



BL O/246/05

9<sup>th</sup> September 2005

## PATENTS ACT 1977

BETWEEN

Jack Lorner

Claimant

and

June Elizabeth Jacobs

Respondent

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PROCEEDINGS

Reference under section 8 and application under section 13(3) of the  
Patents Act 1977 in respect of patent application GB 2401819 A

HEARING OFFICER

Stephen Probert

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## DECISION

### Introduction

- 1 Patent application GB 0311382.6 was filed on 17 May 2003 in the joint names of Mr Jack Lorner and Mr Brian Jacobs. The application form indicates that the joint applicants were also joint inventors of the portable woodworking bench that is the subject of the patent application.
- 2 Sadly, Mr Brian Jacobs died in December 2003, whereupon his rights in the application passed to his widow, Mrs June Jacobs. The patent application is therefore proceeding through the usual examination stages at the Patent Office in the joint names of Mrs June Jacobs and Mr Jack Lorner. The application was published on 24 November 2004 with the serial number GB 2401819A, listing the inventors as Brian Jacobs and Jack Lorner.

### Mr Lorner's statement

- 3 On 24 February 2005, Mr Lorner initiated the present proceedings under section 8 and section 13(3). Mr Lorner claims that he is the sole owner of the patent application (section 8), and the sole inventor of the invention that is the subject of the patent application (section 13(3)). These sections of the Act are well known, and for present purposes it will be sufficient if I simply outline their general provisions rather than reciting them in full.

4 Section 8 gives me the jurisdiction to determine entitlement to the patent application; that is, to decide who owns it. Section 13(3) gives me the jurisdiction to issue a certificate (and initiate the appropriate corrective actions in the Office) if I find that the wrong person has been named as an inventor. When considering who is entitled to be named as an inventor, I shall be guided by section 7(3) of the Act which defines “inventor” in the following terms:

(3) In this Act “inventor” in relation to an invention means the actual deviser of the invention and “joint inventor” shall be construed accordingly.

### **Mrs Jacob’s counter-statement**

5 In due course, Mrs Jacobs filed a counter-statement in which she contests both of Mr Lorner’s claims. However, her counter-statement admits certain key facts that are pleaded by Mr Lorner. For example, paragraph 4 of the counter-statement includes the following admission:

“Mr Jacobs immediately recognised the potential of the Invention when he saw it lying in Mr Lorner’s garage.”

6 Mrs Jacobs’ counter-statement goes on to explain that her late husband, a man with many years marketing experience, helped Mr Lorner to make his invention commercially viable. At paragraph 14, she admits that the portable woodworking bench was “invented, designed and built” by Mr Lorner alone, but adds:

“However, without the expertise of Mr Jacobs, the Invention would not have been commercially attractive to interest companies such as Black & Decker, and be capable of being conferred a patent right.”

7 After reading the statement and counter-statement in these proceedings, it was not clear to me what points were really in dispute between the parties. Before embarking on the formal evidence rounds, I directed the parties to attend a case management conference to clarify the issues, and to identify the matters on which evidence would be required.

### **Case Management Conference**

8 The case management conference was held on 14 June 2005. Mrs Jacobs and Mr Lorner attended in person, each accompanied by one or two friends and/or acquaintances. Mrs Jacobs was accompanied by Mr Keith Wallace. Mr Lorner was accompanied by Mr Dennis Bidwell and Mr Darbon. At the case management conference, it very soon became clear that these entire proceedings were being brought, and defended, on a misunderstanding of patent law. Both Mr Lorner and Mrs Jacobs were under the impression that a person could not be an inventor unless he or she was also an applicant (or joint applicant as in this case) and *vice versa*.

9 Mr Lorner explained that he had been prompted to bring these proceedings after he had seen Mr Brian Jacobs’ name (along with his own) listed as an inventor on the front

page of the published patent specification. Mr Lorner said that he was offended by this because he knew that he had invented the portable woodworking bench on his own. However, he was advised that in order to remove Mr Jacobs' name as an inventor, he would also have to remove his name (or that of his sole beneficiary) as a joint applicant.

- 10 It is not clear who advised Mr Lorner that joint applicants must also be joint inventors. Certainly it was bad advice, and it may have drawn the parties into an unnecessary dispute. There was a suggestion at the case management conference that the misleading advice might have come from a member of staff at the Patent Office — a possibility which, while regrettable, finds some support from the fact that Mrs Jacobs had been similarly advised, and had consequently been vigorously defending her late husband's position as an inventor.
- 11 I explained to Mrs Jacobs that, on the basis of the facts pleaded in the counter-statement, I could not see what possible defence she might have against Mr Lorner's claim to be the sole inventor. Consequently, I could not see any reason to encourage either party to file evidence in relation to the issue of ownership. Mrs Jacobs agreed.
- 12 When I then turned to Mr Lorner and asked him to explain the basis of his claim to be the sole owner of the patent application, he was adamant that he had never made (or intended to make) such a claim. He said that his only reason for bringing these proceedings was to remove Mr Jacob's name as an inventor (because he knew that to be manifestly untrue), and that he had only filed the reference under section 8 (entitlement) because of the incorrect advice he had been given — ie. that he could not be the sole inventor unless he was also the sole applicant.
- 13 Once the legal position was made clear, both Mr Lorner and Mrs Jacobs were satisfied that the application should continue in their joint names, but amended to show Mr Lorner as the sole inventor. At that point, having asked the parties to conclude the proceedings by confirming their agreement in writing, I closed the case management conference.
- 14 By 18 July 2005, the proceedings had not been formally concluded, so the Patent Office's Litigation Section wrote to the parties stating that the Hearing Officer proposed to:
  - a) strike out Mrs Jacobs' defence in the matter of inventorship (section 13(3)), and
  - b) strike out Mr Lorner's claim to sole ownership (section 8).
- 15 The letter gave the reasons for the proposed course of action, and noted that:

“This would not only give effect to the agreement that was reached between the parties at the case management conference on 14 June 2005, but it appears to be the only sensible outcome that can be reconciled with the law and the facts as pleaded in the statement and counterstatement.”
- 16 The parties were invited to request a formal hearing if either of them disagreed with this preliminary indication. Mrs Jacobs confirmed that she was content with the

proposal. Mr Lorner also responded, and although his letter included some additional historical information relating to the circumstances of this dispute, he did not disagree with the proposal in the official letter of 18 July 2005, and neither did he request a hearing.

- 17 Rule 3.4 of the Civil Procedure Rules gives the Comptroller power to strike out all or part of a statement of case if it appears that there are no reasonable grounds for bringing or defending the claim. In relation to the issue of inventorship (section 13), it is clear from Mrs Jacobs' counter-statement that she has no reasonable grounds for defending Mr Lorner's claim that he was the sole inventor. In fact, as soon as the original misunderstanding was cleared up, Mrs Jacobs readily agreed that Mr Lorner is the sole inventor.
- 18 In relation to the issue of ownership (section 8), it is not clear from Mr Lorner's statement that he has a reasonable ground for bringing the claim (ie. for sole ownership) since it became clear at the case management conference that the claim was based on the misunderstanding (shared by both parties) that inventorship and ownership were one and the same thing. Not only did Mr Lorner sign the original patent application form (Form 1/77) which clearly states that the application was being made jointly by himself and the late Mr Brian Jacobs, but he also stated clearly at the case management conference that it had never been his intention to deprive Mrs Jacobs of her late husband's rights in the application — he merely wanted to set the record straight regarding who had invented the portable woodworking bench.

### **ORDER**

- 19 As I have established that there is no prospect of Mrs Jacobs successfully defending the application under section 13(3), I hereby order that her defence to the application be struck out. Furthermore, and in consequence of the foregoing, I order that patent application GB 0311382.6, and the corresponding entry in the register of patents, be amended to show that Mr Lorner is the sole inventor.
- 20 Also, since I have concluded that there is no prospect of Mr Lorner succeeding with his claim for sole ownership under section 8, I hereby order that the reference be struck out.
- 21 As a result of this order;
- a) these proceedings are concluded;
  - b) patent application GB 0311382.6 shall proceed in the joint names of Mrs June Elizabeth Jacobs and Mr Jack Lorner, with Mr Jack Lorner recorded as the only inventor.

### **Costs**

- 22 I have not received (or sought) submissions from either party in relation to costs. I would expect the costs to be much lower than usual, since proceedings have not reached the evidence stages. It seems to me that neither party can claim to have won (or lost) in this case. I also bear in mind that these proceedings were brought on by a

misunderstanding shared equally (as far as I can tell) by both sides. In the circumstances I direct that the parties bear their own costs.

**Appeal**

- 23 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days of the receipt of this decision.

**S J PROBERT**

Deputy Director acting for the Comptroller