



## PATENTS ACT 1977

### BETWEEN

Biomimetics Health Industries Limited Claimant

Global Chemical Technologies Limited Applicant

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### PROCEEDINGS

Reference under section 8 of the Patents Act 1977 in respect of patent application number GB1318907.1

HEARING OFFICER Phil Thorpe

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### PRELIMINARY DECISION

- 1 This decision goes to the following points. In an entitlement dispute does the Comptroller have the power to delay, at the request of the party seeking entitlement, the publication of the patent application at issue pending determination of entitlement and if so should he exercise that power in this particular instance.
- 2 Biomimetics Health Industries Limited (Biomimetics) initiated entitlement proceedings under section 8 in respect of patent application GB1318907.1 (the application) on 9<sup>th</sup> January 2015. The application was filed by Global Chemical Technologies Limited (GCT) on 25<sup>th</sup> October 2013. In a letter of 4<sup>th</sup> December 2013 accompanying the search report the Office advised the applicant that preparations for publication of the application would be completed soon after 24<sup>th</sup> March 2015. This is the date at which the application would have entered the publication cycle with actual publication likely to have occurred 5 weeks later.
- 3 In its statement of case Biomimetics sought relief in the form of an order from the Comptroller withdrawing the application prior to publication or delaying its publication pending the outcome of the entitlement proceedings. More specifically it asked that:  
  
“the Comptroller confirms that the invention that is the subject of U.K Patent Application No. 1318907.1 was obtained in confidence from BHI-UK and that GCT (trading as B&V) breached that confidence in the filing of the Application

and therefore the Comptroller should order the delay of publication of the Application pending the outcome of these proceedings.”

Such an order was according to Biomimetics considered necessary to maintain the confidential nature of information in the application that was obtained by the applicant in breach of confidence.

- 4 The Office wrote to the claimant on 27<sup>th</sup> January 2015 seeking further information including the legal basis for its claim to the relief identified above. The letter referred to the guidance in this area currently provided in the Manual of Patent Practice (MoPP) which reads:

“8.05.1 In line with the preliminary decision in Brooks and Cope's Application (BL O/71/93), in general the preliminary examination, search, publication under s.16 and substantive examination of a patent application should not be deferred pending the determination of a reference under s.8.”

- 5 The letter also noted that similar guidance was provided in section 8.04 of the CIPA Guide. The letter also advised the claimant that if it was minded to continue to seek this relief then the applicant would be invited to make submissions.
- 6 The claimant responded on 9<sup>th</sup> February 2015 confirming it wished to maintain its request for the particular relief. It also made submissions on the legal basis underpinning the relief sought. The applicant was then, prior to the reference being formally served, invited to make observations on the issue of delaying publication. No observations were received.
- 7 The claimant is content for this issue to be decided on the basis of the submissions.

### **The Law**

- 8 The relevant part of the Patents Act is section 16 which governs publication of patent applications. This reads:

16.-(1) Subject to section 22 below and to any prescribed restrictions, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the comptroller shall, unless the application is withdrawn or refused before preparations for its publication have been completed by the Patent Office, publish it as filed (including not only the original claims but also any amendments of those claims and new claims subsisting immediately before the completion of those preparations) and he may, if so requested by the applicant, publish it as aforesaid during that period, and in either event shall advertise the fact and date of its publication in the journal.

(2) The comptroller may omit from the specification of a published application for a patent any matter –

(a) which in his opinion disparages any person in a way likely to damage him, or

(b) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

- 9 Rule 26 of the Patent Rules 2007 sets the period prescribed in section 16 to be 18 months after the date of filing or any declared priority date. The rule also makes

provision for ensuring that the published application does not include the details of any inventor who has waived their right to be mentioned.

- 10 Also relevant is section 8 which sets out the comptroller's powers in entitlement disputes determined before the grant of the patent. So far as is relevant this reads:

8.-(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.

(2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below -

(a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;

...

(c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred;

### **Arguments and analysis**

- 11 In its submission the claimant argues that there is no statutory bar to deferring publication under section 16. It refers for example to paragraph 16.32 of the Manual of Patent Practice (MoPP) which states that publication should be deferred if formalities have not been complied with. I would add that it is also the Office's practice to delay publication until a search report is available. The claimant also refers to the possibility under section 16(2) of suppressing from publication at least part of the content of the application.
- 12 I will respond to the latter point first. Section 16(2) concerns the content of the published application rather than timing. In addition it applies only in respect of certain circumstances which do not include the prevention of disclosure of potentially confidential material. Hence it does really not help the claimant here.
- 13 The broader point about whether section 16 allows any discretion to the Office to delay publication in circumstances such as this is less straightforward. The reference to "as soon as possible" in section 16 anticipates that there will be some circumstances where publication may not be possible at 18 months – this being as noted the period prescribed under section 16. The most obvious circumstance is the

one referred to in paragraph 16.32 of MoPP where the formal requirements relating to patent applications that are set out in the legislation have not been met. These requirements include for example how documents are presented and whether they are capable of reproduction. Whilst the time limits for complying with these formal requirements typically expire before the proposed publication date, it is possible, especially where the Office's preliminary examination which examines compliance with these requirements has been delayed, that formal issues are still outstanding at 18 months. In that case publication may not be possible at 18 months.

- 14 The practice of delaying publication pending completion of the search report stems from the desirability of publishing the application together with some form of assessment of the worth of the application. The desirability of this was highlighted in the Banks Report<sup>1</sup>, the findings of which were the basis for many of the provisions of the current Act, including the shift in section 16 to earlier publication at 18 months rather than at grant as was the case under the previous act.
- 15 Hence for the reasons above, the Office's practice is to deem "as soon as possible" to include when the formal legal requirements are met and when a search report is available. But could it be similarly argued that it is not "possible" to publish an application if it has been claimed or if it has been found that it contains information obtained in breach of confidence?
- 16 There is unsurprisingly not a great weight of relevant case law. The preliminary decision reached in *Brooks and Cope's Application* was that the substantive examination of a UK patent application should proceed even though entitlement proceedings were ongoing. The decision sets out the directions that the Hearing Officer gave at a preliminary hearing. There is nothing in the decision to indicate whether the decision to proceed with the examination was the subject of any argument from the parties or any detailed legal analysis by the hearing officer. I would also note that the application in issue there had already been published by the time of the decision. The matter under consideration there was whether to delay the further processing of the case including substantive examination and grant. The legislation is less specific on when those actions should occur though there is the overarching 4 ½ year period for an application to comply with the requirements. Neither substantive examination nor grant however is required by the Act to be completed "as soon as possible" unlike publication. Since *Brooks* was not concerned with publication I believe it offers no real assistance to me here.
- 17 The CIPA Guide also refers to the Opinion dated 30<sup>th</sup> November 2000 of the Scottish Court of Session in the case of *Quantum Glass Limited & Co v Dr Alexander Rollo Spowart*<sup>2</sup>. This case concerned international application PCT/GB99/03692. Quantum sought an order from the Scottish Court of Session that the application should proceed in the United Kingdom in its name (and another claimant) rather than the then named applicants which included Dr Spowart. Quantum also sought interim relief including to give Quantum control over the processing of the patent application and to prevent Dr Spowart from disclosing certain information beyond that disclosed in the application. Publication of the application was again not an issue – the

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<sup>1</sup> The British Patent System – Report of the Committee to Examine the Patent System and Patent Law July 1970 Cmnd 4407.

<sup>2</sup> <https://www.scotcourts.gov.uk/opinions/NIM2811.html>

application having already been published as WO 00/27645 some 5 months before the Opinion of the Court.

- 18 The Opinion pronounced interim interdict, ie it granted interim relief, as requested by Quantum pending determination of the substantive issue. The Order obtained by Quantum was brought to the attention of the European Patent Office (EPO)<sup>3</sup> who was processing the regional application derived from the international application. The EPO sought evidence from Quantum that it had instigated entitlement proceedings in respect of the application. The EPO noted that under rule 13 of the European Patent Convention proceedings for grant before the EPO would be stayed if such evidence was forthcoming. There is nothing on the file to indicate that the examination was in fact suspended. It is worth noting that rule 13 does not allow proceedings to be stayed before publication.
- 19 The legal basis on which the Court in *Quantum* felt able to grant this interim relief to the claimant is not entirely clear. There are references in the Opinion to sections 8 and 12 of the Patents Act but there is also reference to breach of confidence. It is also possible that the Court may have been relying on its more general powers.
- 20 It is clear that the Comptroller does have broad powers under section 8 and these powers would also be available to the Court if the Comptroller declined to deal with the case<sup>4</sup>. These powers extend to allowing at least for the removal of certain matter from an application prior to publication if it had been determined that the matter related to an invention not belonging to the applicant. Section 8 would also allow the control of the application to be transferred to someone other than the applicant. This would then allow the application to be withdrawn before publication. But I am not persuaded that the powers under section 8 extend to the sort of interim relief provided by the Court in *Quantum*. Indeed the remedies available under section 8, broad as they undoubtedly are, are in my opinion only available once the question of entitlement has been determined.
- 21 As I indicated it is possible that the Court in *Quantum* was relying on another cause of action ie breach of confidence or on its more general declaratory jurisdiction. If the Court was relying on its more general powers then it is reasonable to ask whether the Comptroller might have similar powers. I believe that the answer is no. Whilst the Comptroller has a range of powers to manage proceedings – see for example those set out in rule 82 – there is nothing that would allow him to grant the sort of interim relief that the Court felt able to grant in *Quantum*.
- 22 I would also add that an action under section 8 is not a breach of confidence action. The interaction between breach of confidence and entitlement was considered by Lord Walker in *Yeda*<sup>5</sup> where he noted:

“The misappropriation and misuse of confidential information which does not amount to an invention may give rise to claims for an injunction and damages or an account of profits, but cannot affect title to an invention. As already

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<sup>3</sup> See case file on EPO Patent Register

<sup>4</sup> There is no record of the Comptroller having declined to deal with the case of *Quantum Glass Limited v Dr Alexander Rollo Spowart*.

<sup>5</sup> *Yeda Research and Development Company Limited (Appellants) v. Rhone-Poulenc Rorer International Holdings Inc and others (Respondents)* [2007] UKHL 43

noted, in [University of Southampton's Application] the Court of Appeal rejected the notion (based on the Roman law doctrine of *confusio*) that confidential information which eventually led to the making of a patentable invention (but was not itself an invention) could affect entitlement to the invention. Where a patentable invention is imparted in confidence (for instance, as part of a process of peer review) it does not amount to publication since (in the hallowed words used by Bowen L.J. in *Humpherson v Syer* (1887) 4 R.P.C. 407, 413) the recipient of the information is not "free in law and equity to use it as he pleased." If the recipient were to abuse the confidence and apply for a patent himself, his application ought to fail, not because of breach of confidence as such, but for the simpler reason that he was not the inventor—he was a pirate."

- 23 It is possible that entitlement to the invention set out in the application in issue here may be found to belong to the claimant, not because the applicant has breached confidence but rather because the claimant is the inventor or is entitled through the inventor to the invention. How the applicant came to the invention may form part of the narrative but whether any information was communicated between the parties in confidence or not is not likely to impact on entitlement. It may have a bearing on validity though that is not in issue here.
- 24 So where does this leave the claimant? There is in my opinion no legal basis on which the comptroller can grant the interim relief that the claimant seeks in terms of delaying publication. That the relief sought is not available before the comptroller does not obviously prevent the claimant from pursuing before the courts a separate action for example for breach of confidence. Indeed if it is determined to prevent publication of the application then this is in my view probably the only real option it now has.
- 25 If the entitlement action had been brought sufficiently early in the application process, or indeed before the application had been filed, then conceivably it is possible that a determination as to entitlement could be reached prior to the application being published. The remedies available to the Comptroller under section 8 might then have been used to prevent publication of the application. But for this to have happened the action would have had to be brought early enough to allow determination before publication and also that a determination as to entitlement needed to have been possible without publication of the application.
- 26 In this case the entitlement action was not commenced until January 2015 which is only just over 4 months from the likely publication date of the application. Even if the claimant had not been required to file an amended statement of case, there was little prospect that a final determination could have been made before the application was due to be published.
- 27 It is also unclear whether the claimant is aware of the contents of GB1318907.1. The amended statement of case notes that
- "it had "discovered GCT had filed a patent application, the title of which is "Method and Apparatus for making stable acidic chlorinated solutions". This immediately rang alarm bells ... since it appears to relate to the process

developed by BHI ... It is the belief of BHI that GTC has filed for improvements to the manufacturing process”

- 28 This suggests that the claimant is unsighted as to the precise invention set out in the application. So even if the claimant had brought its case early enough, I suspect it would, without knowledge of the contents of the application, have struggled to succeed with an entitlement case founded at least in part on the question of inventorship<sup>6</sup>. I would add that section 118 prevents the Comptroller from disclosing any information about the application, other than certain bibliography information, without the consent of the applicant.
- 29 I should for completeness mention an argument advanced by the claimant in support of the Comptroller exercising discretion should such discretion to delay publication have been found to be available. The claimant notes that it may be severely disadvantaged if the information passes into the public domain whereas the defendant will not be adversely affected by a mere delay in publication pending determination of this reference. The lack of any response from the applicant on this point does suggest it is not overly concerned about a possible delay in the publication of its application. It is possible that it might prefer to have publication delayed even at the expense of not being able to benefit from the rights arising at publication for example infringement rights under section 69. However if I had had to consider whether discretion should be exercised then it would also have been necessary to consider the broader benefit to the general public that publication at or around 18 months would provide notably in reducing uncertainty. I would also have had to consider the likely length of any delay in publication. In the event I do not need to seek to weigh up these factors as there is no discretion to exercise.

### **Conclusions and findings**

- 30 I am not persuaded that the Comptroller has the power to order the delay in publication of patent application GB1318907.1 pending determination of who is entitled to that application. I therefore make no order in that respect.
- 31 GB1318907.1 will however not be entered into the 5 week publication cycle until after the period for appealing this decision has expired. This is because the vagaries of the publication cycle are such that it can be difficult to extract an application from the cycle. I would therefore expect, if there is no appeal against this decision, for the application to enter the publication cycle on or shortly after 21<sup>st</sup> May 2015 with publication of the application likely to occur 5 weeks after that date.

### **Appeal**

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

### **Phil Thorpe**

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<sup>6</sup> See for example BLO/201/11 where an entitlement claim founded on the question of inventorship made prior to publication was struck out