

13th June 2008

PATENTS ACT 1977

Tom Lloyd Halstead

Claimant

PROCEEDINGS

Reference under section 8 of the Patents Act 1977 in
respect of patent application number GB 0613246.8

HEARING OFFICER

J Elbro

DECISION

Introduction

- 1 These proceedings were initiated by Mr Halstead on 5 November 2007. Mr Halstead seeks an order for the application GB 0613246.8 to proceed jointly in his name and that of the currently registered proprietor, P. G. Lawton (Industrial Services) Limited (Lawton).
- 2 Lawton and other interested parties (the other named inventors) were offered the opportunity to file a counter-statement by 1 February 2008 (later extended to 22 February 2008). They did not do so and were informed by the Office on 5 March 2008 that if they did not respond within 14 days the application would be treated as unopposed. They did not respond and were therefore informed on 16 April 2008 that the application would be treated as unopposed.
- 3 By operation of Rule 77(9), Lawton and the other inventors are taken to support the claimant's case.

The law

- 4 This reference was made under section 8, relevant parts of which read:

Section 8

8.(1) *At any time before a patent has been granted for an invention (whether or not an application has been made for it) –*

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent;

(b) ..

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

(2) ...

5 Also relevant is section 7, which reads:

Section 7

7. (1) *Any person may make an application for a patent either alone or jointly with another.*

(2) A patent for an invention may be granted –

(a) primarily to the inventor or joint inventors;

(b) In preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;

(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned; and to no other person.

(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.

(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

The application

6 GB 0613246.8 ("the application") was filed on 4 July 2006 by P.G. Lawton, claiming priority from a prior GB application filed 9 July 2005, and naming John Pritchard, Richard Ward, and Lloyd Thomas Halstead as inventors. The application was published as GB 2428253 A on 24 January 2007, and is currently pending before the Office.

Inventorship

7 The form 7/77 filed on this application names three inventors: John Pritchard, Richard Ward, and "Lloyd Thomas Halstead". Mr Halstead asserts that he is the last named of these, despite the variation in forenames, and in the absence of

any evidence to the contrary I am willing to accept this. Mr Halstead does not dispute the right of Mr Pritchard and Mr Ward to be named as inventors.

8 I am therefore satisfied that Mr Halstead is a co-inventor, with Mr Pritchard and Mr Ward, of the invention covered by the application.

Proprietorship

9 On the form 7/77, Lawton claims the right to be granted a patent deriving from:

(i) A contract of employment in relation to Mr Pritchard and Mr Ward, and

(ii) By virtue of an assignment in relation to Mr Halstead.

10 No dispute arises relating to point (i). Therefore, Lawton derives a right to be a proprietor of the application by operation of Section 39(1).

11 Regarding point (ii), Mr Halstead asserts that no such assignment exists. No evidence has been put forward of the existence of an assignment, beyond the reference to such an assignment on the form 7/77. As Mr Halstead's assertion has not been contested by Lawton, I accept that there is no such assignment.

12 In view of this finding, by operation of Section 7(1)(a) and in the absence of any evidence of any other reason (such as a contract of employment) why proprietorship should not rest with Mr Halstead as an inventor, I find that Mr Halstead is entitled to be a proprietor of the application.

13 In summary, I therefore find that both Lawton and Mr Halstead are entitled to proprietorship of the application.

Order

14 I direct that the application should proceed in the joint names of P. G. Lawton (Industrial Services) Limited and Tom Lloyd Halstead.

15 I note that the co-owners will need to agree on how to take the further prosecution of this application through the Office forward. In the event that they are unable to agree, either may make a reference to the Comptroller under Section 10 of the Act for him to direct appropriate action to enable the application to proceed.

J ELBRO

Deputy Director acting for the Comptroller