

## **PATENTS ACT 1977**

IN THE MATTER OF a reference under section 8(1) by Marine Contractors Limited in respect of application No GB 0025707.1 in the name of Andre John Barnes

### **DECISION**

#### **Introduction**

- 1 Application No GB 0025707.1 entitled “A helmet protector” was filed through a patent agent on 20 October 2000, without any claim to priority, in the name of Andre John Barnes. Although the application included claims, no abstract was present and no request was made for preliminary examination and search. On 22 January 2001 the Patent Office wrote to Mr Barnes (who had written on 17 January 2001 to give a new address and to say that he was no longer using a patent agent) and explained that the abstract and request would need to be filed by 20 October 2001.
- 2 Nothing further was heard from Mr Barnes, but on 10 October 2001 the claimants Marine Contractors Limited (“MCL”) filed a reference under section 8(1)(a) of the Patents Act 1977 as to the entitlement to the application. The reference was accompanied by a statement setting out the facts on which MCL relied.
- 3 In accordance with rule 7(3) of the Patents Rules 1995, on 31 October 2001 the Patent Office invited Mr Barnes to file a counter-statement within six weeks, ie by 12 December 2001. That date having passed without any reply from Mr Barnes the Office wrote to him on 17 December 2001 proposing to treat the reference as unopposed. In response Mr Barnes promptly telephoned the Office to say that he had not received the letter of 31 October 2001. With the agreement of MCL, the Office wrote on 2 January 2002 allowing Mr Barnes a further six-week period, until 13 February 2002, to file a counter-statement.
- 4 In the absence of any reply, the Office wrote to both parties on 19 February 2002 again proposing to treat the reference as unopposed. The Office explained that Mr Barnes would in consequence be taken to admit the allegations made in MCL’s statement, and also that the application fell to be withdrawn as no request for preliminary examination and search had been filed within the period prescribed by the Patents Rules 1995. In the absence of any replies, the Office confirmed on 12 March 2002 that the reference was now treated as unopposed, and gave the option of a hearing or a decision on the papers on file, the latter course to be followed if no reply was received. MCL consented and Mr Barnes made no reply, and so I will decide the matter on the papers.

#### **The claimants’ case**

- 5 The salient features of the case put forward by MCL in their statement are:
  - they engaged Mr Barnes on 10 July 2000 to take charge of the technical development of

a diver's helmet shell;

- it was agreed that as part of his employment he would also develop the idea of a helmet protector which he claimed to have originated before being employed by MCL, and would assign any rights he had in this idea to MCL in return for a shareholding in a new company to be set up to exploit the idea;

- a formal assignment of the invention and of the right to apply for patent protection was prepared and executed;

- Mr Barnes filed the application having wrongly instructed the patent agents acting for MCL that it was temporarily to be filed in his own name; and

- he told the directors of MCL in November 2000 that this was a mistake which he would rectify; but

- in January 2001 on return from the Christmas holidays it was found that the premises occupied by Mr Barnes had been ransacked and that all documentation relating to the invention, including the assignment and the computer on which it was stored, were missing; Mr Barnes failed to return to work and has not been seen since.

6 MCL say that they are entitled to the invention by virtue of the assignment and their employment of Mr Barnes while the invention was developed.

### **Findings**

7 The above account is incomplete because of the absence of documentation to support MCL's claim to ownership. Nevertheless, I take this version of events to be accepted by both parties in view of the warning given to Mr Barnes by the Office about the inferences to be drawn from his silence, notwithstanding that his letter of 17 January 2001 would seem on the face of it to conflict with the assurance that MCL allege he gave to the directors in November 2000. In consequence I find that MCL, and not Mr Barnes, are entitled to application No GB 0025707.1 and to the invention as described and claimed in it.

8 However I should make clear that I make no finding and express no view concerning paragraph 9 of the statement, which reads:

“The police were informed and commenced investigations which have so far had no result. Although it is suspected that Mr Barnes was involved in the theft the police have found no evidence linking him with the crime and none of the property has been recovered.”

### **Relief**

9 MCL have asked for an order that the application proceed in their name, or such other relief as the comptroller deems suitable under sections 8(2) and (3) (which outline a number of specific orders which the comptroller may make). However, although the application has not yet been treated as withdrawn, it is due to be so treated for failure to file the abstract and the request for preliminary examination and search within the periods

prescribed by rules 25(1) and 25(2) respectively of the Patents Rules 1995. Although these periods can be extended - and I will deal with this later - I do not consider that I can give an order for the application to proceed as things stand at present.

- 10 Having considered all the powers available to the comptroller under section 8, I will therefore simply make a declaration that Marine Contractors Limited are solely entitled to application No GB 0025707.1, and to the invention described and claimed therein. This is in accordance with the general power given to the comptroller under section 8(1) to make such order as she thinks fit to give effect to her determination.
- 11 Both rules 25(1) and 25(2) can be extended at the discretion of the comptroller under rules 110(1) and 110(4) respectively of the Patents Rules 1995, the relevant parts of which read (with my added comment in italics):

“**110(1)** The times or periods prescribed by these rules for doing any act ... , and subject to paragraphs (3) and (4) below, may be extended by the comptroller if he thinks fit, upon such notice to the parties and upon such terms as he may direct; and such extension may be granted notwithstanding that the time or period for doing such act ... has expired.

**110(4)** Without prejudice to paragraph (3) above (*which allows a one month period as of right to extend the period in a number of rules including rule 25(2)*), a time or period prescribed in the rules referred to in that paragraph may, upon request made on Form 52/77, be extended or further extended if the comptroller thinks fit, whether or not the time or period (including any extension obtained under paragraph (3) above) has expired; and the comptroller may allow an extension, or further extension, under this paragraph on such terms as he may direct and subject, unless he otherwise directs, to the furnishing of a statutory declaration or affidavit verifying the grounds for the request.”

but I do not consider that I should exercise that discretion as part of this decision.

- 12 I therefore direct that, if MCL are not satisfied with the declaration above and want the application to proceed, they should make a request to extend the rule 25(2) period in accordance with the procedure in rule 110(4), furnish a statutory declaration or affidavit verifying the grounds for the request, and also request the discretion of the comptroller under rule 110(1) to extend the rule 25(1) period for filing of the abstract. The matter will then be given further consideration. MCL have a period of six weeks to do this, failing which the application will be treated as withdrawn.

### **Costs**

- 13 MCL have asked for costs. Having succeeded in establishing their entitlement, I consider that they are entitled to a contribution to their costs in accordance with the standard scale for proceedings before the comptroller. I therefore direct that Mr Barnes shall within 7 days of this decision pay to Marine Contractors Limited the sum of £350.

### **Appeal**

- 14 This is not a procedural matter and the period for appeal is therefore six weeks.

Dated this 25<sup>th</sup> day of April 2002

**R C KENNEL**

Deputy Director acting for the Comptroller

**THE PATENT OFFICE**