



PATENTS ACT 1977

REFERRER D-Per Technologies Ltd

ISSUE Reference under section 12(1)(a) in
respect of European patent
applications 05109729.3 and
09165991.2

HEARING OFFICER H Jones

DECISION

Introduction

- 1 This decision relates to a reference under section 12(1)(a) of the Patents Act 1977 concerning entitlement to the grant of European patent applications EP05109729.3 and EP09165991.2, and to any other patent applications claiming priority from these applications.
- 2 EP05109729.3 was filed at the European Patent Office (EPO) on 19th October 2005 and was subsequently published as EP1777781. This application names Risto Kalevi Savolainen as both the applicant and the inventor. EP09165991.2 was filed as a divisional application of EP05109729.3 on 21st July 2009 and was subsequently published as EP2124291. The divisional application names Bluesky Positioning IPCo SARL as the applicant and Risto Savolainen as the inventor. The two applications relate to aspects of wireless communications systems.
- 3 The reference under section 12 was filed by D-Per Technologies Ltd on 17th December 2012 together with a statement of case and various documents concerning i) the relationship between Risto Savolainen and Bluesky Positioning Ltd, ii) the assignment of the two applications from Bluesky Positioning Ltd to Bluesky Positioning IPCo SARL, iii) the voluntary liquidation of Bluesky Positioning Ltd and iv) the subsequent sale of its IPR assets to D-Per Technologies Ltd. D-Per Technologies Ltd have requested an order declaring that, at the time of filing the first application, the rights to the inventions contained therein belonged to them.
- 4 An amended statement of case was filed on 8th January 2013 and was served on the likely interested parties, namely Risto Savolainen and Bluesky Positioning IPCo SARL, in an official letter dated 15th January 2013. As there was no response to this letter, it was confirmed by way of a further official letter dated 12th April 2013 that the reference would be treated as unopposed.

Summary of facts and submissions

- 5 Since the reference is unopposed, I must accept the facts of the case to be those described in the supporting documentation. These can be summarised as follows.
- 6 A Service Agreement dated 1st February 2006 confirms that Risto Savolainen was employed as CEO of Bluesky Positioning Ltd from 26th April 2005. The Agreement reaffirms that, in accordance with section 39 of the Act (right to employees' inventions), Bluesky Positioning Ltd is entitled to any Intellectual Property arising through Risto Savolainen's employment. The document is signed by both parties.
- 7 European patent application EP05109729.3 was filed by Risto Savolainen in October 2005 when employed as CEO of Bluesky Positioning Ltd.
- 8 An Assignment Agreement dated 10th December 2008 assigns the rights in EP05109729.3 and a yet to be filed divisional application from Bluesky Positioning Ltd to Bluesky Positioning IPCo SARL. The document is signed by Risto Savolainen in his capacity as CEO of both Bluesky Positioning Ltd and Bluesky Positioning IPCo SARL.
- 9 A Deed of Assignment dated 21st January 2009 assigns the entire rights in European patent application EP05109729.3 from Risto Savolainen to Bluesky Positioning IPCo SARL. This document is signed by Risto Savolainen and was subsequently recorded as a legally valid assignment by the EPO.
- 10 Divisional application EP09165991.2 was filed by Bluesky Positioning IPCo SARL in July 2009.
- 11 A letter dated 24th March 2011, signed by Risto Savolainen on behalf of both Bluesky Positioning Ltd and Bluesky Positioning IPCo SARL, confirms the retrospective nullity of the Assignment Agreement dated 10th December 2008.
- 12 By a Special Resolution passed on 16th January 2012 and signed by Risto Savolainen as Chairman of Bluesky Positioning Ltd, the company was wound-up voluntarily. A Deed of Assignment dated 27th June 2012 assigns the rights in EP05109729.3 and EP09165991.2 from Bluesky Positioning Ltd to D-Per Technologies Ltd. This document is signed by the appointed Liquidator on behalf Bluesky Positioning Ltd.

The law

- 13 The relevant parts of section 12 read as follows:

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) ...

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.

Conclusions

- 14 There is no question that the comptroller has jurisdiction under section 12 to make a declaration in the terms requested in this reference. Although no direct evidence has been provided to show that the inventions described in the two European patent applications were made by Risto Savolainen either in the course of his normal duties as an employee of Bluesky Positioning Limited or in the circumstances set out in section 39 of the Act (i.e. falling outside his normal duties but specifically assigned to him by his employer or because he had a special obligation to further the interests of the employer), the fact that Risto Savolainen signed the Assignment Agreement dated 10th December 2008 provides confirmation that the inventions did belong to Bluesky Positioning Ltd at the time of filing the applications.
- 15 The Assignment Agreement dated 10th December 2008 had the effect of transferring the rights in the inventions described in the two patent applications to Bluesky Positioning IPCo SARL. The Deed of Assignment dated 21st January 2009, which assigned the rights in EP05109729.3 from Risto Savolainen to Bluesky Positioning IPCo SARL, must then be treated as legally invalid because Risto Savolainen did not have any rights in the inventions or the applications at this time.
- 16 The letter dated 24th March 2011 confirming the retrospective nullity of the Assignment Agreement has the effect of re-instating Bluesky Positioning Ltd's rights in the inventions and the two patent applications. In view of the liquidation of this company and the subsequent sale of various assets to D-Per Technologies Ltd, I declare that:

Declaration

D-Per Technologies is entitled to the grant of European patent applications 05109729.3 and 09165991.2, and to any other patent applications claiming priority from these applications.

Costs

- 17 As this reference is unopposed, I do not consider it necessary to make an award of costs.

H Jones

Deputy Director, acting for the Comptroller