Intellectual Property Office

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PATENTS ACT 1977

CLAIMANT	Close Brewery Rentals Limited
DEFENDANT	Geco Holdings Limited
ISSUE	References under sections 12, 13 and 37 and rule 10 in respect of UK patent GB2571465
HEARING OFFICER	H Jones

Mr Usman Tariq (instructed by Cameron Intellectual Property) for the Claimant
Mr Jamie Muir Wood (instructed by Mohun Aldridge Sykes) for the Defendant

Hearing dates: 9 & 10 February 2021

DECISION

Introduction

1 Patent number GB 2571465 for "A Receptacle Washing Device" was filed on 15 May 2019 and was granted to MD Engineering Solutions Limited (MDES) on 18 February 2020. MDES assigned the patent to the defendant, Geco Holdings Limited (Geco), on 22 January 2020, and this assignment was registered with the Intellectual Property Office on 20 February 2020.

2 On 6 March 2020, the claimant, Close Brewery Rentals Limited (CBRL), initiated proceedings by filing a statement of case before the comptroller under sections 12,13 and 37 of the Patents Act 1977. CBRL asserts that it, rather than Geco, should be registered as the proprietor of the patent, and that Mr Gary Phillips and Mr Neil Cashman of CBRL are the true inventors rather than Mr David Hallas and Mr Matthew Horsey of MDES/Geco. Alternatively, CBRL seeks determinations that it be included in addition to Geco as a proprietor and that Mr Phillips and Mr Cashman be named as joint inventors along with Mr Hallas and Mr Horsey. Geco disputes these claims.

3 Following the normal evidence rounds, the issue came before me at a two-day hearing held on 9 and 10 February 2021. The claimant was represented by Mr Usman Tariq of Ampersand Advocates, instructed by Cameron Intellectual Property. The defendant was represented by Mr Jamie Muir Wood of Hogarth Chambers, instructed by Mohun Aldridge Sykes.

Conduct of the hearing

4 Due to the coronavirus restrictions in place at the time, the hearing was held entirely

remotely via Microsoft Teams®. From my point of view the hearing ran as smoothly as one could have hoped for and I am grateful to the parties and their witnesses for their flexibility and willingness to make the somewhat unusual arrangements work. In particular, I wish to thank the parties for working together to provide such a well-structured electronic bundle, which made the task of referring to the relevant evidence at the hearing extremely straightforward.

The claimed invention

5 The granted patent contains only one independent claim, as follows:

> An automated keg and/or cask cleaning device comprising:
>
> an inlet into which a keg or cask can be inserted;
>
> a keg or cask securing device to hold and secure the keg or cask in place during cleaning;
>
> an ultra-high-pressure water lance that is arranged to be inserted into and removed from the secured keg or cask;
>
> an outlet that is separate from the inlet and from which the keg or cask is output once cleaned;
>
> wherein the water lance dispenses water at a pressure between 150,000kPa and 275,000kPa.

6 There are some dependent claims (including a method claim, claim 10, for cleaning a keg with said automated keg cleaning device), but the claimant and defendant were content for me to decide the issue on the basis of the independent claim.

Background to the invention

7 I will not say much about the timeline of the events leading to the invention at this stage, as it will be necessary to consider this and the other evidence in some detail later. However, it will be helpful to set out some of the background to these proceedings to provide the context for what follows. Although there are differences between the position of the claimant, CBRL, and the defendant, Geco, I do not think there can be any material disagreement over this brief overview.

8 CBRL provide a keg and cask rental service to the brewery industry. In the course of providing this service they clean the kegs and casks, both externally and internally. This invention is only about the internal cleaning of casks and kegs. Conventionally in the industry, this has been done using a caustic cleaning solution.

9 Prior to September 2015, CBRL had been using an ultra-high-pressure (UHP) water pump to clean the external surfaces of kegs and casks. During the course of September 2015, Mr Gary Phillips and Mr Neil Cashman of CBRL had the idea of using a UHP water pump for the purpose of cleaning the internal surfaces of the casks and kegs.

10 In January 2016, CBRL engaged the services of Mr Colin McCrorie, an independent

consultant in the brewing sector, whose role was to create a design brief and to oversee management of a project to develop a system for using UHP water to clean the internal surfaces of kegs and casks. Also in January 2016, having failed to get a helpful response to their enquires with their existing UHP pump supplier (Hughes), CBRL entered into discussion with a different pump supplier, Calder Limited, along with their German partner, Hammelmann GmbH.

11 At around the same time CBRL also engaged the services of a consultant metallurgist, Mr Eric Partington. Mr Partington's responsibility was to pronounce on a metallurgical evaluation of the cleaned kegs, and to that end he commissioned Westmoreland Mechanical Testing and Research Ltd to microscopically assess the effectiveness of the UHP cleaning process based on cleaned keg samples. Westmoreland provided a report in February 2016.

12 Hammelmann, under instruction from CBRL and Calder, undertook some initial cleaning tests on 7 March 2016. They undertook some further cleaning trials on kegs with UHP water on 5 April 2016; the report of those tests is dated 17 May 2016. Mr Phillips and Mr Cashman witnessed these further tests, along with Mr Partington.

13 On the basis of the Westmoreland and Hammelmann reports, CBRL determined that UHP water could indeed be used to clean the interior of kegs and casks to the required standard.

14 In late March or early April of 2016, Mr Phillips contacted Mr Hallas of MDES to discuss the possibility of building an automated cask/keg washer system that would work with a Calder UHP pump/lance, together with some robots already purchased by CBRL. MDES provided a budget cost proposal on 11 April 2016.

15 Mr McCrorie prepared a design brief and e-mailed it to Mr Phillips on 22 July 2016. There is no evidence that this design brief was ever shown to MDES.

16 Some further tests were conducted by Hammelmann and another set of reports were provided to CBRL dated 30 January 2017.

17 Another quotation was provided by MDES to CBRL on 31 May 2017 and it was on the basis of this that MDES was formally commissioned to develop, construct and commission the automated cask/keg washer system at CBRL's site.

18 CBRL filed patent two applications relating to different aspects of cleaning the internal surfaces of brewery containers, clearly following on from their UHP idea. GB2575143 was filed on 1 April 2019 and was granted on 10 June 2020. GB2575414 was filed on 11 November 2019 and granted on 3 June 2020. Both patents list Mr Phillips as the sole inventor. The ownership and inventorship of these patents is not in dispute in these proceedings.

19 MDES filed a patent application on 15 May 2019, which was granted on 18 February 2020 as UK patent GB2571465B, and it is this patent that is in dispute in these proceedings. The patent was assigned to Geco Holdings Limited, the current owner of the patent, on 22 January 2020. Geco was set up by MDES to separate its intellectual property assets from its manufacturing and servicing activities. MDES has since entered into liquidation.

The witnesses and evidence

20 There have been two rounds of evidence. Evidence for CBRL was given by Mr Phillips and Mr Cashman, each of whom provided two witness statements and accompanying exhibits. Evidence for Geco was given by Mr Hallas and Mr Horsey. Mr Hallas has provided two witness statements, and Mr Horsey just one, together with accompanying exhibits.

21 Even though I made it clear at an early stage of proceedings that I did not think expert evidence would be of much assistance, CBRL and Geco have nonetheless each filed a report from an expert – Mr Eric Partington and Professor John Round respectively. Both experts directed themselves to identifying the inventive concept.

22 All six individuals were cross-examined at the hearing.

The claimant's witnesses

23 Mr Phillips provided much of the evidence for the claimant and was therefore subject to lengthy cross-examination by Mr Muir Wood. I found Mr Phillips to be somewhat defensive under cross-examination, perhaps unsurprisingly so, but his answers, though sometimes forthright, were in my view generally honest. My only observation relates to the "missing witness", to quote Mr Muir Wood, that is Mr Colin McCrorie. Even though CBRL's statement of case clearly indicated that Mr McCrorie would provide evidence for the claimant, no such evidence was ever submitted. I found it surprising that Mr Phillips was unable to explain why Mr McCrorie was not appearing as a witness. His evidence could potentially have been useful given his apparently key role in the project - Mr Phillips admitted as much under cross-examination - but ultimately its absence is not decisive.

24 Mr Cashman's witness statements were somewhat less useful than those of Mr Phillips, but under cross-examination he was altogether more straightforward in response to the questions put to him by Mr Muir Wood. Mr Muir Wood accepts that Mr Cashman was an honest witness and notes that he could perhaps have been assisted to give better evidence-in-chief. I agree with that. His evidence under cross-examination was generally helpful.

25 CBRL's expert, Mr Partington, has provided services to CBRL on a consultancy basis. He was involved in the early stages of developing the idea which eventually evolved into the project that led to the patent in question. Given the risk of Mr Partington being somewhat biased by this involvement, I have treated his evidence with a degree of caution, but that said I am content that he tried his best to assist me by answering honestly the questions put to him by Mr Muir Wood.

The defendant's witnesses

26 Mr Hallas was the main witness for the defendant. As was the case with the claimant's primary witness, Mr Phillips, I found Mr Hallas to be somewhat defensive under cross-examination. However, his answers were on the whole consistent with his witness statements.

27 Mr Horsey appeared to me to be a very helpful witness who clearly knew a great deal about the work that MDES had undertaken for CBRL.

28 Mr Tariq suggested to me that both Mr Hallas and Mr Horsey were evasive in their answers and that there was something in their evidence that did not quite ring true. He was referring to their evidence that MDES independently identified the optimum pressure range of 150,000kPa - 275,000kPa during commissioning of the system without any input from CBRL. They consistently refused to agree with Mr Tariq that the optimum pressure must have come from the Hammelmann tests conducted for CBRL. I tend to agree with Mr Tariq's submission that this was pushing at the bounds of credibility, as I shall explain in due course. Mr Tariq also suggested that their answers to his questions about the two MDES quotations provided to CBRL in April 2016 and May 2017 respectively were similarly unconvincing. On that point I am not so persuaded, and I will return to it later.

29 Geco's expert witness is Professor John Round. Professor Round has worked as a consultant for MDES and Geco and continues to provide consultancy services to Geco. Professor Round's insight into the industry was generally helpful. The only point I would note about Professor Round's evidence is that he changed his position on a potentially key issue. His written evidence states that he knew of the idea of cleaning the internal surfaces of kegs using UHP water as long ago as 1983, but at the hearing he corrected his statement. The 1983 reference was merely to high pressure, not UHP.

The law

30 Section 37 of the Patents Act 1977 deals with determining disputes over who is entitled to a patent which has already been granted. The relevant parts of that section read as follows:

> *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) whether the patent should have been granted to the person or persons to whom it was granted, or*
> > *(c) whether any right in or under the patent should be transferred or granted to any other person or persons;*
>
> *and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.*
>
> *(2) Without prejudice to the generality of subsection (1) above, an order under that subsection may contain provision -*
>
> > *(a) directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent; ….*

31 Section 13 of the Act and rule 10 of the Rules deal with the right of an inventor to be mentioned in a patent. The relevant parts read as follows:

> *13(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.*

(2) …

(3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.

Rule 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 or patent.

10(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).

32 Section 12 of the Act relates to questions about entitlement to patent applications under foreign or international law. The relevant part is:

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.

33 The leading authority on entitlement is the judgment of the House of Lords in *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc*[1]. Here Lord Hoffman notes:

18. S.7(2), and the definition in s.7(3), are in my opinion an exhaustive code for determining who is entitled to the grant of a patent…

and goes on to say:

20. The inventor is defined in section 7(3) as "the actual deviser of the invention". The word "actual" denotes a contrast with a deemed or pretended deviser of the invention; it means, as Laddie J said in University of Southampton's Applications [2005] RPC 220, 234, the natural person who "came up with the inventive concept." It is not enough that someone contributed to the claims, because they may include non-patentable integers derived from prior art: see Henry Brothers (Magherafelt) Ltd v Ministry of Defence [1997] RPC 693, 706; [1999] RPC 442. As Laddie J said in the University of Southampton case, the "contribution must be to the formulation of the inventive concept". Deciding upon inventorship will therefore involve assessing the evidence adduced by the parties as to

[1] House of Lords [2007] UKHL 43

the nature of the inventive concept and who contributed to it. In some cases this may be quite complex because the inventive concept is a relationship of discontinuity between the claimed invention and the prior art. Inventors themselves will often not know exactly where it lies.

34 Lord Hoffman refers here to section 7 of the Act, which relates to the right to apply for and obtain a patent. It reads as follows:

> *7(1) Any person may make an application for a patent either alone or jointly with another.*
>
> *(2) A patent for an invention may be granted -*
>
> > *(a) primarily to the inventor or joint inventors;*
> > *(b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;*
> > *(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned; and to no other person.*
>
> *(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.*
>
> *(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.*

35 What is clear from this is that resolving any entitlement dispute starts with a simple question - who was the inventor (the actual deviser) of the invention? But there is a preliminary question to answer first - what is the inventive concept?

36 So how is one to determine the inventive concept? Section 125(1) explains what is meant by an invention:

> *125(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.*

37 I do not think that there can be any disagreement that the starting point must be the claims of the patent in question, but s125 does suggest that there are some contexts in which it is not necessarily so simple as taking the invention to be that specified in the claims. So, in the case of entitlement, how do the claims relate to the inventive concept? I was referred to a number of judgments of the courts (not all of which are about entitlement disputes) that provide some assistance.

38 In *University of Southampton's Applications*[2], Jacob LJ stated, at paragraph 43,

[2] [2006] EXCA Civ 145; [2006] R.P.C. 21

> *Next I should expand a little on the "inventive concept" for the purposes of entitlement disputes. Markem has already pointed out that one is not bound by the form of the claims, if any. I think there is a great danger in being over-elaborate about this, about dividing the information in a patent into a myriad of sub-concepts, each of which is considered separately. One must proceed more like a hedgehog than a fox. And after all there is supposed to be only one inventive concept in a patent, see s.14(5)(d).*

39 The relevant portion of *Markem Corp v Zipher Ltd*[3] referred to above is where Jacob LJ quoted the following comment from Christopher Floyd QC, sitting as Deputy Judge in *Stanelco Fibre Optics Ltd's Applications*[4] at paragraph [15A]:

> *It is clear that a mechanistic, element by element approach to inventorship will not produce a fair result. If A discloses a new idea to B whose only suggestion is to paint it pink, B should not be a joint inventor of a patent for A's product painted pink. That is because the additional feature does not really create a new inventive concept at all. The feature is merely a claim limitation, adequate to overcome a bare novelty objection, but having no substantial bearing on the inventive concept. Patent agents will frequently suggest claim limitations, but doing so does not make them joint inventors. Some stripping of a claim of its verbiage may be necessary to determine the inventive concept, and consequently the inventor. But one must keep in mind that it is the inventive concept or concepts as put forward in the patent with which one is concerned.*

40 I should note that the passage from *Stanelco* was in the context of determining whether there were joint inventors. Nevertheless, taken together these two authorities serve as a warning not to simply read the words of the claim and to assume that one has thus identified the inventive concept. It may be necessary to give the matter some more thought. This is on all fours with what Jacob LJ said at paragraph 17 of *Pozzoli SPA v BDMO SA*[5] (quoting from his own judgment in *Unilever Plc v Chefaro Proprietaries Ltd*[6]):

> *It is the inventive concept of the claim in question which must be considered, not some generalised concept to be derived from the specification as a whole. Different claims can, and generally will, have different inventive concepts. The first stage of identification of the concept is likely to be a question of construction: what does the claim mean? It might be thought there is no second stage – the concept is what the claim covers and that is that. But that is too wooden and not what courts, applying Windsurfing stage one, have done. It is too wooden because if one merely construes the claim one does not distinguish between portions which matter and portions which, although limitations on the ambit of the claim, do not. One is trying to identify the essence of the claim in this exercise*.

Of course, Pozzoli is in the context of determining obviousness rather than entitlement, but as HHJ Hacon said in *BDI Holding v Argent Energy*[7]:

> *If the meaning given to "inventive concept" differs at all as between Yeda [2008] R.P.C. 1, Actavis [2017] R.P.C. 21 and Pozzoli [2007] F.S.R. 37, it is not by much.*

41 Additional guidance on identifying the inventive concept can be found in *Henry Brothers (Magherafelt) Ltd v The Ministry of Defence and the Northern Ireland Office*[8]. Here Jacob J noted at page 706:

> *I do not think it is right to divide up the claim for an invention which consists of a combination of elements and then to seek to identify who contributed which element. I*

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[3] [2005] R.P.C. 31
[4] [2004] EWHC 2263 (Pat); [2005] R.P.C. 15
[5] [2007] F.S.R. 37
[6] [1994] R.P.C. 567
[7] [2019] EWHC 765 (IPEC), at paragraph 21
[8] [1997]R.P.C. 693

think the inquiry is more fundamental than that. One must seek to identify who in substance made the combination. Who was responsible for the inventive concept, namely the combination? That was solely Mr. Z. It was his idea which turned a useless collection of elements into something which would work. The patent, as I have said already, is really about the joint. The remainder of the elements of the claim, although necessary, are peripheral.

42 Furthermore, in *IDA Ltd v University of Southampton*[9] Laddie J referred to the comments of Fysh J in *Markem* at first instance. He noted:

> *42. Mr. Alexander's references to enabling disclosure appear to be based on Markem Corporation v. Zipher Ltd (No 1)[2004] RPC 10 , 203–232 a judgment of His Honour Judge Fysh Q.C. (sitting as a judge of the High Court). At paragraph 41, he considered the meaning of the word "devisor" in s.7(3). He said:*
>
> > *"Secondly, the subsection uses the word 'devisor' in relation to the inventor, not 'maker' or 'the person who reduced a particular proposal into practice'. The word devise has, I consider, a slightly broader signification than 'make' or 'implement'; viz. that of planning a particular course of action before even that course of action is actually implemented. Such usage well accords with the jurisdiction which was intended to encompass an inventor's work prior even to the making of a patent application. But there must be a limit; an invention cannot be 'devised' merely by the statement of an inchoate desideratum or a goal - what Mr. Speck characterised in argument as a 'wish list'. With this in mind, the facts of the particular case will provide the court with material to decide whether an inventor has yet devised an invention."*
>
> *43. This appears to be wider than the formulation adopted by Jacob J. in Henry Brothers. Fysh H.H.J. then referred to Collag Corp. v. Merk & Co. Inc [2003] FSR 216 and, in particular, to the following passage in Pumfrey J.'s judgment in that case:*
>
> > *"Before turning to the facts, I should point out that where there are a number of different contributions to the inventive concept described in a patent application, I do not think it correct to look only at the contributions that are inventive … If the invention is a combination, in which the feature which distinguishes the invention from the prior art is contributed by one person, but all the rest by another, I do not believe it is necessarily correct to say that the latter is, or must be, the sole inventor. It becomes a question of fact. Thus, if one asks Jacob J.'s question in the Henry Brothers case at first instance …, the question is: Who was responsible for the combination? In that case, the inventor was the person who turned 'a useless collection of elements into something which would work'. On its facts, there was nothing without the contribution of a man found to be the sole inventor."*

43 What I think *Henry Brothers* and *IDA* make abundantly clear is that there is a danger in looking at a claim and dividing it up into its various integers and deciding which ones are individually novel and non-obvious and which are not, because it may be the case that the inventive concept is the combination of those integers. This is entirely consistent with Jacob LJ's warning of the pitfalls of separately considering a myriad of sub-concepts in *University of Southampton*, mentioned above.

44 There may be a danger in muddling up those provisions of the Act which are about validity, particularly sections 1 and 3, with those which are about inventorship and entitlement, such as sections 7 and 37. Floyd QC in *Stanleco*, at paragraph 12, referred to this when he said:

[9] [2004] EXHC 2017 (pat); [2005] R.P.C. 11

> *The task of the court is to identify the inventive concept of the patent or application and identify who devised it… The Court is not concerned with issues of validity or inventiveness: merely with the concept as described.*

45 While keeping that danger in mind, I think there is a valuable lesson to learn from *Pozzoli*, even though it is about obviousness and therefore about validity rather than entitlement. In *Pozzoli,* Jacob LJ restated and elaborated upon the well-known *Windsurfing*[10] four-step test for assessing obviousness. In the four-step test there is one step of identifying the inventive concept and another step of identifying the difference(s) between the inventive concept and the state of the art. The step of identifying the inventive concept comes first. In other words, identifying the inventive concept is not the same thing as identifying the inventive step (or the inventive difference).

46 To return briefly to *Yeda,* I need to make one further observation. Lord Hoffman notes:

> *21. The effect of section 7(4) is that a person who seeks to be added as a joint inventor bears the burden of proving that he contributed to the inventive concept underlying the claimed invention and a person who seeks to be substituted as sole inventor bears the additional burden of proving that the inventor named in the patent did not contribute to the inventive concept.*

Mr Muir Wood was keen to draw my attention to this point. If I am to make an order that the currently named inventors, Mr Hallas and Mr Horsey of Geco, are to be replaced with Mr Phillips and Mr Cashman of CBRL then CBRL must satisfy me that Mr Horsey and Mr Hallas contributed nothing of substance to the inventive concept.

Arguments and analysis

The inventive concept

47 The parties take quite different views of the inventive concept. CBRL contends that it is:

> "the provision of a device for internally cleaning kegs and/or casks by dispensing water therein within a pressure range of between 150,000kPa and 275,000kPa".

Geco, on the other hand, says that the inventive concept is:

> "an automated device for internally cleaning kegs and/or casks, including an inlet and a separate outlet, automatic clamping and automatic cleaning with an ultra-high-pressure water lance at a pressure between 150,000kPa and 275,000kPa".

48 Both parties accept that it is for me to determine what the inventive concept is. Mr Tariq and Mr Muir Wood spent considerable time questioning the witnesses and the experts on this issue, and also addressed the issue at length in their closing submissions. I can confirm that I have carefully considered all their submissions on

[10] [1985] RPC 59

this issue, but I do not think it helpful nor necessary to delve into all of their submissions in any depth in this decision.

49 Before I set out what I consider to be the inventive concept, I will make some general observations on the submissions of CBRL and Geco on this point. In my view both Mr Tariq and Mr Muir Wood have neglected to heed the warnings of *Henry Brothers* and *IDA* and have stumbled into the trap of dividing up the claim into its component pieces and focussing on the particular pieces that suit their own purposes. Furthermore, some of their submissions appeared to be more about issues that relate to validity (i.e. novelty and obviousness) than entitlement; the validity of the patent is not in question in these proceedings. The question before me is not to determine which part of the claim, if any, makes the invention inventive. That is a matter of establishing patentability, not entitlement. The act of devising the invention comes before the act of granting a patent.

50 Mr Muir Wood put forward a number of reasons why the inventive concept cannot be what CBRL propose. I do not need to dwell on these, but in very broad terms he argued first, and if I may say so rather curiously, that CBRL's inventive concept is a discovery and not an invention, secondly that it is anticipated by devices known in the prior art and, thirdly, that CBRL had disclosed the concept to various parties prior to the filing of the patent application. In my view he strayed very much into the territory of validity rather than entitlement, but in any case it is a moot point. I say that because even if the idea of using UHP water to clean the insides of kegs and casks was not in and of itself capable of patent protection for some reason (and I am certainly not saying that I agree with that) then that clearly does not exclude it from forming part of the inventive concept in the invention. Geco clearly accepts this; it is, after all, in their proposed version of the inventive concept. What Geco are really saying is that there must be more to the inventive concept than what CBRL contend.

51 Mr Tariq obviously disagrees. He argues that it is only the use of UHP water to clean kegs and casks that distinguishes the claim from the state of the art. He referred to prior art cited in the pre-grant proceedings and to a number of videos of existing keg washing systems submitted in evidence. This shows that the separate inlets and outlets, clamps and automation have been well known in the industry for decades. None of the witnesses appeared to take issue with this. But I think Mr Tariq's approach is flawed for two reasons. First, while he may have identified an inventive step over the prior art I am not persuaded that by doing so he has identified the inventive concept; he too has strayed into the territory of validity. Second, by dividing up the claim in the way he has done he has stripped individual features from their context within the claim. To give an example of this, all three witnesses for CBRL accepted that you could not simply replace an existing washer in an existing washing machine with a UHP lance because the clamping force on the existing clamp would be insufficient; you would need to modify or change the clamp.

52 I will briefly address a further argument that Mr Tariq made, namely that I should be guided by the section of the patent application headed "background of the invention" when determining the inventive concept. In this case that amounts to just two short paragraphs which say little more than that kegs/casks need to be cleaned and that this is usually done with caustic cleaning solutions. Mr Tariq makes much of the fact that there is no mention of any problems relating to automation, but I do not think it right to apportion so much weight to such a short section of the patent application. When read as a whole, as the skilled addressee must surely do, it is abundantly

clear that the patent is not merely about using UHP water to clean the inside of kegs and casks.

53 So, what then is the inventive concept? My starting point is the claim, which is clearly directed towards an automated system for keg and/or cask cleaning. The system uses a UHP water lance that can be inserted into and removed from the keg/cask. While the claim does not specify how the lance is inserted into the keg/cask, the system must be able to do this and, furthermore, to do so automatically. The claim also requires that the keg or cask be secured in place during cleaning. Again, there is nothing in the claim which specifies exactly how this is achieved but it must be able to secure the keg/cask sufficiently to withstand the forces generated by the UHP water impinging on the interior surface, and again this must be automatic. The inlet and outlet, the insertion of the lance, and the clamping of the keg/cask are therefore not mere automation, or "pink paint" as Mr Tariq submitted. Rather, the nature of and the automated control of the means for inserting the water lance into the keg/cask and the securing means are both quite clearly intrinsically linked to the use of UHP. As such, they clearly form part of the inventive concept in my view.

54 With that in mind, it is my opinion that the inventive concept is:

> an automated device for internally cleaning kegs and/or casks, including an inlet for introducing a keg or cask to be cleaned and a separate outlet for outputting the clean keg or cask, an automatic clamp for holding the keg or cask during cleaning, and a lance which is automatically inserted into and removed from the keg or cask and dispenses ultra-high-pressure water to clean the internal surfaces of the keg or cask.

55 Broadly speaking this is in agreement with Geco, though I need to make two points. First, I think it is necessary to make explicit that the lance is inserted into the keg or cask, as that is clearly an important feature of how the system works. Second, I have not included the pressure range in my statement of the inventive concept. I accept that this introduces a potential lack of clarity, but I am not writing a patent claim but rather trying to establish entitlement. I will discuss the reasons for omitting the range later.

The devising of the invention

A preliminary issue

56 Having determined what the inventive concept is, my next task is to assess the evidence in order to determine who devised it. But Mr Muir Wood submitted that it may not be entirely open for me to do so. I will address this potentially significant point first.

57 Throughout these proceedings CBRL's repeated argument has been that the inventive concept is what they say it is and that Mr Phillips and Mr Cashman were responsible for it. In closing submissions Mr Tariq advanced an alternative argument on behalf of CBRL. In simple terms he argued that even if I agreed with Geco on their formulation of the inventive concept then I should still find in favour of CBRL because Mr Phillips and Mr Cashman were also responsible for devising that.

58 Mr Muir Wood's submission, in response, was that CBRL had nailed its colours to the mast when it chose to argue its case based on its version of the inventive

concept and it could not now argue a different case. He pointed out that if CBRL had wanted to argue a number of alternatives it could have made this clear in its statement of case but it had not done so. Accordingly, in Mr Muir Wood's opinion, it would not be open to me to decide that CBRL is the sole proprietor of the patent if I found that the inventive concept is in line with what Geco have argued. Mr Muir Wood's argument here is predicated on the basic principle that a party cannot normally introduce matters at a hearing which are not pleaded in their statement of case.

59 It is certainly true that CBRL's statement of case did not put forward the alternative argument that Mr Muir Wood now objects to, but that is hardly surprising since at the time the reference was made CBRL could not have known what Geco would later claim to be the inventive concept. More importantly, CBRL could not know what I would determine the inventive concept to be. The logical extension of Mr Muir Wood's argument is that in an entitlement dispute an applicant cannot succeed unless its statement of case correctly predicts what the hearing officer will determine to be the inventive concept once they have listened to the submissions of both parties and considered the evidence. A statement of case is supposed to be reasonably detailed, but it would clearly be undesirable, perhaps even impossible, for a claimant to include as many alternative arguments as there might be alternative possibilities for the inventive concept.

60 One reason for requiring an adequate statement of case is to ensure that the correct evidence is adduced at the hearing. Sir Richard Scott in *Julian Higgins' Trade Mark Application*[11] said

> *If the pleadings do not identify the right issues, the issues the parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing. The pleadings are supposed to identify the issues to which evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise.*

In this case I do not believe that there is any sense in which the evidence is lacking as a result of Mr Tariq submitting his alternative argument in his closing submissions. The evidence rounds, the skeleton arguments, the cross-examinations and the closing submissions are replete with the details of who did what and when, and they are in my view more than adequate for me to determine who devised the inventive concept.

61 The applicant has made a reference under section 37. The effect of section 37 is that I am required to determine the question of entitlement and to make such order as I think fit to give effect to the determination. Lord Hoffmann in *Yeda* found that a hearing officer has wide discretion in entitlement cases to consider what is fair and just in the circumstances notwithstanding the scope of the pleadings. Furthermore, I must give effect to the overriding objective of dealing justly with these proceedings as set out in rule 74 of the Patent Rules. Among other things, this includes saving expense, dealing with the case expeditiously and allotting to the case an appropriate share of the resources available to the comptroller.

62 Notwithstanding the above, I am not actually persuaded that CBRL have changed their pleading. Their primary position was, and still is, that Mr Phillips and Mr

[11] [2000] RPC 321

Cashman are the inventors and that CBRL is the true proprietor. They have filed their evidence to support that, and MDES have filed their evidence to refute that claim.

63 I am therefore of the opinion that, contrary to Mr Muir Wood's submission, it is indeed open to me to determine that Mr Phillips and Mr Cashman are the inventors and CBRL is the sole proprietor, if that is what the evidence shows. I can now move on to look at the evidence.

The evidence

a) The Hammelmann tests

64 No one disputes that it was Mr Phillips and Mr Cashman who first had the idea of using UHP water to clean the inside of kegs and casks. But they went further than that. They tested their hypothesis to see if their idea would work.

65 That testing was carried out by Hammelmann and it was the focus of much discussion at the hearing. The evidence shows that three initial tests were conducted on 7 March 2016 at a pressure of 2000 Bar (200,000 kPa). A second series of tests was conducted on 5 April 2016. Mr Phillips' witness statement says that this included five test runs, again at 200,000 kPa but the evidence is not entirely consistent with that. The report of the second series of tests (dated 17 May 2016) certainly shows the five test runs at 200,000 kPa. These used varying flow rates, feed rates for the lance and speed of rotation of the nozzles, and produced a >98% clean keg/cask. However, a number of pages of this report are apparently missing from the evidence. The accompanying cover page for the report indicates that there were at least 16 runs in which it appears that a pump pressure of 250,000 kPa (2500 Bar) produced the best results. I am not sure why the reports of the other test runs were not submitted in evidence. They may have been rather useful. A further series of tests were conducted by Hammelmann some time later; there is a report dated 30 January 2017. In this third set of tests, pressures of 150,000, 200,000 and 250,000 kPa were used.

66 What the evidence from the Hammelmann reports clearly demonstrates is that CBRL were trying to establish what operating parameters should be used in order to obtain adequate cleaning. What none of the reports mention is the range now specified in the patent, that is 150,000 kPa - 275,000 kPa. In particular, there is no evidence of a test at anything higher than 250,000 kPa. This begs a question - where did this pressure range specified in the claim of the patent come from? That was a question which occupied considerable time in the cross-examination of Mr Horsey and Mr Hallas.

67 To be clear, there is no documentary evidence of this particular range of pressures prior to it appearing in the patent application. As I have said, it does not appear in the Hammelmann reports. It does not appear in Mr McCrorie's design brief, which only suggests that CBRL were to purchase two 2500 Bar "HDP 170" pump units from Calder. Furthermore, it does not appear in the two earlier CBRL patents.

68 The as-filed MDES patent application says "it is particularly beneficial that the fluid is dispensed at ultra-high pressure, that is at a pressure of 250,000 kPa, or substantially that pressure, for example, between 150,000 kPa and 275,000 kPa". Mr Hallas, under questioning by Mr Tariq, was adamant that this could not possibly have come from the findings of the Hammelmann report as he had never seen them.

When initially asked to say where the preferred pressure of 250,000 kPa or the range of 150,000 kPa to 275,000 kPa came from he said that he could not, but soon afterwards he apparently recalled that the pressures came from the on-site testing that MDES carried out as part of commissioning of the system with actual kegs and casks. Mr Horsey backed up what Mr Hallas had said, and went a little further. He claimed that Mr Philips, Mr Cashman and someone from Calder were present during commissioning when this pressure range was determined. He also claimed that it was MDES that entered all the relevant settings into the automated system, including pressures, without any input from CBRL.

69 Since there are no documents in evidence which corroborate what Mr Hallas and Mr Horsey say, this leaves the only evidence before me regarding the pressure range to be the answers they gave to Mr Tariq under cross-examination, and, as I have already suggested above, I find that evidence to be unconvincing. I am prepared to accept that CBRL did not show the actual Hammelmann reports to Mr Hallas and Mr Horsey but in my view it is inconceivable to think that CBRL would commission MDES to build a UHP based keg/cask washing system without passing onto them any information about the key operating parameters they had established to be necessary through testing, including the most suitable operating pressure. Furthermore, if, as Mr McCrorie's design brief suggests, the pumps were indeed "HDP 170" units from Calder then it would not have been possible for MDES to run these at anything higher than 250,000 kPa during commissioning as that is their maximum operating pressure.

70 That still leaves the question partly unanswered. Where did the lower and particularly the upper bounds of the range come from? In the absence of any persuasive evidence to the contrary there is, in my view, only one possible answer to this, and that is that it resulted from the drafting of the patent application by Mohun Aldridge Sykes on behalf of MDES. Does that make the patent attorney a joint inventor? Plainly not; that point was addressed in *Stanelco*, mentioned above.

71 In my view, the range is no more than an attempt to define what is meant by "ultra-high-pressure". This is a phrase which has no clearly defined meaning, a point correctly raised by the examiner during prosecution of the application. Specifying a range of pressures, rather than a single value, clearly provides a sensible degree of generality regarding the pressure of the water dispensed by the water lance. That is exactly the sort of generalising statement one would expect a patent attorney to include in an application. The two earlier CBRL patents conveniently demonstrate this point; GB2575143, filed without professional assistance, is strictly limited to 2500 Bar (250,000 kPa) whereas GB2575414, drafted some time later by Cameron IP, sensibly refers to a range of 200,000 kPa to 300,000 kPa, which has 250,000 kPa right at its centre. It is also important to note that the range of 150,000 kPa to 275,000 kPa was only introduced into the main claim of the patent in question during the examination process in order to overcome the clarity issue I have already mentioned and hence to distinguish the invention from the prior art; Mr Muir Wood acknowledged as much in his closing submissions.

72 This confirms the conclusion I have already reached above, that the particular pressure range specified in the claim of the patent does not form any part of the inventive concept. There is nothing in the patent application to suggest that the lower and upper limits of the range are anything other than arbitrary, albeit sensible, limitations to define UHP, and there is nothing that I have seen or heard in evidence that suggests otherwise.

73 Before moving on from the Hammelmann tests it is worth commenting briefly on the equipment used during the tests. Obviously, there was a UHP pump, and a lance. The lance was inserted into the kegs with a computer-controlled robot. During the tests the kegs were held securely with a clamp. The clamp was clearly sufficient to withstand the forces generated by the UHP water on the kegs, but it was manual - there was no automation. There were no inlet and outlet to automatically feed the kegs to and from the washing location.

b) The approach to MDES

74 That brings me to the involvement of MDES, and Mr Hallas and Mr Horsey. No one could recall precisely when this involvement commenced, but the consensus was that it was late March or early April 2016, which was around the time of the second Hammelmann test and most probably before. It is common ground that Mr Phillips telephoned Mr Hallas and that subsequently the two men met in Mr Phillips' office to discuss the possibility of MDES developing an automated system that used UHP water to clean kegs and casks.

75 In his first witness statement, Mr Hallas says that Mr Phillips told him that CBRL wished to automate the internal cleaning of kegs and casks using UHP water but did not give any information on how that could be achieved. Mr Phillips, in his second witness statement, agreed that he did not provide detailed information on the proposal for the automated internal cleaning system.

76 Mr Phillips and Mr Hallas were questioned further about their initial meeting at the hearing. Mr Phillips said that the meeting involved the use of a whiteboard. Mr Muir Wood was quick to point out that there was no mention of the whiteboard in the previously submitted evidence and submitted that this was an attempt to give new evidence that Mr Phillips had somehow passed on details of the invention to Mr Hallas. Mr Hallas did not deny that the whiteboard moment happened. In fact, he was happy to answer Mr Tariq's questions about it. Mr Hallas said that Mr Phillips told him that CBRL were looking at the possibility of cleaning kegs with UHP and that he was going over to Germany to do some tests. Mr Hallas suggested that Mr Phillips was somewhat guarded about what he said but he did quote Mr Phillips as saying that because of the pressures involved, which could cut through metal, MDES would have to develop a clamp to hold the kegs/casks securely.

77 At the very least, then, it is clear to me that Mr Phillips told Mr Hallas a number of key things about what CBRL were trying to achieve. They wanted an automated system for using UHP water to clean the inside of kegs and casks, and it needed a secure clamping arrangement.

c) The budget cost proposal

78 While we cannot know precisely what Mr Phillips wrote on the whiteboard, if indeed there even was a whiteboard, it is unquestionably true that Mr Phillips and Mr Hallas had at least one discussion about the project and that this resulted in MDES preparing a budget cost proposal for CBRL on 11 April 2016.

79 The budget cost proposal is, as its name suggests, somewhat short on technical detail. But what it does say is very much worth looking at. It is for a "cask & keg washer framework…specifically designed for a UHP robotic module". It refers to an "in-feed section" having a "fully automated in-feed chain conveyor". It also discusses

clamping the kegs/casks - “a pneumatically driven cylinder will then hold the cask/keg down into place”. And there is an outlet - “upon completion of cleaning the cask/keg will be automatically discharged”. It is also clear from the budget cost proposal that the scope of work included integrating the UHP equipment chosen by CBRL; in other words, it was CBRL and not MDES that were responsible for the supply of the UHP equipment. There is no explicit mention of a lance, or that a lance would need to be inserted into the cask/keg, but that is implicit given that CBRL had been using the Calder pump and lance in that way in their cleaning tests.

d) The McCrorie design brief

80 Mr McCrorie was engaged by CBRL in January 2016. I have already commented on the fact that there is no witness statement or evidence from Mr McCrorie. As such the full extent of Mr McCrorie’s contribution to the project following his engagement is unclear. What we do know is that he e-mailed a design brief to Mr Phillips on 22 July 2016.

81 The design brief provides an outline of the project. As with the budget cost proposal provided by MDES, there is limited technical information. It certainly does not set out in precise terms how the system should work. However, it does set out that the project is concerned with using UHP water to clean kegs and casks. It also makes clear that the project scope includes “infeed and outfeed equipment, the necessary level of utilities, a specified degree of automation, and electrical/software control” and that a suitable UHP pump, provided by Calder, had already been selected based on the Hammelmann tests. As with the budget cost proposal, the design brief makes clear that provision of the UHP equipment was the responsibility of CBRL.

82 I should note that Mr Hallas and Mr Horsey say that the design brief was never shown to them.

e) The formal quotation and the engagement of MDES

83 On 12 May 2017 MDES provided a formal quotation to CBRL. It was this formal quotation against which a purchase order was raised and MDES were formally commissioned to undertake the design and build of the UHP keg/cask washing system.

84 As a source of information about the invention the quotation isn’t particularly helpful. One key difference between the budget cost proposal and the formal quotation is that the former contemplated 4 lanes whereas by the time CBRL were ready to proceed it had evidently been determined that the system should have just 2 lanes. Unsurprisingly there was a corresponding cost difference. In that limited sense the budget cost proposal and the quotation are different, but from a technical perspective it would be absurd to suggest that they do not both relate to one and the same project.

85 There is no disagreement that it was MDES that built the keg/cask washing system and got it working. That is exactly what CBRL paid them to do.

<u>Who devised the inventive concept?</u>

86 Having considered the relevant evidence in some detail, I can now proceed to determine who it was that devised the inventive concept.

87 I do not think there can be any doubt that at the heart of the invention is the idea of cleaning kegs and casks internally by inserting a lance and dispensing ultra-high-pressure water, preferably at 250,000 kPa but if not then somewhere in that region. That aspect of the inventive concept, in my view, was unquestionably contributed by Mr Phillips and Mr Cashman. The Hammelmann tests, at least some of which were conducted prior to any involvement of MDES, are the clear evidence of that.

88 But, as I have set out above, the inventive concept is more than that. It is a combination of features. In line with *Henry Brothers* I must then decide who in substance made that combination.

89 While the Hammelmann tests are evidence that Mr Phillips and Mr Cashman had devised the basic idea underlying the inventive concept by mid-March/early-April 2016, and perhaps had begun to recognise some of the practical implications, some of the features in the combination were not yet present. So, how and when did that combination come together?

90 Mr Tariq's submission was that the McCrorie design brief is the clear evidence of the combination, and accordingly demonstrated that it had been devised by Mr Phillips and Mr Cashman before the input of MDES. I am not convinced that his reasoning is sound. The design brief certainly pre-dates the formal commissioning of MDES by some 10 months but it was after the date of the budget cost proposal. That means that it was possible, in principle, that MDES had some input into the project by the time Mr McCrorie put pen to paper and that the budget cost proposal, in part, formed the basis for the design brief. It is my view that the budget cost proposal is worthy of greater consideration than the McCrorie design brief for two reasons. First, it has an earlier date. Secondly, the McCrorie design brief says nothing of real significance that had not already been reduced to words in the budget cost proposal.

91 As I have already noted, all of the features of the invention are brought together in the budget cost proposal which was prepared by MDES for CBRL. One might argue this to imply that it was MDES who first proposed the combination, but I do not think that this is an inevitable conclusion. The budget cost proposal cannot be viewed in isolation because it followed the initial meeting between Mr Phillips and Mr Hallas. There is no disagreement that Mr Phillips told Mr Hallas that CBRL would like to build an automated keg and cask washing system based on UHP, and Mr Phillips also told Mr Hallas that it would require suitable clamping. Mr Hallas admitted that he knew nothing of UHP at the time, so did Mr Phillips explain to Mr Hallas that it involved inserting a lance into the keg or cask? On balance, it is implausible to think that he did not given the discussions that had already taken place between CBRL and Calder/Hammelmann. And what of the infeed and outfeed conveyors? Were CBRL surprised when these appeared on the budget cost proposal? Again, it is difficult to imagine that this was something that CBRL did not always envisage given MDES' expertise in this field and why they approached them in the first place. It is my view that Mr Phillips and Mr Hallas knew exactly what they wished to achieve, if not precisely how, and that they must have provided MDES with sufficient information about that in order for the budget cost proposal to be prepared.

92 But that is not the end of the matter. There is a fundamental question which remains to be answered. Had Mr Phillips and Mr Cashman actually devised the inventive concept when they approached MDES, or had they merely seen the first faint glimmer of light from a distant lightbulb?

93 CBRL had certainly not taken the step of actually creating a system which worked; that is what they wanted MDES to do. They did not provide MDES with technical drawings, schematics or a full design specification setting out precisely how they wanted the system built; in fact, they never provided such information. Mr Muir Wood made much of this, portraying Mr Phillips and Mr Cashman as technically incapable. He drew attention to e-mails in which they merely forwarded on technical questions to various subcontractors, and also to the fact that they appeared to lack certain software which meant they were unable to view drawings in a certain file format.

94 MDES, on the other hand, did have the expertise to design and build an actual working product. That was their business, and it is precisely what they did. I have no doubt that the project was not entirely straightforward and that there were numerous technical challenges to overcome. After all, no one had built such a system before.

95 So was the inventive concept devised before CBRL approached MDES, or was it only the technical input of MDES to turn the idea into reality that brought the inventive concept into being? The comments of Christopher Floyd QC at paragraphs 13 and 14 in *Stanelco* are of direct relevance here.

> *13. It is suggested by Mr Miller Q.C. who appeared for Stanelco that the requirement that the inventor be the "actual deviser" requires something more than a theoretical proposal. In his skeleton argument he said this:*
>
> *"At one extreme, there are vague ideas and pipedreams—the sort of thing where someone says 'Wouldn't it be nice if we could do such and such'—but without any idea as to whether 'such and such' can in fact be done or how it might be done. That person will not be an actual devisor of an invention that is subsequently made by another—even though without the initial prompt the invention might never have been made. At the other end of the scale there is the person who produces a fully worked-up proposal and an actual working embodiment of it. That person is clearly an actual devisor of the invention. If BioProgress made any contribution at all in this case, it falls at the 'Wouldn't it be nice if . ..' end of the scale."*
>
> *He relied on the decision of H.H. Judge Fysh Q.C. sitting as a High Court Judge in Markem Corp v Zipher Ltd (No.1) [2004] R.P.C. 10 at paras [72–74], where he proposed that:*
>
> *"at least one way of carrying the antecedent disclosure into effect must I think be ascertainable from the antecedent disclosure relied upon".*
>
> *14. I think Mr Miller is right to the extent that it is never going to be enough for an antecedent worker to rely solely on an initial prompt of the vague kind he refers to: a "but-for" approach would lead to all sorts of people being treated as inventors. But where the antecedent worker comes up with and communicates an idea consisting of all of the elements in the claim, even though it is just an idea at that stage, it seems to me that he or she will normally, at the very least, be an inventor of the claim. What US patent law calls "reduction to practice" is not, it seems to me, a necessary component of a valid claim to any entitlement.*

96 The situation here is plainly on all fours with *Stanelco*. There was no fully worked up proposal and no actual working embodiment but in my view Mr Phillips' approach to Mr Hallas involved more than just an initial vague prompt. CBRL knew that what they were asking MDES to undertake was technically feasible. They had already seen the UHP lance being inserted into and removed from a keg using a robot, and they knew that the water at UHP provided adequate cleaning without damaging the kegs/casks. They knew that the kegs/casks could be held securely, though they had only seen

manual clamping. And I have no doubt that they had seen existing washing systems with inlets and outlets for conveying the kegs/casks. That is why they approached MDES - someone they knew were likely to be able to undertake the build of the system. The fact that MDES turned around a budget cost proposal within just a few days of the initial approach underlines this. CBRL communicated the idea consisting of all the elements in the claim to MDES. Accordingly, it is my determination that Mr Phillips and Mr Cashman are inventors.

97 There of course remains the question of whether Mr Hallas and Mr Horsey are co-inventors with Mr Phillips and Mr Cashman. The comments of Jacob LJ at paragraphs 38-39 of *University of Southampton's Applications* are helpful:

> *38. Next, it should be noted that this is a case where what was needed to get a patent was only disclosure of an idea. Disclosure of a means of enablement was not necessary: given the idea, the skilled man could readily practice the invention, as the graduate students did. As Laddie J. observed in a passage quoted with approval in the context of novelty by Lord Hoffmann at [28] in Synthon v SmithKline Beecham [2005] UKHL 59; [2005] IP & T 81:*
>
> *"46. In my view, devising an invention and providing enabling disclosure are two quite different things. Although both may be necessary to secure valid protection, as s.14 of the Act shows, they relate to different aspects of the law of patents. It is very possible to make a good invention but to lose one's patent for failure to make an enabling disclosure. The requirement to include an enabling disclosure is concerned with teaching the public how the invention works, not with devising the invention in the first place".*
>
> *39. In the context of entitlement to a patent a mere, non-enabling idea, is probably not enough to give the patent for it to solely the devisor. Those who contribute enough information by way of necessary enablement to make the idea patentable would count as "actual devisors", having turned what was "airy-fairy" into that which is practical (see the discussion about the co-inventors in Markem at [36]–[37]). On the other hand those who contribute no more than essentially unnecessary detail cannot on any view count as "actual devisors" as Laddie J. rightly said: see his [45].*

98 So did Mr Phillips and Mr Cashman give to Mr Hallas and Mr Horsey a mere "non-enabling idea" to which it was necessary to add something of inventive merit, or did they instead give them sufficient information such that MDES' contribution was merely "essentially unnecessary detail" that one might expect from a skilled person?

99 If one considers the clamping arrangement, for example. It is common ground that Mr Phillips did not explain to Mr Hallas how to build the clamp. Could the clamping be achieved using basic engineering skills? Professor Round certainly thought so, and there is no evidence before me to suggest otherwise. That being so, my view is that CBRL provided enough information to MDES by way of necessary enablement. Designing and building the actual clamp in practice may well have provided a technical challenge and it is perfectly possible that Mr Hallas and Mr Horsey have actually devised a novel and inventive arrangement for securing a keg/cask while it is being cleaned. But the claim, and hence the inventive concept, is silent on the details of the clamping arrangement. All that is required is that there must be one and that it must be suitable for its purpose, and for that I would say that no invention is actually necessary. In any case, there is no hint of such a novel arrangement anywhere in the patent application. In fact, there is no detail of the clamp at all, and it is notable that the examiner has quite rightly not objected to lack of an enabling disclosure. The "how" is simply not important to the invention.

100 The same can be said of the other features that contributed towards the inventive concept. Mr Hallas and Mr Horsey may well have provided a degree of automation of the insertion/removal of the lance which had been hitherto unknown in the industry. They could even have done something very clever with the inlet and outlet. But these features are not the subject of the claimed invention, and there is no suggestion in the patent application that Mr Hallas and Mr Horsey have contributed anything of the sort.

101 While accepting the possibility that Mr Horsey and Mr Hallas might well have invented something during the course of their work, for which they could perhaps have sought patent protection, I am firmly of the opinion that they contributed nothing of substance to the inventive concept. The inventive concept was devised solely by Mr Phillips and Mr Cashman.

Other issues

102 There were a few other issues raised during the proceedings that I need to address.

103 One issue that was the subject of considerable discussion at the hearing was whether or not there were any terms and conditions relating to intellectual property in the contract between CBRL and MDES. Mr Tariq made the point that it was the later quotation that formed part of the contract between the two parties, and that while the budget cost proposal had terms and conditions relating to ownership of intellectual property attached, the formal quotation apparently did not. I have already said that I do not quite see the stark distinction that Mr Tariq sees between the budget proposal and the quotation; the one can be seen as a development of the other, and that is exactly what Mr Hallas and Mr Horsey tried to explain to Mr Tariq during their cross-examination. Mr Muir Wood's view was that this argument was an irrelevance and a side-show. I tend to agree, and since I have determined that MDES did not actually contribute anything to the inventive concept, I do not need to consider this matter further.

104 In the course of cross-examination Mr Muir Wood questioned Mr Phillips about a company called CMB Industrial Services of which Mr Phillips and Mr Cashman are apparently co-directors. Mr Muir Wood asked Mr Phillips if he and Mr Cashman were planning to exploit the patent outside of CBRL. Mr Phillips denied this. I have no idea where this suggestion came from or where Mr Muir Wood was trying to take this line of questioning, and neither it seems did Mr Tariq, but it has absolutely no bearing on the question of entitlement in my view.

105 There was also some debate about when the project became commercially viable for CBRL, specifically whether that was before or after the involvement of MDES. Commercial viability obviously has a part to play in business decisions, but I am not certain that it necessarily has any direct bearing on the concept of devising an invention, at least in this instance.

106 There was some discussion at the hearing about who had engaged and paid for the services of a subcontract automation technician, but I do not think that has any bearing on the outcome of my decision.

Summary and Findings

107 I have determined that Mr Phillips and Mr Cashman are the inventors of the invention set out in GB2571465, and that Mr Horsey and Mr Hallas are not inventors. It follows that CBRL is the sole proprietor of the patent.

Orders

108 In view of the above I make the following orders:

(1) That Mr Gary Phillips and Mr Neil Cashman shall be named as the only inventors of GB2571465

(2) That Close Brewery Rentals Limited shall be named as the sole proprietor of GB2571465

(3) That any foreign or international patent application claiming priority from GB2571465 should proceed in the name Close Brewery Rentals Limited with Mr Gary Phillips and Mr Neil Cashman being named as the only inventors

Costs

109 CBRL is entitled to an award of costs in its favour. I said at the hearing that I would invite submissions on costs even though I did not expect to depart from the standard scale set out at Annex A of Tribunal Practice Notice 2/2016[12]. I will allow a period of 14 days for parties to make any submissions that they wish to make in this regard.

Appeal

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

Huw Jones
Deputy Director, acting for the Comptroller

[12] https://www.gov.uk/government/publications/tribunal-practice-notice-22016/tribunal-practice-notice-22016-costs-in-proceedings-before-the-comptroller