

(b) that person fails to file a counter-statement under paragraph (6) or (8), the comptroller shall treat him as supporting the claimant's case.

4. On 16th August 2013, the Office wrote to Mr Higham and Mr O'Dell advising them that in the absence of a counter-statement they were not considered a party to these proceedings.

Summary of facts and submissions

5. Patent application GB 1010155.8 was filed on 17th June 2010 with Alpha Composites Limited named as the sole applicant. The inventors were named as Mr Kevin Higham and Mr Ian O'Dell. A statement of inventorship was filed stating that Alpha Composites Limited derived the right to the grant of the patent from its employment of each of the inventors. Mr Higham and Mr O'Dell were directors of Alpha Composites Limited.
6. International patent application PCT/GB2010/001567, claiming priority from GB 1010155.8, was filed on 19th August 2010 with Alpha Composites Limited named as sole applicant for all designated states except the US and with Mr Higham and Mr O'Dell again named as joint inventors. Mr Higham and Mr O'Dell were named as joint applicants for the US only.
7. Sigma Composites Limited acquired the intellectual property rights owned or held by Alpha Composites Limited by virtue of an Agreement for the Sale and Purchase of Business and Assets dated 9th March 2012.
8. On 17th December 2012, Sigma Composites Limited proceeded to file a United States national phase entry application from PCT/GB2010/001567. It is this application that is the subject of this decision. In order to progress the application, Sigma requires Mr Higham and Mr O'Dell to sign a combined declaration and power of attorney and assignment document.
9. Sigma has sought on a number of occasions to obtain from Mr Higham and Mr O'Dell the signatures required but has not been able to get them.

The law

10. These proceedings have been brought under section 12 of the Act, the relevant parts of which read:

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.

11. It has established in earlier references to the comptroller under section 12(1), namely *Cannings*¹ and *British Telecommunications*², that it is within the comptroller's broad powers to order the inventor to execute any assignment necessary to give effect to the determination of entitlement to a foreign patent application. If the inventor refuses to execute the necessary assignment then it is within the comptroller's powers to bypass an uncooperative party and authorise an affected party to sign on his behalf.

Conclusions

12. I am satisfied on the basis of the uncontested evidence before me that Mr Higham and Mr O'Dell are the joint inventors of the invention set out in US patent application 13/704,908 and that their rights to that invention were transferred to Alpha Composites Limited by virtue of their employment by that company. The rights of Alpha Composites Limited to the invention were transferred to Sigma Composites Limited by an Agreement for the Sale and Purchase of Business & Assets dated 9th March 2012. I am also satisfied that Sigma Composites Limited has sought without success to secure the signatures of Mr Higham and Mr O'Dell on the documents required to progress the US patent application.

Declaration & Order

13. **I hereby declare that Sigma Composites Limited is entitled to the invention of United States patent application 13/704,908.**
14. **I authorise Franks & Co (South) Limited, agent for Sigma Composites Limited, to sign on behalf of the named joint inventors Mr Kevin Richard Higham and Mr Ian O'Dell the combined declaration and power of attorney and assignment document (as set out in Annex K of its attachments to its statement of case filed on 31 May 2013) to enable the further prosecution of United States patent application 13/704,908 with the assistance of Merek, Blackmon and Voorhees, LLC.**

Appeal

15. Any appeal must be lodged within 28 days

Phil Thorpe

¹ *Cannings*' United States Application [1992] RPC 459

² Re *British Telecommunications plc* BL O/402/01