



PATENTS ACT 1977

BETWEEN

Thompson Friction Welding Limited

Claimant

and

Magna International Inc.

Defendant

PROCEEDINGS

Reference under section 12(1)(a) of the Patents Act 1977 in respect of patent applications US2008/0302161 and CA2635230

HEARING OFFICER

P R SLATER

DECISION

- 1 A reference under section 12(1)(a) was filed on 5 March 2010 by Thompson Friction Welding Limited (“the claimant”) in respect of patent applications US2008/0302161 and CA2635230. However, the claimant’s statement of grounds included both a request for disclosure relating to the aforementioned patents and details of any equivalents filed elsewhere, and a subsequent request under section 12(2) that the comptroller decline to deal with the case on the basis that they intended to initiate related proceedings before the High Court. I will deal with the request under section 12(2) first as it would seem inappropriate to make an order for disclosure, if I then decide to decline to deal with the reference.
- 2 The defendants in their letter dated 28 April 2010 opposed the claimant’s request under section 12(2) on the basis that they had yet to receive confirmation that any corresponding High Court proceedings had commenced, that the issues being raised appeared to be well within the competence of the comptroller, and that the higher costs associated with having the matter heard in the High Court were disproportionate. However, in subsequent letters dated 9 June 2010 and 23 June 2010, they have indicated that they no longer have any objection to the claimant’s request and are content for the proceedings to be transferred to the High Court.

- 3 Mr Michael Dorsett, one of the two inventors listed on both patents has confirmed in his letter dated 28 April 2010 that High Court proceedings have commenced (HC10C01095). Mr Dorsett has also indicated that he has no objection to the comptroller declining to deal with the reference and for the case to be transferred to the High Court.
- 4 The second of the two inventors, Tom Dermody, has been given the opportunity to comment but has not responded, from which I conclude that he does not resist the request.
- 5 It is clearly undesirable to have the same or largely similar issues litigated both before the comptroller and the court, and moreover the request that the comptroller decline to deal with this reference now appears to be supported by all parties to the proceedings.
- 6 On these grounds, I therefore grant the request and decline to deal with the reference.
- 7 As stated above, the claimant's statement of grounds also included a request for disclosure in the form of a witness statement relating to the aforementioned patents and details of any equivalents filed elsewhere. However, having already decided to decline to deal with this case, I do not think it would be appropriate under the circumstances to order disclosure on this occasion, and consider this a matter to be decided by the court.

Costs

- 8 The claimant's in their statement of grounds requested that the issue of costs be dealt with by the court. The defendant has raised no objection to that request, and accordingly I make no order in that respect.

Appeal

- 9 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

P R SLATER

Deputy Director acting for the Comptroller