



PATENTS ACT 1977

BETWEEN

Paul Raven, Kevin Raven & Carol Raven

Claimants

and

Robert Williamson

Defendant

PROCEEDINGS

Reference under sections 10, 12(1) & S12(4) of the Patents Act 1977
In respect of EP02747592

HEARING OFFICER

Phil Thorpe

DECISION

Introduction

- 1 This case relates to the entitlement to a European Patent Application. The application is EP 02747592 which originated as PCT application WO2002GB0338 filed on 24 July 2002. The PCT application claimed priority from United Kingdom Patent Application GB0118128.8 (the priority application) which was filed on 25th July 2001.
- 2 The PCT application entered the regional phase in the European Patent Office (EPO) on 13 February 2004. The EP application was subsequently published as EP1409290 on 21 April 2004. The EP application, the PCT application and the priority application all name as applicants Robert Williamson, Paul Raven and Kevin Raven. Kevin Raven is named as the sole inventor. Both the priority and PCT applications have now lapsed or been refused. The EP application (“the application in issue here”) has also now been deemed to be withdrawn. I will come back to that later.

3 The reference has been brought under sections 10 and 12 by Paul, Kevin and Carol Raven (the claimants). The claimants seeks a determination that:

- Kevin Raven and Paul Raven are entitled to be granted alone any such patent as may be granted under the application.
- Carol Raven is entitled to the right to be named as an applicant and be granted any such patent as may be granted under the application.
- Robert Williamson is not now and further or alternatively has never been entitled to be an applicant for or be granted a patent pursuant to the application
- Further or alternatively, Mr Williamson's name should appear as last named applicant such that the claimants are able to prosecute the application without further hindrance from the Defendant nor prejudice to the prosecution of the application arising from his failures to act in the interests of all applicants and to prosecute the application.

4 Both sides accept that Kevin Raven is the sole inventor of the invention. The position of Carol Raven is also relatively straightforward since any rights that she might have flow solely from a purported assignment of the application to her by Paul and Kevin Raven. Clearly if I find that Paul and Kevin are solely entitled to the application then they are free to assign the application to whomever they want. If however I find that Robert Williamson is rightly entitled to be named as a co-applicant then Carol Raven has no right to the application unless the three co-applicants subsequently decide to assign any right to her.

5 Hence the main issue before me is whether Robert Williamson is entitled to be granted together with Paul and Kevin Raven any patent resulting from the application.

6 The parties are content for me to decide the case on the basis of the evidence filed without the need for a hearing. That evidence comprises for the claimants witness statements from Kevin and Paul Raven and their solicitor Clifford Miller. The defendant has provided witness statements from himself and his brother Brian Williamson. Kevin Raven has also provided a second witness statement in response to the evidence filed by the defendant. None of the witnesses who provided witness statements have obviously been cross-examined.

Brief History

- 7 The claimants have been involved in designing and manufacturing heavy goods vehicle (HGV) trailers since about 1995. Robert Williamson, who has worked as a private venture capitalist since 1994, became involved with Paul and Kevin Raven towards the end of 1996 or early 1997. His role was to provide funding to the business in return for cash generated by the business and capital appreciation of the shares in business. Neither side has provided any documentary evidence of any formal agreement entered into by the parties at the start of their relationship or any time thereafter. In his witness statement Robert Williamson suggests that any agreements he had with Paul and Kevin Raven including consultancy agreements were made orally.
- 8 Robert Williamson did however assume the chairmanship of one of Kevin and Paul Raven's businesses, Raven Trailers Limited, from early 1997 to around July 1997. He claims to have enjoyed a cordial relationship with Paul and Kevin Raven for the six years he worked with them.
- 9 The relationship appears to have broken down in around 2003. Both sides have in their evidence given an extensive account of their version of the circumstances surrounding this breakdown. I do not need to repeat it here in any detail and need consider it only to the extent that it helps me in deciding the main issue of entitlement to the application. It is however clear from the material before me that the breakdown in the relationship has become acrimonious and apparently complete.

The making of the invention

- 10 I turn now to the making of the invention that is the subject of the application and the events surrounding the filing of the various patent applications.
- 11 Since there is no dispute as to who the inventor is, it is not necessary for me to describe the invention in detail. It is sufficient to note that it relates to trailers for carrying containerised loads.
- 12 The actual date that Kevin Raven devised the invention is not entirely clear. There is a suggestion from Robert Williamson that the idea for the invention resulted from a visit he undertook with Kevin Raven to an exhibition in Amsterdam in 2000. There is no confirmation of this by Kevin Raven though in the event nothing turns on the precise date of invention.

The filing of the priority application and the PCT application.

- 13 The circumstances surrounding the filing of the priority application are at the heart of this dispute. The parties have put forward conflicting versions of what happened. It does however seem clear that the preparation and filing of the priority application took only a short time and was done in somewhat of a hurry over the period of a few days in July 2001. Robert Williamson claims the hurry arose from the need to file the application before the invention was disclosed to two potential customers, Corus (Trailers) and Southfields (Coachworks) Limited. Confidentiality agreements were signed by these companies but Robert Williamson claims that he and Paul Raven and Kevin Raven considered a “belt and braces” approach was necessary. In other words it was prudent to quickly file for patent protection for the invention before the disclosure to these two companies.
- 14 Paul and Kevin Raven had prior to this point used the services of patent attorneys, Dummett Copp, to draft and file their patent applications. The claimants have a portfolio of other patents for trailer designs dating back to at least 1997.
- 15 Dummett Copp was however not used to file the priority application. Robert Williamson claims that this was because Dummett Copp had at that time refused to act on behalf of the Ravens because of unpaid fees. In the event the priority application was filed by Dr Brian Williamson, a qualified patent attorney and the brother of the defendant.
- 16 In fact Brian Williamson actually filed two applications for the invention at the UK Patent Office (as it was then) on successive days. The second of these, GB0118128.8, became the priority application for the application in issue here.
- 17 The priority application names as applicants Robert Williamson and Paul and Kevin Raven. Although the Form 1 filed with the application recognised that a “Statement of inventorship and of right to grant of a patent” (Form 7) was required, no such Form 7 was ever filed.
- 18 In December 2001, Dummett Copp took over prosecution of the priority application and on 24 July 2002 filed the PCT application claiming priority from GB0118128.8. The PCT application again lists Robert Williamson and Kevin and Paul Raven as applicants.

The Law

- 19 Before turning to the arguments advanced by both sides it is useful to set out some of the legal framework relevant to this case.

20 This reference is brought under section 12(1) which provides:

At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made) -

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

(b) any of two or more co-proprietors of an application for such 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 so far as he is able to and may make such order as he thinks fit to give effect to the determination.

Section 12(3) provides that section 12(1)

“in its application to a European patent and an application for any such patent shall have effect subject to section 82”.

21 Section 82 in turn sets out the comptroller’s jurisdiction in this respect. That is not an issue here as both parties have either their residences or principle places of business in the UK.

22 Sections 10 and 12(4) are also relevant. These provide that:

Section 10

If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the comptroller may, on a request made by any of the parties, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require.

Section 12(4)

Section 10 above, except so much of it as enables the comptroller to regulate the manner in which an application is to proceed, shall apply to disputes between joint applicants for any such patent as is mentioned in subsection (1) above as it applies to joint applicants for a patent under this Act.

Burden of Proof

23 Section 7(4) is important as it provides that:

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.

This means that the burden of proof in this case is on the claimants to establish that Robert Williamson is not entitled to be named as a co-applicant.

Inclusion of Robert Williamson as an applicant on the priority application

- 24 The claimants claim that they were not aware that the priority application had been filed with Robert Williamson included as a named applicant. In his first witness statement Kevin Raven states that:

“I never met nor did I have any other form of contact with Brian Williamson, the patent agent brother of the defendant.”

He goes on to note that neither he nor Paul Raven saw the priority application before it was filed and certainly did not agree that Robert Williamson should be named as an applicant. This version of events is supported by Paul Raven in his brief witness statement.

- 25 In contrast Robert Williamson states that:

“It was agreed orally between myself and Kevin Raven and Paul Raven that the three of us would be named as applicants on the Priority Application filed by Brian Williamson. This agreement was made shortly before I spoke to Brian Williamson in July 2001”

and that

“The consideration that I provided in relation to the agreement that I should be named on the patent application to be filed was the support, both in terms of strategic advice and finance, that I had supplied and was continuing to supply to the Raven’s business. This included, but was not limited to, persuading my brother to prepare and file the patent applications which he did on 24 and 25 July 2001. It was agreed that I should be named on the patent applications filed by Brian Williamson, any patent applications claiming priority from these applications and any patents which would subsequently be granted from these applications.”

- 26 He gets considerable support from Brian Williamson who in his witness statements sets out in some detail his recollection of events surrounding the filing of the priority application. It is useful to set out this part of Brian Williamson’s witness statement in its entirety.

“On or around Sunday 22 July 2001 I received a telephone conversation from Mr Kevin Raven regarding the invention. Once again, I am able to provide the date of this telephone conversation, as I recall that it occurred on the weekend before the Priority Application was filed. During this conversation Mr Raven confirmed that, even though he alone devised the invention, the patent application was to be filed in the names of all three applicants, i.e. Mr Robert W. Williamson, Mr Kevin Raven and Mr Paul Raven. I do not recall being provided with any information on the nature of the agreement that must have been reached by Mr Kevin Raven and the two non-inventor applicants. However I am certain that Mr Kevin Raven told me that there were to be the three named applicants on the patent application.

During the conversation or around Sunday 22 July 2001 my conditions regarding the transfer of the case to Dummett Copp were readily agreed to, as Mr Kevin Raven felt that Dummett Copp had particular experience and expertise in the technical field to which the invention related. He was therefore happy to return to them in due course so that they could prosecute the application on behalf of the

applicants. Mr Raven stated that he would provide me with a draft description and drawings that he had prepared so that I could add claims and review the description prior to filing a UK application, as a matter of urgency. Mr Raven also stated that there were additional drawings, but that they would have to follow separately as he did not have them to hand at that time.

On Tuesday 24 July 2001 I received a letter dated 23 July 2001 by recorded delivery from Paul and Kevin Raven. The letter was signed on their behalf by Lesley Raven, whom I believe is the wife of Paul Raven, and enclosed a number of drawings and a draft specification without claims. A copy of this letter, together with the recorded delivery envelope dated 24 July 2001, is attached as Exhibit "BW-1". Using these documents I was able to produce the First Application (GB0118008.2), which was filed by fax at the UK Patent Office later that day in order to get as early a date as possible for the invention. The Patent Office fax-return records for the First Application are attached as Exhibit "BW-2".

On Wednesday 25 July 2001 I received a fax from Mr Kevin Raven including 11 pages of additional drawings. A copy of this fax is attached as Exhibit "BW-3". The fax is signed by a person called Wendy, whom I believe is the wife of Kevin Raven. As noted in the fax dated 25 July 2001, these drawings were provided "as discussed", this presumably being a reference to my telephone conversation with Mr Kevin Raven on or around 22 July 2001.

In addition to receiving the faxed drawings, I also spoke with Mr Kevin Raven about the invention on 25 July 2001. Attached to this statement as Exhibit "BW-4" is a copy of some notes relating to the call that I have been able to locate. These notes include a handwritten page of technical questions that I had prepared about the invention and which Mr Raven answered on 25 July 2001. They also include a page of claims numbered 11 to 17 that appear in the First Application and the Priority Application, together with some handwritten manuscript notes of mine about additional claims that only appear in the Priority Application and which tie in with the page of technical questions. For example, there is a technical question "Can you retrofit them to trailers" and a handwritten claim "A retrofit kit for an adjustable trailer – adapted – as claim 1." A revised version of this handwritten claim appears as claim 28 in the Priority Application.

The further information provided under cover of the fax dated 25 July 2001, and during the telephone conversation with Mr Kevin Raven later that day, allowed me to file the Priority Application (GB0118128.8), which claimed priority from the First Application filed a day earlier. As stated above, it was this second application (the Priority Application) from which Dummett Copp later claimed priority when filing the PCT Application (and the European Application). The Patent Office fax-return records for the Priority Application are attached as Exhibit "BW-5".

The fax dated 25 July 2001 (Exhibit "BW-3") notes that a drawing of the "twistlock beam assembly" would be provided by Mr Kevin Raven later that day. I have been unable to locate a copy of the fax under cover of which this additional drawing was provided. However, I can confirm that it was received, as it was included as Figure 5 in the Priority Application filed on 25 July 2001.

Although the Priority Application was filed in the names of Robert Williamson, Kevin Raven and Paul Raven (see Patents Form 1/77 in Exhibit "BW-5"), the filing receipt received on 1 August 2001 only listed Robert Williamson and Kevin Raven as applicants (copy attached as Exhibit "BW-6"). Mr Kevin Raven therefore

telephoned me and requested that this error in the filing receipt, i.e. the failure to list Mr Paul Raven as an applicant, be made known to the Patent Office. Importantly, Mr Kevin Raven did not say anything about the inclusion of Mr Robert Williamson as an applicant. This accords with his initial instructions that all three individuals should be named as applicants. I therefore contacted the Patent Office by telephone and requested that the error be corrected. Attached to this statement as Exhibit "BW-7" is a copy of an amended filing receipt containing the names of all three applicants and that was received on 15 August 2001."

27 Even if I accept as Kevin Raven and Paul Raven claim that neither of these persons saw the priority application before it was filed, and I note that Brian Williamson does not claim to have shown it to them, I find it inconceivable on the basis of the evidence put forward by Brian Williamson that Kevin Raven did not have "any form of contact" with Brian Williamson as he claims. I reach this view having carefully considered all the evidence before me and noting also that the claimants in their evidence in reply did not put forward any real evidence to challenge the extensive evidence of Brian Williamson. For example there is nothing from Lesley Raven or Karen Raven to say that they did not send these documents to Brian Williamson on behalf of either Kevin or Paul Raven. All that was submitted was a further statement from Kevin Raven which focused rather on possible concerns about what I would refer to as the legality of any agreement. Only in the penultimate paragraph of an eight page witness statement does he address the evidence of Brian Williamson and then only with the bland statement:

"Whilst I take issue with a great deal if not all of the evidence given by the Defendant and his brother, Brian Williamson, including the interpretation of facts offered, it will be seen that much of the evidence given on the Defendant's behalf goes far beyond the main issues in this case".

28 Having concluded that Kevin Raven did engage with Brian Williamson on the filing of the priority application I need to decide now whether either he or Paul Raven advised Brian Williamson to name Robert Williamson as an applicant. Brian Williamson and Robert Williamson are adamant that Kevin Raven did. Kevin Raven and Paul Raven are adamant that they didn't. The credibility of Kevin Raven as a witness has undoubtedly been undermined by my conclusions in respect of the contact he had with Brian Williamson. I am also mindful of the apparent general acceptance of Kevin Raven and Paul Raven to Robert Williamson being named as an applicant on the priority application and the ensuing PCT application, at least for the period from the filing of the priority application in July 2001 until the breakdown in their relationship in 2003.

29 The claimants argue that they had no choice but to accept the naming of Robert Williamson as a co-applicant on the PCT application because of licence negotiations on-going at that time with a potential customer. I accept that a dispute at that time between Robert Williamson and Paul and Kevin Raven could have jeopardised those negotiations however that does not explain their acquiescence up until those negotiations and also afterwards.

- 30 The defendant has in this respect provided copies of letters to Paul Raven from Dummett Copp dated 11 December 2001, 28 January 2002 and 31 March 2003 discussing the processing of the priority and PCT applications. In all of these letters it is clearly stated that the applications are “In the names of Kevin Raven, Paul Raven and Robert Williamson”. The letter of 31 March 2003 also refers to a previous letter sent from Dummett Copp to Kevin Raven on 6 January 2003. This letter enclosed an “Assignment Document” which Dummett Copp was keen for the co-applicants to sign. The letter noted that signing this would “formally assign to Paul Raven and Robert Williamson one-third shares in the invention and patent applications”.
- 31 Dummett wrote further on this to Robert Williamson seeking his help in getting Kevin Raven to sign the agreement. In this letter the agent from Dummett, Mr Robert Mclean suggests to Robert Williamson that “as you have an interest in the invention, I thought you might be in a better position to get the necessary signatures”.
- 32 Mr Mclean wrote again to Paul Raven on 31 March 2003 noting that the agreement had not been signed. In his letter he states “Please note that without the completion of this agreement document, neither you nor Robert Williamson have a legal ownership of this invention”. He goes on, somewhat prophetically, to urge all three to sign the document in order “to avoid potential future ownership disputes regarding to this invention”.
- 33 Neither this agreement nor any of the previous correspondence appears to have set any alarm bells ringing with either Paul or Kevin Raven. The claimants argue that their failure to sign this agreement shows that they were not happy with Robert Williamson being named as co-applicant. If that was truly the case then I would have expected correspondence from them to their patent attorney as soon as the agreement was floated. There is no evidence of any such correspondence. This leads me to conclude that they were in fact quite content with Robert Williamson being named as co-applicant and that Robert Williamson’s name was included on the priority application and the subsequent PCT application with the agreement of at least Kevin Raven.
- 34 However that is far from the end of the matter since the claimants have put forward considerable argument that even if Kevin and or Paul Raven agreed to add Robert Williamson as a co-applicant then that is not an “agreement” that gives Robert Williamson entitlement to the grant of the patent or to any right in the application.

- 35 The claimants have referred me to sections 7 and 30(6) of the Patents Act. These read so far as is relevant as follows:

Section 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

Section 30(6)

- Any of the following transactions, that is to say -
(a) any assignment or mortgage of a patent or any such application, or any right in a patent or any such application;
(b) any assent relating to any patent or any such application or right;
shall be void unless it is in writing and is signed by or on behalf of the assignor or mortgagor (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative).

- 36 The corresponding provisions of the European Patent Convention (EPC) are Articles 60 and 72 which read:

Article 60

Right to a European patent

- (1) The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee, the right to a European patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has the place of business to which the employee is attached.
- (2) If two or more persons have made an invention independently of each other, the right to a European patent therefore shall belong to the person whose European patent application has the earliest date of filing, provided that this first application has been published.
- (3) In proceedings before the European Patent Office, the applicant shall be deemed to be entitled to exercise the right to a European patent.

Article 72

Assignment

An assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract.

Robert Williamson's right to be named as an applicant – Legal arguments

- 37 Both sides agree that Robert Williamson was not the inventor. Robert Williamson claims no rights as of the time of Kevin Raven making the invention hence any rights that Robert Williamson has must flow from him being a successor in title to Kevin Raven, the sole inventor.
- 38 The claimants argue that any agreement transferring a share of the title to Robert Williamson that might exist or have existed is void because it was made orally and was not in writing as required by section 30. In this case since we are talking about a European Patent application, the relevant provision is Article 72 but that too also requires an assignment in writing.
- 39 The claimants have not referred me to any case law on this point. The first point to note is that the oral agreement between at least Kevin Raven and Robert Williamson was made before an application was filed. But the Comptroller has in the past been comfortable with section 30 applying to assignments agreed before an application has been filed.¹ Whilst I am not bound by these decisions I find the reasoning in them to be sound and hence I see no reason to depart from them. So section 30(6) and Article 72 apply. It follows therefore that the agreement entered into by Kevin Raven (and Paul Raven) and Robert Williamson was not a valid assignment of any legal rights in the patent application since it was clearly not in writing.
- 40 So Robert Williamson cannot be considered a successor in the legal title by virtue of any assignment. Incidentally it was to address this point that Dummett Copp properly sought the parties to sign the agreement discussed above.
- 41 But does Robert Williamson have equitable rights in the application such that it is proper for him to continue to be named as a co-applicant? The claimants argue that

“To the extent the Defendant might allege any equitable interest [which is denied] , the Act does not confer any right on the beneficiary of an equitable interest to a right to be named as applicant or proprietor. Any such equitable interest as may be alleged is negated by the defendant's conduct in the failure to prosecute the application and especially the failure to pay the renewal fees.”

- 42 I will come on to the conduct of the defendant in respect of the application shortly but first I need to determine whether the defendant has any right to be named as an applicant from any equitable interest in the patent that might have stemmed from his oral agreement with at least Kevin Raven.

¹ BL 0/055/03 Xtralite Limited vs Hartington Conway Limited and BL O/156/01 Bakir and Zadorozhny v Solenzara International Limited

Can a beneficial interest confer a right to be named as an applicant on patent application?

- 43 This question was in part addressed by Nicholls LJ in *Kakkar and Others v Szelke and Others* in the Court of Appeal² where he stated in respect to Article 60

“In my view success on the substantive issue, of entitlement to a beneficial share in the patent, would entitle the Thrombosis Trust to be a co-applicant with Hassle and to be registered as a co-proprietor of the patent. Article 60 of the European Patent Convention provides that the right to a European patent belongs to the inventor or his successor in title. Successor in title must, it seems to me, bear here a meaning wide enough to embrace the case where at the time of the making of the invention some other person was entitled, under an agreement or otherwise, to all or a share of the property in the invention. A narrower interpretation would make article 60 unworkable. This approach is supported by the recognition in article 60 itself that if the inventor is an employee, it may be the employer who has the right to the patent. An employer's entitlement would usually exist, if at all, at the time the invention is made.

- 44 In other words a beneficial interest can lead to the right to be named as an applicant. I should note that Nicholls LJ was talking about agreements entered at the time the invention was made. In this case the agreement was made after that date however I see no reason why that would change things. I should add that the Comptroller has also recognised that equitable rights can lead to the right to named as an applicant or proprietor.³

- 45 I am however conscious that the claimants' argument in relation to equitable rights and the consequence of the need for any assignment to be in writing is not totally without support⁴. In *Victor Ifejika v Charles Ifejika, Lens Care Limited*⁵ Lord Justice Patten stated

“Design rights like any other form of chose in action can be assigned either at law or in equity. This is recognised by the provisions of s.2(2) . Although a written legal assignment is the usual method of transmission, s.2(2) imposes no requirements as to the form any assignment or transmission of the right should take and the general rules relating to equitable assignments are therefore applicable. “

² [1989] 1. FSR 225

³ For example BLO/155/01 Robert W Cameron v Stanley Grossman and BL O/233/99 HMSI Ltd. v Polar Bay Ltd (see especially paragraphs 10-12). Ibid Bakhir and Zadorozhny v Solenzara International Limited

⁴ Interpretation of Copyright Rules: The Role of the Interpreter Lionel Bently ALAI September 20 2005.

⁵[2010] EWCA Civ 563

- 46 Although by virtue of section 30(1) patent rights are not a chose or thing in action, it might still be argued on the basis of this authority that where there is a requirement as to the form of an assignment then the general rules relating to equitable assignments may not apply.
- 47 On balance however I believe that the weight of authority is against the claimants on this point and that notwithstanding section 30(6) and Article 72, equitable rights including those flowing from an oral agreement can provide the basis for a right to be named as an applicant.
- 48 This is however still not quite the end of the matter. The claimants have also argued that any agreement that might have existed lacked certainty and was based either on past consideration or on future consideration that was not provided.
- 49 I do not intend to go into detail as what is required of an equitable assignment. It is sufficient to say that I have carefully considered all the material before me and am satisfied that there is support for the defendant's claim that the nature of his agreement with Paul and Kevin Raven was that he would be named as co-applicant in response to him securing the services of his brother to draft and file the priority application. This he did do. According to the claimants' own statement of case, Robert Williamson also subsequently provided a loan to the business of £3000 for patent agent fees thus giving credibility to the claim of Robert Williamson that he was named as co-applicant also in recognition of the finance he was intending to supply. Hence I am satisfied that the agreement did involve the necessary consideration.
- 50 By their very nature, oral agreements are less certain than written agreements. Is the oral agreement in this instance sufficiently unclear as to render it void? The onus is on the claimants to show it is and, notwithstanding the difficulty of the task, on the basis of the material they have submitted I do not believe that they have shown it is.

The subsequent prosecution of the application.

- 51 The claimants have made much of the conduct of the defendant in the subsequent prosecution of the EP application. Dummett Copp withdrew as the authorized representatives for the application on 14 September 2005. It would appear that up to that point Kevin Raven and Paul Raven were more involved in the prosecution of the application than Robert Williamson. The reason why Dummett Copp withdrew as the representative is not entirely clear. It would appear that they became caught up in the developing dispute between the parties and sought to obtain from either side an agreement that the other would be responsible for controlling the subsequent prosecution of the application. Apparently in the absence of any such agreement from either side Dummett Copp withdrew as representatives.

- 52 No replacement representative was appointed which meant the first named applicant, Robert Williamson, became the common representative for the application. All subsequent correspondence from the EPO was sent to him. In a letter dated 5 Dec 2005 the EPO advised Robert Williamson that the application was deemed as withdrawn for failure to respond to an examination report.
- 53 In addition to the failure to respond to the examination report, there are according to the EPO's register a number of unpaid renewal fees dating back to July 2005. The final date for paying the earliest of these was 31 January 2006. No payment was made by that date. From the evidence it is clear that there was much correspondence between the parties in the run up to that deadline.
- 54 The claimants allege that Robert Williamson's failure to pay these renewal fees negated any interest or right that he had in the patent.
- 55 Robert Williamson argues that he was keen to prosecute the application and that he suggested on several occasions that a way forward would be for the Ravens to select an independent patent attorney to continue with the prosecution of the application. He offered to pay one third of the fees required to at least deal with the outstanding examination report. In the event nothing came of this offer.
- 56 It is not easy to tell whether this was a genuine offer. By this stage there was little or no trust between the two sides and the prosecution of the application was just part of a wider dispute about entitlement to the application and another patent and money allegedly owed by one side or the other.
- 57 However Robert Williamson was aware at that time that he did have added responsibility for the prosecution of the application and as such I believe he carries a greater part of the blame for its failure. If as may have been the case he felt unable to respond fully to the examination report then one option would have been for him to seek to have either Kevin or Paul Raven named as the common representative. This would have enabled Kevin or Paul Raven to continue with the prosecution of the case whilst at the same time not relinquishing any rights he had in the application. Unfortunately as I have noted, by this stage neither side was prepared to give on anything.
- 58 But was the conduct of Robert Williamson such that he in effect relinquished any rights he had in the application? Again the onus is on the claimants to show it was and again notwithstanding the difficulty of doing this, I do not believe that the claimants have made their case on this point.
- 59 The claimants have however sought an order in the event that I find that Robert Williamson is entitled in part to the application that Mr Williamson's name should appear as last named applicant. This would then enable the claimants to continue to seek the prosecution of the application.

- 60 Section 10 extends by virtue of section 12(4) to EP applications with one qualification. The qualification is that I cannot regulate the manner in which an application is to proceed. This qualification would not prevent me from ordering that the application should proceed in the name of just one co-applicant nor would it seem to prevent me from making the sort of order sought here.
- 61 What evidence there is indicates that it was the claimants who were driving the prosecution of the application, at least until the withdrawal of Dummett Copp. It therefore seems fair to allow them to continue to try to do this, notwithstanding their ongoing dispute with Robert Williamson. This is best achieved by making either Paul or Kevin the common representative in the absence of agreement between all the applicants on alternative representation.
- 62 The first task will be to attempt to get the application reinstated. This is a matter for the EPO. It is likely to be difficult although I do not believe that my findings here on entitlement have necessarily made it any more difficult. If the application is reinstated then hopefully all the applicants can work together to secure a patent and then to exploit it. If that doesn't happen then either side is free to return to me for a further order.⁶

Summary and Order

- 63 I find that Robert Williamson is entitled to be named as co-applicant on EP02747592 and is entitled to be granted together with Kevin and Paul Raven any patent resulting from that application.
- 64 I order however that Robert Williamson's name should appear as last named applicant on EP02747592 so that, in the absence of agreement of all the co-applicants as to alternative representation, either Kevin or Paul Raven should be deemed the common representative on the application.

Costs

- 65 Neither side has sought an award of costs and therefore I make no such order.

Appeal

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

P Thorpe
Deputy Director acting for the Comptroller

⁶ See for example BLO/284/03Sheel Khemka v Nana-Akoto Osei for an example of the type of order that might be made.