



BL O/123/05

3rd May 2005

PATENTS ACT 1977

PARTIES Mr Olaf Rock, Telectra Ltd, Alan Frank Parker,
 Donald Keri Rees and Ian Chisholm Hipkins

ISSUE Whether Alan Frank Parker should be mentioned as
 sole inventor in patent application number
 GB 0220042.6 as a result of an application under
 section 13(1) and 13(3)

HEARING OFFICER S M Williams

DECISION

- 1 Patent application number GB 0220042.6 filed on 29 August 2002 and published on 3 March 2004 as GB 2392488 names Ian Chisholm Hipkins as sole inventor.
- 2 The patent applicant's agent, Mr Olaf Rock, has applied to have Alan Frank Parker named as sole inventor in accordance with section 13(1) of the Act and has made an application under section 13(3) to the effect that Ian Chisholm Hipkins should not have been mentioned as an inventor.
- 3 Two statutory declarations headed 'Statement' and 'Witness Statement' have been filed in support of the application by Mr Rock and Mr Wisby, the Managing Director of Telectra Ltd, the patent applicant. Between them these documents set out the facts of the claimant's case and have been treated as a statement filed in accordance with rule 14(1) of the Patents Rules 1995, and evidence, respectively.

Background

- 4 In the statement, Mr Rock says that patent application number GB 0220042.6 was filed on 29 August 2002 on the instructions of Mr Ian Chisholm Hipkins who at the time was an Executive Director of Telectra Ltd. He states that he was informed about the details of the invention and related matters, such as the identity of the applicant and inventor, exclusively by Mr Hipkins and had no reason to question the information supplied. It was only after the filing of corresponding overseas applications and communications with Mr Wisby, the Managing Director of Telectra Ltd, that he was made aware that there was a problem associated with the inventorship details. He accordingly requests that the patent application be amended to show Alan Frank Parker as sole inventor.

- 5 In his witness statement dated 21 April 2004, Mr Wisby states that Mr Hipkins resigned from the company on 10 December 2002 and that since his departure it has been difficult to communicate with him. He confirms that, following discussion with Telectra Ltd's Board of Management of the Business, he instructed Mr Rock to file corresponding US and EP patent applications. He says that he noted that Mr Hipkins had been designated as inventor when he was reviewing the filing details of the overseas applications. He claims that this was the first time he was aware that Mr Hipkins had been named as inventor in the GB application and the subsequent US and EP patent applications. He raised the question of inventorship with those concerned with the development of the product the subject of the patent application and confirmed that Alan Frank Parker, the Design Director of Telectra Ltd, should be named as sole inventor. He goes on to say that he subsequently instructed Mr Rock to take steps to rectify the position and claims that the US and EP patent applications have been amended accordingly and designate Alan Frank Parker as inventor. He also requests that the GB patent application be corrected to show Alan Frank Parker as inventor in place of Ian Chisholm Hipkins.
- 6 The Office queried the relief sought in a letter dated 17 September 2004 since it was not clear that Alan Frank Parker was named as sole inventor in the US and EP patent applications. Following confirmation of the relief sought, and consent by Mr Parker to the application being filed, the Office wrote to Mr Hipkins on 18 October 2004, inviting him to file a counter-statement.
- 7 In his response dated 25 November 2004, Mr Hipkins states that he does not wish to contest the application to have his name removed as inventor and Mr Parker's named added. However he goes on to say that there are a significant number of erroneous claims and inferences included in the documents presented by Telectra Ltd. He states, for example, that Alan Frank Parker was not the sole inventor and refers to the development of the invention as a pooled effort shared between himself, Alan Frank Parker and Keri Rees, a project engineer; that Mr Wisby was fully informed and aware of all stages in the patent application process from the selection of a patent agent onwards and he received copies of all documents throughout; that at no time did he indicate that he was the 'sole' inventor, and that he left contact details with Telectra Ltd when he left the company.
- 8 In response to Mr Hipkins' claim that the development of the invention was a pooled effort, the Office wrote to Mr Rees and invited him to either confirm in writing that he consented to the application or file a counter-statement if he wished to oppose it. In a statutory declaration dated 15 April 2005, Mr Rees states that he has been involved in and responsible for the day to day development of the product the subject of patent application number GB 2392488; that it is his considered opinion that Alan Frank Parker should be named as sole inventor in respect of the application and that he consents to the section 13 application proceeding.

Conclusion

- 9 Although I appreciate that there are differences between Mr Rock's and Mr Wisby's version of events surrounding the GB patent application and that of Mr Hipkins, since Mr Hipkins does not wish to oppose the application filed under section 13, this is not something I have to consider further. Rather in the absence of a counter-statement from Mr Hipkins and given consent to the application from Mr Rees and Mr Parker, I conclude that all relevant parties agree that Alan Frank Parker should be named as sole inventor in the GB published patent application.
- 10 Accordingly I find that Alan Frank Parker should be mentioned as sole inventor in the published patent application and any patent granted for the invention. I also direct in accordance with rule 14(5) that an addendum slip be prepared for the published application; the slip will mention Alan Frank Parker as sole inventor and state that Ian Chisholm Hipkins should not have been named as inventor.
- 11 This decision also serves as a certificate, issued in accordance with section 13(3), to the effect that Ian Chisholm Hipkins should not have been named as an inventor in the published patent application for the invention.

S M WILLIAMS

B3 Head of Litigation Section, acting for the Comptroller