



PATENTS ACT 1977

BETWEEN

Mr Alan James Hughes

Claimant

and

Mr Barry Andrew Davis

Defendant

PROCEEDINGS

Reference under section 12(1)(b) and 12(4) in respect of
European Patent Application EP16182040.2

HEARING OFFICER

Phil Thorpe

DECISION

Introduction

1. This decision relates to a reference under section 12 of the Patents Act 1977 concerning entitlement to European Patent Application EP16182040.2. The patent, which is entitled “A staple Remover”, was filed on 29th July 2016 and published as EP3276106 A1 on 31st January 2018. The patent application names Mr Alan James Hughes and Mr Barry Andrew Davis as co-applicants with Mr Hughes named as the sole inventor.
2. The reference under section 12 was filed on 29th October 2019 by Mr Hughes. In his statement of case Mr Hughes claims that the inclusion of Mr Davis as a co-applicant on the patent application was a mistake as Mr Davis was not an inventor of the invention which is the subject of the application. Furthermore, an agreement between Mr Hughes and Mr Davis by which Mr Davis would contribute towards the cost of the patent application in return for Mr Davis being named as co-applicant, was breached by Mr Davis when he failed to contribute any of the costs associated with the application.
3. The statement was served on Mr Davis on 18th November 2019. A deadline of 3rd January 2020 was set for Mr Davis to file a counterstatement. There was some confusion on the part of Mr Davis as to this deadline which in part prompted him to request an extension to the period for filing the counterstatement. The extended deadline was the 3rd February 2020. Since no

counterstatement had been filed by that date, the Office wrote to both sides informing them that subject to any comments from either side by 6th March 2020, the Office intended to treat the case as unopposed.

4. In the absence of any comments, the parties were informed on 20th March 2020 that an uncontested decision on the papers would be issued. The office did receive an email from a Ms Tracy Davis stating that “we have neither the means nor the inclination to deal with this at this time”. The email, which was dated 22nd March 2020, went on to note that the fence staple puller “was the brainchild of Barry Andrew Davis”. This however did not constitute a counterstatement and indeed I have taken it as acknowledgement that Mr Davis did not wish to oppose this reference.
5. Therefore, in accordance with rule 77(9) of the Patents Rules 2007, which reads:

Where- (a) a person was notified under paragraph (1) or (2); and (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.

I must treat Mr Davis as supporting Mr Hughes' case.

The law

6. 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.

...

(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 (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.

(4) Section 10 above, except so much of it as enables the comptroller to regulate the manner in which an application is to proceed, shall apply to disputes between joint applicants for any such patent as is mentioned in subsection (1) above as it applies to joint applicants for a patent under this Act.

7. Sections 12(3) and 82 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). To the extent relevant here section 84 reads:

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) the applicant has his residence or principal place of business in the United Kingdom; or

(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;

8. The claimant, who is the co-applicant with Mr Davis, is a person whose stated address on the patent application is in the United Kingdom so I am satisfied that the comptroller has jurisdiction to determine the question of entitlement to the application and to make such orders as he deems necessary to give effect to his determination.

9. The right to apply for and obtain a patent is governed by section 7 which reads:

7(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.

and section 39:

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 purpose of this Act and all other purposes

(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.

Mr Hughes' case

10. Since the reference is uncontested, I must accept the facts of the case to be those described in the Statement of Case and the supporting documentation submitted by the claimant. These facts can be summarised as follows. Mr Davis is the inventor and proprietor of two New Zealand patents, NZ618929B and NZ618850B, relating to a fence staple and staple remover used in two products "Stapl-it" and "Strip-it". Mr Hughes saw the "Strip-it" at an exhibition in New Zealand. He discussed producing and selling it in the United Kingdom which Mr Davis agreed to even though he had no rights relating to the product in the United Kingdom.

11. Mr Hughes has since spent considerable effort improving the “Strip-it” product and these improvements form the basis of the patent in issue here and on which Mr Hughes is named as the sole inventor.
12. Mr Hughes admits discussing an arrangement with Mr Davis whereby Mr Davis would pay a fee to Mr Hughes for each product covered by the NZ patents that were sold in the UK, and also contribute towards the costs associated with the European patent application. In return Mr Hughes agreed to allow Mr Davis to be named as joint applicant on the patent application.
13. According to Mr Hughes, Mr Davis has not contributed to any of costs of the patent application and was therefore in breach of the agreement. Mr Hughes further notes that Mr Davis was not an inventor of the invention which is the subject of the application.
14. Mr Hughes further notes that a corresponding US patent application, US15/664195, was filed on 27th July 2017 which initially named Mr Davis as a named inventor however that application has since been amended to name Mr Hughes as the sole inventor.
15. As noted Mr Hughes has provided several documents in support of his case. Since the case is unopposed I do not need to go into the detail of these supporting documents.

Finding and order

16. I find that Mr Hughes was the sole inventor of the invention in European Patent Application EP16182040.2. Further I find that if any agreement had existed between Mr Hughes and Mr Davis in respect of entitlement to the patent application, then that agreement was breached by Mr Davis failing to meet his obligations under the agreement.
17. I therefore order that European Patent Application EP16182040.2 should proceed solely in the name of Mr Alan James Hughes as applicant.

Costs

18. Since the proceedings are being treated as unopposed, I make no order as to costs.

Appeal

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

PHIL THORPE

Deputy Director Acting for the Comptroller