BL O/0612/26

17 July 2026

PATENTS ACT 1977

BETWEEN

	Impedans Limited	Claimant
	and	
	Donal O'Sullivan and Paul Scullin	Defendants

PROCEEDINGS

Reference under section 37 of the Patents Act 1977 in respect of European patent EP2481074 B1

HEARING OFFICER Dr B Micklewright

DECISION

Introduction

1 These proceedings concern entitlement to European patent EP2481074 B1 ("the patent"). The patent was granted to Donal O'Sullivan and Paul Scullin on 17 October 2018. Mr O'Sullivan and Mr Scullin are also listed as the only inventors.

2 The claimant's case is that they are entitled to the patent by virtue of Mr O'Sullivan's and Mr Scullin's employment by the claimant at the time of the devising of the invention in the patent.

3 Neither Mr Scullin nor Mr O'Sullivan filed a counter-statement. The reference is therefore treated as unopposed. In accordance with rule 78(9) of the Patents Rules 2007, I will therefore treat the proprietors of the patent as supporting the claimant's case.

The evidence

4 The claimant attached to their statement of grounds witness statements from the following witnesses, with accompanying exhibits:

A. Mike Hopkins, founder of Impedans, and Chairman of the Board of Impedans since 2004.

B. Paul Scullin, named as one of the proprietors of the patent.

C. Karen Gallagher, a solicitor and partner at Pinsent Masons Ireland LLP, specialising in life sciences patent litigation.

D. David Brophy, a European Patent Attorney and partner at FRKelly.

5 Although these proceedings are unopposed and I am thus treating the proprietors of the patent as supporting the claimant's case, I am nevertheless required to assess the evidence and make findings of fact on the balance of probabilities. I will therefore need to decide whether it is more likely than not that a particular assertion by the claimant, or by a witness, is correct.

The law

6 UK law concerning entitlement to granted patents is set out in section 37. Section 37(1) says:

> (1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question—
>
> > (a) who is or are the true proprietor or proprietors of the patent,
> >
> > (b) whether the patent should have been granted to the person or persons to whom it was granted, or
> >
> > (c) whether any right in or under the patent should be transferred or granted to any other person or persons;
>
> and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.

7 Section 37(5) prescribes a restriction in relation to when a reference under section 37 may be brought:

> (5) On any such reference no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) above on that ground, if the reference was made after the second anniversary of the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

8 Section 39 concerns the right to employees' inventions. Section 39(1) says:

> (1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if—
>
> > (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to

him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

9 Section 42 relates to enforceability of contracts relating to employees' inventions. Section 42(2) states:

(2) Any term in a contract to which this section applies which diminishes the employee's rights in inventions of any description made by him after the appointed day and the date of the contract, or in or under patents for those inventions or applications for such patents, shall be unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent.

10 I note however that section 43(2) states:

Sections 39 to 42 above shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say -

(a) he was mainly employed in the United Kingdom; or

(b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in the United Kingdom to which the employee was attached, whether or not he was also attached elsewhere.

Employee inventions in Ireland – Karen Gallagher's evidence

11 The claimant asserts that the invention was made in Ireland by Irish inventors on behalf of the claimant, an Irish company. As these proceedings are unopposed, I have had no submissions from the defendants and therefore accept this assertion. Section 43(2) therefore applies in this case. I thus need to consider Irish law in respect of employee inventions. One of the claimant's witnesses, Karen Gallagher, a solicitor in Ireland, set out their view on the law concerning employee inventions in Ireland.

12 Karen Gallagher indicated in her witness statement that there is no express provision in Irish law equivalent to section 39. Moreover, she stated that she was not aware of any reported Irish cases which dealt with the ownership of inventions created by employees. She therefore stated that she had considered the case law of the courts of England and Wales for guidance as to the factors an Irish judge is likely to consider when faced with the question of ownership of employee inventions. Her evidence is that such case law, whilst not binding on Irish judges, may be of persuasive value due to the similarity between the two legal systems. Furthermore, she stated that it is often the case that court decisions from England and Wales are

cited in Irish proceedings and the reasoning of those decisions often adopted by the Irish courts.

13 Following this approach, Ms Gallagher's evidence is that, where a contract of employment exists, and where it contains express provisions regarding the ownership of inventions by the employee, those provisions should generally suffice to confirm the position in relation to ownership. I note that section 42, which relates to the enforceability of contracts relating to employee inventions, sets out circumstances where this may not be the case under UK law. There is no evidence or submissions before me in relation to the possible approach under Irish law in relation to these, or other, circumstances where a contract of employment may not suffice to confirm the position in relation to ownership, but there is no reason to suppose that the carve out of section 42, or any other such carve out, will impact these proceedings. For the purpose of these proceedings I therefore accept Ms Gallagher's evidence on this question to the extent that, if an employment contract contains provisions that are generally consistent with those of the UK Patents Act 1977 in assigning rights to inventions made by employees to employers, then it is likely that inventions devised by the employee in such circumstances would be owned by their employer. This will be sufficient for the purpose of these unopposed proceedings.

Assessment

14 The claimant's case is that Mr Scullin and Mr O'Sullivan were both employees of the claimant at the time of the making of the invention in the patent, and that they devised the invention in the course of their employment. A witness statement was provided by Mr Scullin in support of this submission. The claimant's case is not supported by a witness statement from Mr O'Sullivan himself. Rather, the claimant relies on the evidence of the other witnesses in support of the submission that Mr O'Sullivan was an employee at the time of the making of the invention, and that, in his role of General Manager, he was in a high-level position of responsibility and managed product development staff, supporting all of the product development projects of the claimant. The claimant also submits that both Mr Scullin and Mr O'Sullivan were aware that the invention belonged to the claimant at the time of the grant of the patent, which is relevant to considerations under section 37(5).

The inventive concept

15 The claimant's only submission in relation to the inventive concept is found in paragraph 2 of their statement of grounds:

> *"The patent is directed, in general, to apparatus and method for measuring plasma parameters ("the invention")."*

16 Whilst this statement is too general to be considered a specific identification of the inventive concept in the patent, it will be sufficient for the purposes of these unopposed proceedings to identify the inventive concept in these very general terms.

When was the inventive concept created, and by whom?

17 The claimant accepts that Mr Scullin and Mr O'Sullivan are the inventors of the inventive concept in the patent.

18 According to Mr Scullin's evidence, he commenced a project in 2008 with Mr O'Sullivan which resulted in the filing of the Irish patent application on 17 September 2009, from which the patent claims priority. This evidence is not contradicted by any of the other witnesses. Given the unopposed nature of these proceedings, I therefore accept that the invention was made in 2008 and/or in 2009, before the filing of the Irish priority document on 17 September 2009.

Employment of Mr Scullin

19 Mr Scullin's witness statement includes evidence of Mr Scullin's employment to the claimant at the time of the devising of the invention. Paragraphs 5 and 6 of Mr Scullin's witness statement state:

> *"5. I confirm that the foregoing invention [described in paragraphs 2-4 of the witness statement] was created by Donal O'Sullivan and I in the course of our employment at Impedans Limited, and on the basis of instructions from Mike Hopkins.*
>
> *6. I further declare that EP'074 was erroneously filed under my name and that of Donal O'Sullivan, instead of being filed under the name of Impedans Limited. It has always been unequivocally clear within the company that all inventions made by employees were the property of Impedans Limited at the time of grant, on 17th October, 2018. This understanding is also firmly supported by the provisions in my employment agreement."*

20 Exhibited with Mr Scullin's witness statement is a copy of his signed employment agreement dated 28 June 2007 in which it is stated that Mr Scullin's employment would commence on 1 August 2007 in a full-time capacity. This employment agreement includes, in clause 14, the following terms:

> *"14. INVENTIONS AND PATENTS*
>
> *(a) As part of your duties you will consider whether, and if so by what means, **new material** can be invented and developed.*
>
> *(b) All **new material** and all rights in it including copyright and design right shall become the sole property of Impedans Limited and you hereby assign all copyright, and such other property rights as may be appropriate, to Impedans Limited.*
>
> *(c) You will during and for two years after your employment with the Company communicate full details of all **new material** to the Company and do whatever is reasonably required by the Company to obtain patent or other protection for that material on behalf of the Company.*
>
> *(d) If at any time during your appointment you, alone or jointly, make any invention which is in any way connected to the business of the Company, you will disclose full details to the Company so as to enable the Company to determine whether it is a **Company invention**. If the invention is not a **Company invention**, all such information disclosed by you will be treated as confidential.*

*(e) If the invention is a **Company invention**, you will hold it in trust for the Company and you will do whatever is necessary, at the Company's expense, in order to obtain patent or other protection of the invention for the Company.*

*(f) Decisions as to the patenting and exploitation of any **Company invention** shall be at the sole discretion of the Company.*

*(g) You hereby irrevocably appoint the Company to be your attorney to sign any documents necessary for the purpose of giving to the Company the full benefit of a **Company invention**.*"

21 Given that these proceedings are unopposed, I accept, based on this evidence, that Mr Scullin was an employee of the claimant when he devised the inventive concept of the patent. I also accept that he devised the inventive concept in the course of his employment by the claimant. On the basis of Mr Scullin's employment agreement and of Ms Gallagher's evidence above in relation to Irish law concerning entitlement, I therefore conclude that the claimant is entitled to the patent through Mr Scullin's employment by the claimant. The claimant refers specifically to paragraph 6 of Mr Scullin's witness statement to support their submission that Mr Scullin was aware at the time of grant that the invention in the patent belonged to the claimant. On this basis I accept that Mr Scullin was aware at the time of grant of the patent that rights to the invention belonged to the claimant.

Employment of Mr O'Sullivan

22 The claimant's submissions in relation to Mr O'Sullivan's employment are supported by the witness statement of Mike Hopkins. In his witness statement Mr Hopkins explained that, due to the passage of time, the claimant no longer holds a signed copy of Mr O'Sullivan's contract of employment. He did however exhibit an unsigned copy with his witness statement. This contract states that Mr O'Sullivan commenced employment on 1 March 2007 in a full-time capacity. Mr Hopkins referred to clause 14 of this contract in support of his understanding that all inventions made by employees of the claimant are automatically owned by the claimant. This is identical to clause 14 of Mr Scullin's contract, reproduced above.

23 Mr Hopkins also stated that, during Mr O'Sullivan's employment with the claimant, Mr O'Sullivan solely held the function of General Manager, his daily tasks including managing a small group of staff involved in product development, early sales and support, and supporting Mr Hopkins in sales, finance and operations. As part of the managerial team, Mr Hopkins' evidence is that Mr O'Sullivan was expected to further the interests of the business and was specifically tasked with the development of the subject matter protected by the patent.

24 David Brophy's evidence also relates to Mr O'Sullivan, specifically to an affidavit of Mr O'Sullivan dated 26 March 2014 which was filed in relation to unrelated proceedings in the High Court. Mr Brophy provided a copy of this affidavit with his witness statement and highlighted paragraph 19, which states:

"19. Mr Hopkins describes himself as the named inventor on a number of patents which comprise the core intellectual property of the business of the company. He chooses not to tell this Court that I your Petitioner and other employees of the company are recognised as inventors on a number of the primary patents exploited

by the company. For what I would take to be the four main Company patents, the I/V Sensor, Wireless Sensor, Analyzing RF Signals from a Plasma System and Mass Measurement patents, a mixture of Paul Scullin, your Deponent, the First Named Respondent, David Gahan are listed as the inventors. All the Impedans Limited patents were developed by Impedans Limited and are the property of Impedans, any contribution made by Mr Hopkins to the development of the patents was done in his capacity as an officer of Impedans Limited and this was the representation he made to Enterprise Ireland."

25 Mr Brophy's evidence is that one of the patents referred to in this paragraph of the affidavit was filed with Paul Scullin and Donal O'Sullivan as applicant under application number EP1075609.0. This is the patent application which resulted in the patent which is the subject of these proceedings.

26 Mr Brophy also provided a list of four patents which, according to his evidence, he had been directly involved in drafting and filing following receiving instructions from either Donal O'Sullivan or Mike Hopkins of Impedans. He also confirmed that Impedans solely paid all his professional fees, patent filing taxes and disbursements.

27 The claimant's submission is that Mr Brophy's evidence, together with the comment in Mr O'Sullivan's affidavit that "*All the Impedans Limited patents were developed by Impedans Limited and are the property of Impedans*", demonstrates that Mr O'Sullivan knew at the time of grant that he was not entitled to the patent.

28 As these proceedings are unopposed, and taking into account the evidence of Mr Hopkins and Mr Brophy, and also Mr Scullin's evidence in paragraph 5 of his witness statement, set out above, I accept the claimant's submissions that Mr O'Sullivan was an employee of the claimant at the time he devised the invention. Although the copy of Mr O'Sullivan's contract of employment provided by Mr Hopkins is unsigned, I note that his employment status is corroborated by Mr Scullin's evidence, and, given that these proceedings are unopposed, I accept that this unsigned copy of the contract accurately reflects the terms of Mr O'Sullivan's employment by the claimant. I also accept that, in accordance with Mr O'Sullivan's contract of employment and his normal and specifically assigned employment duties, he devised the invention in the course of his employment. On the basis of Mr O'Sullivan's employment agreement and my analysis of Ms Gallagher's evidence above in relation to Irish law concerning entitlement, I therefore conclude that the claimant is entitled to the patent through Mr O'Sullivan's employment by the claimant. Furthermore, I also accept that Mr O'Sullivan was aware at the time of grant that the claimant was entitled to the patent.

29 I have concluded that Mr Scullin and Mr O'Sullivan were both employees of the claimant at the time they devised the inventive concept, that they devised the inventive concept in the course of their employment, and that the claimant has established entitlement through the rights of each inventor. I therefore conclude that the claimant is solely entitled to the patent.

Timing of the reference

30 This is not however the end of the matter. Before I can make an order under section 37, I need to consider section 37(5), which states that no order shall be made under section 37 transferring the patent on the ground that the patent was granted to a person not so entitled if the reference under section 37 was made after the second

anniversary of the date of grant of the patent. However, such an order can be made if it is shown that the registered proprietor(s) knew at the time of grant that they were not entitled to the patent. The date of grant of the patent in these proceedings is 17 October 2018, and the reference under section 37 was made on 3 September 2025.

31 It is in view of the requirements of section 37(5) that the claimant has submitted that both Mr Scullin and Mr O'Sullivan knew at the time of grant that they were not entitled to the patent. I have accepted the claimant's submissions on this point. I therefore conclude that section 37(5) does not prevent me from making an order transferring the patent from Mr Scullin and Mr O'Sullivan to the claimant.

Conclusion and Order

32 Based on the documentary evidence submitted by the claimant, I have found that the claimant is solely entitled to the patent. I have also found that section 37(5) does not prevent me from making an order under section 37 transferring the patent to the claimant.

33 I therefore order that the registered proprietor of European patent EP2481074 B1 be recorded as being Impedans Limited.

Costs

34 Since these proceedings are being treated as unopposed, I make no order as to costs.

Appeal

35 Any appeal must be lodged within 28 days after the date of this decision.

B MICKLEWRIGHT
Deputy Director, acting for the Comptroller