BL O/292/06

16th October 2006

PATENTS ACT 1977

BETWEEN

I.D.A. Limited, Colin Thomas Metcalfe, David Julian Lax and Polymer Powder Technology (Licensing) Limited	Claimants
and	
The University of Southampton, Philip Edwin Howse and Roger Edward Ashby	Defendants

PROCEEDINGS

Application for an order under section 12 of the Patents Act 1977 in relation to US Patent Application Nº 09/736023

HEARING OFFICER Stephen Probert

PROCEDURAL DECISION & ORDER

1 This decision relates to a number of matters that fell to be decided following a telephone hearing that took place on 3rd October 2006. It also confirms an order that was made at the conclusion of the hearing.

2 At the hearing, the claimants were represented by Mr Tim Bain Smith of Raworth Moss & Cook, and the defendants were represented by Mr Daniel Alexander QC instructed by Miss Barbara Halliday from the University of Southampton's Legal Services.

3 It was Mr Bain Smith who requested the hearing, and he explained that he was seeking an order from the Comptroller compelling the defendants to release a 'petition' that was urgently required in relation to two US applications that are still pending.

Background

4 The parties have already fought a long battle over entitlement to a bundle of patent applications relating to methods and devices for catching and killing insects such as cockroaches and house flies. The matter rests with the

judgment of the Court of Appeal[1] after the House of Lords refused leave for a further appeal. Following its judgment, the Court of Appeal ordered that the reference be remitted to the Comptroller "... *to make such further orders as he thinks fit in order to determine the rights of the parties in accordance with this Order and the Judgment of this Court including under sections 12 and 13 of the Patents Act 1977* ...".

5 In brief, the judgment of the Court was that Colin Metcalfe was the sole devisor of the invention, and that IDA Limited is entitled to the patent applications instead of the defendants.

6 According to Mr Bain Smith, arrangements for transferring ownership of the bundle of patent applications around the world is proceeding relatively smoothly, with the exception of the USA. There are two relevant applications pending at the US Patent and Trademark Office (USPTO); a first application (09/736,023) that is in the name of Philip Howse and Roger Ashby, and a second application (10/821,041) — a continuation of the first — in the name of Colin Metcalfe. The fate of the second application depends on the first application, and in order to "correct" the inventors' names on the first application, the USPTO requires a document called a 'petition' signed by Philip Howse and Roger Ashby. Mr Bain Smith explained that the time allowed by the USPTO for receiving such a petition is rapidly running out, and extensions of time are both expensive and difficult to obtain.

7 Messrs Howse and Ashby have already signed the necessary petition. That much was not in dispute, and the document is in the possession of the University of Southampton. Nevertheless, despite several requests, the University of Southampton has refused to release the signed petition to the claimants.

The Issue

8 Mr Alexander explained that the defendants were reluctant to hand over the petition because the position in relation to the first US patent application was yet to be determined. He submitted that the defendants should be allowed time to investigate the legal position in the USA and, if necessary, produce evidence to show how a court in the USA would have decided ownership of the patent application. He was confident that this could be achieved before 23 November, when there is a hearing arranged before the Comptroller to determine what, if any, orders are required in connection with the Court of Appeal's judgment, and as to costs of the proceedings before the Comptroller.

9 According to Mr Alexander, if the defendants released the petition before the US legal position had been fully considered, they would be irrevocably prejudiced. Whereas maintaining the status quo was not seriously damaging the claimants' position — it was merely costing them money, and that was something that the Comptroller could easily address when the question of costs was being considered.

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[1]University of Southampton's Applications [2006] RPC 21 at page 567.

10 Lastly, Mr Alexander pointed out that in the draft directions being sought by the claimants (dated 2nd October — the day before the hearing), there was a specific reference to the defendants being required to file evidence concerning foreign law by 20th October. In Mr Alexander's submission, there was no point in the defendants providing evidence concerning US law if I were to allow Mr Bain Smith's request and order them to hand over the petition immediately.

11 I asked Mr Alexander to comment on the statement made by Jacob LJ in his judgment in this case where he says (paragraph 16):

> "It is common ground that the decision as to this patent and all patents derived from it follow from the s.8 determination."

12 At first sight it appeared to me that the Court of Appeal had already reached a decision in relation to all of the patents involved in this dispute, but Mr Alexander said that he had no idea why the Court made this statement because the defendants had never accepted that the fate of the US application was so linked with that of the PCT and European applications upon which the Court's judgment was primarily based.

13 In the event, Mr Alexander succeeded in creating sufficient doubt in my mind that there might be a real issue of substance here that I decided not to order release of the petition to IDA at this time. In coming to this decision, I was also swayed by the fact that there is a hearing date set in November[2] when both parties will have an opportunity to make detailed submissions on the matter before I make a final decision.

14 However, with a view to eliminating any further delay and/or expense in relation to the US application(s), I did order that the University of Southampton should bring the original signed version of the petition to the hearing in November so that if I should decide that those applications belong to IDA and/or Mr Metcalfe, the petition can be handed over immediately.

ORDER

15 Following the telephone hearing held on 3rd October 2006, the defendants are hereby ordered to ensure that the original petition described above (and already signed by Messrs Howse and Ashby) shall be brought to the hearing on 23rd November 2006 (or such earlier date as the hearing can be arranged).

Appeal

16 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days of the receipt of this decision.

S J Probert
Deputy Director acting for the Comptroller

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[2]During the hearing, both parties agreed to speak with each other, and with the Hearings Clerk at the Patent Office, with a view to agreeing an earlier date for the November hearing.