



*(b) that person fails to file a counter-statement under paragraph (6) or (8), the comptroller shall treat him as supporting the claimant's case.*

- 4 On 6<sup>th</sup> March 2017, the Office wrote to Yuyao Yuchang Electrical advising them that in the absence of a counter-statement they were not considered a party to these proceedings.

### **Summary of facts and submissions**

- 5 Since the reference is unopposed, I must accept the facts of the case to be those described in the Statement of Case and the supporting documentation. These facts can be summarised as follows.
- 6 The invention of a 360 degree rotational mechanism in a base of an inspection lamp or torch was initially devised by Mr L'Anson who created the original drawings on the 14<sup>th</sup> October 2011. Before April 2012 Mr Thompson was shown the drawings and his input led to the idea of extending and closing the torch from the base. Both Mr Thompson and Mr L'Anson were employed by Jack Sealy Limited and their duties as employees were such as to fall within Section 39(1) of the Act<sup>1</sup>.
- 7 On 10<sup>th</sup> April 2012 Mr L'Anson visited Mr Yong (also known as 'Honk') of Yuyao Yuchang Electrical to discuss the invention. It was agreed that Mr Yong would help develop and produce the invention devised by Mr L'Anson and Mr Thompson. There followed several exchanges between Mr Yong and Mr L'Anson wherein the design of the inspection lamp was altered and improved.
- 8 On the 18<sup>th</sup> May 2012 GB patent application 1208798.7 was filed in the name of Jack Sealy Limited naming Mr Thompson, Mr L'Anson, and Mr Yong as inventors. The application related to an inspection lamp having a 360 degree rotational mechanism in the base wherein the lamp portion was extendable from the base.
- 9 On the 24<sup>th</sup> September 2012 Yuyao Yuchang Electrical filed Chinese patent application CN201210355995.4 naming Mr Yong as sole inventor. On the 8<sup>th</sup> October 2012 Yuyao Yuchang Electrical filed international patent application PCT/CN2012/001348 claiming priority from the Chinese patent application and again naming Mr Yong as sole inventor. The applications that are the subject of this reference represent regional/national phases of the international application. The applications filed by Yuyao Yuchang Electrical relate to an inspection lamp having a 360 degree rotational mechanism in the base wherein the lamp portion is extendable from the base. The extendable/rotational mechanism is a modification of the mechanism disclosed in GB patent application 1208798.7. A number of the drawings

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<sup>1</sup> 39(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.*

of the applications filed by Yuyao Yuchang Electrical are the same as drawings sent from Mr Yong to Mr L'Anson during correspondence.

- 10 On the 24<sup>th</sup> January 2013, an assignment document (exhibit H) sent by Jack Sealy Limited, was received by Mr Yong. He replied via email (exhibit G) on 22<sup>nd</sup> February 2013 confirming that the assignment document had been signed and sent back to Mr L'Anson. The assignment document assigns rights relating to improvements to the "invention contained in the claims" of GB1208798.7 from Yuyao Yuchang Electrical and Mr Yong to Jack Sealy Limited. In particular, item 1(a) of the assignment document specifies the assignment of 'improvements and the full benefits and exclusive benefit of them, including all intellectual property contained in them and relating to them'.
- 11 Since the reference was filed a deed of assignment has been filed at the European patent office dated the 16<sup>th</sup> January 2017. The deed assigns rights to European patent application number 12881144.5 from Yuyao Yuchang Electrical and Mr Yong to Jack Sealy Limited.

### **The law**

- 12 These proceedings have been brought under section 12 of the Act, the relevant parts of which read:

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

- 13 Sections 12(3)<sup>2</sup> and 82<sup>3</sup> of the Act set out the circumstances in which the comptroller has jurisdiction to determine questions concerning entitlement to European patent applications under section 12(1).

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<sup>2</sup> 12(3) Subsection (1) above, in its application to a European patent and an application for any such patent, shall have effect subject to section 82 below.

<sup>3</sup> 82(4) The court and the comptroller shall have jurisdiction to determine any question to which this section applies, other than an employer-employee question, if either of the following conditions is satisfied, that is to say-

(a)...

(b) the other party claims that the patent should be granted to him and he has his residence or principal place of business in the United Kingdom and the applicant does not have his residence or principal place of business in any of the relevant contracting states;

- 14 There is no question that the comptroller has jurisdiction to determine the question of entitlement to the applications and to make such orders as he deems necessary to give effect to his determination.

### **Conclusion**

- 15 I am satisfied on the basis of the uncontested evidence before me that Mr L'Anson, Mr Thompson and Mr Yong are joint inventors of the invention set out in the applications. I am also satisfied that Jack Sealy Limited is entitled to the contributions of Mr L'Anson and Mr Thompson to the invention by virtue of their employment by that company. It is clear that the invention to which the applications in issue here relate represents an improvement of the original invention devised by Mr L'Anson and Mr Thompson so as to fall within the assignment agreement between Mr Yong, Yuyao Yuchang Electrical and Jack Sealy Limited signed by the parties in January/February of 2013. I am therefore also satisfied that the rights to the contribution made by Mr Yong and Yuyao Yuchang Electrical to the invention were transferred to Jack Sealy Limited by virtue of that assignment document.

### **Declaration & Order**

- 16 I hereby declare that Jack Sealy Limited is solely entitled to the grant of both European patent application number 12881144.5 and United States patent application number 14/126,213.
- 17 I also declare that Jack Sealy Limited, not Yuyao Yuchang Electrical Appliances Co. Ltd., is entitled to any and all rights in or under i) European patent application number 12881144.5 and ii) United States patent application number 14/126,213.
- 18 I further order that:
- Jack Sealy Limited, not Yuyao Yuchang Electrical Appliances Co. Ltd., should be named as applicant in both European patent application number 12881144.5 and United States patent application number 14/126,213.
- 19 I also note that Mr L'Anson and Mr Thompson should be named as co-inventors, in addition to Mr Yong, in both European patent application number 12881144.5 and United States patent application number 14/126,213. However since this is a reference only under section 12 I am not able to make an order to give effect to this. However I would note that Jack Sealy Limited as the applicant will be able to file the necessary documentation at the European Patent Office and United States Patent and Trademark Office to include their employees Mr L'Anson and Mr Thompson as named inventors.

### **Costs**

- 20 The Claimant has requested their costs in the matter however since this action is unopposed it is not appropriate to make any cost order.

### **Appeal**

- 21 Any appeal must be lodged within 28 days.

**Phil Thorpe**  
Deputy Director, acting for the Comptroller