



PATENTS ACT 1977

BETWEEN

Guy Jackson-Ebben

Claimant

and

Defendant

(1) James Nash
(2) Wine Innovations Limited

PROCEEDINGS

Reference under sections 8, 12 and 37 of the Patents Act 1977 in respect of patent number GB2469554B and related patent applications

HEARING OFFICER

J Elbro

Mr George Schlich of Schlich LLP for the claimant
Mr Michael Deans of MJP Deans for the defendants
Hearing date: 12 September 2013

PRELIMINARY DECISION

Background

- 1 Mr Jackson-Ebben (“the claimant”) has made a reference under section 37 claiming to be entitled to patent number GB 2 469 554 B (“the GB patent”). He seeks to be named as sole or, in the alternative, joint patent proprietor. He has also applied to be named as sole or, in the alternative, joint inventor. He seeks similar remedies in respect of a number of corresponding patents or applications.
- 2 The GB patent was granted on 14 September 2011 to Wine Innovations Limited as sole proprietor, with Mr James Nash identified as the sole inventor. The patent arises from application GB 1005488.0 filed by Wine Innovations Limited on 1 April 2010, which claimed priority from an earlier application, GB 0906430.4, also filed by Wine Innovations Limited.
- 3 The invention in question concerns a method and apparatus for filling and sealing a beverage container, of the kind from which a user may drink directly. The main embodiment set out in the GB patent concerns a filled and sealed plastic wine

goblet.

4 Mr Nash and Wine Innovations Limited (collectively, “the defendants”) dispute the reference and the application regarding inventorship.

5 This Decision relates to a request for disclosure as outlined below. However, it is convenient first of all to outline the shape of the overall dispute.

The Claimant’s case

6 The Claimant’s primary contention is that he is the inventor of the invention and is entitled to the patents and applications in question. He alleges that the work leading up to and including the making of the invention took place between January and April 2009, at a factory in which Wine Innovations Limited operated a beverage filling machine. He alleges that he himself managed the design, manufacture and testing of that machine – and that he performed detailed testing and modification of the machine, which led him to make the invention in question.

7 Further, the Claimant alleges that Mr Nash was not involved at a technical level in the work on the machine at the time that the invention was made, and so is not to be regarded as the inventor.

8 The Claimant’s fall-back position is that, if Mr Nash is to be regarded as an inventor, then he (the Claimant) is nevertheless a co-inventor and is therefore jointly entitled to the patents and applications.

The Defendants’ case

9 The Defendants’ case is that the Claimant is not the inventor and is not entitled to the patents and applications.

10 In particular, the Defendants deny that work leading up to and including the invention took place between January and April 2009, and they deny that it took place at the factory in question. They allege that the Claimant was employed by Wine Innovations Limited as Operations Manager at the factory between January and April 2009, and they admit that he was “involved in work testing and resolving problems in the operation of a filling machine” but they allege that the invention was made by Mr Nash before the Claimant had any connection with Wine Innovations Limited.

11 Further, the Defendants deny that Mr Nash had no technical involvement during the January to April 2009 period.

12 The Defendants further contend that, even if the Claimant had made or contributed to the making of the invention, Wine Innovations Limited would still be entitled to the invention in accordance with section 39 and/or by virtue of the contract under which the Claimant was employed as Operations Manager of Wine Innovations Limited.

Requests for Disclosure

13 In the original statement of claim, the claimants sought as a remedy, *inter alia*,

“Supply by James Nash or Wine Innovations Ltd of the details of any licences or other agreements under which any rights in the Application (or US/EPO applications) have been licensed or transferred or proposed to be licensed or transferred to any third party.”

- 14 This request was unfortunately misunderstood by the Intellectual Property Office as a request for disclosure, and described as such in the initial letter from the Office to the defendants. I should make clear that this was not an order by a hearing officer (who would not have seen the case at that stage), but an administrative action intended to summarise requests made by the claimant which might need attention before any substantive hearing. The defendants pointed out this error in their response of 14 December 2011, but voluntarily disclosed the existence of some licensing agreements and asserted there were no others.
- 15 Subsequent correspondence (9 January 2012) from the claimant challenged this assertion, in particular on the basis of information from a number of websites, including Wine Innovation’s Facebook page, which appeared to imply the existence of other licences. The claimant thus appeared to pursue this as a disclosure request. The defendants responded on 23 January 2012, again denying any obligation to make any disclosure in this respect, but asserting that no contracts had yet been signed in any of the relevant business transactions, despite what might be asserted on the webpages.
- 16 Following an unsuccessful attempt at mediation, and the resolution of a request for summary judgment by the defendants (which in the event was not pursued following a preliminary evaluation), in response to an official letter of 11 March 2013, the claimant indicated on 25 March 2013 that he wished to maintain that disclosure request, and made a further request that the defendants, or in the alternative the defendants’ representative, Mr Deans, be ordered to provide a full and frank disclosure of the files of Mr Deans relating to the patent applications.
- 17 This disclosure request came before me at a hearing on 12 September 2013. A request by the defendants for the involvement of the claimant’s former trustee in bankruptcy was also scheduled for consideration, but this issue was not pursued. In addition, agreement was reached at the hearing on the claimant providing security for costs of £1800.

The Law

- 18 Guidance on the approach to be taken when considering requests for disclosure can be found in *Tribunal Practice Notice (TPN 1/2000)* and is set out in more detail in paragraphs 3.40 to 3.56 of *The Patent Hearings Manual*. I summarise relevant parts of this below.
- 19 Disclosure is not as common in proceedings before the Comptroller as it is in the High Court. It can be costly and discretion must be exercised to keep excessive costs down. In exercising their discretion to make an order for disclosure, hearing officers have traditionally followed principles set out in Order 24 of the old Rules of the Supreme Court. This approach was endorsed by Aldous J in *Merrell Dow*

*Pharmaceuticals Inc's (Terfenadine) Patent*¹. The questions to be considered are:

- *whether the documents concerned relate to the matters in question in the proceedings; and*
- *whether their disclosure is necessary to dispose fairly of the proceedings or to reduce costs*

20 The relevance of documents is not an issue when deciding whether to make an order, but equally from the above it is important to consider the particular matters which are to be decided at the main hearing, as indicated by Aldous J in *Merrell Dow*, where he said:

"The test is whether the documents relate to the matters in question. If they do, then they should be disclosed and their relevance will be decided at trial. To decide whether a document relates to a matter in question, it is first necessary to analyse what are the questions in issue in the proceedings."

21 The hearing officer also has the discretion to refuse to make an order, for example, if the value of the material to the Claimant is outweighed by the burden it would impose on the Defendant, as discussed in *Mölnlycke AB v Procter and Gamble Ltd (No 3)*².

22 Another reason might be if the categories of documents requested were very general and not adequately particularised. In other words, the request amounts to a "fishing discovery", as discussed in *British Leyland Motor Corporation v Wyatt Interpart Co Ltd*³.

23 Finally, the provisions of the Rules of the Supreme Court have now been replaced by the Practice Direction to part 31 of the Civil Procedure Rules 1998, which the Office's practice on specific disclosure should now reflect. This says at 5.4:

"In deciding whether or not to make an order for specific disclosure the court will take into account all the circumstances of the case and, in particular, the overriding objective described in Part 1. "

However, as the hearing officer concluded in *Cerise Innovation Technology Ltd v Abdulhayoglu*⁴, this new approach does not mean that the old tests are to be discarded, but the hearing officer should now additionally put greater emphasis on the principle of proportionality and on the need to deal with proceedings expeditiously.

The Claimant's arguments

24 Mr Schlich for the claimants argued that what licensing agreements exist are relevant to the present dispute because any licensees would retain certain rights if the disputed patent rights were transferred to the claimant. He pointed to what he considered to be the defendants' incomplete disclosure of licensing agreements

¹ *Merrell Dow Pharmaceuticals Inc's (Terfenadine) Patent* [1991] RPC 221

² *Mölnlycke AB v Procter and Gamble Ltd (No 3)* [1990] RPC 498

³ *British Leyland Motor Corporation v Wyatt Interpart Co Ltd* [1979] FSR 39 at pages 44-45

⁴ *Cerise Innovation Technology Ltd v Abdulhayoglu* BL O/177/99

relating to South Africa and argued that this showed that the defendants were only willing to reveal details of licence agreements when specifically challenged. Mr Schlich conceded that this request had only become a disclosure request, as opposed to a remedy sought, following the misunderstanding by the Office referred to above, but considered what he characterised as the defendants “evasiveness” on this issue as justifying disclosure. He also conceded that he did not believe this disclosure necessary to determine the question of entitlement.

- 25 Regarding the disclosure of the file, Mr Schlich argued that correspondence between the parties, which would be on the file, would be relevant to being able to determine who the inventor was. He denied that this was a “fishing expedition”, stating that there was at least one meeting in which the parties were all present in a room discussing the product and process of the invention, and that disclosure of those minutes and all follow-up correspondence on the filing of the patent application should be disclosed. He stated that the claimant had one or two emails from that period, but not all of them.

The Defendants’ arguments

- 26 Regarding the licensing information, Mr Deans argued that this is not relevant to the question of inventorship, and that disclosure of this information would be appropriate only if the claimant were to succeed on that issue. He argued that otherwise the proceedings would descend into a “wholly irrelevant examination of Defendant’s attempts to commercialise the Invention”.
- 27 Regarding the request for Mr Deans’ files, Mr Deans argued that this request was unreasonably wide, including even correspondence relating to these proceedings. He also asserted that he was not involved in the filing of the European, United States, or Australian applications, and that much of his other file had been transferred to other attorneys and was no longer available to him. This last point led to some further submissions after the hearing from both sides about what Mr Deans had previously stated he possessed.
- 28 Mr Dean also argued that disclosure was not usually ordered before the comptroller, and any disclosure ordered should be restricted to the narrow point of what contribution (if any) the claimant made to the making of the invention.
- 29 The defendants also sought for any disclosure to be limited to the claimant’s representative, indicating that the defendants were concerned that any information disclosed might be used by the claimant to attempt to discredit the defendants, as the defendants alleged the claimants had done previously. While disputing the allegations or the need for such a confidentiality restriction, the claimant was willing to agree to this.

Discussion

- 30 The underlying question to be answered during these proceedings is who actually invented the invention in the patents, in particular the contributions (if any) made by Mr Nash and Mr Jackson-Ebben and whether Mr Jackson-Ebben was an employee of Wine Innovations at the relevant time.

- 31 The claimant does not appear to have put forward any real argument which shows that the licensing information is related to this question. The subsequent licensing of the invention appears to bear no relationship whatsoever to whatever happened in the making of the invention. The information might be relevant to the remedies, if I were to find in the claimant's favour – and as noted this was the original claimant's case – but that is something to be considered at that stage. The forthrightness or otherwise of the defendants on this matter – regarding information they have not been obliged to disclose – seems to me to be of no relevance in this context.
- 32 At first blush, the file on the patent application more closely relates to the underlying question, as it may have information in it which covers the time period in which the invention was made. However, the claimant has not, in my view, sufficiently identified what material they believe to be in the file that would bear on the question. The closest he came was to refer to minutes of meetings that are said to have occurred, but without a clear indication as to what is alleged to have transpired that will be shown by such minutes. The degree to which this was a clear specification of the documentation to be disclosed was further undermined by reference to all subsequent correspondence relating to these meetings.
- 33 Overall, the impression is given that the claimant is embarking on a “fishing expedition”, hoping that there will be something in the file that they can make use of. Bearing in mind the guidance in *British Leyland* referred to above, I believe making an order for disclosure of the file would not be proportionate in this case, and unnecessarily add to the costs for the defendant.
- 34 In coming to this conclusion I have not been swayed by Mr Dean's arguments that he no longer has the file in question. Had I believed it necessary, I would have ordered disclosure by the defendants, who would then have needed to obtain it from wherever it currently resides (or explain what has happened to it).

Conclusion

- 35 I therefore refuse the claimant's requests for disclosure. In light of this, I do not need to consider the defendants' requests for confidentiality in the event that I ordered disclosure.

Appeal

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

J ELBRO

Divisional Director acting for the Comptroller