

July 2007, Dr Fenney instructed Potter Clarkson by email to file the application in the name of Sigmala Limited and confirmed that both he and Mr Chilcott should be named as inventors. A copy of this email is submitted in evidence.

- 7 The UK patent application was duly filed and received a filing date of 9th August 2007. At the time the UK application was made, both Dr Fenney and Mr Chilcott were directors of Sigmala Limited, and a copy of the annual return for Sigmala Limited obtained from the Companies House register submitted in evidence confirms this to be the case.
- 8 The international patent application was filed and received a filing date of 9th May 2008. It was filed in the name of Sigmala Limited and had Dr Fenney and Mr Chilcott as the named inventors.
- 9 Sigmala Limited entered into administration in April 2009. The company's assets, including the intellectual property associated with the invention, were transferred to Zincometal S.p.A. on 16th April 2009. A copy of the administrator's statement of sale is submitted in evidence.
- 10 The US patent application was filed on 8th February 2010 as a national phase application of the international application. Efforts were then made to contact Dr Fenney and Mr Chilcott in order for them to complete a combined declaration and power of attorney form and an assignment form - these forms are necessary under US patent law to allow Zincometal S.p.A. to proceed as the named applicant instead of the inventors. Zincometal claim that Dr Fenney has refused to sign the documents and that Mr Chilcott has failed to respond to any correspondence. No evidence has been submitted in support of these claims.

The law

- 11 The relevant parts of section 12 read as follows:

12. (1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made) -

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) ...

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

- 12 It has established in earlier references to the comptroller under section 12(1), namely *Cannings*¹ and *British Telecommunications*², that it is within the comptroller's broad

¹ Cannings' United States Application [1992] RPC 459

² Re British Telecommunications plc BL O/402/01

powers to order the inventor to execute any assignment necessary to give effect to the determination of entitlement to a foreign patent application. If the inventor refuses to execute the necessary assignment then it is within the comptroller's powers to bypass an uncooperative party and authorise an affected party to sign on his behalf.

Conclusions

- 13 The documentary evidence submitted by Zincometal provides material support for the uncontested facts in this case. Dr Fenney and Mr Chilcott are the inventors, and any rights concerning ownership of the invention transferred to Sigmala Limited by virtue of their positions within the company - this was confirmed by Dr Fenney in his email to Potter Clarkson. These rights were sold to Zincometal when Sigmala Limited entered into administration. Zincometal have asked the inventors to sign the documentation necessary to put its entitlement to the invention into effect in the United States, but they have either refused (in the case of Dr Fenney) or failed (in the case of Mr Chilcott) to do so. The facts dictate that an order in the terms requested by Zincometal is appropriate.

Declaration

- 14 **I hereby declare that the invention the subject of US patent application 12/672561 belongs to Zincometal S.p.A.**

Order

- 15 **I authorise Potter Clarkson LLP, on behalf of Zincometal S.p.A., to execute on behalf of the named inventors Dr Lee Fenney and Mr Arthur Chilcott:**

a) a combined declaration and power of attorney (as set out in Annex A of their letter dated 9th December 2011) permitting the US firm Hollingsworth & Funk, LLC to prosecute the US application; and

b) an assignment of rights in US 12/672561 to Zincometal S.p.A. (as set out in Annex B of their letter dated 9th December 2011).

H Jones

Deputy Director acting for the Comptroller