

PATENTS ACT 1977

CLAIMANT Advantage Silver Dental Arrest, LLC

PROCEEDINGS Reference under section 8(1)(a) and
 an application under rule 10(2) in
 respect of GB2100728.1

HEARING OFFICER H Jones

DECISION

- 1 GB2100728.1 is a UK national phase application based on PCT/US2019/026017, which was filed on 5 April 2019 in the name of Healthy Advances, Inc. The PCT application claims priority from US 62/688149 filed on 21 June 2018 and names Dr Jong Seto as the sole inventor.
- 2 On 9 May 2018, the claimant (Advantage Silver Dental Arrest, LLC) entered into a Technology Development Agreement (“the Agreement”) with Dr Seto and Healthy Advances, Inc. A copy of the Agreement submitted alongside the statement of grounds provides a description of the services, specifications and developments that was covered by the Agreement. It sets out two milestones for delivery, these being i) the synthesis and characterisation of an encapsulated SDF Form, and ii) the characterisation and validation of antimicrobial properties of encapsulated SDF Forms. Section 2.2 of the Agreement confirms that all developments were the property of the claimant.
- 3 The claimant says that development work carried out under the Agreement resulted in the filing of the US priority application (US 62/688149), the subsequent filing of the PCT application and then the national phase application. It says that the invention claimed in the national phase application arises from the development work to which the Agreement pertains and submits that it is entitled to be named the sole applicant of the national phase application. Furthermore, Dr Peter Milgrom, an employee of the claimant at the time the invention was made and who developed the idea of encapsulation and the mechanism for that encapsulation and subsequent release, should be added as a co-inventor in the national phase application.
- 4 Healthy Advances Inc. and Dr Seto have been notified of this reference and have not opposed it. Since the reference is unopposed, I must accept the facts of the case to be those set out in the claimant’s statement of grounds and the supporting documentation.
- 5 Based on the documents submitted by the claimant, I am satisfied that the invention claimed in UK national phase application GB2100728.1 arises from the development

work set out in the Technology Development Agreement and that the claimant is entitled to be named as applicant/proprietor. The description of Dr Peter Milgrom's work in developing the idea of encapsulation is consistent with him being named as co-inventor in the application.

Declaration

- 6 I hereby declare that Advantage Silver Dental Arrest, LLC is the entitled sole applicant of GB2100728.1 and that Dr Peter Milgrom should be added as a co-inventor.

Huw Jones

Deputy Director, acting for the Comptroller