there is an allegation that a person ought not to have been named, then section 13(3) provides for an application to be made to the comptroller for a certificate to that effect.

26 I will therefore give the claimants an opportunity, within the period of four weeks mentioned above, to confirm whether or not they are intending to proceed under section 13(3) as well as section 13(1) and to amend their statement if necessary. The defendant will be given an opportunity to comment on any such amendment.

Costs

27 The claimants ask for costs, and this is not opposed by the defendant. However, I will defer any award of costs until the issue of a final decision.

Appeal

28 This is not a procedural matter and the period for appeal is therefore six weeks.

Dated this 20th day of September 2002

R C KENNEL

Deputy Director acting for the Comptroller

THE PATENT OFFICE