

PATENTS ACT 1977

IN THE MATTER OF a reference under section 37(1) and an application under section 13(1) & (3) by Andrew Webb in respect of Patent no. 2291342 in the name of Sandra Agnes McGriskin

INTERIM DECISION

Background

1. On 17 June 1995 Sandra Agnes McGriskin (“McGriskin”), acting as a private applicant without the assistance of an agent, filed patent application number 9512390.7. She named herself as sole applicant and sole inventor and did not claim any earlier priority. The application was given accelerated treatment at her request because she claimed that another party was manufacturing her invention already without her permission or involvement, and she was granted a Patent no. 2291342, entitled “The balance stool”, on 19 June 1996.
2. On 9 June 1998 a reference under section 37(1) and an application under section 13(1) & (3) were made by Andrew Webb (“Webb”) with regard to the patent. He requested the Comptroller to (I) add his name as an inventor, (ii) remove McGriskin’s name as an inventor, (iii) transfer the proprietorship of the patent to him, and (iv) award costs to him.
3. In due course the statement of case, the counterstatement and the usual rounds of evidence were filed, the last evidence filed being the evidence in reply filed by Webb on 27 May 1999 which included, inter alia, a third affidavit by Webb.
4. On 12 July 1999 McGriskin wrote to the Patent Office saying that there were several important observations she had to make in regard to the referrer’s third affidavit and asking for confirmation

that the Comptroller would accept these observations in writing from her. Also, in her letter of 12 July 1999, McGriskin queried Webb's request for costs, she herself not having asked for an award of costs.

5. The preliminary view of the Patent Office with regard to the request by McGriskin to make observations, given to both sides in an official letter of 16 July 1999, was that it would be best dealt with at a short oral hearing in which both parties would be free to make such observations as they wished on the other's case. Also, in this same official letter, McGriskin was informed that "costs in any proceedings are generally awarded in favour of the successful party at the discretion of the Comptroller and in line with a published scale".

6. However, Webb wrote to the Patent Office on 19 July 1999 to say that he would prefer to see the observations on paper and have a short time to study them, rather than have to reply immediately as he would at a hearing and, accordingly, McGriskin was invited to file her further observations in writing. In the event McGriskin failed to file further observations in the time set and a hearing was appointed before me for 16 December 1999. At the hearing both McGriskin and Webb represented themselves, although the former was accompanied by her solicitor.

The patent

7. The patent relates to a rocking stool which can be used during the teaching of the 'Alexander Technique' (a technique which helps with human body movement, in particular helping with poise and movement such as sitting, standing, walking and bending and can assist with back pain).

8. The three claims of the granted patent read -

1. A therapeutic stool, comprising a circular wooden forwardly sloping seat, mounted via wooden legs on two wooden arcuate rockers which converge towards the front of the stool.
2. A stool as claimed in claim 1 in which the rockers are united in the front by means of a triangular block fixed in the angle where they meet.
3. A stool as claimed in claim 2, in which there are three legs, the single front leg being doweled into the top of said triangular block and the lower ends of the two rear legs being attached to the rockers in

the vicinity of the rear ends thereof.

9. The description of the patent specification explains that the idea to design a balance stool with rockers was created by the applicant to be used during teaching of the Alexander Technique, and that the applicant approached a carpenter/furniture maker with her idea, to make a balance stool with rockers in wood . The description also explains that as a teacher the applicant wanted to find a solution to a recurring problem of a pupil using his/her legs to push off the ground, at the same time tightening the muscles of the neck pulling the head back, and that during anatomical studies of human structure and function she became aware of the points of pivot, or rockers, within the human skeleton structure and decided to see what effect putting a rocker at the base of a sitting structure would do.

10. In the specification a specific embodiment of the invention is described with reference to accompanying drawings, which consist of eight figures. With regard to figure 3, the description states that -

“ Figure 3 shows in perspective how the rockers put underneath the stool give a balancing flowing action to the base, letting the person allow a movement forwards and up, by thinking the Alexander directions “Let the neck be free so the head can move forwards and up off the spine, in such a way that the back can lengthen and widen. Let the knees go forward and away”. This formula alters the axis of the body weight forward, with the head is leading and the head/neck/spine are connected as one. Notice how the position of sitting bones change too. They rock forward as the weight of the head moves. There is a folding at the hip joint.”

Background of McGriskin and Webb

11. McGriskin qualified as a teacher of the Alexander Technique in 1992, and in June 1993 she began working at the Cumbria Complementary Health Centre, Cockermouth, Cumbria. On her own admission she has no previous experience of designing furniture.

12. Webb was apprenticed to a boatbuilder building wooden boats, then served as a police constable from 1979 to 1985 when he resigned to set up as a furniture maker in Keswick, working

at the Riverside Workshop from 1989 and making a wide variety of furniture, with a particular interest from 1987 onwards in seating. Following back problems, he took regular lessons in the Alexander Technique from 1988 onwards for many years, initially from Wendy Bonington, an Alexander Technique teacher at Fellside Alexander School (“Fellside”), Kendal and, subsequently, from McGriskin herself having some 100 lessons in all.

The written evidence

13. Webb’s written evidence is considerably more extensive than McGriskin’s. It consists of three affidavits by Webb himself, affidavits by sixteen other people (furniture makers and retailers, a sculptor, a Business Links counsellor, co-ordinators of “ Made in Cumbria” Intellectual Property Register, persons who purchased furniture from him, and several Alexander Technique teachers) and a large number of exhibits (photos of furniture, market survey questionnaires, copies of work log books, diary extracts, notes of meetings, letters, leaflets, catalogues, orders, purchase plans, paying in book, “ Made in Cumbria “ priority date registers, and a certificate certifying that Webb was a police constable from 1979 until he resigned in 1985). Much of this evidence is largely irrelevant to the inventorship/entitlement issue under consideration, or mere opinion or hearsay to which I can give little weight, however it fully establishes his claim to be an experienced furniture maker with a particular interest in Alexander Technique seating.

14. McGriskin’s evidence consists of an affidavit by herself and ten exhibits (a notice and press report about an Artists in Commission Exhibition, her Alexander Technique teacher’s certificate, map and diary entries, four letters, an information leaflet about the Alexander Technique, drawings of stools and background notes, a leaflet by Webb, two press releases, and a newspaper article). In similar manner to Webb’s evidence, much of this is irrelevant to the issues under consideration or hearsay.

The law

15. Sections 37(1) & (2) of the Patents Act is concerned with entitlement to patents after grant and reads -

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

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

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

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

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

Thus section 37 gives me considerable latitude both as to the decision I may make and also to the remedies I decide to apply.

16. The right to apply for and be granted a patent is governed by section 7 of the Act. Subsections 2 to 4 of that section read -

7 - (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 any enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of 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

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

7 - (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 section (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.

17. The consequence of Section 7(4) is that the onus is on the referrer to establish his case.

18. Section 13 (1) and (3) are concerned with the rights of inventors and read -

13 - (1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be mentioned in accordance with the rules in a prescribed document.

(3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and any of the documents prescribed for the purposes of subsection (1) above.

19. Finally, I need to recite a part of section 36 which deals with co-ownership of patents:

36 - (3) Subject to the provisions of sections 8 and 12 above and section 37 below and to any agreement for the time being in force, where two or more persons are proprietors of a patent one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent ...

The hearing

20. At the commencement of the hearing I put it to McGriskin and Webb that if either of them wished to introduce new evidence then he or she should indicate this at the start of the hearing,

but Webb told me he had no additional evidence and McGriskin asked me to proceed.

21. Both parties individually put their cases to me and both cross examined the other under oath. I also put a few clarifying questions to each party. Webb came over as cool, collected and well used to cross examination whereas McGriskin came over as more volatile and less clear. She was inclined to meet an uncomfortable question by firing back a question to the questioner.

22. The evidence, both written and given under cross examination, allows me to establish the following as uncontested facts:

(a) Rocking stools with forwardly sloping seats and parallel rockers are known and have been on sale from at least 1989;

(b) Webb had made a working seat by taking an old chair and clamping it on rockers before McGriskin made any request of him, and he had designed a three-legged stool **not** on rockers in 1993;

(c) McGriskin saw samples of Webb's work in the 'Artists Working for Commission' exhibition in Kendal in November 1994 and picked up one of his business cards indicating his special interest in Alexander Technique seating;

(d) Shortly afterwards, she visited Webb in his workshop in Keswick and made regular visits on Wednesdays for a period of some months thereafter;

(e) In an early visit during January 1995 McGriskin asked Webb if he could make her a stool on rockers;

(f) During discussions as to the form of the stool, the concept of a three-legged stool with forwardly converging rockers arose;

(g) A prototype version of the stool was created and seen by McGriskin in late May

1995;

(h) At least one prototype such stool was exhibited together with other pieces of furniture at Fellside in June 1995;

(I) Photographs of *inter alia* such stools were registered with the 'Made in Cumbria' IP Register on 20 June 1995. I note that affidavits by the register co-ordinators, Richard Knowles and Sally Renshaw and copies of their records confirm that photos, including one showing four stools, namely an adjustable height rocking stool and three rocking stools with inclined round seat, three legs and convergent rockers, were received and registered on 20 June 1995. In the photograph showing three stool with convergent rockers only one stool does not include a rail between the two back legs.;

(j) The stool was the subject of *inter alia* a letter dated 26 September 1995, a undated sales leaflet, a press release of circa October 1995 and a newspaper article of November 1995;

(k) The patent drawings illustrate a stool without a back rail between the two rear legs. The prototype seen by McGriskin in May 1995 was the only version of the stool made in this way;

(l) Despite sending Webb a breach of confidence letter in April 1996, McGriskin did not reveal the existence of the patent application or the granted patent until April 1997, well after the patent was granted in June 1996; and

(m) Webb is currently producing stools according to the patented design under the changed company name 'The Wave Seat Company'.

23. Other matters, however, which are crucial to the issues under consideration are strongly contested or subject to conflicting evidence.

24. The evidence disagrees as to the date of the parties first meeting. Webb refers to it being in November - December 1994, whilst McGriskin's written evidence specifies a Wednesday early in January 1995. Under cross examination, however, she modified this to agree with Webb, ie November - December 1994. In so far as it is significant, I find this date to be established.

25. Webb contests that McGriskin showed him any drawings detailing seat construction, but he does admit to being shown anatomical drawings. There is evidence from Webb's trainees that he did not use drawings when creating items of furniture. McGriskin made no point on this issue, and I again find it established that she did not show Webb drawings other than anatomical ones. On a related subject, she initially testified that she had the complete idea in her head at the time of their first meeting. On cross examination, however, it became clear that this was not the case and some aspects, eg the converging ski-type rockers, were developed later. Webb commented, in this regard, that if she had already had the design when she first asked him to make her a stool on rockers it would have been more logical to get the patent application in first and then start to approach people to make it and, equally, if he had wanted to claim the idea as his own then it would have been in his interests to send details to the 'Made in Cumbria' IP Register straight away.

26. There was dispute also, about whether McGriskin had sat in a rocker chair which Webb kept in his workshop, his office or at his home. Although her initial reaction was to deny doing so, the evidence not only of Webb himself but of others working for him indicates that she did and she herself admitted this under cross examination. Moreover, the evidence of Webb under cross examination suggests that her realisation of how much easier it was to stand up from a rocking chair than a fixed one is of vital importance in establishing McGriskin's rationale for requesting a stool on rockers in the first place.

27. As to the development of the concept of a three-legged stool with forwardly converging rockers, despite as has been previously said McGriskin initially indicating she had had the complete idea in her mind at the outset, it quickly became clear under cross examination that this concept had been developed later. As to the date of development, the evidence is not entirely clear. Both parties seemed to indicate that this was discussed in January 1995 (possibly the third

Wednesday in January), but later in his presentation Webb seemed to indicate rather that the concept still was not developed by 17 May 1995. I am inclined to accept the view that the subject was at least initially discussed in January 1995, but it is not necessary for me to formally decide upon this point, since the parties agree that it first came up in joint discussion, although there is dispute as to who primarily raised the idea.

28. There was dissent also over whether or not McGriskin had actually commissioned the stool from Webb as opposed to merely giving him the idea. Webb informed me that when McGriskin had asked for the stool on rockers he had told her that it would take a lot of time to design. He explained to me that even just the making, setting up machines for the joints, was not going to make it economically viable for one item and the cost would probably run into thousands of pounds. However, since he thought that a rocking seat would be good for his work, as a work seat for the general public, he thought that he would see what he could do about it when he had time and then she could have one free of design costs. McGriskin for her own part was adamant she had commissioned Webb for his wordworking expertise to make up a stool to 'her' design and that when she had taken away an example of the stool which had been left at Fellside she saw it as merely collecting that to which she was entitled. McGriskin agreed that she had ordered four stools of the invention from Webb in November 1995 for teaching purposes and had paid him £240 for them, saying that she had also paid £141 six months later in 1996. McGriskin told me that she had also given Webb three lessons during March and April 1995, part payment for the stool being offset by these lessons, and his brother had two free lessons as well. She also mentioned an additional sum of £40 in cash given to her. Webb on the other hand, told me that he had half a dozen Alexander lessons from McGriskin and had paid the going rate for his own lessons. He agreed that his brother had several lessons, but said that he had no connection in that regard, only giving her his brother's phone number. I note that the evidence suggests that she paid nothing for the stools until circa November 1995 when she paid £240 for four stools (ie £60 per stool when the stools are currently sold for £150 each) indicating that she certainly paid less than the going rate. There is no suggestion of payment of any commissioning costs and no testimony from McGriskin that she did pay any such costs beyond the disputed free Alexander lessons to Webb and/or his brother.

29. Much of Webb's cross examination of McGriskin was directed at establishing her lack of expertise in woodworking matters and her lack of knowledge of how aspects of the stool which is the subject of the patent effectively work together. Webb brought a stool of the invention to the hearing and when he cross examined McGriskin he put many technical questions to her about the stool. He said that he considered that a stool on rockers was not novel and that the nub of the invention lay in the particular configuration. He asked McGriskin about rocker and pivot points, about the joint at the front and its assembly, about the length of the rockers and why they converged to the front, and about the benefit of convergent rather than parallel rockers. He also pointed out that the patent had been based on the first prototype seen by McGriskin in May 1995 because the figures in the patent show a stool without a rail between the back legs and the first prototype was the only stool of the invention which he had ever made without a rail, and he questioned her about the purpose of such a rail. He additionally claimed that figure 3 of the patent is wrong because it shows the stool slipping backwards as a person rises from it, whereas the stool does not slip, and that this indicated that when McGriskin wrote the patent she had not understood the mechanics of the action. It quickly became apparent that McGriskin could not answer these questions satisfactorily and that she did not have wood working or technical skills connected with seat making. I take it as established that she showed clear lack of knowledge in these respects, but as she herself said, she is ignorant of such matters which is why she employed Webb in the first place. I do not take it as necessarily indicating that she has no inventorship rights.

30. There was dispute also over a demonstration by Webb of a number of items of furniture (including prototypes of the stools) at Fellside in June 1995. Firstly, as to the actual date of the demonstration - Webb said 10 June (ie before the filing date of the patent application) and McGriskin countered 17 June (ie after the filing date), and secondly to whether or not the demonstration was private or public. With regard to the disputed date of 10 June 1995, I note that Madeleine Shaw, an Alexander Technique teacher, in an affidavit of 17 November 1998 which has not been challenged by cross examination, states that on 10 June 1995, while she was training at Fellside School, she remembers Webb bringing the stool of the invention to the school. Webb's evidence also includes affidavits from several others who state that they saw the stool of the invention at Fellside school in summer or June 1994, but without giving a date, and I also note

that an entry in his diary, which I inspected at the hearing, against 10 June 1994 says “Stools etc demonstrated at Fellside today”. For her own part, McGriskin was adamant that the actual date had been later than this but she said that she could not confirm this later date because her car had been broken into in August 1995 and her personal notes, handbag and diary stolen therefrom. She told me that she had reported this incident to the police. I made it clear that these issues went to the validity of the patent, not something I would be considering at that hearing and on which I would require full evidence if raised formally.

31. There was a further issue connected with this demonstration, however, that when questioned by Webb why she had not objected to his passing off the stools as his own work on this occasion, McGriskin made it clear that she had been furious about the way he had brought the stool with convergent rockers and the questionnaires and leaflets to the Fellside School in June 1995 and had given the impression to those present that it was his stool, later coercing them into supporting him. She claimed that she had been humiliated but had not wanted a massive row in front of people since she had been interested in getting maximum feedback from teachers and pupils about the stool. She said that she did complain to others afterwards over a period of about three months. Having seen McGriskin at the hearing, however, I find it hard to believe she could so restrain herself entirely.

32. Webb said that he found it very surprising that McGriskin had not informed him about the existence of the patent application or the granted patent until April 1997, well after the patent was granted in June 1996 and also well after she had issued a breach of confidence letter to him in April 1996. He said that he could think of no other reason for her delay in telling him except that she thought he could hinder her application and that once it was granted it would be irrevocable. Webb told me that he had continued to make stools of the invention after receiving the breach of confidence letter because he was sure he had a right to do so; he had taken legal advice and been told that he had a problem but it could be sorted out. I questioned McGriskin about why she had kept totally silent about the patent application and had not informed Webb of the patent until 1997. She seemed to find this question difficult to answer but said that it was really to do with the situation in her life at that time, she had moved twice and had a new working environment which took a lot to set up and fund. I find this to be an unconvincing response.

33. Webb explained why he had credited McGriskin with some involvement in the stool with convergent rockers in for example a sales leaflet, a letter and a press release originating from him about the stool. These were filed in evidence by McGriskin and they refer to “our” stool and to the stool being “partly inspired” by McGriskin, and to the stool as originating “from an idea of Sandra McGriskin”. He said that he was thankful to the Alexander Technique and what it had done for him, especially in his furniture making, and, because the press liked to mention individual names in articles, he had mentioned his trainees by name and also McGriskin. He explained that he was full of enthusiasm for being free of back pain for the first time for years and for the way the Alexander Technique had changed his life, and he was trying to thank it through her in a way.

He said that he wrote to her and sent her copies of two press releases in August and September 1995 and he would not have done that or put her name in the press release if he thought there was a dispute between them. I asked Webb what he meant by his reference in his press release about the London launch of the stool to the “invaluable help” given by McGriskin and he answered that he was feeling generous and full of enthusiasm for the Alexander Technique. I am of the opinion that more than this was meant.

34. Webb claimed that McGriskin did not have any input into the round top, the converging rockers, the three legs, the triangular block, the front joint, these features being entirely his own work. I am inclined to believe him because of the acknowledged absence of any woodworking expertise on the part of McGriskin. When it comes to the idea of converging rockers, however, as previously indicated the situation is less clear. Webb told me that when he had initially made a stool on parallel rockers, after McGriskin’s request and during discussions with her, he had said “rockers would catch our heels” and “we could make it meet” and she had said “yes, like a pair of skis”. As earlier indicated, McGriskin disputes this, arguing it was her idea. I see this as an unresolved conflict of evidence.

35. Webb, however, did make a number of telling admissions under cross examination (my emphasis):

(1) McGriskin: “Okay. Would you agree that you had not by yourself put all of the elements of this stool together at the time? [ie January 1995 - my addition]

Webb: Yes.

McGriskin: So even though you were working on all kinds of other things this was not something that had happened at that point?

- Webb: No, it had not been finalised.”
- (2) McGriskin: “Mr Webb, you were, you claim, involved in making a comfortable type of seat at the time when I approached you. I came to you with an idea for a seat that would solve a problem in the way people sit and stand up. Do you agree?
- Webb: “ No, you never expressed any particular interest in how they sat. You were only interested in how they stood up out of it and that was entirely your realisation. That would not have occurred to me.”
- (3) Webb: “I did not say that. I said I did not appreciate its benefits or rather the benefits of this chair to help in standing. That is something an Alexander teacher would realise.
- McGriskin; Yes, I did.
- Webb: That is your expertise and not mine.”
- (4) Hearing Officer: “So you do not admit that Ms McGriskin has contributed anything to that construction?
- Webb: She has prompted me to do the thinking. I may have done it sooner because of her request...”

These concessions strongly indicate to me that it was McGriskin’s initial discovery of how a seat on rockers made the act of standing up particularly compatible with her Alexander Technique teachings and her consequent request for such a stool that initiated the whole inventive process, and that Webb by himself would not have been prompted to make the invention at that time, if ever, in the absence of such a request.

35. After Webb had been cross examined by McGriskin I asked Webb whether he was still maintaining that he was the sole inventor and he said that he was. On the other hand when I asked McGriskin whether in hindsight she thought it was fair to claim to be the sole inventor she said “I would have to say that the combination of factors here is a very difficult one. It is something that one cannot happen without the other. You cannot produce or manufacture something without the inspiration to make it. I suppose that maybe I was too guarded in that inspiration in that I took my interpretation of what a patent is. There is a copyright, there is a design, but a patent to me is the first thing to happen in that area. Do you know what I mean ?”

Conclusions

36. Claim 1 of the patent specifies far more than just a wooden rocking stool; it also requires that the stool seat is circular and forwardly sloping and that the rockers converge towards the front of the stool. Claims 2 and 3 specify more detail about the rockers and legs. In deciding which person or persons invented the stool, I have to bear in mind who devised these features specified in the claims. I accept that as far as claim 1 is concerned, each of the individual features specified therein, except for the convergent rockers feature, was known before the filing date of the patent application but it is the effect of the overall combination that is new.

37. It is clear to me that McGriskin has only limited knowledge of patent matters, and this is only to be expected of a private individual who does not work in the legal field. Nevertheless, I consider that McGriskin may have acted in a somewhat underhand way in applying for the patent without informing Webb and in naming herself as the sole inventor, apparently giving no thought to whether Webb, who had made the stool, should be named as a co-inventor. Moreover, I cannot fully understand her motives in waiting until April 1996 before issuing a breach of confidence letter to him, and in not informing him about the existence of the patent until April 1997.

38. However, Webb has not convinced me that on the balance of probabilities he alone devised the convergent rockers which features in claim 1 of the patent. I remain uncertain as to exactly what occurred when it was realised by him and/or McGriskin that parallel rockers got in the way of feet, and which of the pair of them came up with the idea of convergent rockers and when that was. It is basically Webb's word against McGriskin's, and although he struck me as a more straightforward witness than her, I have no reasoned justification for accepting his word in preference to hers.

39. Moreover, I have not also been convinced that in the absence of the impetus of McGriskin's initial request that Webb would have put his mind to designing the stool of the invention at least at that time. In support of this I would draw attention to the quoted passages from his cross examination and also to the praise given to McGriskin *inter alia* in the sales leaflet and the press

release.

40. As I have not been convinced in either of these respects, it follows that McGriskin should remain named as an inventor.

41. On the other hand I am convinced that it was Webb alone who devised the features brought out in the two appendant claims, namely that the rockers are united in front by means of a triangular block fixed in the angle where they meet, and that the single front leg is dowelled into the top of the triangular block and the lower end of the two rear legs are attached to the rockers in the vicinity of the rear ends thereof . At the hearing McGriskin quite clearly showed that she does not have the necessary technical knowledge or skills to be the originator or even a joint originator of these features in the appendant claims.

42. Accordingly, I find that McGriskin and Webb are joint inventors. It therefore follows that McGriskin and Webb should also have joint ownership rights in the patent unless an enforceable agreement exists which causes section 7(2)(b) to apply rather than section 7(2)(a).

43. No written agreement has been drawn to my attention. McGriskin claims that she commissioned the stool and paid for it, but Webb denies the commissioning and the payment. It seems most unlikely to me that Webb agreed to make the stool under commission because of the development costs involved, and it is clear to me that McGriskin did not pay for the true cost of the stool. Although at the hearing under oath she stated that she gave Webb and his brother some free Alexander Technique lessons, I note that in her affidavit she states to the contrary that Webb paid for his lessons, which is what he told me. Further, no mention has been made of any discussion taking place between McGriskin and Webb in 1994 or 1995 which was concerned with taking out a patent or with which person or persons should be the proprietor of a patent should one be taken out for any invention made by one or both of them. Accordingly, I do not consider that any enforceable agreement existed between McGriskin and Webb concerning applications for patents. Thus section 7(2)(b) does not apply and Webb and McGriskin should have joint patent rights.

44. As I have earlier indicated section 37 (2) gives me considerable discretion as to the orders I can make and it seems to me that, given the clear antagonism between the parties at the hearing, my orders should ensure that it is possible for each of McGriskin and Webb to manufacture and sell the stool of the invention without being beholden in any way to the other. This is particularly so because it was clear at the hearing that the two have very different intentions as to the way the stools are to be marketed. Accordingly, it seems a proper way for me to proceed to ask for the parties' submissions in this regard having due regard to the restrictions imposed by the Patents Act and, in particular, section 37(2) quoted above and section 36 also quoted above which limits the freedom of joint proprietors.

Orders

45. In line with my conclusion that I find Andrew Webb and Sandra McGriskin to be joint inventors, I direct under section 13(1) that Andrew Webb be mentioned as an inventor together with Sandra Agnes McGriskin in the granted patent and that erratum slips should be prepared for the patent, in accordance with Rule 14(5) for this purpose.

46. However, I also allow the respective parties 3 weeks from the date of this decision to make submissions as to the form of order I should make under section 37(2) which is consistent with my findings of joint rights in the patent. Examples of possible such orders are:

(a) I could direct that the patent should simply proceed in the joint names of the two parties. This solution would most accurately reflect my finding that both parties have rights in the invention but, if the parties are not prepared to cooperate could inhibit the subsequent exploitation of the patent having regard to the provisions of section 36 of the Act. This solution might be particularly unsatisfactory for Ms McGriskin who, in practice, may only be able to exploit the patent by licensing. The terms of section 36 *prima facie* would prevent her from doing this without the agreement of Mr Webb who might not feel inclined to cooperate in the circumstances. I would be reluctant to direct joint ownership, therefore, without giving Ms McGriskin greater freedom to enter into licensing agreements than a joint proprietor would normally enjoy.

(b) I could direct that the patent proceed in the name of Ms McGriskin alone with the grant of an irrevocable, royalty-free non-exclusive licence to Mr Webb. This option is perhaps most consistent with my finding that Ms McGriskin made the initial request and Mr Webb solved the constructional problems. It would perhaps have the disadvantage that Mr Webb would have no further control over the continued prosecution of the patent, eg the continued payment of renewal fees, but given that he was apparently content to manufacture without the known protection of a patent and with the protection rather of Design Right (through registration with the 'Made in Cumbria' IP Register) this would perhaps be of lesser importance. This is my preferred option.

(c) A third option is to allow the patent to proceed in the name of Mr Webb but to grant an irrevocable, royalty-free, non-exclusive licence to Ms McGriskin such as to allow her to exploit the patent personally or by sub-licensing to a third party. This would leave the onus of the continued prosecution of the patent in the hands of Mr Webb who perhaps has shown lesser interest in the protection provided by a patent than in that provided by registration. This would also sit less well also with my finding that Ms McGriskin prompted the initial request. I am less attracted to this option.

47. Other options are of course possible. The evidence before me is limited and I am not in possession of all of the facts concerning the current position of the parties or the potential value of the invention and the patent rights. It is possible, for example, that either party may wish to consider the sale of their patent rights or prefer a licensing arrangement whereby one would pay royalties to the other. I recommend that the parties consider the situation fully and perhaps consult their professional advisors before making their submissions.

Costs

48. I regard Andrew Webb as the successful party in these section 37 and 13 actions, albeit only partly so since I have made a finding of joint, rather than sole, inventorship and ownership rights. At the end of the hearing Mr Webb made a submission to me on the issue of costs pointing out

that he had made an offer through Ms McGriskin's solicitors not to ask for costs if she did not contest the action. This was declined and accordingly he had been put to an awful lot of work and costs. I pointed out that it was not the general practice to award other than a contribution of costs in Patent Office proceedings for fear of frightening parties away from litigating in the Patent Office.

49. I propose to defer consideration of the matter of costs until I have decided what orders are appropriate and to deal with the matter in the final decision.

Appeal

50. Since this is not a matter of procedure, any appeal should be lodged within six weeks of the date of this decision.

Dated this 3rd Day of February 2000.

G. M. BRIDGES

Divisional Director acting for the Comptroller

THE PATENT OFFICE