

## **PATENTS ACT 1977**

IN THE MATTER OF a reference under  
Section 12(1)(a) by British Telecommunications  
Public Limited Company in respect of  
of US Patent Application No 08/652433,  
Canadian Patent Application No 2177488  
and divisional applications thereof

## **DECISION**

- 1 This decision relates to an uncontested reference to the Comptroller under section 12 of the Patents Act 1977 and concerns patent applications in the USA and Canada in respect of an invention made in the UK. The background was set out in the reference and supported by exhibits filed with the reference. As none of this has been contested, I accept it all as a true statement of the facts.
- 2 US Patent Application No 08/652,433 and Canadian Patent Application No 2,177,488 are national phase applications in the USA and Canada respectively corresponding to an international application, GB 94/02613, made under the Patent Co-operation Treaty (PCT) and claiming priority from a European Patent Application No EP93309544.0. The PCT application request named Nicolae Marius Busuioc, Bharat Purohit, Ian Barry Crabtree and Jacob Yadegar as inventors. It identified BT as the applicant except for the USA where, in accordance with US law, the inventors were named as applicants. A power of attorney was signed by Nicolae Marius Busuioc, Bharat Purohit, Ian Barry Crabtree and Erica Dutton permitting 14 members of the BT Group Legal Services Intellectual Property Unit, including Erica Dutton, to act in respect of the international patent application.
- 3 The UK Patent Office acting as a Receiving Office invited the correction of defects in the international patent application on 13 December 1994. One of the defects notified was that the international application had been signed by what appeared to be an agent/common representative, but the international application was not accompanied

by a power of attorney appointing him. Further defects were listed in respect of indications concerning Jacob Yadegar, including his address and nationality.

4 Dr Yadegar was first employed by BT in 1981. At times he was temporarily employed in a group led by Barry Crabtree. He worked with others on tasks which resulted in the invention described and claimed in international patent application number PCT/GB94/02613 and the corresponding US and Canadian national patent applications. He left BT on 23 April 1993, prior to the filing of European Patent Application No 93309544.0. BT have since had difficulty contacting him and hence on 16 March 1995, Dr Michael Evershed, then Head of Patents for BT, filed an Appointment of Agent form signed by himself on behalf of Jacob Yadegar.

5 Evidence has been filed to show that BT have made efforts to locate Dr Yadegar. However these have so far been unsuccessful. Hence BT filed the present reference under section 12(1)(a) asking the Comptroller to now authorise their Head of Intellectual Property, Simon Roberts, to sign on behalf of Jacob Yadegar three documents namely:

1. a declaration and power of attorney permitting the American firm of Nixon and Vanderhye to prosecute each of the US patent applications

2. an assignment of US rights to BT in respect of each of the US patent application(s), and

3. an assignment of Canadian rights to BT in respect of each of the Canadian patent application(s)

6 The reference was served on Dr Yadegar at the address provided in the PCT application on 22 May 2001, no other address being forthcoming. Dr Yadegar was allowed six weeks to file a counter-statement and advised that if he did not do so, the reference would be treated as uncontested. As a counter-statement has not been filed I will rely on the uncontested facts as set out in the statement in reaching a decision.

7 The unchallenged statement and the accompanying exhibits establish to my satisfaction

that Dr Yadegar was an employee of BT within the terms of section 43 and 130 of the Patents Act 1977 and that he made his contribution to the invention during the normal course of his duties as an employee of BT.

8 As such, I therefore find that under the provisions of section 39 of the Patents Act, BT is entitled to the invention in both the US and Canadian applications. I am satisfied that BT have made every effort to contact Dr Yadegar. I note that the Hearing Officer in *Cannings' United States Application [1992] RPC 459* authorised the referrer to sign an assignment on behalf of an uncooperative party, having established that an assignment signed in this way would be acceptable to the US Patent and Trademark Office for the purpose of establishing rights in the US. In the absence of evidence to the contrary, I shall assume that such an order would also be acceptable to the Canadian Patent Office.

9 Therefore I authorise Simon Roberts, the Head of Intellectual Property at BT, to sign on behalf of Dr Yadegar:

1. a declaration and power of attorney permitting the American firm of Nixon and Vanderhye to prosecute each of the US patent applications,
2. an assignment of US rights to BT in respect of each of the US patent application(s), and
3. an assignment of Canadian rights to BT in respect of each of the Canadian patent application(s)

in the form in which these documents were provided to this Office.

### **Costs**

10 Since a request for costs has not been made, I accordingly make no order for costs.

### **Appeal**

11 As this decision is not on a matter of procedure, the appeal period is six weeks commencing from the date of this decision.

Dated this 13<sup>th</sup> day of September 2001.

**MRS S WILLIAMS**

B3 Head of Litigation Section, acting for the Comptroller

**THE PATENT OFFICE**