

## **PATENTS ACT 1977**

IN THE MATTER OF references  
under sections 8, 12 and 13 by  
Dr Helena M Windsor in respect of patent  
application GB 0017073.8 and international  
patent application PCT/GB01/03128  
in the name of University College London

## **DECISION**

### **Introduction**

1. These references were filed on 18 October 2001 by Dr Helena M Windsor (the claimant) and are concerned with entitlement to and inventorship of patent application GB 0017073.8 (the UK application) and international patent application PCT/GB01/03128 (the international application). The UK application was filed in the name of University College London (the defendant) on 11 July 2000 and terminated before publication. The international application claims priority from the UK application, but has not been published. As I understand it the international application is still pending, although the defendant has indicated that it does not intend to continue with the prosecution.
2. The references were accompanied by a statement of case, a slightly amended statement being filed on 20 December 2001. Under the terms of rule 7(2), the statement was copied to the defendant, to Mycoplasma Experience Limited (hereafter Mycoplasma Experience), a company of which Dr Helena Windsor is a director, and to Dr ADB Webster, of the Department of Clinical Immunology, Royal Free Hospital (part of University College London), who is named as inventor in the international application. The defendant has stated that it does not intend to file a counterstatement, no reply has been received on behalf of Mycoplasma Experience, and Dr Webster has indicated that he does not intend to oppose the relief sought by the claimant. The references therefore stand unopposed.

### **Circumstances**

3. The facts of the case, as described in the statement filed by the claimant, may be summarised as follows.
4. The claimant and her husband, Dr DG Windsor, are co-directors of Mycoplasma Experience, a company registered in the UK in 1988. The company works with mycoplasma species and closely related organisms. Mycoplasmas are free-living micro-organisms which, unlike bacteria, lack cell walls. They are important to the biotechnology industry as cell-culture contaminants. Some time prior to January 1999, the company agreed to attempt to isolate mycoplasmas from sputum samples provided by Dr Webster. There was a charge for the service and over fifty samples were tested, although there was no formal contract. On 8 February 1999 a specimen was received (identified as MEHT A39) and cultured. Mycoplasma-like colonial growth was

detected by Dr Helena Windsor and reported to Dr Webster on 25 March 1999. A culture was sent to the Central Public Health Laboratory at Colindale, which reported that the organism was a novel species. A39 strains were also grown from three more of the samples. In July 2000 the defendant filed the UK patent application, followed in July 2001 by the international application which claimed priority from the UK application. The applications are concerned with mycoplasma spp A39 and related subject matter.

5. Correspondence between the parties concerning entitlement in and inventorship of the patent applications culminated in letters dated 13 and 14 September 2001 from the defendant, the first offering to consider assigning the international application to the claimant “for reasonable terms” (quantified as a substantial sum in a subsequent email), and the second enclosing a copy of the specification of the international application on a confidential basis for the purpose of establishing whether to proceed with negotiations. However in the event the parties were unable to conclude an agreement and the claimant has filed these references.

### **The law**

6. The question of entitlement to the UK application is governed by section 8, the relevant parts of which state:

*8.-(1) At any time before a patent has been granted for an invention (whether or not an application has been made for it) -*

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

*(b) [not relevant]*

*and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.*

*(2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below -*

*(a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;*

*(b) [not relevant];*

*(c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred;*

*(d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.*

*(3) Where a question is referred to the comptroller under subsection (1)(a) above and -*

*(a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;*

*(b) any such application is refused under subsection 2(c) above before the comptroller has disposed of the reference (whether the reference was made before or after the publication of the application); or*

*(c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference, but after the publication of the application;*

*the comptroller may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 76 below, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.*

7. The question of entitlement to the international application 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.*

8. The claimant has also made an application under section 13(1). This deals with the right to be named as inventor and states:

*13.- (1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.*

### **Conclusions**

9. Since the reference is unopposed, I accept the facts of the case for the purposes of these proceedings as described in the statement filed by the claimant, and I accept that the relief sought should be given, to the extent that such relief is available to the claimant under the law.
10. The relief sought by the claimant may be summarised as follows:
- (i) an order that the UK and/or the international application proceed in the name (or jointly in the name) of Dr Helena Windsor and/or Mycoplasma Experience
  - (ii) if either application is deemed withdrawn or is refused, an order to reinstate it so that the claimant and/or Mycoplasma Experience may pursue prosecution thereof
  - (iii) if relief under (i) and (ii) is not available, an order under section 8(3) allowing the claimant to file a new application.
11. On the general question as to whether any relief should be granted to Dr Helena Windsor alone, or to Mycoplasma Experience alone, or to both parties jointly, I note that no response to these references has been made by Mycoplasma Experience. From this I conclude that it has no objection to any relief being granted solely to the claimant, and that is the course that I therefore intend to follow.
12. I turn first to the UK application and the relief available under section 8. This application was taken to be withdrawn under section 15(5) through failure to request preliminary examination and search. In view of this, the relief requested in (i) above, which is a request for an order under section 8(2), is not available. Moreover since the application was terminated before publication, the relief requested in (ii) and (iii) above, that is to say a request for an order under section 8(3), is also not available.
13. The question then arises as to what relief is available under section 8. I am aware of *Szucs' Application* (SRIS O/4/86) which deals with an application which, as in the present case, was treated as withdrawn under section 15(5) before publication. It was held in that case that the claimant was entitled under section 8(1) to a declaration that certain matter was its property, and it seems to me that a similar declaration would be appropriate here.
14. I turn next to the international application and the relief available under section 12. The

comptroller has broad powers under section 12(1), and having regard to the relief requested in (i) above, it seems to me appropriate to make a simple declaration as to inventorship and entitlement that the claimant may use in support of any request she wishes to make to the International Bureau on this matter (or indeed to any national and/or regional authority in respect of any national and/or regional phase application(s) that the international application matures into).

15. Finally regarding the request under section 13(1), since no patent has been granted or application published in respect of the UK application, or for that matter the international application, no remedy would appear to lie under this section.

### **Order**

16. Taking account of my findings above, I hereby declare that the claimant, Dr Helena M Windsor, is inventor of and is entitled to the invention the subject of patent application GB 0017073.8.
17. I also hereby declare that the claimant, Dr Helena M Windsor, is inventor of and is entitled to the invention the subject of international patent application PCT/GB01/03128. This declaration may be used in support of any request to the International Bureau to amend ownership and/or inventorship details in respect of that application and/or to any national and/or regional authority for the same purpose in respect of any national and/or regional phase application(s) that the international application matures into.

### **Costs**

18. In her statement the claimant asks for costs; a request which stands unopposed. Guided by the published scale of costs in proceedings before the comptroller, I award the claimant the sum of £350 in respect of her costs in filing these references and the accompanying statement. I therefore direct that the defendant shall pay the claimant the sum of £350 as a contribution to her costs, and that 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**

19. 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 19<sup>th</sup> day of August 2002

D J BARFORD  
Deputy Director, acting for the Comptroller

**THE PATENT OFFICE**