

inventors over a period of time no response has been received. Therefore as required by rule 77(9) of the Patents Rules 2007, I must treat them as supporting the referrer's case. Rule 77(9) says:

77(9) 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.

The law

4. These proceedings have been brought under sections 13(3), 37(1)(a) and 37(1)(b) of the Patents Act, which read:

Section 13(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.

Section 37(1)

After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question-

(a) who is or are the true proprietor or proprietors of the patent,

(b) whether the patent should have been granted to the person or persons to whom it was granted, or

(c) ...

and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.

Referrer's arguments

5. According to the Statement of Grounds Malaysian, Palm Oil Board's business is in the field of microwave processing of oleochemicals. In October 2012 Malaysian Palm Oil Board entered into a collaborative research agreement (CRA) with CTI Biofuels LLC. A copy of the CRA has been submitted as evidence. The aim of the CRA was to commercially develop and bring to market a microwave chemical process for making value-added products on the basis of intellectual property owned by CTI Biofuels LLC.

6. The CRA sets out three stages of research of which only the first stage was carried out. The first stage entailed the testing of Malaysian Palm Oil Board's intellectual property using the microwave facilities of CTI Biofuels LLC to evaluate the feasibility of developing the technology and the design for stage two. Stage one was carried out from January to May 2008 at CTI Biofuels LLC laboratory using processes from Malaysian Palm Oil Board's intellectual property and under the guidance of Malaysian Palm Oil Board's employees. All costs from stage one were borne by Malaysian Palm Oil Board. Stages two and three were subsequently cancelled by the Malaysian Palm Oil Board due to cost and other commercial considerations.
7. Article 5 of the CRA sets out that all IP arising from the collaborative research shall be jointly owned in equal shares by the Malaysian Palm Oil Board and CTI Biofuels LLC. However the referrer states the invention covered by the patent did not arise from the collaborative research between the Malaysian Palm Oil Board and CTI Biofuels LLC but that it was developed solely by Malaysian Palm Oil Board. In support of this the referrer has filed in evidence an email dated 30 December 2009 from Mr Leonard Hintz of CTI to Dr Hazimah Abu Hassan of Malaysian Palm Oil Board in which Mr Hintz clearly states:

“that all inventive steps were actually yours (MPOB) and as such we feel it would be inappropriate to claim/suggest that we have provided intellectual assistance. Therefore we have no inventor(s) to submit from our side”.
8. The referrer further clarifies that the invention covered by the Patent relates to a new process for the production of polyglycerol from crude glycerol and does not relate to the scale-up or commercialisation of the Malaysian Palm Oil Board's technology and as such is unconnected with the aims and intentions of the CRA.

Findings and order

9. In view of the absence of any counter-statement, I accept the facts of the case as set out in the Statement of Grounds filed by Malaysian Palm Oil Board. I therefore find that Malaysian Palm Oil Board is entitled to be named as the sole proprietor of the Patent.
10. I also find that a certificate should be issued to the effect that the four named inventors who are/were employees of CTI Biofuels LLC (namely Mr Marc Portnoff, Ms Margaret Nasta, Mr Leonard Hintz and Mr Kevin P. Reilly) should not have been mentioned as inventors in the Patent.
- 11. I therefore order that granted patent EP 2248842 B should be in the name of Malaysian Palm Oil Board as sole proprietor and the comptroller should issue a certificate under section 13(3) to the effect that the four named inventors who are/were employees of CTI Biofuels LLC should not have been mentioned as inventors in the Patent.**

Costs

12.No request has been made as to costs and hence I make no such order.

Appeal

13.Any appeal must be lodged within 28 days

Phil Thorpe

Deputy Director acting for the Comptroller