



BL O/301/04

30 Sept 2004

PATENTS ACT 1977

BETWEEN

Ancon Limited

Claimant

and

Zdzislaw Jozef Szewczyk

Defendant

PROCEEDINGS

A reference under Section 37 in respect of
entitlement in Patent Number GB2355026 B

HEARING OFFICER

S N Dennehey

DECISION

Introduction

- 1 Patent number GB 2355026B entitled “Construction Fixings” was granted on 23 January 2002 to Zdzislaw Jozef Szewczyk who is named as inventor and proprietor. Mr Szewczyk (“the defendant”) had previously been employed by Ancon Limited and, on 1 February 2002, the company initiated a reference under section 37(1)(a) of the Patents Act 1977 (“the Act”). The grounds of this reference were that, under the provisions of section 39(1)(a) of the Act which deals with employees’ rights, the invention in GB 2355026B rightfully belonged to Ancon Limited (“the claimants”). Inventorship is not in dispute.
- 2 The filing of a statement (as amended), counterstatement and supporting evidence followed the normal pattern. The claimants’ evidence in chief comprises a witness statement by Mr Aidan Chippendale as the Development Manager at Ancon Limited. This is accompanied by 21 exhibits. The defendant’s evidence comprises a witness statement by Mr Szewczyk and nine exhibits. Evidence in reply comprises a second witness statement by Mr Chippendale with nine exhibits, and a witness statement by Mr Graham Law, as the Technical Manager at Ancon Limited.
- 3 The matter duly came before me at a hearing, at which Mr Daniel Alexander, instructed by Murgitroyd & Company, appeared as Counsel for the claimants. Mr Szewczyk, who

had been represented by Franks & Co for most of the pre-hearing stages, represented himself at the hearing. Mr Alexander and Mr Szewczyk both supplied skeleton arguments ahead of the hearing.

Preliminary Points

- 4 Before considering the substance of this case, I shall note the outcome of two preliminary points I dealt with at the hearing. The first concerned an application from Mr Szewczyk to cross-examine Mr Graham Smith. Mr Szewczyk had written to Murgitroyd & Company on 18 November 2002 requesting that the claimants arrange for Mr Smith, one of their employees who was referred to in evidence, to attend the hearing as a witness. This request was rebutted by the claimants in a letter dated 15 January 2003. They argued that, as Mr Smith had not filed a witness statement, and as the first reference to Mr Smith was to be found in Mr Szewczyk's witness statement of 8 August 2002, they themselves had not introduced any hearsay evidence from him into the proceedings, so the comptroller had no discretion to permit Mr Szewczyk to call Mr Smith for cross-examination. They pointed in particular to the wording of rule 103(6) of the Patents Rules 1995 as amended, which refers to the situation where a party adduces evidence of a statement made by a person otherwise than while giving oral evidence. In such circumstances, the comptroller has discretion to "permit any other party to the proceedings to call that person as a witness and cross-examine him....". The claimants pointed out that, in the present circumstances, Mr Szewczyk was the party adducing evidence and Ancon Limited were "any other party".
- 5 At the hearing, Mr Szewczyk said that Mr Smith would have been a crucial witness as he himself had been unable to go into the claimants' files to get evidence. This was countered by Mr Alexander who argued that, at the time the evidence was being adduced, Mr Szewczyk had been represented by patent agents who could have invoked disclosure procedures if they had seen fit. There was, in any case, no legal basis for Mr Smith to be called for cross-examination.
- 6 Having considered the matter, I decided at the hearing that there was indeed no reasonable basis on which I could order that Mr Smith should be called to give evidence, and I declined to do so.
- 7 The second preliminary issue concerned the statement of Mr Michael Wells filed as exhibit ZJS 1 to Mr Szewczyk's witness statement. In his skeleton argument, Mr Alexander had called into question the admissibility of this evidence since it related to the situation regarding the duties of Mr Szewczyk when he was first employed by the company in 1987, well before the time when material events were taking place. Mr Alexander did not press the point at the hearing however, and accepted that the status of Mr Wells' evidence was more a matter of weight than admissibility.

Cross-Examination of Witnesses

- 8 Two witnesses were cross-examined during the course of the hearing: Mr Szewczyk and Mr Chippendale.
- 9 The experience of giving oral testimony was clearly something of an ordeal for Mr

Szewczyk. That is quite understandable and natural. For the most part, he remained calm and considered under cross-examination, although he did on occasion allow grievances he had with his previous employers to rise to the surface. Mr Szewczyk is, it seemed to me, a highly experienced and skilled engineer though his modesty did not allow him to admit as much on the witness stand. He came over as a proud man who applies exacting standards in his work and is precise in his use of words. This, at times, made him seem a little pedantic in the way he answered questions posed by Mr Alexander, but I am sure this was due to his cautious nature and desire to get things absolutely right and not from any desire to be obstructive. Nevertheless, on occasion, Mr Szewczyk's testimony was a little inconsistent.

- 10 Mr Chippendale also gave me the impression of being very experienced in his work and highly knowledgeable in his field. All his responses under cross-examination were considered and measured, even when Mr Szewczyk's questioning became a little heated. He struck me as an honest and open witness, preferring to admit when he was genuinely unable to bring to mind a particular fact rather than attempt an answer to every question come what may.

Chronology

- 11 It will be helpful to describe briefly the chronology of events which culminated in the filing of the application for the patent in suit.
- 12 Mr Szewczyk joined the company (formerly known as Ancon Stainless Steel Fixings Limited and Ancon CCL Limited) in January 1987. During the early 1990's there was what Mr Alexander referred to at the hearing as a "development push" in the company. This resulted in a number of patent applications being filed, several of which named Mr Szewczyk as inventor or co-inventor. Of particular interest in these proceedings is a family of patents co-invented by Mr Szewczyk, numbered GB 2255358B, GB 2260348B and GB 2260349B, which were granted in 1995 for what became known as the "ST1" wall tie. (For convenience, and where appropriate, I have adopted that term in this decision.) It is common ground that this development activity rather fell off after 1996, but some product development continued nonetheless, and when it became apparent in 1999 that the performance of the ST1 was over-specification, effort was put into developing a simpler version requiring less material in its manufacture. At the end of August in the same year Mr Szewczyk tendered his resignation and, soon after leaving the company, he made his application for the patent in suit.

The Law

- 13 These proceedings have been brought under section 37 of the Act which deals with determination of the rights to a patent after grant. The important part for the present proceedings is section 37(1) which states:

"37(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question -

(a) who is or are the true proprietor or proprietors of

the patent,

- (b) whether the patent should have been granted to the person or persons to whom it was granted, or*
- (c) whether any right in or under the patent should be transferred or granted to any other person or persons;*

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

- 14 The grounds argued by the claimants for making the reference under section 37 are that they have the right to the invention under the provisions of section 39(1)(a) which reads:

“39(1) 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”*

- 15 Section 39(2) goes on to say:

“39(2). Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.”

- 16 In order to reach a determination on these grounds, I need to decide *inter alia* what the invention in the patent in suit actually is and, in so doing, it is settled law that I should construe the term “invention” in its broadest sense of that which has been invented, without regard to any particular form of claim.

- 17 To assist me in my deliberations, both parties referred me to *Harris's Patent* [1985] RPC 19 where the Patents Court held that the expression "an invention" in s.39(1)(a) cannot mean any invention whatsoever. It must be an invention which achieves or contributes to the aim or object to which the employee's efforts in carrying out his duties were directed. It was also held that an employee's normal duties were the actual duties that he was employed to do.

- 18 Finally I should mention that the onus is on the claimants to show that they are entitled to the relief sought which, in the present case, is to be named as sole proprietors of the patent in suit.

The patent in suit

19 The patent in suit, GB 2355026B, concerns a construction fixing in the form of a wall tie for tying cavity walls together or a frame cramp for tying an external wall to a non-masonry board. Earlier wall ties are said to use excessive amounts of material in their manufacture and ties of the ST1 type are referred to in this regard. Other considerations are that the tie should be free of dangerous edges, enable the passage of falling debris while preventing transfer of moisture, have end portions which will resist pull-out and be inexpensive to manufacture. Numerous objects of the invention are listed in the patent specification, including one of providing a construction fixing which utilises less metal than prior art fixings.

20 The granted patent has two independent claims which read as follows:

Claim 1: A construction fixing comprising an elongate substantially planar metal member having a central region defined between a first and a second end, said first and second ends each being configured for anchoring to a structure, wherein said central region comprises a bend formed about an axis extending along the length of said region, said bend thereby effecting said region to further comprise longitudinal sides inclined transversely to said plane; and at least one of said first and second ends comprises a portion comprising an expanded slit, said portion being configured to function as a keying structure.

Claim 16: A method of making a construction fixing from a substantially elongate planar metal member having a main length, said method comprising the steps of: slitting said elongate member substantially at regions towards the ends of said member; bending said member along first bend axes located substantially at the inner ends of said slits, said axes being transverse to said main length of said elongate member and said axes subsequently defining a central region of said member; and bending said member about a second axis which is substantially parallel to said main length and which is located substantially centrally along said main length.

21 As mentioned previously, in reaching a decision on what is the invention for the purposes of section 39(1) I have to construe the term “invention” in its broadest sense of that which has been invented, without regard to any particular form of claim. That said, having carefully read the specification of the patent in suit in its entirety, I have reached the conclusion that there are two inventions in the patent - the construction fixing as defined in claim 1 and the method of making a construction fixing as claimed in claim 16 - albeit that they form a group which are so linked as to form a single inventive concept.

Substantive Issues

22 I now turn to the substantive issues on which I have to reach a decision. In order for the claimants to make their case under section 39(1)(a), they must satisfy me on three counts. First, they must satisfy me that Mr Szewczyk was in their employ at the time he made the inventions I have identified. Second, they have to persuade me that the two inventions were made in the course of Mr Szewczyk’s normal duties or other duties specifically assigned to him. Finally, they must satisfy me that the circumstances were such that an invention might reasonably be expected to result from the carrying out of

those duties. I shall deal with each of these issues in turn.

Was Mr Szewczyk in the claimants' employment when he made the inventions?

- 23 In the statements of case and the written evidence, there was some disagreement regarding the circumstances in which Mr Szewczyk left the company. In their statement initiating these proceedings, the claimants state that Mr Szewczyk tendered his notice of resignation at the end of August 1999 and that, as a month's notice needed to be served, his employment terminated on 28 September 1999. His application for the patent in suit was made just 7 days later, on 5 October 1999.
- 24 In his counter-statement however, Mr Szewczyk claims that he handed in his notice on 1 September and was told the same day not to work his notice period of 4 weeks. He backs this up with a copy of a letter dated 1 September 1999 from Mr Altman, the Managing Director of the claimants, part of which reads "take today to say farewell to your colleagues, and take the rest of your notice period on leave." For my part, I think this comment could bear a number of interpretations.
- 25 However, it seems to me that this particular disagreement between the parties is something of an irrelevance to the present proceedings since it is admitted in paragraphs 9.1 and 9.3 of Mr Szewczyk's counter-statement and in his witness statement that he arrived at the invention disclosed in the patent in suit in June 1999 while he was employed at Ancon Limited. I do not believe, therefore, that it will be of any assistance to attempt to delve into the exact situation regarding the conclusion of Mr Szewczyk's employment in the company during the month of September 1999.
- 26 I conclude, then, that Mr Szewczyk was in the claimants' employment when on his own admission he made the inventions in June 1999.

What were Mr Szewczyk's normal duties at the relevant time? Were other duties specifically assigned to him?

- 27 In the normal course of events, one might expect to turn first to an employee's written contract of employment for assistance in determining the nature of his normal duties. Unfortunately, this is not possible in the present case. It is common ground that for some years following Mr Szewczyk being taken on by Ancon CCL Limited in January 1987, he had only an oral contract of employment. In his first witness statement, Mr Chippendale claims that this changed in January 1994 following restructuring in the company when all employees were given new written contracts of employment. In support, he exhibited a specimen contract (GC7) and a signed receipt (GC1) but neither of these pertained specifically to Mr Szewczyk. In Mr Szewczyk's counter-statement it is stated that "at no time did Mr Szewczyk have a written contract of employment...". I note that this is tempered somewhat in Mr Szewczyk's witness statement where he states in paragraph 9 that he is "not sure" whether he had such a contract. Nonetheless, the fact remains that no such contract has been put in evidence by either side.
- 28 In an effort to shed light on the exact nature of his duties, I have carefully considered the great deal of documentary evidence concerning Mr Szewczyk's work, his job titles, and his rates of pay during his time at Ancon Limited, and these issues were the subject of

much argument and counter-argument at the hearing itself. According to the signed statement of Mr Wells at exhibit ZJS 1 of Mr Szewczyk's witness statement, when Mr Szewczyk was initially taken on by Ancon in 1987, it was as a toolmaker and he was not employed to make or invent new products. Nonetheless, it is accepted by both sides that Mr Szewczyk had an inventive mind which led to several patent applications being applied for by the claimants in the early 1990's naming him as inventor or co-inventor.

- 29 Mr Szewczyk says the fact that he went on to invent new products was as a result of his own personal nature rather than being employed to do so and he was never rewarded for having done so. The other side see things rather differently. According to Mr Chippendale's first witness statement, Ancon is a "multi-functional" firm in which all employees are encouraged to generate their own ideas. Several are said to have been named as inventors on the company's patents. It has no research and development group as such, R&D being just one of many responsibilities of Mr Chippendale himself and the technical manager, Mr Law. He points to internal "Personnel Change Notification Forms" for the period 1994 to 1998 which indicate Mr Szewczyk's job title as "project engineer", this being a "staff" position. In addition, from 1997 he was a "tool room supervisor". These change notification forms appear in the evidence as Exhibits GC 2 to 6. Mr Chippendale draws attention to an inventor questionnaire signed by Mr Szewczyk and exhibited at GC 8, describing Mr Szewczyk as a "project engineer" and his normal duties as including "new products" at the time in 1990 when he invented a product known as the "Omega Channel" for the company. In his evidence, Mr Chippendale also refers to Exhibits GC9 to 17, which are brief minutes of "new product development meetings" held in 1993 to 1994 allegedly showing Mr Szewczyk's involvement in development projects. These meetings were allegedly held regularly up to 1996, to provide updates on all ongoing development projects.
- 30 When cross-examined by Mr Alexander concerning the change notification forms, Mr Szewczyk refused to accept that he had been promoted to a staff position as project engineer. He said that job titles in the company were, as he put it, "loosely given" and that he had been forced to move from "works" to "staff" pay by the managing director. However, when questioned on the inventor questionnaire at GC 8 describing him as a "project engineer", he accepted that what was stated on the form was true, though he insisted that it had been put in front of him on the shop floor when he was busy, the implication being that he had not known exactly what he was putting his name to. When questioned about a second inventor questionnaire he had signed in 1994, exhibited at 2GC 3 to Mr Chippendale's second witness statement, he accepted as true statements on the form indicating that he was working as an engineer on the Brick Support project as part of his normal duties when he made that invention, though he seemed to find it difficult to accept that the brick support constituted an invention at all - it was "just a tooling issue" as he put it. I think this is a good example of Mr Szewczyk having in his mind a clear and narrow idea as to what constituted "invention", and how he felt that label did not properly apply to what he was doing. This is something I shall return to.
- 31 Turning to the new product development meetings, Mr Szewczyk readily accepted that he attended such meetings but only in his capacity as a toolmaker to advise on tooling matters. Mr Alexander drew attention to a reference in the minutes of the meeting of 26 October 1993 at Exhibit GC 9 which had Mr Szewczyk down as a "core member" of the Product Development Group. Mr Szewczyk accepted that it had been intended that he

should be a member, as distinct from a core member, but that this had, in fact, never materialised. In Exhibit GC 14, Mr Alexander pointed to a reference to Mr Szewczyk holding a brainstorming session on the so-called Briclok Alternative project. Again, Mr Szewczyk insisted that he was just there to advise on engineering issues.

- 32 Having carefully reviewed this part of the documentary evidence and oral testimony in detail, I am persuaded, on the balance of probabilities, that in the early 1990's, Mr Szewczyk's normal duties extended to an involvement in inventing new products for the company. In reaching this conclusion, I have found the evidence regarding pay of little persuasive force. More significant to my mind are the acknowledged inventive nature and engineering skills of Mr Szewczyk, his job titles, his attendance at new product development meetings on a regular basis and especially the fact that he is named as inventor or co-inventor on several of the company's patent applications filed from 1991 to 1995 including those for the ST1 and the Brick Support. The clear implication is that the major inventive input into these projects was his. I believe that in his position as a highly competent engineer and an experienced toolmaker with a flair for new ideas in a relatively small company which had a keen eye on innovative products, he was involved in developing new products for the company, and that this was part of his normal duties.
- 33 It might be natural to assume that the nature of Mr Szewczyk's duties would remain the same into the second half of the 1990's but I have to consider a number of significant factors that came into play at around this time. Mr Szewczyk's assertion in his skeleton argument and at the hearing is that he was excluded by the claimants' "new management" from input to new product invention from 1994 to 1999. It is apparent from the evidence that, as time progressed and the company expanded, Mr Szewczyk began to assume a less prominent role in what had become a more team-oriented approach to development. The Personnel Change Notification Form dated May 1997 exhibited at GC 5 refers to Mr Szewczyk needing "to work upon his teamwork skills and accept that other people have ideas too". Mr Szewczyk accepted under cross-examination that he tended to be more of a lone worker than a team player.
- 34 A second, perhaps more significant factor is that, in late 1996, Mr Chippendale was taken ill and had to take time off work. Mr Chippendale explained under cross-examination that, as a result, product development at the company waned somewhat and the regular "new product development meetings" more or less ceased. However, individual project meetings continued to be held as and when possible, and Mr Chippendale said that, to the best of his recollection, Mr Szewczyk had attended some of these, although he admitted he had no documentary evidence to corroborate that. Mr Chippendale insisted that Mr Szewczyk had continued to be involved in product development. For example, on one particular project he had made channel test blocks and had been involved in discussions about anchorage lugs. On the project which resulted in the patent in suit, Mr Chippendale said he was "99% certain" there had been discussions with Mr Szewczyk about what he felt could be done to modify the ST1 wall tie, particularly from the point of view of the tooling. He was the expert on the tooling - the only one in the company - and Mr Chippendale would be "absolutely amazed" if Mr Szewczyk were not aware that modifications were being considered - it was "his baby". This version of events was strenuously denied by Mr Szewczyk who refused to accept that the patent in suit had anything to do with a modification of the ST1 wall tie. In his

eyes, his invention concerned a completely new method of making a wall tie and he had conceived the idea in his own time.

- 35 It is worth mentioning at this point that Exhibit GC 18, which is a note of a product development meeting held on 8 May 1997, refers to Mr Szewczyk being asked, in respect of the ST1, to modify samples to show new drip notches and, in respect of the “2-Part Tie”, to modify and test samples and produce tooling. In his witness statements, Mr Chippendale asserted that Mr Szewczyk’s involvement in the “2-Part Tie” project included introducing a longitudinal stiffener and, in his opinion, amounted to far more than that of a mere toolmaker. Mr Law, in his witness statement, confirms that Mr Szewczyk suggested a change to the profile of the tie. In addition, I think it is notable that the Personnel Change Notification Form dated May 1998 exhibited at GC 6 refers to Mr Szewczyk’s “innovative contribution” being invaluable. Under cross-examination by Mr Alexander, Mr Szewczyk was unwilling to accept comments on this form concerning his time keeping, but he did accept the remainder.
- 36 In cross-examination, Mr Alexander asked Mr Szewczyk whether, at any time, he had refused when he had been asked to participate in product development. Mr Szewczyk said he had not. It was his job to “do the engineering” and he could not refuse to do his job. He also said he had participated, “on the engineering side” as he put it, after 1994. When pressed by Mr Alexander about whether this extended to product development, Mr Szewczyk said it did not really matter what it was - he could not refuse the engineering function because it was part of his job.
- 37 Mr Alexander went on to ask whether Mr Szewczyk would have refused to attend product development meetings after 1996 had he been invited. Mr Szewczyk confirmed that he would have attended and considered it part of his job. I must say I have difficulty with this particular line of questioning. No evidence has been adduced that the company invited Mr Szewczyk to product development meetings after 1996 and I find hypothetical questions regarding whether Mr Szewczyk would have attended had he been asked of little assistance to me in my task of deciding what were the nature of Mr Szewczyk’s actual duties. What matters is what Mr Szewczyk’s normal duties were in the circumstances that pertained, not what his reaction might have been had the circumstances been different.
- 38 That said, having considered the circumstances and all the evidence on the matter, I am persuaded that, on the balance of probabilities, Mr Szewczyk’s actual duties in the late 1990’s, and in particular when the inventions under consideration were made, continued to involve a degree of product development. I accept that the extent of his involvement was probably less than in the early years when his rather single-minded approach to new ideas had resulted in him inventing several new products. I also accept that, in Mr Szewczyk’s eyes and in his terminology at least, his later contributions had been more “on the engineering side” than in what might be called pure product research and development. His was, I believe, an inventive contribution nonetheless, and I think others around him in the company viewed his role in that light, even though he would not describe it in those terms himself. Mr Szewczyk admitted that he had participated in development after 1994 and that, as long as there was “an engineering function”, his involvement would extend to product development. There is evidence of Mr Szewczyk being asked to modify and test samples, and produce tooling, in 1997 in the context of

a product development project based on the 2-Part Tie. In addition, there is documentary evidence of acknowledgement from the company of his continuing and invaluable “innovative contribution” in 1998.

39 As I have found that Mr Szewczyk’s normal duties at the relevant time included an involvement in product development, and hence invention, I do not need to decide whether any other relevant duties were specifically assigned to him. However, for completeness I should mention that there were no submissions from either side on this point.

The circumstances surrounding the making of the invention

40 I now turn to a consideration of the circumstances that pertained when the inventions of the patent in suit were made. In particular, I need to decide whether the circumstances were such that an invention might reasonably have been expected to result from Mr Szewczyk carrying out his normal duties at the relevant time, and whether the inventions that did result were such as to achieve or contribute to the aim or object to which Mr Szewczyk’s efforts, in carrying out these duties, were directed.

41 In their statement initiating these proceedings, the claimants indicate that when it was noted, around the summer of 1999, that the performance of the ST1 wall tie was in excess of requirements, modifications were discussed within the company and Mr Szewczyk was consulted on the viability of making changes to the tie while retaining the existing tooling.

42 This was denied by Mr Szewczyk both in written evidence and under cross-examination. He claims that while he was occasionally asked by the development engineers to make clearly instructed minor modifications to products they had conceived, no such activity was requested in connection with the ST1 or any other wall tie at around the time he first conceived his idea. The last time he had any involvement with the ST1 was when he visited the North Wales site in April 1999 to check on the tooling and resultant quality of the product being produced. He claims the development engineers’ approach was to shave down the ST1 as much as possible, but he looked at the matter again and, quite by chance when he accidentally trod on a car aerial, came up with the idea of slitting material to form a new type of wall tie. In his view, his inventions were not a modification of the ST1 but a completely new departure. He developed his idea in his own time and on his own premises. As Mr Alexander pointed out, however, simply being off the claimants’ premises is not in itself sufficient if the subject of Mr Szewczyk’s thoughts fell within the scope of his normal duties for the company.

43 In his second witness statement, Mr Chippendale argues that, even if Mr Szewczyk arrived at the invention in the manner alleged, without his employment by the company, whose significant activities included the manufacture of wall ties, he would not have associated a split car aerial with a new way of making a wall tie. There had been two modifications to the ST1, the first being a modification of the drip notch in 1997 which, as evident from Exhibit GC 18, had involved Mr Szewczyk, and the second in 1999, which was the modification regarding shaving the girth of the tie. Mr Chippendale says that Mr Szewczyk produced the vast majority (if not all) the designs, sketches and drawings for the tools which he and his fellow tool-makers made and argues that Mr

Szewczyk's trip to the North Wales site in 1999 indicated his involvement in ST1 tooling at the relevant time. It would, he argues, be surprising if Mr Szewczyk had not been aware of the project to shave the girth of the ST1.

44 Under cross-examination, Mr Chippendale explained that when the company started looking at how they might reduce the material used in the ST1, the project would have been handled as usual, by one person championing the project and calling on the skills and expertise of others at any stage as necessary. He was "99% certain" there had been discussions with Mr Szewczyk about what he felt could be done to modify the ST1 wall tie, particularly from the point of view of the tooling. Mr Szewczyk was the expert on the tooling - the only one in the company - and he would be "absolutely amazed" if Mr Szewczyk were not aware that modifications were being considered - it was "his baby".

45 Having reviewed all the evidence, a picture emerges to me of Mr Szewczyk continuing to be closely involved in the tooling and engineering side of the company's wall tie business in the time leading up to when the inventions were made. In 1997, for example, he was involved in modifying the ST1 wall tie to provide new drip notches. As late as April 1999, he was visiting the North Wales site to check on the ST1 tooling and quality. In Mr Szewczyk's eyes, these activities amounted to no more than him taking instructions and carrying them out according to well-defined guidelines. He sought to persuade me that, by 1999, he had been completely excluded from the process of developing new ideas, but I believe this is not an objective or accurate view of the situation, perhaps in part stemming from Mr Szewczyk's own modesty regarding his continuing worth to the company and his perception of what constitutes product development. In this regard, I note that under cross-examination he accepted both that his job was "engineering and therefore it was tooling, anything to do with manufacturing", and that "manufacturing considerations are an important part of the product design process". I am inclined to accept the claimants' assertion that the patent application was at its root prompted by their desire to modify the ST1 wall tie. It is, to my mind, of less importance whether the inventions which resulted are properly categorised as a modification of the ST1, as the claimants have said, and as the terms of the patent suggest, or a completely new product and method as Mr Szewczyk would have it. Of greater significance, in my view, is that the subject matter of the patent and its inventions, as defined in claims 1 and 16, is exactly in the field the employer was working on at the time. Bearing in mind his expertise as a tool maker, the depth of his knowledge in the company's core business of wall ties generally, and the ST1 in particular, his continuing detailed involvement in the engineering, tooling and manufacturing side of the business, and his acknowledged innovative skills, I am persuaded that his involvement in the work to reduce the amount of material used in the ST1 in the course of his normal duties extended beyond merely working to clearly defined instructions and was such that an invention might reasonably be expected to result. I am also persuaded that the two inventions that did result were such as to achieve or contribute to the object being pursued by his employer of reducing the material in the ST1 and with which Mr Szewczyk's normal and actual duties were involved.

Summary

46 I have found that Mr Szewczyk arrived at the inventions disclosed in the patent in suit

while he was employed at Ancon Limited and that his normal duties at the relevant time included product development which involved him in making inventions. I am persuaded that his involvement in the work to reduce the amount of material used in the ST1 wall tie was such that an invention might reasonably be expected to result, and I have found that the two inventions that did, in fact, result were such as to achieve or contribute to the object of reducing the material in the ST1 with which Mr Szewczyk's efforts, in carrying out his normal duties, were involved.

- 47 Having reached the conclusion that the requirements of section 39(1)(a) are met, I find that the inventions in GB 2355026B belong to the claimants, Ancon Limited.

Order

- 48 To give effect to my finding, I order that ownership of GB 2355026B shall be transferred to Ancon Limited. A notice to that effect will be inserted in the *Patents and Designs Journal* and the change of ownership will be recorded in the Register of Patents. A reprinted version of the patent will also be prepared and published in due course.

Costs

- 49 As I explained to Mr Szewczyk at the hearing, it is long-established practice for costs awarded in proceedings before the comptroller to be guided by a standard published scale. The scale costs are not intended to compensate parties for the expense to which they may have been put but merely represent a contribution to that expense. In submissions on costs, both sides have indicated that they would be content for costs to be awarded on the usual scale and I do not see any reason for departing from the normal arrangement in the present case.

- 50 Applying the scale, bearing in mind the relatively modest amount of evidence submitted and taking all other circumstances into consideration, I order that the defendant, Mr Szewczyk, shall pay the sum of £1,000 to the claimants, Ancon Limited, as a contribution to their costs. This sum should be paid within seven days after the expiry of the period for appeal against this decision, except that if an appeal is lodged, payment is suspended pending the outcome of the appeal.

Appeal

- 51 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal against this decision must be filed within 28 days after the date of this decision.

S N DENNEHEY

Director, acting for the Comptroller