

## **PATENTS ACT 1977**

IN THE MATTER OF

a reference under section 8

by Furfix Products Limited

in respect of Patent Applications Nos GB9509562.6 and GB9609921.3

in the name of Harold John Andrews

## **INTERIM DECISION**

### **Introduction**

1. Patent application no GB9509562.6 was filed on 11 May 1995 by Mr Harold John Andrews naming himself as inventor, and was treated as withdrawn under section 15(5) of the Patents Act 1977 ("the Act") before publication. Patent application no GB9609921.3 was filed on 11 May 1996, also by Mr Andrews naming himself as inventor, and claiming priority from GB9509562.6. GB9609921.3 was published on 11 December 1996 as GB2301603A and has not yet been granted.

2. On 13 December 1995 Furfix Products Limited ("Furfix") submitted to the comptroller a reference under section 8 accompanied by a statement under rule 7 which, as amended on 9 April 1997, seeks an order to the effect that the invention set out in GB9509562.6 belongs to Furfix. A counterstatement was filed by Mr Andrews on 8 May 1996. On 9 April 1997 Furfix submitted to the comptroller a second reference under section 8 accompanied by a statement under rule 7 which seeks an order to the effect that: the invention claimed in GB9609921.3 belongs to Furfix; GB9609921.3 may proceed in the name of Furfix only instead of in the name of Andrews; and Furfix shall be given the right to amend any current claims or file claims based on the disclosure in the specification without any unnecessary limitation. Evidence, comprising two statutory declarations by him with exhibits, was filed by Mr Andrews in November 1996 and July 1997. Furfix's evidence, filed in January 1997, comprises a statutory declaration by Mr Paul John Furr, Managing Director of Furfix.

3. The parties having agreed that the two section 8 proceedings should be consolidated, the matter came before me at a hearing on 11 November 1997, at which Mrs Anne Spence of Fry Heath & Spence appeared as agent for the referrer, Furfix, and Mr Andrews, the opponent and patent applicant, represented himself.

### **The patent applications**

4. GB9509562.6 relates to a joist hanger, that is to say a metal hanger used in the construction industry to support a joist (or roof truss) from a load bearing wall. In the specification, conventional forms of hanger are outlined and their disadvantages discussed. In particular, on page 2 it is said:

“One reason why it has hitherto proved difficult to provide a satisfactory one piece joist hanger is that it has been assumed to be necessary for the joist to be supported by a shoe extending beneath its end portion. However the applicant has realised that, by omitting the shoe, not only can the production problems be overcome but several unexpected advantages can be obtained, while still providing the calculated requirements as to load carrying and stability.”

5. As described and shown with reference to figures 1 to 6, the hanger of GB9509562.6 is formed from a single sheet of metal and comprises a bearing portion for resting on a wall, an abutment portion extending generally at right angles from the bearing portion to abut the surface of the wall and a pair of integral side portions extending parallel to each other away from the abutment portion. In use, a joist is received between the side portions and secured by fasteners, such as nails, extending through apertures in the side portions. Thus, in this construction there is no need to provide a lower horizontal portion at the bottom of the abutment portion to support the joist. Several advantages follow, for instance, that the joist can be adjusted vertically before fastening, that there is no possibility of damp being trapped beneath the joist, and that plasterboard can be nailed directly to the joist. In addition, manufacture can be simplified - the entire hanger may be made by slitting and folding a truncated, isosceles triangular blank of sheet metal. Although no claims were filed on the application, a statement of invention on page 2 reads:

“According to the invention there is provided a joist hanger comprising a bearing portion adapted to rest on a horizontal top face of a supporting element in use, an abutment portion adapted to abut a forward face of the supporting element in use, and a pair of integrally formed side portions extending generally parallel to each other away from the abutment portion and spaced apart by a distance sufficient to receive a joist between the side portions, aperture means being provided for fasteners by which the side portions may be secured to the joist in use.”

6. Application GB9609921.3 appears to incorporate the disclosure of GB9509562.6 together with certain additional options which are described with reference to figures 7 to 12. As well as using the hanger with the abutment portion extending downwards from the bearing portion as described in GB9509562.6, use in an inverted position with the abutment portion extending upwards is shown. In the latter position, a vertical truss may be secured between the side portions. In addition, manufacture of the hanger from a rectangular blank is described. There are twenty claims in all, of which claims 1 to 16 and 19 relate to a hanger or similar support, and claims 17, 18, and 20 to a blank or blanks adapted to provide a hanger or similar support. Of the independent claims, claims 19 and 20 are of the omnibus form, while the sole main claim, claim 1, reads:

“1. A hanger or similar support for a joist or the like comprising a bearing portion adapted in use to rest on a horizontal face of a supporting element or wall structure, an abutment portion or end plate extending substantially at right angles from said bearing portion and a pair of side portions extending generally parallel to each other away from the abutment portion and spaced apart by a distance sufficient to receive an end part of a joist or the like between them, said abutment portion providing locating abutment as necessary for the end of the joist or the like and/or against a said supporting element or wall structure, aperture means being provided through the side portions to receive fasteners for positively securing them to the joist or like end part in position of use.”

7. Of the remaining claims, claim 6 is especially worth noting. It reads:

“6. A hanger or similar support according to any of the preceding claims wherein vertically open ended space between the side portions permits vertical adjustment of a joist or like end part between them e.g. when height adjusting and/or levelling the joist or the like in position of use prior to positively securing the side portions to the joist or like end part, and/or to permit projections and exposure of the underpart of the joist or like end part below the side portions.”

## **Events**

8. It is convenient first to outline the sequence of events in this case, starting with what is common ground between the parties. Mr Andrews was employed by Furfix as a structural engineering consultant, and was paid a retainer plus consideration for any tasks deemed to fall outside this arrangement. On 19 April 1995 Mr Andrews attended a meeting ("the April meeting") with Mr Paul Furr, Managing Director, Mr Donald Furr, Chairman, and Mr John Young, Technical Director, all of Furfix. Mr Andrews was shown, in confidence, a drawing dated 19 April 1995, a copy of which ("the first drawing") is attached to the counterstatement at Annex A. The drawing shows a one-piece hanger with side portions turned in at their bottom edges to form a partially open base. It was agreed that Mr Andrews would give further thought to the mechanical performance of the hanger and make tests. At a subsequent meeting with Mr Paul Furr, Mr Andrews described a modification in which the turned-in edges were dispensed with so as to form a fully open base, and indicated that he had applied for a patent on this construction. Mr Andrews offered to sell the patent rights to Furfix for the costs he had incurred in filing the application, but Furfix declined the offer and instigated the present proceedings. There is no dispute thus far over the sequence of events.

9. There is, however, dispute over what I shall call "the second drawing", the drawing attached to Furfix's statement of 13 December 1995 as Appendix A, which shows a one-piece hanger differing in a number of respects from that shown in the first drawing. In his statutory declaration of 4 December 1996, Mr Paul Furr states that the first drawing was handed to Mr Andrews at the April meeting and was amended at the meeting as a result of general discussion to the form shown in the second drawing. He asserts that Mr Andrews therefore either had or

knew of the amended drawing before he left that meeting. By contrast, Mr Andrews submitted at the hearing that this is untrue, and that the first time he saw the second drawing was when it was submitted by Furfix in the present proceedings. I should perhaps make clear that while noting Mr Andrews' submission, I must also recognise that it was not sworn in evidence.

10. At the hearing Mrs Spence described the joist hangers on the market in April 1995 of which Furfix was aware. These hangers either comprised several parts welded together, or a single-piece construction with a solid base, upstanding sides and split abutment and bearing portions. She noted that both of these prior arrangements are described in each of Mr Andrews' applications. Referring me to the second drawing, Mrs Spence said that Furfix saw three main advantages in this construction (which I shall call "the Furfix design"): it was stronger, more blanks could be cut from a given area of sheet material, and the partly open base allowed further elements to be attached to the base of the joist in the area of the hanger. Turning to Mr Andrews' applications, Mrs Spence referred me first to the statement of invention and certain subsequent paragraphs in the introduction of GB9509562.6, and secondly to the claims of GB9609921.3. She asserted that the only modification of the Furfix design proposed by Mr Andrews was the elimination of any base to what she called the stirrup portion. She pointed out that all of the passages she had cited and most if not all of the claims, including claim 6, arguably read onto the Furfix design, since none is restricted to a hanger with a completely open base or an extended fold line between the abutment portion and bearing portion, these being the main features of Mr Andrews' invention as stated in his statutory declarations.

11. Referring to the first and second drawings, Mrs Spence noted that the second showed a modification in which the fold line between the abutment and bearing portions was extended, and that although there was a dispute over the origin of the second drawing, Mr Andrews had not denied that this modification was discussed at the April meeting. She pointed out that what I shall call the "third drawing" forming Annex B to Mr Andrews' counterstatement shows an extended fold line. This drawing is dated 24 April 1995, just five days after the meeting, and is labelled "Furfix Masonry Hanger". In Mrs Spence's view this was a clear indication that Mr Andrews regarded the extended fold line feature as belonging to Furfix. She concluded this part of her submission by making it clear that Furfix do not dispute that Mr Andrews originated the idea of

having no base at all to what she called the stirrup portion of the Furfix hanger, that is eliminating the two folded-in edges of the Furfix design.

12. In reply Mr Andrews explained that his relationship with Furfix was a good one and a longstanding one. He noted that he had been in the building construction industry for many years and although not an expert in patent matters was familiar with them, having been involved in some fourteen patents over the years of which seven are ongoing. He was, however, something of an expert in the field of joist hangers. Referring to the April meeting, as already noted above he denied seeing the second drawing at that meeting. Instead he said that he had agreed at that meeting to test the adequacy of the partly open base formed by the turned-in edges and of the fold between the abutment and bearing portions of the construction shown in the first drawing. Following this work and as a consequence of it, he sent to Furfix the third drawing (Annex B to the counterstatement) which shows a hanger retaining the turned-in edges but now having an extended fold line. This he saw as a viable construction for Furfix to follow up.

13. Mr Andrews then described a thought process which he regarded as distinct from the work he had carried out for Furfix. It struck him that if a joist could be carried by nails on the face of another joist using a face fixing hanger, then it should be equally simple to carry a joist on nails between two side plates of a hanger of the type to which these proceedings relate. This led him to the idea of the open base structure. Since he was confident that this idea was his, he applied for a patent and offered it to Furfix for what it had cost him to date in taking out the patent, offering the view that although Furfix's design was perfectly good his was better. Mr Andrews concluded by making clear that the only feature he devised was the open base; he had no claim to the extended fold line since to him it was well known. I might note that Mr Andrews' disavowal of inventing the extended fold line is contrary to his written evidence (paragraph 5 of his statutory declaration dated 31 October 1996) filed before the hearing.

### **The law**

14. The right to apply for and obtain a patent is governed by section 7 of the Act. Subsections 2 to 4 of section 7 read:

"(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."

15. Sub-section (2) thus makes clear that an inventor named under a patent is presumed to have the entitlement in it unless there is an over-riding enactment, law, treaty or agreement, and sub-section (3) that the "inventor" is the actual deviser of the invention. Since Mr Andrews is the named inventor under the patent applications, the onus lies on Furfix, as the referrer, to show, on

the balance of probabilities, that he was not the actual deviser of the invention.

## **Issues**

16. What then are the issues which I need to decide in the light of the dispute and the applicable law? It seems to me they are: (i) who devised the features disclosed in the patent applications; (ii) who is the inventor or who are the joint inventors of those features; (iii) who is entitled to the ownership of those features, and (iv) in the light of the answers to the preceding questions, what relief is appropriate.

## **Who devised the features disclosed?**

17. In relation to question (i), it seems to me that there are four key features of the joist hanger, namely:

- (a) a partially open base formed by turned-in edges, which edges in use provide support for the joist;
- (b) a fully open base which provides no support for the joist, the joist being in use secured by fasteners (eg nails) extending through apertures in the side portions of the hanger;
- (c) a fold line formed at the juncture of the bearing and abutment portions and extending beyond the width of the abutment portion;
- (d) manufacture by bending a single piece of sheet metal.

Of these, (b), (c), (d) are features disclosed in the patent applications in suit, while (a) is not but is relevant to the submissions made to me.

18. Inspection of the prior art documents appended to the counterstatement suggests that it is not unlikely that some at least of the features (a) to (d) listed above are known. However, Mrs Spence submitted that in these proceedings the question of patentability is not relevant. In support she cited the Hearing Officer's decision in *Northern Engineering Industries plc v Drillcon Industries Ltd (Great Britain)* (O/67/85), and in particular the passage at lines 15 to 17 of page



10 which reads:

" .. reading the Act as a whole, the term "invention" appears to encompass anything devised by the inventor and includes both patentable and non-patentable inventions. ..."

Thus she argued "invention" has a broad meaning in these proceedings not limited to patentable inventions, and this I accept.

19. In the light of the statement by Mrs Spence that Furfix has admitted that Mr Andrews devised the idea of an open base, ie eliminating the two folded-in edges of the Furfix design, and the statement by Mr Andrews that the only feature he devised was the open base, the decision as to who devised what would appear to be relatively straightforward. Although there is dispute over the origin of the second drawing which shows the extended fold line between the abutment and bearing portions, Mr Andrews stated at the hearing, in contradiction of his sworn evidence, that he had no claim to the extended fold line since this was well known. Taking all the evidence before me and the submissions made at the hearing into account I find that, for the purposes of these proceedings, feature (b) was devised by Mr Andrews and features (a), (c) and (d) were devised by someone at Furfix. Who precisely that someone might be was not as clearly defined in the referrer's case as it might have been. Indeed, as I pointed out to Mrs Spence at the hearing, the referrer's case did not include an explicit application under section 13 for the mention of an inventor, although the matter was clearly central to that case. Mrs Spence responded that there had been an error in that respect, and that Mr Donald Furr was the inventor of the Furfix features. Her assertion is supported in paragraph 3 of Furfix's statement, and I note that the first drawing carries the legend "Original D Furr". In the absence of any argument to the contrary from Mr Andrews, I am prepared to accept that features (a), (c) and (d) were devised by Mr Donald Furr.

### **Who is the inventor or who are the joint inventors?**

20. I now turn to question (ii), namely who is the inventor or who are the joint inventors of the invention or inventions in the patent applications.

21. Mrs Spence said that Mr Andrews acted as a consultant to Furfix and was asked to investigate and test the Furfix proposed product. She argued that the feature (b) devised by Mr Andrews was a modification which resulted directly from the work carried out by him on behalf of Furfix; she did not believe he would have come up with it if he was not asked by Furfix to investigate its proposed design. In this connection she referred me to the circumstances in the case of *William Rose Smith's Patent* (1905) 22 RPC 57, and took me especially to page 61 where Earle J is quoted in *Allen v. Rawson* (1845) 1 C.B.551 as follows:

"I take the law to be that if a person has discovered an improved principle and employs engineers agents or other persons to assist him in carrying out that principle, and they in the course of experiments arising from that employment make valuable discoveries accessory to the main principle and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle and may be embodied in his Patent; ..."

22. While I would observe that there is more recent case law on this subject, I accept that the precedent to which Mrs Spence took me is applicable to my finding that feature (b) was devised by Mr Andrews and features (a), (c) and (d) by Mr Donald Furr. As applied to the present case, and given that it is not disputed that Mr Furr devised features (a), (c) and (d) before the April meeting and therefore before Mr Andrews devised feature (b), the question is whether, if Mr Furr is regarded as having invented a new main principle, Mr Andrews' contribution (b), using the words of Earle J, amounted to a valuable discovery accessory to the main principle and tending to carry that out in a better manner. If so, the "inventor" of the feature I have found Mr Andrews devised will be Mr Furr. If Mr Andrews' contribution is more than this, he will be the "inventor" of that feature.

23. Mr Andrews submitted that the idea of eliminating a bottom bearing or base and relying on nails was not a "modification" but a "new concept". He suggested that in arriving at the idea of a fully open base he was not influenced by the tests he carried out for Furfix. I have to say that in presenting his case Mr Andrews struck me as straightforward and plain speaking, and I am persuaded that in his own mind he is genuinely convinced that he arrived at the idea independently

of the tests he made. However, it still remains for me to decide whether or not, in the circumstances of this case, his conviction is justified. If Mr Andrews were in the position of providing consultancy over a wide range of civil engineering subjects, and had come to joist hangers primarily through the medium of the work he was carrying out for Furfix, then I would find it difficult if not impossible to accept that his idea of an open-bottomed joist hanger was not a consequence of his testing Furfix's joist hanger. However, this does not appear to be the case in the present instance. Mr Andrews submitted that he is something of an expert in the field of joist hangers, a submission which in the light of the expertise he demonstrated in the presentation of his case I accept. It follows, it seems to me, that there is a strong probability that turning over in his mind various alternative constructions of such hangers is a continuing part of his professional life, with the generation of fresh ideas not being dependent on the stimulation of a commission to test a particular form of hanger.

24. Whether or not that is right, there is a further strong indicator in my view. Although the point was not argued as such before me, it seems to me that a hanger with a completely open base which itself provides no support at all for the joist does not lie in the direct path of development of the various Furfix designs in evidence, all of which have a partly open base which provides substantial support for the joist. Mrs Spence argued that Furfix felt that the modification of the open base arose because Mr Andrews was asked to investigate whether the folded-in flaps would contribute any or enough strength; they felt the idea of an open base where the whole of the weight could be taken by putting in a few extra nails derived from what he was asked to do for them. However, there is no evidence that when commissioned Mr Andrews was steered in the direction of developing a hanger with a fully open base. Rather, the Furfix design which he was testing would if anything have led him away from developing the fully open base. Mr Andrews exercised his own initiative and went beyond his brief, and unprompted devised the fully open base hanger. I do not consider that the provision of a fully open base in a hanger, as an alternative to a partially open base as in the Furfix design, can be regarded as accessory to that concept. Accordingly, I am not persuaded that Mr Andrews' contribution belongs to Furfix and I therefore recognise him as being the inventor of feature (b).

25. Although as I indicated at the hearing and above there is no formal application under

section 13, I need to consider the matter in the light of my findings on inventorship. Since the provisions of section 13 are restricted to granted patents and published applications, I need only consider this point in respect of GB9609921.3. Given that I have found there to be features in this patent application invented by Mr Andrews and Mr Donald Furr, it follows that both have a right under section 13 to be mentioned as joint inventors, and I shall reflect that right in the orders I will make later.

### **Who is entitled to the ownership of those features?**

26. I turn now to question (iii), namely who is entitled to be granted a patent for the features disclosed in the patent applications. Section 7(2), which I quoted earlier, requires in effect that the inventor is, or joint inventors are, entitled to apply for and obtain a patent for an invention unless there is an over-riding enactment, law, treaty or agreement. Having found, as I have, that Mr Andrews and Mr Donald Furr both invented features contained in the patent applications in suit, it follows from sub-section (2)(a) that each has an entitlement in the applications unless any preference of the sort specified in sub-section (2)(b) exists. Moreover, the effect of the word “primarily” in sub-section (2)(a) is that the onus of proof is on whoever seeks to deny an inventor an entitlement. It is of course Furfix’s assertion that it has the entitlement in all the features of the patent applications. So far as the features invented by Mr Donald Furr are concerned, this assertion is undisputed, and in the absence of argument to the contrary I am prepared to accept Furfix’s entitlement to them. So far as the feature invented by Mr Andrews is concerned, in order to determine the question of entitlement, I need to examine the relationship between Furfix and Mr Andrews and its implications. In doing so, Mrs Spence urged me to bear in mind the dictum of Earle J followed in *Smith* which I have already quoted, and I shall do so.

27. Mrs Spence discussed the relationship between Furfix and Mr Andrews. She noted that he was employed as a consultant by Furfix and emphasised that, although there was no written contract between Mr Andrews and Furfix, and indeed that the arrangement might be described as an extremely casual one, the disclosure of the first drawing to Mr Andrews at the April meeting was in confidence, and this was accepted by Mr Andrews in his counterstatement. Although there is little doubt that the relationship between Furfix and Mr Andrews was, in Mrs Spence's words,

"extremely casual", it is not in dispute that there was a long standing relationship between the parties for which Mr Andrews was paid a monthly retainer plus consideration for any tasks falling outside this arrangement, although Mr Andrews' counterstatement states that at no time was he retained or paid to provide innovative designs for new products. As I pointed out at the hearing, the referrer's evidence on the point of the contractual relationship between Mr Andrews and Furfix is very thin indeed. The onus is on Furfix as the referrer to show that an agreement existed which over-rides the statutory position under section 7(2)(a) whereby Mr Andrews derives an entitlement to feature (b) because he was the inventor of it. I am not persuaded that the referrer has discharged that onus.

28. On a slightly different line of reasoning, Mrs Spence referred me to lines 24 to 27 of page 10 of the *Drillcon* decision where the Hearing Officer said:

"To my mind, I have simply to determine whether the referrers have established an entitlement to the relief they seek by virtue of satisfying me that Drillcon have imported into their application matter relating to their invention which was derived from and devised by TFW."

29. She sought to establish that Mr Andrews had imported into his applications matter derived from and devised by Furfix on the basis that the statement of invention and certain paragraphs in the introduction of GB9509562.6, and most if not all of the claims of GB9609921.3, read onto the Furfix design, none being restricted to a hanger with a completely open base. While I accept the factual accuracy of her observation, it does not seem to me to be sufficient to make her case. In this context there is a fundamental difference to my mind between an application which describes a particular piece of apparatus, and an application which contains no such description, but has claims or statements which include within their scope that piece of apparatus. In the present case it seems to me that, having found that for the purposes of these proceedings that Furfix are entitled to the benefit of features (a), (c) and (d), I have to determine whether or not Mr Andrews has imported this specific subject matter into his applications; it is not sufficient for this matter merely to be included within the scope of claims or statements in those applications. Since there can I think be no doubt that features (c) and (d) are present in both applications I find

that in this respect Furfix are entitled to appropriate relief. Feature (a) is not, however, described in either of Mr Andrew's applications and I find therefore that no relief is due under that head.

**Relief: GB9509562.6**

30. Since GB9509562.6 was treated as withdrawn under section 15(5) before being published, relief under section 13 is not available. Likewise, relief under section 8(2) or 8(3) is not available; only relief under section 8(1) can be considered. It therefore seems to me that the appropriate form of relief is a declaration of Furfix's entitlement in the patent application. **So far as patent application number GB9509562.6 is concerned therefore I find that for the purposes of these proceedings Furfix is entitled to a declaration that:**

**" a joist hanger formed from a single piece of sheet metal bent to form a bearing portion adapted to rest on a horizontal top face of a supporting element in use, an abutment portion adapted to abut a forward face of the supporting element in use, and a pair of integrally formed side portions extending generally parallel to each other away from the abutment portion and spaced apart by a distance sufficient to receive a joist between the side portions, the side portions having apertures for fasteners by which the side portions may be secured to the joist in use, and with the fold line formed at the juncture of the bearing and abutment portions extending beyond the width of the abutment portion, was invented by Mr Donald Furr and is the property of Furfix".**

**Relief: GB9609921.3**

31. I turn now to GB9609921.3 which has been published but not yet granted. Taking first the matter of inventorship, I have found that of the features contained in the application, Mr Andrews invented feature (b), while Mr Donald Furr invented features (c) and (d), and hence that Mr Donald Furr has a right under section 13 to be mentioned as inventor. **I therefore certify that Mr Donald Furr has the right to be mentioned as joint inventor with Mr Harold John Andrews on patent application number GB9609921.3, and I direct that an addendum**

**mentioning him as an inventor be prepared for the published form of that application, namely GB2301603A.**

32. As to the entitlement to grant of a patent on this application, of those features to which I have found Furfix is entitled, this application describes features (c) and (d), but not feature (a). I am faced with the difficulty here that although, as pointed out by Mrs Spence, the main claims at least of this application cover the Furfix design incorporating feature (a), a partially open base formed by turned-in edges, the only embodiments described show the fully open-bottomed construction of feature (b) to which I have found that Mr Andrews is entitled; feature (a) is neither shown nor suggested in the application. Any order that I might make under section 8(3) in favour of Furfix in terms of the amendment of GB9609921.3 or for the filing of a fresh application would be constrained by section 76 which precludes the introduction of additional subject matter. I therefore believe there is no order that I can make that would allow the inclusion of feature (a). I note also that this feature is now in the public domain by virtue of these proceedings. Likewise, if I were to order joint ownership of the patent application, it could be difficult and impractical for both parties. Taking all these matters into account, and in particular my finding that Mr Andrews has an entitlement to feature (b), it seems to me that the offer made by Mr Andrews at the outset to sell his rights in this application to Furfix for the costs he had incurred in filing it was a fair one, and I recommend Furfix to reconsider taking up this or a similar offer if it is still on the table.

33. It is necessary for me to consider the most appropriate course of action if the parties are, in the event, unable to reach an agreement on this head. The task before me is to divide the rights in GB9609921.3 equitably between the parties in accordance with my findings as to entitlement, and this objective could in my view be served by my ordering under section 8(2)(a) that the application should proceed in the name of Furfix while under section 8(2)(d) ordering that an irrevocable, exclusive licence, with the power to sub-licence, be granted to Mr Andrews in respect of hangers incorporating feature (b), viz joist hangers having a fully open base which provides no support for the joist. Alternatively, I could order that the application proceed in Mr Andrews' name with a similar licence being granted to Furfix for hangers having features (c) and (d) but not having feature (b). In either of those eventualities, the question of whether any royalty should be

payable under the licence would arise.

34. Furfix have requested that they be given the right to amend any current claims or file claims based on the disclosure in the specification without any unnecessary limitation. It seems to me that the aptness of such relief would depend on who finally owns the application, but that it would in any case probably be inappropriate in the light of the other orders I am likely to make.

**35. It seems to me that before I make any order to give effect to my finding on entitlement to patent application number GB9609921.3, the parties ought to be given an opportunity to negotiate an agreement between themselves, and failing that at least an opportunity to make submissions to me on the form of order I should make. I therefore allow the parties two months from the date of this interim decision within which to make written submissions on this issue. If they can reach an agreement between them, then those submissions should inform the comptroller of the terms of that agreement. If they are unable to agree, those submissions should give their respective views on the form of order as to entitlement in GB9609921.3 I should make. Each party should send a copy of its submissions to the other party who, unless the submissions report an agreement, will then have a period of one month from the date of receiving the copy within which to submit comments on them. I will then consider any such submissions and comments before making my final decision on this issue.**

### **Costs**

36. Furfix, but not Mr Andrews, has asked for costs. Mrs Spence argued that Furfix probably would not have entered into this dispute if Mr Andrews' applications had not covered what Furfix thought was their invention, and in addition that, in contrast to Mr Andrews, Furfix had filed a minimum of evidence hoping for a quick hearing. Although I take her points, it is my view as I have stated above that the offer by Mr Andrews to sell his rights to Furfix for the costs he had incurred in filing his patent applications was a fair one that Furfix might have been well advised to take up. On balance I am inclined to make no order for costs. That said, the matter may depend on the outcome of the remainder of the action. I therefore defer settling the question of



costs until the issue of my final decision at the conclusion of the proceedings.

### **Appeal**

37. This being a decision other than on a matter of procedure, any appeal against this decision shall be filed within six weeks after the date of this decision.

Dated this 12<sup>th</sup> day of March 1998

**S N DENNEHEY**

Superintending Examiner, acting for the comptroller

**THE PATENT OFFICE**