

PATENTS ACT 1977

IN THE MATTER OF applications under
Section 13 by Dr Vitold Mikhailovich Bakhir
and Dr Yuri Georgevich Zadorozhny
in respect of Patent Numbers GB2253860 and
GB2257982 both in the name of Solenzara
International Limited

DECISION

1. This decision concerns two patents, GB2253860 and GB2257982, both granted in 1995. The application for grant of GB2253860 was made in March 1991 by Kirk and Charavshvili International Fine Arts Company Limited, whose name subsequently changed to Kirk and Company Limited. The application for grant of GB2257982 was made in July 1991 by Kirk and Company Limited. Both applications named as inventors Ronald Francis Kirk and Yuri Georgievich Zadorozhny (the latter's surname being spelt, apparently incorrectly, Zadorozhni). In 1996 an assignment to Solenzara International Limited was registered on both patents.

2. Subsequently Dr Vitold Mikhailovich Bakhir and one of the named inventors, Dr Zadorozhny made:

C references under Section 37 to seek ownership of the patents, and

C applications under Section 13 for Dr Bakhir to be mentioned as an inventor and for certificates from the comptroller to the effect that Ronald Francis Kirk, who was originally named as inventor, ought not to have been so mentioned.

3. Copies of the references and applications, together with the accompanying statements, were sent to both Solenzara International Limited and Mr Kirk. Solenzara International Limited responded by opposing the references and applications. Mr Kirk, however, did not file any opposition to the Section 13 applications. The proceedings then followed the normal course, with the usual evidence rounds. By agreement, the proceedings in respect of the two patents were consolidated. Eventually, moves were made to bring the matter to a substantive hearing, but following a change in representation of Solenzara International Limited, it became clear that a settlement was being considered. This resulted in a letter dated 16 November 1999 from the proprietor's Agents agreeing to the mention of Dr Bakhir as inventor, and the removal of Mr Kirk. Subsequent letters dated 3 December 1999 and 14 December 1999 from either side confirmed that neither would oppose this course of action. It is also, however, clear from the correspondence that whilst this might dispose of the application under Section 13, the reference under Section 37 was not conceded. Indeed, as things stand, this is down for hearing on 15 February 2000.

4. However, both sides have asked that the Section 13 applications be decided in advance of that hearing. This decision is therefore solely concerned with the applications under Section 13.

5. The proprietors have consented to the relief sought in the applications under Section 13, namely that mention of Mr Kirk as an inventor be removed, and Dr Bakhir be mentioned as inventor. Mr Kirk was sent copies of the applications and the statements filed with them (as prescribed by Rule 14(2) of the Patents Rules 1995) and has not filed opposition on his own behalf as is allowed by Rule 14(3). I therefore conclude that all the relevant parties now agree that the inventors of the two patents were Dr Bakhir and Dr Zadorozhny, but not Mr Kirk.

6. Accordingly, I direct that Vitold Mikhailovich Bakhir should be mentioned as an inventor in both patents. This decision also serves as a certificate, issued in accordance with Section 13(3), to the effect that Ronald Francis Kirk ought not to have been mentioned as an inventor in either patent. I further direct that erratum slips be prepared for the patents, in accordance with Rule 14(5), mentioning Dr Bakhir as inventor, and stating that Mr Kirk should

not be mentioned as inventor.

7. I note that the original counterstatements filed by the proprietor ask for costs to be awarded to them. Neither side has made representations that I should award costs in this agreed resolution of the Section 13 applications, and I do not therefore consider it necessary to consider the issue of costs at this stage. I will, however, return if necessary to the issue of costs in respect of the Section 13 applications upon the resolution of the Section 37 proceedings.

Dated this 13th day of January 2000

P HAYWARD

Divisional Director, acting for the Comptroller

THE PATENT OFFICE