

PATENTS ACT 1977

IN THE MATTER OF

UK Patent Application No. 9808874.3

and a reference by Keahinuimakahahaikalani Howard Seymour
under Section 8(1)(a)

DECISION

Background

1. This is an ownership dispute under section 8 in respect of UK application number 9808874.3 which was filed on 27 April 1998 in the name of Coventry University as the proprietor. The application is concerned with an item of footwear suitable for sporting or recreational activities.

2. On 20 April 1999, Keahinuimakahahaikalani Howard Seymour (the referrer) filed a reference under section 8 on Form 2/77 with an accompanying statement. The Patent Office wrote to Coventry University (the opponent) on 29 April 1999 enclosing a copy of the reference and the statement and invited the opponent to file a counter-statement under rule 7(3) of the Patents Rules 1995.

3. On 29 June 1999, agents for the opponent informed the Patent Office that the opponent would not be filing a counter-statement in these proceedings. In response, the Patent Office in a letter dated 2 July 1999 drew the opponent's attention to the Office's practice in circumstances where no counter-statement is filed in an *inter partes* case by copying to them paragraph 72.09 of the Manual of Patent Practice and inviting them to file comments. No comments were received in response.

The law

4. In proceedings before the Comptroller, failure to file a counter-statement under rule 7(3)

will lead to an opponent's case being treated as undefended and the proprietor will forfeit the right to take further part in the proceedings. The application can then be considered by the Comptroller as if each specific fact set out in the statement were conceded unless it is contradicted by other documents available to the Comptroller.

The facts

5. The facts that I have to consider are alleged in the referrer's statement and I will consider them as stated.

6. Firstly, the statement alleges that Mr Seymour is the inventor of the invention covered in UK Patent Application No. 9808874.3. Since no Form 7/77 has been filed, even though it was requested by the Office in a letter dated 13 May 1998, no document has emerged to contradict the allegation.

7. Secondly, the statement alleges that Mr Seymour made the invention in 1993 as part of an A-level Design Technology Certificate and submitted details to the Examination Board. Again, no document contradicts the allegation. In fact, the documents submitted to the Examination Board (and filed on 7 May 1999) are dated October 1993.

8. Thirdly, the statement alleges that Mr Seymour included the invention as part of his course work while at Coventry University. However, the invention covered by the application in suit was fully developed prior to Mr Seymour's enrolment at the University as evidenced by the documents submitted to the Examination Board. No document has emerged to contradict these allegations.

9. Fourthly, the statement alleges that while the Student Regulations of Coventry University specify that intellectual property rights in respect of work forming part of a student's course work belong to the University, the invention covered by the application in suit was fully developed prior to enrolment of Mr Seymour at the University. Therefore, it is not covered by the Student Regulations. Again, no document has emerged to contradict these allegations.

10. Finally, the statement alleges that Mr Seymour has not assigned any rights in the invention covered by the patent application in suit to Coventry University. There is no record of any

assignment on the file of the patent application in suit.

Decision

11. As a consequence of not finding any document which contradicts any of the facts made in the referrer's statement, and in the absence of a counter-statement from the opponent, I determine that a ground for entitlement to UK Patent Application No. GB 9808874.3 has been made out by the referrer. I therefore order that the application shall proceed in the sole name of Keahinuimakahahaikalani Howard Seymour instead of the name of Coventry University.

Costs

12. The referrer also sought relief in the form of costs. I propose that the opponent pay £150 to the referrer. Such payment should be made by a deadline of seven days after the expiry of the appeal period, which is six weeks in this case.

Appeal

13. This being a decision on other than a procedural matter, the period for appeal is six weeks from the date of this decision.

Dated this 29th Day of June 2000

G M BRIDGES

Divisional Director, acting for the Comptroller

THE PATENT OFFICE