BL O/282/08

16th October 2008

PATENTS ACT 1977

BETWEEN

Mr Francis Gerard McGurk Mr Tony MacMahon	Claimants
and	
Mrs Tracey Pilling	Defendant

PROCEEDINGS

Reference under section 8 of the Patents Act 1977 in respect of patent application number GB 0611364.1

HEARING OFFICER Stephen Probert

DECISION

1 This reference under section 8 (entitlement) is uncontested, and the facts can be stated briefly. Messrs Tony MacMahon, Francis (Frank) McGurk and Gordon Pilling worked together to develop a concept in the field of scaffolding platforms. They agreed to set up a company to market and distribute the resulting product. The company was incorporated in April 2006, naming Mr Pilling's wife, Tracey, as the owner of the single share in the company.

2 In July 2007, Mr MacMahon and Mr McGurk learned that a patent application had been filed by Mrs Pilling (as the applicant) in relation to the product. The statement says that the application also named Mr Pilling as the sole inventor, but in fact no statement of inventorship has been filed, and the deadline for filing such a statement expired a little over a year ago on 8 October 2007.

3 In August 2007, Messrs MacMahon and McGurk brought these proceedings in which they ask the Comptroller to transfer the application to them. They also ask the Comptroller to confirm that they are named as joint inventors, along with Mr Pilling, but rule 10(4) of the Patents Rules 2007 specifically requires that a statement of inventorship must be filed on Patents Form 7. No Form 7 has been filed in this application, and it will now be necessary for the applicant(s) to request an extension of time in order to file one. If no Form 7 (statement of inventorship) is filed, the application shall be taken to be withdrawn (see section 13(2) of the Act).

4 Mr and Mrs Pilling were each sent a copy of the statement; Mr Pilling as a person likely to have an interest, and Mrs Pilling as the original applicant for the patent. They both chose not to file a counter-statement. Therefore I must treat Mr & Mrs Pilling as supporting the claimants' case as required by rule 77(9). This rule says:

> (9) Where—
>
> (a) a person was notified under paragraph (1) or (2); and
>
> (b) that person fails to file a counter-statement under paragraph (6) or (8),
>
> the comptroller shall treat him as supporting the claimant's case.

The Law

5 The present proceedings have been brought under section 8 of the Act, which gives me the jurisdiction to determine entitlement to the patent application in this dispute. The relevant parts of section 8 read as follows:

> **Determination before grant of questions about entitlement to patents, etc.**
>
> 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; or
>
> (b) any of two or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;
>
> and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.
>
> (2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below -
>
> (a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;
>
> (b) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly;
>
> (c) .....

6 Mrs Pilling was advised in an official letter dated 3 July 2008 that as no counter-statement had been filed, these proceedings would be treated as unopposed.

Order

7 On the basis of the facts pleaded in the claimants' statement, and in view of the absence of any counter-statement, I am satisfied that patent application

GB 0611363.1 belongs to the claimants. **I therefore order that this patent application should proceed in the names of Mr Tony MacMahon and Mr Francis (Frank) McGurk as joint applicants, instead of Mrs Tracey Pilling.**

Appeal

8 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