Intellectual Property Office

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24 August 2016

PATENTS ACT 1977
(THE PATENTS RULES 2007)

CLAIMANT	Alan Neath
DEFENDANT	Peter Neath
ISSUE	Applications under section 13(3) and rule 10(2) in respect of UK Patent GB2459912
HEARING OFFICER	H Jones

Both parties appeared in person
Hearing date: 24 June 2016

DECISION

Introduction

1 Patent application GB0902490.2 entitled "*Tool handle*" was filed in the name of Peter Neath (hereafter PKN, the defendant) on 16 February 2009 claiming an earliest priority date of 7 May 2008. The application was subsequently published as GB2459912 ("the patent") on 11 November 2009 and granted with effect from 9 June 2010. There is a corresponding international application PCT/GB2009/001121 which was filed on 6 May 2009 and was published as WO2009/136150 on 12 November 2009.

2 The patent has already been the subject of a dispute in relation to entitlement under sections 12(1) and 37(1) of the Patents Act 1977 ("the Act"). This entitlement dispute also involved the defendant PKN and the claimant in the present proceedings, Mr Alan Neath (hereafter ATN). The parties involved entered into mediation on 29 November 2012 and an agreement was reached and signed on 10 January 2013.

3 The present decision relates solely to the issue of inventorship, i.e. who has the right to be mentioned as an inventor on the patent. This decision does not concern the issue of ownership or entitlement of the patent.

4 The claimant, ATN, has applied under section 13(3) of the Act to remove PKN's name from the patent so that he is not named as inventor, together with a further application under rule 10(2) of the Patents Rules 2007 ("the Rules") to add his name as sole inventor for this patent.

5 The defendant, PKN, opposes the two applications.

6 I issued a preliminary evaluation in February 2016 setting out the issues to be decided and asking both parties to focus their efforts on showing how they had

contributed to the inventive concepts set out in the patent. I also asked them to consider joint inventorship in the light of the evidence available at the time.

7 After a number of preliminary matters were dealt with, the matter came before me at an oral hearing on 24 June 2016. Both parties represented themselves and I was assisted by Dr Lawrence Cullen.

8 At the hearing, both parties were reminded of the running order which I had notified them in writing prior to their attendance at the hearing. As both parties had sought and been given permission to cross-examine the other, this process took place first with the claimant, ATN, standing as witness and being cross-examined by PKN in relation to the material he provided in his written statement of case; and then the defendant, PKN, standing as witness and being open to cross-examination by ATN in relation to the material he had provided in his written counterstatement.

9 Once cross examination was completed and each party had had a chance to reply to the other, ATN, as the claimant, presented his arguments based on the evidence that had been submitted and the testimony that came out of the cross-examination to show why he should be named inventor and why PKN should be removed as inventor. Then PKN, as defendant, responded with his arguments, again on the basis of the evidence that had been submitted and testimony that came out of the cross-examination, as to why ATN should not succeed in being mentioned as an inventor of the patent or in having PKN's name as an inventor removed from the patent.

10 Both parties confirmed that they were content with this approach.

The patent

11 The patent relates to a tool handle that may be used readily in either a single- or two-handed manner. The tool handle comprises a substantially elongate shaft section and a head section. The elongate shaft section comprises a first handle formation that extends outwards from the general direction of the length of the shaft section. The head section comprises a second handle formation and two strut sections, the second handle formation extends substantially perpendicular to the length of the shaft section and the two strut sections each extend between a respective end of the second handle formation and an end of the shaft section to form a structural inter-connection between the second handle formation and the shaft section.

12 Figure 1 from the patent (reproduced below) illustrates the features of the invention. The tool handle (12) comprises an elongate shaft section (13) and a head section (21). The elongate shaft section comprises a first handle (14) which extends outwards from the general direction of the shaft length and which is sometimes referred to as a baton grip. The main section (21) of the shaft (13) has a substantially concave surface (22) which extends up to an opening defined by a space between two strut sections (15). The second handle (17) extends substantially perpendicular to the length of the shaft and also is curved along its length in a manner consistent with the concave curvature of the shaft surface (22).

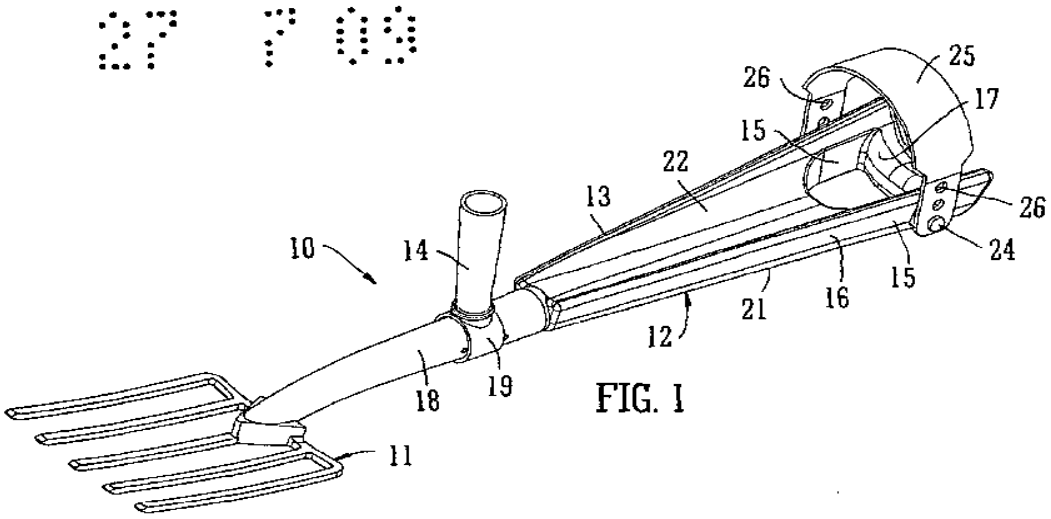

FIG. 1

13 Each strut 15 is provided with an attachment means, such as the combination of the stud (24) and strap of flexible material with apertured ends (25) that enable the strap to be secured to and pivot about the studs. This attachment means is adjustable, e.g. the strap has a plurality of stud apertures (26) so that the effective length of the strap may be adjusted by a user to enclose their arm when using the tool in a single-handed fashion. When the first handle (14) is gripped by the user's hand, the elbow of the user and/or the adjacent region of the user's forearm sits within the concave shaft surface (22) and the attachment means can then be placed over the user's arm to restrict the movement of the arm and so facilitate single-handed use of the tool.

Issue to be decided

14 The issue to be decided in these proceedings is who should or should not be mentioned as inventor or inventors for patent GB2459912.

15 The claimant, ATN, has applied under section 13(3) of the Act to remove PKN's name from the patent. ATN has also applied under rule 10(2) of the Rules to add his name as inventor. As the claimant in these proceedings, the burden of proof rests on ATN.

16 A number of outcomes are possible. First, in order to be named as an inventor on the patent, it is for ATN to show, on the balance of probability, why he should be so named. If he does so his name will be added as an inventor but this will have no impact on any other named inventor (or inventors) of the patent.

17 Secondly, if ATN succeeds in showing why PKN should not be named as inventor, PKN's name will be removed from the patent and ATN's name will thus remain as sole inventor of the patent.

18 Thirdly, if ATN does not succeed in showing why PKN should not be named as an inventor, then PKN's name will not be removed from the patent and will remain as a named inventor. It is not necessary for PKN, as the currently named (sole) inventor on the patent to show positively why he was the inventor. In this outcome, both ATN and PKN will be listed jointly as inventors on the patent.

The law

19 Section 13(3) of the Act and rule 10(2) of the Rules, read as follows:

> *s13(3): Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.*
>
> *r10(2): A person who alleges that any person ought to have been mentioned as the inventor or joint inventor of an invention may apply to the comptroller for that person to be so mentioned:*
> *(a) in any patent granted for the invention; and*
> *(b) if possible, in any published application for a patent for the invention.*

20 There is no dispute as to the applicable case law in this instance. It has been held in the cases of *Yeda*[1], *Markem*[2] and *Henry Brothers*[3] that in order to determine inventorship it is first necessary to identify the inventive concept or concepts of the patent, before then going on to determine the actual deviser(s) of such inventive concept(s).

Arguments and analysis

21 Before turning to consider what are the inventive concepts of the patent, I note the following points which were not in contention and are relevant to the discussion below:

a. PKN had a workshop at his home that was suitable for carrying out practical engineering tasks such as drilling of wood, of metal, etc., and mechanical repairs. ATN did not have such a workshop;

b. ATN worked as a gardener and created a garden tool – a fork – for his own use in this job;

c. Mr John Badger was a patent attorney retained by PKN. He prepared and filed the application for the patent that is the subject of these proceedings. The patent was filed on 16 February 2009 claiming an earliest priority date of 7 May 2008 and granted with effect from 9 June 2010;

d. PKN has another business interest in the area of barbeque equipment including other patents which are not relevant to the issue to be decided in this case.

Inventive Concepts

22 I will summarise the views of the claimant and the defendant below in relation to what are the inventive concepts disclosed in the patent and what is the contribution that they made to these concepts. I will include reference as appropriate to the written statements and Exhibits from both parties and any oral testimony.

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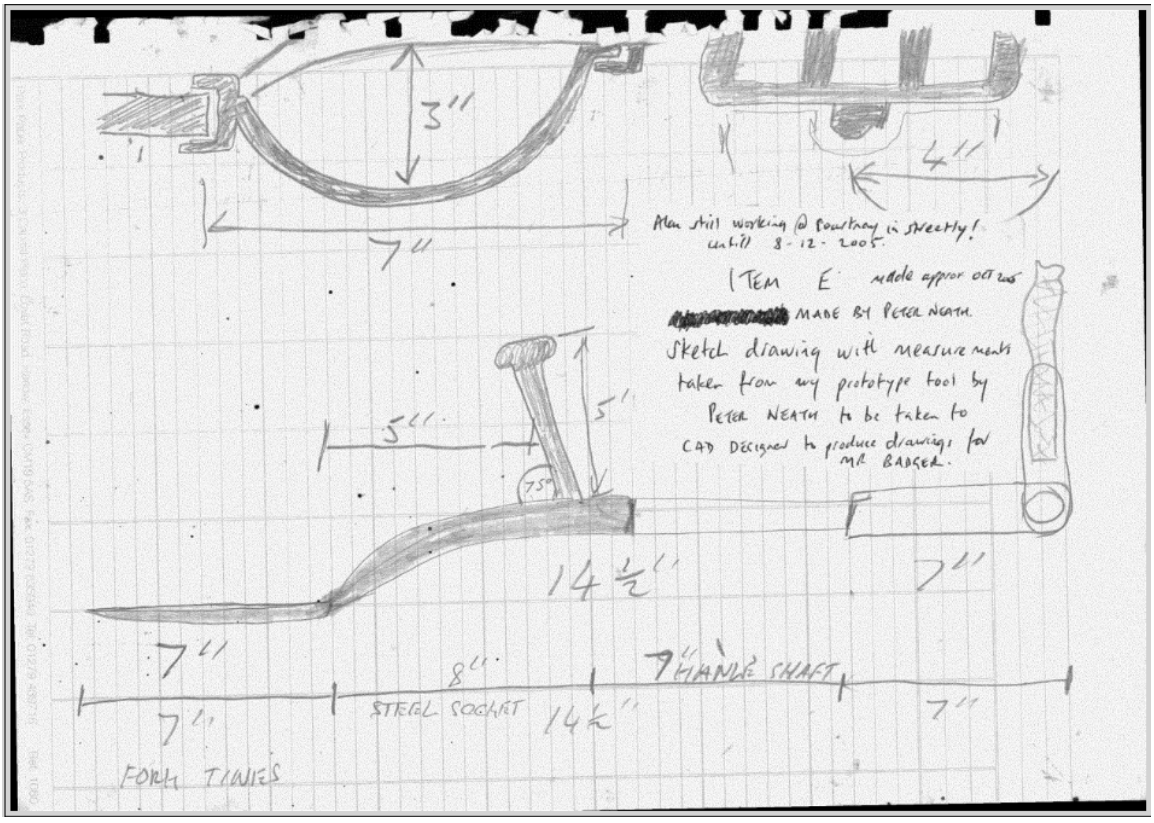
[1] Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc, [2007] UKHL 43
[2] Markem Corp v Zipher Ltd, [2005] EWCA Civ 267, [2005] RPC 31
[3] Henry Brothers (Magherafelt) Ltd. v The Ministry of Defence and the Northern Ireland Office [1999] RPC 442

Claimant's view

23 ATN's written statement of case was unclear regarding the chronology of events involved in devising the invention disclosed in the patent. ATN claimed that it was he who had the idea of adapting an existing long handle tool, i.e. a garden fork, for single-handed use by cutting down the length of the shaft and fixing a first handle extending outward from the shaft – the so-called "baton-grip". The first handle at this point in time comprised the wooden handle from an old file pinned to the cut-down, wooden shaft. He says that it was his idea to re-fix the "D" handle of the longer handle onto the shorter, cut-down shaft (see paragraph 10 of his statement of case). ATN stated that he used bandages and then later some straps to tie the forearm in place along the shaft for single-handed use. He does not say when he came up with these ideas, but claims that it was during the time he was employed as a gardener for a Mrs Marjorie Heath in Streetly, West Midlands. He attached a copy of his P45 to confirm the time when his employment with Mrs Heath came to an end (8 December 2005). I note, however, that elsewhere in this statement of case ATN says that he worked for Mrs Heath between 2000 and 2006 (see paragraph 6).

24 ATN relied heavily on a drawing (Exhibit E, reproduced below) which he stated illustrated the features of the garden tool he was using in 2005-2006 and which he considered included all the inventive features covered by the patent. He says that this drawing – a freehand sketch – was produced by PKN and describes the features of the tool made by ATN with assistance from PKN. I will discuss this further below.



(ATN's Exhibit E)

25 ATN did not offer much more information on what he considered the inventive concepts in the patent to be at the hearing than he had already provided in his written submission. He did however offer two corrections to the points he had made in his written statement.

26 In his written statement of case, ATN referred to the drawing (Exhibit E) as having been produced in November 2005, but at the hearing he corrected this to 'in 2006'. PKN was happy to accept this correction as it chimed with his recollection of events and was one of the points he made in his counterstatement. This was ATN's first correction

27 ATN had stated initially in his statement of case that he then had the idea of adding a length of plastic guttering to the shaft of his tool to help provide more support to his forearm – and so in effect to create a concave surface along the shaft that could be used to position the user's arm in single-handed use mode. He stated that he found a suitable piece of guttering at PKN's house and asked if he could use it but did not tell PKN why he needed it. He took it away from PKN's premises and fitted it to the tool to create an arm rest. However, at the hearing ATN corrected this point saying that he accepted the account that PKN had given in his counterstatement in relation to this point, i.e. that PKN and ATN had identified a suitable piece of guttering at PKN's home and worked together to fit it to the tool in PKN's home workshop. This is ATN's second correction.

28 After some time of using his tool, ATN asked PKN to modify the first handle (or baton grip) arrangement because the old wooden file handle was no longer staying in place and a more secure fixing was required. He first asked PKN to weld a piece of steel tube to the metal shaft of the fork to replace the earlier wooden handle. A short time later, ATN again asked PKN for assistance to adjust the angle of this steel tube baton grip for ease of use, A baton grip that is angled forward is not as hard to use, especially for a prolonged period, as one that is perpendicular because, in use, the latter strained the hand holding the grip especially the webbing between thumb and forefinger while the former did not.

29 ATN also says that he had the idea of adding a fulcrum arrangement to act as extra leverage when using the tool, which PKN welded onto the tool at this time. I note that while this arrangement is illustrated in Exhibit E, it is not an inventive concept set out in the patent at issue.

30 ATN says that PKN became interested in the tool and they began discussing the possibility of patent protection and of marketing the product. He says that PKN asked him to bring a prototype tool to his house around November 2005 (now corrected to sometime in 2006) in order for PKN to sketch it, so PKN clearly knew about the tool and expressed an interest in it at this point. This is the sketch drawing provided by the claimant as Exhibit E, which shows (i) a first handle fixed to the metal shank of the fork and extending outwards from the general direction of the elongate shaft; (ii) a fulcrum arrangement; (iii) a short shaft length; and (iv) a second handle with a strap arrangement. I note that this sketch drawing does not show a recessed arrangement with a concave surface for further supporting/restraining the user's forearm.

31 It was unclear from ATN's statement to what extent the tool handle was modified between the occasion when PKN first started his interaction with ATN, i.e. late 2005 or sometime in 2006, and the filing of the patent application in May 2008.

32 At paragraph 25 of his statement, ATN says that PKN told him that he should not discuss the idea or show the tool to anyone, and that it was fortunate that, because of her health, the old lady in Streetly who he worked for and was housebound would not see him using this tool. This conversation must have occurred before December 2005 when AKN's employment at Streetly stopped. ATN says that he began researching for similar products and patent applications at this point, but makes no mention of modifying the design of the fork handle from that shown in the Exhibit E sketch.

33 At paragraph 45 of his statement, ATN says that by the time that PKN became involved, the idea behind the tool and the rationale for its development had already been developed by him (ATN) and suggests that PKN was not involved in devising any element of the invention set out in the patent application.

34 At the hearing, ATN provided further information in relation to the "baton grip" and the curved armrest. He stated that the curved shape on top of the handle where the arm rests is important. Also, the pistol grip is not exactly perpendicular - it was re-adjusted after the initial making at a later date to be tilted forward, which is very important because it causes damage to the web of the hand when gripped.

35 Under cross-examination by PKN, ATN agreed that they had spoken about the tool shown in Exhibit E in 2005. In his written statement and again at the hearing, ATN maintained that he made a tool, with PKN's help, in the period 2005-2006, which led, after a period of time, to the patent. At this time ATN was working full time as a gardener, a job he finished in December 2005. The help provided by PKN related to modifications to the gardening tool ATN had developed. He said:

> *"I have mentioned once already in my corrections the first time I came to him was to ask for a piece of plastic guttering. The second time I came to Peter's home was to ask for him to weld a steel pistol grip to the tool. The third occasion was to correct the angle of the pistol grip and add a fulcrum plate to that tool.*

36 Under cross examination by PKN, when describing the features disclosed in Exhibit E, ATN accepted that Exhibit E does not show the concave surface along the shaft that functions as an arm rest which was based on fitting a piece of curved guttering to the tool being used by ATN. He described the features of the Exhibit E sketch as follows:

> *"The drawing appears to be based around a conventional garden fork as opposed to a hand fork. It seems to me to be representing elements of a conventional garden fork, much like the one that I used myself to make my tool. The comparison was that I used a lady's small light-weight border fork. There are distinct similarities in this sketch to that because of the size of the tines on the head of the fork for digging. Clearly, it is much too big to be a hand tool and very much indicative of the type of tool that I was using when I made my tool, because the tines are a good seven inches long as indicated in your drawing. The sizes and dimensions are part of your original drawing, not sizes that I have written on the drawing. From the large full-sized or, perhaps, the ladies' border fork section, you have clearly got the steel socket showing in your diagram, which is curved or cranked? That is common to ladies' border forks or garden forks.*

The item next in the drawing is a pistol grip. That, I would say, is something you wouldn't find on a hand fork, a hand trowel or a garden fork. That pistol grip is not quite as perpendicular as initially described [..] it is leaning forward, which makes me agree that this pistol grip leaning forward is a lattice reflection of or the same as the later development that I felt that I personally made when I developed my tool, and found that the initial pistol grip that I made was perpendicular when, in fact, I found that it was extremely painful to the web of my hand and thumb, and asked at a much later, with yourself, Peter, to cut it off and re-weld it with the lean. So this is a step forward towards making the tool much easier to use.

Beyond that steel socket and the pistol grip, you have got a handle shaft. Whether it be wood, plastic or steel, possibly, is not intrinsically important to the drawing.

Beyond that, you have got some type of handle that could be, like my own tool, a standard garden fork handle, be it a 'D' shape or a 'Y' shape. However, it has an addition. Because I am familiar with this concept, although the drawing does not necessarily make it obvious to see it, the top handle there has got what I would call a strap of some form. It may not be obvious to anybody looking at this from a new perspective. The strap would have been attached by a number of methods.

Your drawing, which I am describing to you, includes at the top of the 'YD'-type handle some means of drawing, the two separate drawings that have been provided, the top-left corner shows, in part, the four tines, but behind that and below the steel socket is a curved feature. That would be representing what I call a fulcrum plate, which would provide extra leverage to dig out stubborn or large-rooted plants, either by using the tool as a single-handed tool or, if called upon, as a two-handed tool. Having a fulcrum plate as depicted in your drawing, that curve -- by the way, that curve doesn't fully show the fulcrum plate -- is the spine to provide the support, and under that is a large flat plate, because a large footprint on a fulcrum will not sink into the earth when used as a lever to dig out a large plant. The concept us shown as a curve, and I understand it, because that, indeed, is what I have got on the tool I made. Indeed, it is what you welded on the tool for me on one of the three occasions you helped me with it.

However, it is worth just pointing out, while we are talking about the fulcrum, that it was something that we both agreed would not necessarily find a winning audience in the retail market because it looked far too aggressive and much too heavy duty to be part of the patent that we were working on. We were discussing making it into a tool that was very attractive, lightweight and strong, but certainly not as heavy or aggressive as the tool that I chose to make for myself to make my job easier.

Finally, to the right-hand side -- I am not quite sure what that represents. It is clearly something to do with the tines on the tool drawn by yourself -- it is worth noting that that particular cross-section of the tines has four tines on it. It is, again, reflective of the fact that the initial ideas worked around garden forks. It was not working around, at this stage of the drawing, with hand forks. A major

difference is not only in the overall size of those tools, but a garden fork is something you can use when you are standing up, whereas a hand fork is something you use, probably, when kneeling down. A hand tool would, generally, only have three tines and be of an overall size of 12 inches, whereas the tines in this particular drawing represent tines being seven inches long and a width of, possibly, eight inches because you have drawn four inches to the centre. That is the best description I can give just at the moment."

37 At the hearing, ATN summarised his case as follows:

"I made the garden tool to help myself in the work I did at that time in 2005-2006 as a gardener. I had help on a number of occasions as identified from the statements made for this hearing today, where my brother [PKN] did help me with providing a piece of plastic to make a shape on the handle and to help me with welding the baton grip, and then at a later date taking the baton grip off and readjusting it to lean forward, and added a third feature, which was the fulcrum lever plate. I explained that I was not familiar with the technical wording or terminology within the patent and the claims for that patent. I was happy at the time that my brother kindly offered to help with Mr Badger to write those types of things and that my brother would be the project leader. I feel that, even though I don't know the intimate technical legal details of what that patent was finally granted on, what the grounds were or what the claims were that led to a patent to be granted, but I firmly believe that the tool I made, the jobs I did with my brother between 2005 and right through to the point where the patent initially submitted by Mr Badger in 2008, and eventually granted in 2010, covered the period of time when I worked with my brother on what I firmly believe was one single tool until I stopped working with him in 2010."

Defendant's view

38 In his written statement dated 22 November 2015 (see especially paragraphs 12-21) and again at the hearing, PKN explained the origin of the ideas in the patent as deriving from a chronology of events which took place in 2007 to 2008, i.e. after the interaction with his brother (ATN):

a. On holidays with his young children, PKN purchased some plastic beach spades for his children to use at the beach. He was struck by how well made each spade was in terms of being moulded in a single piece and being designed with a rake-type shape as the top of the spade part to allow for more flexible use (see paragraph 12 of PKN's witness statement dated 23 November 2015);

b. In addition, while on holiday he came across a selection of old magazines available for visitors which included a magazine about metal detectors called 'Searcher' – already old at this time but still interesting in the view of PKN. Looking through the magazine, one could see that detectors have a wide variety of handles and arm grip features including recess-type arm grips and arm cuffs and baton grip handles which facilitate single-handed use;

c. This prompted him to make some drawings using his children's crayons that he considers were the start of an idea and shape for a one-piece handle with a recess built in like those on a metal detector and shaped like a child's spade;

d. This led PKN at the end of 2007 to assemble a tool from an old fork head and some 20mm steel tubing which included a grooved recess for resting the user's elbow in. However, in working on this he realised that using and handling such a tool could hurt your elbow and 'funny bone';

e. A wooden version was then made in PKN's workshop which he refined so that it would be a shape that could be moulded in one piece from plastic. It also needed to have an overall design that was different from that seen with metal detectors and that could be used when standing, kneeling, sitting, etc.;

f. This work was completed by January/February 2008. A registered design for a garden tool was applied for by PKN in May 2008 which included a baton grip, a curved "D" handle grip, a concave grooved surface to position the user's arm and a strap based restraining means (see Exhibit 7 of PKN's counterstatement showing a top handle arrangement very similar to that shown in figure 1 of the patent).

g. Given his previous experience with barbeque equipment (an existing and functioning business which PKN manages), PKN was aware of the need to be informed of what already existed in terms of patents, designs and available products that might have an adverse impact on further development of this proposed product, e.g. to obtain a patent (see paragraphs 18 and 19 of PKN's witness statement dated 22 November 2015).

h. PKN engaged the services of a patent agent, Mr John Badger, in April 2008 to prepare the application for the patent at issue in this case;

i. PKN states that the tool he had developed was used to create some 3D drawings and these were then used in preparation of the patent application.

39 Other than providing the details of the registered design application which included images of his tool handle design, I note that PKN has not provided any material evidence to show the development of this tool through the different stages discussed above, e.g. no photographs or drawings or sketches, such as the crayon drawings that were his initial design, or sketches or pictures of the different metal or wooden versions he prepared.

40 PKN noted that there was a significant gap between (a) the time of the drawing of Exhibit E and the events related to it in November 2005 to December 2006 which ATN discussed as the basis for the ideas in the patent and (b) the time when the priority patent application was filed in May 2008. PKN considers that this is significant – the tool in Exhibit E includes a fulcrum plate and, as a result, was not attractive as a general tool – a point referred to by ATN in his oral submission also.

41 PKN admits to making the drawing attached as Exhibit E of ATN's statement; PKN says at paragraph 11 of his counterstatement that it was drawn by him and admitted that this would have been in November 2005 as claimed then by ATN (now corrected to sometime in 2006). At paragraph 7 of his witness statement, PKN says that during

the period between 2005 and 2007 he made various repairs to the gardening tool used by ATN. He says at paragraph 15 of his counterstatement that he had seen what ATN describes as his “ramshackle” border fork, i.e. the shortened shaft, the first handle pinned to the shaft made from the handle of an old file, a second "D" handle at the top of the shaft and the bandages/straps (see paragraphs 10 and 11 of ATN's statement).

42 PKN confirms that in the period 2005-2006 he welded a piece of steel tube to the metal shank of the fork and later adjusting the angle of the tube for ease of use and a curved fulcrum plate to the tool.

43 At paragraph 9 of his witness statement, PKN points out differences between the Exhibit E sketch and the invention set out in the patent, namely the presence of a fulcrum plate, the absence of any guttering and the fixing arrangement on the top handle to “give a more fixed point of attachment as with a plastic crutch top c section”. The presence of a fulcrum plate and the realisation that this was already known in the patent art (see paragraph 10 of PKN witness statement of 23 November 2015) is what prompted the end of any further work on this design as the basis for a patent. PKN considers that there was no contribution from this work and interaction with ATN that resulted in the features included in the patent.

44 PKN says at paragraphs 16 and 17 of his witness statement that it was around January 2008 that the plastic guttering was added to the fork used by ATN. This is well after the features illustrated in Exhibit E which relate to modifications to ATN’s tool made in 2005-2006 (already discussed above) but only shortly before the patent application was filed.

Analysis

45 Given the passage of time since the patent application was made, it was somewhat inevitable that both sides would have difficulty recalling precisely the key dates leading up to the making of the invention. Indeed, this became evident at the hearing when both sides agreed that the Exhibit E sketch was made later than originally claimed. However, while it may not be possible to pin down dates precisely, I have found it possible from the written statements and the oral testimony to understand the general sequence of events that occurred and that are relevant to deciding the question of inventorship.

46 Based on the written statements and oral testimony from both parties, I find that the patent includes the following inventive concepts:

a. The first inventive concept was the idea that you had a garden tool which was shortened in some way to allow single-handed use. In order to allow for single-handed use, there was this notion of having a first handle which came up somewhat perpendicular to the length of the garden tool handle.

b. The second inventive concept was the notion that you could use this tool also in double-handed use. So you had the conventional “D” or “Y” handle at the top of the length of the garden tool to allow a user to enclose the grip of the handle in his hand.

c. The third inventive concept was the notion that you can include a restraining effect for the user's arm to improve the single-handed use. This is represented by the plastic moulded handle which, as well as the conventional "D" handle, includes some sort of restraining means as well, for example, a strap and stud arrangement that can be secured across the user's arm.

d. The fourth inventive concept was the notion of having a recessed concave groove in the plastic moulded handle which serves to position and support the user's arm during single-handed use and makes the restraining means or effect work better.

47 ATN's work as a gardener prior to 2006 provided him with the motivation to devise inventions relating to gardening tools before the filing of the patent application. He refers to his "ramshackle" tool as sketched by PKN to support this. PKN's counterstatement and witness statement do, in my view, support the claim made by ATN that he, i.e. ATN, had at least developed the idea of shortening the length of wooden shaft of a standard gardening fork and then making various modifications to make it easier to use as a single-handed tool, i.e. a first handle extending outwards from the general direction of the elongate shaft section and a restraining means for strapping the forearm of the user in place relative to the shaft. PKN's input at this time was to repair and modify the tools brought to him by ATN.

48 This first handle underwent modification based on the use that ATN made of the shortened fork. He found that if the handle was perpendicular or very close to it, it put pressure on the webbing of the hand between thumb and forefinger when used and so he sought the help of his brother to modify this handle so that it was tilted at a forward-leaning angle (towards the tines of the fork head). As a consequence of this modification, he found the handle easier to grip and overcame the problem encountered with the more upright earlier form of the handle.

49 ATN says that it was his idea to include the standard "D" or "Y" shape grip onto the end of the shortened shaft, allowing the tool to be used for double-handed use. The evidence in support of this is sparse: the only evidence which points in ATN's favour is the fact that he worked with gardening tools every day and was familiar with the types of handles on them, although PKN would also have known of such handles from his own general use. Given ATN's work in modifying the shaft of his garden fork for single-handed use, I find it more likely that ATN devised the idea of replacing the "D" or "Y" handle onto the shortened shaft, thereby allowing for double-handed use.

50 The use of the restraining means is suggested by Exhibit E and, although quite crudely illustrated, it supports the argument that this concept was part of the work involved in adapting the tool for single-handed use. It is a simple way to restrain the user's upper arm at the end of the handle when the hand of this arm is used to grip the first handle. Without this restraining means or effect, the hold on the tool would only be at the first grip and this would reduce significantly the effectiveness of the tool in use.

51 The development of the concept of a recessed concave groove in the handle of the tool which improves the positioning of the user's arm and the effectiveness of the restraining means is the most difficult to determine. There is nothing to suggest it in the Exhibit E sketch submitted by ATN despite his assertion that this illustrates all the

features latter included in the patent. ATN does refer in his written statement and his oral testimony to the idea of attaching a piece of plastic guttering – which has a concave curved surface - onto the shaft. There is an inconsistency in ATN's evidence about what the precise circumstances were and when the guttering was added to the shaft. For example, ATN states that the guttering was added before PKN modified the angle of the first handle and before PKN drew the sketch diagram of Exhibit E, but for some reason the guttering arrangement is not shown in the Exhibit E sketch. There is also nothing in ATN's evidence to show how he was involved in developing the idea of supporting the user's forearm from the initial guttering arrangement to the recessed handle arrangement disclosed in the patent. PKN, on the other hand, does explain how the idea of the curved handle was developed, referring to his work in early 2008 when he purchased a cutting tool and used it to shape some of 3D models of the handle. This work led him to file a registered design application which shows a handle arrangement identical to that illustrated and described in the patent. It may well be the case that the initial gutter solution, which both parties accept they worked on together before the filing date of the patent, was the inspiration for PKN's work, which would suggest a joint involvement in the development of the concept, or it may be the case that it was not the inspiration for his work, as PKN suggests, and that PKN is the sole deviser of the recessed concave groove in the handle. Either way, it is clear from the evidence that he, i.e. PKN, was involved in its development to a significant extent.

52 Taken together I am of the view that the development of the inventive concept involving the concave surface and its refinement from a shape where the groove is of same diameter along its length (as in a piece of plastic guttering) to one that tapers outward from the diameter of the shaft to the diameter of the handle grip at the end of the shaft as shown in the patent is properly attributed to PKN. While I am satisfied that PKN was involved in the development of this concept, it is less clear to me what role ATN had in its development. While he has asserted that he conceived of the idea to use a piece of plastic guttering in this way and searched for a suitable piece at PKN's house, I do not consider that he has been able to provide sufficient support to show that he did so without any interaction with PKN. As it is for ATN to show why he should be named as inventor for the patent and also to show why PKN should not, I do not consider that he has been able to show that, on the balance of probabilities, PKN did not have a significant role in the development of the fourth inventive concept referred to above.

53 I should note that PKN has offered an alternative explanation of how he developed the inventive concepts disclosed in the patent. He indicates that this took place after the period in 2006 when he had been interacting with his brother ATN as set out above. PKN considers that his reaction to the "well-made" plastic moulded beach tools used by his children on holiday in 2007 linked to his discovery of the magazine illustrating metal detectors with baton grip handles and arm support cuffs and his recognition that a better restraining means was needed for the user's arm that would restrict movement of the arm in a number of ways was responsible for planting in his mind the basis for all four inventive concepts identified above. While, I am prepared to accept that he developed the fourth inventive concept – as I have mentioned above – I am not so persuaded in relation to inventive concepts one, two and three. PKN was exposed to the tool that ATN was using on a number of occasions in 2005 & 2006, where he was involved in handling and manipulating the tool in a number of ways to add or adjust features of it in his workshop. Thus I am satisfied that on balance he would have seen the relevance of the first handle, the inclusion of the "D"

and “Y” grip handle and the restraining means for the upper arm to a garden tool that is adapted for single-handed or double-handed use. Although he may have refined these features and provided more detail or variations, I am satisfied that the initial idea would have come from his significant exposure to the tool ATN was using and to the features of the tool illustrated in Exhibit E as discussed above. I do not consider that PKN alone was responsible for the development of these three aspects of the invention. Thus I consider that on the balance of probability, ATN should be mentioned as an inventor in relation to these aspects of the invention.

Conclusion

54 I find that the application by Alan Neath (ATN) under rule 10(2) of the Rules succeeds and that he is entitled to be named as an inventor in patent GB2459912. I do not find that Alan Neath has been successful in showing, beyond the balance of probabilities, why Peter Neath (PKN) should be removed as a named inventor in the patent. Thus, I find that the application under section 13(3) of the Act does not succeed. Peter Neath remains as a named inventor in the patent.

55 The overall effect of this conclusion is thus that Alan Neath should be added as a named inventor and Peter Neath should remain as a named inventor in the patent.

Order

56 I direct that the register of patents be updated and that an addendum slip be prepared mentioning Alan Tredwell Neath as joint inventor with Peter Karl Neath for the patent GB2459912.

Costs

57 The claimant has succeeded in one application but not on the other, thus I consider that each party should bear their own costs

Appeal

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

H Jones
Deputy Director acting for the Comptroller