

## **PATENTS ACT 1977**

IN THE MATTER OF a reference under  
Section 12(1) by Edenlist Ltd in respect of  
US Patent Application No 08/090131 in the  
name of David Scott and Brian Scott

AND

IN THE MATTER OF a reference under  
Section 37(1) by David Scott and Brian  
Scott in respect of GB Patent No 2253948  
in the name of Edenlist Limited

## **DECISION**

1. US Patent Application No 08/090131 (now granted as US Patent No 5457464) and GB Patent No 2253948 relate to the same invention, but whereas the former stands in the name of the two inventors, David Scott and Brian Scott, the latter stands in the name of a company, Edenlist Limited. On 9 July 1997 I decided that Edenlist Limited ("Edenlist") were the rightful owners of both patents. I therefore ordered Edenlist to prepare a form of assignment for the US patent, which they duly did. It was sent to David and Brian Scott by Edenlist's agents, William Jones, attached to a letter dated 17 July 1997, and was also copied to the Patent Office.

2. I further ordered David and Brian Scott to execute the assignment within 14 days of its receipt, failing which Edenlist would be at liberty to come back to me for further directions. The Scott brothers did not execute the assignment, but instead sought legal aid to appeal my decision and asked for an extension of the period allowed for appeal to give time for the legal aid application process to be completed. Edenlist countered by seeking immediate directions in

respect of the execution of the assignment. In a further decision on 15 August 1997 I extended the appeal period and declined to give further directions in respect of the assignment for the time being. I said, though, that when the extended appeal period expired Edenlist would be at liberty to come back to me then for directions.

3. The extended appeal period expired on 28 November 1997. Shortly afterwards Edenlist wrote to the comptroller saying that no appeal had been lodged and asking again for directions in respect of the assignment. The Patent Office's own verbal enquiries of the High Court seemed to support Edenlist's contention that no appeal had been lodged, but to be quite sure the Office wrote to the Scott brothers on 9 December 1997 asking them to confirm within 14 days whether an appeal had been lodged, and if not, whether they had signed the assignment or intended to do so shortly. The letter made quite clear that if no response was received within the 14 days I would then give further directions.

4. The Scott brothers have not responded to the Office's letter of 9 December 1997. I feel I am fully entitled to construe their silence as confirmation that no appeal has been lodged and that they do not intend to comply with the order in my original decision that they execute the assignment of the US patent.

5. In my original decision, I stated that if the Scott brothers failed to execute the assignment I would be prepared to follow the course of action adopted in *Cannings' United States Application [1992] RPC 459*. In *Cannings* the Hearing Officer directed the unsuccessful party in a section 12 application in respect of a US patent application to sign an assignment within a specified time. When the unsuccessful party failed to sign, he then authorised the successful party to sign on his behalf, having first ascertained that the US Patent Office would recognise this as a valid assignment. I am satisfied that the time has come for me to give Edenlist an authorisation along these lines.

6. Accordingly I authorise Edenlist Limited to sign on behalf of David Scott and Brian Scott an assignment document in accordance with that attached to the letter dated 17 July 1997 sent to David and Brian Scott by William Jones.

7. As this decision relates to a matter of procedure, under the Rules of the Supreme Court any appeal must be lodged within 14 days.

Dated this 5th day of January 1998

**P HAYWARD**

Superintending Examiner, acting for the comptroller

**THE PATENT OFFICE**