



## PATENTS ACT 1977

BETWEEN

Michael Stephens and Andrew Bartlett Claimants

and

Anthony Brian Mallows Defendant

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PROCEEDINGS

Reference under section 37 of the Patents Act 1977 in respect of  
GB patent number GB2537810 B

HEARING OFFICER

Phil Thorpe

Mr Majeks Walker appeared for the claimants and

Ms Jane Lambert appeared for the defendant

Hearing date: 24<sup>th</sup> and 25<sup>th</sup> January 2022

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## DECISION

### Introduction

- 1 This decision relates to a reference made under section 13 and section 37(1) of the Patents Act 1977 (“the Act”) concerning entitlement to UK patent GB 2537810 B granted 15<sup>th</sup> July 2020.
- 2 This is not the first time that the rights to the invention have been considered. The patent was originally filed in the name of Abmwaterstop Ltd with the current defendant, Mr Anthony Brian Mallows (“Mr Mallows”), named as the sole inventor.
- 3 In March 2018, Mr Mallows launched entitlement proceedings under section 8(1)(a) of the Act seeking that he, and not Abmwaterstop Ltd, be named as the sole proprietor. Before matters could be heard, Abmwaterstop Ltd, entered voluntary liquidation and withdrew from proceedings. This meant the reference under section 8(1)(a) was uncontested and after considering the facts and submissions made, in a decision dated 7<sup>th</sup> May 2019, I ordered that the application (as it was then) continue with Mr Mallows named as the sole proprietor<sup>1</sup>.
- 4 The present reference was launched by Mr Michael Stephens (“Mr Stephens”) and Mr Andrew Bartlett (“Mr Bartlett”) on 24<sup>th</sup> November 2020. They believe they should

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<sup>1</sup> BL O/234/19

be named as co-inventors and consequently co-proprietors of the patent. Mr Stephens and Mr Bartlett were the Directors of Abmwaterstop Ltd at the time it entered liquidation, and both provided witness statements in support of Abmwaterstop Ltd in the earlier entitlement dispute.

- 5 In May of 2021, I held a case management conference with the parties, hearing from both sides on a matter of whether the present reference should be struck out as an abuse of process. In my decision of 5<sup>th</sup> August 2021, I concluded that there had been no abuse of process and ruled against striking out the reference<sup>2</sup>.
- 6 The proceedings therefore continued albeit in manner that has not been smooth. In September 2021 Mr Mallows dispensed of his professional representatives to become a litigant in person. Despite this, from mid-October 2021 to mid-November 2021, the IPO and various other parties, some of whom are directly associated with these proceedings, started to receive lengthy and convoluted bundles of correspondence from a Mr Andrew Hall (“Mr Hall”). Some of this correspondence was purportedly filed on behalf of the defendant in these proceedings, and some of it was seemingly intended to serve as evidence in reply and or related to the proceeding in some way.
- 7 This was raised with Mr Mallows in an email of 8<sup>th</sup> November 2021, with a warning that the claimants may wish to make submissions on the material when dealing with the matter of costs. In an email of 10<sup>th</sup> November 2021, Mr Mallows apologised for the inordinate amounts of statements sent by Mr Hall and advised the Office that Mr Hall had been asked to not send any further emails on his behalf. This was reiterated by Mr Mallows in an email of 6<sup>th</sup> December 2021 where it was explained that *“Mr Hall had been requested to not submit any written material in his name – be it in relation to this dispute or otherwise – but regrettably it appears that in some cases he has done exactly that”*.
- 8 On 18<sup>th</sup> November 2021, Mr Snowdon was appointed representative for the claimants. Given the recent flurry of correspondence a case management conference (“CMC”) was arranged to discuss the preparations for and the conduct of the hearing. This took place on the 29<sup>th</sup> November 2021 where, amongst other things, it was confirmed by Mr Mallows that all and any submissions made by Mr Hall in respect of these proceedings should be disregarded.
- 9 The substantive hearing had been scheduled to take place on 6<sup>th</sup> and 7<sup>th</sup> December 2021, however, on the 6<sup>th</sup> December we still had no agreed bundle. What had been provided from each party was also not without issue. There were, for example, documents included within the defendant’s bundle not previously submitted as evidence. There was also a question of whether submissions – some being filed quite late in the day - were being copied between parties. For example, the claimants’ skeleton argument with authorities was submitted on the day by the claimant and it was unclear whether the defendant had been given sight of it.
- 10 There was also concern that the defendant was appearing in person.

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<sup>2</sup> BL O/584/21

- 11 Mr Hall's interventions were also still something of a concern to me (and the claimant), as was some correspondence sent to the IPO in late November 2021 from the Insolvency Manager for the former Joint Liquidators of ABM Waterstop Ltd in which concerns were raised about the present dispute and the exchanges they had had with Mr Hall.
- 12 After raising these matters with the parties, I considered it would be in everyone's best interests to adjourn the hearing, rescheduling it for January 2022.
- 13 The hearing took place on 24<sup>th</sup> January 2022. The claimants were represented by Mr Majeks Walker of Counsel, instructed by Mr William Snowdon of Comlegals (trading name of Edgeon Ltd) with the defendant represented directly by Ms Jane Lambert of Counsel. Both sides provided skeleton arguments for which I am grateful.

### **Preliminary matters**

- 14 On the day of the hearing some additional preliminary matters needed to be dealt with. From the defendant, there was a challenge to the admissibility of the amended statement of grounds on the grounds that it was filed late and outside of the timeframe set. The defendant also sought to introduce a second witness statement from Mr Mallows, and a witness statement from Ms Sarah Mallows ("Ms Mallows"), the daughter of Mr Mallows who had served as director of Abmwaterstop Ltd.
- 15 The claimant also sought to introduce new material in the form of a short testimonial provided by a Mr Keith Harris going to work carried out with and for Mr Stephens.
- 16 In my decision of 5th August 2021, I questioned the basis on which Mr Stephens and Mr Bartlett are now claiming a proprietary interest in the patent given that they have previously argued that Abmwaterstop is entitled to the patent including in respect of any inventive contribution provided by them. I explained that if they wanted to amend their statement of grounds to better set out their case then they should do so by 10<sup>th</sup> September 2021. An amended statement was duly filed 10<sup>th</sup> September 2021 and copied to the other side. Both sides were then invited to file evidence by 1<sup>st</sup> November 2021. The claimant was also advised that the amended statement needed to be properly signed and dated. Mr Mallows, who by this time had dispensed with his representative was copied in on this communication. A further signed and dated amended statement was duly filed on 1<sup>st</sup> November 2021 which in substance was identical to that filed on 10<sup>th</sup> September 2021. Mr Mallows had ample opportunity to raise any concerns about the amended statement including at the case management conference on 29<sup>th</sup> November 2021. He did not do so. On that basis and given that the content has remained unchanged from that filed on 10<sup>th</sup> September 2021, I could see no justification for declaring it inadmissible.
- 17 In respect of the new witness statements from the defendant, I do not consider them to serve strictly as evidence in reply. They were also filed right at the last minute, far too late for the other side to consider, and placed the claimant on an unfair footing. The defendant had plenty of time to file these statements. Indeed, the absence of a witness statement from Ms Mallows was noted in my CMC report sent to the parties on the 1<sup>st</sup> of December 2021. I therefore refused to admit the defendant's new witness statements.

- 18 For similar reasons and noting that Mr Harris was not available as a witness for the defendant to cross-examine, I refused to allow the claimant's testimonial of Mr Harris to be admitted at such a late stage.

### **Witnesses and their cross examination**

- 19 Of the witnesses who provide witness statements the following were subject to cross examination: Mr Mallows, Mr Bartlett and Mr Stephens. I discuss their evidence in more detail later however I need to say a little first about the cross examination of these witnesses and how credible they were. This assessment was made shortly after the hearing with their performance during cross-examination fresh in my mind. All witnesses were cross-examined via video conference. Even with the limitations of giving evidence via video conference, there was nothing that I detected in the demeanour of any of the witnesses that caused me to question their credibility. I will now consider their overall credibility in the order in which they gave evidence.
- 20 Mr Bartlett sought to answer questions in a straightforward manner, neither dodging nor deflecting the questions asked of him. There were no clear inconsistencies between his oral evidence and his witness statement. He was questioned at some length by Ms Lambert on his technical and business background with a clear intent to question his inventive capacity. His responses to this attack were particularly assured and contributed to his overall credibility as an honest witness seeking to assist the tribunal.
- 21 Mr Stephens was a more combative witness who at times answered questions in a strictly literal way rather than in a more open manner. For example, when Ms Lambert was exploring the companies of which he was a director he responded that he was not a director of DCCL but when pressed accepted he had been a director of that company but had resigned. It also became apparent during his evidence that he was referring to notes that had not been submitted as evidence. He was to his credit open about this though it did undermine the weight I could give to his ability to recollect events accurately. Notwithstanding this, overall, he came across as an honest and credible witness who was ready to admit when he did not know something or when his recollection was not clear. There were no clear inconsistencies between his written and oral evidence.
- 22 Mr Mallows was the last to be cross examined. He openly answered the questions put him even where those answers were harmful to his case. Under cross-examination Mr Mallows did suggest that it was Mr Stephens who advised him to name only himself as inventor on the patent. Mr Walker queried why Mr Mallows had not mentioned this in his witness statement. Given the nature of the case advanced by Mr Stephens and Mr Bartlett, it was indeed surprising that Mr Mallows had not included this in his witness statement. In producing his witness statement, Mr Mallows was however seemingly not assisted by his representative in the same way that Mr Bartlett accepted that he, and I also suspect Mr Stephens, had been assisted by their representative. I would also note that this claim by Mr Mallows was included in his evidence in the earlier case brought by him. Hence, I do not believe its omission from his witness statement in the later case, and his subsequent reference to it in his oral evidence, was a deliberate attempt to ambush the claimants or introduce new evidence in a way that would undermine his credibility as a witness. Overall, I found him to be a credible witness.

## The patent

23 GB 2537810 B relates to a flexible seal for use with an appliance, such as a bath, shower tray or work surface, to prevent water passing down between the appliance and an adjacent wall. The patent provides a development of an earlier seal devised by Mr Mallows; a seal that had been protected by UK patent, GB 2364555 B which ceased to be in force on 7<sup>th</sup> July 2010.

24 Figures 1 and 4 of GB 2537810 B are reproduced below. The seal (1) has a substantially planar base portion (2) which, in use, is adhered to a wall (20) and then covered by tiles (22). A sealing portion (8) extending from the planar base portion is forced to press down against the upper surface of the appliance (30) to form a seal that prevents the passage of water between the appliance and the wall. Any water running down the tiles flows over the sealing portion and into the appliance. A tapered region (23) of an upper portion (3) helps to direct any water which might have passed behind the tiles because of cracks in the tiles or the grouting above the seal into the appliance.

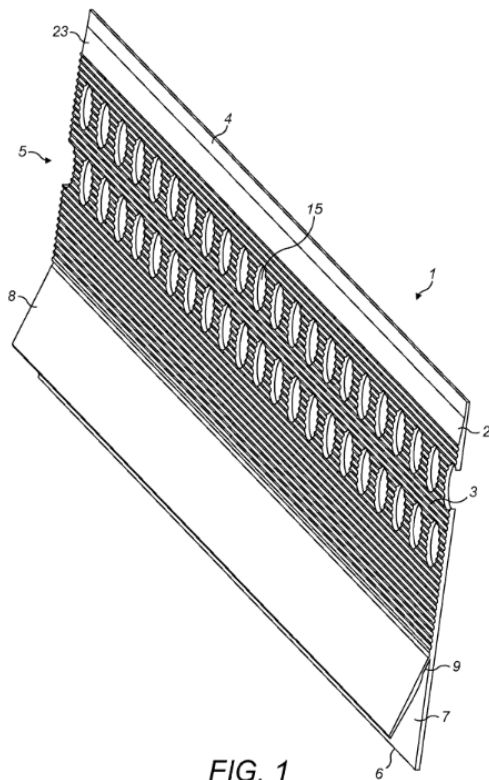


FIG. 1

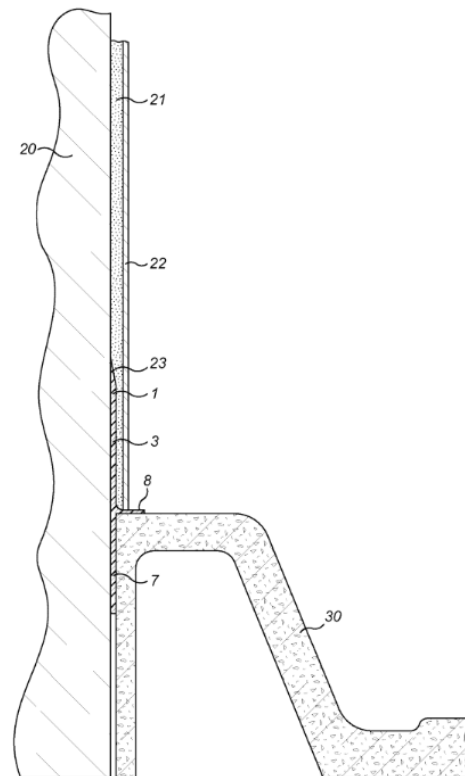


FIG. 4

25 The seal further includes apertures (15) in the upper portion which allow the passage of a fixative for securing the seal to a wall. The fixative may, for example, be the tile cement (21) used to fix tiles to the wall. The apertures are arranged in at least two rows but with the apertures of one row being offset in relation to those in an adjacent row, i.e. their centres are not vertically aligned.

26 The upper portion of the seal is provided with at least two ribs running parallel to the upper and lower edges of the seal. The patent requires at least two ribs to be

located between the top edge of the seal and the apertures, and that the ribs extend between the apertures.

27 The description notes that

Conveniently, the apertures account for 30-35 % of the upper portion. In this manner material for forming the seal is saved and adhesion of the seal in its environment is enhanced.

28 The description goes on to discuss the material for the seal noting that:

A formulation including EVA produces an important antimicrobial activity and would have up to ten year's life span. A blend of Zinc omadine and polychlorometaxyleneol can be used as the actives. In embodiments of the present invention, a method of producing the seal comprises Zinc Omadine which exhibits a capacity to leach from the extrusions, providing a zone of inhibition of up to 5 mm fungistatic activity. This enables durability and zone inhibitive qualities. The combination of these two advantages is very desirable.

29 The patent was granted with a main claim reading as follows:

1. A flexible seal having a substantially planar base portion in the form of an elongate strip having top and bottom edges and a sealing portion extending from a side of the base portion along the length of the base portion intermediate to the top and bottom edges and protruding outwardly and downwardly from the base portion to produce a seal, the sealing portion dividing a front face of the base portion into an upper portion and a lower portion, the upper portion further comprising more than one row of through apertures, provided within a ribbed area that extends across the upper portion, the ribs of the ribbed area running substantially parallel to the top edge, and wherein at least 2 ribs are provided between the top edge of the strip and the through apertures, wherein the ribs extend between the through apertures, wherein the apertures in adjacent rows are offset so that their centres are not vertically aligned.

30 Claim 2 to 17 of the patent are dependent claims:

2. The seal of claim 1, wherein the lower portion is provided with a self-adhesive material.

3. The seal of claim 1 or 2, wherein the through apertures are between 5 and 15 mm in diameter.

4. The seal of claim any one of claims 1 to 3, wherein the through apertures are 10 mm in diameter.

5. The seal of any preceding claim wherein the through apertures are circular.

6. The seal of any preceding claim, wherein the through apertures account for 30-35% of the area of the upper portion.

7. The seal of any preceding claim, wherein the through apertures account for 40% of the ribbed area.

8. The seal of claim 2, wherein the self-adhesive strip is ribbed.

9. The seal of any preceding claim, wherein 2 to 5 ribs are provided between the top edge of the strip and the through apertures.

10. The seal of any preceding claim, wherein 10 to 14 ribs are provided between the through apertures and sealing portion.

11. The seal of claim 10, wherein 12 ribs are provided between the through apertures and the sealing portion.

12. The seal according to any preceding claim, in which the seal is of plasticised poly vinyl chloride having a Shore hardness value of A70.

13. The seal of any preceding claim, wherein the upper and lower portions have a thickness of 1-1.5mm.

14. The seal of any preceding claim, wherein the seal comprises ethylene vinyl acetate (EVA), zinc omadine and chloroxylenol.

15. The seal of claim 14, wherein EVA is included as a polymer carrier between 10-95%, zinc omadine is included as an active antimicrobial 30-80%, and chloroxylenol is included as an active antimicrobial 5-35%.

16. The seal of claim 15, wherein the seal is 75% EVA, 20% zinc omadine, and 5% chloroxylenol.

17. The seal of any preceding claim, wherein the through apertures have an oval shape.

## The Law

31 This reference is brought under section 37(1) of the Act which provides that:

*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.*

32 Also relevant is section 7 which provides that:

*(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.*

- 33 The leading authority on entitlement is the judgement of the House of Lords in *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc*<sup>3</sup>. Here Lord Hoffman notes that:

*“18. Section 7(2), and the definition in section 7(3), are in my opinion an exhaustive code for determining who is entitled to the grant of a patent. That is made clear by the words “and to no other person.” In saying that the patent may be granted “primarily” to the inventor, section 7(2) emphasises that a patent may be granted only to the inventor or someone claiming through him. The claim through an inventor may be made under one of the rules mentioned in paragraph (b), by which someone may be entitled to patent an invention which has been made by someone else (the right of an employer under section 39 is the most obvious example) or the claim may be made under paragraph (c) as successor in title to an inventor or to someone entitled under paragraph (b).*

*19. In my opinion, therefore, the first step in any dispute over entitlement must be to decide who was the inventor or inventors of the claimed invention. Only when that question has been decided can one consider whether someone else may be entitled under paragraphs (b) or (c)....”*

Lord Hoffman goes on to say that:

*“The inventor is defined in s.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] R.P.C. 11, the natural person who “came up with the inventive concept.” It is not enough that someone contributed to the claims, because they include non-patentable integers derived from prior art: see *Henry Brothers (Magherafelt) Ltd v Ministry of Defence* [1997] R.P.C. 693, 706; [1999] R.P.C. 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.”*

- 34 So, the first question I need to decide is who were the actual devisors of the invention in the patent? To answer this, I also need to determine what the inventive concept is.

### **Identifying the inventive concept or concepts in the patent in issue here**

- 35 Ms Lambert referred to Jacob LJ. comments in *Pozzoli*<sup>4</sup> where he noted:

*[17] What now becomes stage (2), identifying the inventive concept, also needs some elaboration. As I pointed out in *Unilever v Chefaro* [1994] RPC 567 at page 580: ‘It is the inventive concept of the claim in question which must be considered, not some generalised concept to be derived from the specification as a whole. Different claims can, and*

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<sup>3</sup> *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc* House of Lords [2007] UKHL 43

<sup>4</sup> *Pozzoli Spa v BDMO SA and another* EWCA Civ 588 [2007] FSR 37



generally will, have different inventive concepts. The first stage of identification of the concept is likely to be a question of construction: what does the claim mean? It might be thought there is no second stage – the concept is what the claim covers and that is that. But that is too wooden and not what courts, applying *Windsurfing* stage one, have done. It is too wooden because if one merely construes the claim one does not distinguish between portions which matter and portions which, although limitations on the ambit of the claim, do not. One is trying to identify the essence of the claim in this exercise.'

[18] So what one is seeking to do is to strip out unnecessary verbiage, to do what Mummery LJ described as make a precis.

[19] In some cases the parties cannot agree on what the concept is. If one is not careful such a disagreement can develop into an unnecessary satellite debate. In the end what matters is/are the difference(s) between what is claimed and the prior art. It is those differences which form the "step" to be considered at stage (4). So if a disagreement about the inventive concept of a claim starts getting too involved, the sensible way to proceed is to forget it and simply to work on the features of the claim.

[20] In other cases, however, one need not get into finer points of construction -- even without them the concept is fairly apparent – in *Windsurfing*, for instance, it was the "free sail" concept. In yet other cases it is not even practical to try to identify a concept - a chemical class claim would often be a good example of this.

[21] There is one other point to note. Identification of the concept is not the place where one takes into account the prior art. You are not at this point asking what was new. Of course the claim may identify that which was old (often by a pre-characterising clause) and what the patentee thinks is new (if there is characterising clause) but that does not matter at this point."

- 36 Perhaps recognising that these comments related to the question of inventive concept for the purpose of considering obviousness, Ms Lambert also directed me to the comments of Hacon J. in *BDI Holding v Agent Energy*<sup>5</sup>. Here in commenting on the use of the term "inventive concept" in the context of entitlement, (as in *Yeda*), scope of protection (as in *Actavis*<sup>6</sup>) and obviousness (as in *Pozzoli*) he noted that:

"21. If the meaning given to 'inventive concept' differs at all as between *Yeda*, *Actavis* and *Pozzoli*, it is not by much."

- 37 Mr Walker in turn referred me to the comments of Hacon J. in *Regen Lab v Estar*<sup>7</sup> where he noted that:

"The invention is that which is claimed ... I take the inventive concept or core of the invention to be the new technical insight conveyed by the invention -- the clever bit -- as would be perceived by the skilled person."

- 38 Seeking to apply this guidance the claimant argues that there are two inventive concepts – the first being that the flexible seal has an upper portion, comprising one or more rows of through apertures, provided within a ribbed area that extends across the upper portion and the second being the specific material used to form the flexible seal which prevents it from becoming mouldy.

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<sup>5</sup> *BDI Holding v Agent Energy* [2019] EWHC 765 (IPEC), 2019 WL

<sup>6</sup> *Actavis UK Ltd v Eli Lilly and Company* [2017] UKSC 48 RPC 21

<sup>7</sup> *Regen Lab v Estar* [2019] EWHC 63 (Pat)

39 In support the claimant refers to an earlier examination report on the patent application where the examiner, in commenting on the originally filed claims, noted that they related to the following separate inventions:

(i) A seal characterised by the provision of at least one row of apertures in a ribbed area (as set out in claim 1 of the originally filed claims).

(ii) A seal characterised in that it is formed from ethylene vinyl acetate, zinc omadine and chloroxlenol (as set out in independent claim 17 of the original filed claims).

40 Ms Lambert sought to break claim 1 as granted into integers identifying the following aspects of the flexible seal:

- i) a general planar portion front elongate strip
- ii) a substantially planar base portion in the form of an elongate strip
- iii) top and bottom edges and a sealing portion extending from a side of the base portion along the length of the base portion intermediate to the top and bottom edges and protruding outwardly and downwardly from the base portion to produce a seal,
- iv) the sealing portion dividing a front face of the base portion into an upper portion and a lower portion, the upper portion further comprising more than one row of through apertures, provided within a ribbed area that extends across the upper portion, the ribs of the ribbed area running substantially parallel to the top edge, and wherein at least 2 ribs are provided between the top edge of the strip and the through apertures,
- v) wherein the ribs extend between the through apertures, wherein the apertures in adjacent rows are offset so that their centres are not vertically aligned.

41 Ms Lambert then sought to precis these integers into those that really count. It was not always easy to follow Ms Lambert though I am satisfied that she accepted that the improvements stemming from the holes was an important inventive concept.

42 Her position on the material of the seal was slightly less clear. She did however highlight paragraph 9 of the examination report of 18<sup>th</sup> September 2019 which notes:

*“9. In so far as the features of dependent claims 2, 8, 14, 15 and 16 are not directly known from the combination of documents as described above, they simply relate to minor modifications thereto which come within the scope of customary practice followed by a person skilled in the art of constructing bathroom seals, e.g. lower portion of seal being provided with self-adhesive material, ribbed self-adhesive, the selection of plasticised polyvinyl chloride and EVA for the seal strip, and zinc omadine and chloroxlenol selection for antibacterial properties.”*

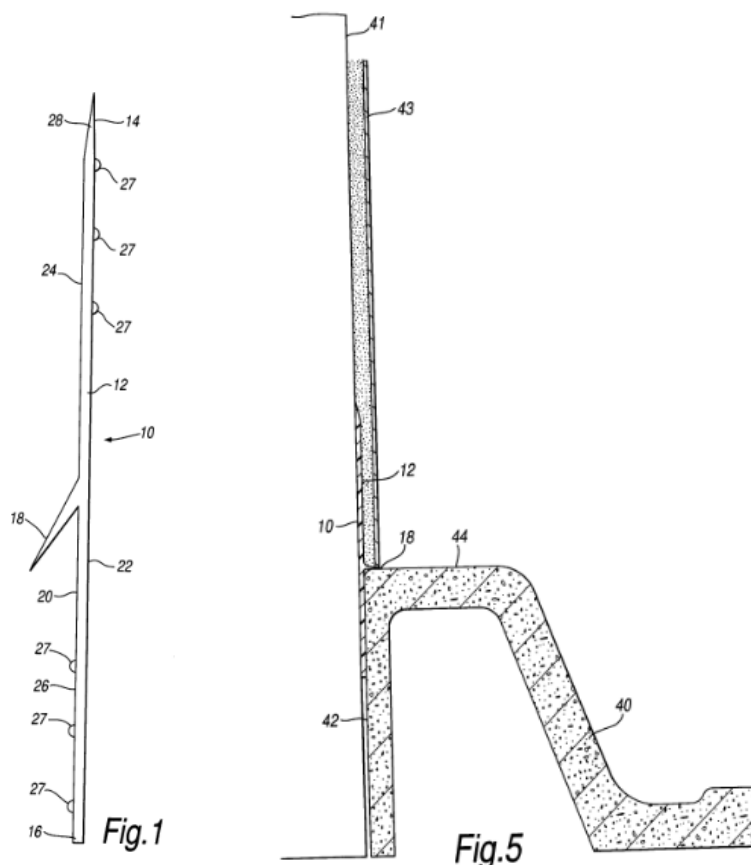
43 The claims 14,15 and 16 referred to above were identical to the granted versions of those claims and were directed at the material for the seal. Ms Lambert argued that this demonstrated that the examiner considered that the subject matter of these claims was obvious and as such could not contribute to the inventive concept of the invention.

44 The addition of common general knowledge to an idea does not usually confer inventorship of the person making that addition. This was made clear by Jacob LJ. in *University of Southampton*<sup>8</sup> where he noted:

*“37 ..... Normally the addition of matter which is common general knowledge is the sort of thing often forming the subject of subsidiary claims of no significance as regards inventorship. Persons skilled in the art naturally add common general knowledge to their key ideas.”*

45 In the *University of Southampton*, the nature of the common general knowledge appears to have been accepted by the parties and there was some prior art to support that. Here however other than the observations of the examiner in their examination report of 18<sup>th</sup> September I have very little to show that the particular materials set out in claims 14-16 are indeed part of the common general knowledge in relation to the skilled person considering the design of seals as in this case.

46 As already discussed, the invention in issue here is presented as an improvement on a similar product set out in GB 2364555 B. This patent, as can be seen in the figures below, discloses a seal similar to that in the patent in issue. The description in GB 2364555 B notes that the seal is “extruded and made from a polymeric material such as plasticised poly vinyl chloride (PVC)”.



47 The description in the patent in issue adds to the disclosure of GB 2364555 noting that:

<sup>8</sup> *University of Southampton's Applications* [2006] EWCA Civ 145

"A polymer comprising the component Ethylene Vinyl Acetate or EV A known as ELVAX" or CAS 2437-78-8 may be used for making a seal according to the present invention. This polymer is suitable for producing the seal because it has a softness and flexibility that approaches that of elastomeric materials and can be processed like other thermoplastics. This material has a good clarity and gloss, and a low temperature toughness. Moreover, it is resistant to cracks due to stress and to Ultra-Violet or UV radiation. Additionally this material which can melt at high temperature exhibits waterproof properties which makes it extremely suitable for a sealant. A formulation including EVA produces an important antimicrobial activity and would have up to ten year's life span. A blend of Zinc omadine and polychlorometaxyleneol can be used as the actives. In embodiments of the present invention, a method of producing the seal comprises Zinc Omadine which exhibits a capacity to leach from the extrusions, providing a zone of inhibition of up to 5 mm fungistatic activity. This enables durability and zone inhibitive qualities. The combination of these two advantages is very desirable. The masterbatch percentage of the total pvc product should be less than 5%."

48 As I have already noted, the original claims filed with the patent in issue included two independent claims. These were as follows:

1 . A flexible seal having a generally planar base portion in the form of an elongate strip having top and bottom edges and a sealing portion extending from a side of the base portion along the length of the base portion intermediate to the top and bottom edges and protruding outwardly and downwardly from the base portion to produce a seal, the sealing portion dividing a front face of the base portion into an upper portion and a lower portion, the upper portion further comprising one or more rows of through apertures, provided within a ribbed area that extends across the upper portion, the ribs of the ribbed area running substantially parallel to the top edge, and wherein at least 2 ribs are provided between the top edge of the strip and the through apertures.

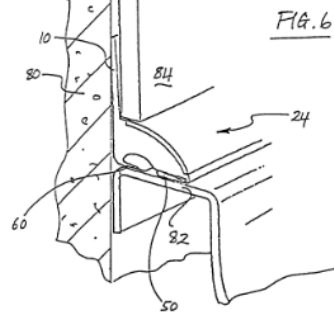
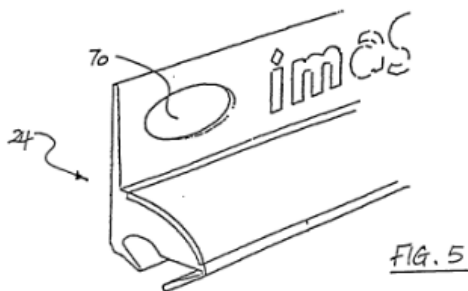
and

17. A flexible seal having a generally planar base portion in the form of an elongate strip having top and bottom edges and a sealing portion extending from a side of the base portion along the length of the base portion intermediate to the top and bottom edges and protruding outwardly and downwardly from the base portion to produce a seal, the sealing portion dividing a front face of the base portion into an upper portion and a lower portion, wherein the seal is formed from (EVA), zinc omadine and chloroxylenol.

49 Weighing up the arguments of the parties and the disclosures in the previous patent and the patent in issue, I believe these two independent claims provide a sound basis for identifying the true inventive concepts in the patent.

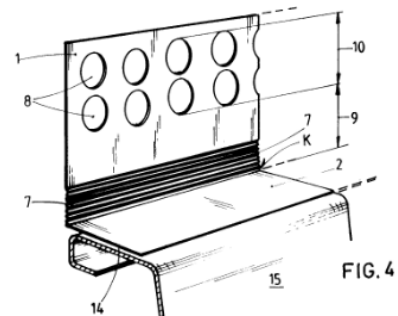
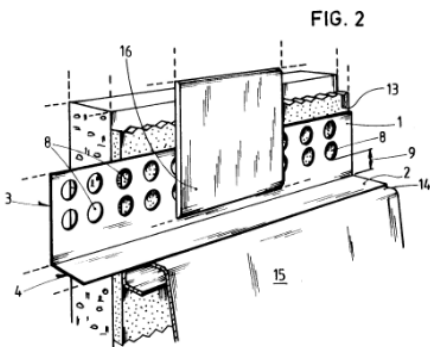
50 However, those claims, including claim 1, were modified during the examination of the application. Notably the examiner argued that it was common practice to provide apertures in bathroom seals to allow the fixing material to flow through and provide better adhesion. The examiner referenced two prior documents as examples of this.

51 GB2295866A discloses a seal for sealing between for example a bath rim (82) and a tiled wall (84).



52 The description of GB2295866A notes with reference to figure 5 that "... the first limb 10 is provided with apertures 70 through which adhesive can flow when the sealing member is affixed to a wall or the like."

53 Also referred to is DE9006767 which shows a similar apertured seal.



54 The applicant responded to the examiner's objection by amending claim 1 to focus on the idea that the ribs extend between the through apertures of the two or more rows of apertures and that the apertures in adjacent rows are offset so that their centres are not vertically aligned. And it is this idea that I believe is the first inventive concept in the patent. The second inventive concept is the specific material used to form the flexible seal which prevents it from becoming mouldy.

### Identifying the devisors of the inventive concepts

55 I turn now to the question of who the actual inventor or inventors of these inventive concepts was.

#### *The involvement of Mr Stephens and Mr Bartlett*

56 It is not in dispute that Mr Mallows was the inventor of the flexible seal disclosed in GB 2364555. It is also common ground that that seal was made available to purchase and that Mr Bartlett had purchased and used the seal. The precise date when that or those prior purchases happened is neither clear nor ultimately important. It is common ground that in 2014 Mr Bartlett contacted Mr Mallows with the aim of purchasing more of the sealing material. Mr Mallows informed Mr Bartlett that he was no longer in the business of selling the sealing material but that he did

have some left in his loft. According to Mr Bartlett, Mr Mallows agreed to send him “several rolls” of the product.

- 57 Mr Bartlett then claims that he discussed the product with Mr Stephens who he was working with at the time. It is not in dispute that Mr Stephens then contacted Mr Mallows.
- 58 Mr Stephens notes that he visited Mr Mallows house on 30<sup>th</sup> October 2014 and again on 26<sup>th</sup> November but denies that there were any discussions at those meetings about improving the original product. Mr Stephens contends that these were basically “getting to know you” meetings though they did discuss the implications of Mr Mallows being subject to an Individual Voluntary Arrangement (IVA) were they to take the product forward. Mr Stephens referred in the hearing to a further meeting on 14<sup>th</sup> January 2014 where there were discussions on improvements to the products and where agreement was reached to form a company to take the new product forward.
- 59 I was provided with a series of email exchanges between the various parties, and it is I believe useful to set out some of those to better understand the relationships and activities of the key players at the time. Certain email addresses have been redacted. I begin with an email exchange dated 28<sup>th</sup> November 2014 culminating with Mr Stephens responding to Mr Mallows, copying in Mr Bartlett:

“From: Mike Stephens [REDACTED]

Sent: 28 November 2014 16:21

To: 'Tony Mallows'

Cc: agbartlett@[REDACTED]

Subject: RE: Waterstop HEADER

Thanks Tony,

Already have copies of this from Andrew. Intend to use it as the base for a revision.

Am speaking with Graham Watt's office, to try and resurrect the patent, now waiting for their call.....”

Mike

“From: Tony Mallows [REDACTED]

Sent: 28 November 2014 14:52

To: [REDACTED]

Subject: Waterstop HEADER

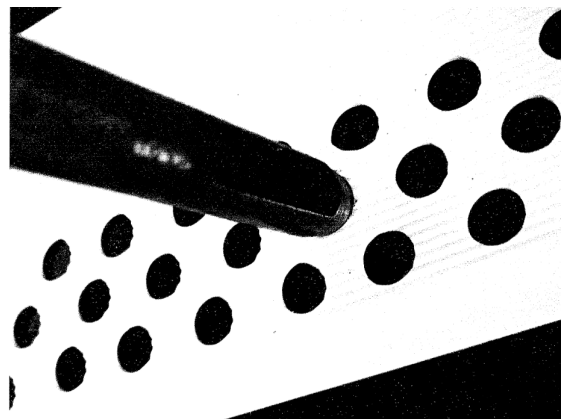
Hi Mike

Just an idea of the material I used.

Best

Tony”

- 60 Mr Mallows and Mr Bartlett both confirmed that it was samples of the original seal that Mr Stephens had copies of, and which was to be the basis for revision.
- 61 Mr Bartlett claims that he immediately identified shortcomings with the product and that he started working on improvements. In cross examination he mentioned that the advice that accompanied the original product suggested using silicone sealant to hold the seal in place however he noted that silicone is not an instant drying product and that previously, to hold the seal in place, Mr Bartlett had stapled it to the wall. This he suggested prompted him to consider a different type of adhesive. In his witness statement Mr Bartlett claims that he experimented using various glues and tapes including Butyl tape. He also claims to have identified that the original seal was too thick causing the tiles that are laid over the seal to be offset to the remainder of the tiles. He goes on to claim that he also came up with the idea for the holes and produced a sample of the seal with holes using a hole punch as shown below. He suggested for the first time under re-examination that one of the drivers for coming up with the idea of the holes was that if you are using small tiles, particularly mosaics, they would not adhere to the seal without the holes.



- 62 Ms Lambert put it to Mr Bartlett that he may well have mocked up a prototype but that was only implementing ideas that Mr Mallows had given him. Mr Bartlett denied this.
- 63 Mr Bartlett asserts that he shared his ideas for improving the seal in discussions with Mr Stephens and that it was Mr Stephens who also came up with the antimicrobial material for the seal. Mr Stephens in his evidence asserts that it was Mr Bartlett who came up with the idea of having “apertures to improve the adherence of the seal in place”.
- 64 Mr Bartlett has provided a copy of an email from Mr Mallows to an Italian company, Bizeta, who had manufactured the previous seal, where Mr Mallows asks about making the seal thinner, more flexible and for it to include a strip of adhesive tape.

From: Tony Mallows [REDACTED]

Sent: 01 December 2014 12:17

To: [REDACTED]@bizeta.it

Cc: [REDACTED]@bizeta.it; Andrew Bartlett; [REDACTED] (Mike Stephens)

Subject: Waterstop seal alterations

Buongiorno Fabrizio and Roberto

I would very much like you to consider the following and tell me if it is possible:

1. Make the profile thinner, possibly to .5mm. I do realise this will make the overall dimensions smaller but that does not matter.

2. Make the profile more flexible, say to Shore A 60 or Shore 00 50?

3. Supply and fit a strip of strong adhesive tape below the lip 50/60mm wide, with a release tape to the outer face.

Grazie mille

Tony

65 Mr Mallows accepts that these three changes improved the original seal but argued initially that they were his ideas. Mr Walker pressed him on this during cross-examination:

“Mr Mallows: .... If I may just say, the first one, no. 1, "make the profile thinner" is one that I had told Mr. Stephens at our first meeting, that it should have been thinner and better. The Shore, I do not think they would have understood what the Shore value is of things, and the third one did come a strong adhesive tape was something that we did talk about as a way to go forward, but the first one was certainly mine.

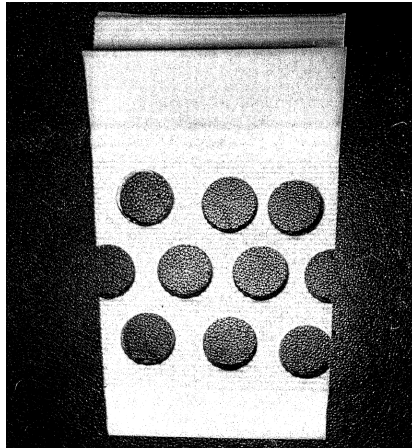
Mr Walker - We dispute that would you then agree even if we accept the first one was yours, which we do not, do you not agree that the other parts there were ideas from Mr. Bartlett?

Mr Mallows - Number 3 was, yes.”

66 Mr Stephens explains that he contacted the patent attorneys Graham Watt about the improved seal on 19<sup>th</sup> December 2014 and that he and Mr Mallows visited Mr Steven Suer at Graham Watt on 29<sup>th</sup> January 2015 where it was agreed that Mr Suer would draft a patent application reflecting the improvements to the seal.

67 Mr Nicholas Kirkham of Graham Watt has provided a witness statement that was not challenged by the defendant. A handwritten note taken by Mr Suer of the telephone conversation with Mr Stephens on 19<sup>th</sup> December 2014 is referred to in the statement and a copy of that note has been provided by Mr Kirkham. The note refers to “3 alterations” comprising reducing the tongue to 25 mm, two rows of holes to improve adhesion and self- adhesive tape. Mr Kirkham also noted that Mr Stephens provided Mr Suer with the following photograph representing what he described as “a mock-up design of the new product”





68 Mr Stephens also emailed Mr Mallows and Mr Bartlett on 19<sup>th</sup> December 2014 noting:

Hi both,

I have instructed Steve Suer at Graham Watt to proceed with reregistering ABMWaterstop TM. At the same time I sent a photo of your alterations Andrew, added the tape and asked him to make a new patent application.

Tony, I know you haven't seen Andrew's clever changes, I will send them to you by phone. Did you get a response to your email to Italy yet? If not will you please ask them for a date in early Feb we can visit with them. We need to make sure they still have the tool, can make the alterations and recast the profile.

Mike.

69 Mr Stephens for his part notes that he had the idea of applying specific materials and compounds to the seal to provide it with antimicrobial properties in late 2014. Mr Stephens explained by way of background that prior to becoming involved with this product he had had a long interest in how to fix durable antimicrobial chemicals to flexible products including curtains for use in hospitals.

70 Mr Stephens has provided a copy of an email exchange commencing with an email dated 24<sup>th</sup> February 2015 from Mr Keith Harris at Isca UK, a manufacturer of speciality chemicals, providing details of formulations for providing an antimicrobial effect. This email talks about the possibility of Mr Harris running some trials. Mr Stephens then forwarded this email on the same day to Mr Mallows asking him to forward the email to Steven Suer at Graham Watt LLP. which Mr Mallows duly did also on the 24<sup>th</sup> February 2015. In the covering email Mr Mallows notes:

Hi Steven

Here is the approved profile with two lines of holes. I am instructed also to mention that we intend to offer the adhesive tape as an optional extra

- i.e. the customer can fix desired, or they can purchase our purpose made double sided tape which is an easier solution.

Please also see below for inclusion.

with best wishes

Tony

- Original Message -----

From: Mike Stephens

To: 'Tony Mallows'

Sent: Tuesday, February 24, 2015 1.17 PM

Subject: FW: Water-stop masterbatch

Hi Tony,

Will you forward this to Steven please. My added comment would be that Zinc Omadine exhibits a capacity to leach from our extrusion, providing a zone of inhibition of up to 5mm fungistatic activity. We therefore are claiming durability but also zone inhibitive qualities, this combination is extremely innovative.

Steven should also note that the masterbatch percentage of the total pvc product should be less than 5%.

Thanks, Mike.

From: Keith Harris [REDACTED]

Sent: 24 February 2015 11:47

To: Mike Stephens

Subject: Water-stop masterbatch

Dear Mike,

The following formulation would produce a very nice antimicrobial activity and would have up to a ten year life- span. Also you can claim synergy with the blend of zinc omadine and polychlorometaxyleneol as the actives, Components

1. Ethylene vinyl acetate(EVA also known by the trade name ELVAX)(CAS 2437-78-8) a polymer that approaches elastomeric materials in softness and flexibility, yet can be processed like other thermoplastics.

The material has good clarity and gloss, low-temperature toughness, stress-crack resistance, hot-melt adhesive waterproof properties, and resistance to UV radiation.

Zinc omadine (CAS No 13463-41-7) also known as Zinc pyrithione a coordination complex of zinc. It has fungistatic (that is, it inhibits the division of fungal cells) and bacteriostatic (inhibits bacterial cell division) properties.

Chloroxylenol (4-chloro-3,5-dimethylphenol)(CAS No 88-04-0) a broad spectrum antimicrobial chemical compound used to control bacteria, algae, fungi and virus. It is used in hospitals and households for disinfection and sanitation.

Percentages in formulation

EVA as a polymer carrier between 10 --95% but suggest 75%

Zinc omadine as active antimicrobial 30 -80% but suggest 20%

Chloroxylenol as active antimicrobial 5 - 35% but suggest 5%

This is merely the framework formulation and I will have to run some small scale trials with Mike Russell so we will need an NDA with him.”

- 71 Attached to the covering email from Mr Mallows to Mr Suer was a PDF file titled “Water Stop 2015\_approved profile though a copy of that document has not been submitted as evidence.
- 72 Mr Stephens has also provided an email dated 10<sup>th</sup> October 2018 to him from Mr Harris which reads:

Dear Mike,

Further to our conversation last week, we confirm our discussions and the development of an Antifungal/Antimicrobial compound and coating in late 2014 and early 2015 for the proposed new Waterstop bathroom seal using innovative Isca technology loosely based on preservatives for the cosmetic sector using a range of chemicals including Zinc pyrithione, 2-Octyl-2H-isothiazol-3-one and conforming to the Biocides Products Regulations.

I confirm this work was conducted on behalf of and paid for by you. The technology remains confidential between our companies.

The challenge was to develop a treatment more appropriate and longer lasting for the application than the Micron and Biomaster products available in the market.

Your new treatment has enhanced performance over the alternatives due to the synergistic effect of the active antimicrobials and unique Polymer compatibilization system over an extended lifespan.

Kind regards,

Keith Harris  
Isca Uk Ltd.

- 73 Whilst this later evidence is not contemporaneous, it was unchallenged and does lend support to Mr Stephen’s claim that it was he who came up with the particular material for the seal.
- 74 More telling however was the following exchange during Mr Mallows’ cross-examination about the email from Mr Keith Harris to Mr Mike Stephens of 24<sup>th</sup> February 2014 and what Mr Walker referred to as the “microbacterial issue”:

“Mr Walker: What I want you to look at, Mr. Mallows, is the issue of the email from Keith Harris to Mr. Stephens. Have you seen that? So do you agree that your original product did not have in any way, shape or form, did not deal with any microbacterial issue, do you agree with that?

Mr Mallows: Yes.

Mr Walker: So do you agree that the issues raised in this email between Mr. -- you think it is Mr. Harris and Mr. Stephens deal with that problem?

Mr Mallows: Yes.

Mr Walker: So do you agree that the final patent that was filed by yourself, which I will come to shortly, covers this issue and would you accept that these are Mr. Stephens' invention?

Mr Mallows: Yes, I do. I do not know about the word invention but certainly he came up with all of that necessary for it to work.”

75 That admission by Mr Mallows, coupled with the evidence provided by the claimant, satisfies me that Mr Stephens was the deviser of the second inventive concept namely the claimed material for the seal.

76 The deviser of the first inventive concept relating to the apertures is however less clear cut. Mr Mallows suggests an alternative narrative for the development of the idea of the holes to that of Mr Bartlett and Mr Stephens. He argues that he had the idea some 10 years before he met them. He has referred me to an email from Mr Mike Beckett sent 15<sup>th</sup> August 2018 where Mr Beckett notes:

“I am happy to confirm that ABM carried out work for Collins and Beckett Ltd in 2006 on a small project for Presentation Housing Association in Brixton. Whilst installing the new shower tray in accordance with the requirements of the local authority occupational therapist we discussed the water stop product that your team were installing. My observations at the time were that the product could be improved by adding perforations so that the adhesive would make direct contact with the tiling. You acknowledged this observation at the time.”

77 Mr Mallows also presented an email sent on 15<sup>th</sup> August 2018 from Mr Ian Hansell GM of Bristan Ltd in which he notes:

“Just to confirm during the time when Bristan worked with you on the development and launch of your innovative new 'Waterstop' product we gave you feedback on how we believed it could be improved, upon;

Our feedback and insight at the time included;

- It was tricky to fit with just silicone as the "glue", and that there should be some way of improving adhesion between tile cement and wall/cubicle surface.
- We had discussions that centred on how that might be achieved -- via holes, slits, or some other method of securing a better fix.”

78 Mr Mallows notes that Bristan Ltd was the biggest customer for his original seal between 1994 and 1998. Whilst neither of these emails are contemporaneous with the devising of the invention, they do both suggest the idea of incorporating holes in the seal. However, even if I were to accept that Mr Mallows had the idea of including holes in the seal prior to any involvement of Mr Bartlett or Mr Stephens, that would not demonstrate that he was the sole deviser of the first inventive concept. This concept extends beyond the mere provision of the holes or apertures to the idea that the ribs extend between the through apertures of the two or more rows of apertures and that the apertures in adjacent rows are offset so that their centres are not vertically aligned.

79 Mr Mallows in his witness statement does provide a narrative to support his claim that he was also responsible for that concept. He suggests that following the interest in his original product by Mr Bartlett and Mr Stephens, he decided to develop his original seal further. He goes on to note that:

“My thinking behind the current design and placement of the apertures is as follows:

- There had to be an area of ridged seal (a ridged surface area was part of the initial design for Mark 1) above the lip which was free from perforations for maximum efficacy. The ridges

prevent capillary action. The inclusion of ribs between the apertures and the top edge of the strip ensure that water is not directed from the top edge towards the apertures.

- Similarly, there should be an area of solid seal above the perforated area for ease of fitting. A fully perforated seal would be almost too flexible and the topmost row of apertures could coincide with the grout line above the first row of tiles - which could in extreme cases provide an ingress point. My overall thinking was that perforations should be present but confined to a specific portion of the surface area in order to maximise adhesion without compromising the efficacy or structural integrity of the design.
- To maximise adhesion, I came up with the idea of providing more than one row of through apertures in the ribbed portion. To reduce the risk of water leakage through the apertures, I decided that a ribbed portion should be provided between the top row of apertures and the top edge of the strip.
- Finally, perforations should be offset. Vertically aligned holes could compromise the strength of the seal and render it prone to splitting. After 30 years in the building trade, I am well acquainted with the laws of stress. Offset rows of apertures would maintain the integrity of the seal whilst allowing for enhanced flexibility and adhesion."

- 80 Mr Walker did not really challenge Mr Mallows on this. It therefore does lend some weight to his claim though clearly if there was more contemporaneous evidence supporting this narrative including that he had shared this thinking with either Mr Bartlett or Mr Stephens then that would have considerably strengthened his case.
- 81 Mr Bartlett has not provided any comparable narrative to explain the thought process underpinning his claim to have devised this inventive concept. All he has suggested was that the provision of holes would allow smaller mosaic tiles to be fitted though this does not really go into the particular arrangement of holes and ribs claimed.
- 82 The first documentary evidence of the realisation of the first inventive concept that I have been presented with is the photograph that Mr Stephens provided to Mr Suer at Graham Watt Ltd. In a contemporaneous email Mr Stephens refers to the photograph showing "Andrew's alterations" though it is not clear which specific alterations he was referring to.
- 83 Ms Lambert questioned Mr Bartlett about his witness statement in particular the precise wording that he used to identify his contribution which mirrored exactly the wording in the granted claim. This she argued went further than what he really claims to have contributed namely the idea to include the apertures. Mr Bartlett's initial response was simply that the original concept of the holes was "his idea". When pressed about the particular limitation in the claim, and Mr Mallows claim that he was responsible for that, Mr Bartlett simply said "I totally disagree with that".
- 84 I would add that Ms Lambert did question whether Mr Bartlett was likely to have come up with the idea given his lack of having previously patented anything. Under cross-examination Mr Bartlett presented himself as a very practical person who had run several companies. He also reiterated that he had used the previous seal before and so was aware of some of its shortcomings. Further as I have discussed above, Mr Mallows accepted that Mr Bartlett had contributed to improvements to the seal singling out the addition of the tape.
- 85 For completeness I will also mention that Ms Lambert challenged Mr Bartlett and Mr Stephens as to why, if as they claimed that they were responsible for the

improvements to the seal, was it necessary to involve Mr Mallows at all. Why had they simply not taken the improved seal forward on their own? Both Mr Bartlett and Mr Stephens responded that they were keen to take advantage of Mr Mallows knowledge and contacts especially of his previous customers and suppliers. That seemed to me to be entirely reasonable.

### *The patent application*

- 86 A draft patent application was sent to Mr Mallows in the beginning of March 2015 at which time Mr Mallows confirmed that the applicant's name on the patent should be Abmwaterstop with him named as the sole inventor. As noted above Mr Mallows submits that this was done on the instruction of Mr Stephens.
- 87 Both Mr Stephens and Mr Bartlett however deny knowing that Mr Mallows had listed himself as sole inventor. Mr Walker also highlighted that Mr Mallows had not, prior to his cross-examination mentioned that Mr Stephens had instructed him to name himself as the inventor. The patent application was duly filed on 18<sup>th</sup> March 2015.

### *Conclusion on the devisor of the first inventive concept*

- 88 So, what can I conclude as to the devisor of the first inventive concept? From the material before me I am satisfied that the first inventive concept had been devised by no later than 19<sup>th</sup> December which is when a photograph of the concept was shared with the patent attorney.
- 89 It is not in dispute that Mr Bartlett was responsible for the prototype seal shown in the photograph. The question is whether what is shown in that photograph is i) the result of the independent efforts of Mr Bartlett alone with the possible assistance of Mr Stephens), ii) the result of the independent efforts of Mr Mallows alone which he then communicated to Mr Bartlett (or to Mr Bartlett via Mr Stephens) or iii) the result of the combined efforts of Mr Mallows and Mr Bartlett?
- 90 Ms Lambert did suggest to Mr Bartlett that the prototype was produced by him under instruction from Mr Mallows however Mr Bartlett denied this. Mr Bartlett also denied that Mr Mallows had communicated any ideas for improving the original seal to him. Mr Stephens was also pressed on this. He noted that he had a number of meetings with Mr Mallows between the end of October 2014 and January 2015 and that at the meeting on 26<sup>th</sup> November they did start "talking about improvements to the product" although he went on to say that they did not discuss "anything serious about how the product could be developed". Mr Stephens refers to a further meeting in January 2015 where improvements were discussed but this was after the latest date by which the first concept had been devised.
- 91 Mr Mallows has in his witness statement provided a credible narrative as to the benefits arising from the first inventive concept to support his claim that he was the devisor. However, there is nothing, amongst the numerous emails submitted as evidence, to support Mr Mallows' claim that he communicated any ideas he had to either Mr Bartlett or Mr Stephens in the relevant period.
- 92 Despite Ms Lambert's assertions, I accept that Mr Bartlett was involved in coming up with improvements to the original seal in late 2014 and early 2015. This was

admitted to as such by Mr Mallows at least in respect of the adhesive tape. It is also I believe conceivable that both Mr Mallows and Mr Bartlett separately came up with the idea of adding holes to the seal and that this is also something that Mr Mallows had considered much earlier when he was developing and selling his original seal.

- 93 I did not find much between Mr Mallows and Mr Bartlett in terms of their credibility as witnesses. Whilst both sought to maintain their positions that they were the devisors of the first inventive concept, this was guided in my view by their focus on the idea of providing the holes rather than the precise disposition and arrangement of the holes.
- 94 This takes me back to the photograph provided to Mr Suer by Mr Stephens which he stated at the time showed "Andrew's alterations". That was an observation made by Mr Stephens before relations had broken down. I believe on balance that had Mr Mallows been solely responsible for the holes and their disposition, that Mr Stephens would have referenced this in that email. Instead by referring to Andrew's alterations I believe he is referring to Mr Bartlett's inventive contribution including in respect of the first inventive concept.
- 95 The claimants are not seeking to displace Mr Mallows as a co-inventor. Whilst strictly that would not prevent me from reaching a finding that he was not as co-inventor, in this case I can see no compelling evidence to override the presumption in section 7(4) that he was indeed a co-inventor.
- 96 Hence, I find that Mr Mallows and Mr Bartlett were the co-devisors of the first inventive concept and that Mr Stephens was the devisor of the second inventive concept.

#### *Determining entitlement*

- 97 Having determined the devisors of the two inventive concepts, I now need to determine whether their rights to the invention belong to anyone else.
- 98 The patent was originally in the name of Abmwaterstop Ltd with the accompanying Statement of Inventorship noting that Abmwaterstop Ltd acquired the right to the patent by virtue of their employment of the single named inventor Mr Mallows.
- 99 The named applicant was subsequently changed following an uncontested decision to Mr Mallows after he provided prima facie acceptable evidence that he was not an employee of Abmwaterstop at any time.
- 100 Abmwaterstop was incorporated on 19<sup>th</sup> December 2014 with the following % allocation of shares: Ms Sarah Mallows 20%, Mr Andrew Bartlett 40% and Mr Michael Stephens 40%. Ms Mallows is the daughter of Mr Tony Mallows. Mr Bartlett explained that Ms Mallows was included as a director and shareholder as it was considered undesirable to have Mr Mallows as a director as he was, as noted above, subject at the time to an IVA.
- 101 Both sides accept that there was no formal shareholder agreement nor anything in writing to clearly set out the purpose of the company though it seems to be accepted by all sides that it was to promote and market the new seal.

102 The directors of Abmwaterstop subsequently fell out for a number of reasons which it is not important to go into here. Ms Mallows was removed as a director and the company wound up. Mr Bartlett accepts that a new company was established that continued to sell the improved seal.

103 Mr Stephens and Mr Bartlett had previously claimed that any rights, including any flowing from them or Mr Mallows as inventors, belonged to Abmwaterstop but by the time of the latest hearing they had changed their position. They now claim that any rights in the patent stemming from their inventive contribution belong to them individually as they too were not employees of Abmwaterstop. Further there was no agreement at any time transferring any rights they or Mr Mallows might have to Abmwaterstop. This latest position was not challenged by Mr Mallows.

104 Irrespective of whether Mr Stephens or Mr Bartlett were employees of Abmwaterstop, they were directors of that company. Because of their duties and responsibilities as directors it is possible that any contribution they made to the invention may belong to the company by virtue of Section 39(b). This reads:

*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 –*

*(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.*

105 Section 39(b) could however only be relevant if the inventive contributions were made when they were directors. Mr Stephens asserts that he devised the second inventive concept in late 2014 which is clearly before he became a director of Abmwaterstop. This has not been challenged by Mr Mallows. The latest date that I have concluded that the first inventive concept was devised in part by Mr Bartlett was 19<sup>th</sup> December 2014 which also happens to be the same day Abmwaterstop was incorporated. Given that it was in my opinion the latest date that the first inventive concept was devised and given the likelihood that it was in fact devised prior to that date I accept the Mr Bartlett's position as director does not impact on the question of entitlement to his contribution.

106 For completeness I would add there is no suggestion from either side that any rights that either Mr Mallows, Mr Bartlett or Mr Stephens had, were subsequently transferred to Abmwaterstop by any agreement or undertaking.

107 If I had found that the rights to the patent, at least in part, vested at any time with Abmwaterstop, then the claimants wished to rely on a purported chain of assignments transferring those rights back to them individually. Given that I have concluded that Abmwaterstop did not at any time have rights to the invention then I need say no more about any possible assignments especially given the primary case of both sides is that entitlement rests with the inventors.

## **Conclusion**



108 I find Mr Anthony Brian Mallows, Mr Michael Stephens and Mr Andrew Bartlett are all joint inventors and joint proprietors of the invention in GB2537810 B.

109 I therefore order that:

- 1) Mr Michael Stephens and Mr Andrew Bartlett should be named alongside Mr Anthony Brian Mallows as joint inventors of the invention in GB2537810 B
- 2) Mr Michael Stephens and Mr Andrew Bartlett should be named alongside Mr Anthony Brian Mallows as joint proprietors of GB2537810 B

110 If either side wishes me to make any other orders following my determination, then they should inform me within the period specified below for filing any submissions on the matter of costs.

### **Costs**

111 The claimants has been successful in its claim and are therefore entitled to an award of costs. It is long established practice that in proceedings before the comptroller only a contribution towards the successful party's costs should normally be awarded and that the amount should be guided by the comptroller's published scale<sup>9</sup>. I will allow both sides a period of 6 weeks from the date of this decision to make any submissions they wish to make on the matter of costs.

### **Appeal**

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

Phil Thorpe

Deputy Director Acting for the Comptroller

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<sup>9</sup> [Tribunal Practice Notice \(TPN 4/2007\)](#)