

PATENTS ACT 1977

BETWEEN

Orbital 2 Limited

Claimant

and

Urs Viktor Giger

Defendant

PROCEEDINGS

Reference under section 12 of the Patents Act 1977 in respect of
patent applications WO 2008/104257 & WO 2008/104258

HEARING OFFICER

Stephen Probert

Mr Carsten Koch (of Liermann-Castell) for the defendant

Miss Kathryn Pickard (instructed by Mr Ross Cavill of Wynne-Jones, Lainé & James LLP)
for the claimant

Hearing date: 29th January 2010

TRANSCRIPT OF ORAL DECISION

Request to strike out

- 1 This is an action for entitlement in relation to WO2008/104257 & WO2008/104258 that are both currently in the name of Mr Viktor Giger.
- 2 The Claimant, Orbital 2 Limited, contends that they are entitled to both of these applications because either, on the one hand, one of their employees made the invention and then disclosed it under conditions of confidentiality to Mr Giger (leading to a claim under section 7(2)), or alternatively that Mr Giger contributed to part of the inventive concept while working for Orbital 2, and thus they claim entitlement by virtue of section 39(1).

Request to strike out the action

- 3 The defendant, Mr Giger, has requested that the whole reference under section 12 be struck out because the claimant's statement of grounds does not clearly indicate what the claimant considers to be the inventive concept. Mr Koch says it is essential that the claimant clearly sets out what they consider the inventive concept to be, because otherwise his client is unable to defend his

position. Mr Koch also went further and submitted that, for example, the arrangement shown in annex 1b (to the statement of grounds) is a schematic diagram and cannot possibly show the inventive concept in the '257 patent because the invention in that case is a constructional detail of a gearbox.

- 4 The Comptroller has wide powers for case management, including the power to strike out a statement of case. Although the Comptroller may not be strictly bound by the Civil Procedure Rules, this tribunal has always followed them in situations where we do not have clear guidance in the Patents Act and the Patents Rules. In this situation, the Civil Procedure Rules are clear; rule 3.4 of section A part 3 reads as follows:

Rule 3.4 Power to strike out a statement of case

The court may strike out a statement of case if it appears to the court-

- (a) that the statement of case discloses no reasonable grounds for bringing or defending the claim;
- (b) that the statement of case is an abuse of the court's process or is otherwise likely to obstruct the just disposal of the proceedings; or
- (c) that there has been a failure to comply with a rule, practice direction or court order.

- 5 It seems to me that the defendant's request on this occasion arises under the first of these provisions — ie. that the statement of grounds discloses no reasonable grounds for bringing the claim.

- 6 So the question that I have to decide this morning is: can I be satisfied that the statement of grounds (either the original statement, or an amended version before me) discloses no reasonable grounds for bringing the claim?

- 7 In the course of her submissions, Miss Pickard referred me to the House of Lords' judgment in *Yeda*¹, which is the most up-to-date statement of the Court in relation to patent law on entitlement in the UK. In particular, I noted the words of Lord Hoffman towards the end of paragraph 20:

"Deciding upon inventorship will therefore involve assessing the evidence adduced by the parties as to the nature of the inventive concept and who contributed to it. In some cases this may be quite complex because the inventive concept is a relationship of discontinuity between the claimed invention and the prior art."

- 8 This argues strongly in favour of allowing these proceedings to continue so that I can determine what the **inventive concept** is, and who is the "**actual deviser**" in the light of evidence adduced by the parties in the usual way.

- 9 Mr Koch referred me to paragraph 21 of *Yeda*¹ which continues:

"The effect of s.7(4) is that a person who seeks to be added as a joint inventor bears the burden of proving that he contributed to the inventive concept underlying the claimed invention and a person who seeks to be substituted as sole inventor bears the additional burden of proving that the inventor named in the patent did not contribute to the inventive concept."

¹ *Yeda Research & Development Co. Ltd v Rhone-Poulenc Rorer International Holdings Inc* [2008] RPC 1

- 10 Mr Koch emphasised that there is an “additional burden” on the claimant in this case because they are attempting (in one of the alternative forms of relief being sought) to substitute Mr Giger altogether as sole inventor. That is correct. But the additional burden is a “... burden of proving ...” — which indicates that this increased burden is one that the claimant is expected to satisfy through adducing evidence, and not something that they need to establish from the outset.
- 11 Having heard submissions from both sides, I have reached the conclusion that there is not a sufficient reason to strike out this reference. The claimant may or may not be able to make out its case eventually, but I cannot tell until they have had an opportunity to bring forward evidence to support their case.

Amended Statement of Grounds

- 12 The purpose of the statement of grounds is to enable the parties and the tribunal to know the outline of the claimant’s case and the extent to which the defendant accepts or denies the claims. The parties then know what they need to prove, through evidence, and what (if anything) has been accepted as fact.
- 13 The proposed amendments to the statement of grounds do not, it seems to me, introduce any new grounds. They are relatively minor amendments; nevertheless it does seem to me that they clarify the legal basis of the claim and therefore I will allow the statement to be amended as proposed under rule 82(1)(e). Mr Koch confirmed that the defendant would not be seeking to amend the counter-statement as a result of this amendment to the statement of grounds.

Next steps - Evidence rounds

- 14 Having heard Mr Koch’s submission that the defendant is not clear in his own mind about what the inventive concept is, I proposed that the evidence rounds in these proceedings should follow a sequential pattern. Miss Pickard and Mr Koch did not disagree. After hearing submissions from the parties as to the time needed to prepare evidence, I gave directions as follows for the remainder of these proceedings:

Claimant to file evidence in chief by: 29th March 2010

Defendant to file evidence in chief by: 24th May 2010

Claimant to file evidence-in-reply by: 21st June 2010

Window for substantive hearing — 19th July to 31st August 2010

- 15 I said that the Hearings Clerk would be in touch with the parties representatives shortly, with a view to setting a time and venue for the substantive hearing.

Mediation

- 16 Miss Pickard and Mr Koch both assured me that there has been correspondence between the parties on the subject of mediation, and that they will explore it further in the next few weeks.

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