

PATENTS ACT 1977

CLAIMANT

Kwix UK Ltd

PROCEEDINGS

References under sections 8 and 12 in
respect of:

UK application GB1107673.4
PCT application PCT/GB2012/051012
EP application EP12725871.3

HEARING OFFICER

H Jones

DECISION

Introduction

- 1 In my preliminary decision dated 11 November 2020 ([BL O/563/20](#)), I allowed the Joint Trustees of the Bankruptcy Estate of Matthew Murphy (“the JTIB”) a period of six weeks to inform the Office whether they wished to contest the claimant’s references to entitlement of UK patent application GB1107673.4 filed on 9 May 2011, PCT patent application PCT/GB2012/051012 filed on 9 May 2012 and the EP regional phase application arising from the PCT application, namely EP12725871.3 (collective referred to as “the Applications”). The UK patent application served only as a priority application for the PCT application and has since been terminated.
- 2 The Office has not heard from the JTIB, so I must treat the reference as uncontested, i.e. accepting the facts of the case to be those described in the claimant’s supporting documentation. These facts are summarised at paragraphs 55-60 of my preliminary decision.

The Law

- 3 The relevant parts of sections 8 and 12 read as follows:

8.-(1) At any time before a patent has been granted for an invention (whether or not an application has been made for it) -

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or

(b) any of two or more co-proprietors of an application for 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 and may make such order as he thinks fit to give effect to the determination.

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

...

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.

Order & Declaration

- 4 On the basis of the claimant's evidence presented in this case and for the reasons set out in my preliminary decision, I am satisfied that the claimant, Kwix UK Ltd, is entitled to be granted any such patent for the invention set out in the Applications. The invention was devised by Matthew Murphy, but the rights, title and interest in all patents arising from the invention belongs to Kwix UK Ltd as a precondition of the investments made in commercialising the invention. As noted above, GB1107673.4 has been terminated, so no declaration under section 8 appears necessary. I declare that:

whereas the comptroller has jurisdiction under sections 12 and 82 of the Patents Act 1977 to determine questions concerning entitlement to foreign and convention patents, and

whereas the comptroller shall determine the questions so far as he is able to and make such order as he thinks fit to give effect to the determination,

Kwix UK Ltd is entitled to the grant of European patent application EP12725871.3 and any/all applications arising from PCT/GB2012/051012.

Costs

- 5 In my preliminary decision I said that I would invite the parties involved in the proceedings up until that point to make detailed submissions on costs once it had become clear whether a full hearing was required.
- 6 The claimant wrote to the Office on 5 January 2021 asking that directions be issued in relation to the consequential matters arising out of my preliminary decision and suggested that it would like the opportunity to make submissions on the appropriate cost order against Mr Murphy, anticipating an off-scale award based on the significant expense to which the claimant had been put by Mr Murphy's actions. The claimant wrote again on 11 February 2021 to say that it did not intend to make submissions on costs. I therefore make no such order despite the fact that the claimant has won its case.

Huw Jones

Deputy Director, acting for the Comptroller