

ENTITLEMENT & OWNERSHIP



PHIL THORPE

Intellectual Property Office is an operating name of the Patent Office

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Quick quiz

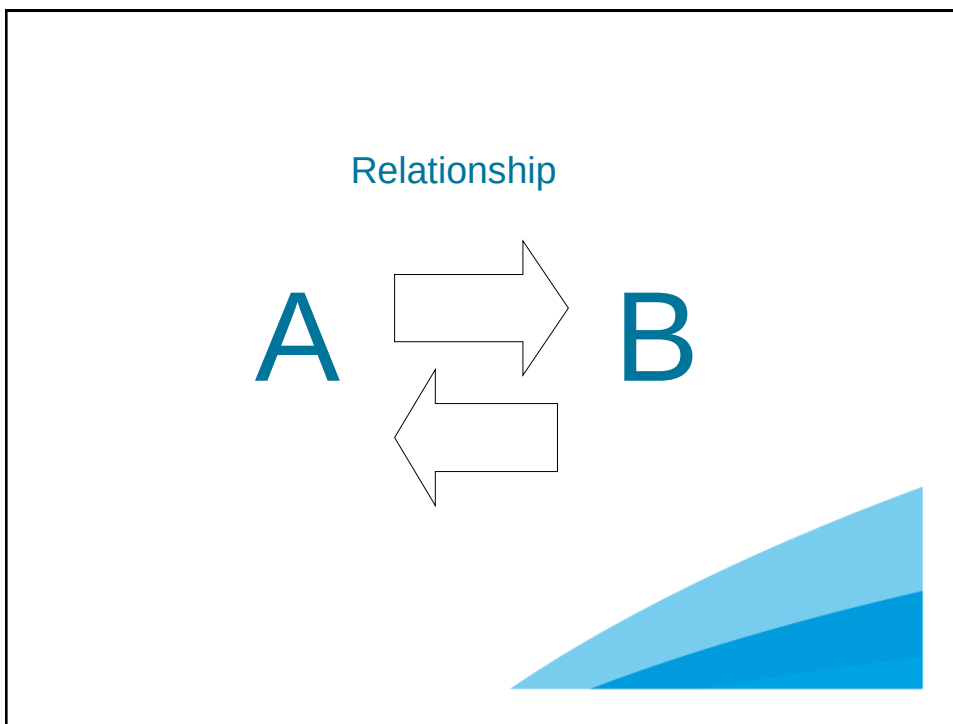
A	
B	

- March 2007 A invents wheelbarrow
- April 2007 B files a patent application for the wheelbarrow
- Who is most likely to be entitled to the patent?

- A B



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Quick quiz

A	
B	

- A invents a wheelbarrow whilst working as a design engineer for a garden equipment company B
- Who is most likely to be entitled to the patent?
- A B

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Quick quiz

A	
B	

- A invents wheelbarrow in his spare time whilst working as a cleaner for a garden equipment company B
- Who is most likely to be entitled to the patent?
- A B



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Quick quiz

- An AI machine A owned by B running under the control of C a program devised by D using a training dataset assembled by E invents an invention?
- Who is most likely to be entitled to any patent?

A B C D E



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PROGRAMME

- Who is entitled to patent rights?
- How are disputes settled?
- Cases



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Legislation

- Patents Act - sections 7 to 13, 36 to 43, 66, 82, 83, 106, 125(1)
- European Patent Convention – articles 60, 61; rules 13 to 16; Protocol on recognition
- PCT – rule 18(4)(c), rule 92bis.1



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- 1. Who is entitled to the patent rights?

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Section 7

A patent for an invention may be granted -

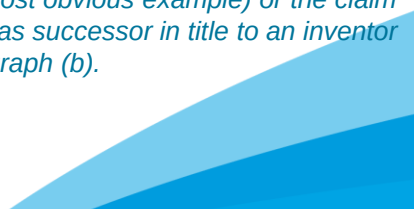
- (a) *primarily to the inventor or joint inventors;*
- (b) *in preference to the foregoing, to any person or persons who, by virtue of any enactment or **rule of law**, or any foreign law or treaty or international convention, or by virtue of an **enforceable term of any agreement entered into with 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.*

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Yeda Research and Development Co Ltd v Rhône-Poulenc Rorer International Holdings Inc

- *“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).”*

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Yeda Research and Development Co Ltd v Rhône-Poulenc Rorer International Holdings Inc

- *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)....”*
- *“The inventor is defined in s.7(3) as “the actual deviser of the invention”. The word “actual” means the natural person who “came up with the inventive concept.”*



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Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc

- *It is not enough that someone contributed to the claims, because they may include non-patentable integers derived from prior art: 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.”*



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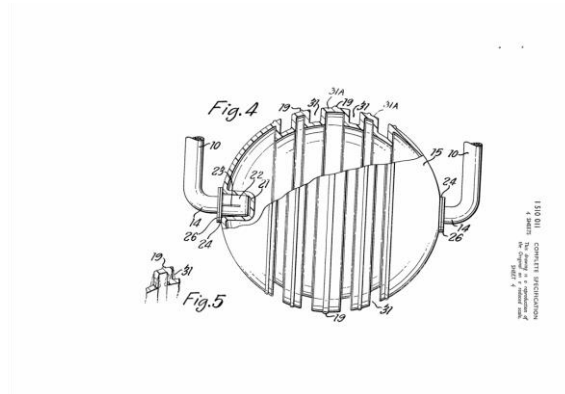
Who counts as the inventor?

- S7(3): the “actual deviser of the invention”
- Is the “invention” claim 1, any claim, or anything new in the description?
- What if there is no patent?
- Am I a deviser if I:
 - identified a market or found funding?
 - brought in a prior-art idea?



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Ballbarrow



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Claims

- 1 A movable structure of the kind referred to, comprising a frame and a supporting ground engaging member rotatably mounted therein, said member comprising a ball moulded in one piece
- 2
- 3
- 4 A movable structure as claimed in either of claims 2 and 3, wherein the bearing cups are moulded from nylon material

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- “What one is normally looking for is “the heart” of the invention. There may be more than one “heart” but each claim is not to be considered as a separate “heart” on its own.”

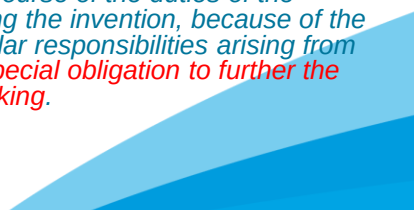
Markem v Zipher EWCA



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Section 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**.*



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2. How are disputes settled?



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EP and PCT applications

- Ownership of property is for national law
- So EPC simply says:
 - rights belong to inventor or successor in title
 - for employees, depends on local law
- PCT steers well clear:
 - allows different applicants for different states

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Co-ownership

- Agreement of co-owners not needed to:
 - work the patent
 - sue an infringer
- Agreement is needed to license or assign
- A recipe for disaster if owners fall out
 - but log jams pre-grant can be resolved



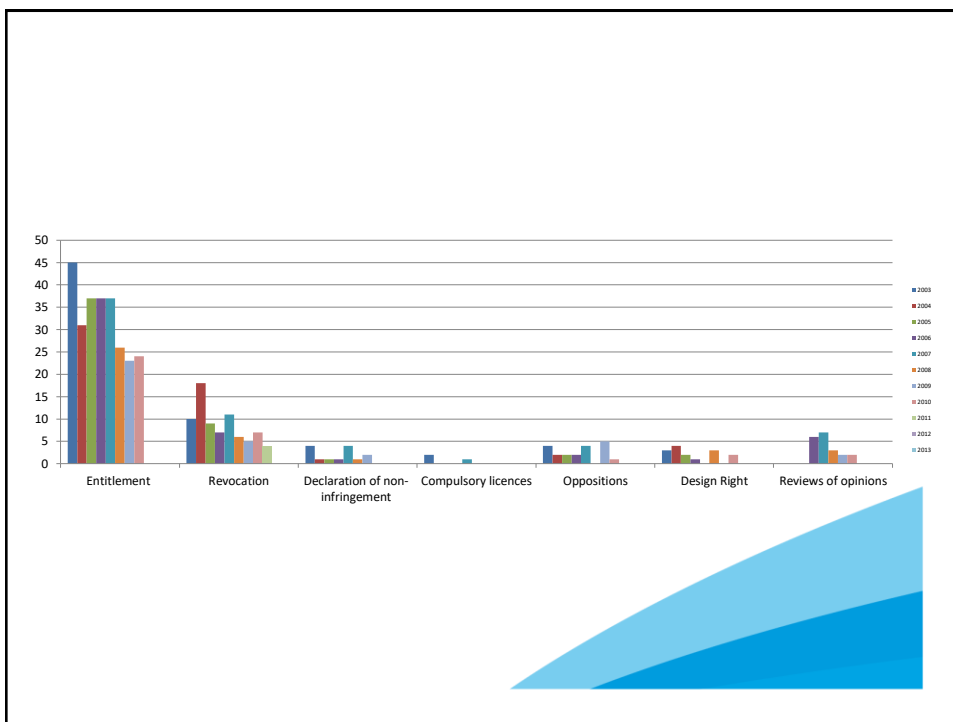
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Comptroller's jurisdiction

- Entitlement disputes common
- Can be asked to determine entitlement
 - S8: to UK application
 - or even before any application is made
 - S37: to granted patent
 - S12: to EP, WO or foreign application pre-grant
- May have to consider foreign law
- EPO has no jurisdiction



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Relief available

- For UK patent, wide powers, eg
 - transfer ownership
 - add or delete a co-owner
 - grant a licence
 - split the patent
- In other cases, have to use common sense
- what is feasible?

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Typical issues

- Was the inventor an employee?
- Was there a legal or equitable assignment?
- Did the alleged inventor get the invention from someone else?
- If several people were involved, which of them count as 'inventors'?



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Procedures

- Comptroller must notify
 - others alleged to be entitled
 - co-proprietors
 - anyone shown on register/file as having interest
 - all inventors (if pre-grant)
- Any of these can oppose the reference
- If comptroller changes ownership, must notify any licensees



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Role of courts

- Fewer powers if action starts in the courts
- But courts assume full powers of comptroller:
 - on appeal
 - if comptroller declines to deal



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Pending patent applications

- UK applications
 - examination and grant just go ahead
 - action continues after grant under S37
- EP applications
 - all proceedings suspended on request
- WO applications
 - just go ahead, but no grant process anyway



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Some real cases

Intellectual Property Office

Results of past patent decisions

This service allows you access to patent decisions issued by us.

If you know the British Library (BL) number of a decision, you can use the BL number search to view the summary and/or full decision. The general search allows you to customize your search criteria to suit your requirements.

For a chronological list of decisions, select the type of hearing and click GO. Alternatively you can use the browser by year facility towards the bottom of this page.

A selection of pre-1995 decisions are also available on ODOUK. Please note that these cannot be accessed by using the search facility below.

Decisions of the UK courts can be accessed at [ECLAIR](#) >>

BL number search

BL Number:

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Choose the hearing, if you know it. If you do not, it is optional. A full decision will be returned if you select a full decision.

General search

Type of hearing:

Application / Patent Number:

Issued between: Month Year and Month Year

Hearing officer:

Person(s) or company(s) involved:

Provisions discussed:

Keyword or phrase:

Keyword or phrase:

Keyword or phrase:

☒ General search
Blank fields will be ignored by the search.
You can enter a maximum of 25 characters or phrases.

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Enter a section of the Patents Act 1977.

Browse by year

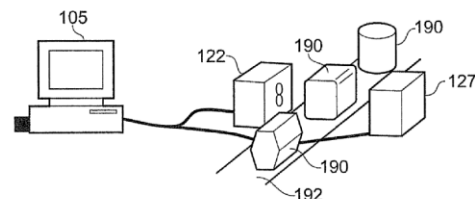
Click on a year in the following table to view all decisions issued during that period.

2013	2012	2011	2010	2009	2008	2007	2006	2005	2004	2003	2002
2001	2000	1999	1998								

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University of Warwick v Dr Diamond

- (19) **United States**
(12) **Patent Application Publication**
(43) **Pub. No.: US 2009/0279773 A1**
(43) **Pub. Date: Nov. 12, 2009**
- (54) **IMAGING APPARATUS AND METHOD**
- (75) **Inventors:** **Tat Hean Gan, Tipping Peng (MY); David Arthur Hutchins, Coventry (GB); Geoffrey Graham Diamond, Coventry (GB)**
- Correspondence Address:
POLSNELLI SUGGART PC
700 W. 47TH STREET, SUITE 1000
KANSAS CITY, MO 64112-1892 (US)
- (73) **Assignee:** **THE UNIVERSITY OF WARWICK, Coventry (GB)**
- (21) **Appl. No.:** **12/306,505**
- (22) **PCT Filed:** **Jun. 28, 2007**
- (86) **PCT No.:** **PCT/GB07/50368**
§ 371 (c)(1), (2), (4) **Date:** **Dec. 23, 2008**
- (30) **Foreign Application Priority Data**
Jun. 28, 2006 (GB) 0613165.0
- Publication Classification**
- (51) **Int. Cl.** **G06K 9/00** (2006.01)
G01N 25/06 (2006.01)
- (52) **U.S. Cl.** **382/141; 378/51**
- (57) **ABSTRACT**
- Apparatus for inspecting an article comprising: a controller configured to generate a drive signal having a periodic amplitude variation; a source, the source being operable by the controller to emit a source beam thereby to irradiate an article, the source beam comprising a beam of electromagnetic radiation having a periodic amplitude variation corresponding to that of the drive signal; and a detector, the detector being configured to detect a portion of the source beam that has been transmitted through at least a portion of the article, and to generate a detector signal having an amplitude variation corresponding to the amplitude variation of said portion of the source beam, the controller being further configured to generate a difference value corresponding to a difference between the amplitude of the detector signal and the amplitude of a reference signal.



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University of Warwick v Dr Diamond

- Dr Diamond employed on rolling 3-6 months research contracts
- Together with two others not in dispute that Dr Diamond was co-inventor of invention however University claimed rights under section 39(1)

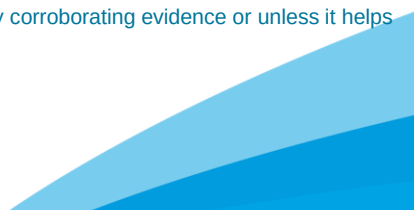


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University of Warwick v Dr Diamond

- 2 Day hearing
- Witness statements from 4 witnesses – 2 cross examined
- Credibility – Dr Diamond

"He contested anything that he thought might hurt his case, even when it was apparent that it was either not relevant or any challenge was hopeless. This together with his at times evasiveness and his partial and unconvincing recollection of events meant he was not a particularly credible or reliable witness. Hence even if I reject, as I am minded to do, Mr Ward's claim that Dr Diamond was a dishonest witness, I must I believe still treat his evidence with great caution unless it is supported by corroborating evidence or unless it helps the claimants case."



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University of Warwick v Dr Diamond

- The claimant relied only on section 39(1)(a).
- Furthermore it contended only that the invention was made in the normal course of Dr Diamond duties and not in the course of duties specifically assigned to him.
- Hence decision turned on i) what were the normal duties of Dr Diamond at the time that the invention was made ii) was the invention made in the course of those duties and iii) were the circumstances such that an invention might reasonably be expected to have resulted from the carrying out those duties.

Finding

"The claimant has not shown that the invention was made in the course of Dr Diamond's normal duties and therefore its application under section 12 in respect of US Patent Application 12/306505 fails."



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Auckland v Enderby

It was Mr Auckland's normal Health and Safety duty to deal with accidents that was relevant. Enderby claims that Mr Auckland had a role in investigating accidents involving Enderby workers and in participating in preparing reports into them

A bricklayer had fallen down a manhole that he was working on. The worker had managed to climb out of the manhole but was later taken to hospital.

Mr Auckland identified a need for a device that would prevent workers from falling down manholes, or from hurting themselves if they did, and yet would still allow them to work on the manhole.



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Auckland v Enderby



(12) UK Patent (19) GB (11) 2 410 283 (13) B

(45) Date of publication: 28.12.2005

(54) Title of the invention: Temporary cover assembly for a void

(51) Int Cl⁷: E02D 29/12

(21) Application No:	0425210.2	(72) Inventor(s):	Paul Richard Auckland
(22) Date of Filing:	16.11.2004	(73) Proprietor(s):	Paul Richard Auckland 6 Watson Avenue, MANSFIELD, Notts, NG18 2BS, United Kingdom
(30) Priority Data:		(74) Agent and/or Address for Service:	Franks & Co 15 Jessops Riverside, Brightside Lane, SHEFFIELD, S9 2RX, United Kingdom
(31) 0424390	(32) 04.11.2004	(33) GB	
(43) Date A Publication:	27.07.2005		
(52) UK CL (Edition X):			
E1G G94X G96X			
(56) Documents Cited:	GB 2345611 A		
GB 2392700 A			
US 3426659 A			
(58) Field of Search:			
As for published application 2410283 A viz:			
UK CL (Edition X) E1G			
INT CL ⁷ E02D, E03F			
Other: ONLINE-WPL EPODOC			
updated as appropriate			

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Auckland v Enderby

Finding

The invention was made in the course of Mr Auckland's normal duties but the circumstances were not such that an invention might reasonably be expected to result from the carrying out of those duties.

Mr Auckland was not specially assigned duties and the circumstances were not such that an invention might reasonably be expected to result from the carrying out of those duties.

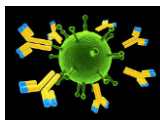
At the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties Mr Auckland did not have a special obligation to further the interests of his employer's undertaking.

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Patent disputes heard by the IPO

- Multi-million pound pharmaceutical cases

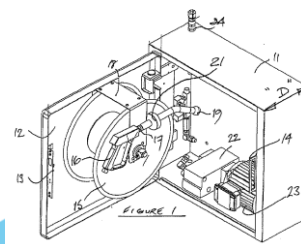
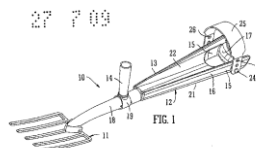
- Brother v Brother



- Husband v Wife

- Unrepresented v Represented

- Unrepresented v Unrepresented



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Some final thoughts

- Entitlement is very important because it determines who gets the £££s
- Unfortunately parties often fail to think about it until they fall out years later
- Some disputes are bitter personal wrangles
 - though others do involve big money



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