



**PATENTS ACT 1977**  
(THE PATENTS RULES 2007)

CLAIMANT	HAPSS Limited
DEFENDANT	John G. Bowen
ISSUE	Application to strike out a reference under section 12(1) in respect of European patent application EP1658101
HEARING OFFICER	H Jones

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**PRELIMINARY DECISION**

**Introduction**

- 1 This preliminary decision relates to an application by Mr John Bowen to strike out a reference under section 12 (entitlement to grant of European patent application) made by HAPSS Limited ("HAPSS") in respect of EP1658101A1 ("the EP application"). The EP application is currently pending in the name of Mr Bowen, and proceedings for grant have been stayed by the European Patent Office ("EPO") under Rule 14(1) of the European Patent Convention upon request by HAPSS. Mr Bowen says that the reference under section 12 should be struck out for the following reasons:
- Mr Bowen is barred from entering the UK, which would prevent him from having a fair and just hearing contrary to the European Convention on Human Rights;
  - none of the shareholders in HAPSS are resident in the UK (four are citizens and residents of the US, one is an "artificial person established in and resident of Ireland", and another is a UK citizen living in Luxembourg); HAPSS has no business in the UK and has not filed accounts with Companies House;
  - an agreement to transfer ownership of the patent application from Mr Bowen to HAPSS is invalid;
  - the proper jurisdiction for deciding this matter is the United States, and an action for Declaratory Relief has already been filed in the US Federal Court in Los Angeles.

**The law**

- 2 The statutory provisions for striking out a statement of case and summary judgment are set out in rule 83:

*83(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.
- (3) The comptroller may give summary judgment against a claimant or defendant on the whole of a case or on a particular issue if -
- (a) he considers that -
    - (i) that claimant has no real prospect of succeeding on the case or issue, or
    - (ii) that defendant has no real prospect of successfully defending the case or issue;
  - and
  - (b) there is no other compelling reason why the case or issue should be disposed of at a hearing.

3 Rule 83(2)(c) says that a statement of case may be struck out if there has been a failure to comply with a section, a rule or a previous direction given by the comptroller. The relevant sections of the Act for the purpose of these proceedings are section 12 and section 82, the relevant parts of which read as follows:

*12.-(1) 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.*

.....

*(3) Subsection (1) above, in its application to a European patent and an application for any such patent, shall have effect subject to section 82 below.*

*82.-(1) The court shall not have jurisdiction to determine a question to which this section applies except in accordance with the following provisions of this section.*

*(2) Section 12 above shall not confer jurisdiction on the comptroller to determine a question to which this section applies except in accordance with the following provisions of this section.*

*(3) This section applies to a question arising before the grant of a European patent whether a person has a right to be granted a European patent, or a share in any such patent, and in this section "employer-employee question" means any such question between an employer and an employee, or their successors in title, arising out of an application for a European patent for an invention made by the employee.*

*(4) The court and the comptroller shall have jurisdiction to determine any question to which this section applies, other than an employer-employee question, if either of the following conditions is satisfied, that is to say -*

- (a) the applicant has his residence or principal place of business in the United Kingdom; or*
- (b) the other party claims that the patent should be granted to him and he has his residence or principal place of business in the United Kingdom and the applicant does not have his residence or principal place of business in any of the relevant contracting states;*

*and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom.*

*...*

*(7) If, after proceedings to determine a question to which this section applies have been brought before the competent authority of a relevant contracting state other than the United Kingdom, proceedings are begun before the court or a reference is made to the comptroller under section 12 above to determine that question, the court or the comptroller, as the case may be, shall stay or sist the proceedings before the court or the comptroller unless or until the competent authority of that other state either -*

*(a) determines to decline jurisdiction and no appeal lies from the determination or the time for appealing expires, or*

*(b) makes a determination which the court or the comptroller refuses to recognise under section 83 below.*

### **Summary of facts and submissions**

- 4 In a letter to the Office dated 4 January 2016, Mr Bowen says that his application for a European patent has already been granted by the EPO and that no reference can therefore be made under section 12. He provides a copy of the grant letter issued by the EPO dated 2 April 2015 as confirmation of this. However, Mr Bowen would have known that the EPO issued a further letter dated 30 April 2015 confirming that the decision to grant a European patent issued on 2 April 2015 was "without effect" pursuant to a request by HAPSS for a stay in proceedings submitted the previous day, i.e. on 1 April 2015. Mr Bowen would have seen this letter through his attorney prosecuting the application, but in any case was also sent it as part of these proceedings.
- 5 In response to Mr Bowen's claim that he would be deprived a fair hearing in this matter by his being barred from entry into the UK, HAPSS, represented in these proceedings by Mr Cordina of Olswang LLP, says that any difficulty of Mr Bowen entering the UK does not affect the statutory jurisdiction to determine questions of entitlement to a patent provided by section 82 of the Act. He also points to the third witness statement of Mr Sandle, the Chief Executive of HAPSS, who says that he is aware of at least two occasions when Mr Bowen had travelled to the UK after his release from prison, which suggests that there is a contradiction in what he claims to be fact and his actual behaviour. Mr Bowen was given an opportunity to respond to this point but did not to do so.
- 6 Mr Cordina says that the comments of Mr Bowen with regard to the residence of HAPSS' shareholders are irrelevant since the claimant in these proceedings is the company itself, which according to Mr Sandle's third witness statement is active and up to date with all UK filing requirements at Companies House.
- 7 The final point to note concerns Mr Bowen's reference to an action for Declaratory Relief already filed in the US Federal Court, which he says is the proper venue to resolve this ownership dispute. In his third witness statement, Mr Sandle says that the US court action mentioned by Mr Bowen does not concern the European patent application in question. A copy of the complaint document (reference 2:15-cv-08438) filed at the US District Court is submitted in evidence by Mr Bowen, which seeks judicial determination of entitlement to US patents US7862784, US9056145 and US7018592, as well as "other and further relief as the court may deem just and proper". Paragraph 20 of the complaint document alleges that the plaintiff, Mr Bowen, is entitled to a "declaratory judgment from the court finding that [Mr Bowen]

is the sole and exclusive owner of the patents including foreign and continuation in part filings attached to the aforementioned specific patents." Mr Bowen says that since HAPSS was properly served this complaint "according to international conventions" and has answered it, HAPSS must be taken to have voluntarily submitted to "another jurisdiction", i.e. the United States Federal Court. Mr Cortina denies that HAPSS has submitted to any jurisdiction other than the UK. He also notes that an action in the US is in any case irrelevant to section 82 of the Act because section 82(4) refers to "jurisdiction of a relevant contracting state", and the US is not a relevant contracting state.

## **Assessment**

- 8 I shall deal with Mr Bowen's third ground for strike out first, i.e. that the agreement to transfer ownership of the patent application from Mr Bowen to HAPSS is invalid. On the basis of the evidence and arguments before me, I find that Mr Bowen has not shown that there is no reasonable ground for bringing this reference under section 12. Although submitted in rather unconventional form, HAPSS' statement of case describes how the terms of an agreement to transfer rights in the European patent from Mr Bowen to HAPSS have not been met. Mr Bowen may well be right to say that the agreement to transfer ownership of the patent is invalid, but the time to decide upon this is when all the available evidence has been submitted and when all arguments have been fully advanced.
- 9 Mr Bowen argues that the proper jurisdiction for deciding this matter is the United States, and refers to an action for Declaratory Relief filed in the US Federal Court. The copy of the complaint document submitted by Mr Bowen refers to three US patents by number and also " foreign and continuation in part filings attached to the aforementioned specific patents". The complaint document does not specify the application numbers of these filings.
- 10 I note that the published specification of US7862784B2 shows that the application was filed on 5 May 2010 as a continuation of application of US12/008,038, filed on 8 January 2008, which is itself a continuation-in-part of application US11/210,217 filed on 22 August 2005. The published specification of US9056145B2 indicates that the application was filed on 14 December May 2011 as a continuation-in-part of application of US13/136,446, filed on 1 August 2011, which is a continuation-in-part of application US12/925,912, filed on 2 November 2010, which is a divisional application of US7862784. The published specification of US7018592B2 indicates that it was filed on 26 June 2002 as application US10/180,845.
- 11 The priority application of the European patent is US10/626,373, filed on 24 July 2003. This priority application number is not recorded against any of the US patents above, which supports Mr Sandle's statement that the US court action mentioned by Mr Bowen does not relate to the European patent application in these proceedings. Mr Cordina suggests that this does not necessarily matter because section 82 of the Act quite clearly states that the comptroller or court in the United Kingdom has jurisdiction to determine the question of entitlement to a European patent application when i) the party making the reference under section 12 has his residence or principal place of business in the United Kingdom, ii) the applicant does not have his residence or principal place of business in any of the relevant contracting states, and iii) there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the

United Kingdom. Mr Bowen is resident in the US, which is not a relevant contacting state to the European Patent Convention. The evidence shows that HAPSS has its principal place of business in the United Kingdom, so I agree with Mr Cordina that the comptroller has jurisdiction to determine this reference under section 12.

- 12 The final point to consider is Mr Bowen's claim that he will be denied a fair hearing due to his bar from entering the United Kingdom. Mr Bowen has not submitted any evidence to substantiate this claim, and the evidence of Mr Sandle is that Mr Bowen has indeed travelled to the United Kingdom after his release from prison, contradicting Mr Bowen's claim. Although this point was not mentioned by either side, Practice Direction 32 of the Civil Procedure Rules (paragraph 29 and Annex 3) sets out circumstances in which videoconferencing can be used in civil proceedings, and this facility may be of assistance to Mr Bowen if his claim that he is barred from entering the United Kingdom is true. As it stands, I do not have sufficient evidence to say whether it is true or not, and I cannot strike out HAPSS' statement of case on this basis.

### **Conclusion**

- 13 I am satisfied that HAPSS' reference under section 12 meets the requirements of the Act. In addition, Mr Bowen has not been able to demonstrate that HAPSS' statement of case discloses no reasonable grounds for bringing a reference under the said section. Section 82 of the Act gives the comptroller jurisdiction to determine questions as to entitlement to European patent applications, so I refuse Mr Bowen's application to strike out.

### **Appeal**

- 14 Any appeal must be lodged within 28 days after the date of this decision.

**H Jones**

Deputy Director acting for the Comptroller