

CHAPTER 10

SECTION 40 COMPENSATION OF EMPLOYEES FOR CERTAIN INVENTIONS

Introduction	10.01
Making an application	10.02 - 10.05
Who may apply?	10.02
To whom should the application be addressed?	10.03
Which type of patents can a section 40 application relate?	10.04
Period during which an application may be made	10.05
Public Inspection	10.06
Initial Action	10.07 - 10.08
Formal Requirements	10.07
Action by Litigation Assistant (A1)	10.08
Statement of Grounds	10.09 - 10.11
What should the statement of grounds contain?	10.09
What happens if the statement of grounds does not comply?	10.10
Serving the statement of grounds	10.11
Counter-statement	10.12
Management of proceedings	10.13
Evidence rounds	10.14
Decision	10.15

10 COMPENSATION OF EMPLOYEES FOR CERTAIN INVENTIONS

INTRODUCTION

10.01 Section 40 provides for the Court or the comptroller to award compensation to be paid by an employer to an employee in respect of an invention made by the employee, in certain circumstances.

MAKING AN APPLICATION

Who may apply?

10.02 The employee is the person who can apply. He should be named as inventor of the patent. If he has not been named, he will need to file an application under rule 10(2).

To whom should the application be addressed?

10.03 The application should be made with reference to the employer not the current proprietors. The employer may be a different person from the current proprietors (*Fellerman's Application* (BL 0/11/96)). If there is any confusion on this point, it will need to be addressed in the early stages of the proceedings.

Which type of patents can a section 40 application relate to?

10.04 The patent must be a granted patent. Foreign patents as well as GB patents may be the subject of an application. More than one patent may be mentioned on the Patents Form 2.

Period during which an application may be made

10.05 The application may be made at any time from the date of grant of the patent until one year after the patent has ceased to have effect (rule 91(1)). If, after failure to pay a renewal fee, a request is made for restoration of the patent under section 28 then:

- if the patent is restored, the period continues as if these events did not occur or
- if the restoration is refused, the period expires either one year after the patent ceased to have effect or six months after the refusal, whichever is the later.

PUBLIC INSPECTION

10.06 Documents filed in section 40 proceedings are not open to public inspection. Decisions are not open to public inspection for 28 days, pending comments by the parties concerning any parts of the decision for which confidentiality is requested. The comptroller may then issue a redacted version of the decision. This is open to public inspection.

INITIAL ACTION

Formal Requirements

10.07 Follow procedures at 1.04 to 1.07. The B3 should inform the A1 that the proceedings are NOPI.

Action by Litigation Assistant (A1)

10.08 Follow procedures at 1.08 to 1.09.

PECS:- Each Indexing and Scanning Request Sheet should show that the documents should be indexed as NOPI.

STATEMENT OF GROUNDS

What should the statement of grounds contain?

10.09 Follow procedures at 1.11 to 1.12.

PECS:- The B2 should annotate the front cover of the dossier “Section 40

Litigation proceedings NOPI”

What happens if the statement of grounds does not comply?

10.10 Follow procedures at 1.13 to 1.18

PECS:- Letters created and imported into the PECS dossier should be shown as NOPI.

Serving the Statement of Grounds

10.11 Follow procedures at 1.19 to 1.24. A copy of the application should also be served on the employer mentioned in Patents Form 2.

PECS:- Letter created and imported into the PECS dossier should be shown as NOPI.

COUNTER-STATEMENT

10.12 Follow procedures at 1.25 to 1.26.

PECS:- The Indexing and Scanning Request Sheet should show that the counter-statement should be indexed as NOPI.

MANAGEMENT OF PROCEEDINGS

10.13 Follow procedures at 1.28 to 1.40.

PECS:- All documents created and received should be indexed as NOPI.

EVIDENCE ROUNDS

10.14 Follow procedures at 1.41 to 1.53.

PECS:- All documents created and received should be indexed as NOPI.

DECISION

10.15 Follow procedures at 1.54 to 1.56. See also 10.06 above and 5.12 – 5.14.