



PATENTS ACT 1977

BETWEEN

Fireworks Fire Protection Limited

Claimant

and

Andrew Cooke and Kevin Musk

Defendants

PROCEEDINGS

Reference under section 8 in respect
of patent application GB 1006737.9

HEARING OFFICER

Phil Thorpe

Hearing date: 20 May 2011

DECISION

Introduction

- 1 This decision relates to a request to strike out an entitlement reference made under section 8. The case is unusual in that the party seeking entitlement to the patent application does not know what the application discloses.
- 2 The entitlement reference was filed on 15th October 2010 by Fireworks Fire Protection Limited (Fireworks) and relates to application number GB1006737.9 (the application)". The application was filed on 22nd April 2010 and names Mr Kevin Musk and Mr Andrew Cooke as both co-applicants and co-inventors. The title of the application is "An improved Fire Hose System". The application has not yet been published.
- 3 Fireworks seek a determination that it, rather than either of the persons currently named as co-applicants and co-inventors is entitled to the "whole property in and any rights arising out of the making of any invention disclosed or embodied" in the application. It also seeks a determination that Mr William Bridgman and/or Mr Derek Killaspy is or are entitled to be named as the true inventors in preference to either or both of the currently named inventors.
- 4 In their counterstatement the defendants, Mr Cooke and Mr Musk, reject all the claims and request that the case be struck out. A preliminary hearing was held

on 20th May 2011 to consider that request for strike out. At the hearing the defendant was represented by Ms Anna Edwards-Stuart of Counsel instructed by Mr Paul Harrison of Novagraaf. The claimant was represented by Mr William Jones of IP21.

Argument

- 5 Ms Edwards-Stuart's case is simple. She claims that the correct approach for determining entitlement is set out in *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc*¹ where Lord Hoffman notes:

"S.7(2), and the definition in s.7(3), are in my opinion an exhaustive code for determining who is entitled to the grant of a patent. That is made clear by the words "and to no other person." In saying that the patent may be granted "primarily" to the inventor, s.7(2) emphasises that a patent may be granted only to the inventor or someone claiming through him. The claim through an inventor may be made under one of the rules mentioned in paragraph (b), by which someone may be entitled to patent an invention which has been made by someone else (the right of an employer under s.39 is the most obvious example) or the claim may be made under paragraph (c) as successor in title to an inventor or to someone entitled under paragraph (b).

In my opinion, therefore, the first step in any dispute over entitlement must be to decide who was the inventor or inventors of the claimed invention. Only when that question has been decided can one consider whether someone else may be entitled under paragraphs (b) or (c). In many cases, including the present, there will be no issue about paragraphs (b) or (c)...

The inventor is defined in s.7(3) as "the actual deviser of the invention". The word "actual" denotes a contrast with a deemed or pretended deviser of the invention; it means, as Laddie J. said in *University of Southampton's Applications* [2005] R.P.C. 11, [39], the natural person who "came up with the inventive concept." 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] R.P.C. 693, 706; [1999] R.P.C. 442. As Laddie J. said in the *University of Southampton* case, the "contribution must be to the formulation of the inventive concept". 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. Inventors themselves will often not know exactly where it lies.

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. But that, in my opinion, is all. The statute is the code for determining entitlement and there is nothing in the statute which says that entitlement depends upon anything other than being the inventor. There is no justification, in a dispute over who was the inventor, to import questions of whether one claimant has some personal cause of action against the other."

- 6 Ms Edwards-Stuart argues that because the application here has not yet been published, neither Fireworks nor Messrs Bridgman or Killaspy have seen it. They can therefore not identify the inventive concept or concepts of the application and hence are unable to identify the true inventors. As such they have no basis on which to claim entitlement. Since the burden of proof in this

¹ *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc* [2007] UKHL 43 [2008] R.P.C. 1

instance rests with Fireworks and since it is unable to discharge this burden then the reference is doomed to fail and should be struck out.

- 7 Mr Jones for the claimant notes that it is only justified to strike out a reference at its inception if there is no arguable case whatsoever for the case as set out in the claimant's statement. He argues that it is not denied that Mr Cooke and Mr Musk were employed by the claimant at the time the application was filed and that they did not inform the claimant of its filing. The title of the application indicates subject matter which could only lie within the field of the employer. Further a product was marketed which in its marketing material displayed the application number of the application in issue. He concludes by noting that it is

“inconceivable that on these facts, none of which is contested, there can now be deemed without further investigation to be *nothing* in the patent application that might be argued to belong to the Defendants ex-employer and that *no* case exists to be examined under Section 39(1); and that this current reference must be dismissed with no evidence yet having been filed by either side”.

Comptroller's power to strike out a reference

- 8 Rule 83 of the Patent Rules 2007 as amended provides that:

- (1) A party may apply to the comptroller for him to strike out a statement of case or to give summary judgment.
- (2) If it appears to the comptroller that—
 - (a) the statement of case discloses no reasonable grounds for bringing or defending the claim;
 - (b) the statement of case is an abuse of process or is otherwise likely to obstruct the just disposal of the proceedings; or
 - (c) there has been a failure to comply with a section, a rule or a previous direction given by the comptroller,

he may strike out the statement of case.

- 9 The power to strike out a reference should however be used sparingly. Often amendment of the pleadings will be more appropriate than striking out.
- 10 Unsurprisingly there is little by way of relevant precedent to help me with the unusual circumstances here. I did bring to the attention of the parties the IPO decision in *Joseph Toland v Peter Coates-Smith*². In that case a reference under section 8 in respect of two unpublished applications was struck out inter alia because it was not clear what the dispute was really about. Mr Jones seeks to distinguish the situation here by arguing that in *Toland* there were also other factors that contributed to the decision to strike out – want of prosecution

² *Joseph Toland v Peter John Coates-Smith* BL O/079/08

and also the termination and abandonment of the unpublished applications. He also argues that it is clear what the dispute is about here.

- 11 The Hearing Officer in *Toland* was clearly mindful of the claimant's lack of specific knowledge of the inventions. In paragraph 2 the Hearing Officer notes:

"It is possible to bring a reference under section 8 even before an application has been filed, but in such a case there must be a duty on the claimant to specify clearly in his statement what he believes the invention is in which he is seeking rights. In the present case, the statement contains only the vaguest suggestion of several ideas that might underlie the invention(s)."

- 12 In that case the Hearing Officer read the specifications and compared them with what was perceived to be the invention by the claimant. He concluded that there was not enough in common between the two to enable the proceedings to continue. So in the context of that case knowledge of the inventions was considered necessary. That decision is however a very short decision. It was not necessary to set out for example the basis on which entitlement was sought. And as Mr Jones points out there were a number of other factors that appear to have contributed to decision to strike out. Hence I do not think it provides me with much assistance. Neither side was able to present any other relevant authorities.

- 13 Turning now to the facts of this case, I need to determine whether Fireworks has any reasonable ground for bringing the claim. I will consider first the claim that Mr William Bridgman and/or Mr Derek Killaspy is or are entitled to be named as the true inventors in preference to either or both of the currently named inventors. I can be brief. Without knowledge of what inventive concept or concepts is or are disclosed in the application, then in my opinion it is simply not possible for the claimant to succeed with any case relating to inventorship. Here the title of the application provided by the applicant, "An improved Fire Hose System", does not in my view provide sufficient information of what the invention is. Hence there is no reasonable ground for bringing that part of the claim as it currently stands.

- 14 I turn now to the claim that Fireworks is entitled to any rights in the application. To the extent that Fireworks claim entitlement through the claimed inventorship of Messrs Bridgman and Killaspy, then that claim for the reasons given above also has no real prospect of success as things currently stand.

- 15 The position of Fireworks' claim that even if Messrs Cooke and Musk are the inventors then the invention would still belong to Fireworks by virtue of their employment of Messrs Cooke and Musk is in my opinion less clear cut. This is because the question of who is the true inventor does not arise. Fireworks is accepting for this part of its claim that Messrs Cooke and Musk are the true inventors. Hence the first step set out by Lord Hoffmann in *Yeda* has already been reached. The question then becomes is someone else entitled under section 7(2)(b) or (c). Fireworks claims it is so entitled by virtue of the operation of section 39(1). But is it possible for Fireworks to show this if it does not know precisely what the invention is that is disclosed in the application? All it knows

at this moment is, from the title³ that the invention relates to “An improved Fire Hose System”.

16 Section 39(1) provides that an invention made by an employee shall be taken to belong to his employer if:

(a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

17 To succeed on this part of its claim Fireworks will need to provide evidence showing that the duties, circumstances and responsibilities of Messrs Musk and Cooke were such that the making of any invention relating to an improved fire hose system belongs to it. Such evidence in my opinion does not necessarily require a detailed knowledge of the invention. That it relates to an improved fire hose system may be sufficient. Therefore on balance I think that this part of the claim may involve a reasonable ground for bringing the claim. If however during the subsequent prosecution of the case that no longer seems to be the position then the question of strike out can be revisited.

18 So on the question of striking out, I am minded to strike out those parts of the claim requiring a determination of inventorship but not that part of the claim seeking entitlement on the basis of an acceptance of Messrs Musk and Cooke as the inventors of the invention. But is there an alternative to striking out so much of the claim? Could the claim be somehow amended?

19 As I have mentioned, the defendants have marketed a product explicitly linked to the application. Mr Jones advises me that the claimant was unaware of this when it submitted its original claim. Hence one option might be for the claimant to base its claim on this product. In other words it could seek a determination as to who is entitled to the grant of a patent for the invention encapsulated in that product. This could also consider entitlement flowing from a claim that the product was invented by Messrs Bridgman and Killaspy. This was a possibility I invited Mr Jones and Ms Edwards Stuart to consider. Mr Jones, whilst receptive to the idea emphasises that his client would not wish to relinquish any rights to anything in the application that extends beyond the product.

20 Ms Edwards-Stuart observes that amending the claim to cover the product would be equivalent to making a new claim and as such it would be far better to strike out the existing reference in its entirety. Notwithstanding that I am not minded to do that, I am also not convinced that amending the existing claim to focus on the particular product would constitute making a new claim. The

³ Rule 12(6) provides that the title of the invention must indicate the matter to which the invention relates.

original claim is claiming entitlement to any invention in the application. The defendants have marketed a product that is supposedly covered by the application. Hence any such amendment could be considered a narrowing of the claim to in effect a particular embodiment as represented by the product. Ms Edwards-Stuart however makes a further more pertinent observation. This is that irrespective of what form the claim might take now, it is virtually certain that the claimant will want to amend it once the application is published. Having listened carefully to Mr Jones I believe she is right. Further amendment of the claim may indeed be sought upon publication. The application is due to be published soon after 13 September 2011 unless of course it is withdrawn. This is roughly 3 months from the date of this decision.

- 21 Mr Jones emphasises the various case management powers that I have in particular that of staying proceedings⁴. It is not difficult to see why he might favour a stay now of say 4 months as this would allow his client to consider the contents of the application and if necessary seek to file an amended claim. Had I been minded to strike out the whole of the claim at this point then I would not have considered the possibility of staying the proceedings. But since I have decided not to strike out the whole reference then it is something I should now consider.
- 22 There are certainly some attractions to staying the case. The alternative of allowing the claim, albeit in a limited form based either solely on the section 39 claim or that claim together with one based on the product, to proceed to the evidence rounds before the application is published runs the risk of pushing up the cost of the proceedings. The likelihood of the claimant seeking further amendments to its pleadings may also delay the proceedings.
- 23 Would such a stay be unfair to the defendants? It is not ideal but I do not believe it would necessarily be unfair. To the extent that it somehow results in the claimant incurring extra costs then that is something that can be considered when I decide on costs in just the same way that any extra cost incurred as a result of either side seeking to amend the pleadings can be taken into account.
- 24 I am also aware of at least two further actions before the comptroller involving the same parties. These are both entitlement and inventorship disputes albeit in respect of different patents. They are at a slightly less advanced stage than this case. From a brief review of the various statements on those cases it is clear that they raise many of the same issues as here. In the interests of saving expense for the parties and also with a view to ensuring that a disproportionate share of the comptroller's resources is not allotted to these cases there may be benefit in consolidating the respective proceedings as much as possible. A stay of this case for 4 months could I believe facilitate such consolidation.

Conclusion and Order

- 25 I have decided to strike out much of the claim but not that part which recognises the currently named inventors as the true inventors. I have also decided to stay proceedings for 4 months.

⁴ Rule 82

26 I therefore order that:

- 1.those grounds which the claimant relies on which necessitate a determination as to who is the inventor or inventors of the inventions disclosed in patent application GB 1006737.9 be struck out.**
- 2.that the reference proceed solely on the basis of the ground which accepts Messrs Musk and Cooke as the true inventors but which seeks entitlement by virtue of the claimant's employment of those persons. No amended statements of case are necessary in this respect.**
- 3.the proceedings in respect of the remaining ground be stayed for 4 months from the date of this decision. At that time if the reference has not been withdrawn or an amended statement has not been submitted by the claimant, then the claimant will have 4 weeks from that date to file its evidence in chief in respect of the original ground not struck out by this decision.**

Costs

27 The matter of costs was not discussed at the hearing. I will therefore defer making any order at this time. I will however in due course invite the parties to make submissions on costs in respect of the matters covered by this decision.

Appeal

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

PHIL THORPE