

PATENTS ACT 1977

IN THE MATTER OF a reference under
Section 12(1)(a) by Denny Brothers
Printing Limited in respect of European
Patent Application No 95200285.5 in the
name of David John Instance

DECISION

1. European patent application No. 95200285.5, published under the number EP0650154, was filed in the name of David John Instance as proprietor and inventor. Under Section 12(1)(a) of the Patents Act 1977, Denny Brothers Printing Limited (hereinafter referred to as "the referrers") have referred to me the question whether they, and not Mr Instance, are entitled to the invention of this application and to be registered as the proprietors of any patent resulting therefrom.
2. The patent application is divided from European application no. EP0546047, which is part of a family of patents and patent applications derived from a GB patent application GB9019032.3. This family includes two GB patents, GB2247662 and GB2274268. They all relate to self-adhesive labels.
3. In 1995, David J Instance Ltd launched a High Court action, CH 1995 I No 3482, against the referrers alleging infringement of GB patent no. GB2274268. The referrers filed a counterclaim for revocation, amongst the grounds of which was non-entitlement under Section 72(1)(b) of the Patents Act 1977. In addition, the referrers launched a second action, CH 1995 D No 5843, for a declaration of entitlement.
4. The referrers then referred to the comptroller under sections 12 and 37 the question of entitlement in connection with British patent no. GB2247662 and two European applications from the same family, nos. 9195912.9 and 94200154.6, requesting at the same time that the comptroller should decline to deal with the references under sections 12(2) and 37(8). European application no. 9195912.9 was published as EP0546047, the parent of the application in suit.

5. In my oral decision of 24 July 1996, I declined to deal with those references, principally because the issues that would have been before the comptroller were very similar to those before the High Court, with a lot of overlap. I considered it was undesirable to have the same issues litigated in two different fora.

6. The referrers have asked me to decline to deal with the present reference too. The proprietors have been given the opportunity to comment on this request and have not responded, from which I deduce that they do not resist it.

7. It is immediately apparent that the present reference involves what are essentially the same issues, the same facts and the same pleadings as the previous references. The patent application in suit is, after all, merely a divisional from one of those involved in the previous references. Thus it seems to me that the grounds on which I declined to deal with the earlier references apply equally to the present one. Accordingly, under section 12(2) I decline to deal with the present reference under section 12(1)(a) in connection with European patent application no. 95200285.5.

8. The referrers may now, if they so wish, apply to the High Court within 28 days, under Order 104, rule 17 of the Rules of the Supreme Court, to determine the question.

9. As this decision is on a matter of procedure, under the Rules of the Supreme Court any appeal from this decision should be lodged within two weeks.

Dated this 27th day of November 1998

P HAYWARD

Superintending Examiner, acting for the comptroller

THE PATENT OFFICE