

PATENTS ACT 1977

IN THE MATTER OF a reference under section 12(1)(a) by British Telecommunications plc in respect of United States patent application 09/805377 in the name of Richard Wyatt, Robert Michael Percival and Raman Kashyap and Canadian patent application 2339345 in the name of British Telecommunications plc

DECISION

Introduction

1. This reference was filed on 15 February 2002 by British Telecommunications plc (hereafter referred to as BT or the claimant) and is concerned with entitlement to United States patent application 09/805377 (the US application) and Canadian patent application 2339345 (the Canadian application).
2. The reference was accompanied by a statement of case and by witness statements from three employees of BT's Intellectual Property Department, namely Ms Karen Thirwell, a European Patent Attorney, Mrs Bhavna Vasani, a formalities officer and Mr Chris Ruff, also a formalities officer. No counter-statement having been filed by Richard Wyatt, Robert Michael Percival and Raman Kashyap (the defendants), the reference stands unopposed.

Circumstances and relief sought

3. Since the reference is unopposed, I accept the facts of the case for the purposes of these proceedings as described in the statement and accompanying documents filed by the claimant. These facts may be summarised as follows.
4. In October 1999 the defendants made an invention concerning an optical communications system and a method of protecting an optical route. At that time the defendants were employed by BT as research staff in the Photonics Laboratory at BT's Research Laboratories. The Photonics Laboratory was sold to Corning Limited (hereafter Corning) in February 2000.
5. On 22 November 1999, Ms Thirwell and Messrs Percival and Wyatt met to discuss the invention and the question of inventorship, and Messrs Percival and Wyatt indicated that they together with Mr Kashyap were the inventors. Ms Thirwell subsequently drafted a patent application in consultation with Mr Percival; and European patent application number 00302423.9 (the priority application) was duly filed on 23 March 2000. This application served as priority for the US application, which was filed on 14 March 2001, for the Canadian application, which was filed on 5 March 2001, and for a European patent application number 01200802.5, which was also filed on 5 March 2001. In accordance with the law of the United States, the defendants, as

inventors, were named as applicants for the US application. The priority application was allowed to lapse.

6. In order to prosecute the US and Canadian applications, the claimant requested each of the defendants to sign three documents, namely a declaration and power of attorney permitting attorneys in a US firm, Nixon and Vanderhye, which is an associate of the claimant, to prosecute the US application before the United States Patent and Trademark Office, an assignment assigning the defendants' rights in the US application to BT, and an assignment assigning the defendants' rights in the Canadian application to BT. The request was addressed to the defendants at addresses supplied by the Patent and Licensing Department of Corning in a letter dated 12 February 2001. Corning stated in that letter that Mr Kashyap was no longer employed by them but in Canada by a company called Corvis Canada (hereafter Corvis), and provided a forwarding address at Corvis which had been left by Mr Kashyap himself. Mr Wyatt and Mr Percival duly signed the documents and returned them to the claimant in good time. Mr Kashyap has not complied with the claimant's request. Communications between the claimant and Mr Kashyap are described in more detail below.
7. The claimant sent letters on 6 April 2001 and 25 April 2001 to Mr Kashyap at the forwarding address at Corvis, requesting his signature on the relevant documents. In the absence of a response to either letter, Mrs Vasani for the claimant contacted Corvis by telephone in June 2001 and spoke to Mr Kashyap's secretary who confirmed receipt of the two letters, but recommended a different address for Mr Kashyap, again in Canada. On 20 August 2001, the claimant sent a third letter to the new address, but again received no response. Mrs Vasani spoke to Mr Kashyap's secretary on a number of occasions between June 2001 and October 2001, receiving repeated assurances but no signed documents. In early November 2001 Mrs Vasani spoke to Mr Kashyap himself, who said he would phone back after seeking advice, but did not. Finally on 28 November 2001, the claimant sent a fourth letter to Mr Kashyap referring to the correspondence and telephone calls described above, summarising the position under section 39 as interpreted by the claimant, noting that Mr Kashyap had signed similar documents in respect of numerous other inventions, and stating that if the signed documents were not returned as a matter of urgency, BT would seek entitlement before the UK Patent Office and an award of costs. Again there was no response.
8. The claimant argues that the invention arose in the course of the inventors' normal duties, that it was expected that inventions such as the one in question would result from those duties and that in consequence, in accordance with section 39(1)(a) which deals with the rights to employees' inventions, the invention belongs to BT.
9. The claimant seeks a declaration that the invention belongs to BT, an order authorising the head of BT's Intellectual Property Department to sign certain documents in order that the US and Canadian applications may be prosecuted, and costs.

The law and precedent

10. Entitlement to foreign patents is governed by section 12. The important part for these proceedings is section 12(1) which states:

12.-(1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made) -

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) [not relevant]

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

11. Sections 39 to 43 deal with inventions made by employees. The parts relevant to these proceedings are section 39(1) and section 43(2) and (3). Section 39(1) states:

39.-(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if -

(a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

12. The relevant parts of section 43 state:

(2) Sections 39 to 42 above shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say -

(a) he was mainly employed in the United Kingdom; or

(b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in the United Kingdom to which the employee was attached, whether or not he was also attached elsewhere.

(3) In sections 39 to 42 above and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to

his merely contributing advice or other assistance in the making of an invention by another employee.

13. No case law has been cited by the parties, however I am aware of *Cannings' United States Application* [1992] RPC 459 (hereafter *Cannings' Application*) which is concerned with proceedings under section 12 and which has a number of parallels with the present case. In *Cannings' Application*, an employee-inventor refused to execute an assignment of his rights in a US application, which had entered the national phase by the PCT route. The hearing officer concluded that, under section 39 and 43, the inventor's employer was entitled to the invention, and that the employer was therefore also entitled to the US application and to any patent granted thereon. The hearing officer considered the comptroller's power under section 12 and concluded that, although that power is limited by the particular foreign or international law under which an application was made, it was within the comptroller's broad powers under section 12(1) to order the inventor to execute any assignment necessary for the US application to proceed.
14. The hearing officer noted however that the comptroller had no power to enforce such an order in the event that the inventor refused to comply with it, and that in general in such circumstances the onus would lie on the aggrieved party to seek enforcement through the court. He went on to point out that an alternative approach was provided in section 8 which is concerned with entitlement to UK patents before grant. The relevant part is section 8(5) which states:

(5) If any person to whom directions have been given under subsection (2)(d) or (4) above [subsections which relate to orders transferring or granting licences or other rights in or under patent applications] fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the comptroller may, on application made to him by any person in whose favour or on whose reference the directions were given, authorise him to do that thing on behalf of the person to whom the directions were given.

15. The hearing officer concluded that section 8(5) establishes the principle that in appropriate circumstances the comptroller has powers, at least in relation to rights in UK applications, to bypass an uncooperative party by authorising an affected party to sign on his behalf, and that, although there is no corresponding provision in section 12, the generality of section 12(1) regarding orders that the comptroller may give, permitted the approach sanctioned by section 8(5) to be followed in respect of the US patent.

Conclusions and orders

16. I turn first to the position under sections 39 and 43. Since the statement of case is uncontested I do not need to look for support for the assertions made in that statement, though I note that the witness statements accompanying the statement support the claimant's case on all material points. On this basis then I find that the requirements of section 43(2) on the questions of domicile are satisfied, and that section 43(3) applies in that there are joint inventors. The terms of section 43 being satisfied, it follows that

section 39 applies.

17. Again having regard to the uncontested case put forward by the claimant, I find that the invention was made by the defendants whilst employed by the claimant, that it arose in the course of the inventors' normal duties, and that it was expected that inventions might reasonably be expected to result from those duties. In consequence, I find under the terms of section 39(1)(a) that the invention belongs to the claimant, that the claimant is therefore also entitled to the US and Canadian applications and to any patents granted thereon, subject to the requirements of the law of the United States and of Canada, and that the claimant is entitled to a declaration to that effect.
18. **I therefore hereby declare that the invention the subject of US Patent Application 09/805377 belongs to British Telecommunications plc and that the invention the subject of Canadian Patent Application 2339345 belongs to British Telecommunications plc.**
19. Having made that determination, it is necessary to consider what orders are appropriate to give effect to it. The claimant has requested an order authorising the head of its Intellectual Property Department to sign certain documents so that the US and Canadian applications may be prosecuted. I have sympathy with this request since there can be doubt that the claimant has made repeated and genuine efforts to obtain Mr Kashyap's signature. However I think that the right procedure to follow is first to direct Mr Kashyap to execute the documents in question. That this is within the comptroller's broad powers under section 12(1) is consistent with the decision in *Cannings' Application*. I should add that I have no reason to doubt from the uncontested evidence before me that the documents that the claimant seeks Mr Kashyap to sign are necessary for the prosecution of the US and Canadian applications.
20. **I therefore direct Raman Kashyap to execute the following documents and return them to the claimant within 14 days of the date of this decision, namely**
 - (i) **a declaration and power of attorney authorising Messrs Nixon and Vanderhye to prosecute US patent application 09/805377 before the United States Patent and Trademark Office,**
 - (ii) **an assignment of US rights to British Telecommunications plc in respect of US patent application 09/805377**
 - (iii) **an assignment of Canadian rights to British Telecommunications plc in respect of Canadian patent application 2339345.**
21. I should make it clear that since that Mr Kashyap has already received several copies of these documents to sign, I do not think that the claimant should be put to the trouble of providing Mr Kashyap with yet further copies, unless he so requests in good time.
22. I now turn to the question of how to proceed in the event that Mr Kashyap does not comply with this order. In the proceedings under section 12 in *Cannings' Application*, the approach sanctioned by section 8(5) was followed. I think it wholly appropriate given the circumstances to follow that approach here, that is to say to authorise the

documents in question to be signed on behalf of Mr Kashyap if Mr Kashyap does not sign them himself. I note that rule 11 sets out the procedure for applying for an authorisation under section 8(5) and includes a requirement for the claimant to provide a statement of the facts and the nature of the authorisation sought, and a requirement for the comptroller to send a copy of the application and statement to the defendant. However to all intents and purposes this procedure has already been followed in these proceedings, Mr Kashyap having received full details of what facts the claimant wishes to rely on and the authorisation sought. In consequence I do not think it necessary to go through those stages here before making an order.

23. **Therefore, in the event that Raman Kashyap does not wholly comply with the above direction to execute the said documents and return them to the claimant within 14 days of the date of this decision, I authorise the head of the Intellectual Property Department of British Telecommunications plc to execute the said documents on behalf of Raman Kashyap.**

Costs

24. The claimant seeks an award of costs which is not contested. However, since Messrs Wyatt and Percival on their part have fully complied with the claimant's requests, it would clearly be inappropriate to make any award against them. Mr Kashyap on the other hand has put the claimant to considerable trouble and inconvenience, making no attempt whatsoever to resolve the issue. I therefore think it appropriate to make an award against him. Guided by the current scale, I award the claimant the sum of £650 as a contribution to its costs in filing this reference and the accompanying statement and in preparing and filing its evidence.
25. **I therefore direct that Raman Kashyap shall pay British Telecommunications plc the sum of £650 as a contribution to its costs. The payment shall be made within seven days of the expiry of the appeal period unless an appeal is lodged, in which case payment may be suspended pending the appeal.**

Appeal

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

Dated this 17th day of July 2002

D J BARFORD
Deputy Director, acting for the Comptroller

THE PATENT OFFICE