

PATENTS ACT 1977

BETWEEN

Joseph Henry George Meider Claimant

and

Edward Henry Whitfield Respondent

PROCEEDINGS

Reference under section 37 and application under section 13(3) of the
Patents Act 1977 in respect of patent GB 2433866B

HEARING OFFICER Stephen Probert

Mr Roderick Ramage (solicitor) represented the respondent
Mr Joe Meider (claimant) represented himself, assisted by Mrs Ortensia Meider

Hearing date: 26th May 2010

TRANSCRIPT OF ORAL DECISION

- 1 In these proceedings, Mr Meider claims that he is the sole inventor of the invention that is the subject of patent GB 2433866B. Based on the statements of case, which are ... not as clear as they might be, I infer that Mr Meider requests a certificate under section 13(3) to the effect that Mr Whitfield ought not to have been mentioned as a joint inventor.
- 2 Mr Meider further claims (under section 37) that he is the sole owner of the patent, presumably on the grounds that he is the sole inventor. That, as far as I can make out, is what is claimed.
- 3 Mr Whitfield (the “respondent”) has filed a counter-statement opposing the application to remove his name from the patent. I take this to mean that Mr Whitfield opposes Mr Meider’s claims under section 13(3) and section 37.
- 4 Shortly after proceedings were joined, I issued a Preliminary Evaluation indicating what I thought were the issues between the parties, and giving a non-binding opinion as to the likely outcome on each issue. I did this partly because of the problems with the inadequacy of the statements of case, and partly because it

appeared to me that this was a case in which I might want to give summary judgment¹. The substance of the Preliminary Evaluation² was that:

- a) the claimant's statement discloses no reasonable grounds for bringing the claim under section 37, and
- b) the respondent's counter-statement discloses no reasonable grounds for defending the claim under section 13(3).

- 5 Consequently I advised the parties that in my opinion these proceedings could only result in the patent continuing in the joint names of Mr Meider and Mr Whitfield (as equal co-owners), but with Mr Meider recorded as the sole inventor.
- 6 Neither Mr Meider nor Mr Whitfield agreed with the Preliminary Evaluation, and therefore this hearing was arranged to consider whether I should exercise the Comptroller's powers of case management to give summary judgment as indicated in the Preliminary Evaluation.
- 7 Having heard Mr Meider and Mr Ramage (on behalf of Mr Whitfield), I have concluded that my preliminary view of the issues was correct.
- 8 I cannot see how Mr Meider can succeed in his claim to sole ownership of the patent, on the basis of his pleaded case. Mr Meider and Mr Whitfield are co-owners, in equal shares, of the patent. My reasons for reaching this conclusion are as set out in the Preliminary Evaluation. In brief, Mr Meider signed an agreement, the effect of which was to share the patent with Mr Whitfield. Mr Meider told me that he regards the agreement as being void, but this is not part of his pleaded case, and in any event, I heard nothing this morning that gives me reason to suppose that Mr Meider can renounce the agreement unilaterally. Mr Ramage maintained that the agreement was still in force. I therefore strike out that part of Mr Meider's claim which is made under section 37 (entitlement).
- 9 As for who is the inventor, or actual deviser, of the invention, my decision is that Mr Meider is the sole inventor. My reasons are as set out in the Preliminary Evaluation. On the basis of his case as pleaded in his counterstatement, I do not believe that Mr Ramage can now say that his client is a joint inventor in respect of any invention in the patent. The 'defence' in the counterstatement (Part A, paragraph 2) is that Mr Whitfield is a joint inventor because of the agreement made between the parties on 12 July 2004. For the reasons given in the Preliminary Evaluation I do not think this defence has even the slightest prospect of success.
- 10 Mr Ramage submitted that Mr Whitfield was jointly responsible for some "matters" in the patent, and in particular that he contributed to some of the later (dependent) claims³ — eg. the one-way valve in claim 8 and the hollow ring in claim 12. On this basis Mr Ramage argued that Mr Whitfield should continue to be mentioned as an inventor in the patent. I suppose that, strictly speaking, I don't need to

¹ See Civil Procedure Rules 3.3 & *Colin Orford v Rasmi Electronics* [2002] EWCA 1672

² The Preliminary Evaluation is incorporated into this decision at Annex A.

³ The claims of the patent are reproduced in Annex B to this decision.

make a decision in relation to this argument since I have already found that Mr Ramage was not entitled to run it. Nevertheless, in case it helps the parties in future, I will observe in passing that I can only see one invention in the claims of the patent. This should not be surprising since there is supposed to be only one invention (or inventive concept) in the claims — see section 14(5)(d). It seems to me that the inventive concept is as claimed in claim 1; the dependent claims 2 to 15 define subsidiary features that do not appear to be inventions in their own right. As Lord Hoffman said in *Yeda*⁴:

“It is not enough that someone contributed to the claims, because they may include non-patentable integers derived from prior art: see *Henry Brothers (Magherafelt) Ltd v Ministry of Defence* [1997] RPC 693, 706; [1999] RPC 442. As Laddie J said in the *University of Southampton* case, the “contribution must be to the formulation of the inventive concept”.”

Summary

- 11 I have struck out that part of Mr Meider’s claim relating to section 37 (entitlement), and I have given summary judgment in relation to the remainder of his claim — ie. section 13(3) (inventorship) — the result of which is that Mr Meider may have a certificate from the comptroller to the effect that Mr Whitfield ought not to have been mentioned as an inventor. So that there is no room for misunderstanding, I repeat that the patent continues to be jointly owned by Mr Meider and Mr Whitfield in equal shares.
- 12 It was clear to me that joint ownership is not a thrilling prospect to either Mr Meider or Mr Whitfield. Their working relationship has completely broken down. All I could suggest is that both parties seriously consider mediation, in an attempt to find a way forward.

Appeal

- 13 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

⁴ *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc.* [2008] RPC 1

Annex A



25th February 2010

PATENTS ACT 1977

BETWEEN

Joseph Henry George Meider

Claimant

and

Edward Henry Whitfield

Respondent

PROCEEDINGS

Reference under section 37 and application under section 13(3) of the
Patents Act 1977 in respect of patent GB 2433866B

HEARING OFFICER Stephen Probert

Written Preliminary Evaluation

- 1 Patent GB 2433866B was granted on 2nd September 2009 in the joint names of Joseph Henry George Meider and Edward Henry Whitfield. Messrs Meider and Whitfield are also shown as joint inventors of the plant feeding apparatus that is the subject of the patent.
- 2 On 25th November 2009, Mr Meider (the “claimant”) initiated the present proceedings under section 37 and section 13(3). Mr Meider claims that he is the sole owner of the patent (section 37), and the sole inventor of the invention that is the subject of the patent (section 13(3)). Mr Whitfield (the “respondent”) has filed a counter-statement opposing the application to remove his name from the patent.
- 3 In the light of the statements filed by both parties, it appears to me that the claimant’s statement discloses no reasonable grounds for bringing the claim under section 37, and also that the respondent’s counter-statement discloses no reasonable grounds for defending the claim under section 13(3). In the circumstances, I thought it would be useful to issue a preliminary evaluation setting this out. Any opinion expressed in this written preliminary evaluation is provisional, and therefore not binding on the final decision.

Annex A

Section 13(3) — Who actually devised the invention?

4 Mr Meider says in his statement that he devised the invention (a plant feeder) over a period of time between 1993 and 1996, but did not have the funds to pursue it commercially at the time. He met Mr Whitfield in May 2004, following which the two men agreed to work together to market the invention. They set up a company together (Feed 'N' Leave Limited), and signed an agreement which covered, among other things, ownership of intellectual property.

5 In reality, I don't think that Mr Whitfield has opposed Mr Meider's claim to be the sole inventor. In his counter-statement, he refers to Mr Meider's claim that he (Mr Meider) first thought of the idea for a plant watering system in or about 1993/4, and specifically says:

"The Respondent does not challenge the statements in this paragraph."

6 Nowhere in the counter-statement does Mr Whitfield suggest that he had any part in devising the invention. On this basis, it seems to me that Mr Meider's application to remove Mr Whitfield's name as inventor is unassailable.

7 In his statement, Mr Meider says that he allowed Mr Whitfield to sign as a co-inventor as a courtesy because Mr Whitfield was providing factory premises for the company that they set up together. However, inventorship is strictly a matter of fact; it is not something that can be arranged or negotiated after the event to suit the circumstances of persons having an interest in any resulting patent.

8 My preliminary evaluation is therefore that Mr Meider is the sole inventor.

Section 37 - Who owns the patent?

9 In the covering letter that accompanied his statement, Mr Meider refers to a meeting that he and Mr Whitfield attended at their patent attorney's office, in which:

"... I stated to Mr Whitfield that because he had offered to use his factory facilities that it was only fair that I allow him to share part of the Patent. This was done with trust and appreciation."

10 Whereas Mr Meider was not in a position to 'share' inventorship, he clearly was in a position to share ownership of the resulting intellectual property. It is clear from the statements of case provided by the parties, that this is what happened.

11 Mr Whitfield has provided, as an attachment to his counter-statement, a signed copy of the agreement between himself and Mr Meider. It is dated 12th July 2004, and the first paragraph reads:

"The Company has been formed as a vehicle for design, development, manufacture, marketing and sales of a range of products ("the Products") whose function is long-term automatic watering (and optionally, feeding) of plants kept in containers such as pots and baskets. Intellectual property rights in the Products are at the date of this Agreement the subject of a pending patent application filed on the Company's behalf by Swindell & Pearson under their reference RRS/8956. JM and EW ("the Directors") are joint inventors and joint owners of all intellectual property rights in the Products."

Annex A

- 12 The title of the agreement indicates that “JM” is Joe Meider and “EW” is Edward Whitfield.
- 13 Having agreed to share ownership of the intellectual property rights (including the patent in suit) with Mr Whitfield, I cannot see how Mr Meider can now succeed in his claim to sole ownership of the patent.
- 14 My preliminary evaluation is therefore that Mr Meider and Mr Whitfield are equal co-owners of the patent.

Summary

- 15 For the reasons given above, my preliminary evaluation is that these proceedings will result in the patent continuing in the joint names of Mr Meider and Mr Whitfield, but with Mr Meider recorded as the sole inventor.

S PROBERT

Deputy Director acting for the Comptroller

Annex B

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CLAIMS

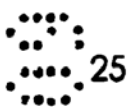
1. Plant feeding apparatus, the apparatus including a feeding member
5 locatable in the growing media for a plant or plants, the feeding member being
hollow and made of a permeable ceramic material, a reservoir member to
locate liquid feed, the reservoir member including an outlet and an open
ended pipe means extending from the outlet, with the reservoir member
10 resting in use on an upper part of the feeding member or a connection to the
feeding member, with the pipe means extending downwardly therein such
that liquid in the reservoir member can be in direct communication with liquid
in the feeding member.

2. Apparatus according to claim 1, characterised in that the reservoir
15 member is substantially closed except for the outlet.

3. Apparatus according to claim 1 or 2, characterised in that the pipe
means includes a rigid pipe means extending from the reservoir member.

20 4. Apparatus according to claims 1 or 2, characterised in that the pipe
means is flexible.

5. Apparatus according to any of the preceding claims, characterised in
that the pipe means is significantly elongate.



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6. Apparatus according to any of the preceding claims, characterised in
that the reservoir member comprises a closed hollow body with the pipe
means extending therefrom.



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7. Apparatus according to any of the preceding claims, characterised in
that the reservoir member is substantially spherical.

Annex B

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8. Apparatus according to any of the preceding claims, characterised in that a one way valve is provided in an upper part of the reservoir member to permit liquid feed to be supplied into the reservoir member.

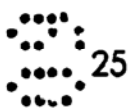
5 9. Apparatus according to any of the preceding claims, characterised in that the reservoir member is transparent or translucent.

10 10. Apparatus according to any of the preceding claims, characterised in that the reservoir member includes a liquid level sensor, an inlet valve to a supply of liquid plant feed, and is arranged such that when the liquid level falls below a predetermined level, the inlet valve opens to replenish the reservoir member with plant feed.

15 11. Apparatus according to any of the preceding claims, characterised in that the feeding member has a generally conical or frusto conical configuration, with an open top.

20 12. Apparatus according to any of claims 1 to 10, characterised in that the feeding member is in the form of a hollow ring, with an opening into the interior of the ring for connection to the connection means.

13. Apparatus according to any of claims 1 to 10, characterised in that the feeding member is substantially elongate with an opening for connection to the connection means.



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14. Apparatus according to claim 13, characterised in that a further opening is provided in the feeding member to connect to further feeding members.



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15. Apparatus according to any of the preceding claims, characterised in that a plurality of feeding members are provided for one reservoir member.