PATENTS ACT 1977

IN THE MATTER OF a reference under sections 8(1) and an application under section 13(1) by Raymond Lonsdale in relation to patent application number GB9806376.1 in the name of Kevin John Rutherford.

DECISION

1. The patent application in dispute, GB9806376.1, was filed on the 26th March 1998 by Mr Rutherford in his name alone. It relates to a child's swing safety seat. Mr Lonsdale initiated these proceedings on the 16th September 1998, supplying a detailed statement of how, according to him, the invention had been developed. Mr Lonsdale did not employ the services of a professional representative and it was not initially entirely clear what he was seeking. However he subsequently confirmed that he was making both a reference under section 8(1) and an application under section 13 to seek joint entitlement to the application with Mr Rutherford and also to be named as joint inventor, again with Mr Rutherford.

2. In response to this Mr Rutherford, who is also acting without a professional representative, wrote saying :

> "I am writing to confirm my acceptance to the design input from Raymond Lonsdale and subsequently the dual rights to the Patent application (Child Safety Swing Seat).
>
> Any further developments of the application will be by joint venture.
>
> This acceptance is under condition that any development costs accrued to the present date and any future development costs will be divided equally between myself and Mr Lonsdale."

3. Mr Lonsdale replied denying that any agreement to a joint venture had been reached. He said :

> "In his letter .... Mr Rutherford accepts my level of design input .... and subsequently my claim to dual rights to the .... application. He therefore cannot dispute my request to have my name added to the application as co-applicant and co-inventor. Any financial arrangements regarding this invention are a separate issue and have no bearing upon my rights as inventor and applicant."

He went on the say :

> "Up until the point of Mr Rutherford filing the application all costs incurred by the design, development, prototype and initiation of the Patent procedure had been divided equally ... . The moment Mr Rutherford filed the application naming himself as sole inventor and applicant he effectively ceased my involvement with the invention. I feel I cannot be expected to contribute to any expenditure incurred after the application."

4. The parties were unable to progress matters between them. In response to letters from the Patent Office asking the two parties to confirm that they did not wish to be heard and were content for a decision to be made on the papers on file, Mr Lonsdale indicated that he was content. Mr Rutherford wrote saying :

> "..... I reaffirm my acceptance to allow Mr Lonsdale to have joint application for the patent application ... .
>
> I will not be seeking to progress with the invention and no further patent protection will be sort (*sic*)."

Since he has not suggested he wishes to be heard, I am construing this as indicating that Mr Rutherford too is content for a decision on the papers.

5. I can deal with the question of inventorship very briefly. It is clear the two sides now agree that Mr Lonsdale was a joint inventor of the swing seat with Mr Rutherford, and indeed I am satisfied that this was so from the uncontested statement submitted by Mr Lonsdale. I shall make an order that both be named as inventors.

6. I will now turn to the question of entitlement. Section 7(2)(a) of the Act states that a patent for an invention may be granted primarily to the inventor or joint inventors. Subsections (b) and (c) which follow provide certain derogations from this by virtue of the law, an agreement or succession in title, but there is no suggestion any of these apply in the present case. Accordingly, it follows from section 7(2)(a) that Mr Lonsdale is jointly entitled with Mr Rutherford to be granted a patent in respect of this invention.

7. *Prima facie*, the obvious order I should make is that Mr Lonsdale be added to the application as co-applicant. I am, though, very aware that the relationship between Messrs Rutherford and Lonsdale has broken down and that Mr Rutherford says he no longer has any interest in the patent application. I realise, therefore there is a risk that this straightforward order may merely create more problems. I do have the power under section 8 to make a wide range of orders so as to meet the needs of any particular case. However, I do not feel that in the present circumstances I can use those powers to come up with a satisfactory solution to the breakdown in relationships. I have come to this conclusion in part because neither side has clearly asked me to resolve the problem of proceeding with the application and in part because I do not actually know quite what Mr Lonsdale wishes to do now. I shall therefore make the straightforward order.

8. If either party wishes to proceed with the application and they cannot agree between them on what basis this should be done, it is open to them to apply to the comptroller under section 10 of the Act, which reads:

> "If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the comptroller may, on a request made by any of the parties, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in

which it shall be proceeded with, or for both those purposes, according as the case may require."

However, embarking on litigation always involves time, money and stress, and it would therefore be far better, for both sides, to try and reach some reasonable compromise even if only one of them wishes to continue with the patent application. If they really cannot reach agreement, they should contact the Patent Office's Patent Litigation Section for information on how to proceed under section 10.

9. The patent application had been filed with a description of the invention, but without any claims, or an abstract or a Form 9/77 with its fee for a Preliminary Examination and Search. It is important for the parties to realise that one or other of them will need to file these by the 26th March 1999 if the application is to be continued, though this period can be extended by one month, or possibly more, on payment of fees. Since it is not clear to me whether Mr Lonsdale has got a copy of the patent specification in the form in which it was finally filed, I shall order that he be supplied with one.

Order

10. In conclusion therefore, I hereby order:

- that Raymond Lonsdale be added as a joint applicant with Kevin John Rutherford to patent application number GB9806376.1;

- that Kevin John Rutherford and Raymond Lonsdale be mentioned as joint inventors in any patent granted for the invention and in any published application for a patent for the invention;

- that Raymond Lonsdale be sent, by the Patent Office, a copy of the patent application as filed, together with a copy of the one Official Letter (with its enclosures) that has been issued in respect of the application.

11. Neither side has asked for an award of costs in respect of this action and accordingly I make no order for costs.

12. Under the Rules of the Supreme Court, any appeal against this decision must be lodged within six weeks.

Dated this 22nd day of February 1999

P HAYWARD
Divisional Director, acting for the comptroller

THE PATENT OFFICE