



PATENTS ACT 1977

PARTIES	Alfa Laval Corporate AB, Syncrude Canada Ltd, Leonard Borgström, Lasse Hurnasti, Daniel John Bulbuc, David Harold Childs, Thaddeus Eugene Kizior and Kevin Reid
ISSUE	Reference filed under Section 37 and application under rule 10(2) for mention of additional inventors for patent number EP(UK) 2628544
HEARING OFFICER	Susan Eaves

DECISION

- 1 European patent (UK) No. 2628544 proceeded to grant in the name of Alfa Laval Corporate AB. There were two inventors, Leonard Borgström and Lasse Hurnasti.
- 2 Alfa Laval Corporate AB has made an application under rule 10(2) of the Patents Rules 2007 to the effect that Daniel John Bulbuc, David Harold Childs, Thaddeus Eugene Kizior and Kevin Reid ought also to have been mentioned as joint inventors. They have also filed a reference under Section 37 of the Patents Act 1977 requesting that Syncrude Canada Ltd be named as a co-proprietor by virtue of their contract of employment with Daniel John Bulbuc, David Harold Childs, Thaddeus Eugene Kizior and Kevin Reid and an assignment from Daniel John Bulbuc, David Harold Childs, Thaddeus Eugene Kizior and Kevin Reid to Syncrude Canada Ltd . A statement of grounds has been filed by Alfa Laval Corporate AB to initiate these proceedings together with a copy of the assignment document.
- 3 Syncrude Canada Ltd have also filed a statement to confirm in writing that they consent to Daniel John Bulbuc, David Harold Childs, Thaddeus Eugene Kizior and Kevin Reid being named as joint inventors and also to being added as co-proprietors of the patent by virtue of their contract of employment with the named inventors and assignment.

The law

The proceedings have been brought under section 37 of the Patents Act 1977 and rule 10(2) of the Patents Rules 2007, the relevant parts of which read:

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)..
- (c)..

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

Rule 10

10.—(1) An inventor or joint inventor of an invention, if not mentioned in any published application for a patent, or in any patent granted, for the invention, must be mentioned in an addendum or an erratum to the application or patent.

(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, and, if not so mentioned, in the manner prescribed by paragraph (1).
- (3)..
- (4)..

Also relevant is section 39, which reads:

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; 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.

- 4 In the absence of consents from each of the named inventors and from those inventors to be mentioned, the Office wrote to Leonard Borgström, Lasse Hurnasti, Daniel John Bulbuc, David Harold Childs, Thaddeus Eugene Kizior and Kevin Reid and allowed them a period of six weeks in which to file a counter statement should they wish to oppose the applications. They were advised that subject to any counter statement being filed, the applications would be treated as unopposed. No counter statement has been filed. I therefore consider the applications to be unopposed.
- 5 Accordingly I find that Daniel John Bulbuc, David Harold Childs, Thaddeus Eugene Kizior and Kevin Reid should be mentioned as joint inventors in the granted patent for the invention along with Leonard Borgström and Lasse Hurnasti. I therefore conclude that in accordance with Section 39 of the Patents Act 1977, Syncrude Canada Ltd are entitled to be named as co-proprietors on the granted patent along with Alfa Laval Corporate AB.

I direct that the patent register be updated accordingly and an addendum slip prepared to reflect this finding for the granted patent.

SUSAN EAVES

B3 Tribunals Technical Co-ordinator, acting for the Comptroller