



PATENTS ACT 1977

BETWEEN

Professor Anant Sharma

Claimant

and

Geuder AG

Defendant

PROCEEDINGS

Reference under Sections 12 and 13(3) of the Patents Act 1977 in respect of
patent applications WO2021/098922 and DE102019217825

HEARING OFFICER

Phil Thorpe

DECISION

- 1 This decision relates to a reference under section 12 of the Patents Act 1977 concerning entitlement to patent applications WO2021/098922 and DE102019217825 (the applications). WO2021/098922 was filed on 19th November 2020 and claims priority from DE102019217825 filed 19th November 2019. Both applications name Geuder AG (“Geuder”) as the applicant and Mr Thorsten Winkler and Mr Hamadi El-Ayari as the inventors.
- 2 This reference was filed by Professor Anant Sharma on 4th February 2022. In his accompanying statement Professor Sharma claims to be the sole inventor of the invention in the applications and that therefore ownership of the inventions should be transferred into his name.
- 3 The statement was duly served on Geuder and Mr Winkler and Mr El-Ayari in April 2022. Ullrich and Naumann on behalf of Geuder and the named inventors responded initially to challenge a request in the statement of case that some material be kept confidential. On May 19th 2022, Ullrich and Naumann contacted the IPO to advise that “due to a negative search report” Geuder and the named inventors had decided to withdraw the patent applications. They also noted that they assumed that because of the withdrawals these proceedings would become obsolete.

- 4 Professor Sharma was invited to comment on this and his representative, Sarah Grant from Stratagem IPM Limited, responded noting that Professor Sharma wished to continue with a determination as to entitlement to the inventions.
- 5 Geuder and the named inventors were subsequently advised that the IPO intended to continue with the proceedings as requested by Professor Sharma taking account of the remedies possible under for example section 12(6)(c). Section 12(6)(c) notes that:

(6) In the following cases, that is to say –

..... (c) where an international application for a patent (UK) is withdrawn, or the designation of the United Kingdom in the application is withdrawn, whether before or after the making of any reference under subsection (1) above or the publication of the application; the comptroller may order that any person (other than the applicant) appearing to him to be entitled to be granted a patent under this Act may within the prescribed period make an application for such a patent for the whole or part of any matter comprised in the earlier application (subject, however, to section 76 below) and that if the application for a patent under this Act is filed, it shall be treated as having been filed on the date of filing the earlier application.

- 6 Geuder and the named inventors were advised that should they wish to contest the reference then they should file a counterstatement no later than 15th September 2022. No such counterstatement was received within that period hence the IPO wrote to Geuder on 17th October 2022 to advise them that subject to any comments they might wish to make within 14 days of the letter, the reference would be treated as unopposed. No response was received.

Summary of facts and submissions

- 7 The applications in issue relate to an ophthalmological instrument for performing a hydrodissection or a hydrodelineation.
- 8 Professor Sharma notes that in March 2018, he filed an International Patent Application, which was published in October 2018 with International Patent publication number WO2018/178658. The application also related to intraocular devices and methods. He is named as both inventor and applicant for this application. He contends that in spring 2019, he attended the ARVO conference in Vancouver, where he met Tim Pieplau and Hamadi El-Ayari from Geuder and showed them a video of the device described in his patent application. Following the meeting he e-mailed them a copy of the video on 2nd May 2019, and through his business partner Andrew Knight, he also sent them a copy of his earlier patent application.
- 9 A non-disclosure agreement was subsequently entered into with Geuder, and Professor Sharma contends that he then entered into negotiations with them in the belief that they were intending to licence the invention in his earlier patent application. Professor Sharma accepts that he discussed the design of the device with several people within Geuder, most noticeably Thorsten Winkler and Sebastian Hinz. He contends that he described in detail how fundamental the flow of the fluid in

the device is, in order to enable a surgeon to promote or enhance fluid flow out of the eye when Intraocular Pressure (IOP) is raised. These conversations were based on the device described in his patent application WO2018/178658.

- 10 Professor Sharma also accepts that during this period, the representatives of Geuder were investigating how his device could be manufactured. Their objective was to be able to produce the intra-ocular device to fit within their current product portfolio in a cost-effective matter, for example by using their pre-existing moulds. He argues that he did not have any conversations with them related to altering the way the device works. For example, the placement of the passages permitting fluid flow was dictated by how easily these could be introduced during the manufacture of the device, rather than changing the way the fluid would flow.
- 11 Professor Sharma's earlier patent application describes that there may be a 'plurality of apertures' 'to permit excess fluid' to enter and leave the device. The figures of WO2021/098922 has two passages labelled "8" included in the device. According to Professor Sharma, what determined the number of holes and their position was the ease of punching these holes through the device in a single step, after release from the mould. No manufacturing hurdles had to be overcome during these discussions, these were routine tasks, and no modification was made to the way the device actually performs in use.
- 12 Professor Sharma also notes that when Thorsten Winkler e-mailed an external contact at a different company about the design for the device, he specifically introduced him as "the inventor of the product", and it was acknowledged by those he was working with in Geuder that it was his device that they were looking to manufacture. During this time, as far as he is aware, Hamadi El-Ayari did not have any input in these conversations. His involvement according to Professor Sharma was in drafting the commercial terms for the licensing of his device to Geuder
- 13 Professor Sharma learnt in February 2020 that Geuder AG had filed a German Patent Application in November 2019. He notes that the patent application was filed without his knowledge and without his permission. He was surprised, therefore that when WO2021/098922 was published in May 2021 that he was not even named as an inventor on the application. Both Geuder and their Patent Attorney have allegedly confirmed in writing that he should be named as the inventor. He notes that the European Patent Office has identified his earlier patent application as the closest relevant prior art, and this has been cited against all claims of the International Application. This is because the invention in WO2021/098922 derives entirely from my work.
- 14 Professor Sharma suggests that he has read the claims of WO2021/098922 and notes that these claims cover the device that he conceived and discussed in detail with the team at Geuder. He contends that the claims describe ideas that he provided to Geuder in his discussions with Thorsten Winkler and others. According to Professor Sharma he was the only person to provide substantive and inventive contributions to the design of the device in this application, and as such he is the sole inventor.
- 15 He goes on to note that following the disclosure of the filing of the German Patent Application by Geuder, he was sent a "Draft contract for the remuneration of Dr

Anant Sharma", to sign so as to transfer his rights in his invention to Geuder. Professor Sharma did not sign the draft agreement which he took to be a standard agreement for a "Freelance inventor" such as him.

- 16 The draft contract defined the contribution of those involved as follows: "The freelance inventor developed and invented as a freelance inventor together with the co-inventors Thorsten Winkler and Hamadi El-Ayari. The freelance inventor has a 50% share in the above mentioned invention." Professor Sharma contends that Thorsten Winkler merely accommodated his device design within pre-existing Geuder technology and manufacturing constraints, and that Hamadi El-Ayari did not contribute to discussions on manufacturing at all, given his commercial role as a VP of Sales and Marketing.

Conclusion and Determination

- 17 Based on the evidence provided by Professor Sharma and taking into account that the reference is being treated as unopposed, I am satisfied that Professor Sharma devised the invention in WO2021/098922 and DE102019217825, without contribution from any other parties.
- 18 Further there is nothing before me to suggest that anyone else has a right to the invention.
- 19 I hereby declare that Professor Sharma is solely entitled to the invention of patent applications WO2021/098922 and DE102019217825.

Costs

- 20 Professor Sharma has asked for his costs in these proceedings however since they are being treated as unopposed, I make no order as to costs.

Appeal

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

PHIL THORPE

Deputy Director acting for the Comptroller