

PATENTS ACT 1977

IN THE MATTER OF references
under sections 12 and 13 by Oliver
Jevons in respect of the invention
disclosed in International Patent
Application PCT/US99/06438 in the
name of Minnesota Mining and
Manufacturing Company

FINAL DECISION AND ORDER

- 1 In my decision of 25 September 2001 in this dispute about entitlement to International Patent Application PCT/US99/06438, I found that Mr Jevons, the referrer, and Minnesota Mining and Manufacturing Company (“3M”), the patent applicant and defendant, were jointly entitled to the application. I gave the parties an opportunity to make submissions as to what they thought an appropriate order under the section 12 reference might be. They failed to reach agreement, and this led to a further hearing on 15 April 2002.
- 2 In my decision of 15 May following that further hearing, I made a number of rulings on what the order should contain, but I could not finalise the order because there were a few loose ends on which I required further submissions from the parties, viz the responsibility for future prosecution, the handling of prosecution costs to date and in the future, dispute settlement mechanisms, and the possible need for clauses covering what happens if infringement or revocation issues arise or if one party fails to pay its share of the renewal fees. I have now received those submissions and can finalise the order.
- 3 I will not go over the ground covered in my decision of 15 May but will just deal very briefly with the loose ends. On past and future prosecution, Mr Jevons has agreed to take responsibility for future prosecution if 3M bear the cost they have already incurred, and 3M are content with that. 3M have also, helpfully, suggested suitable wording to put this into effect in as unambiguous a way as possible. On what happens if one party fails to pay renewal fees, 3M have suggested a clause to make clear that the party’s rights and obligations cease, and I am happy to adopt this suggestion. Finally, neither side wants the order to include any provisions for dispute settlement or what should happen if infringement or revocation issues arise, and I am content to leave these out.
- 4 There is one other matter I must resolve. In my first decision, I concluded that 3M should pay Mr Jevons £1200 as a contribution towards his costs up to the substantive hearing. However, I deferred making a formal award until I issued my final order so that I could take account of any additional costs that may arise.
- 5 In my subsequent decision on 15 May, I made clear the conclusion on costs in my first decision did not necessarily mean Mr Jevons would also get costs for subsequent

proceedings. Indeed I expressed concern about indications that he had not been as constructive and realistic as he should have been following the substantive hearing and about his persistence with the issue of the non-European patents until just before the hearing on 15 April. In their most recent submissions, 3M have emphasised these points, but they have also rightly pointed out that the substance of the order I am about to make closely reflects proposals on the form of order that they put to Mr Jevons on 13 November 2001, which they subsequently embodied in a formal draft on 4 December. Had Mr Jevons agreed to those proposals, none of the subsequent proceedings, including the hearing on 15 April, would have been necessary.

6 Against this background, I think it is right that Mr Jevons should be required to pay 3M a contribution towards their costs for the proceedings subsequent to the substantive hearing. 3M submitted that this contribution should cancel out the £1200, leaving no order as to costs. That might be right if I were applying the comptroller's current standard scale of costs, but as I pointed out in my first decision, because the present proceedings were commenced before 22 May 2000, it is the previous scale that applies. That scale points to a somewhat lower figure for the contribution 3M should receive, and I have decided the appropriate figure is £500. This, of course, must be offset against the £1200, leaving a net £700 to be paid to Mr Jevons by 3M.

7 Accordingly I order as follows:

ORDER

- 1 That it be declared that, under the law of England and Wales, Mr Oliver Jevons and Minnesota Mining and Manufacturing Company ("3M") are jointly entitled to International Patent Application PCT/US99/06438 (the "International Application"). Their inventive contributions, with reference to the claims of the application as they stand at present, were as follows:
 - (a) Mr Jevons and Mr Bouic of 3M were co-inventors of the inventive concept claimed in claims 1 and 4;
 - (b) Mr Bouic was the sole inventor of the inventive concept claimed in claim 3;
 - (c) Mr Jevons was the sole inventor of the inventive concept claimed in claim 5.
- 2 That the portion of the International Application designating the EP countries (the "EP Application") and any patent resulting from or granted pursuant to that application ("EP Patent") be owned jointly by Mr Jevons and 3M.
- 3 That each of the parties is deemed to have royalty-free licences under the EP Application and EP Patents and has the right to sub-license without consent of the other and without the need to account to the other and that these licences and rights extend to all the inventive concepts identified in paragraph 1 above.
- 4 That Mr Jevons assumes responsibility for the prosecution of the EP Application and pays the prosecution costs of such from the date of this Order through to

registration of any resulting EP Patents in the designated European states. Mr Jevons shall not be entitled to any contribution from 3M for these costs (which, for the avoidance of doubt, include the costs of registration and translation fees). 3M shall not be entitled to a contribution from Mr Jevons for the costs already incurred in prosecuting the EP Application and/or the International Application.

- 5 That both parties shall share the renewal costs of any resulting EP Patents. If either party fails to pay its share of the renewal costs of any resulting EP Patent then (without prejudice to any existing liabilities) 30 days after the unpaid renewal cost became due that party's rights and obligations in relation to that EP Patent under this Order (or otherwise) shall cease.
- 6 That there shall be no assignments of the parties' rights and interests in the EP Application and/or EP Patents to any third party without consent from the other party. Either party may assign its own rights and interests in the EP Application and/or EP Patents at any time to the other party without the need for consent. Without prejudice to any existing liabilities, the assigning party's rights and obligations in relation to the EP Application and/or EP Patents under this Order (or otherwise) shall cease from the date of such assignment.
- 7 That 3M pay Mr Jevons £700 as a contribution towards his costs.

I make no Order in relation to the other six individually designated countries of the International Application.

Appeal

- 8 As this decision is not a matter of procedure, any appeal to the Patents Court must be made within six weeks.

Dated this 17th day of July 2002

P HAYWARD

Divisional Director acting for the comptroller

THE PATENT OFFICE