



15 October 2009

PATENTS ACT 1977

PARTIES	Jon Teale and Lee Berman
PROCEEDINGS	Reference under section 37 and applications under section 13(3) and rule 10(2) in respect of patent number GB 2426448
HEARING OFFICER	S M WILLIAMS

DECISION

Introduction

- 1 Patent application number GB 0510948.3 was filed on 27 May 2005 and named Lee Berman as patent applicant and inventor. The application was published as GB 2426448 and subsequently proceeded to grant on 2 May 2007.
- 2 Jon Teale has now filed a reference under section 37 of the Patents Act 1977 along with an application under section 13(3) and an application under rule 10(2) of the Patents Rules 2007. Mr Teale is seeking to be named as sole inventor and proprietor of patent number GB 2426448.
- 3 In his statement dated 10 August 2009, Mr Teale states that Mr Berman applied for the patent on his behalf. Mr Berman used his own patent attorney to file the application. However it was not made clear to the attorney that Mr Teale was the inventor and not Mr Berman. Consequently the application proceeded to grant in the name of Mr Berman.
- 4 In a letter dated 4 August 2009 accompanying the reference and applications, Mr Berman wrote to say that he supported the inventorship proceedings filed by Mr Teale under section 13(3) of the Patents Act 1977 and rule 10(2) of the Patents Rules 2007. He also says that he does not contest Mr Teale's application and supports his case to be named as sole inventor and owner of patent number GB 2426448 and confirms that he should not have been named as the sole inventor in the original patent application.

The law

- 5 The proceedings have been brought under sections 37 and 13(3) of the Patents Act 1977 and rule 10(2) of the Patents Rules 2007, the relevant parts of which read:

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) ..

(c) ..

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

Section 13

13.(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.

Rule 10

10.(1) An inventor or joint inventor of an invention, if not mentioned in any published application for a patent, or in any patent granted, for the invention, must be mentioned in an addendum or an erratum to the application of patent.

(2) A person who alleges that any person ought to have been mentioned as the inventor or joint inventor of an invention may apply to the comptroller for that person to be so mentioned-

(a) In any patent granted for the invention; and

(b) If possible in any published application for a patent for the invention

and, if not so mentioned, in the manner prescribed by paragraph (1).

(3) ..

(4) ..

- 6 Also relevant is section 7, which reads:

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)

(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.

Conclusion

- 7 On the basis of the information provided, I accept the facts of the case as set out in Mr Teale's statement, that is, that the patent application was filed in the name of Lee Berman as it was not made clear that Mr Teale was in fact the deviser of the invention and as such was entitled to be named as sole inventor and sole patent proprietor. In view of the consent filed by Mr Berman, I conclude that he agrees that Mr Teale should be named as sole inventor. I also conclude that he agrees that Mr Teale should be named as sole patent proprietor.

Findings and order

- 8 Accordingly I find that Jon Teale is entitled to be named as sole inventor and sole patent proprietor in respect of patent number GB 2426448 and that Lee Berman should not have been named as such. I direct that the patents register be updated and an addendum slip prepared to reflect this finding.
- 9 This decision also serves as a certificate, issued in accordance with section 13(3), to the effect that Lee Berman should not have been mentioned as an inventor in the published patent application and granted patent for the invention.

S M Williams

B3 Head of Litigation Section, acting for the Comptroller