

## CHAPTER 7

### SECTIONS 8, 10, 12, & 37 ENTITLEMENT

|   |             |
|---|-------------|
| Introduction  | 7.01 - 7.06 |
| Initial Action  | 7.07 - 7.09 |
| Formal Requirements   | 7.07        |
| Action by Litigation Assistant  | 7.08 - 7.09 |
| Statement   | 7.10 - 7.25 |
| What should the statement contain?  | 7.10 - 7.17 |
| What happens if the statement does not comply?  | 7.18 - 7.23 |
| Serving the statement   | 7.24        |
| Conversion of a section 8 reference into a section 37 reference                       | 7.25        |
| Counter-statement   | 7.26        |
| Evidence rounds   | 7.27        |
| Decision  | 7.28 - 7.32 |
| Updating the Register (B3 action) - free text entries<br>(below the line)             | 7.29 - 7.30 |
| Updating the Register (B3 action) - adding proprietor's details<br>(above the line)   | 7.31        |
| Updating the Register (B3 action) - removing proprietor's details<br>(above the line) | 7.32        |
| Registration of assignments   | 7.33        |

## 7 SECTIONS 8, 10, 12 & 37

### INTRODUCTION

- 7.01 Within the Patents Act 1977, three sections deal specifically with the question of who is entitled to a patent or patent application. These are:
- **Section 8** which relates to GB patents that have not yet been granted and applies whether or not a patent application, has been filed.
  - **Section 12** which relates to patents under foreign or international law which have not yet been granted
  - **Section 37** which relates to patents granted under the Patents Act 1977.
- 7.02 Where a European patent application is concerned, section 82 lays down the jurisdiction of the court and the comptroller to determine such questions. Thus before proceeding with an EP reference under section 12, the B2/B3 should check section 82 provides the appropriate jurisdiction.
- 7.03 A granted European patent designating the UK ie a European patent (UK), is treated as if it were a patent under the 1977 Act resulting from an application made under the 1977 Act. Questions with regard to entitlement may therefore be referred to the comptroller under section 37.
- 7.04 Section 12 applies to applications under the Patent Co-operation Treaty (PCT), during the international phase while section 8 applies during the national phase (see section 89B(4) of the Patents Act 1977).
- 7.05 In addition to these sections, section 10 of the Act provides that certain disputes between joint applicants for a patent may be resolved by the comptroller on request from any of the parties involved.
- 7.05.1 Occasionally entitlement references refer to sections 9 and 82 of the Patents Act 1977. These do not provide for proceedings to be filed. Rather they simply affect the extent to which the other sections are applicable.

7.06 The procedures in relation to entitlement actions and for requests made under section 10 or section 12(4) by a joint applicant, are set out in the Patents Rules 1995.

## **INITIAL ACTION**

### Formal Requirements

7.07 Follow procedures at 1.03 and 1.04.

### Action by Litigation Assistant (A1)

7.08 Follow procedures at 1.05 to 1.07.

7.09 Using the OPTICS function REG ENT, a free text entry in relation to a reference under section 8,12 and 37 should be made as follows:

‘Reference under Section ..... filed on .....’

Where a request is made under section 10 or section 12(4), the free text entry should read:

‘Request under Section ..... filed on .....’

## **STATEMENT**

### What should the statement contain?

7.10 Follow procedures in paragraphs 1.08 to 1.11.

### Relief under section 8

7.11 For a reference made under section 8(1), the comptroller will determine the question and will make such orders as he thinks fit to give effect to the determination. As set out in section 8(2), the comptroller may:

- order that the application proceed in the name of the claimant, either solely or jointly with any other applicant, instead of in the name of the applicant or any specified applicant.

- order that the application proceed in joint names where the reference is made by two or more persons.
- refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred.
- make an order transferring or granting any licence or other right in or under the application and give directions to any other person for carrying out the provisions of any such order.

7.12 Where a question is referred to the comptroller under section 8(1)(a), section 8(3) provides, at the discretion of the comptroller, for the making of a new application by the claimant when the original application is no longer proceeding or no longer contains the matter to which the claimant is held to be entitled. The question of third party terms may need to be raised and considered.

7.13 Where a person refers a question under section 8(1)(b), the comptroller may make an order giving directions to any person in relation to transferring or granting any right in or under the application.

#### Relief under section 12

7.14 For a reference under section 12(1)(a) or 12(1)(b), the comptroller may make such orders as he thinks fit to give effect to the determination; however, the extent to which the comptroller is able to determine the question may be affected by a number of factors, for example, the particular foreign or international law under which the application has been made and the stage reached in the prosecution of the application.

#### Relief under section 37

7.15 For a reference under section 37(1)(a),(b) or (c), the comptroller may again determine the question and make such orders as he thinks fit. Examples of the type of relief available are mentioned in section 37(2). The comptroller may issue an order:

- directing that the claimant should be included on the register as a proprietor
- directing that the registration of a transaction, instrument or event be made in favour of the claimant
- granting any licence or other right in or under the patent
- directing that the existing proprietor or any other person having rights in respect of the patent be given directions as necessary to carry out the other provisions of the order

7.16 Whilst a reference may be referred to the comptroller under section 37 at any time after the publication of the mention of its grant, the remedies available may be restricted if the reference is made more than two years after the mention of grant (section 37(5)). In such circumstances, although, for example, the claimant may claim a proprietary interest, the HO may not make an order that satisfies the relief sought.

#### Section 10, 12 (4)

7.17 For a request made under section 10 or 12(4), the statement should again set out fully the facts relied upon and also the directions sought. Under section 10 of the Act, the comptroller may give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which the application should proceed or both as the case requires.

#### What happens if the statement does not comply?

7.18 Follow procedures at 1.12 to 1.16.

7.19 Where the reference has been made under section 8(1)(a) or 12(1)(a), the letter pointing out the defects in the statement should be copied to:

- any person (other than the claimant) alleged in the reference to be entitled to be granted a patent for the invention

- any person, not being a party to the reference, who is shown in the register as having a right in or under the patent
- where the application for the patent has not been published, any person who is an applicant for the patent or has given notice to the comptroller of a relevant transaction, instrument or event
- every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention

7.20 Where the reference has been made under section 8(1)(b) or 12(1)(b), the letter should be copied to:

- each proprietor who is not a party to the reference and who has not otherwise indicated his consent to the making of the order sought
- any person to whom it is alleged in the reference that any right in or under an application for a patent should be transferred or granted
- any person, not being a party to the reference, who is shown in the register as having a right in or under the patent application
- where the application for the patent has not been published, any person (not being a party to the reference) who has given notice to the comptroller of a relevant transaction, instrument or event
- every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention.

7.21 Where the reference is made under section 37(1), the letter should be copied to:

- a person who is shown on the register as having any right in or under the patent
- a person who is alleged in the reference to be entitled to a right in or under the patent

- 7.22 Where a request is made under section 10 or section 12(4), the letter should be copied to each other joint applicant.
- 7.23 A covering letter should be sent with the copy letter. This should point out to the parties concerned that they are not being invited to file a counter-statement until the issues raised with the claimant have been resolved.

### Serving the Statement

- 7.24 Follow procedures at 1.16 - 1.17 and 1.33 - 1.34

### Conversion of a Section 8 Reference into a Section 37 Reference

- 7.25 Occasionally a reference under section 8 will need to be converted to one under section 37 because the patent application in question has proceeded to grant. A letter along the following lines should be sent to the claimant and copied to the other side:

‘Patent application number..... has now been granted. By virtue of section 9 of the Patents Act 1977, we will treat the entitlement reference you have made under section 8 as though it had been made under section 37. This may affect the relief available to you if you are successful, but should not otherwise affect the course of the proceedings. Unless I hear from you or the defendant to the contrary, I shall assume you are both happy to defer dealing with the question of relief until the substantive hearing.’

(For a more detailed explanation of this procedure, see Chapter 16 of this Manual).

### **COUNTER-STATEMENT**

- 7.26 Follow procedures at 1.18 to 1.22.

### **EVIDENCE ROUNDS**

- 7.27 Follow procedures at 1.23 to 1.28.

## DECISION

7.28 Follow procedures at 1.29 to 1.30.

### Updating the Register (B3 action) - free text entries (below the line):

7.29 If the reference has been allowed:

- use REG ENT free text and type in a register entry. Examples are below:

‘In a decision of the comptroller dated day.month.year,  
..... [insert name] was removed as a named proprietor of the patent.

‘In a decision of the comptroller dated day.month.year, the comptroller ordered that .....[insert name and address] should be named as joint applicant/proprietor

7.30 If the reference is refused:

- use REG ENT free text and type in a register entry as in the following example:

‘In a decision of the comptroller dated day.month.year, the reference under section ..... filed on day.month.year, was refused.

### Updating the Register (B3 action) - adding proprietor's details (above the line):

7.31

- Check if the proprietor you wish to add has an ADP number - use OPTICS function SEA NAM.
- If no ADP number exists, contact Assignments Section who will arrange for one to be created. The person's/company's full name and address need to be supplied.
- Use OPTICS function CHA ROL. From the CHA ROL 1 screen, make a note of the start date of the other proprietors mentioned. Scroll through the rest of the screens inserting ‘Y’ at the bottom.

- On screen CHA ROL 2, enter in Role Code 1, the start date and the ADP number of the person/company you are adding. When this is confirmed, the name and address details should appear on screen. Once this is confirmed as correct, the update is complete.
- To check this, go back into the CHA ROL 1 screen. The added proprietor details should also appear on the DIS FUL print

Updating the Register (B3 action) - removing proprietor's details (above the line):

7.32

- Use OPTICS function CHA ROL. Rather than removing details from the register, the action taken will close them down. On screen CHA ROL 1, insert end date. This should be the date of the Hearing decision and should be the same date as referred to in the free text entry initially carried out.

Note: The screen on which the free text register entry is typed provides an option to move directly to the 'CHA ROL' screens. Simply change the 'Roles to Record' to 'Y'. From the following pages, select the appropriate options.

**REGISTRATION OF ASSIGNMENTS WITHIN ENTITLEMENT PROCEEDINGS**

7.33 Where entitlement proceedings are pending before the comptroller, a request to register an assignment should be referred to a HO. Unless special circumstances apply, the HO will direct the B2 to contact the claimant to determine if he is content with the registration. If the claimant is not content, the registration should be stayed until the proceedings have been settled. The assignment request will be recorded on the register.