

CHAPTER 3

THE INVENTOR

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Introduction

- 3.01 The right to grant of a patent belongs primarily to the inventor (s.7 (2)), i.e. the person(s) who devised the invention (s.7 (3)). However, this right may pass to another person or legal entity, e.g. by deed of assignment, by inheriting the rights following the death of the inventor, by contract of employment or by acquisition following the bankruptcy of the inventor.

Identification of Inventor

- 3.02 Any applicant who is not an inventor must file a F7 naming the person(s) who he believes to be the inventor(s) and stating how he derived his right to the grant of the patent. The form must be filed no later than 16 months from the earliest declared priority date, or, if there is no priority date, no later than 16 months from the date of filing the application (r.10(3)). The period can be extended by two months under r.108 (2) upon filing of a F52 (with prescribed fee). A further discretionary extension may be considered under the provisions of r.108 (3) but will be subject to the conditions of rule 108(5) and (7). See Chapter 10.37 - 41.
- 3.03 If the applicant in a divisional application is not an inventor, he must file a F7 even if this has already been done in respect of the parent application and even if there is only one inventor. This must be done either within the time allowed for filing this form for the parent application (i.e. 16 months from the declared priority date, or, where there is none, from the filing date).
- 3.04 If this period has already expired, the form should be filed either within 2 months of the initiation date if there are more than 6 months to the compliance date when the divisional is filed or on the same date as the divisional application if less than 6 months remain to the compliance date. The period for filing a F7 may be extended by 2 months under r.108 (2) and a discretionary extension may be considered under r.108(3) although this is restricted by r.108(5) & (7). See 10.37 - 41
- 3.05 The surname or family name of the inventor(s) should be underlined. Guidance from the applicant/agent should be sought in cases where the surname or family name is not immediately obvious. Where it is evident from part 2 of F1 that any applicant is a corporate body a F7 will be necessary and must be filed within the 16 months period prescribed by r.10(3) (extendible by r.108(2) and r.108(3) as above). The objection should be made at preliminary examination and should be communicated in accordance with the procedures in Chapter 7. If the objection is made to a private applicant a blank F7 should be sent.

3.06 Where it is evident that all the applicants (including single applicants) mentioned in part 2 of the F1 are not corporate bodies an objection should be raised if part 7 of F1 is not completed in full. It cannot be assumed that all applicants are also inventors unless the questions in part 7 are answered "YES" and "NO" in that order.

3.07 If the applicant fails to file a statement of inventorship within the prescribed period the application is taken to be withdrawn under the provisions of s.13(2) and will not be published. The WR4 reminder letter will be issued before termination (see also Chapter 11).

Derivation of Right

3.08 There are various ways by which the applicant may have acquired his right, e.g. by deed of assignment or by a contract of employment (s.39), or by inheriting the rights following the death of the original applicant although a personal representative may be acting on behalf of the deceased while his estate is being distributed.

3.09 A statement of the derivation of right must be given at part 5 of F7 if the applicant is not the inventor. This is a mandatory requirement of s.13(2). A F7 without a derivation of right should be treated as invalid (ie. not filed) and the applicant/agent invited to re-file it. If the 16 month period has expired an extension of time will need to be sought under rule 108(2) or (3) as in 3.02. It is not possible to correct a F7 in order to add a derivation of right if the 16 month period has elapsed.

The statement must show clearly how the applicant derives the right to grant of the patent. Some statements may be too broad or insufficiently comprehensive to comply with the requirements of the Act. Examples of such statements are:

- "by operation of law or by due process of law"
- an incomplete chain of title, such as "by assignment from A to B" where the applicant is C
- "we are entitled to the whole property of the invention"

Such descriptions of title are unacceptable because they are simply statements that the applicant has the right. They do not show how the right was derived.

3.10 A statement that the applicant derived the right by virtue of s.7 (2) (b) or (c) is acceptable following the Nippon Piston Ring [1987] RPC 120 case.

3.11 On any case where a defective description of derivation of right occurs, the matter must be immediately discussed with the Formalities Manager. If the Formalities Manager agrees with the objection, and provided at least three weeks remain of the prescribed 16 month period for submitting the F7, the agent/applicant should be telephoned and advised to correct the defect within the 16 month period. This must be done by filing a fresh F7. If however, the 16 months has elapsed the derivation should be corrected with a request in writing under s.117. A telephone conversation report should be issued in the usual way and a copy imported into the dossier. (Where no derivation of right has been given see 3.09)

3.12 If, however:

- (a) there is less than 3 weeks left of the 16 month period; or
- (b) the agent refuses to correct the defect; or
- (c) the F7 or the correction request is submitted after expiry of the 16 month period,

the Formalities Manager should refer the matter to the Head of Administration.

Incomplete or Incorrect Patents Form 7

3.13 If, upon Formalities examination, it is found that the F7 is not fully or correctly completed a request for a fresh form should be made and this must be filed within the prescribed 16 month period (see 3.11 above). If the fresh form is acceptable it should be annotated 'effective' on the TOC. The original form should be annotated 'cancelled'.

3.14 Since the requirements of r.10(3) are regarded as having been complied with upon the filing of a complete F7, any minor discrepancy discovered after the prescribed period (excluding the statement of derivation of right, see 3.09 - 3.10) may be capable of correction within a period specified by the Office. If there is any doubt about any case likely to require such treatment it should be referred via the Formalities Manager to the Assistant Head of Administration for consideration.

3.15 Within the period prescribed by r.10(3) the applicant may submit a request to add or correct information on an earlier filed F7. Depending on the extent of the change requested, it may be acceptable for the request to be made by letter as opposed to filing a fresh F7. Thus if, for instance, all that needs correcting is a mis-spelt name, the Formalities Examiner can effect the correction using the Enhancer. If the Formalities Examiner is unsure, then the matter should be referred to the Assistant Head of

Administration for advice on whether or not a fresh F7 is needed. No evidence is required to substantiate the correction. Depending on whether or not a fresh F7 is filed the Formalities Examiner should either correct the original F7 or cancel it and endorse the new F7 as the effective form in the TOC. Copies of the corrected or replacement F7, as the case may be, should be despatched to the inventors if the application is in the category referred to in 3.20.

- 3.16 If the period prescribed by r.10(3) has expired the applicant/agent may request that such an error be corrected with a written request under s.117. If the request is allowed and the F7 is corrected, copies of the corrected F7 should be sent to the inventors if the application is in the category referred to in paragraph 3.20 below. If the application has been 'A' published - see also 3.23. If the applicant/agent wishes to change an address on a F7 after the period prescribed by r.10(3) has expired he may do so by requesting the change in a letter.
- 3.17 When an inventor has been added or deleted, following a correction request, *before* completion of preparation for early publication, in addition to correcting the F7, the necessary "OPTICS" action to record Footnote 6 should also be taken.
- 3.17a If the 16 month period for filing F7 has elapsed, the applicant or agent can only add or remove an inventor by requesting a correction in writing if there is a F7 already on the dossier. If no F7 has been filed after 16 months the applicant or agent should be advised that F52 is required to extend the period for filing F7.
- 3.18 Copies of the correct F7 should be sent to the inventors, in either circumstance, if the application is in the category referred to in 3.20.
- 3.19 When a divisional application is filed under s.15 (9) of the Act, the applicant may request deletion of one or more of the inventors names from the parent application. To satisfy the Office in this regard, the applicant should be informed that if an inventor's name is to be removed from the parent application, the procedure contained in s.13(3) and r.10 should be followed. Upon receipt of a completed F2 and attached statement the case should be directed to Litigation Section who will then deal with the matter. Following the amendment of claims the applicant/agent may request deletion of one or more of the inventors' names from the parent application. Such a request need not be filed using a F2 but should be brought to the attention of the (Assistant) Head of Administration for action.

Copies of Patents Form 7

- 3.20 Where the application does not declare a foreign priority or a GB priority is declared a copy of the F7 should be sent to each inventor. The F7 should be printed and the inventor ticked to indicate to the post room where to send the document. The Post Room will attach a pre-printed slip which explains why the F7 is being sent. The F7 in the TOC should be annotated "F7 sent to inventor(s)".
- 3.21 Where copies of the F7 despatched to the inventor(s) are not delivered and are returned to the Office, the Agent should be contacted (by telephone, if possible, with confirmatory report) to see if the address is correct or if an up-dated address is available.
- 3.22 Where a forwarding address has been lodged with the Post Office, mail will be re-directed automatically. Under no circumstances is the Post Office allowed to give details of any forwarding address.

Right to be Named as Inventor

- 3.23 When the application is published under s.16, the inventors named on F7 will be mentioned on the 'A' print. Any person not mentioned on the F7 by the applicant may claim that he has a right to have been so mentioned as an inventor by filing F2. The form is then actioned by Litigation Section who also deal with applications under s.13(3) for the Comptroller to certify that a person should not be mentioned as inventor. This should not be confused with a correction request to correct inventor details. If there is any doubt the case should be referred to the Assistant Head of Administration.

Failure to file Patents Form 7

- 3.24 If the applicant is not the inventor, and a F7 has not been filed, care should be taken to ensure that the report of this outstanding procedural matter is communicated to the applicant in sufficient time to allow the requirement to be complied with. Therefore, if, when preliminary examination is made, expiry of the period prescribed by r.10(3) is relatively near; the Agent should be contacted by telephone followed by a confirmatory report. In the case of a private applicant a first letter should be issued before the case is referred to the examiner.
- 3.25 If a F7 is not filed by the time the r.10(3) period expires and the 2 month extension period allowed under Rule 108(2) has expired a WR4 letter should issue. (See 11.29 – 33) The letter will state that the application has

now been terminated. If the application is to continue reinstatement action will be required.

Confidentiality & Publication

- 3.26 An inventor (but not an applicant) may have his name and address kept confidential by the Office. These provisions are important in meeting concerns about inventors working in controversial areas such as biotechnology. The applicant will still be required to supply the inventor details and derivation of right on F7 but rule 11 allows the inventor to apply to the Comptroller to waive his right to be mentioned publicly as inventor.
- 3.27 The request for confidentiality must be made **before** the preparations for publication of the application are complete.
- 3.28 An inventor may ask for his name and address or just his address to be kept confidential. His address can be withheld 'as of right' but for both name and address to be kept confidential reasons must be given. Each request will be judged on merit to achieve a balance between the concerns of inventors working in certain fields and concerns that confidentiality could remove a useful tool for searching patent applications and evaluating inventions.
- 3.29 A request to withhold only the inventor's address may be actioned by the Formalities Examiner dealing with the case. The Formalities Examiner should use Optics function **SUP INV** (Suppress Inventor Details) to action the request (selecting the option to suppress the address only).
- 3.30 A request to withhold both name and address will be decided by the Head of Administration in consultation with legal advisors.
- 3.31 If the request is accepted no document will be published which identifies the inventor's name and/or address. No details will appear in the bibliographic data published online or on the front page of the 'A' specification and a footnote will indicate that at least one inventor has waived the right to be mentioned. The same will apply to the 'B' specification at grant.
- 3.32 If the request is accepted, the Formalities Examiner should use Optics function **SUP INV** (Suppress Inventor Details) to action the case (selecting the option to suppress the name and address). Furthermore, the Head of Administration will supply the wording for a footnote to the published specification, which should be added using Optics function **REC FOO**.

- 3.33 If there are other inventors who do not want their details kept confidential they will appear on the printed specifications in the usual way.
- 3.34 After publication any document, including the F7, containing the inventor's name and/or address must be withheld from public inspection and rule 51(3) allows this.
- 3.35 If all the inventor details are subject to confidential treatment, the F7 should be set as "No" in the Public column in the TOC and a suitable annotation added "Not Open to Public Inspection". If only some of the inventor details are to be withheld then a copy of F7 should be made up with the confidential details blanked out so as to leave the remaining inventor details available on the open part of the dossier. The original F7 should be placed on the closed part of the dossier.
- 3.36 Care should be taken to ensure that any other correspondence or document containing the confidential details is set as "No" in the Public column in the TOC and a suitable annotation added "Not Open to Public Inspection". This may include, for example, the letter from the inventor requesting confidentiality. The Comptroller may however provide access to the inventor details in a particular case if there is a bona fide need to disclose them in, for example, entitlement or inventorship proceedings.
- 3.37 An inventor may change his mind and ask to have his details made public. This may be subject to conditions e.g. if he changes his mind after 'A' publication we do not have to re-publish the 'A' specification just to show the inventor's name.
- 3.38 If the inventor's name has been withheld from the register and 'A' and 'B' publication, it will also be withheld from the certificate of grant.
- 3.39 Rule 44 requires that unless a confidentiality request has been accepted the names of the inventors are entered on the register at s.16 publication therefore a request for accelerated publication cannot normally be actioned until F7 has been filed.

Deceased Inventors

- 3.40 The Patents and PCT rules both require that an inventor's name and address be supplied and these details are also required for entry onto the Patents Register. A number of section 89 National Phase PCT cases have been received where the inventor has been shown on the WIPO pamphlet as 'deceased' without any address details present.
- 3.41 Indexing & Scanning Section are unable to allocate an ADP number on Optics without some address information and this has caused difficulties

processing the application through Formalities. Although the inventor may be deceased at the time of filing the application, at the time the invention was made he/she would have had an address. Although in theory it should be reasonably straightforward to obtain this information, this may not always be possible and it is a potentially sensitive issue to be handled with care.

- 3.42 When the inventor is deceased and the address details are missing, Formalities Examiners should proceed as follows:
- 3.43 In all cases Formalities Examiners should request the last known address of the deceased inventor from the agent or representative;
- 3.44 If the agent or representative cannot supply the address the Formalities Examiner should request the country in which the inventor resided, this will enable an ADP number to be allocated. If the country of residence cannot be supplied the application should be referred through the Formalities Manager to the Head of Administration.
- 3.45 When requesting the last known address the Formalities Examiner should state that we are doing so because of the requirements of Rule 44 to enter this on the patents register;
- 3.46 In all cases the Formalities Examiner should explain that if required, the address details can be suppressed (once supplied) under the provisions of Rule 44. If suppression is requested the Formalities Examiner should follow the procedure set out in paragraphs 3.26 to 3.39 above.
- 3.47 Having obtained the address details, the Formalities Examiner should refer the application to Indexing & Scanning Section for allocation of an ADP number.