

Background

- 5 The facts of this case as set out in the claimant's statement can be summarised as follows. On 19 January 2010 a US provisional application, US61/296,214 was filed in the names of William A. Grissom, Kim Butts Pauly, Michael Lustig and Yoav Medan. During the priority year four assignments were executed to transfer the rights in this application to Stanford University and Insightec Limited. The PCT application filed on 19 January 2011 claims priority from the US application but was filed in the name of Insightec Ltd only. Based on the assignment of US61/296,214 Stanford University claim that they, along with Insightec Ltd, are entitled to be named as joint applicants for all designated states except the US in respect of international patent application number PCT/US2011/021657. They also point out that it was always the intention of both parties to file the PCT application in both their names, and the application was filed in the sole name of Insightec Ltd as a result of an oversight. A request for entry into the European regional phase was filed on 10 August 2012 and application EP11710061.0 is derived from PCT/US2011/021657.

The Law

- 6 The reference has been made under section 12(1)(a), the relevant part of which reads:

Section 12

12.(1) At any time before a patent has been 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 an 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.

The reference

- 7 In support of the reference, evidence in the form of a declaration has been provided on behalf of Stanford University by Katharine Ku, Director of Technology Licensing at Stanford University. Ms Ku confirms the facts set out above. A declaration has also been filed by Dr Kobi Vortman, President of Insightec Ltd. As well as consenting to the reference, Dr Vortman states that Insightec Ltd always intended Stanford University to be named as applicant for patent application number PCT/US2011/021657 and confirms that they were inadvertently omitted when the application was filed. For their part each of the inventors named in the PCT application have also confirmed that they consent to the reference.

Findings

- 8 In view of the evidence filed, I conclude that all the relevant parties agree that international patent application number PCT/US2011/021657 should proceed in the

joint names of The Board of Trustees of The Leland Stanford Junior University and Insightec Ltd and indeed should be treated as having been originally filed in both names. In light of this I also find that EP11710061.0 should also proceed in the joint names of The Board of Trustees of The Leland Stanford Junior University and Insightec Ltd and should also be treated as having been originally filed in both names.

Declaration

- 9 In terms of the order requested, section 12(1) provides the comptroller with broad powers, as the claimants have pointed out. I therefore declare that international patent application number PCT/US2011/021657 be treated for each jurisdiction designated, apart from the US, as having been jointly filed by both The Board of Trustees of The Leland Stanford Junior University and Insightec Ltd on 19 January 2011 and that both parties are entitled to the invention in the subject of the international application. As such, the claimant may use this declaration in support of a request to the International Bureau on this matter or to any national and/or regional authority in respect of any national and/or regional phase application(s), the international application matures into. Further to this I also declare that European patent application EP11710061.0 should also be treated for each jurisdiction designated as being jointly filed in the names of The Board of Trustees of the Leland Stanford Junior University and Insightec Ltd.

A R BUSHELL

B3 Head of Litigation Section, acting for Comptroller