



THE PATENTS ACT 1977
(THE PATENTS RULES 2007)

CLAIMANT	Martin R H Cane
ISSUE	Reference under section 37 and applications under section 13 in respect of GB2396236
HEARING OFFICER	H Jones

DECISION

Introduction

- 1 In a statement of case dated 20 February 2014, the claimant (Martin Cane) states that he is the sole inventor of the remotely controlled female lock set out in patent GB2396236 and claims that he is entitled to sole rights in the patent. The patent derives from PCT application WO03/006768 filed on 10 July 2002 and published on 23 January 2003. The patent application entered the GB national phase on 9 February 2004 in the names of Da-peng Zhang and Zhi-qiang Wan. It was granted on 5 January 2005 to Martin Cane and Da-peng Zhang following a notification of assignment filed on 26 March 2004, and names Da-peng Zhang and Zhi-qiang Wan as the inventors.
- 2 In a preliminary evaluation of the case dated 7 May 2014, I informed the claimant that since the reference under section 37 was being made some nine years after the date of grant of the patent, no order could be made concerning entitlement to a patent on the grounds that it was granted to a person not so entitled unless it was shown that the person registered as proprietor of the patent knew at the time of the grant that he was not entitled to the patent (section 37(5)). Since none of the facts set out in the claimant's statement of case addressed the issue of whether Da-peng Zhang knew (or reasonably should have known) at the time of grant that he was not entitled to the patent, my initial view was that the claimant's reference to entitlement under section 37 was unlikely to succeed. The claimant was invited to submit an amended statement of case in respect of entitlement, which he later submitted on 29 May 2014.
- 3 The claimant's amended reference under section 37 (right to patent after grant) and his applications under section 13 (mention of inventor) have not been opposed by either Da-peng Zhang or Zhi-qiang Wan. In accordance with rule 77(9), the comptroller must treat Da-peng Zhang and Zhi-qiang Wan as supporting the claimant's case.

Assessment of the facts

- 4 The application under section 13(1) to have the claimant's name added as inventor appears to be unnecessary because of transcription errors made by the Patent Office upon entry of the PCT application into the national phase. The bibliographic details of WO03/006768 records the inventors as being Da-Peng Zhang and Martin Cane, but when the PCT application entered the GB national phase the names of Da-Peng Zhang and Zhi-qiang Wan appear to have been entered by mistake. The name of Martin Cane can be recorded as an inventor and the name of Zhi-qiang Wan can be removed by way of a correction of an Office error under rule 107.
- 5 The application under section 13(3) to have Da-peng Zhang's name removed as inventor is supported by the uncontested facts set out in the claimant's amended statement of case: it was Mr Cane who devised the idea of the remote control lock and it was Mr Da-Peng Zhang who was tasked with testing the product and putting it into production.
- 6 The reference under section 37 to have Mr Cane registered as sole proprietor of the patent is supported by the uncontested facts set out in the claimant's amended statement of case: Mr Cane states that he was the sole deviser of the invention set out in the patent and that there has never been a contract or written agreement of any kind between himself and Mr Zhang concerning ownership of rights in the remote control lock. Mr Zhang would have known that he was not entitled to the patent when he filed the application.

Conclusions and Order

- 7 I find that Da-peng Zhang should not be named as inventor in the patent, and this decision serves as a certificate under section 13(3) to that effect.
- 8 The claimant's application to add his own name as inventor and for the name of Zhi-qiang Wan to be removed can be effected by way of a correction of an Office error under rule 107. In accordance with rule 10(1), I direct that Mr Cane's name be mentioned as sole inventor in an erratum to the patent.
- 9 I find that the claimant is entitled to be named as the sole proprietor of the patent and I order that the register be amended accordingly.

H Jones

Deputy Director acting for the Comptroller