

PATENTS ACT 1977

IN THE MATTER OF patent application
GB 9700759.5 in the name of Carbury
Herne Limited

and

IN THE MATTER OF referrals under
sections 8 and 13 by James Richard Jackson

FINAL DECISION

1. This is a final decision in proceedings relating to a dispute over entitlement and inventorship of patent application GB 9700759.5. Although this application was irretrievably terminated before publication, it has served as the basis for a priority claim in an application under the Patent Co-operation Treaty (PCT/GB98/00136 - hereafter "the PCT") which has in turn given rise to national/regional phase applications. Carbury Herne Ltd (hereafter "CHL"), the registered applicants of GB 9700759.5 (hereafter "the UK application"), are a company in liquidation.

2. The parties came before me at a substantive hearing held on 17 February 2000 following which I issued an interim decision on 28 March 2000. The full background to the case is set out in that decision.

3. In my interim decision, I found that the applicant in these proceedings Mr Jackson had succeeded in his claim to be a joint inventor, and that in consequence he ought to have been regarded as a joint applicant of the UK application. However I found that no specific remedies were available to him in view of the application's unpublished and terminated status.

4. The reason for issuing an interim decision was to allow time for the parties to decide what to do next. In the course of the hearing Mr Jackson had indicated his intention to launch section 12 proceedings in respect of the PCT and related foreign applications should I find in his favour. In the light of this and of my findings, it was appropriate to allow the parties the opportunity to negotiate a settlement.

5. The foreshadowed section 12 proceedings were started by Mr Jackson on 7 April 2000.

6. In a letter sent by fax to the Office on 1 June 2000 Mr Jackson stated that the parties had agreed the text of a heads of agreement in which CHL *inter alia* acknowledge that they regard him (Jackson) as a joint inventor and applicant of the PCT. Mr Jackson also requested that I now issue a final decision in the present proceedings, addressing the first and second findings of fact set out in paragraph 68 of my interim decision, and requested that the issue of costs be deferred, to be dealt with in the context of the section 12 proceedings.

7. In response to an Official Letter dated 1 June 2000 to the receivers (Price Waterhouse Coopers), a letter dated 12 June 2000 was received from Messrs Edward Geldard (solicitors for the receivers), indicating that they were happy for a final decision to be issued and for the matter of costs to be deferred.

8. I thus understand that negotiations are under way which may result in a settlement of the action under section 12, but that in any case the parties are content for me to issue a final decision now terminating the present proceedings. Moreover, given the parties' agreement that the matter of the costs in the present proceedings can be dealt with in the context of the resolution of the section 12 proceedings, they do not wish me to make any order for costs here.

9. Accordingly, in terminating these proceedings, I make no order or finding other than to confirm the following findings of fact as set out in my interim decision referred to above:

(I) James Richard Jackson is a joint inventor of the subject matter of patent application GB9700759.5;

(II) Mr Jackson is to be regarded as a joint applicant of the said UK patent application.

10. This being a decision other than on a procedural matter, the period for appeal is six weeks.

Dated this 20th day of June 2000

G M BRIDGES
Divisional Director, acting for the Comptroller

THE PATENT OFFICE