



PATENTS ACT 1977

PROCEEDINGS

Reference under Section 12(1)(a) concerning
entitlement to US 2019/0013591 A1

Drayson Technologies (Europe) Limited

Claimant

HEARING OFFICER

Stephen Probert

Decision off the paper

DECISION

Introduction

1. These proceedings are concerned with entitlement to a US patent application published as US2019/0013591A1 (“the patent application”). The patent application describes a microstrip patch antenna, and arose from a PCT application which in turn claimed priority from two earlier UK patent applications. The patent application was made by the claimant, Drayson Technologies (Europe) Ltd (“Drayson”).

Background

2. The patent application names three UK inventors — Soheyl Soodmand, Bruno Roberto Franciscatto and Manuel Pinuela Rangel. This decision concerns the question of entitlement as between the claimant (Drayson) and one of the inventors, Mr Bruno Franciscatto.
3. Mr Franciscatto was employed by Drayson as an RF Product Engineer ¹ from 1st October 2014 until 30th November 2017. So at the time the application was first filed, Mr Franciscatto was employed by Drayson, but he has since left the company.
4. Drayson has asked Mr Franciscatto to sign a formal assignment to recognise that, in accordance with section 39(1) of the Act, the patent application and the inventions

¹ RF stands for Radio Frequency.

described in it both belong to Drayson. This, they understand, is a formal requirement of US practice, because the USPTO will otherwise decline to decide questions of entitlement which they deem to relate to the ownership of property under foreign law. Drayson says that although they have asked Mr Franciscatto on a number of occasions, he has not yet completed such a formal assignment.

5. Mr Franciscatto, who is now believed to be living and working in France, was informed of these proceedings by official letter dated 23rd October 2019, and invited to file a counter-statement if he wished to oppose the proceedings. He did not file a counter-statement in response to this invitation; consequently the Office wrote to him again on 20th December 2019 advising him that as he had not filed a counter-statement, these proceedings will be treated as uncontested. He did not respond to that letter either.
6. The other two inventors were also informed of these proceedings, as they were considered likely to have an interest (rule 77(2)). Mr Rangel did not reply. Mr Soodmand responded briefly to let the Office know that we had misspelt his surname, and to observe that the documents sent to him were relevant to Mr Franciscatto and not to him. A further email was sent to Mr Soodmand giving more explanation about the process, and repeating the invitation to file a counter-statement if he wished to oppose the proceedings. No further correspondence was received from Mr Soodmand.

The Grounds

7. The claimant's grounds for seeking entitlement of the patent application are very simple. Mr Franciscatto was employed as an RF Product Engineer, and his main duties were defined in a contract of employment² as responsibility for:

“research and development of wireless energy technologies and products under development by the business and as directed from time to time. Your focus will be mainly on the design of radio frequency energy harvesting systems and system blocks as well as electromagnetic design.”

8. The invention described in the patent application relates to precisely the field of technology in which, in the course of his normal duties, Mr Franciscatto was employed by Drayson to invent. Accordingly, Drayson submits that the circumstances of Mr Franciscatto's employment were such that the invention described in the patent application could reasonably be expected to result from the carrying out of his normal duties. I agree. By virtue of section 39(1)(a)³, the invention belongs to Drayson. That being so, the patent application relating to invention also belongs to the claimant.

² The claimant has supplied a (heavily redacted) copy of Mr Franciscatto's contract of employment.

³ Right to employees' inventions

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;

Decision

9. Bearing in mind that these proceedings are uncontested, I accept the claims made by the claimant in relation to the patent application and the invention(s) to which it relates.

Order

10. In view of the above, I make the following orders:-
- a. Drayson Technologies (Europe) Limited is and has at all material times been alone entitled to be granted a patent in the United States of America for the inventions described and claimed in patent application US2019/0013591 A1.
 - b. Drayson Technologies (Europe) Limited has or would have all right and interest in any such patent or application for any such patent in the United States of America.
 - c. Mr Bruno Franciscatto's rights in the invention(s) described in the patent application, and any patents or patent applications relating to those inventions, are hereby assigned to Drayson Technologies (Europe) Limited.

Stephen Probert

Deputy Director, acting for the Comptroller