



PATENTS ACT 1977

BETWEEN

Touch Biometrix Limited

Claimant

and

Michael A. Cowin

Defendant

PROCEEDINGS

Reference under section 12 of the Patents Act 1977 in respect of certain international applications and related applications¹ made under the law of countries other than the United Kingdom

HEARING OFFICER

B Micklewright

DECISION

Introduction

- 1 This decision relates to a reference under section 12 of the Patents Act 1977 concerning entitlement to eleven international patent applications and one Taiwanese patent application, listed in the Annex to this decision, and to any further patent rights derived from these applications. The applications were filed between 9 March 2020 and 14 November 2021, with earliest priority dates between 7 March 2019 and 12 November 2021. All the listed applications name Touch Biometrix Limited as applicant. Michael Cowin is named in each application as one of the inventors.
- 2 The claimant stated in their statement of grounds that “*Each of the Applications described and claims certain inventions (“the inventions”)*”. They request that the comptroller makes determinations pursuant to section 12(1) that Touch Biometrix Limited:

“(i) owns and has at all times owned the inventions, and is and has at all times been alone entitled to be granted a patent for the inventions in any jurisdictions, including the United States of America, whether such patent arises from the Applications listed in the Annex at the foot of this letter [listed in the Annex to this decision] or otherwise; and

¹ The patent applications are listed in the Annex to this decision.

(ii) has or would have all right and interest in any such patent or application for any such patent in the United States.”

- 3 The claimant also requested that I order assignment of the applications listed in the Annex, and the inventions in those applications, from Mr Cowin to the claimant, or give any such order as I think fit.
- 4 The claimant stated that the reason for making this reference to the comptroller is because Mr Cowin has not completed formal assignments required by the United States Patent and Trademark Office (USPTO). However, the claimant informed the tribunal on 22 January 2025 that these signed documents have now been received from Mr Cowin. Despite this, the claimant requested that these proceedings continue.
- 5 Mr Cowin did not file 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 applicant as supporting the claimant’s case.

Summary of facts and submissions

- 6 The claimant included in their statement of grounds information which they described as an extract from Companies House records in relation to Mr Cowin’s involvement at Touch Biometrix Limited. This extract states that Dr Michael Anthony Cowin, was appointed as Director on 18 October 2017, and resigned as Director on 21 December 2023. Whilst the extract itself does not name the company to which the extract relates, two documents were included with the extract. The first document is a Certificate of Incorporation which certifies that Touch Biometrix Limited was incorporated on 18 October 2017 with Dr Michael Anthony Cowin as Director. The second document is a completed Companies House form TM01, entitled “Termination of a Director Appointment”, in which it is recorded that Dr Michael Anthony Cowin’s appointment as Director of Touch Biometrix Limited is terminated as of 21 December 2023.
- 7 The claimant also claimed to have access to PAYE payroll evidence in relation to Mr Cowin’s employment at Touch Biometrix Limited, although this evidence was not included with the statement of grounds.
- 8 The claimant submitted that consequently, in accordance with section 39(1)(b) of the Patents Act 1977, any inventions and patent applications for which Mr Cowin was an inventor during the period in which he was the CEO of Touch Biometrix Limited must belong to the company. In support of this submission the claimant stated that the earliest priority dates and filing dates of the patent applications listed in the Annex fell within the period during which Mr Cowin was CEO of Touch Biometrix Limited. They also submitted that, at the time the inventions within the patent applications were made, Mr Cowin was employed as the CEO of Touch Biometrix Limited.
- 9 The claimant also submitted that, because of the nature of the company as a small concern engaged entirely in the development of new technology, the course of Mr Cowin’s normal duties included the making of inventions and duties from which an invention could reasonably be expected to result. They argued that, as a result, the inventions are owned by the claimant pursuant to section 39(1)(a).

Assessment

- 10 Whilst the claimant did make reference to the inventions being made when Mr Cowin was CEO of Touch Biometrix Limited, their submissions focussed on arguments that the applications were filed whilst Mr Cowin was CEO. It is possible that Mr Cowin devised the inventions before he became Director of Touch Biometrix Limited, even if the applications were filed after he became Director. However, I note that the reference is unopposed, and I am treating Mr Cowin as supporting the claimant's case. I therefore conclude that it is more likely that Mr Cowin devised the inventions during the period he was a Director of Touch Biometrix Limited.
- 11 Based on the evidence provided by the claimant and taking into account that the reference is being treated as unopposed, I am satisfied that the claimant, Touch Biometrix Limited, is entitled to the patent applications listed in the Annex, and to any other patent applications which may be filed for the inventions in those applications.

Conclusion and determination

- 12 In *Cannings' United States Application*² an employee-inventor had refused to execute an assignment of his rights in a US application, which had entered the national phase by the PCT route. In that case it was established that, where the comptroller has determined the question of ownership of an invention which is the subject of a US application, it was within the comptroller's broad powers under section 12(1) to order the employee to execute an assignment if that was necessary to give effect to the determination of entitlement and if such an assignment was required for the employer to enjoy the fully benefit of any patent of the US application. In the present case the claimant has however confirmed that they have now received the signed formal assignments from Mr Cowin. There is therefore no need for me to make such an order in these proceedings, and a declaration of ownership will suffice.
- 13 I hereby declare that Touch Biometrix is solely entitled to the inventions of the patent applications listed in the Annex to this decision, and to any other patent applications relating to those inventions.

Costs

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

Appeal

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

Dr B MICKLEWRIGHT

Deputy Director, acting for the Comptroller

² *Cannings' United States Application* [1992] RPC 459

Annex – List of patent applications referred to by the claimant in their statement of grounds

Application Number	Publication Number	Earliest Priority Date	Filing Date
PCT/GB2020/050560	WO2020/178605	07 March 2019	09 March 2020
109106782	TW2021/01188	07 March 2019	02 March 2020
PCT/GB2020/051369	WO2020/245602	05 June 2019	05 June 2020
PCT/GB2020/051371	WO2020/245604	05 June 2019	05 June 2020
PCT/GB2020/051374	WO2020/245607	05 June 2019	05 June 2020
PCT/GB2020/051373	WO2020/245606	05 June 2019	05 June 2020
PCT/GB2020/051773	WO2021/014162	23 July 2019	23 July 2020
PCT/GB2021/052298	WO2022/049398	07 September 2020	07 September 2021
PCT/GB2021/052299	WO2022/049399	07 September 2020	07 September 2021
PCT/GB2021/052300	WO2022/049400	07 September 2020	07 September 2021
PCT/GB2021/052352	WO2022/053822	10 September 2020	10 September 2021
PCT/GB2022/052885	WO2023/084245	12 November 2021	14 November 2022