

PATENTS ACT 1977

IN THE MATTER of patent applications
Nos. GB 2347098 and WO 01008809 in the
name of Air Pollution Abatement Limited
and
a reference under sections 8(1)(a) and
12(1)(a) by AEA Technology Plc

DECISION

- 1 UK patent application Number 9917929.3 was filed without priority on 31 July 1999. It named Michael Mulholland as inventor. Although originally filed in the name of Paul Robert Harrison as applicant, it then passed through a pair of assignment actions in March 2000 via Michael Mulholland to Air Pollution Abatement Limited as final proprietor. The application was subsequently published as GB 2347098 and provides the basis for a PCT application (subsequently published as WO 01008809).
- 2 A patents form 2/77 together with an accompanying statement was filed on the 3 January 2001 by Solicitors acting for AEA Technology Plc. The statement was accompanied by a letter requesting that the Comptroller should decline to deal with the entitlement questions raised.
- 3 The grounds given were that High Court proceedings had been commenced against both an ex-employee, Mr Mulholland, who is the named inventor of the patents at issue and also against his recently formed company, Air Pollution Abatement Limited, who is the named respondent in these proceedings. The grounds for the High Court action (number HC 0005788) are said to include questions of alleged breach of contract by Mr Mulholland involving the filing of the UK priority patent application and, thus, are said to be largely based on the same facts as would arise in this reference.
- 4 The proprietors submit, therefore, as there are High Court proceedings afoot which deal with the same facts as are raised in this application, the questions of entitlement would be more properly dealt with by the Court.
- 5 The proprietors' comments were sought in respect of this letter. Their Agent responded in a letter dated 26 February 2001 stating that "In view of the other litigation in progress between the parties, the proprietor does not intend to resist the application to transfer and does not have any comment to make on the subject at this time"
- 6 The Comptroller is always mindful that it would be both undesirable and wasteful for the same issue, in this case involving an alleged breach of contract by a former employee of the referrer, to be litigated both before herself and before the Court. The proprietor has indicated, moreover, that it does not contest the referrer's application for the question of entitlement to be heard as part of the High Court proceedings.
- 7 There is a slight complication in this case due to the fact that the UK specification was

itself very recently granted with effect from 30 January 2001 (with publication of grant appearing in the Patents and Designs Journal on 28 February 2001). However, Section 9 of the Patents Act 1977 allows for this circumstance in permitting the reference instead to be treated as one under Section 37.

8 Accordingly, as provided for under Sections 37(8) and 12(2), I decline to deal with the reference. In the circumstances, I make no order for costs.

9 As this is a procedural matter, any appeal against this decision must be lodged within 14 days.

Dated this 12th day of March 2001

G M BRIDGES

Divisional Director, acting for the Comptroller

THE PATENT OFFICE