

PATENTS ACT 1977

CLAIMANT Mrs Gillian Taylor

DEFENDANT Lanarkshire Health Board

ISSUE References under sections 12 and 37
in respect of UK patent GB2543835B
and related applications

HEARING OFFICER H Jones

*Ms Roisin Higgins QC (instructed by Cameron Intellectual Property) for the Claimant
Mr Usman Tariq (instructed by Harrison IP) for the Defendant*

Hearing dates: 26-27 April & 1 June 2021

DECISION

Introduction

- 1 This decision is concerned with a variety of joints – joint ownership, joint inventorship, joint employment, joint funding, and, quite appropriately, relates to a device for supporting the human body. The claimant, Mrs Gillian Taylor, initiated proceedings under sections 12 and 37 of the Patents Act 1977 (“the Act”) on 15 April 2020. She seeks to be named as proprietor on patents which are currently in the name of the defendant, Lanarkshire Health Board (LHB). She also seeks an order under section 38 directing that existing licenses be transferred to her as licensor. The primary patent in question is UK Patent GB2543835B (“the patent”), which names Mrs Taylor as the sole inventor. The proceedings also relate to a “first family” in the form of applications EP16801282, US15/771895, CA3041194 and HK12548981 (all of which stem from PCT application WO 2017072527, which claims priority from the patent), and to a “second family” in the form of CN201921745685.7 and foreign equivalents thereof. Alternatively, the claimant seeks to be included in addition to the defendant as the relevant proprietor and licensor.
- 2 The claimant also seeks a decision on whether, as a result of any determination or order made in relation to sole or joint ownership of the patents, it is entitled to recovery of any back-dated royalties already paid by licensees of the patents in question.
- 3 The defendant denies the claimant’s right to ownership of the patent based on her employment with the Health Board at the time of making the invention and considers itself to be the rightful sole owner and licensor. In its counter-statement dated 22 September 2020, the defendant denies that Mrs Taylor is the sole inventor of the patent and claims that a Mr Ken McCorkindale should also be listed as an inventor, filing a statement of inventorship to that effect at the same time.

- 4 Following the normal evidence rounds, the issue came before me at a three-day hearing held on 26 & 27 April and 1 June 2021. The claimant was represented by Ms Roisin Higgins QC, instructed by Cameron IP, and the defendant was represented by Mr Usman Tariq, instructed by Harrison IP.
- 5 Due to the coronavirus restrictions in place at the time, the hearing was held entirely remotely via Microsoft Teams®. I am grateful to the parties and their witnesses for their assistance in making the somewhat unusual arrangements work as effectively as they did.
- 6 It was agreed that as both parties were located in Scotland and the relevant acts had taken place in Scotland, I should apply Scottish Law to the extent that it applies. I have not used the legal terms for claimant (“pursuer”) and defendant (“defender”) used in Scottish Courts Procedure simply for consistency with the statements and arguments put forward by the parties.
- 7 Although the defendant and current proprietor is Lanarkshire Health Board, I may refer to the defendant as NHS Lanarkshire (NHSL) to be consistent with the evidence and witness statements. NHS Lanarkshire is the common name of the Lanarkshire Health Board.

Preliminary issues

- 8 A question of admissibility of evidence was put to me by Mr Tariq, who argued that a license agreement that had been submitted by the claimant as part of the evidence rounds had been done in breach of contract. It had been disclosed to the claimant under a confidentiality agreement for the purposes of personal information, and he argued that using it in these proceedings against the defendant breached that confidentiality agreement. Ms Higgins countered that the license agreement was of real importance to the case and argued that the document should be admitted but kept off public record. She also argued that the confidentiality agreement specified that disclosure could be made if required by law or by a competent authority, and that the IPO had the power to do this. I agreed that the information in the document was relevant to the proceedings and so, in order to get to the just answer in these proceedings, I said that I would allow the evidence to be admitted. It will be made subject to confidentiality within the Office, so will not be open to public inspection.

Background to the invention

- 9 Patent number GB2543835 relates to a weighing device incorporated into a patient transfer board. Patient transfer boards, commonly known as Patslides, are used by clinicians to transfer patients from one surface to another, such as from a trolley to a bed.
- 10 Mrs Taylor had an embryonic idea to incorporate a weighing scale into a patient transfer board in 2007/2008 while working for the defendant in emergency medicine. However, it was not something she thought about in any great depth at that time, and she did not try to develop it. The parties are in agreement that this embryonic idea did not constitute an “invention” - it was merely an early stage concept which was already in the public domain.

- 11 In 2012, Mrs Taylor began employment as a Practice Development Facilitator for Stroke with Chest, Heart and Stroke Scotland (CHSS). CHSS is a health charity aimed at supporting people and their families across Scotland with chest, heart and stroke conditions. In Mrs Taylor's case, CHSS provided educational support to Scottish Health Boards and her post was a service level agreement partnership with NHS Lanarkshire, meaning that it was funded by both CHSS and NHSL. Her work required her to work out of NHSL premises and to work closely with NHSL staff.
- 12 Mrs Taylor approached Scottish Health Innovations Limited (SHIL) in 2014 to enquire about developing her idea. SHIL are an independent organisation set up to support innovation across NHS Scotland. SHIL were interested in helping Mrs Taylor and they sourced and appointed a design consultancy, Cramasie, to work with her to develop a prototype. A patent application (GB1519251.1) was filed in October 2015 and a patent was granted in October 2017, this being the primary patent in question in these proceedings.
- 13 The patent was filed in the name of Lanarkshire Health Board (LHB) and named Mrs Taylor as the inventor. It is the claimant's position that LHB are not entitled to be named proprietor as they were not her employer at the time. She also claims that she developed the invention in her own time, not as part of her normal duties or as part of duties specifically assigned to her.
- 14 The defendant claims that it is entitled to the patent as they were a joint employer of the claimant at the time she devised the invention and that she did so as part of duties specifically assigned to her. They also claim entitlement to the patent through Mr McCorkindale's role as joint inventor and the contractual assignment of rights to the invention that flowed to LHB from Cramasie via SHIL (Mr McCorkindale being a director of Cramasie at the time). The defendant seeks to remedy the omission of Mr McCorkindale's name as an inventor at the time of filing the application by filing a statement of inventorship on Patents Form 7 as part of these proceedings, which I shall return to later in my decision.
- 15 Furthermore, the defendant considers that the current application for entitlement is subject to a time bar under section 37(5) as it has been referenced later than two years from the grant of the patent and does not meet the requirements for an exemption to this law. The defendant also considers Mrs Taylor to be subject to the doctrine of "personal bar" under Scottish Law. This was described by the Hearing Officer in *Robert Wilson v Enviromax Ltd*¹ as a close cousin of the concept of "estoppel by representation" in English Law. In this instance, the defendant seeks to use the doctrine to bar Mrs Taylor from arguing that she should be entitled to the patent because she agreed to accept help from SHIL on the basis that the patent should be filed in the name of the defendant.
- 16 It was agreed before the hearing that in the event that I decide that the time bar under section 37(5) does apply, further submissions will be invited from the parties as to the precise order I should make.

¹ [BL O/403/15](#)

The witnesses

For the claimant

- 17 Gillian Taylor is the claimant who has brought these proceedings against LHB.
- 18 Lynn Reid was the claimant's line manager at CHSS, in charge of the Stroke Education Facilitators.
- 19 Kenneth McCorkindale was a director of Cramasie, the design agency appointed by SHIL to develop the claimant's idea.
- 20 Campbell Chalmers was an employee of NHS Lanarkshire and part of the Stroke Managed Clinical Network (Stroke MCN). He was the claimant's clinical supervisor in the NHS.
- 21 Albert Nicholl worked with SHIL to assess the commercial potential of innovations from NHS employees.
- 22 All of these witnesses provided witness statements and were cross-examined by Mr Tariq. They appeared to provide honest answers as to their understanding of the situation at the time and their testimony was not criticised by Mr Tariq.
- 23 Joan James, a Director of Nursing for NHS Lanarkshire's Acute Division provided a witness statement as to the nature of the claimant's employment but was not cross-examined.

For the defendant

- 24 Sheena MacCormick worked for SHIL in a role that supports and provides funding to NHS staff who have innovative ideas.
- 25 Katrina Brennan was the Stroke MCN lead at NHS Lanarkshire and managed the team where the claimant worked.
- 26 Kate MacDonald provided administrative support for the Stroke MCN team.
- 27 Colin Lauder was head of Planning and Development at NHS Lanarkshire, but also holds an innovation role. He gave evidence as to the support the claimant received from NHS Lanarkshire.
- 28 Ann Armstrong was a colleague of the claimant at CHSS, who also has a partnership post and works in the Stroke MCN team.
- 29 All of the defendant's witnesses provided witness statements and were cross-examined by Ms Higgins. They all appeared to give honest answers as to their understanding at the time and their testimony was not criticised by Ms Higgins.

Entitlement

The law

- 30 Section 37 of the Act deals with determining disputes over who is entitled to a patent which has already been granted. The relevant parts of that section read as follows:

37(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question -

- (a) who is or are the true proprietor or proprietors of the patent,*
- (b) whether the patent should have been granted to the person or persons to whom it was granted, or*
- (c) whether any right in or under the patent should be transferred or granted to any other person or persons;*

and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.

(2) Without prejudice to the generality of subsection (1) above, an order under that subsection may contain provision -

- (a) directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;*
- (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;*
- (c) granting any licence or other right in or under the patent;*
- (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.*

- 31 The right to apply for and obtain a patent is set out in section 7 of the Act. It reads as follows:

7(1) Any person may make an application for a patent either alone or jointly with another.

(2) A patent for an invention may be granted -

- (a) primarily to the inventor or joint inventors;*
- (b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;*
- (c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned; and to no other person.*

(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.

(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

- 32 It is clear from this that resolving any entitlement dispute starts with a simple question - who was the inventor (the actual deviser) of the invention? When considering the question of who is the actual deviser of the invention, both sides referred me to the judgment of the House of Lords in *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc*². Here Lord Hoffman notes:

18. S.7(2), and the definition in s.7(3), are in my opinion an exhaustive code for determining who is entitled to the grant of a patent...

and goes on to say:

*20. The inventor is defined in section 7(3) as "the actual deviser of the invention". The word "actual" denotes a contrast with a deemed or pretended deviser of the invention; it means, as Laddie J said in *University of Southampton's Applications* [2005] RPC 220, 234, the natural person who "came up with the inventive concept." It is not enough that someone contributed to the claims, because they may include non-patentable integers derived from prior art: see *Henry Brothers (Magherafelt) Ltd v Ministry of Defence* [1997] RPC 693, 706; [1999] RPC 442. As Laddie J said in the *University of Southampton* case, the "contribution must be to the formulation of the inventive concept". Deciding upon inventorship will therefore involve assessing the evidence adduced by the parties as to the nature of the inventive concept and who contributed to it. In some cases this may be quite complex because the inventive concept is a relationship of discontinuity between the claimed invention and the prior art. Inventors themselves will often not know exactly where it lies.*

- 33 In order to determine who the actual deviser of the invention is, I must first establish the inventive concept.

The inventive concept

- 34 Granted patent GB2543835 contains two independent claims, claims 1 and 5:

1. An apparatus to weigh a patient comprising a patient transfer board configured to support a patient in a supine position, wherein an upper surface of the patient transfer board is configured to receive the supine patient, the upper surface having a width and a length;

the patient transfer board comprising a plurality of transducers provided beneath the upper surface, said transducers configured to determine a weight of the patient,

the apparatus comprising summing means configured to provide the summed weight sensed by the plurality of transducers,

characterized in that the plurality of transducers includes at least 8 transducers, and each transducer is no more than a distance of 300 mm from another of the transducers,

the transducers are provided at three or more positions across the width of the patient transfer board;

² House of Lords [2007] UKHL 43

wherein more than 50% of the transducers are provided 150 mm or less from a lateral outside boundary of the patient transfer board.

5. An apparatus to weigh a patient comprising a patient transfer board configured to support a patient in a supine position, wherein an upper surface of the patient transfer board is configured to receive the supine patient, the upper surface having a width and a length

the patient transfer board comprising a plurality of transducers provided beneath the upper surface, said transducers configured to determine a weight of the patient,

the apparatus comprising summing means configured to provide the summed weight sensed by the plurality of transducers, characterized in that at least one transducer is provided beneath every unit area of the area of the patient transfer board configured to receive the supine patient, wherein said unit area corresponds to 90,000 mm²,

the transducers are provided at three or more positions across the width of the patient transfer board;

wherein more than 50% of the transducers are provided 150 mm or less from a lateral outside boundary of the patient transfer board.

35 Ms Higgins, for the claimant, put it to me that the inventive concept is:

“a weighing means incorporated within a patient transfer board, the weighing means being adapted to facilitate accurate weight measurement even when a patient is not located centrally on the patient transfer board (for example, during the transfer of a patient to/from another surface).

36 The difference between this proposed inventive concept and the original idea (which both parties agreed was not an invention) is the fact that accurate weight can be measured when the patient is not located centrally on the board. As an inventive concept, it stops short of including the feature that allows the accurate measurement to take place. Ms Higgins refers in her skeleton arguments to the following comment by the Hearing Officer in *David Rose v Ability International Limited*³ (at paragraph 47):

“I therefore accept Mr Carter’s view of how I should approach the question and am not simply prepared to conclude without further thought that any elements conferring novelty on the claims over the prior art must be at the heart of the invention. The invention must, however, encompass at least those elements which, together, solve the problem which has been posed.”

37 Ms Higgins also refers to *Stanelco Fibre Optics Ltd’s Applications*, where Mr Christopher Floyd QC, sitting as Deputy Judge of the Chancery Division, stated:

11. ...So what an inventor must have actually devised is, unless the context otherwise requires, to be taken to be that which is specified in the claim...

12. The task of the court is to identify the inventive concept of the patent or application and identify who devised it: see *Henry Brothers (Magherafelt) v Ministry of Defence and*

³ [BL O/247/11](#)

Northern Ireland Office [1997] R.P.C. 693 at 706 (Jacob J.) and [1999] R.P.C. 442 at 448 (Robert Walker L.J.) and Collag Corp v Merck & Co Inc [2003] F.S.R. 16 at [70] (Pumfrey J.). The Court is not concerned with issues of validity or inventiveness: merely with the concept as described....

15A. It is clear that a mechanistic, element by element approach to inventorship will not produce a fair result. If A discloses a new idea to B whose only suggestion is to paint it pink, B should not be a joint inventor of a patent for A's product painted pink. That is because the additional feature does not really create a new inventive concept at all. The feature is merely a claim limitation, adequate to overcome a bare novelty objection, but having no substantial bearing on the inventive concept. Patent agents will frequently suggest claim limitations, but doing so does not make them joint inventors. Some stripping of a claim of its verbiage, may be necessary to determine the inventive concept, and consequently the inventor. But one must keep in mind that it is the inventive concept or concepts as put forward in the patent with which one is concerned, not their inventiveness in relation to the state of the art."

38 Ms Higgins referred me to paragraphs 35-45 of my own decision in *Close Brewery Rentals Ltd v Geco Holdings Ltd*⁴, which summarises the approach to identifying the inventive concept in entitlement disputes as set out by the Courts. That approach has changed very little, if at all, since the time I issued that decision (a mere three months ago), and Mr Tariq, who represented the claimant in that case, has not argued here that my approach then was incorrect - in fact, the caselaw cited in his skeleton arguments is consistent with that set out in my decision. I shall approach the task of identifying the inventive concept on the same basis as in my previous decision.

39 When considering the inventive concept, we are reminded to look at the essence of the claim in question, as stated by Jacob LJ in *Pozzoli*⁵. I must consider the inventive concept put forward by the claims, not the inventive step in relation to the prior art. Mr Tariq, for the defendant, has proposed an inventive concept which includes some details of the layout:

“an apparatus to weigh a patient comprising a patient transfer board and, at least, eight transducers provided beneath the upper surface of the board in a specified layout.”

40 The approach to understanding the inventive concept must be taken from the standpoint of the person skilled in the art, whom both parties agreed would be “involved in the design of patient transfer and weighing devices adapted for human patients. This person would be aware of typical designs and essential components of such devices and would be aware of the most common materials that such devices are constructed from”.

41 In *Actavis UK Ltd v Eli Lilly and Company*⁶, the Supreme Court also considered the inventive concept of a claim to be synonymous with “the inventive core” of the claim. When considering what this might be, consideration should be given to the problem the invention is trying to solve. In *University of Southampton's Applications*⁷, Jacob LJ stated at paragraph 43 that:

⁴ [BL O/264/21](#)

⁵ [2007] EWCA Civ 145, CA.

⁶ [2017] RPC 21

⁷ [2005] RPC 11

“Next I should expand a little on the “inventive concept” for the purposes of entitlement disputes. Markem has already pointed out that one is not bound by the form of the claims, if any. I think there is a great danger in being over elaborate about this, about dividing the information in a patent into a myriad of sub-concepts, each of which is considered separately. One must proceed more like a hedgehog than a fox. And after all there is supposed to be only one inventive concept in a patent. (Patents Act 1977 section 14(5)(d))”.

- 42 The problem addressed by the invention is one of speed and accuracy. For patients who cannot support their own weight, the step of moving them into a hoist for weighing is removed, and thus the time taken to deliver accurate doses of medicine can be reduced. However, the patient is often not located centrally on the board or is small in stature so their weight is not spread across the whole of the board.
- 43 The defendant’s assessment of the inventive concept includes within it at least eight transducers provided beneath the upper surface of the board in a specified layout. The “specified layout” of the transducers is clearly important for solving the proposed problem - that of measuring accurately when a patient is not central on the board. Therefore, I accept that providing a specific layout of transducers is part of the inventive concept. The precise number and layout will however depend a great deal on the level of accuracy required. Using “at least eight” transducers in such a specified arrangement is clearly one way of accurately measuring the weight of a person on a board which met the desired medical standard in place in the UK at the time (NAWI Class 3 standard), but I consider this to be a claim limitation, rather than part of the inventive concept.
- 44 We can see from the Cramasie design document submitted in evidence that these precise layouts resulted from a limited number of experiments carried out during the design phase with the goal of meeting this particular specified requirement of accuracy. Other arrangements may provide a result of acceptable accuracy (although perhaps not meeting the stringent medical standard mentioned above) and still share the inventive concept of the invention. Industry standards will vary over time and geographical area, and this will influence the requirements for accuracy and thus the precise load cell layout, but not the core inventive concept. Having weighed up the evidence presented by both parties I consider the inventive concept to be:

a weighing means incorporated within a patient transfer board which facilitates weight measurement to a desired accuracy even when a patient is not located centrally on the patient transfer board, by using a specified arrangement of transducers located under the surface of the board.

Who devised the invention?

- 45 Having established what I consider the inventive concept to be, I must now determine who came up with it. The claimant tells us in her first witness statement, and repeats under cross-examination, that she had an idea for a Patslide which could weigh a person as part of an existing process. She describes how she was inspired by the flat scales in her kitchen and envisaged them incorporated into a known Patslide. From her evidence it is clear that Mrs Taylor felt it was critical to incorporate the weighing process into the existing transfer process. Under cross-examination, she stated that she *“needed it to be part of an existing process. I needed it to be - when the patient was in the middle between the two surfaces, that is when you were going to get the weight. I knew, us as nurses, I know what we are like, and, if you make it part of that existing process, then people will buy into it. They*

will use it. They will enjoy it. They will like it. If you veer away from that existing process, then you are giving the nurse another task to do, and they don't like that". However, there is no evidence that she knew what form a Patslide that would be able to do this would take. From her first witness statement it is clear that she had some idea that a load cell mechanism would be required *"Of course, I knew that the invention needed to have a load cell mechanism in order to weigh a patient."*

- 46 The defendant seeks to add Kenneth McCorkindale as a joint inventor given his contribution to the invention as director of Cramasie. Sheena MacCormick, the innovations manager at SHIL, states in her witness statement that when she was approached by Mrs Taylor there was already a concept for a Patslide that could weigh but no tangible solution. No discussions around load cell number or placement took place. Mr McCorkindale worked closely with Mrs Taylor to develop a board that would be lightweight, thin and meet accuracy requirements. In his witness statement he tells us that *"Gillian mentioned that load cells could be used, like in other weigh scales, but didn't know if this would work"*. He states that Cramasie and SHIL investigated the safety, accuracy and commercial requirements and developed the load cell layout which complied with these.
- 47 I have set out what I consider to be the inventive concept above. This includes a specified arrangement of transducers which allow the board to weigh to a desired accuracy. Mrs Taylor was most concerned with keeping a single transfer and weighing process, which she felt would be critical to the invention's success. She tells us in her first witness statement how she showed Mr McCorkindale a video of the existing transfer process for moving a patient so he could understand what it involves. However, there is no evidence that she knew that providing a specific number and layout of load cells would influence the accuracy required. She did not approach SHIL needing only to refine the layout of a plurality of transducers – she had, at that time, only a notion that a load cell incorporated into a Patslide might work. When questioned under cross-examination about the configuration of the load cells between the two surfaces she agrees that *"What is in the middle of the scale was Ken McCorkindale's input, but with advice from myself on the user aspects of the device, yes"*.
- 48 The evidence submitted by the defendant included a design document produced by Cramasie detailing the research and experiments carried out by them to develop the invention from the initial idea to a working prototype which met the required accuracy requirements. This document detailed what was known in the field at the time, the distribution of body weight for different sizes of patients and possible construction materials. It then set out various proposed layouts of load cells which were tested with weights, then with people of various sizes, to determine the accuracy of the results. From these results a layout which provided the necessary accuracy was chosen and the prototype was constructed.
- 49 Ms Higgins argued that the work carried out by Cramasie to establish the best layout was simply trial and error and thus does not qualify as the input of an inventor. She refers to the design brief provided to Cramasie dated 9 December 2014, to support her argument that the idea was at an advanced stage before Mr McCorkindale's involvement. However, this document only briefly mentions that "loads cells" would be required between two rigid panels and says no more about the number of cells or how the layout of the cells may affect accuracy. Although accuracy is stated as a requirement to meet quality standards, the only concern about accuracy raised in the design brief is that it should not be affected by laying the device on a soft mattress.

No concerns are raised in this brief about the patient not being central, or about the different weight distributions of different sized patients.

- 50 I have concluded above that the inventive concept includes having a specific arrangement of transducers which weigh to a desired accuracy. It is clearly true that the arrangements set out in the patent application were devised as a result of experiments, and that there were a number of variables to be adjusted. But there was a clear goal to the experiments of meeting the desired accuracy - this much is evident from the Cramasie design document submitted in evidence. It is necessary that the inventor carry out this type of research as part of the inventing process in order to ensure there is not an undue burden on the skilled person reading the patent application. The inventor must bring to the table their idea and how they intend to put it into practice. On the basis of the evidence put before me I find that Mrs Taylor brought the idea of combining scales with a Patslide and a lot of user knowledge to the table, but that Cramasie worked out how this idea might be put into practice by defining how specific layouts of transducers affect the accuracy of the weight measurement when a person is not centrally located on the board. There would be no patent to dispute without both of these inputs.
- 51 The claimant also argues that she should be considered sole inventor as the defendant was happy to file the patent application on 30 October 2015 naming her as the sole inventor on the Patents Form 7. A licence agreement with SHIL dated 30 January 2017 and 3 February 2017 also states that “the patient transfer board described in the Patent was conceived by the Claimant”. Furthermore, media articles from 2018 in the national newspaper *The Daily Record* and the magazine *Innovation & IP* also refer to her as the “inventor”. However, referring to someone as “inventor”, or even stating it on an official form or agreement, does not necessarily make it so. When questioned under cross-examination about naming the claimant as inventor on the Patents Form 7, Sheena MacCormick stated that naming the NHS innovator as inventor was simply SHIL policy at the time and no great significance was placed on it as the Health Board was named as the proprietor.
- 52 It is quite clear that in accordance with section 7(3) of the Act, to determine the inventor I have to consider who is the “actual devisor of the invention”. Also, as stated in *University of Southampton’s Applications*, the inventor is the natural person who “came up with the inventive concept”. Mr McCorkindale was in charge of the design team who developed the invention for Cramasie and as such I consider him to be a joint inventor, together with the claimant.
- 53 The defendant has sought to remedy the lack of acknowledgement of Mr McCorkindale’s contribution as joint inventor at the time of filing the patent application by now filing a statement of inventorship on a Patents Form 7. Rule 10(4) of the Patents Rules 2007 (as amended) states that a statement filed under section 13(2) must be made on a Patents Form 7. Section 13(2) requires the applicant to identify the person or persons whom he believes to be the inventor or inventors within a prescribed period or else the application will be taken to be withdrawn, this period being specified in rule 10(3) as being sixteen months from the earliest filing date of the application. A declaration on a Patents Form 7 is not the mechanism for adding Mr McCorkindale’s name as joint inventor after the patent has been granted. What the defendant should have done was to apply to the comptroller under rule 10(2) for Mr McCorkindale to be so mentioned, which would then have commenced proceedings to be heard before the comptroller.

- 54 The present entitlement proceedings have considered the question of Mr McCorkindale's role as joint inventor even though an application under rule 10(2) has not been made, with witness evidence admitted and properly tested under cross-examination. I consider the lack of a formal application under rule 10(2) to be formal omission having no material consequence, and in the interest of dealing with cases expeditiously and fairly as set out in the overriding objective of rule 74, I deem the request made on Patents Form 7, i.e. to add Mr McCorkindale's name as an inventor, to be an application under rule 10(2).
- 55 Having decided that Mrs Taylor and Mr McCorkindale are joint inventors of the invention, I must now consider whether entitlement to the patent passes to another person or persons in the circumstances set out in section 7(2), for example by way of an employer/employee relationship.

Employment

- 56 The claimant asserts that she should be named as a proprietor of the patent as she was not employed by the defendant when the invention was devised, and that in any case she made the invention in her own time.
- 57 The defendant claims to be entitled to be named proprietor of the patent under section 7(2)(b) on the ground that it was the claimant's joint employer and/or had rights assigned to it by the claimant's employer, CHSS. It claims that Mrs Taylor made the invention as part of duties specifically assigned to her by her employer.
- 58 Section 7(2)(b) states that a patent may be granted to any person other than the inventor who, "by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it".
- 59 The employer's right to own patents made by an employee is set out in section 39(1) of the Act. Under this part of the Act, the employer will be entitled to any invention made by an employee in the course of their normal duties or in the course of duties specifically assigned to them. The relevant parts of section 39 are set out below:

39.-(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if –

(a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

- 60 Mr Tariq referred me to *Secretary of State for Defence's Application*⁸, which states that specifically assigned duties are duties which are not the standard or everyday duties for which a person is normally employed.
- 61 The claimant's employment situation was atypical in that her post was funded by NHSL and CHSS to the amount of approximately 50% each. The postholder would be responsible for educating staff in NHSL about stroke in order to improve care for stroke patients throughout Lanarkshire. A job advert and contract were provided in evidence and it is clear that the post was advertised by CHSS and that the claimant's employment contract is with CHSS. The terms and conditions of the role set out in the job advert clearly state that the post holder will be employed by CHSS and would be line managed by CHSS staff. It also states that the postholder will be subject to "the CHSS objective setting, supervision and appraisal process".
- 62 The claimant also provided pay slips from CHSS which showed that they paid her salary and made her National Insurance and pension contributions. She is clearly of the view that these were her only employers and cites the fact that she was not allowed to re-join the NHS pension scheme as further evidence that she was not employed by NHSL.
- 63 There is agreement between the parties and the witnesses that the claimant was employed by CHSS. However, the defendant claims that NHSL was also a joint employer. Mr Tariq argues that an employment contract need not necessarily be written but may be "implied". He referred to section 130 of the Act, which requires a contract of employment to constitute an "employment relationship". He argued that the reality of the relationship between the claimant and NHSL was one of employment, and in his skeleton arguments drew my attention to *Ferguson v John Dawson & Partners (Contractors) Ltd*⁹, where Lawton LJ said:
- "As I understand the law there is no single test for deciding whether a man is a servant of another. Various factors have to be considered and weighed. Control of working is one; intention is another; carrying on business on one's own account is a third. The label which the parties attach to a bargain is not to be disregarded but it is far from being conclusive."*
- 64 Also of relevance here, and referenced by both Mr Tariq and Ms Higgins in their skeleton arguments, is *Ready Mixed Concrete (South East) Ltd v Minister of Pensions and National Insurance*¹⁰, where MacKenna J laid down three conditions for determining whether or not someone is employed under a contract of service. He said as follows (at page 515):
- "A contract of service exists if these three conditions are fulfilled. (i) The servant agrees that, in consideration of a wage or other remuneration, he will provide his own work and skill in the performance of some service for his master. (ii) He agrees, expressly or impliedly, that in the performance of that service he will be subject to the other's control in a sufficient degree to make that other master. (iii) The other provisions of the contract are consistent with its being a contract of service."*
- 65 When considering whether the claimant has an implied contract of employment with NHSL, I need to ask if Mrs Taylor was subject to the control of NHSL in a sufficient degree to make it her "master".

⁸ [BL O/135/89](#)

⁹ [1976] 1 WLR 1213

¹⁰ [1968] 2QB 497

Implied contract of employment with NHSL

- 66 Mr Tariq argued that the claimant's employment formed part of a joint working arrangement between CHSS and the NHS and that half of the claimant's salary was paid by NHSL. However, we can see from the payslips submitted in evidence that the claimant's entire salary was paid by CHSS, as were her National Insurance and pension contributions. It may well be the case that her post was jointly funded by the NHS, but it was CHSS who paid her to carry out her duties. According to Mrs Lynn Reid, who was Mrs Taylor's line manager at CHSS, Mrs Taylor's post was a Service Level Agreement partnership, which meant in practice that it was a funding partnership between CHSS and NHSL. NHSL would have input into what Mrs Taylor's duties would be, but this was an agreement between the two organisations, not between the claimant and NHSL. Mrs Taylor's contractual agreement was with CHSS.
- 67 Other facts relied upon by Mr Tariq in support of an implied contract were that the claimant was based on the defendant's premises, i.e. Coathill Hospital in Coatbridge, and was line managed by an NHS employee, Mrs Katrina Brennan, who was the Stroke NHS Lead at NHSL. However, when questioned under cross-examination, even Mrs Brennan admitted that Mrs Taylor was line managed by Mrs Reid, a CHSS employee. She said *"I had never claimed to be Gillian's line manager. I claimed to manage the service, of which Gillian was a part of that service"*. Also, as stated above, it is clearly set out in the job description that the postholder will be line managed within CHSS. When asked by Mr Tariq if he accepts that the claimant reported to Mrs Brennan, Mr Campbell Chalmers, a Stroke Nurse Consultant who worked on the Stroke MCN team with the claimant, said *"No, I do not accept that"*.
- 68 Mrs Brennan was in charge of the Stroke MCN team in which Mrs Taylor worked and as a result she would manage the work delivered by the team on a day-to-day basis. Mr Tariq notes that Mrs Brennan was on the interview panel which employed the claimant and claims that this is an indicator of who had responsibility for Mrs Taylor within NHSL. A letter signed by Mr Colin Lauder, Director of Planning, Property and Performance at NHSL and Mrs Brennan's line manager, confirms that it is his understanding that the claimant reported to Mrs Brennan on a day-to-day basis, but he also accepted the line management responsibility of Mrs Reid. Under cross-examination he clarified *"Katrina Brennan is the manager of the stroke Managed Clinical Network for Lanarkshire, so she is the head of a team of clinicians and we provide stroke care across the county. Gillian is one member of that team."*
- 69 The claimant worked in NHSL premises because the rest of the team she worked with were based there, many of whom were NHS employees. The role was "hosted" in NHSL premises. She had an NHSL email because she was often in communication with other members of the team, but she also had a CHSS email address.
- 70 Quite a lot of time was dedicated at the hearing to establishing who the claimant would seek approval from for annual leave and sick leave. The evidence obtained during cross-examination of witnesses suggests that she would agree annual leave with both her CHSS line manager, Mrs Reid, and her MCN team manager, Mrs Brennan. If sick, she would also make sure both parties were informed. I don't think that the precise order of who was informed first is of real relevance as to who had "control", as it would necessarily depend on her duties on that particular day and who might be inconvenienced by her absence.

- 71 Mr Tariq argued that electronic records of the claimant's time off and sick leave were held by the defendant, and this was put forward as a further reason to consider that there was an implied employment contract between them. In her second witness statement, Mrs Reid clarified that, as her CHSS line manager, she approved sick leave for Mrs Taylor and informed the CHSS HR department, and that she collected Doctor's certificates and passed them to HR. She also completed any return to work forms. Annual leave was agreed in advance using a CHSS annual leave form which was signed by the claimant and Mrs Reid. Mrs Reid acknowledged that Mrs Taylor was conscious of the training schedule when arranging her annual leave and would inform Mrs Brennan accordingly. Mrs Kate McDonald was the MCN Co-ordinator. With regard to the claimant discussing her leave with the MCN team, Mrs McDonald said in her witness statement that "*This was necessary in order to take cognisance of other team members' commitments, and a courtesy to the team as a whole, and this leave information would then be relayed to CHSS accordingly. I am witness to Gillian Taylor's annual leave being discussed with Katrina, in order to accommodate both the service and Gillian's requirements*". Under cross-examination, the claimant agreed that this was correct. She said "*That was the right thing to do. We had to talk to each other. We had to tell each other where we were, what we were doing, and keep each other informed, you know. That is why I did that.*"
- 72 Mr Tariq set out in his skeleton arguments that a personnel file for the claimant was held by the defendant, and that this was also evidence of an implied contract of employment. Mrs McDonald confirmed in her witness statement that a personal file was held within the MCN Office. When questioned about this under cross-examination, the claimant agreed that the file was kept in the MCN Office but asserted that it should never have been transferred to them. She felt that it should have been kept at "practice development", her last NHS post before severance. Mrs Reid confirmed under cross-examination that she had her own file for the claimant, and CHSS HR department also had a file. Mrs McDonald confirmed, when questioned on the matter by Mr Tariq, that when someone moves within NHSL from one department to another, their file is passed on. She also said that nothing was added to the file during Mrs Taylor's time with the MCN team. Having heard the evidence in this regard, it appears that an NHS personnel file on Mrs Taylor was held at the MCN Office but it was not used by either NHSL or CHSS during the time the claimant worked in the MCN team. Since CHSS had functioning HR files that were being used, I consider this redundant file to be of little relevance to the argument.
- 73 An additional point raised by Mr Tariq with regard to the claimant's employment relationship is the fact that she described herself as being an employee of the defendant to others. He compared the situation to that in *Walter's Applications*¹¹, where Dr Walters referred to himself as Commercial director or CEO when it suited him. Mrs MacCormick says in both of her witness statements that Mrs Taylor informed her that half of her salary was paid by NHSL, but that her actual work contract was with CHSS. It is true that in an article in *Innovation and IP* magazine Mrs Taylor was referred to as an NHS Lanarkshire Emergency Department Nurse, and in a *Daily Record* article she was referred to as a nurse in Monklands General hospital, where she once worked in the A&E department. This stems from the ongoing confusion that her employment when she had the original idea of combining a Patslide with a weighing means was fundamental to her IP rights. As has been established above, this idea did not constitute the invention in question here. As such, any reference to her employment at that time cannot be understood as Mrs

¹¹ [BL O/272/05](#)

Taylor trying to assert NHSL was her employer when the invention was developed with Cramasie.

- 74 In their counter-statement the defendant also refers to an email sent by the claimant on 17 February 2016 in which she stated "*That's good as NHSL will be paying in the respect I am off work*" as evidence that she considered herself an employee of the defendant. I am not clear how this can be inferred from the sentence above and I note that this email was not relied upon in this way at the hearing. This email, however, was relied upon as evidence of NHSL covering the claimant's expenses, and this is a point I will return to later.
- 75 Returning to the question of whether Mrs Taylor was subject to the control of NHSL to a sufficient degree to make it her "master" as per *Ready Mixed Concrete (South East) Ltd v Minister of Pensions and National Insurance*, I find that the evidence in this case points clearly to the claimant already having a clear "master" in the form of CHSS. The defendant states in their skeleton arguments that "*It is accepted that the Claimant was employed by CHSS from around 29 October 2012. It is accepted that the claimant's written employment contract was with CHSS*". As such, although consideration must have been given to the objectives of the Stroke MCN team when carrying out her work and arranging annual leave, the claimant would have had no reason to think there was an implied contract of employment with NHSL alongside the obvious one with CHSS. It is inevitable when people work together in a team, and that team has a leader, that the leader will have some control over how the objectives of the team are delivered. However, this is not necessarily an "employment relationship". Mrs Taylor was already subject to control in an employment sense by her CHSS line manager, Mrs Reid, who gave evidence that her roles and responsibilities were as the claimant's line manager. This fact was accepted by the defendant's witnesses; Mrs Brennan said under cross-examination "*I would agree that Lynn Reid was a direct line manager*", and Mr Lauder also agreed that "*Lynn Reid was Gillian's strategic manager at CHSS at the time*".
- 76 I do not think there is any doubt from the evidence before me that that the claimant worked solely for CHSS. As such, her right to the invention would lie first with CHSS if she made the invention as part of her normal duties or duties specifically assigned to her. However, if she made the invention in her own time then any rights would lie with her.

Was the invention made as part of Mrs Taylor's normal duties or duties specifically assigned to her?

- 77 The claimant's role was in the field of stroke education. Both parties agree that developing the invention was not something that fell within the remit of her normal duties in this role. She maintains in her witness statements and also under cross-examination that she was never assigned any duties relating to the invention, and that the majority of the work on the invention took place in her own time.
- 78 In her witness statements and oral evidence, Mrs Reid, the claimant's CHSS line manager, denies any assignment of duties for the claimant to develop the invention. She said "*Gillian's training priorities were directed in relation to the NHS Lanarkshire work plan as it was agreed that they had a better understanding of what local priorities were. However the work she was doing in relation to the PTS was not, to my knowledge, included in the work plan and it was certainly never indicated to me that she was expected to carry this out in her 32.5 hours contracted to CHSS*". The

PTS referred to by Mrs Reid is the patient transfer board, i.e. the invention. Mrs Reid said she was aware of the project and was supportive of it only under the condition that the claimant prioritised her service responsibilities and carried out work on the invention in her own time.

- 79 The claimant acknowledged under cross-examination that she was given some time to attend meetings, but that the vast majority of the time spent was her own time. Mrs Reid also clarified in her oral evidence that throughout the process of developing the invention, the claimant was meeting “*all of her objectives and more*”.
- 80 The claimant had a managed time agreement in place and explained in her witness statements and oral evidence that any time spent working on the invention during normal office hours was made up at a later date using this flexibility. Mrs Reid described the claimant in her witness statement as “*very conscientious*”, and Mrs Brennan also said under cross-examination that the claimant worked hard, often over her allotted time. Mrs Brennan also agreed that it was possible that the claimant could have been using her managed time agreement to make up the hours, although admitted that she did not keep a record of the precise amount of time spent on developing the invention.
- 81 The claimant was supported and encouraged by NHSL to develop the invention. The Stroke MCN team in particular were supportive as they could see how the invention might benefit the NHS. Mr Lauder said under cross-examination that he was keen to develop the invention because it would be a good tool to use in delivering care, not just for the IP rights. He said it was regarded by everyone as an NHS project: “*We are here to provide health and social care and this product is clearly, in the way it is being used by clinicians across the world now, is a very important tool in providing that. That is our motivation. The IP ownership was never central to our thoughts in that respect.*” He also said that “*This was being done very much as a Health Board sponsored activity.*”
- 82 The support for Mrs Taylor within the NHS came not only in the form of the significant services of SHIL, the innovation support organisation for the NHS in Scotland, but also in the form of collaboration in meetings with NHS staff such as Mr Lauder and Mrs Brennan, access to expertise to discuss matters of manual handling and infection control, and use of NHS premises and staff for focus groups. It is clear from Mrs Sheena MacCormick’s witness statement, which sets out the times and places of various meetings, that some of them were on NHS premises and involved a number of NHS staff. Also, the resources provided by SHIL, which were substantial, were only intended for NHS employees. This support was most likely provided to the claimant because NHSL believed that they would own the IP rights in any invention developed.
- 83 On the subject of support provided by SHIL, Ms Higgins argues that the claimant was wrongly advised by SHIL that her employer would own her invention, and that SHIL proceeded on the misunderstanding that NHSL would own the invention even though they were informed of the fact that the claimant was employed by CHSS. This is a situation which is complicated by the fact that the claimant was employed by the defendant when she had her initial idea as an emergency department nurse in 2007/2008 (an idea which all parties agreed did not constitute an invention). It appears from her witness statements that Mrs MacCormick accepted the fact that the defendant was the claimant’s current joint employer without much further investigation and did not consider whether the idea conceived in 2007/2008 was an

“invention”, or whether any invention subsequently deriving from the claimant’s idea would rightfully belong to her employer. It seems that further investigation into the inventive contribution of those involved in the project did not occur at the time of filing the application. Likewise, Mr Lauder, Mr Raymond Hamill (the Corporate Research and Development Manager for NHSL) and Mrs Brennan were aware of the claimant’s employment contract with CHSS and did not stop to consider if it was appropriate to invest SHIL resources. Since I have concluded above that the claimant was employed by CHSS alone, it seems that the use of SHIL and other NHSL resources was, with hindsight, inappropriate, but this investment of time and money by both SHIL and NHSL would not, on its own, render the invention the property of the defendant.

- 84 The defendant asserts that the inventive concept was devised in the course of duties which were specifically assigned to the claimant by NHSL and CHSS. Mrs Brennan said in her witness statement, and confirmed under cross-examination, that the claimant had been authorised to work on the invention within her working hours by Mr Lauder and herself: *“She absolutely knew that she was working on the project with support from many people from within NHS Lanarkshire during the time that we paid for her to deliver education, so there was time made for the project as part of Gillian’s role”*. She said that Mrs Taylor spent a significant amount of time on it *“during working time”*. Mr Lauder has provided a letter to Mr Alan Cowie, the current CEO of CHSS in evidence, which says that at the time he understood the claimant to be specifically assigned to work on the invention. However, this letter was written after these proceedings were launched and Mr Lauder admitted under cross-examination that he did not draft it himself.
- 85 Mr Tariq argues in his skeleton arguments that the development of an invention was the object of these duties and so the claimant’s rights to the invention would belong to her employer under section 39(1)(a). I have established above that the claimant was not employed by the defendant when the invention was being developed and therefore was under no obligation to perform any task specifically assigned to her by NHSL. It was Mrs Taylor’s employer, CHSS, that could specifically assign duties to her, and any rights derived as a result of duties specifically assigned to her would belong to CHSS alone. However, Mr Tariq also put it to me that in this circumstance the defendant nevertheless derives ownership via CHSS as a result of an agreement between NHSL and CHSS dated 5 June 2020 which was submitted in evidence. This document is signed by Mr Lauder of NHSL and Mr Cowie of CHSS. As a result, if the claimant is found to have developed the invention as a result of duties specifically assigned to her, her rights would still pass to the defendant.
- 86 In their counter-statement the defendant points to the email of 17 February 2016 in which Mrs Taylor says *“That’s good as NHSL will be paying in the respect I am off work”* to show that SHIL covered her expenses for meetings in relation to the Patient Weighing Device, indicating that these were duties assigned to the claimant by the defendant. Mr Tariq referred me to *Harris’ Patent*¹² and *Prosyscor v Netsweeper*¹³ when pointing out that the development of the invention was the aim of these duties which were funded by SHIL, and that this is far removed from an employee devising an invention in her own time, using her own resources and expertise. When questioned under cross-examination about the fact that SHIL paid expenses for this meeting, Mrs Taylor said *“Because I was taking a day off my work, what I did not*

¹² [1985] RPC 19

¹³ [2019] 1302 (IPEC)

want was to then start to pay for hotels, and quite rightly so they should have been paying for it.” I agree with Mr Tariq that the invention was not developed by the claimant using her own resources and expertise, and it is clear that she had substantial support from SHIL in terms of resources. However, as I have established above, she was not an employee of the defendant at the time and only CHSS could assign her duties.

- 87 It is not clear why the claimant would use her own time to develop the invention when it appears to have been universally acknowledged at the time that it was an NHS project and any IP rights would lie with the NHS. It is clear from the record of meetings and focus groups that took place that many of them were within what would be considered normal office hours. However, we also know from Mrs Reid’s witness statement that the claimant often had to work in the evenings delivering training and thus banked time to use under her managed time agreement. This was a system that operated mainly on trust, and no record was kept of the time spent working on the invention. We also have evidence in the form of Mrs Brennan’s statements under cross-examination that the claimant was conscientious and still had full responsibility for delivering the normal duties of her role in accordance with the service level agreement between CHSS and NHSL. In the email sent on 17 February 2016, the claimant states that she will be “*off work*” during a meeting with Marsden Weighing, and she said under cross-examination that she also took annual leave for her meetings with Mr McCorkindale of Cramasie.
- 88 On balance I find that Mrs Taylor did do most of the work on the invention in her own time, even if it was out of necessity because she was still fulfilling her normal role, rather than a belief that this might provide her with any rights in the invention.
- 89 Although Mr Lauder and Mrs Brennan of NHSL have both attested to the fact that they assigned the claimant duties to work on the invention, it is clear that Mrs Reid, her CHSS line manager, did not assign her any such duties. Indeed, she insisted that it be done in the claimant’s own time. Since it has been established above that CHSS are the claimant’s employer, her CHSS line manager is the only one who can assign her duties. I conclude therefore that the claimant did not develop the invention in the course of her normal duties or in the course of duties specifically assigned to her.
- 90 Despite the substantial resources and expertise invested by NHSL and SHIL in helping the claimant to develop the invention, any rights deriving from her contribution to the inventive concept belong to the claimant. However, as set out above, I consider Mr McCorkindale to be a joint inventor as he contributed to the inventive concept during his work on the invention as leader of the team at Cramasie. A written document signed by Mr McCorkindale, confirming that any of his rights in the invention reside with Cramasie as his employer at the time, was submitted in evidence. Any IP which arose from the work carried out by Cramasie has been assigned to SHIL, and this is evidenced by a written document submitted in evidence and signed by the owner of Cramasie in 2020 (Mr David Crosland) and the director of SHIL in 2020 (Mr Graham Watson). Mrs Sheena MacCormick states in her witness statement “*The contractual agreement between SHIL and Cramasie ensured IP transfer from Cramasie to SHIL*”. A further assignment agreement submitted in evidence is signed by Mr Graham Watson of SHIL and a representative from Lanarkshire Health Board, having the effect of transferring the IP rights in the invention from SHIL to Lanarkshire Health Board. This was also dated August 2020. It is noted that these assignment documents are dated many years after the patent

application was filed, however they reflect the defendant's current position with regards to assignment of ownership rights and there is no evidence to suggest that any of the signatories dispute this. As such, the defendant is considered a co-proprietor via rights originating with Mr McCorkindale's contribution to the inventive concept and being assigned via Cramasie and SHIL to the defendant.

Personal bar

- 91 The defendant argues that the claimant is personally barred from challenging entitlement to the patent under Scottish Law. Both parties' arguments referred to passages from *Gatty v Maclaine*¹⁴, where Lord Birkenhead observed (at page 7):

"Where A has by his words or conduct justified B in believing that a certain state of facts exists, and B has acted upon such belief to his prejudice, A is not permitted to affirm against B that a different state of facts existed at the same time."

- 92 In this instance, the defendant relies upon the doctrine to bar Mrs Taylor from arguing that she should be entitled to the patent on the basis that she agreed that the patent should be filed in the name of Lanarkshire Health Board. The law requires (1) words or conduct by A, (2) which gave rise to a justifiable belief on the part of B, and (3) actings by B in reliance on that belief to his prejudice. The principle to be applied is based on the inference which one party is reasonably entitled to make from the conduct of the other. Reference was also made to the circumstances in *Wilson v Enviromax Ltd*¹⁵, which Mr Tariq considered analogous to the facts here. He argues that the claimant did not dispute the defendant's entitlement to the grant of the patent until very recently, and that she accepted considerable help from SHIL to develop the invention. The support from SHIL was given on the basis that the invention developed would be owned by NHSL. She was aware and involved in the patent application process and made no objection to it being filed with the defendant as owner.

- 93 As noted by the Hearing Officer in *Wilson v Enviromax*, "*there are three components to personal bar: misrepresentation, reliance and detriment. The defender needs to establish all three.*" Mr Tariq argues that SHIL relied upon Mrs Taylor's agreement to it having the rights to any IP when it made the decision to invest. He argues that SHIL have spent 1,758 office hours on the project, invested considerable funding in the development of the design and met the legal costs of drafting and filing the patent application, which is to their detriment. NHSL have also provided resources in the form of facilities and support from staff such as Mr Colin Lauder and Mr Raymond Hamill.

- 94 Mr Tariq also makes the point that at the time when Mrs Taylor approached SHIL to discuss developing her idea, there were no rights, as no IP existed. He argues that what was agreed from the outset was that any future rights would reside with NHSL. He draws similarities with the situation in *Wilson v Enviromax*, where the claimant in that case misrepresented to the defender that he was content for the application to be filed in the defender's name.

- 95 Ms Higgins argues that SHIL was responsible for advising both the claimant and the defendant that any IP rights would belong to the defendant, so party A in the passage quoted above from *Gatty v Maclaine* is SHIL, not the claimant. She also

¹⁴ 1921 SC (HL) 1

¹⁵ BL O/403/15

argues that for the doctrine of personal bar to apply, the person subject to the bar must have been aware that they had the right which they now seek to assert. Thus the defendant would have to show that, at the time of filing the patent, Mrs Taylor knew she was entitled to be named as proprietor and/or she knew that the defendant was not entitled to be named as proprietor. She refers to an extract from “The Law of Scotland”¹⁶ which says:

“3.06...At the time of so behaving the person barred must have known about the right; one cannot be barred from asserting a right of which one has been ignorant, and in this respect personal bar differs from prescription. There are two aspects to be considered in establishing the requisite level of knowledge. In almost all cases the obligee must have been aware of the factual background supporting the right and allegedly barred. In addition, the bar requires the person barred should have understood the legal implications of that background as they affected him or her. However, the requisite level of knowledge is normally presumed, except in exceptional circumstances such as where the person allegedly barred is clearly disadvantaged relative to the obligor”.

- 96 Ms Higgins argues that Mrs Taylor was an individual with no experience of the law and had limited resources. As such a requisite level of knowledge should not be presumed. She was at a clear disadvantage with regards to the defendant who had an R&D manager in the form of Mr Raymond Hamill and an Innovation Director in the form of Mr Colin Lauder. Ms Higgins also argued that the defendant should have to show that the claimant was aware that she was in fact entitled to the patent and they were not, and they cannot do this. She then argued that the defendant would have to show that the claimant’s conduct gave rise to a justifiable belief that they (the defendant) were entitled to the patent. In fact, she argues, it was SHIL who advised the defendant that they had rights, not the claimant.
- 97 Also, in order to invoke personal bar, the defendant would also have to show that it had acted in reliance on that belief to its prejudice. Ms Higgins argued that the defendant proceeded with the patent application on the reliance of discussions with SHIL and on the advice of Mr Hamill that the IP should rest with the Health Board, not because of anything the claimant said or did. As to the matter of detriment, Ms Higgins argued that any investment of time or money has been made by SHIL, not by the defendant, and SHIL is an independent organisation. Mrs Sheena MacCormick from SHIL also gave evidence to the effect that it is SHIL who takes the risk when developing innovative ideas. What’s more, SHIL recoups all of its investment as a condition of the licence agreement with the claimant and is well on the way to recovering all of its of costs. As a final point Ms Higgins asserts that any personal bar would only apply to the GB patent, and not those in the first and second families.
- 98 In *Wilson v Enviromax*, the pursuer actively wanted the application filed in the name of Enviromax, and he did not think it was his only option. The Hearing Officer said *“It is not the case that Mr Wilson mistakenly thought he had to go along with the patent being filed in Enviromax’s name because he was an employee”*. However, this does seem to be the situation here – the claimant was under the impression that she had no rights to the invention as this is what she was advised by SHIL. Whether this is because, when she approached SHIL, she explained that she had her first idea when she was an emergency department nurse working for the defendant, or whether it was because she understood that the conditions of SHIL’s assistance meant that they would own the invention, or a mixture of both. Mrs MacCormick says in her

¹⁶ “The Law of Scotland” (14th edn.), Gloag & Henderson

witness statement *“my understanding, which was also the understanding of SHIL at that time, was that Intellectual Property relating to place of work would be owned by the employer. I provided Gillian with this information in good faith and explained that I could put her project forward for SHIL support and funding following an evaluation of the idea”*.

- 99 Mrs MacCormick tells us in her witness statement and under cross-examination that she took the project forward on the basis that half of Mrs Taylor’s salary was paid for by NHSL and that the claimant first had the idea when working as an A&E nurse for the defendant. In her oral evidence she said *“To me, it did seem that there was an NHS involvement”*. She advised the claimant that SHIL would only take it forward on the basis that the Health Board would own any Intellectual Property: *“if we were involved it would be on the basis of the Health Board owning the IP, viewing Gillian as an employee of the Health Board and that her rights as an employee would be with the Health Board”*. This would seem to be going about things backwards – deciding who employs a person and thus owns their IP on the basis that they would like to develop the idea. An email from Mr Hamill (copied to Mrs MacCormick, Mrs Brennan and Mr Lauder) dated 12 February 2015 is the first in which it is acknowledged that the claimant’s current employment was with CHSS and perhaps agreement should be sought that they have no interest in the invention. The claimant replied to this email that she had the original idea while working for the defendant as an A&E nurse and she understood that IP lies with the employer. There is no evidence that this situation was investigated any further by anyone involved in the conversation. Under cross-examination Mr Lauder said *“The advice that I received from both Raymond Hamill and also Sheena MacCormick was that -- again, bear with me. I am no expert in these matters but the advice was that if a person in their employment developed an idea, then the intellectual property rights would belong to the employer, which I think is obviously the heart of the dispute in this case. As I say, that was the advice I received, and I think there were various forms of communication to that effect.”* The claimant reiterates her understanding of the situation as late as 23 April 2019 in an email to Calum Campbell where she still appears to be under the impression that as the defendant was her employer when she had the initial idea in 2007/2008 that they are entitled to the rights. In her witness statement Mrs Brennan confirms this when she says she discussed IP ownership with the claimant and *“she was very clear that she had the idea when working with NHS Lanarkshire”*.
- 100 All parties are in agreement now that the initial idea conceived when the claimant worked as an A&E nurse is not the subject of the invention in question. However this was a matter of confusion at the time for the claimant, who is not an IP professional, and also a matter of confusion for Mrs MacCormick at SHIL, who made decisions and gave advice on the basis of there being “NHS involvement” without digging any deeper. Indeed Mrs MacCormick, Mr Lauder and Mr Hamill appeared to proceed with the project on an assumption that because SHIL was funding the development then it follows that they would own the IP, and that telling the claimant this was sufficient to make it so. Mrs MacCormick said *“I made it very clear in that SHIL’s involvement meant that the IP needed to be owned by the NHS”*.
- 101 I have no doubt that all parties were clear about the fact that SHIL were investing on the basis that the defendant would own the IP, including the claimant. In order to invoke the doctrine of personal bar, what I need to establish is whether, when the decision to proceed with the project was made, the claimant had the knowledge that she could potentially have rights to the IP and chose to proceed under SHIL’s

conditions regardless. As argued by Ms Higgins, someone cannot be barred from asserting a right they did not know they had. I accept Ms Higgin's assertion that the claimant, as an individual with no knowledge of the law and no background in IP, was disadvantaged in relation to the defendant's organisation, who had employees specifically employed to understand and oversee innovation. Thus, her level of "knowledge" as to the factual background and the legal implications of that background cannot be presumed, and she was guided by what she was advised. She states in her oral evidence *"Sheena MacCormick told me that my employer owns my idea and that I had no legal rights to my idea, and even if I wanted to go ahead and take my idea forward then I would have to seek approvals from the board. And my stomach sank at that point slightly, but a very good -- and my view offer was put on the table, but that was because I had not a full understanding of the law at that point."* Also, in her witness statement, the claimant states *"I strongly object to the latter part of Colin's statement that I was in full agreement that any IP developed would belong to the board. I was not included in the agreement as the assumption was already made that I had no entitlement to IP in the first instance and that is what I was told. Therefore, why on earth would I approve the IP to go to the board? If this had happened and I was asked to assign rights to the board I would certainly have questioned it at this point."*

102 Mr Tariq argues in his closing submissions that Mrs Taylor entered into discussions with SHIL with her "eyes wide open" as she was aware when she approached them that they only took forward NHS employee ideas. She also agreed to file the patent in the name of the defendant. However, as established above, it is clear that Mrs Taylor was under the impression that she had the original idea when working for the defendant in A&E, and as someone with no IP knowledge she had presumed any IP would belong to her employer at that time. She didn't hold SHIL to ransom, they were free to make the decision as to whether to invest in the project or not. It is SHIL's responsibility to investigate how to appropriately use their resources. Mr Tariq made reference in his closing submissions to how the claimant tried to establish links with the NHS by providing information about the funding of her post, and her place of work. When questioned about this under cross-examination Mrs Taylor admitted she wanted to *"demonstrate that I was happy for NHS Lanarkshire to take it forward"*. As I see it, the information, or "links" to the NHS that the claimant provided were just facts about her situation, and it is not surprising that she was happy for NHSL and SHIL to take it forward when she was under the impression that the rights to her idea would belong to NHSL regardless.

103 Having considered the law and the evidence presented by both sides, it seems to me that the claimant believed that she had no rights to any existing or future IP and so was accepting of the situation presented to her by SHIL at the time. She didn't willingly support the filing of the patent application in the defendant's name while being aware that there might have been other options. The doctrine of personal bar exists to address inconsistency in behaviour, but I cannot accept that the claimant acted with inconsistency with regards to asserting her rights as she was not aware that she may have been entitled to any rights at the time when she acquiesced to the patent application being filed in the name of the defendant. As such the doctrine of personal bar does not apply. Since I find there is no personal bar in relation to the claimant's rights with regard to the patent in question, I also find there is no bar in relation to the patents in the first or second families.

Is the claimant's application challenging the entitlement to the patent out of time?

- 104 The defendant asserts that the claimant has brought her entitlement action out of time, as the remedy of transferring the granted patent to the claimant is only available where the entitlement proceedings are commenced within two years of the second anniversary of grant of the patent. Section 37(5) of the Act reads:

On any such reference no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) above on that ground, if the reference was made after the second anniversary of the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

- 105 An exception to this time bar applies if the claimant can show that, at the time of grant of the patent, the defendant knew it was not entitled to the patent. Mr Tariq set out in his skeleton arguments that the burden is on the claimant to show that the defendant had knowledge at the time of grant that it was not entitled to the patent. He referred to the Hearing Officer's comments in *Farr v Orbis Corporation*¹⁷ where he described this test as a "high hurdle to overcome". The purpose of section 37(5) is to prevent stale claims and provide certainty. He referenced the *CIPA Guide*¹⁸ which states that a finding that the defendant "must have known" it is not entitled is insufficient. He also argued that a finding that the defendant "ought to have known" is insufficient. He referred to *Lockheed Martin v Hybrid Air Vehicles*¹⁹ and *Darenth Vending Services/Parr's Patent*²⁰ in which the Hearing Officers considered the requirement in section 37(5) to be a subjective test of the defendant's knowledge at the time. He went on to argue that there is no evidence to show that the defendant knew it was not entitled to the patent. It believed itself entitled at the time of grant of the patent and evidently still does, thus these proceedings.
- 106 Ms Higgins, for the claimant, accepts that this reference was made after the second anniversary of the date of grant of the patent, but argues that the time bar does not apply. She contends that the defendant did know it was not entitled to the patent at the date of grant because it knew that, at that time, the claimant was working under a contract of employment with CHSS and was not an employee of the defendant. At least, she argues, the defendant knew it was a joint employer with CHSS as that is what is contended in these proceedings. She claims that the defendant also knew the claimant's duties did not include inventing or product development, and that the claimant had not been assigned any such duties.
- 107 Ms Higgin's argues that it is enough to show that the defendant "must have known" that it was not entitled to the patent. She cites *Angle Ring Co. Ltd. v ASD Westok Ltd.*²¹, where Hacon HHJ sets out the test to be applied when assessing 'knowledge':

"...in any circumstances where a court must decide on the subjective knowledge of an individual, plainly the court cannot literally probe into his mind. Far less is that possible when the relevant date for such probing is in the past. So what the court must do is look at all the surrounding circumstances and come to a conclusion, on the balance of

¹⁷ [BL O/161/08](#)

¹⁸ CIPA Guide to the Patents Acts (9th ed.), commentary on section 37, paragraph 37-11

¹⁹ [BL O/235/08](#)

²⁰ [BL O/46/94](#)

²¹ [2015] EWHC 2779 (IPEC) – para 15

probabilities, whether those surrounding circumstances point to a conclusion that the individual had the requisite subjective knowledge or not. Putting this, I think, colloquially, what the court is having to decide, on all the relevant evidence is whether the individual in question must have known the relevant facts. Mr Austen sought to suggest that there is a distinction between (a) proving that the patentee knew that he was not entitled to the patent and (b) proving that he must have known that he was not entitled to the patent. That, it seems to me, is a false distinction. In practice, they amount to the same thing. The latter is in reality what the court will decide at trial in order to reach conclusion as to the former.”

- 108 The relevant facts as set out by Ms Higgins above are however those that are in dispute at these proceedings. The defendant argues that there was an employment relationship between itself and the claimant. Regardless of my findings, which as I have set out above are not in agreement with the defendant on these matters, the defendant’s position has been clear. We have evidence in the form of Mr Lauder’s witness statement that the NHSL staff involved in the project believed there to be an employment relationship “*this was a partnership arrangement*”. When Mr Hamill set out his understanding of the claimant’s employment in his email of 12 February 2015, he said “*I...am happy that IP ownership should rest with NHS Lanarkshire*”. Nevertheless, he asked Mrs Brennan to confirm that CHSS had no interest in the IP, and eleven days later Mrs Brennan replied that “*I spoke to David Clark last week and he is happy that NHSL has IP on this work*”. David Clark was the Chief Executive of CHSS at the time. When questioned about this email under cross-examination, Mrs MacCormick said “*What I understood was that Chest Heart & Stroke Scotland were happy for the NHS to have ownership of the IP*”. Mr Lauder told us “*CHSS were in agreement that any IP developed (which was not guaranteed at the start) would be the Health Board’s*”
- 109 Mrs MacCormick also said in her oral evidence “*Because it was a joint role, we just wanted to make sure that there was not also a joint ownership of IP. As far as I was aware, it was agreed with Chest Heart & Stroke Scotland. It was agreed then and then it was agreed later.*”
- 110 None of this evidence points to the defendant believing they were not entitled to the patent. In fact, it seems to show that matters had been sorted and that the defendant would be entitled to the IP. There was no evidence submitted which suggests the defendant knew that the claimant had any entitlement. The only seed of doubt, which was ultimately considered to have been resolved, was whether CHSS may have rights. Ms Higgins pointed to the passage in *Angle Ring*¹⁸ above, which states that what I have to decide is whether the defendant knew all the relevant facts. The “facts” as argued by the claimant are that she was employed by CHSS and is entitled to rights in the patent. But we can see from the evidence submitted that these are not what the defendant, rightly or wrongly, considered to be the facts. Mr Tariq referenced a passage in *Lockheed Martin v Hybrid Air Vehicles* in which the Hearing Officer said (at paragraph 16):

“At root, it seems to me, the argument was over whether the requirement in section 37(5) is for objective or subjective knowledge on the part of the patent applicant ... In my view, the words of the statute are crystal clear. The legislation says “knew”, not “knew or ought to have known” ... I can see no way to read this as other than a subjective test, and I was not shown any case law which might cast doubt on the plain meaning of the words.”

- 111 Mr Tariq further referenced *Darenth Vending Services/Parr’s Patent* where the Hearing Officer commented (second paragraph, page 5):

“It is an overriding requirement of section 37(5) that a reference under section 37 must be made within two years of the grant of the patent ... unless it is shown that the person registered as the proprietor... knew at the time of the grant that he was not entitled to the patent. However, the mere unsupported assertion in paragraph 7 of the declaration dated 22 October 1993 that Mr. Parr was an experienced director “who would have known or ought to have known that he was not entitled to the Patents in suit” does not appear sufficient to satisfy the above requirement, notwithstanding the submissions on the interpretation of that section contained in that declaration.”

- 112 It is possibly the case that the defendant ought to have known that they were not entitled, had they taken the time to fully investigate the employment situation of the claimant. But I am in agreement with Mr Tariq that this is a subjective test of the defendant’s knowledge at the time, and I can find no evidence to suggest that they were not of the opinion that they were entitled to ownership of the patent. The claimant herself, at the time, believed the facts to be that her employer owned the right to any IP. She says in her oral evidence *“I just knew I was not entitled and it was my employer that owned it because that was the mantra that was told to me”*. I cannot accept that the defendant might have known the rights lay with the claimant when she “knew” this was not the case herself.
- 113 Ms Higgins argued that the defendant was told by SHIL that CHSS could have rights in the invention. This issue was discussed in the 12 February 2015 email referred to above. She argues that the email from CHSS is not enough to give ownership and is at best an indication that they were not planning on challenging the rights of NHSL. I agree that this is true, but it is not necessarily how the defendant understood the situation at the time. Mrs Brennan’s email from the Chief Executive of CHSS was quite definitive *“I spoke to David Clark last week and he is happy that NHSL has IP on this work”*. It is apparent that no formal written agreement was entered into in 2015 beyond these emails. Ms Higgins argues that the confirmatory assignments and agreements which have been produced in 2020 as a result of these proceedings show that the defendant accepts there were difficulties with its position in 2015. However, I consider it more likely that the fact the defendant proceeded without any such formal agreements in place in 2015 shows it had confidence in its position as the owner of any rights to the invention. It seems likely that if the defendant did believe there were difficulties with the situation in 2015 that they would have made more of an effort to have formal agreements in place at the time.
- 114 Ms Higgins also argues for a fall-back claim where the claimant is named as joint proprietor along with the defendant. How then does the time bar of section 37(5) apply in this situation where entitlement to a share of the patent is being sought? Ms Higgins referred to *Cicada Cube Pte Ltd. v National University Hospital (Singapore) Pte Ltd.*²², this being a case argued in the Court of Appeal in Singapore, a country with very similar IP law to the United Kingdom. In this decision the Judge agrees that the test of knowledge is a subjective one (at para 55), which is little surprise given the reference back to *Lockheed Martin v Hybrid Air Vehicles*:

“This is a subjective enquiry: the proprietor must have actually known that it was not entitled to the patent and it is not enough that it ought to have known”.

- 115 However, the Judge then goes on to say at paragraph 57 that it is enough for the claimant to show that the defendant knew it was not solely entitled to the patent:

²² *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52

“it suffices if the applicant can prove that the proprietor knew that it was not solely entitled to the patent. In other words, the applicant can satisfy his burden under s 47(9) of the Act by showing that the registered proprietor knew that he was not entitled at all to the patent or by showing that he knew that some other person or persons were also entitled to the patent. In our judgment, this is implicit in s 47(9) and is eminently fair.”

- 116 The Judge found that Cicada was not solely entitled to the patent as it knew that its employees had worked closely with a third person who had contributed to the inventive concept and was not employed by Cicada. Ms Higgins argues that NHSL knew that there was a risk that CHSS had rights in the patent, evident from the 12th February email from Mr Hamill, and there was no proper agreement put in place to deal with this.
- 117 The situation in Cicada is not completely analogous to this case – here the defendant knew that the claimant and Cramasie were working on the invention and believed it had rights via both. When the issue of whether CHSS may have rights came up the situation was resolved, apparently by an unrecorded conversation between Mrs Brennan and David Clark, which is referred to in Mrs Brennan’s email of 23 February 2015 *“Yes I spoke to David Clark last week and he is happy that NHSL has IP on this work.”* I accept Ms Higgins’ point that this is far from an official agreement, but there is no evidence to suggest that it was not satisfactory for the defendant to continue in the belief that IP would belong to them.
- 118 In his email of 12 February 2015 Mr Hamill also says *“The idea, as Katrina can attest, was initially envisaged when Gillian was an employee of NHS Lanarkshire – employed as an A&E Nurse but working in Older People’s Care. NHS Lanarkshire now intends to support Gillian, in conjunction with Scottish Health Innovations Limited, in taking her product forward to prototype, and potentially production. As the idea came about through Gillian’s NHS Lanarkshire employment, the IP rests with NHS Lanarkshire”*. It seems clear from this that the defendant, like the claimant, was still operating under the illusion that Mrs Taylor’s employment at the time of her original idea meant that they were entitled to the IP rights as her employer.
- 119 Given that, as stated by Hacon HHJ in *Angle Ring*, *“the court cannot literally probe into his mind”* when deciding what the subjective knowledge of the individual was, it must be decided on the balance of probabilities. I conclude from the evidence set out above that the defendant believed it was entitled to be sole proprietor of the patent when it was granted, and that the s.37(5) time bar does apply to the relevant orders.

Which orders are affected by the time bar?

- 120 Ms Higgins pointed out that even if the time bar does apply, it only limits the ability to grant those specific orders mentioned in section 37(5), namely transferring the patent on the ground that it was granted to the person not so entitled and the orders mentioned under s 37(4) concerning making a new application for a patent. The relevant parts of section 37 are set out below:

37(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question –

- (a) who is or are the true proprietor or proprietors of the patent,*
- (b) whether the patent should have been granted to the person or persons to whom it was granted, or*
- (c) whether any right in or under the patent should be transferred or granted to any other person or persons;*

and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.

(2) Without prejudice to the generality of subsection (1) above, an order under that subsection may contain provision –

(a) directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;

(b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;

(c) granting any licence or other right in or under the patent;

(d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.

...

(5) On any such reference no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) above on that ground, if the reference was made after the second anniversary of the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

121 Ms Higgins argues that I can make any of the orders under section 37(1) in relation to determining the question of the true proprietor of the patent and whether it should have been granted to the person it was granted to, and whether any rights should be transferred. Section 37(5) may prohibit the actual transferring of the rights in the patent, but it does not prevent findings on those matters under section 37(1). She also argues that if the time bar does apply, as I consider it does, I should make an alternative order. She refers to the *CIPA Guide*¹⁵ page 502, which relates to the sub-sections of section 37:

"However, the wording in subsection 9 is different from that in subsection 5. In subsection 9 the wording prevents the court from exercising its declaratory jurisdiction to decide whether a patent is granted to a person not entitled to it. In subsection 5, the wording is less restrictive. It does not prevent the comptroller from, for example, ruling on entitlement or granting licences, but it does prevent him from making certain types of order that would otherwise be opportune under section 37, namely transferring the patent or allowing a new application to be filed under section 37(4)."

122 Mr Tariq considers that the time bar applies to determining the questions under section 37(1), as well as to making the orders under section 37(2).

123 Having considered the precise wording of the Act and the passages quoted from the *CIPA Guide*, I do not consider that section 37(5) prevents me from determining the questions in section 37(1) or from making the orders under section 37(2). It very clearly prohibits transferring of the patent if I find that it was granted to a person not so entitled, and it clearly prohibits orders under sub-section (4). It was agreed at the hearing that should the time bar bite, further submissions as to the exact orders I should make would be made either orally or in writing, so I will invite those before coming to a decision on that matter.

The first and second patent families

- 124 As noted above, all of the patents and applications comprised in the first family stem from PCT application WO2017072527, which claims priority from the patent. In addition, the Hong Kong application is wholly dependent on the European application by virtue of the fact that the European application is the designated patent application for the Hong Kong application. The claimant's arguments in relation to the patent apply *mutatis mutandis* to the first family. As already noted above, the time bar in section 37(5) does not apply to the applications comprised in the first family because section 37(5) applies to patents granted under the Act. The claimant notes that although the US application was granted on 8 September 2020 as US patent 10768040, this grant occurred after the present proceedings had been commenced. They say that that the US patent is still properly capable of consideration for the purposes of section 12 and refer me to paragraphs 94-98 in *Innovia Films Ltd v Frito-Lay North America Inc*²³ as the authority for this.
- 125 For the second family, the claimant says that the defendant has sought to register patents comprising the same inventive concept as the patent in numerous jurisdictions and listing inventors other than the claimant (CN210802650, TWM593536, AU2020100308, TWM582580). All of these have proceeded to grant apart for the Chinese application.
- 126 The defendant does not contest that the inventive concept of the patent is the same as in the first family of patents, so my findings in respect of inventorship and entitlement to the patent should be consistent with the first family. For the second family, the defendant says that the various applications were filed after the publication date of the patent, and thus to be patentable, the second family must be novel and inventive over the disclosure made in the patent. Accordingly, the inventive concept of the second family cannot be the same as the patent. The defendant says that the second family relates to optimisation of load cell layout providing increased accuracy of weighing and that this optimisation was conducted in Taiwan by a third party manufacturing and development company contracted by the licensee of the patent under the supervision of the licensee. The defendant adds that the claimant had no discussions whatsoever with the third party company and therefore has no entitlement to the second family of patents.
- 127 The second family of patents are directed to a weighing device incorporated into a Patslide, which has a number of transducers arranged under the surface of the board in a particular configuration. The configuration is different from that set out in the first family of patents, comprising fourteen sensors where 85% are arranged 150mm or less from a side of the weighing surface. In the first family of applications at least eight transducers are required, where 45% are arranged 100mm or less from an outer boundary of the board. Referring back to paragraph 44 above, I have already considered the inventive concept to be:

a weighing means incorporated within a patient transfer board which facilitates weight measurement to a desired accuracy even when a patient is not located centrally on the patient transfer board, by using a specified arrangement of transducers located under the surface of the board

I do not consider the different specific arrangement of the transducers in the second

²³ [2012] RPC 24

family of patents to confer a different inventive concept, it is still a “specified arrangement” as required above. The specific arrangement set out in the second family is merely a claim limitation resulting from optimising the invention with a different goal of accuracy in mind. The inventive concept of both families of patents is the same. Mr Tariq argues that these claims set out in the second family of patents, since they have been granted after the publication of the patent, must contain a different inventive concept or they would not have been granted. However, both Mr Tariq and Ms Higgins referenced *Actavis UK Ltd v Eli Lilly and Company*⁶ in their skeleton arguments to point out that the inventive concept is the “inventive core” of the claim, which is ascertained by focussing on the problem underlying the invention. This is not the same as the “inventive step” which needs to be established by individual Patent Offices with respect to the prior art. In any case, this decision is not concerned with the validity or inventiveness of the second family of patents, merely inventorship and ownership. Since I consider Mrs Taylor and Mr McCorkindale to have been jointly responsible for devising the inventive concept above, I consider their contribution to the inventive concept to be the same regarding the second family as the first family. As such Mrs Taylor and the defendant are also considered to be joint proprietors of these patents.

Conclusion

- 128 I consider the time bar in section 37(5) of the Act to apply, but only to the remedy of transferring the patent or making a new patent. As such I have made determinations on the questions in sections 37(1)(a)-(c).
- 129 I do not consider Mrs Taylor to be personally barred from asserting her rights to proprietorship.
- 130 As set out above, I consider the claimant and Mr McCorkindale to be joint inventors. I do not consider the defendant to be Mrs Taylor’s employer, and I consider that she made her contribution to the invention in her own time. Mr McCorkindale has assigned his rights in the invention to the defendant via Cramasie and SHIL. The patent should have been granted to Mrs Taylor and Lanarkshire Health Board as joint proprietors.
- 131 Section 37(5) prohibits transfer of any rights in the patent to Mrs Taylor, although it does not apply to any of those patents in the first family and the second family which were granted within two years of the reference or are yet to be granted, as the section 37(5) time bar is two years from the date of grant. These patents may be subject to orders under section 37 or section 12. I will issue orders in relation to these patents after considering the submissions referred to in paragraph 123 above.
- 132 I have found that the first and second family of patents share the same inventive concept and that Mrs Taylor and Mr McCorkindale were joint devisers of that inventive concept.

Costs

- 133 Both sides seek an award of costs in their favour. I will invite detailed submissions on costs consequent to my findings above (together with those on the precise orders I should make) once the period for appeal set out below has elapsed, but will say now that I do not expect to depart from the standard scale set out at Annex A of Tribunal

Practice Notice 2/2016²⁴ based on how both sides have contributed to the efficient hearing of the case.

Appeal

134 Any appeal must be lodged within 28 days after the date of this decision.

Huw Jones

Deputy Director, acting for the Comptroller

²⁴ <https://www.gov.uk/government/publications/tribunal-practice-notice-22016/tribunal-practice-notice-22016-costs-in-proceedings-before-the-comptroller>