

## **PATENTS ACT 1977**

IN THE MATTER OF a reference under section 12 by Philip Trevor Slack and an application under section 13 by Simon Philip Slack in respect of international application No PCT/GB00/02176 in the name of Joshua Charles Michael Haigh

### **FINAL DECISION**

#### **Introduction**

- 1 International application No PCT/GB00/02176 entitled “Inducing curls in fibres” was filed on 6 April 2000 in the name of Joshua Charles Michael Haigh (“the defendant”), who was also named as the sole inventor. The application claimed priority from three United Kingdom applications dated 10 July 1999, 18 January 2000 and 23 March 2000. It was published under No WO 01/04395 A1 on 18 January 2001.
- 2 The above reference under section 12 and application under section 13 were filed on 1 August 2001. In my interim decision of 20 September 2002 I found that, even though the proceedings were unopposed, the claimants had not clearly made out their case either on entitlement or on inventorship. However I gave them an opportunity to clarify a number of matters of fact, and on inventorship to make clear whether, despite the application form (Form 2/77) referring only to section 13(1) relief was also sought under section 13(3) in view of the allegation in the statement that the defendant ought not to be named as inventor.
- 3 In a letter dated 21 October 2002 the claimants gave further explanation about the facts of the case, asking for the late reply (one working day after the expiry of the four-week period that I had given the claimants) to be excused. The defendants made no comment, and their patent agent confirmed by telephone on 24 December 2002 that he had received no instructions from his clients. The Office wrote again to the parties on 22 January 2003 proposing to accept the claimants’ late reply, and noted that the claimants had made no response in respect of the relief sought under section 13. In their reply dated 24 January 2003 the claimants filed an amended application Form 2/77 making clear that they did indeed wish to proceed under both sections 13(1) and 13(3), some misunderstanding apparently having arisen about how this point was to be dealt with. The Office wrote to the parties on 21 February 2003 proposing to accept the amended Form, to treat the proceedings as unopposed and to issue a final decision on the papers on file.
- 4 In the absence of any further comments from the parties, I will therefore issue my final decision on the papers, taking into account the comments and the amended Form 2/77 filed by the claimants. The delay in dealing with this matter is due in part to an oversight by the Office and this is regretted.

## **The claimants' case**

- 5 In my interim decision I set out the salient facts of the claimants' case as they appeared to me. Whilst I do not need to repeat these in detail, it will be helpful to outline the main features, and to emphasise that they have not been opposed by the defendant.
- 6 The patent application in suit is concerned with inducing curls into spun synthetic fibres prepared by extruding filaments of the synthetic material from a spinneret, drawing them to the required denier, and chopping to the required length. The invention as claimed in claims 1 and 43 (the widest independent method and apparatus claims) requires that before taking lengths of fibre from the filaments, the filaments are caused to pass a heated member in order to induce a temperature differential across them. The heated filaments are under tension as they are pulled through the subsequent processing apparatus, and the release of tension on cutting into fibres causes the unheated portions to contract to produce the desired curl. Claims 18 and 26 further specify that the filaments may pass a further member that is cool relative to the heated member respectively after and before the filaments have passed the heated member.
- 7 The claimants allege that the invention arose out of the modification of a machine designated the "Autocrimp" embodying the invention of an earlier application, published as No WO 97/13898 in the names of SCS Consultancy Services as applicant and Philip Trevor Slack ("PTS") as inventor. The "Autocrimp" was developed by Extrusion Systems Limited ("ESL") as a result of a working arrangement with PTS (which did not materialise into a full licence agreement); Simon Philip Slack ("SPS") was a director of ESL. An "Autocrimp" machine supplied by ESL to a German firm, Teutofillfaser GmbH, under a contract dated 30 March 1996 did not perform to expectations, and was modified by a Mr Ken Pease at the request of ESL, the modifications being devised by SPS in 1996 or 1997 (paragraph 11 of the claimants' statement is ambiguous as to the year).
- 8 The claimants further allege that ESL went into receivership in 1998 and was wound up soon after, and PTS purchased all of the intellectual property remaining in ESL appertaining to "self crimping fibre" including any rights arising from work done by SPS. In the meantime however, the agent (Mr Paul Jansen) who had acted as negotiator in the contract between ESL and Teutofillfaser had passed the designs and know-how relating to the modified "Autocrimp" machine to the firm F Drake of Golcar Limited. F Drake had then included them in equipment that they manufactured, the defendant being a director of the firm at the time the patent application in suit was filed.
- 9 In my interim decision I invited the claimants to explain the following matters which were not clear to me:
- the assignment to PTS of the intellectual property rights in the "Autocrimp" system having been made not by Extrusion Services Limited but by an apparently different company Extrusion Systems (Leeds) Limited ("ES Leeds") as sole owners of the rights in question, what rights ES Leeds actually obtained from ESL;
  - whether ESL themselves actually obtained any rights in these modifications in the first place, since it was not clear in what capacity SPS was acting when he made them;

- because of ambiguities in the claimants' statement of case, what exactly SPS had invented, and whether Mr Pease made any inventive contribution.

### **The claimants' further explanation**

- 10 In their letter dated 21 October 2002, the claimants explain that SPS and Mr Pease were respectively employed by ESL as Technical Director and Engineering Manager, and that by virtue of their employment any invention made by them in their field of employment would automatically belong to ESL. SPS in his capacity of Technical Director "added to the Teutofillfaser machine a hot pipe (Plate) followed by a cold pipe (Plate) immediately after the existing cold pipe", and made sketches of how these were to be positioned on the machine. Mr Pease made no inventive contribution, his function being to dimension the parts and have them manufactured and fitted.
- 11 The claimants further explain that, upon ESL going into receivership shortly after the modification of the Teutofillfaser machine, the receivers accepted offers from PTS, who traded as SCS Consultancy Services, to buy "all the intellectual property remaining in ESL pertaining to 'self-crimping fibre' and any 'self-crimping fibre' machinery that had been built by ESL", and from a Mr Ian Drake (not connected with F Drake of Golcar Limited) for other of ESL's assets. However the receivers asked PTS and Mr Drake to come to an agreement whereby there would be only one purchaser of the assets being disposed of. The agreement reached was that Mr Drake would purchase all the assets, including the intellectual property rights which he would then re-sell to PTS trading as SCS Consultancy Services. For this purpose Mr Drake purchased a ready made company (Shinelogic Ltd) whose name he later changed to Extrusion Systems (Leeds) Limited; PTS and SCS Consultancy Services had no financial involvement in these companies but did rent office space from them. (I note that in the assignment constituting Appendix 8 of the claimants' statement ES Leeds assign to PTS and not to SCS Consultancy Services.)

### **Findings, declarations and orders**

- 12 It will be seen from the published application WO 01/04395 that the features said to be added by SPS correspond to the heated member of claims 1/43 and the *subsequent* cooling member of claim 18 (referenced in Figure 1 as 16 and 18 respectively). As I mentioned in my interim decision, the *preceding* cooling member of claim 26 (referenced 18A) was present in the unmodified "Autocrimp" machine. The claimants' further explanation thus removes an ambiguity in their statement in which paragraph 11 appeared to suggest that SPS had also contributed this feature.
- 13 Otherwise, the explanation does not contradict anything in the claimants' statement, particularly as regards the chain of events following ESL going into receivership. The defendants have not opposed this explanation, and I accept it. As a result I am satisfied on the balance of probabilities, first, that the invention of the application in suit was made by SPS and that no inventive contribution was made by the defendant; and, second, PTS is now entitled to the invention. I therefore find and declare that Simon Philip Slack and not Joshua Charles Michael Haigh is the inventor of the invention in the application in suit, and that Philip Trevor Slack and not Joshua Charles Michael Haigh is entitled to be granted a patent for that invention.

14 The relief which the claimants ask for is that the application should proceed in the name of PTS as sole applicant and that SPS should be named as the sole inventor. However, as I observed in my interim decision, the defendant's agent in his letter of 5 June 2002 states that to the best of his knowledge, the application "has not been implemented in any national or regional countries". As far as I am aware, in respect of the designation of the United Kingdom and the designation for a European patent, the application has not entered the national or regional phase, although it appears to have been given an application number 2000/0935407 on the register of the European Patent Office. In the absence of any further explanation or evidence as to the status of the application, I cannot be clear whether it has entered any national or regional phase under the Patent Cooperation Treaty.

15 If it has not, then since the period normally prescribed for this will by now have expired for most, if not all, designated national and regional phases, the international application will fall to be treated as withdrawn for those phases. I do not therefore think it appropriate to simply order the application to proceed as the claimants request.

16 As regards the United Kingdom, section 12(6)(c) of the Act prescribes that

"(c) where an international application for a patent (UK) is withdrawn, or the designation of the United Kingdom in the application is withdrawn, whether before or after the making of any reference under subsection (1) above but after publication of the application;

the comptroller may order that any person (other than the applicant) appearing to him to be entitled to be granted a patent under this Act may within the prescribed period make an application for such a patent for the whole or part of any matter comprised in the earlier application (subject, however, to section 76 below) and that if the application for a patent under this Act is filed, it shall be treated as having been filed on the date of filing the earlier application."

I therefore order that Philip Trevor Slack may within the period prescribed by rule 10 of the Patents Rules 1995, which states:

"The prescribed period for the purposes of sections 8(3) and 12(6) shall be three months calculated from the day on which the time for appealing from an order under either of those subsections expires without an appeal being brought or, where an appeal is brought, from the day on which it is finally disposed of",

make an application under section 12(6) for a United Kingdom patent for the invention of the application in suit, and that if such an application is made Simon Philip Slack shall have a right to be mentioned as inventor in any published application or patent granted thereon in accordance with section 13(1) of the Act.

17 As regards the European patent application 2000/093547 which arises from the international application, sections 12(3) and 82 of the Act give me the jurisdiction to determine the question of entitlement to the European patent. I therefore declare that for the purposes of Articles 60 and 61 of the European Patent Convention, Philip Trevor Slack, and not Joshua Charles Michael Haigh, has the right to the European patent.

- 18 I do not consider that any further relief under sections 12 or 13 of the Act is appropriate. What other action may be possible or appropriate in respect of designated states or regions other than the United Kingdom will depend on the confirmed status of the application there and the appropriate national or regional law. In the absence of any evidence on this, I decline to make an order under section 12 to give effect to my declaration above as regards proceedings in such designated states or regions. However, to the extent that the local or regional law allows, it is open to the claimants to put forward that declaration in any such proceedings, and if that does not suffice, it is open to them to request further directions from the comptroller.

### **Costs**

- 19 The claimants' request for costs is not opposed by the defendant, and I consider that they are entitled to costs in accordance with the comptroller's usual scale. I therefore order the defendant Joshua Charles Michael Haigh to pay the sum of £350 to the claimants Philip Trevor Slack and Simon Philip Slack. This should be paid within 7 days of the expiry of the appeal period, though the period for payment should be treated as stayed should an appeal be lodged.

### **Appeal**

- 20 Under rule 52.4 of the Civil Procedure Rules, the period for appeal is 14 days unless I direct a different period. I can see no reason to do so in the present case and accordingly any appeal must be lodged within 14 days. The lodging of an appeal will not of itself stay my order above under section 12(6), but it will be open to the parties to apply for a stay under rule 52.7(a) of the Civil Procedure Rules.

Dated this 16<sup>th</sup> day of April 2003

**R C KENNELL**

Deputy Director acting for the Comptroller

**THE PATENT OFFICE**