

08 February 2012

PATENTS ACT 1977

BETWEEN

Mr Andrew Cooke	Claimant
and	
Watermist Limited	Defendant

PROCEEDINGS

Reference under section 8 in respect
of patent application GB 0805683.0

HEARING OFFICER

Phil Thorpe

PRELIMINARY DECISION***Introduction***

- 1 This decision is one of three that have dealt with strike-out requests in three separate entitlement actions involving essentially the same parties¹. In this instance it relates to an entitlement action launched under section 8 by Mr Andrew Cooke in respect of patent application GB 0805683.0. Mr Cooke claims that he should be named as co-inventor and co-applicant. The patent application in issue was filed on 28 March 2008 and names the defendant here, Watermist Limited as the applicant and its employee Mr William Bridgman as the sole inventor.
- 2 The patent application was published as GB 2458689 A on 30 September 2009. It relates to a fire suppression unit comprising a hose-reel, pump and motor all housed in a cabinet and capable of producing a fine mist or fog of water droplets. The patent was granted on 23 February 2011.

The reference

- 3 Mr Cooke's case is basically that whilst he was employed by Fireworks Fire Protection Limited ("Fireworks") he worked with Mr Bridgman to devise the invention set out in GB 0805683.0. He goes on to claim that the invention, or more precisely the part of the invention that he contributed to, does not belong to his then employee as none of the conditions set out in section 39(1) apply. It

¹ See also BL O/201/11 and BL O/048/12

is not necessary here to set out those conditions or to elaborate in any more detail Mr Cooke's claim.

- 4 Watermist filed its response to the reference on 28 April 2011. It rejected the claims of Mr Cooke and instead sought a declaration that Mr William Bridgman should continue to be named as the sole inventor and Watermist as the sole applicant. In addition it also sought the striking out of the proceedings. It is to that last point that this decision is directed.
- 5 Both sides are content for me to decide the matter on the basis of the papers already submitted.

Comptroller's power to strike out a reference

- 6 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.

- 7 The power to strike out a reference should however be used sparingly. Often amendment of the pleadings will be more appropriate than striking out.

The arguments

- 8 Watermist bases its request to strike out the reference on the following grounds:
 - a. That Mr Cooke has misstated in his statement the alleged invention.
 - b. He has failed to provide any evidence to support his claim.
 - c. That since 2008 and up to around sometime shortly before when the reference was made, Mr Cooke continued to work for "the Watermist/Fireworks Group and during that time made no claim to entitlement to the invention.
 - d. That some five months before making this reference, Mr Cooke was accused of infringing the patent and that only after many exchanges of correspondence on that did Mr Cooke raise the issue of his entitlement to the invention.

- 9 I invited Mr Cooke to respond solely to Watermist's request that the reference be struck out. In his submission Mr Cooke accepted that he had erred in his description of the invention. He sought in response to amend his original statement. I accept this request. To the extent that it results in the defendant being put to additional expense, and given the relatively minor nature of the amendment I struggle to see how it would, then this can be taken account of in any later order for costs.
- 10 In respect of his failure to date to provide any evidence then Mr Cooke rightly points out that the evidence rounds have not yet commenced.
- 11 As for his apparent delay in launching the proceedings then he points out that the Patent Act clearly sets out the time period for filing entitlement proceedings and that he is within that time period. The time period he refers to is set out in section 37(5) and extends up to 2 years from the date of the grant of the patent. There is no requirement other than this in the legislation in relation to when an entitlement action needs to be brought. This is not surprising since a party may want to see first whether a patent is granted and also what is the nature of the invention claimed in the granted patent. To borrow the words of LJ Jacob, he may wish to see first if there really is a bone worth fighting over. Hence I can see nothing in the timing of the reference that would warrant such a drastic action as striking out.
- 12 I have carefully read both statements of case. There is clearly a difference in opinion as to who contributed what. That however is entirely normal in entitlement disputes and which view prevails will be determined by the evidence that each side is able to put forward in the forthcoming evidence rounds. If after the evidence rounds are complete, Watermist is still of the opinion that there is no arguable case then it can come back to me with a further request that the reference is struck out. For the time being I am satisfied that Mr Cooke has a reasonable case to bring.

Order and costs

- 13 I refuse Watermist's claim that the reference be struck out. The parties will be contacted shortly in respect of the timetable for the evidence rounds.
- 14 Both sides were content for me to decide the issue of costs in line with the published scale². Watermist has failed in its strike-out request and therefore Mr Cooke is entitled to a cost award in its favour. Taking into account that this was a decision on the basis of the papers I believe that an award of £300 in favour of the Mr Cooke is justified.
- 15 I therefore order the defendant, Watermist Limited to pay the Claimant, Mr Andrew Cooke the sum of £300. This sum should be paid within seven days of the expiry of the appeal period below. Payment may be suspended in the event of an appeal.

² <http://www.ipo.gov.uk/p-tpn-42007.htm>

Appeal

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

PHIL THORPE