

CHAPTER 8

SECTION 13 MENTION OF INVENTOR

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8 SECTION 13

INTRODUCTION

- 8.01 Section 13 of the Patents Act 1977 concerns the right of an inventor to be mentioned in an application or a patent (section 13(1)), the obligation on the patent applicant to identify the inventor(s) (section 13(2)), and the right of any person to object to a mentioned inventor. (section 13(3)).
- 8.02 The invention to which a patent or an application relates is determined by the claims. Since these may be amended, it is possible that a person may be entitled to be named as an inventor in the published application but not in the granted patent.
- 8.03 Litigation Section deals with the procedural aspects of disputes arising from inventorship ie section 13(1) and section 13(3). The procedures governing such disputes are laid down in the Patents Rules 2007. Disputes arising under section 13(1) are filed as an application under rule 10(2) of the Patents Rules 2007.
- 8.04 (Deleted)
- 8.05 In the case of an application for a European patent (UK), inventorship details may be corrected before the EPO under rule 19 of the European Patent Convention. An application under rule 10(2) and 13(3) may be made once the grant of a patent has been mentioned in the European Patent Bulletin. An application may be made under section 13(3) either before or after mention of grant of a patent in the European Patent Bulletin. However, if the application is made before the grant, the relief available in respect of a published application is limited (see section 78(2)).

INITIAL ACTION

Formal Requirements

8.06 Section 13(1) provides that:

'The inventor or joint inventors of an invention shall have the 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.'

8.07 In other words, an application may be made under rule 10(2) to add an inventor or inventors. Under the Patents Rules, any person may make an application; that is, any person may allege that any other person should have been mentioned as an inventor or joint inventor in any patent granted or any published application for a patent for the invention (see rule 10(4)).

8.08 Section 13(3) provides that:

'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.'

8.09 In other words, if an inventor or joint inventor is shown on the register and it is considered that he should not be named as such, an application can be made under section 13(3) for a certificate to that effect. If a certificate is issued (it will be in the form of a decision), the register will be altered and any copies of the patent subsequently distributed, will be amended.

8.10 Any person may make such an application under section 13(3).

8.11 Follow the procedures at 1.04 to 1.07.

Action by Litigation Assistant A1

8.12 Follow the procedures at 1.08 to 1.09.

8.13 Using the OPTICS function REG ENT, a free text entry should be made as follows:

For section 13(1):

‘Application under rule 10(2) by.....filed on.....’

For section 13(3):

‘Application under section 13(3) by.....filed on

STATEMENT OF GROUNDS

What should the statement contain?

8.14 Follow procedures at 1.11 to 1.12.

What happens if the statement does not comply

8.15 Follow procedures at 1.13 to 1.18

8.16 The letter which is sent to the applicant pointing out the defects in the statement should be copied for example to:

- every person registered as proprietor of, or applicant for, the patent
- 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
- every other person whose interests the comptroller considers may be affected by the application

8.17 A covering letter should be sent with the copy letter. This should point out to the parties that they are not being invited to file a counter-statement until the issues raised with the applicant have been resolved.

PECS:- Letter is created in Microsoft ® Word and imported using manual

import (doc code is LETTER-LIT)

Serving the Statement of Grounds

- 8.18 Follow the procedures at 1.19 - 1.24.
- 8.19 The B2/B3 should send a copy of the statement and Form 2 to those referred to in para 8.16 above other than the applicants under rule 10(2) or 13(3) and any other person who has consented in writing to the application.

Unopposed applications

- 8.20 If those invited to file a counter-statement do not do so within the time allowed or subsequently confirm in writing that they do not oppose the application filed, the comptroller will allow the application and will issue a decision accordingly (see annex 1).
- 8.21 The procedure may be simplified even further if, when the application is filed, the applicant provides written consent from all parties involved. If an application under rule 10(2) and/or 13(3) is considered unopposed, the B3 should issue a decision to that effect. An example of a decision is included at annex 1.
- 8.22 It should be noted that there may be circumstances where it may not be appropriate to file formal proceedings to remove an inventor or joint inventor under section 13(3) because essentially there may not be a dispute. As a result of filing an amendment relating to a published patent application, for example, the contribution made by a particular inventor may be deleted. While the inventor may be correctly named in the published patent application, it may not be appropriate to name him as such in any patent granted for the invention. Once an amendment has been accepted, if all parties agree that a person should not now be mentioned as an inventor, the Office would not mention him as such in any patent granted for the invention. If the question of inventorship was in dispute, and this was the only matter outstanding, this would not prevent the amended application from proceeding to grant. It would mean

however that an application under section 13(3) may be filed in order to resolve the dispute.

THE COUNTER-STATEMENT

8.23 Follow procedures at 1.25 to 1.26.

MANAGEMENT OF PROCEEDINGS

8.24 Follow procedures at 1.28 to 1.40.

EVIDENCE ROUNDS

8.25 Follow procedures at 1.41 to 1.45.

DECISION

8.26 Follow the procedures at 1.46 to 1.47.

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

8.27 If an application under rule 10(2) is allowed:

- use REG ENT free text and type a register entry in line with the example below:

‘In a decision of the comptroller dated day, month, year, the application filed on day, month, year, under rule 10(2) was allowed. The comptroller ordered that[insert name and address details] should be named as a joint inventor’.

8.28 If an application under rule 10(2) is refused:

- use REG ENT free text and type a register entry as follows:

‘In a decision of the comptroller dated day, month, year, the application under rule 10(2) filed on day, month, year, was refused.’

8.29 If an application under section 13(3) is allowed:

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

‘In a decision of the comptroller dated day, month year, the application filed on day, month, year, under section 13(3) was allowed. The comptroller ordered that[name of inventor] should not be mentioned as an inventor.’

8.30 If an application under section 13(3) is refused:

- use REG ENT free text and type a register entry as follows:

‘In a decision of the comptroller dated day, month, year, the application under Section 13(3) filed on day, month, year, was refused’.

If the application relates to rule 10(2) and section 13(3), the register entry should record both outcomes.

Updating the register (B3 action) - adding an inventor's details:

8.31 When updating the register as a result of a rule 10(2) application being allowed, the B3 should:

- Check if the inventor being added already has an ADP number - use OPTICS function SEA NAM
- If no ADP number exists, contact Assignments Section who arrange for one to be created. The person's full name and address details will need to be supplied
- On receipt of the ADP number, use OPTICS function CHA ROL. From the CHA ROL 1 screen, make a note of the start date of the other inventor(s) mentioned. Scroll through the rest of the screens inserting 'Y' at the bottom.
- On screen CHA ROL 2, enter in Role Code 2, the start date and the

ADP number of the person being added. 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 inventor details should also appear on the DIS FUL print.

Updating the Register (B3 action) - removing an inventor's details

8.32 When updating the Register as a result of a section 13(3) application being allowed, the B3 should:

- 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.

Summarising the decision

8.33 The B3 should summarize the decision and send an electronic version of the summary along with the decision to the Hearings Clerk via the decisions and abstracts email address. The Hearings Clerk has access to the decision and abstracts email and will add the date, BL number and electronic signature to the decision before issuing. The Hearings clerk will also update the summary information with the BL number and date of the decision.

Annex 1

BLO/000/07
2nd October 2008

PARTIES

Insert name
of parties

ISSUE

Whether (insert name)should be mentioned
as sole inventor in patent number
GB(*****) as a result of an application
Under section 13(1) and 13(3)

HEARING OFFICER

Insert name

DECISION

- 1 Patents Form 7/77 names one inventor; (insert name of inventor).
- 2 (Insert name), the patent proprietors, have applied to have (insert names) named as sole inventor in accordance with rule 10(2) of the Patent Rules 2007 and have made an application under section 13(3) of the Act to the effect that (insert name) should not have been mentioned as an inventor.
- 3 (Insert name) and (insert name) have both provided written consent to the application filed under rule 10(2) and section 13(3). I therefore conclude that all the relevant parties agree that (insert name) should be named as sole inventor in the published patent application and granted patent for the invention
- 4 Accordingly I find that (insert name) should be mentioned as the sole inventor

in the published patent application and granted patent for the invention. I also direct, in accordance with rule 14(5), that an addendum slip be prepared for the published patent application and for the granted patent for the invention. The slip will mention (insert name) as sole inventor and state that (insert name) should not have been named as an inventor.

- 5 This decision serves as a certificate, issued in accordance with section 13(3), to the effect that (insert name) should not have been mentioned as an inventor in the published patent application and granted patent for the invention.

(Insert Hearing Officers name)

(Insert Job Title), acting for the comptroller