Intellectual Property Office

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PATENTS ACT 1977

Parvaiz Akhtar Claimant

PROCEEDINGS

Reference under Section 8 of the Patents Act 1977 in respect of UK patent application GB9723190.6

HEARING OFFICER B Micklewright

DECISION

Introduction

1 This decision relates to a reference under section 8 of the Patents Act 1977 concerning entitlement to UK patent application GB9723190.6 ("the patent application"). The patent application was filed in the name of TDK Grey Cell Limited on 3 November 1997, with Nick Hunn and Robert James Bell named as inventors. The Office was notified of a change of applicant name to TDK Systems Europe Limited on 9 April 1999. The patent application was published as GB2330926A on 5 May 1999 but never proceeded to grant. The Patent Register states that the patent application was terminated and indicates a "Not in force" date of 4 May 2002.

2 The reference was filed by Mr Parvaiz Akhtar on 19 February 2025. Mr Akhtar's case is that he originally developed the invention in the patent application and disclosed it to the defendant under strict confidentiality agreements. Although the statement of grounds is not entirely clear, it seems that Mr Akhtar seeks a declaration that he is sole inventor of the invention in the patent application and is entitled to the patent application (notwithstanding, as noted above, that it was terminated in 2002).

3 I note that the statement of grounds also refers to the allowability of the patent application, and of any possible amendments. Submissions in the statement of grounds relating to novelty and inventive step are not however sufficiently fleshed out for me to be able to consider them in the context of the section 8 reference. As noted above, the patent application was terminated before grant, and thus issues relating to the allowability of the patent application need no further consideration.

4 According to Mr Akhtar's own submission, and to Companies House records, TDK Systems Europe Limited was dissolved on 5 February 2011. The IPO Tribunal served the proceedings on possible successors in title, and also on the inventors, but no counter-statement was filed. The reference is therefore treated as unopposed. In accordance with rule 77(9) of the Patents Rules 2007, I will therefore treat the applicant of the patent application (such as they or a successor in title may exist at all) as supporting the claimant's case.

The law

5 Section 8 concerns determinations before grant about entitlement to patents. Section 8(1) states:

> (1) At any time before a patent has been granted for an invention (whether or not an application has been made for it)—
>
> > (a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or
> >
> > (b) any of two or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;
>
> and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.

6 Despite the termination of the patent application, Mr Akhtar requested that these proceedings continue. It is still possible for me to make a determination under section 8 as to whether the claimant would have been entitled to the patent application even when the patent application has been terminated, and I will consider the section 8 reference in this decision.

Summary of facts and submissions

7 The claimant has provided a statement of grounds, which was subsequently revised, and has exhibited the following documents with the statement of grounds[1]:

> Exhibit 1: the published patent application GB2330926A.
>
> Exhibit 3: "*Feasibility study of using DSP Processor in the new PC based Faxcast receiver*", Parvaiz Akhtar, Design Engineer, FSS Chesterfield, 4 October 1995.
>
> Exhibit 4: "*Data Services on the Samsung GSM Handset*", P. Akhtar, Software Engineer, SERI, 18 April 1996.
>
> Exhibit 5: "*Agreement between Samsung Electronics Research Institute and Grey Cell Systems Limited*", made on 29 August 1996, signed on behalf of

[1] No document titled "Exhibit 2" was included or referred to in the statement of grounds, the numbering skips from "Exhibit 1" to "Exhibit 3".

Grey Cell Ltd by K. G. Marsden, Managing Director, but no signature present on behalf of Samsung Electronics.

Exhibit 6: Appears to be LinkedIn (r.t.m.) profile for Nick Hunn, stating his roles in various organisations between 1990 and 2010.

Exhibit 7: An extract from the Companies House database relating to TDK Systems Europe Limited.

Exhibit 8: Pages from a Technical Specification, most pages dated 28 August 1996, alleged to be written and issued by Mr Akhtar to TDK Grey Cell Systems Ltd.

Exhibit 9: Appears to be a TDK Systems Europe Ltd press release entitled "*TDK Ships "Soft" Modem for Palm™ Connected Organizer Users*", dated 21 May 1999.

8 I note that Mr Akhtar has not provided a witness statement. He has however provided a statement of truth with his statement of grounds.

9 Mr Akhtar asserts that the invention in the patent application is derived from his pre-existing software, technical designs and confidential information. In his statement of grounds he states:

> *"The technical features disclosed in the 1997 application directly correspond to the invention conceived, developed, and fully documented by Mr Akhtar between 1995-1996, including:*
>
> - *Transparent Data Services for transferring text, drawings, and computer files*
> - *Communication protocols performed external to the GSM handset*
> - *Implementation via PCMCIA card or computer software without additional hardware*
> - *The use of a serial (RS232) link between handset and computer*
> - *Software-based modem functionality replacing conventional hardware modems.*
>
> *These features were originally provided to Grey Cell Systems Ltd under strict NDA and confidentiality obligations, and not as a public disclosure or license."*

10 Mr Akhtar claims that he had an idea he refers to as a "Soft Modem PCMCIA idea" in October 1995 and then developed a feasibility study and design concept which he identifies as the document of Exhibit 3. He states that he worked with Samsung Electronics Research Institute and then interviewed and presented the Soft Modem idea to four specialist contractors, for development and production, referring to Exhibit 4 as relevant to these presentations. According to Mr Akhtar's pleadings, these presentations took place between May and July 1996. Mr Akhtar states that a company called Grey Cell Systems Ltd, one of the contractors who received the presentation, was awarded the contract on 29 August 1996. According to Mr Akhtar an Agreement, reproduced in Exhibit 5, was signed by KG Marsden, who, according to the Agreement, was the managing Director of Grey Cell Ltd at the time. Mr Akhtar

submits that strict non-disclosure conditions were imposed. The version of the Agreement reproduced in Exhibit 5 includes the signature of Mr Marsden but no signature is present for Samsung Electronic Research Institute.

11 According to Mr Akhtar, TDK Systems Europe Limited merged with Grey Cell Systems Ltd on 9 September 1997 and was known as TDK Grey Cell Ltd for a period. Mr Akhtar provided, in Exhibit 6, a LinkedIn profile for Mr Nick Hunn as evidence that he was the Managing Director of TDK Systems Europe Limited at the time. He also provided, in Exhibit 7, a printout of Companies House records which indicates that the company was previously known as TDK Grey Cell Limited, the name in which the patent application was filed on 3 November 1997.

12 Mr Akhtar states that he issued a detailed technical specification, written by himself, to Grey Cell Systems Ltd on 9 September 1997. At least some pages of this specification are reproduced in Exhibit 8 and are dated 28 August 1996.

13 Mr Akhtar asserts that TDK Grey Cell sold and shipped soft modems in 1999 with software which is "*one and the same as Mr Parvaiz Akhtar invention*". He reproduced in Exhibit 9 what appears to be a TDK press release dated 21 May 1999 in support of his assertion that TDK Grey Cell sold and shipped such devices.

14 Mr Akhtar states that TDK Systems Europe Limited became insolvent on 5 February 2011, reproducing a Companies House record in Exhibit 7 in support of this.

15 In his statement of grounds Mr Akhtar provided a table of similarities in functionality, similarities in implementation approach, and shared strategic considerations between something he calls the "TDK Global Pulse soft modem" and the "Parvaiz Akhtar invention". He summarises his submissions on the similarities of the two systems as follows:

> *"1. Both systems eliminate bulky external modems by implementing software-based GSM modem solutions - one for Palm organisers and the other for Samsung GSM handsets.*
>
> *2. Both rely on serial connections (RS232) to link mobile devices to computers, reducing the need for additional hardware.*
>
> *3. Both solutions prioritize mobile professionals needing lightweight, portable connectivity solutions.*
>
> *4. Each company explores alternative solutions: TDK through software-only modem implementation and Parvaiz Akhtar invention through a PCMCIA card option.*
>
> *5. Both projects involve partnerships with other tech companies to enhance software development and integration."*

16 Mr Akhtar submits that his comparative analysis highlights the technical convergence between TDK Global Pulse and the Parvaiz Akhtar invention, emphasising their mutual focus on simplifying mobile data connectivity.

17 Mr Akhtar submits, in view of the evidence presented in his statement of grounds, that he is the true inventor of the soft modem, and the patent application is derived from his pre-existing invention, developed in collaboration with Samsung Electronics

Research Institute. He submits that the evidence highlights that he formulated the original concept and designs and developed and implemented the technology. He therefore requests that he be recognised as the true inventor of the soft modem technology and seeks a finding of entitlement to the patent application.

Assessment

18 I note that, in referring to a collaboration with Samsung Electronics Research Institute, Mr Akhtar does not suggest that anyone else contributed to the invention. Rather he argues that he is the sole inventor, and explicitly states in his statement of grounds that Samsung did not contribute to the inventive concept.

19 It is not always entirely clear whether Mr Akhtar is arguing that, as the true inventor, he is solely entitled to the invention, although he does explicitly claim that the defendant is not entitled. In this context, and given that these proceedings have been brought under section 8, I consider that it is Mr Akhtar's case that he was solely entitled to the patent application by virtue of being the sole inventor.

20 Mr Akhtar has not clearly set out in his statement of grounds what he considers to be the inventive concept of the patent application, and his comparison of similarities is between what he calls his invention and a product called TDK Global Pulse. Nevertheless, whilst I have no clear identification of the inventive concept before me, I note that claim 1 of the patent application states:

> *"An active cable for connecting a computer and an electrical device, the active cable being adapted to identify itself to the computer when connected to the computer."*

21 Whilst, for the purposes of section 8, the inventive concept is not necessarily determined by the claims, I note that claim 1 is drafted broadly. I have read the patent application including the other claims and consider that, at least in general terms, claim 1 of the patent application does broadly reflect the inventive concept in question. This will be sufficient for the purposes of this decision.

22 I note that these proceedings are unopposed. I accordingly accept that Mr Akhtar's account of events, summarised above and supported by the accompanying documentary evidence is, on the balance of probabilities, more likely than not to be correct.

23 Moreover, I consider the inventive concept in the patent application to be somewhat related to the "soft modem" concept discussed by Mr Akhtar and described in the documentary evidence. Given that these proceedings are unopposed, I accept, based on Mr Akhtar's account of events and the accompanying documentary evidence, that, on the balance of probabilities, Mr Akhtar devised the inventive concept in the patent application.

24 It is not entirely clear in the statement of grounds whether it follows that Mr Akhtar was entitled to the patent application. His employment status is not made clear. I note however that he states that he worked with Samsung Electronics Research Institute, rather than being an employee. In particular, Mr Akhtar states that Samsung Electronics Research Institute acted as a technical evaluation partner assisting with demonstrations and contractor engagement. Moreover, there is no

suggestion in the evidence or submissions before me that Mr Akhtar was ever an employee of TDK Grey Cell Systems Limited or its successors in title.

25 Furthermore, whilst the Agreement between Samsung Electronics Research Limited and TDK Grey Cell Systems Limited does state that intellectual property rights in software developed under the Agreement would be the property of TDK Grey Cell Systems Limited, my understanding (in the absence of any further submissions that could assist me) is that this relates to work done by TDK Grey Cell Systems Limited under the Agreement. Mr Akhtar's case is that he devised the invention before this Agreement was made and provided the invention to TDK Grey Cell Systems Limited under the Agreement. I do not therefore consider this contract to be determinative in entitlement to the patent application.

26 Given that these proceedings are unopposed, I consider that, on the balance of probabilities and based on the evidence before me, Mr Akhtar was not employed by Samsung Electronics Research Institute when he devised the inventive concept, and the invention was not devised under the Agreement between Samsung Electronics Research Institute and TDK Grey Cell Systems Limited. I therefore conclude that it is more likely than not that Mr Akhtar was entitled to the patent application.

Conclusion and Determination

27 Based on the evidence provided by Mr Akhtar, and taking into account that the reference is being treated as unopposed, I am satisfied that Mr Akhtar devised the invention in the patent application, without contribution from any other parties.

28 Further there is nothing before me to suggest that anyone else has a right to the invention.

29 I hereby declare that Mr Parvaiz Akhtar is solely entitled to the invention of patent application GB9723190.6.

Costs

30 Mr Akhtar has asked for his costs in these proceedings. However, since they are being treated as unopposed, and there is no other party from whom costs can be recovered, I make no order as to costs.

Appeal

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

B MICKLEWRIGHT
Deputy Director, acting for the Comptroller