



BL O/377/04

29 December 2004

## PATENTS ACT 1977

BETWEEN

Glasgow School of Art

Claimant

and

Saquib Ibrahim

Defendant

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PROCEEDINGS

Reference under section 8(1)(a) of the Patents Act 1977 in  
respect of patent application number GB 0220610.0

HEARING OFFICER

R C Kennell

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## DECISION

### Introduction

- 1 The patent application in suit entitled “3D Optical Computer Device” was filed on 5 September 2002 in the name of Saquib Ibrahim.
- 2 The above reference was filed on 10 October 2003, accompanied by a statement. The defendant has filed a counter-statement and the claimant has filed evidence. When filing its evidence, the claimant also sought leave to introduce a supplementary statement of case with a view to admitting certain matters in the counter-statement but adding further explanation to rebut other matters. The claimant also sought confidentiality for one item of evidence.
- 3 The Patent Office wrote to the parties on 1 April 2004 proposing to stay the filing of evidence by the defendant until these matters had been resolved. However on 8 April 2004 the defendant wrote to the Office withdrawing from the entitlement proceedings in the light of the results of the official search under section 17 of the Patents Act sent to him on 16 February 2004. In a further letter dated 14 May 2004, the defendant said that his decision to withdraw was not based on the merits of the entitlement issue. As I understand the letter, the defendant wishes to maintain the case set forth in his counter-statement but not to file evidence, and I will proceed on that basis.

- 4 The Office has confirmed in correspondence that irrespective of the withdrawal of the defendant, the application will not be refused, withdrawn or taken to be withdrawn until the proper owner has been determined, and that publication of the application is accordingly stayed. This is in line with its practice to avoid taking any irrevocable action which might be to the detriment of the claimant if subsequently found to be entitled (see paragraph 8.10.1 of the “Manual of Patent Practice”).
- 5 In the absence of any comments from the defendant, following his withdrawal, on the Office’s proposal in its letter of 1 April 2004, the supplementary statement has been admitted into the proceedings and, with the agreement of the claimant, entitlement is to be decided on the basis of the papers on file. In subsequent correspondence both parties have made submissions on the matter of costs. To some extent this correspondence touches on the substantive issues underlying the dispute, but I confirm that I have taken account of it only to the extent that it bears on the costs to be awarded.

### **Background and statements of case**

- 6 The dispute arises because the defendant has filed in his own name a patent application to which the claimant believes itself entitled as the defendant’s employer. The filing of the application came to light shortly after the defendant was asked on 13 August 2002 to write a technical description of the idea underlying the invention in support of a grant application. The defendant was suspended from his employment on 18 August 2002 for refusing to do this and was eventually dismissed on 9 October 2003 for gross misconduct, including the filing of the application in his own name. I should however make it clear that the defendant denies that he refused to write the description and says that he was seeking to resolve a possible conflict of interest if he did so; and also that the defendant does not accept the grounds for his dismissal.
- 7 The claimant alleges that at the time of the above events the defendant was employed as a research programmer and systems integrator at the Digital Design Studio (“DDS”), part of the Glasgow School of Art, and was therefore an integral part of DDS’ research activity concerning customised 2D and 3D human-computer interfaces, and development of inventions and concepts leading to inventions was part of his normal duties within DDS. The claimant says that although it has not seen the patent application, its title suggests that the defendant is seeking to patent on his own behalf an invention that falls within this area and relates to a concept that DDS was actively researching; and that it therefore belongs to the claimant by virtue of section 39(1) of the Act, which states:

“Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if -

- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) ...”

8 The defendant however denies that such development was part of his normal duties. He says that these could be summarised as integrating software with hardware devices or tools which were commercially available and required no customisation or modification; and that his role in research was limited to commissioning such equipment and providing technical support and basic software development. He states that the patent application relates to a hardware device, and DDS had never been involved in development of or research into hardware. Although the defendant admits to involvement in meetings of various research groups at DDS, he says that research was not carried out at these meetings and they were concerned essentially with settling research agendas and their funding.

9 The defendant says that he never received a copy of the job description “Systems Administrator and Researcher” referred to in his contract of employment effective from 1 October 1998, or a new contract or job description when his job title was amended from to “Research Programmer and Systems Integrator” just before the previous contract expired. I should mention that the earlier contract (a copy of which was supplied by the defendant) is in fact dated 15 September 1999, but refers to continuous employment since 1 October 1998.

10 The defendant’s view of the genesis of the invention is given in paragraph 3.1 of the counter-statement, the relevant part of which reads:

“Mr Ibrahim had an idea involving infrared and optical techniques and mentioned this to some colleagues during casual conversations at work. Unknown to Mr Ibrahim, some of these colleagues then had speculative discussions regarding his idea. Mr Ibrahim was not party to those discussions and the contents or outcome of those discussions were never communicated to Mr Ibrahim. The idea was never formalised. Meanwhile Mr Ibrahim had begun developing his concept privately. It is admitted that the Research Development Group held a meeting on 13 August 2002 at which it was decided that Mr Ibrahim’s idea would be submitted for a Scottish Enterprise proof of concept grant. Mr Ibrahim was asked by his manager to write a technical description for the idea in support of the application for the grant.”

11 As regards the filing of the patent application he states at paragraph 3.4:

“It is denied that a meeting was held on 19 August 2002 between Mr Ibrahim, the management of Digital Design Studio and the HR Manager for the Glasgow School of Art. That meeting took place on Monday 18 August 2002. It is admitted that Mr Ibrahim indicated that he had already filed a patent application. However, unknown at that time to Mr Ibrahim the person responsible for filing the application that morning had failed to do so. The application was subsequently filed on 5 September 2002.”,

but I note that although the defendant refers to “a person responsible for filing”, the application was in fact filed without professional assistance, on the face of it by the defendant himself. The defendant does not dispute that the application relates to the

concept which was discussed at the meeting of 13 August 2002.

### **Evidence and analysis**

- 12 The claimant's case is supported by affidavits from Professor Paul Anderson and Tom Kenny, the Director and Deputy Director respectively of DDS. Professor Anderson says that he was the line manager, and Mr Kenny that he was a close working colleague, of the defendant. The two affidavits are accompanied by a total of 29 exhibits (one of which is subject to confidentiality directions following the request mentioned above) directed to the type of research carried out at DDS, the way in which it was carried out and the obligations incurred by researchers, the activities undertaken at DDS by the defendant and the circumstances surrounding his suspension and dismissal. I have read all this evidence very carefully, and whilst I do not think I need to go through it in detail it will be helpful to refer to the salient features.
- 13 Both Professor Anderson and Mr Kenny believe that the defendant's core duty was to conduct research and that the patent application relates to an invention which was within DDS' core research interests and to a concept - the "Touchspace" concept - which was a DDS research goal from an early stage. Professor Anderson says that DDS were involved in research into both the hardware and software aspects of human - computer interaction through both tethered and untethered devices. He also says that the defendant was a senior member of the research team who had carried out innovative work to customise both hardware and software and was one of a small group (the Research Development Group) who discussed strategic research issues in confidence.
- 14 In support of the above, the exhibited documents include a project brief said to be written by the defendant and naming him as operational leader for the development of new tools and interfaces for a client (Anderson, Appendix 7), a published international patent application WO 01/90870 A1 for a 3D human-computer interface in which the defendant is named as a co-inventor (Anderson, Appendix 26), and a paper on emerging visualisation technologies of which the defendant was a co-author (Kenny, Appendix 29).
- 15 The exhibited documents also include the draft notes of a disciplinary meeting on 1 July 2003 at which the defendant was asked to put his case in response to a management recommendation that he be dismissed (Anderson, Appendix 27), and the final report by Ms Seona Reid, Director of the Glasgow School of Art dated 9 October 2003 containing the conclusions of the disciplinary investigation (Anderson, Appendix 13). The report concludes that the concept underlying "Touchspace" - the use of untethered devices to allow intuitive human - computer interaction in 2D/3D - had been explicitly discussed amongst staff at DDS since April 2002 with the defendant present on a number of occasions, and that it was generally perceived to be a core aspect of DDS' research. The report also found it well understood amongst DDS researchers that there was an ethos of sharing ideas and that ideas generated and developed by them were the property of DDS. It notes that, by his own admission, at no time between April 2002 and 13 August 2002 did the defendant declare an interest in "Touchspace" or claim ownership of it despite clear indications that DDS was planning to develop it. It found no convincing evidence to support the defendant's

claim that he owned “Touchspace”, or that this was a different kind of device in which DDS had not previously expressed an interest.

- 16 On the issue of the contract, the report found that even if, as was quite possible, the defendant had not received a copy of the new contract (dated 24 April 2002) containing explicit clauses relating to intellectual property, the defendant would still have been in breach of his confidentiality obligations under the previous contract - of which he could hardly have been unaware - by filing his own patent application.
- 17 The underlying basis of the defendant’s case as outlined in Appendix 27 seems to be that he had decided to take a stand with “Touchspace” against what he saw as a culture of management getting credit for ideas generated by staff and then refusing to develop them, and that he was not going to let any more of his ideas go to DDS unless he had budgetary control. (Interestingly, given that in the present proceedings he says that the has no research role, he is reported as claiming to have generated 80% of the ideas on an IP audit.) There is no concrete information as to why this particular invention should belong to the defendant rather than DDS, beyond suggesting that DDS only got involved when Professor Anderson chanced upon a casual discussion that the defendant was having with colleagues.
- 18 I recognise that the above accounts of the disciplinary proceedings are not direct evidence of what the defendant said or did. Nevertheless, I believe that the claimant has made out a case which is sufficiently clear, consistent and cogent to put an onus on the defendant to come up with a more compelling case of his own.
- 19 In my view, the defendant has failed to do this. His counter-statement alone is of little help - indeed it is a sketchier version of events than is given in the claimant’s evidence of the disciplinary proceedings, going no further than the passages I have quoted above as to how the invention was conceived and developed and how the patent application came to be filed. Also, the defendant has filed no evidence of his own either to substantiate his version of events or to rebut a number of extremely damaging allegations made by the claimant.

### **Conclusion**

- 20 I am therefore satisfied on the balance of probabilities that, irrespective of whether or not the defendant had received a copy of his latest contract, the invention was made in the normal course of the defendant’s duties and that these duties were such that an invention might reasonably be expected to result. It follows that invention belongs to the claimant by virtue of section 39(1)(a). I therefore find that the claimant is, and the defendant is not, entitled to be granted a patent on application no. GB 0220610.0.

### **Relief**

- 21 The claimant has asked either that I transfer all rights in GB 0220610.0 to them, or that I refuse to grant a patent on GB 0220610.0 and instead grant them the right to make a new application for the whole or part of any of the matter contained in the original application and retaining the filing date of the original.

22 I recognise that the claimant has concerns that GB 0220610.0 may not have been drafted in a way which would adequately protect their interests. However, even if I have the power to order the making of a new application, I am not satisfied that this would achieve anything that could not be achieved by simply transferring the original application to the claimant to prosecute it as they wish. Neither alternative would allow the claimant to introduce any matter which was not present on the filing date of GB 0220610.0.

23 I therefore order that, if no appeal is filed against this decision within the prescribed period below,

- application no. GB 0220610.0 will proceed in the name of the claimant, Glasgow School of Art;

- a copy of the papers on the application file will be sent to the claimant, who will be given a period of three months from the date the papers are sent to decide whether to continue with the prosecution of the application or to withdraw it, and to make further submissions should they then consider that my order does not adequately protect their interests;

- and that publication of the application will remain stayed unless the claimant either decides to continue with the application or makes no response within the above three month period.

24 In the event of an appeal, pending its outcome the publication should remain stayed and under rule 52.7(a) of the Civil Procedure Rules the remainder of the order should also be treated as stayed.

### **Costs**

25 The claimant has won and is therefore entitled to an award of costs. However, both sides have referred to the standard scale set forth in paragraph 5.45 of the “Patent Hearings Manual” (and reproduced in [2000] RPC 598) and submitted that I should depart from it. Scale costs are only intended to represent a contribution to expenses, but, as explained in paragraph 5.46 of the Manual, the comptroller has power to award off-scale costs, even approaching full compensation, where the circumstances warrant it.

26 The defendant asks that, even I decide to award costs in favour of the claimant, I should offset these by £400 to take account of the costs incurred in prosecuting the patent application. This possibility is indeed mooted in the Manual at paragraph 5.50, but with the rider that care is needed because the other party will have had no say in the magnitude of the expenses incurred. In this case the claimant points out that the decision to file the application was the defendant’s alone, and sees no reason why it should bear his costs. I agree, and decline to offset to the award for these expenses. There may be circumstances where such an offset might be appropriate, but I do not think this is such a case.

27 The claimant suggests that the actions of the defendant justify a departure from the

standard scale and draws attention to his refusal to provide details of the application under conditions of confidentiality, which might have avoided the need for formal entitlement proceedings; and to a lack of expedition in filing documents and in deciding to withdraw from the proceedings in the light of the official search report.

- 28 I have considered these points carefully, but I do not think that the defendant's conduct is so blameworthy in relation to that of the claimant as to justify a departure from the standard scale. As to possible lack of expedition, the correspondence at the time suggests that the claimant was content to concur with late filing of documents provided its interests were protected by staying publication. As to the decision to withdraw from the proceedings, this was communicated on 8 April 2004 around 7½ weeks after the search report was sent to the defendant on 16 February 2004, in the light of advice from a patent agent stated by the defendant to have been obtained in March 2004. In the absence of any evidence of specific detriment to the claimant, I do not consider that this is necessarily an unreasonable period of time for the defendant to take advice and weigh up his options.
- 29 As to whether the defendant's refusal to provide details of the invention under conditions of confidentiality has entailed recourse to entitlement proceedings which might otherwise have been avoided, I do not think this holds much water as regards the draft confidentiality agreement dated 9 October 1993 given to the defendant at the time of his dismissal (Anderson, Appendix 14). The letter of 9 October 1993 (a copy of which accompanies the defendant's letter of 1 September 2004) informing him of his dismissal and enclosing the draft agreement says that entitlement proceedings had already been launched. Even if the claimant was prepared to withdraw them later, as suggested in the letter, the decision to go ahead with proceedings appears to have been taken irrespective of whether or not the defendant signed the agreement. I have not been directed to any earlier attempt to secure disclosure under confidentiality.
- 30 I therefore consider that the claimant should be awarded costs on the standard scale, but I do not think the amount of evidence justifies an award anywhere near the maximum level for preparing and filing evidence that the claimant seeks in its letter of 14 July 2004. I therefore award the claimant the sum of £1100 to be paid by the defendant not later than 7 days after the expiry of the appeal period. If an appeal is lodged, payment will be automatically suspended pending the outcome of the appeal.

### **Appeal**

- 31 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

**R C KENNEL**

Deputy Director acting for the Comptroller