

- 6 The invention set out in the applications is a method of determining the correct placement of a medical device (especially a nasogastric feeding tube) in a patient. The method makes use of the catalytic activity of an enzyme which is found in the correct placement position to confirm correct placement.
- 7 The joint inventors of the invention set out in the applications are Dr Reuben Carr and Mrs Lucy Farley, both UK nationals and UK residents at the time the invention was conceived. The invention arose following a discussion between Mrs Farley and Dr Carr after their hospitalised grandmother had undergone nasogastric feeding tube placement. Mrs Farley, a nurse at the time of conception of the invention, was familiar with the problems of incorrect nasogastric feeding tube placement. Dr Carr had detailed knowledge of enzyme function. Based on their discussions they jointly devised the improvement to known technologies which is set out in the applications.
- 8 The invention was further developed and tested by Ingenza prior to filing of the applications. At the time the invention was made, Dr Carr was employed by Ingenza as a Senior Research Scientist. His employment commenced on 1 November 2004 and he remains an employee of Ingenza.
- 9 Dr Carr's ownership of the invention passed to Ingenza by virtue of his employment and in line with section 39 of the Act. Dr Carr executed an assignment of his rights in respect of the corresponding US patent to Ingenza on 1 November 2013. This assignment was required to fulfil formal requirements before the US Patent and Trademark Office (USPTO), which Ingenza says does not imply that ownership was not already transferred by virtue of his employment. Ingenza says that this puts beyond doubt that ownership of the invention passed from Dr Carr to Ingenza, whether by virtue of employment or assignment.
- 10 Mrs Farley was not at the time of the invention, and never has been, an employee of Ingenza. At the time of the invention, Mrs Farley was a nurse. The invention did not arise during the course of her normal duties or in the course of duties falling outside her normal duties but specifically assigned to her. Her duties were not such that the present invention could reasonably be expected to arise. Accordingly, Mrs Farley was, jointly with Ingenza, the initial owner of the invention.
- 11 Ingenza says that neither Dr Carr nor Mrs Farley had, at the time of the invention, or at any time thereafter, any contractual or other form of obligation to Richmond. On 3 December 2009, US provisional application 61/283,401 was filed at the USPTO. This was correctly filed in the name of Dr Reuben Carr and Mrs Lucy Farley.
- 12 On 1 December 2010, International PCT application PCT/US2010/058585 was filed at the USPTO. It was incorrectly filed naming Richmond Chemical Corporation as applicant.
- 13 Ownership of rights in respect of the corresponding US patent, US8696567, passed from Mrs Farley to Ingenza by virtue of an assignment executed on 11 January 2014. Ingenza claims that this assignment also transferred ownership of all related non-US patent applications to Ingenza, which it says is clear from the wording "...and all foreign rights including the right to make application for Letters Patent for said inventions in any and all foreign countries". Ingenza says that the invention in the corresponding US patent is identical to the invention set forth in the applications.
- 14 A confirmatory assignment has recently been executed by the inventors which

confirms that "all rights, title and interest in and to the inventions and the Patents vests in the Assignee", i.e. Ingenza Limited. A copy of the assignment, dated 22 December 2016 and listing all of the applications by number, was submitted by Ingenza on 19 January 2017.

The law

15 The relevant parts of section 12 read as follows:

12. (1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made) -

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) ...

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

16 Sections 12(3) and 82 set out the circumstances in which the comptroller has jurisdiction to determine questions concerning entitlement to European patent applications.

17 There is no question that the comptroller has jurisdiction to determine the question of entitlement to the applications referred to by Ingenza and to make such orders it deems necessary to give effect to its finding.

Determination

18 The documentary evidence submitted by Ingenza provides material support for the uncontested facts set out in the Statement of Grounds. Dr Reuben Carr and Mrs Lucy Farley are the inventors of the method of determining the correct placement of a nasogastric feeding tube in a patient as set out in the applications. Mrs Lucy Farley and Ingenza Limited were jointly entitled to any patent for the invention at the time of filing the PCT application. Ingenza Limited became solely entitled to any patent for the invention through the execution of an assignment of Mrs Farley's rights. Richmond Chemical Corporation derives no rights in the applications and should be removed as the named applicant.

Declaration

19 I hereby declare that Ingenza Limited is solely entitled to the grant of European patent application number 10835070.3, Canadian patent application number CA2819582, Indian patent application number IN5900DEN2012, plus any other patent application which derives from PCT application number PCT/US2010/058585.

Order

20 I order that:

- Ingenza Limited and Mrs Lucy Farley, not Richmond Chemical Corporation, should be named as joint applicants in PCT application number PCT/US2010/058585 as of its date of filing;
- Ingenza Limited, not Richmond Chemical Corporation, is entitled to any and all rights in or under i) European patent application number 10835070.3, ii) Canadian patent application number CA2819582, iii) Indian patent application number IN5900DEN2012.
- Richmond Chemical Corporation should take any and all necessary steps to assist Ingenza Limited give effect to my determination.

H Jones

Deputy Director, acting for the Comptroller