



BL O/142/06

8 June 2006

PATENTS ACT 1977

BETWEEN

Ernest Ogden

Claimant

and

John McKenzie and
Projectile Ltd

Defendants

PROCEEDINGS

References under sections 12, 13 and 37 in respect of
patent number GB 2378382 and international patent
application number PCT/GB 2003/000293

D J Barford

DECISION

Introduction

- 1 Patent application number GB0119378.8 (“the application in suit”) was filed on 9 August 2001 claiming no earlier priority. It was published on 12 February 2003 and granted on 19 November 2003 as GB 2378382 (“the patent”). The GB application was made in the names of Mr Ogden, Mr McKenzie and Projectile Limited (“Projectile”), naming Messrs Ogden and McKenzie as inventors.
- 2 These proceedings were launched by Mr Ogden on 1 December 2003 by way of a reference under sections 13 and 37. In his statement Mr Ogden claims that he is the sole inventor and that he should have sole proprietorship of the patent. In his counterstatement Mr McKenzie claims that he is the sole inventor, and that proprietorship should be equally divided between himself, Mr Ogden and Projectile.
- 3 International patent application number PCT/GB 2003/000293 (“the PCT application”) was filed on 17 January 2003 claiming no earlier priority. It was published as WO 2004/065892 on 5 August 2004. As with the GB application,

the PCT application was made in the names of Mr Ogden, Mr McKenzie and Projectile, naming Messrs Ogden and McKenzie as inventors.

- 4 There was a preliminary dispute as to whether or not the reference should be amended, at Mr Ogden's request, to include the PCT application under section 12. In a preliminary decision dated 1 August 2005, I allowed the request. Also in that decision I allowed both parties to file further evidence outside the normal evidence rounds.
- 5 At issue then are the questions of who invented and who is entitled to the patent and to the PCT application.
- 6 These matters came before me at a hearing on 16th March 2006 at which both litigants appeared in person.

The law

- 7 Relevant to the dispute are sections 7, 12, 13, 36 and 37. These read:

Section 7

7.- (1) Any person may make an application for a patent either alone or jointly with another.

(2) A patent for an invention may be granted -

(a) primarily to the inventor or joint inventors;

(b) In preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;

(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned; and to no other person.

(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.

(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

Section 12

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) any of two or more co-proprietors of an application for such a patent for that invention may so refer the question whether any right in under the application should be transferred or granted to any other person;

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.

(2)

Section 13

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.

(2) ..

(3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.

Section 36

36.-(1) Where a patent is granted to two or more persons, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.

(2) Where two or more persons are proprietors of a patent, then, subject to the provisions of this section and subject to any agreement to the contrary -

(a) each of them shall be entitled, by himself or his agents, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would apart from this subsection and section 55 below, amount to an infringement of the patent concerned; and

(b) any such act shall not amount to an infringement of the patent concerned.

(3) Subject to the provisions of sections 8 and 12 above and section 37 below and to any agreement for the time being in force, where two or more persons are proprietors of a patent one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent or in Scotland cause or permit security to be granted over it.

(4) Subject to the provisions of those sections, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.

(5) *Where a patented product is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.*

(6) *Nothing in subsection (1) or (2) above shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.*

(7) *The foregoing provisions of this section shall have effect in relation to an application for a patent which is filed as they have effect in relation to a patent and -*

(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and

(b) the reference in subsection (5) above to a patented product shall be construed accordingly.

Section 37

37.-(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question -

(a) who is or are the true proprietor or proprietors of the patent,

(b) whether the patent should have been granted to the person or persons to whom it was granted, or

(c) whether any right in or under the patent should be transferred or granted to any other person or persons;

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

(2) ..

The patent and the PCT application

8 The patent is entitled "Blast attenuating, blast-directing and extinguishing apparatus".

9 Claim 1 is the only independent claim and at grant reads:

A blast attenuating, blast-directing and extinguishing apparatus, comprising of an open mouthed inner container housed within an open mouthed partially spherical outer container with a cavity defined between the two containers containing a fluid with extinguishing capabilities such as water, the wall of the outer and inner containers being joined by a member having a number of apertures adjacent the mouth of the inner container.

10 The invention finds particular application in dealing with the problem of terrorist bombs placed in litter bins, and to this end the inner container may be used to

receive a bin. In the event of an explosion, the inner container will deform, forcing jets of fluid and debris through the apertures in the member joining the inner and outer containers rather than radially outwards, and dispersing energy from the blast. The apparatus may be made of plastics, fiberglass or metal. The fluid may be water.

11 The PCT application is identical in wording to the patent at grant.

Chronology

12 The following does not appear to be in dispute.

13 Following an incident in Warrington in which two children were killed by a bomb planted in a litter bin, Mr Ogden developed the idea of a bomb proof bin, and a freelance patent agent Ms Arlene Hall assisted him in drafting and filing a patent application (which was subsequently terminated) to protect the idea.

14 This application, number GB9828516.6 (“the terminated application”) entitled “Apparatus and method relating to blast attenuating, blast-directing and extinguishing assembly” was filed on 23 December 1998 by Mr Ogden naming himself as sole inventor and claiming no earlier priority. Due to lack funds Mr Ogden was not in a position to progress the application. No request for preliminary examination and search was made and the earlier application was terminated before publication on 28 February 2000.

15 Mr Ogden subsequently contacted Mr McKenzie for assistance. Mr McKenzie proposed – and Mr Ogden agreed - that the two of them take things forward together on a joint ownership basis with Mr Ogden providing the technical input and Mr McKenzie the administrative input and the finance.

16 Mr McKenzie proposed using a company called Projectile, which Mr Ogden understood to have the two of them as directors, to take the project forward.

17 Applications GB0119378.8 and PCT/GB 2003/000293 were then filed as described above, and the two men cooperated in taking steps to obtain support for the invention, all paid for by Mr McKenzie as agreed. These included meetings with Qinetiq on possible military applications, and a successful demonstration to the Home Office using high explosive.

18 However the relationship subsequently showed signs of strain and the parties agreed to put their agreement in writing through solicitors.

19 Mr Ogden states that when his solicitor, Mr Laurence Pritchard, checked the records of Companies House, he found that Mr Ogden was not in fact named as a director of Projectile. Mr Pritchard, in a letter dated 10 September 2003, wrote to Mr McKenzie pointing this out, and stating that “in order to formalise the arrangements agreed between you [Mr McKenzie] and my client relating to this matter, there needs to be put in place a formal agreement”. Mr Pritchard went on to propose, amongst other things, that the patent should be exploited

only through Projectile, which would be owned in equal shares by the two parties, and that Mr Ogden would be made a director.

20 In a letter dated 1 October 2003, Mr McKenzie's solicitor, Mr Nik White, responded that "I confirm that my client is in principle willing to accept your proposal in broad terms subject to the following comments". Mr White went on to list a number of points, including references to other inventions which he did not describe in detail and which are not in any case the subject of the present dispute. One point which is of relevance to this dispute however is Mr White's proposal that "Both clients will be individually responsible for their own sphere of influence within the company ie Mr McKenzie – Management and Mr Ogden-Technical, as both parties had agreed from inception. Areas such as Policy and Finance will be the responsibility of both clients."

21 However in the event no agreement was signed and at this point the parties' accounts differ. Mr Ogden describes his surprise on learning that he was not named as a director of Projectile. Mr McKenzie however states that Mr Ogden was well aware that he was not named as a director of Projectile, and in fact wanted things that way since he was going through divorce proceedings and did not want any income from the project to be open to a claim from his wife. Mr McKenzie states that Projectile was a dormant company set up several months before he and Mr Ogden started to work together, and was used primarily to give a professional edge when dealing with potential customers.

22 In the event, Mr Ogden initiated these proceedings.

Inventorship

23 Section 7 quoted above states that "inventor" in relation to an invention means "the actual deviser of the invention".

24 Mr McKenzie argues that he contributed to the invention on two counts – firstly through his negotiations with the Patent Office examiner and changes he made to the application in suit which resulted in an application that would have been refused being granted; and secondly through certain development work he has carried out on the invention.

25 It seems to me that McKenzie's first argument must inevitably fail. However skilfully he redrafted his claims and amended his description during prosecution of the application in suit, and however much time and effort he put into this, he can have done no more than re-work material that was present in its entirety when the application was filed. There was no devising going on here as required by section 7, only re-drafting. It is of course conceivable that, contrary to patent law, he introduced additional matter during prosecution of the application before the Patent Office. However he has not pointed me to any such matter and indeed inspection of the relevant documents indicates that there is none.

26 I turn then to Mr McKenzie's second argument, that he contributed to the

development of the invention. He states that he recognised that the invention had wider application than containing the explosions in litter bins eg it could be used for military purposes such as containing explosions from detonated mines. He also describes technical work he carried out on the invention, including changing the position of the apertures in the member joining the inner and outer containers, altering the shape at the top of the structure and using fluids other than water. He states that he contacted the Patent Office regarding these changes and was reassured that they were covered by the application as it stood. He also states that the Home Office trial was unsuccessful when water was used as the fluid and only worked when it was replaced by a slag material.

- 27 There is no dispute that Mr Ogden is the sole inventor of the terminated application. What then is to be found in the patent which is not in the terminated application? The two are clearly very similar – the descriptions are practically identical and the figures are wholly identical. (I note that there are two figures in the application in suit – figures 6 and 7 - which are not in the terminated application and which in fact are also absent from the patent itself. However they appear to show little more than three dimensional views of what is shown in figure 1; and the point was not in any case raised as an issue by Mr McKenzie).
- 28 At the hearing I asked Mr McKenzie to point out any material differences between the patent and the terminated application and he referred me to a passage on page 3 of the patent which states “The inner spherical nature of the device is the fundamental item, which reduces and directs the force of the blast and the debris in a desired direction”. This wording is not to be found in the terminated application, but neither is it to be found in the application in suit. Unless this passage is introducing new matter, contrary to patent law, it can only describe what is already there, and indeed to the extent that I understand its meaning, it appears to be referring to the shape of the outer container. This is clearly shown as spherical in the drawings of the terminated application, and indeed the terminated application at page 2 also refers to “a hollow sphere”.
- 29 One difference is that the terminated application has no claims but the patent does. However the terminated application does have a paragraph on page 2 which sets out the inventive concept. This reads:
- In accordance with the present invention, a blast attenuating, blast-directing and extinguishing assembly comprises a housing for containing fluid or other material having an inner wall and an outer wall structure having one or a plurality of apertures such that force from a blast applied to the inner wall causes an increase pressure in said housing, the rise in fluid pressure causing displacement of fluid and/or material through said apertures. Energy from the blast is thus transformed to energy expended in displacement of the fluid from the housing.
- 30 This clearly bears a close relationship to claim 1 of the patent, and in my view wholly supports the conclusion that both relate to the same invention. For

completeness I note that there is no subject matter in the claims which is not in the description.

- 31 Having regard to the above I conclude that there is no material difference between the invention of the terminated application and that of the patent.
- 32 I understood Mr Ogden not to dispute that Mr McKenzie has introduced some developments to the invention, however none of these is mentioned in the patent; and it is the invention of the patent to which these proceedings relate.
- 33 I have concluded that the invention of the patent is the same as that of the terminated application. Since there is no dispute that Mr Ogden is the sole inventor of the terminated application, it follows that he is the sole inventor of the patent. The patent and the PCT application being identical, it also follows that Mr Ogden is the sole inventor of the PCT application.

Entitlement

- 34 There is no dispute that Messrs Ogden and McKenzie embarked upon this project concerning the invention of the patent and the PCT application on the basis that they would share ownership equally, with Mr Ogden providing the technical input and Mr McKenzie the administrative input and the finance. At the hearing both confirmed that this was the case. It is this agreement which clearly underlies the exchange of solicitors' letters referred to above (although Mr White proposes a somewhat different division of responsibilities). I conclude therefore that there was a contract between Messrs Ogden and McKenzie, albeit an oral one, under which there was a clear understanding that the patent rights were to be shared.
- 35 This exchange of solicitors' letters, in which the parties agreed to formalise their agreement using Projectile as the vehicle, did not however come to fruition. In order to make a contract there must be a clear offer by one party and a clear and unconditional acceptance by the other and here we have an offer but no unconditional acceptance. Accordingly I conclude that Projectile has no contractual entitlement to a share in the patent rights.
- 36 In the light of these conclusions, I find that Messrs Ogden and McKenzie are jointly entitled to the patent and the PCT application, but that no rights fall to Projectile.
- 37 For completeness, I note that the issues as to how long the parties have known each other, what their technical expertise is, and why Mr Ogden was not made a director of Projectile – questions on which the parties' have strongly held and conflicting views – are not material to the above conclusions on inventorship and entitlement, and I need make no decision on them.

Declaration and order

The patent

- 38 Having regard to my findings above, I hereby declare under section 37 that Mr Ernest Ogden and Mr John McKenzie are jointly entitled to patent number GB 2378382 and were so entitled when the patent was granted; and that Mr Ogden was the sole inventor.
- 39 Accordingly, I direct under section 13 that an addendum for the granted patent be prepared and the register amended to reflect my findings on inventorship.
- 40 As to entitlement, to give effect to the above declaration I could simply direct that the patent proceed in the names of Messrs Ogden and McKenzie as proprietors and that the register be amended accordingly. The terms of section 36 quoted above apply to the co-ownership of UK patents, and in the absence of any agreement to the contrary, Mr Ogden and Mr McKenzie would each have an equal share in the patent and could work it however he pleased without the consent of the other – but consent would be necessary if either wished to licence, assign or mortgage a share in the patent.
- 41 However, it seems to me that before making any order, I should give the parties the opportunity to negotiate an agreement, or at least to make submissions on the form of order I should make – something on which they might be well advised to seek professional advice. Accordingly I allow Messrs Ogden and McKenzie two months from the date of this decision in which to make submissions to this end if they so wish, hopefully in the form of an agreed joint submission. I should add that this should not be taken by either party as an opportunity to put in submissions on any other issue.
- 42 If there are no submissions, or none offering the possibility of a clear alternative way forward, I shall proceed as above and the terms of section 36 will apply. However I should make it clear that this would not in any way preclude the parties from reaching some other agreement in the future.

The PCT application

- 43 Having regard to my findings above, I also declare under section 12 that Mr Ogden and Mr McKenzie are jointly entitled to international patent application number PCT/GB 2003/000293; and that Mr Ogden was the sole inventor. This declaration may if necessary be used in support of any request to the International Bureau, the European Patent Office or other appropriate authority to amend details of inventorship or ownership.

Costs

- 44 Neither party has asked for costs and so I make no award.

Appeal

- 45 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any

appeal must be lodged within 28 days.

DAVID BARFORD

Deputy Director acting for the Comptroller