

13th September 2007

PATENTS ACT 1977

BETWEEN

James Campbell Claimant

and

Aberdeen University Defendant

PROCEEDINGS

Reference under section 12 of the Patents Act 1977 in
respect of patent application number WO 03/057470 A1
and equivalents (EP(UK) 1467858)

HEARING OFFICER Stephen Probert

DIRECTIONS

- 1 This is a dispute over who is entitled to be granted a patent in respect of the invention in patent application WO 03/057470 A1 — entitled “Air permeable cladding panel”. The application was filed by Aberdeen University, but James Campbell claims that the invention was made by one or more industrial placement students who were employed by him and working under his supervision.
- 2 After the counterstatement was filed, I reviewed both the statement and the counterstatement and directed under rule 88(1A) that the parties attend a case management conference (CMC) in order for me to give directions with regard to the management of these proceedings.
- 3 At the CMC, which was held on Thursday 6th September 2007, Mr Campbell was assisted by Dr Howard Fisher, while Dr Elizabeth Rattray and Dr Mohammed Imbabi (for Aberdeen University) were represented by Mr Steven Suer and Mr Thomas Gaunt (Patent Attorneys from Ablett and Stebbing).
- 4 There were three particular issues that I wanted to address at the CMC; they were:
 - a. Clarification of the statement and counter-statement
 - b. A timetable for the remainder of the proceedings
 - c. Consideration of mediation or ADR in general.

Statement and Counterstatement

- 5 The statement runs to some 18 pages, and is accompanied by 3 boxes of supporting documents that are listed as evidence. It was clear at the CMC that this entitlement dispute is just one of several ongoing disputes between the parties. It appears to me that some of these other disputes have spilled over into these proceedings. For example, the statement refers to various alleged breaches of confidence and/or other agreements after the filing date of the patent application, and also mentions other patents that Mr Campbell says arose from the same programme of work, but which Aberdeen University say relate to entirely separate inventions. I am therefore directing that the statement be amended to make it clear that these proceedings are only concerned with entitlement (and inventorship - see below) of patent application WO 03/057470 A1. The parties agreed at the CMC that anything that took place after the priority date of the application (11 January 2002) is likely to be irrelevant to the issues that have to be decided in these proceedings and can be removed from the statement and counterstatement.
- 6 Mr Campbell confirmed that it is his intention to establish entitlement to the patent application by, among other things, proving that Sebastien Lafougere is the true inventor, and not Dr Imbabi (as currently named). However, any reference to section 13 ("Mention of inventor") has been deleted from Form 2/77, and the statement does not make any request under section 13 either.
- 7 The statement should therefore be amended to include a request under section 13 corresponding to the claimant's case in relation to inventorship.
- 8 Although it was not mentioned during the CMC, the guidance of the Court of Appeal in *Markem*¹ should also be kept in mind when amending the statement. The following paragraphs from the judgment of Jacob LJ are particularly relevant to this situation:

78. It follows that it is not enough for A to assert that the invention or concept (we use the expression loosely at this stage) was known to its employees and that that itself gave A an entitlement to make an application under s.7. What has to be shown is that A is entitled to B's application or part of it. In the usual run of case, such an entitlement will arise by reason of the operation of some independent rule of law, such as contract, breach of confidence or the like. So, for example, if an employee in breach of confidence takes a trade secret consisting of an invention and applies for a patent in his own name, the employer can properly say the employee was not entitled (i.e. had no right) to apply for the patent by reason of the fact that the invention (i.e. the right to deal with and use the relevant information) belonged to the employer. Or, where two people co-operate in making an invention, there will be some agreement express or implied about who is to own any corresponding patent. Probably there will be joint ownership. There may be an inquiry as to who actually contributed relevantly to the concept, but that inquiry will not alone determine the matter. In the end the question is always "who was to own the invention and the corresponding

¹ *Markem Corp v Zipher Ltd* [2005] RPC 31

patent?” The question is about “title” and that involves a question of legal rights.

79. We think it follows that, whether or not A is entitled to apply for a patent pursuant to s.7 is, as such, irrelevant to whether or not he can claim an entitlement to an application by B. For the latter he must be able to show that in some way B was not entitled to apply for the patent, either at all or alone. It follows that A must invoke some other rule of law to establish his entitlement – that which gives him title, wholly or in part, to B’s application.

9 So Mr Campbell cannot succeed in this entitlement action by proving **only** that the invention was first made by Sebastien Lafougere. That would have given Mr Campbell the right to apply for a patent before anyone else; albeit the opportunity to exercise that right expired on 11 January 2002 when this application was filed by Aberdeen University. In order for Mr Campbell to succeed, according to *Markem*, he needs to prove that Aberdeen University was not entitled to apply for the patent. Just to be absolutely clear, that cannot be achieved by proving that one of the University’s employees (the named inventor) was not the first to come up with the invention.

Timetable for the remainder of the proceedings

- 10 At the CMC I decided that the claimant (Mr Campbell) should have a period of two weeks (from the date of these directions) in which to file an amended statement. I will then review the amended statement, and if it complies with my directions above, the amended statement will be formally served on the defendants.
- 11 From the date on which the amended statement is formally served on the defendants, they shall have a period of two weeks in which to file an amended counter-statement. As with the statement, I will review the counter-statement, and if it complies with my directions above, it will be formally served on the claimant.
- 12 Both parties were content with the standard period of 6 weeks for the formal evidence rounds, so Mr Campbell will be expected to file any evidence he considers necessary to support his amended statement within 6 weeks of receiving the amended counter-statement. Then the defendants shall have 6 weeks to file any evidence which they consider necessary to rebut the claim against them. Finally, if there is anything in the defendants’ evidence that Mr Campbell considers requires further evidence (strictly “in reply”) from him, he will have a period of 6 weeks from receipt of the defendants’ evidence in which to file it.
- 13 These periods allowed for filing evidence are maximum periods. In other words, if either party is in a position to file its evidence sooner, or chooses not to file evidence at all, the Office’s Litigation Section should be informed so that the next stage in the proceedings can be started sooner.

Mediation

- 14 As stated in Tribunal Practice Notice 1/2000², staff from Litigation Section have repeatedly asked the parties whether they have considered mediation or other forms of ADR³ as a means of resolving this dispute. Mr Campbell has indicated a willingness to try mediation, but so far Aberdeen University have been reluctant to accept the suggestion.
- 15 At the CMC, Mr Suer explained that the University prefers to regard this patent entitlement dispute as a self-contained issue, and did not share Mr Campbell's desire to treat it as a small part of a larger dispute, eg. in a mediation. He said that as far as his clients were concerned, the central issue in this case was one of fact — ie. who made the invention? He did not think there was anything to be achieved by trying mediation in these particular circumstances, since there was nothing within this dispute that the parties could negotiate in order to reach a settlement.
- 16 Mediation is a voluntary process, and therefore I do not have the power to compel the parties to give mediation a chance. Personally I am much more optimistic about the prospects of a successful mediation than Mr Suer. It seemed to me that even within the comparatively narrow confines of this dispute, there is sure to be a negotiable outcome that is better for both parties than battling on with expensive litigation. I would therefore encourage the parties to consider mediation at every stage in these proceedings. As the Tribunal Practice Notice² states, I am prepared to stay these proceedings if the parties agree to give ADR a chance.

Appeal

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

S PROBERT

Deputy Director acting for the Comptroller

² www.ipo.gov.uk/patent/p-decisionmaking/p-law/p-law-tpn/p-law-tpn-2000/p-law-tpn-2000-tpn12000.htm

³ ADR = Alternative Dispute Resolution. I have kept to the terminology used in the Tribunal Practice Notice, but I am aware that EDR (Effective Dispute Resolution) is becoming the accepted term.