

PATENTS ACT 1977

BETWEEN

Simon Bibby

Claimant

and

Bernard Ward

Defendant

PROCEEDINGS

References & cross-references under sections 13 and 37
in respect of patent N^o GB 2 402 821 B

&

Counter-application under section 72 for revocation of
patent N^o GB 2 402 821 B

HEARING OFFICER

Stephen Probert

DECISION

- 1 Patent number GB 2 402 821 B, entitled "Lamp driver for decorative lighting", was granted on 8th February 2006 naming Simon Bibby and Bernard Ward as inventors and joint proprietors.
- 2 On 24 January 2005, before the patent was granted, Simon Bibby applied for a certificate under section 13(3) to the effect that Bernard Ward ought not to be mentioned as an inventor. At the same time, he referred to the Comptroller under section 8(1)(a) the question whether he alone was entitled to be granted the patent. (Following the grant of a patent on the application, the reference was treated as being one under section 37 by virtue of the operation of section 9.)
- 3 Bernard Ward filed a counter-statement contesting the application and the reference; he further counter-claimed that the application should proceed in his name alone (as inventor and proprietor). Both sides filed evidence and the matter was due to come before me at a hearing in October 2006.

Revocation

- 4 Shortly before the hearing, on 3rd October 2006, Bernard Ward applied under section 72 to revoke the patent. Where there are joint proprietors (as here), section 36(3)(a) prevents one proprietor from applying for revocation without the consent of the other. However, the correspondence filed in these proceedings suggests that Simon Bibby consented to the filing of Bernard Ward's application for revocation. Moreover, both proprietors agreed that the entitlement proceedings should be stayed until the issues raised in the revocation action had been determined. I regard this agreement on Simon Bibby's part as giving implied consent to Bernard Ward's application for revocation; certainly neither Simon Bibby nor his attorneys have said or done anything to give me any cause to doubt his consent.
- 5 The correspondence indicates that Simon Bibby and Bernard Ward continued to seek a settlement of the issues in dispute between them during the time before the counter-statement was due to be filed in the revocation proceedings. According to the attorneys acting for Bernard Ward, both proprietors agreed to surrender the patent, and also agreed that each would bear his own costs. However, Simon Bibby later confirmed, through his attorneys, that he does not intend to surrender the patent. However, he also confirmed that he does not intend to file a counter-statement in the revocation proceedings.
- 6 The application for revocation of the patent is made under section 72(1)(a) (lack of novelty and inventive step) and section 72(1)(c) (insufficiency). It concerns each and every claim in the patent. In my opinion, Bernard Ward's statement clearly makes out both grounds for revocation, and since Simon Bibby has chosen not to file a counter-statement, I hereby revoke the patent (GB 2402821 B) in its entirety.

Entitlement and Inventorship

- 7 In view of the revocation of the patent (for want of defence) on grounds of invalidity and insufficiency, and the fact that revocation has effect *ex tunc*¹, there is nothing left for me to decide in terms of entitlement or inventorship. As the Court of Appeal expressed it in *Markem*², there is "no bone" to be fought over, and the references and cross-references under sections 13 and 37 have abated.

Costs

- 8 I make no decision as to costs in either proceedings, because the latest information available to me is that the parties have settled the question of costs between themselves.

S PROBERT

Deputy Director acting for the Comptroller

¹ Which means that the patent is deemed never to have been granted.

² *Markem Corp v Zipher Ltd* [2005] RPC 31