

PATENTS ACT 1977

IN THE MATTER OF patent applications Nos PCT/GB99/01705, EPA 99925168.9 and AU9941556 in the name of Charles Penny and a reference under Section 12(1) by Balfour Beatty Rail Limited

PRELIMINARY DECISION

- 1 A statement of grounds under Section 12(1) in respect of PCT/GB99/01705 and its corresponding European Patent application and Australian application was filed on behalf of Balfour Beatty Rail Limited (BBRL) on 24 November 2000 and it was served on the proprietor Charles Penny under cover of an Official letter dated 18 December 2000. However, in a letter dated 15 January 2001, the proprietor's Agents, Raworth Moss & Cook (RMC), stated that the pleading was 'plainly inadequate' and wanted certain further particulars supplied voluntarily by BBRL within 10 days or, failing that, seeking an Order from the Comptroller to the effect that such further particulars be provided.
- 2 Correspondence since then has been limited to a bare statement from the referrers' Agents, Elkington and Fife dated 31 January 2000 to the effect that the statement was sufficiently detailed (although they made minor amendments to the F2/77 and statement under cover of a letter dated 8 February 2001 to add the corresponding EP number), and from RMC dated 6 February 2001 refuting this and referring back to their previous letter. They also argue that support for their point of view is gained by reason of the fact that the period for filing of the proprietor's counter-statement had been stayed. Both parties have indicated that they are agreeable for the issue to be decided on the papers.
- 3 The point regarding staying of the proceedings can be easily dismissed. It is standard practice in Patent Office proceedings upon receipt of a letter such as that dated 15 January 2001 to stay any subsequent action which may otherwise be due until the other side has had an opportunity to comment. It cannot be viewed as supporting, in this case, the basic premise that the pleading was insufficient *per se*.
- 4 Turning to the statement of grounds itself. Although, as pointed out on behalf of the proprietor, there is little more than a bare recitation of Section 39(1) in paragraph 3, this must be read in the context of the following paragraphs (in particular paragraphs 4 and 5) and of the supporting documentation, in particular the alleged contract of employment. Any further detail must be a matter for evidence filed to support the facts pleaded.
- 5 The RMC letter of 15 January 2001 poses a number of specific questions regarding Mr Penny's duties. All I consider are *prima facie* answerable either by reference to the alleged contract of employment or by reference to paragraphs 4 and 5 of the statement of grounds, for example: (i) The 'normal duties of' Mr Penny at the relevant time (in the question 1 context) would *prima facie* appear to be defined with respect to the alleged contract of employment; (ii) 'the duties specifically assigned to' to him (in the question 2 context) would *prima facie* appear with reference to paragraph 4 of the statement of

grounds, in particular him being assigned to the 'Slabtrack project'; (iii) The circumstances giving rise to an expectation to the allegation that an invention would be expected to result from the (normal or specifically assigned) duties would *prima facie* appear with respect to paragraph 17 of the alleged contract of employment vis-a-vis ownership of Intellectual Property and also the reference in paragraph 4 of the statement of grounds to the function of SDG; and, (iv) the 'duties' of Mr Penny, the 'nature of his duties' and 'the particular responsibilities' (in the context of questions 4, 5 and 6) would *prima facie* appear to arise from the alleged employment of Mr Penny as a Director of the Strategic Development Group.

- 6 As a result the Comptroller must decline to give an Order for further particulars as requested.
- 7 To avoid any doubt, the above decision does not imply any consideration of the merits or otherwise of the referrers' actual case, but is solely concerned with the adequacy of the statement of grounds.
- 8 As a procedural matter, the period allowed for appeal to the Patents Court from this decision is 14 days.

Dated this 15th day of February 2001

G M BRIDGES

Divisional Director, acting for the Comptroller

THE PATENT OFFICE