



2 September 2011

PATENTS ACT 1977

PARTIES Bayer Materialscience AG, Technogel
Italia S.r.l., Andreas Hoffman, Ebert
Heinz-Dieter and Matteo Mason

ISSUE Reference filed under Section 37 and
application filed under Section 13(1) in
respect of EP(UK) 1928927

HEARING OFFICER A R BUSHELL

DECISION

- 1 European patent (UK) No. 1928927 proceeded to grant in the name of Bayer Materialscience AG. There were two inventors, Andreas Hoffmann and Ebert Heinz-Dieter.
- 2 Bayer Materialscience AG has made an application under rule 10(2) of the Patents Rules 2007 to the effect that Matteo Mason ought also to have been mentioned as a joint inventor. They have also filed a reference under section 37 of the Patents Act 1977 requesting that Technogel Italia S.r.l. be named as a co-proprietor by virtue of their contract of employment with Matteo Mason. A statement of grounds has been filed by Bayer Materialscience AG to initiate these proceedings.
- 3 Bayer Materialscience AG, Andreas Hoffmann and Ebert Heinz-Dieter have confirmed in writing they consent to Matteo Mason being named as a joint inventor and that consequently Technogel Italia S.r.l. should also be added as a co-proprietor.
- 4 Matteo Mason has provided written consent for his name to be added to the list of inventors for patent number EP(UK) 1928927 and for Technogel Italia S.r.l. to be named as a co-proprietor. Technogel Italia S.r.l. has also provided written consent for these changes to be made.

The law

- 5 The proceedings have been brought under section 37 of the Patents Act 1977 and rule 10(2) of the Patents Rules 2007, the relevant parts of which read:

Section 37

37.(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question-

(a) who is or are the true proprietor or proprietors of the patent

(b)..

(c)..

and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.

Rule 10

10.(1) An inventor or joint inventor of an invention, if not mentioned in any published application for a patent, or in any patent granted, for the invention, must be mentioned in an addendum or an erratum to the application of patent.

(2) A person who alleges that any person ought to have been mentioned as the inventor or joint inventor of an invention may apply to the comptroller for that person to be so mentioned-

(a) In any patent granted for the invention; and

(b) If possible in any published application for a patent for the invention

and if not so mentioned, in the manner prescribed by paragraph (1).

(3)..

(4)..

- 6 Also relevant is section 39, which reads:

7 Section 39

39.(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes 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.

Conclusion

- 8 On the basis of the information provided, I accept the facts of the case as set out in the statement provided by Bayer MaterialScience AG, that is, that due to an error the patent application was filed incorrectly. In view of the consent filed by those involved, I conclude that all parties agree that Matteo Mason should be named as a co inventor and therefore under Section 39 Technogel Italia S.r.l. should also be named as co proprietors.

Findings and order

- 9 Accordingly I find that Matteo Mason is entitled to be named as a co inventor in respect of patent number EP1928927. I also find that Technogel Italia S.r.l. are entitled to be named as co proprietors on this patent. I direct that the patents register be updated and an addendum slip prepared to reflect this finding.

A R BUSHELL

B3 Head of Litigation Section, acting for Comptroller