

PATENTS ACT 1977

IN THE MATTER OF references
under sections 12 and 13 by Oliver
Jevons in respect of the invention
disclosed in International Patent
Application PCT/US99/06438 in the
name of Minnesota Mining and
Manufacturing Company

DECISION

Introduction

- 1 This decision is concerned with entitlement to an international patent application PCT/US99/06438 and the inventorship of the invention or inventions in that patent application. Oliver Jevons, the claimant in these proceedings, argues that he is the sole inventor and that he alone is entitled to any patents that might be granted on the basis of this application. The Minnesota Mining and Manufacturing Company (3M), the patent applicant and defendant in these proceedings, maintains that the invention or inventions were made solely by Phillip Bouic, currently named as the inventor and an employee of 3M, and that the defendant is entitled to sole proprietorship of any patents. The matter came before me at a hearing on 6 August, at which Mr Douglas Campbell, instructed by Hill Dickinson appeared as Counsel for Mr Jevons, and Mr Simon Thorley, instructed by Bristows, appeared as Counsel for 3M.

The technical subject matter

- 2 International patent application PCT/US99/06438 is concerned with a foam masking tape for use in masking vehicle body paintwork to prevent penetration of paint spray through unsealed gaps between openings and surrounds of a vehicle body. The application claims priority from patent application GB9807613.6 filed on 9 April 1998 in the name of the defendant.
- 3 Claims 1 to 5 of the international patent application are the most relevant to the present dispute and read as follows:
 1. *A masking material for use in masking a gap between a movable panel of a vehicle and an adjacent part of the vehicle, the masking material comprising an elongate foam strip having a generally elongate cross-section with rounded ends, a cold-welded seam along each curved longitudinal edge, a width in the range of from 25 to 35 mm, a thickness in the range of from 5 to 15 mm, and a strip of pressure-sensitive adhesive adjacent one longitudinal edge; the adhesive strip having a width in the range of from 8 to 12 mm and being located at least 2 mm from the said one longitudinal edge.*
 2. *A masking material as claimed in claim 1, provided as a roll which is*

formed by winding the foam strip upon itself.

3. *A roll of masking material comprising a parallel array of conjoined and manually separable elongate foam strips, each strip having a generally elongate cross-section with rounded ends, adjacent strips being joined by cold-welded seams along the curved longitudinal edges of the strips; each strip having a width in the range of from 25 to 35 mm, a thickness in the range of from 5 to 15 mm, and a strip of pressure-sensitive adhesive adjacent one longitudinal edge; the adhesive strip having a width in the range of from 8 to 12 mm and being located at least 2 mm from the said one longitudinal edge.*

4. *A method of masking a gap between a movable panel of a vehicle and an adjacent part of the vehicle, the method comprising the steps of: providing an elongate foam strip having a generally elongate cross-section with rounded ends, a cold-welded seam along each curved longitudinal edge, and a strip of pressure-sensitive adhesive adjacent one longitudinal curved edge; opening the movable panel; applying the foam strip, by means of the adhesive strip, to an edge of the inner surface of either the movable panel or the adjacent part so that the foam strip projects beyond the edge; and closing the movable panel so that the projecting portion of the foam strip is located in the gap with the longitudinal curved edge of the foam strip remote from the adhesive directed towards the exterior of the vehicle.*

5. *A method as claimed in claim 4, further including the step of pushing the end of the projecting portion of the foam strip back into the gap after the movable panel has been closed.*

- 4 The remaining claims are all dependent directly or indirectly on claim 4. Claims 6 and 7 add in the dimensions specified in claim 1, claims 8 and 9 specify the type of foam and claims 10-12 refer to the use of the method for various specific parts of a vehicle.

The Law

- 5 These proceedings have been brought under sections 12 and 13 of the Patents Act 1977. Section 12 deals with questions about entitlement to applications made under the law of any country other than the United Kingdom. The important part for the present proceedings is section 12(1) which states:

“12.-(1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made)-

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) [not relevant]

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.”

- 6 Section 13 deals with the right to be named as an inventor. Section 13(1) spells out an inventor’s right to have his or her name mentioned:

“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 so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.”

whilst section 13(3) allows the names that have been mentioned to be challenged:

“(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 of any documents prescribed for the purposes of sub-section (1) above.”

Evidence

- 7 The evidence for the claimant, Mr Jevons, consists of two affidavits by himself with supporting exhibits in the form of documents and tape examples. The evidence for the defendant, 3M, consists of statutory declarations and witness statements from Phillip Bouic, Ebenezer Asirvatham and Cecilia Ann Hill, with supporting exhibits in the form of documents and tape examples. Two of these witness statements were filed very late but were admitted as the other side took no objection to them. Further evidence was handed up and admitted at the hearing itself. This further evidence includes pages of Mr Bouic’s technical notebook that are subject to a confidentiality order under rule 94(1) of the Patents Rules 1995, made by my colleague Mr Dennehey on 3 August. In the event I have not had to mention the detailed contents of those pages in this decision, so it has not been necessary for me to prepare a redacted version of the decision for publication.
- 8 Mr Jevons has been associated with the motor repair trade for 14 years and from 1993 to 1997 was Director of Vasco Limited, a British company trading in masking tapes for car body paintwork. Phillip Bouic has been an employee of 3M since 1996 and works as a product development engineer in the development laboratory of their Automotive Aftermarket business. Ebenezer Asirvatham has been an employee of 3M since 1980 and is the European Technical Service manager for their Automotive Aftermarket business. Cecilia Ann Hill is a Chartered Patent Agent and European Patent Attorney employed in the Office of Intellectual Property Counsel at 3M Europe, Belgium since June 1994.

Outline history of events

- 9 Although the two sides have different perspectives on the events leading up to the

invention in dispute, there are many facts that are either agreed or at least not disputed. I will start with what the claimant, Mr Jevons, was doing.

- 10 In 1997 Mr Jevons was aware that none of the masking tapes then available for sealing the gap between a vehicle door and the door surround when spray painting was entirely satisfactory. He devised a new foam masking tape, and a method of using it, that overcame the disadvantages of existing tapes. His tape had a generally rectangular cross section whose proportions were within a certain range - not too fat, not too thin, typical dimensions being 25mm by 10mm - with one tape edge (ie one end of the rectangle) square and the other rounded or tapered. There was a strip of adhesive close to the square edge, typically 8mm wide and 2mm from the edge. In use the tape was secured to the inside of the door, not to the door surround as had been most commonly done in the past. When the door was shut, the rounded or tapered end filled and projected out of the gap. It could then be adjusted if needed, eg pushed back into the gap a little. Because the tape was fastened to the inside of the door, there was no risk of adhesive being exposed in the gap, a problem with previous tapes that could cause hard edges to build up in the paint. Further, because the part of the tape that was in the gap could be adjusted after fixing, accurate positioning of the tape was no longer critical.
- 11 Mr Jevons filed a patent application, GB 9719091.2, for this tape and the method of using it in September 1997. Since he felt his new tape was superior to the tapes the defendant was selling, he initiated licence negotiations with the defendant, 3M, in October 1997 through his agent Mr McNeight. He then demonstrated his tape to representatives of 3M at a meeting at their Atherstone site on 11 November 1997 and gave them a copy of his patent application. In accordance with their normal policy, 3M refused to sign a confidentiality agreement in respect of what was demonstrated, but since the patent application had already been filed and Mr Jevons felt there was a strong probability that 3M would want a licence, Mr Jevons went ahead with the demonstration despite the absence of any formal obligation of confidence on 3M's part.
- 12 Meanwhile, Mr Bouic had been trying to develop a new tape for his employer 3M. In line with good company practice, he kept records of his technical work in a Technical Notebook. On 12 August 1997, he met with Mr Hills and Mr Hunt of another company, Speedarrive Projects Ltd, to discuss masking tapes that they had devised and that were described in their international patent application WO 95/21700. These tapes were not of an essentially rectangular cross section like the one that Mr Jevons devised. Rather, they had a thick portion - usually round or approximately so - which sealed the gap and a thin portion - usually flat - which projected from the thick portion and carried the adhesive strip. Like Mr Jevons' tape, though, their tapes were attached to the inside of the door, not to the door surround. Following this meeting, Mr Bouic set about devising ways in which a tape of this type could be produced. He recorded his ideas as they developed and as he tried them out in his Technical Notebook, from which it is clear he was still working on developing the Speedarrive tape when Mr Jevons arrived at 3M with his tape.
- 13 Mr Bouic did not attend Mr Jevons' demonstration on 11 November. However, Mr Thompstone, a technical colleague of Mr Bouic's who did attend, told Mr Bouic about Mr Jevons' ideas shortly afterwards. Mr Bouic recorded this in his Technical

Notebook on 12 November 1997, making a sketch of the tape that is very similar indeed to fig. 1 of Mr Jevons' patent application (save that the drawing is the other way up) with very similar dimensions - 28mm by 10mm. He also commented in his notebook that:

“This works in exactly the same way as the Robin Hills product and further more is only a slight modification on ‘B’ post, ie use thinner foam (maybe 13mm to allow for compression), set the blades at 28mm not 27mm and arrange every other blade for a sharp cutting blade. Then you just coat one band of adhesive not two.”

‘B’ post refers to an existing 3M tape which was made in the way specified in claim 3 of the patent application in suit - ie as a parallel array of tapes, joined to one another by cold-welded seams, which could be manually separated. This method of manufacture was the subject of a 3M patent that had been granted in 1995. I will refer to it as their “cold welding patent”.

- 14 Mr Bouic carried out trials of making the Jevons'-style tape using the B-post technology, and on 11 March 1998 he submitted a Record of Invention. The description of the invention commences:

“This inventions (*sic*) relates to a universal soft edge tape product for use on all car apertures including the A-post, B-post and tailgate. The AAD division was approached by an outside inventor on 11/11/97 with an idea for a soft edge product in a “bullet” shape. The idea was for a foam strip approximately 28mm wide by 10mm thick with one edge rounded and one cut flat and a single strip of adhesive running along the flat cut edge. It was immediately apparent that a similar product could be made using a slight modification of the B- post product set up.”

It goes on to give some examples and to explain how the product is used. The Record also states that information relating to the invention was first written down on 12 November 1997. A month after Mr Bouic submitted this record, 3M filed patent application GB 9807613.6, the priority application for the application in suit.

- 15 I will now go back briefly to Mr Jevons' side of the story. In the period following the demonstration to 3M, he filed three further related patent applications relating to foam masking tape and sent copies to the defendant. Although at one stage the defendant apparently offered to pay for the filing of an international patent application, negotiations ceased, and subsequently Mr Jevons negotiated a licence agreement with a German manufacturer. Mr Jevons did in due course file an international patent application on 8 September 1998, whilst his September 1997 GB application was granted as patent no. GB 2327052 on 25 May 1999.
- 16 Whilst not strictly material to the issues before me, it is worth noting that in August 1999 Mr Jevons learned that 3M had launched a new foam masking tape which, he felt, was very similar to his own. In May 2000, he took infringement action against them for infringement of his patent GB 2327052. 3M counterclaimed for revocation, but in the end the claim and counterclaim were dismissed by consent of the parties.

17 At this stage I think it would be helpful to draw attention to the main similarities and differences between the tape shown in Mr Jevons' patent and the tape shown in the application in suit. Both have more or less the same proportions and the same dimensions. Further, both are used on a car door in exactly the same way. However, whereas the tape in Mr Jevons' patent has one straight edge and one rounded (or tapered) edge, the tape in the 3M application has both edges rounded. Further, the 3M application explains how its tape can be manufactured by compressing a foam web longitudinally with spaced, blunt, rotary cutters to produce cold welded seams, the end result being an array of parallel strips with two rounded edges, joined to each other by those edges but manually separable. This of course was using the technology that was the subject of 3M's cold welding patent.

Facts in dispute

18 There is no real dispute about the history of events as I have outlined them so far. There is, however, dispute about exactly what information Mr Jevons conveyed to 3M at his demonstration, what influence that had on the development by Mr Bouic of the tape that forms the subject of the application in suit, and whether 3M were in fact under an obligation of confidentiality in respect of the demonstration despite the absence of any formal confidentiality agreement. I need to resolve these issues before I can go on to consider the other main area of dispute between the two sides, viz the legal implications of what happened so far as entitlement to the application in suit is concerned. Before I do that, however, I must say a brief word about the witnesses.

19 Oliver Jevons, Phillip Bouic and Cecilia Ann Hill were cross-examined on their evidence. Cecilia Ann Hill came across as totally open and honest: she said when she was unable to recollect facts rather than trying to guess them. At the end of the day, though, her evidence was of peripheral value. Both Oliver Jevons and Phillip Bouic were careful in their responses under cross-examination. Although I did not get the impression that either was deliberately lying or misleading, both came across as clearly aware of the case their side needed to make and I felt this was colouring their recollection of events and their opinions. It was, for example, clear at times that they were trying to work out in their mind where the questioning might be leading before answering. As a result, some of their comments were unconvincing. For example, Mr Bouic's assertion that he had not seen Mr Jevons' patent application, even though it had been given to 3M, did not sit well with his agreement that one of the first things he would have done on hearing of the Speedarrive tape was to look at their patent application, whilst Mr Jevons' assertions about the substantial identity between the tape he says he showed 3M and the tape shown in the patent application in suit did not sit well with the actual tape sample we had. I have therefore treated their opinions with some caution, looking to see whether their recollections and interpretation of events were consistent with contemporaneous documents.

20 I will now look at the facts in dispute, turning first to the question of what happened at the demonstration. Mr Jevons made no contemporaneous note of the demonstration but says he remembers it well because for him it was a big event, with the potential for a valuable licensing agreement. He recalls that he applied his sample foam tape to all the apertures of a four door motor car that was available in the body shop where he met

with Mr Thompstone. He also recalls demonstrating how easy the tape was to apply and how it covered, using only a single type and size of tape, all the apertures including the A-post gap that the defendant's tapes could not cope with. He pointed out how the tape avoided the problem inherent in the defendant's tapes of exposure of the adhesive, and how it facilitated the "wet-on-wet" technique of spraying the final paint coat before the undercoat had dried because the tape could be adjusted so easily by pushing it further into the gap.

- 21 He also asserts that the tape he demonstrated was not as illustrated in his own patent specification because the second edge was not squared off. In his written evidence he says the tape he actually demonstrated had two rounded edges just like the tape in the application in suit. He also says he formed the tape using the "crush welding" technique disclosed in 3M's cold welding patent, and that he did this because he felt 3M's interest would be increased if he showed them that his tape could be manufactured using their existing technology.
- 22 3M do have a contemporaneous written record of the meeting because one of their attendees, Mr Asirvatham, wrote a minute of the meeting, which was passed to Mr Bouic on 17 November 1997. This minute states that the tape demonstrated by Mr Jevons was made of foam and had a square edge with an adhesive strip and the opposite edge was bullet-shaped. It also confirms that the demonstrated tape had been made using the cold welding technique, that the demonstrations had been carried out on a range of vehicle apertures and that Mr Jevons had shown them how the tape could be adjusted by pushing it back into the gap.
- 23 On the face of it, we have a clear conflict in the evidence as to whether the second edge of the tape that was demonstrated was rounded or square. However, under cross-examination, supported by a sample of the type of tape that had been demonstrated, it became clear to me that the conflict was one of terminology rather than substance, not helped by Mr Jevons' reluctance to say anything that might suggest that there were any material differences between his tape and that of the patent application in suit. Mr Jevons explained that he made his demonstration tape by using the 3M cold welding technique to form the first edge, but that he slowed the cutter down so that it dragged through the foam to form the second edge. The end result, as can clearly be seen from the sample, is a second edge that is almost square but has slightly rounded corners. The shape of this edge is much closer to that shown in Mr Jevons' patent than that shown in the application in suit, and I have not the slightest doubt that Mr Jevons was trying to show 3M that they could produce a shape substantially the same as that shown in his patent (or patent application as it was then) using their cold welding technology. I do not believe, on the evidence available, that he suggested to them the tape could have both edges equally rounded.
- 24 I now turn to the question of what influence this demonstration had on the development of what now appears in the application in suit. The defendant argues that it had very little influence. The development of the tape described in the application, it says, stemmed primarily from the Speedarrive tape and the work Mr Bouic was doing on that. It points to the note in Mr Bouic's Technical Diary immediately after he had been told about Mr Jevons' demonstration that "This works in exactly the same way as the Robin Hills product" as clear evidence of this.

25 I do not find this argument convincing. Compared with the very simple shape of Mr Jevons' tape, the Speedarrive tape has a relatively complex shape in that it has two distinct parts in cross section. Looking through Mr Bouic's Technical Diary, it is clear he was trying to develop this concept of what I might call a two part tape right up to the time he was told about Mr Jevons' tape, and that he then immediately switched track to the simpler Jevons-like shape. In saying in his Diary that the Jevons' tape worked exactly like the Hills (ie Speedarrive) tape, I am sure what he had in mind is that it fastened to the door in the same way and was trapped in the gap in the same way, not that the two tapes were more or less the same.

26 My conclusion that the tape in the application in suit was not simply the end result of development of the Speedarrive tape is reinforced by two telling documents in the evidence. The first is a minute from Mr Bouic to Cecilia Hill on 2 December 1997 enclosing samples he had produced which he acknowledges were trying to replicate Mr Jevons' tape. He observes that from the tests he had done:

“I cannot see how having this edge flat as opposed to cold welded makes any difference to the way the product works”

which clearly implies this is a conclusion he had come to, not one that was given to him by Mr Jevons. The second document is the Record of Invention that I have already quoted above, which quite clearly recognises that the invention stemmed from Mr Jevons' demonstration. That is not all, however, because under cross examination Mr Bouic conceded that had he not had the conversation with Mr Thompstone on 12 November 1997, he would have probably spent another two months trying to work out how to make a Speedarrive-like product. Putting all this evidence together, there is not the slightest doubt in my mind that Mr Jevons' demonstration resulted in a sudden change in the direction of Mr Bouic's work, and that this change led directly to the invention in suit.

27 So much for the shape of the tape. As for the way it can be used, I am satisfied that the idea of being able to adjust the tape after it had been stuck to the door by pushing it back into the gap also came from Mr Jevons. The defendant argued this was a feature of the Speedarrive tape on the basis of claim 21 of the Speedarrive patent application, which talks about

“longitudinally bending the attachment portion adjacent the sealing portion and pushing the sealing portion into the gap so that the sealing portion is positioned within and seals across the gap”.

However when one reads this claim in the context of the specification as a whole it is quite clear it is referring to the way the tape can be used to seal between two fixed vehicle parts (as shown in fig. 6B of the specification), not to adjusting the tape in the way described by Mr Jevons and disclosed in the application in suit. The defendant also tried to argue that the “pushing back” idea was recorded by Mr Bouic in his Notebook on 22 August 1997, well before Mr Jevons' demonstration, but again the context is quite different, since the passage in question is discussing how the tape could be used if it were stuck to the outside of the door. Finally I should say that under re-

examination Mr Bouic did say he had adjusted the Speedarrive tape after installation by pushing it back in to the gap before Mr Jevons had come along, but I have to say I do not feel the weight of evidence supports this.

28 For completeness, I should add that whilst I am satisfied Mr Jevons did tell 3M his tape could be made using their cold welding technology, equally it is clear from his Notebook that Mr Bouic was also trying to use that technology when developing the Speedarrive tape. There is, though, no evidence that Mr Jevons suggested manufacture as an array of parallel tapes using the 3M cold welding technology. It is possible that is because he took that aspect for granted when discussing cold welding technology, but in the absence of any specific evidence on this point I cannot take that for granted.

29 Finally I turn to the question of the confidentiality of Mr Jevons' demonstration. I do not think I need say much about this because Mr Jevons does not deny that 3M refused to sign a confidentiality agreement. Rather, the best he can argue is that because both sides went away from the meeting envisaging that they might eventually be agreeing a licence, there was an implicit understanding by the end of the meeting that matters should be treated on a commercial-in-confidence basis. Even if there was such an implicit understanding, I cannot see how the evidence can possibly support the view that it went beyond confidentiality in respect of the terms of the licence. There is not a shred of evidence that 3M ever suggested or implied that they would treat what Mr Jevons had demonstrated to them as confidential.

30 In short, then, I find that:

C Mr Jevons did not disclose to 3M the idea of having both edges of the tape rounded - it was Mr Bouic who came up with this idea after he had learned of Mr Jevons' tape.

C Mr Jevons did disclose the use of the 3M cold welding technique to manufacture the tape, though Mr Bouic was already trying to use that technology anyway. I have no evidence that Mr Jevons suggested using this technique to make the tapes in a parallel array.

C Mr Jevons did disclose the idea of adjusting the tape after it had been fixed by pushing it back into the gap, and Mr Bouic had not thought of this before he was told about it following Mr Jevons' demonstration.

C Mr Jevons' demonstration triggered an abrupt change in the direction in which Mr Bouic was going, and that change led directly to the application in suit.

The legal principles to be applied

31 I must now turn to the legal implications of what I have found to be the facts, and crucial to this is the relationship between patentability and entitlement. Two issues involved in this relationship arise in the present case. First, disputes about entitlement under section 12 and the fairly similar provisions of section 8 take place before a patent has been granted, and very often before it has been examined. Indeed, they can take place even before any patent application has been filed. Thus the dispute is being

considered without knowing what, if anything, will eventually be identified as the patentable invention or inventions. In a nutshell, the difficulty is this: how can one determine whether someone is entitled to a patent for an invention X when X may not be a patentable invention? The second issue arises where more than one person has played some part in the genesis of the invention. How does one determine whose parts qualify them to be regarded as an inventor (and thus in principle entitled to a share in any patent) and whose do not? In particular, can a person whose contribution, on its own, may not be patentable nevertheless be entitled to a share?

- 32 These issues have cropped up in a number of previous entitlement disputes. In the present case, both sides accept that it would be quite wrong to conduct an examination of the patent application in entitlement proceedings in order to establish what, if anything, is patentable. The same line has been taken in previous cases, and in my view it must be right, for a number of reasons. For example, if the patent application has not even been searched and/or no claims have yet been filed, vital material needed to assess patentability will not be available. Further, as Mr Campbell rightly pointed out, whether something is patentable may well depend on the law of the country in which patent protection is being sought: a disclosure which may destroy patentability in European countries, for instance, may not do so in countries which have more-restrictive novelty requirements or in the USA under their well known “first to invent” doctrine.
- 33 How, then, should I approach the question of entitlement whilst avoiding an enquiry into patentability? Mr Campbell and Mr Thorley drew my attention to a number of relevant precedents, concentrating on three: *Norris’s Patent [1988] RPC 159*, *Viziball’s Application [1988] RPC 213* and *Henry Brothers (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office [1997] RPC 693* and *[1999] RPC 442*. I shall refer to these as *Norris*, *Viziball* and *Henry Brothers* respectively. *Norris* was a reference under both sections 8 and 12 whilst *Viziball* and *Henry Brothers* were (at least initially) references only under section 8, but since the relevant provisions of these two sections are very similar, I do not need to distinguish between them for present purposes.
- 34 *Norris* was concerned with a device for determining the refractive index of a fluid sample, the device having both optical and control aspects. Two people had been involved in its development, but a patent application had been filed in the name of just one of them. The decision of the hearing officer was upheld on appeal to the High Court, and there are a number of points in the decision and Falconer J’s judgement that are relevant to the present case. First, Falconer J supported the hearing officer’s view that he should not be concerned with the precise formulation of the claims. As the hearing officer pointed out, this follows from the fact that references under section 8 and 12 can be launched before patent applications - let alone claims - have been filed. However, I note that both the hearing officer and Falconer J did look at the claims to ascertain what the invention was. Secondly Falconer J also supported the hearing officer’s view that he needed to consider all aspects of the invention, and this was underlined by his conclusion that the claimant:

“ . . . contributed to the design of the electronic system which forms a significant aspect of the invention disclosed in the patent . . . ”

The final point worth noting is that the hearing officer pointed out that claims under section 12 might require the submission of information about foreign patent laws and procedures. Indeed, because he had not been given such information, he declined to make any order under section 12 to give effect to his findings.

- 35 *Viziball* was concerned with a reflective squash ball in whose development two people had again been involved. One complicating factor in this case was the fact that, unbeknown to either person, an important aspect of the invention had already been disclosed in a previously-published US patent. The hearing officer disregarded this completely, saying (p217):

“I regard the invention as that which was conceived by the applicant to be an invention at the time he filed his application whether that be a patentable invention or not i.e. the alleged invention. That the term invention in section 8(1)(a) has this meaning flows from a general reading of the Act. For example section 1(1) defines *patentable* invention and section 72(1)(a) uses the term invention to embrace non-patentable inventions. Again sections 2(1) and (3) use the term “invention” in a general sense. Moreover section 8(3) . . . [*which allows a new application to be filed for the whole or part of the matter comprised in an earlier application*] . . . refers . . . to matter comprised in or excluded from the earlier application and makes no reference to whether the matter be patentable or not. Further the opening part of section 8(2) . . . [*which refers to the patent application in dispute being refused or withdrawn before the comptroller has disposed of the reference under section 8*] . . . implies by the words “unless the application is refused or withdrawn” that the comptroller makes his decision irrespective of the likely refusal of the application.”

- 36 This approach - taking as the invention for the purposes of entitlement proceedings that which was conceived by the applicant to be an invention at the time he filed his application - has been adopted in numerous subsequent cases, normally with the agreement of both sides and even when the patent application has actually been examined and granted by the time the decision on entitlement is being made. I observe in passing that the latter has sometimes troubled me, because one can envisage a situation in which the matter which justifies one person being regarded as a co-inventor has been wholly struck out of the patent application before grant and yet, adopting this approach, one would apparently still be required to find them entitled. However, that problem has never in practice arisen and certainly does not arise in the present case.
- 37 What the hearing officer did in *Viziball* (p218) was to identify the essential elements of the invention and then consider what contribution, if any, the claimant made to those elements. He identified the essential elements by looking at the claims, and then went on to decide who was entitled to each claim, arriving at different answers for different claims. On appeal, Whiford J followed the same approach.
- 38 I will now turn to *Henry Brothers*. This was concerned with a blast-resistant structure for a building and went to the Court of Appeal. It involved other issues as well as entitlement, but it is only the entitlement aspects that are relevant to the present case. The approach to deciding entitlement adopted by Robert Walker LJ in the Court of Appeal ([1999] RPC 446 (in turn reflecting the approach adopted by Jacob J in the

High Court) was to ask two questions - what is the inventive concept, and then, who devised that inventive concept? He observed that the first question depended on the true construction of the patent specification, for which he adopted the well-established approaches of *Catnic Components v Hill & Smith [1982] RPC 183, 242-3* and *Improver Corporation v Remington Consumer Products [1990] FSR 181*. This, I observe, inevitably involved looking at the claims. I also observe that Jacob J rejected a submission that anyone who contributes to the claim in a substantial way, who took part in the actual devising of the invention to a significant extent, must be regarded as an inventor. However, this was in the context of a finding that the inventive concept was the putting together of a combination of elements, not in the provision of any individual element, a finding that was rejected on the facts of the case on appeal.

39 Having briefly outlined the three main precedents, I must say a few words about some of the observations Mr Campbell and Mr Thorley made on them. Mr Campbell supported the approach taken by the hearing officer in *Viziball* in ignoring the prior art when identifying the invention for the purposes of the entitlement proceedings. To do otherwise, said Mr Campbell, would be inconsistent with *Henry Brothers* approach, where the inventive concept was identified by construing the patent specification. However, he urged me to reject the *Viziball* approach of regarding the invention as that which was conceived by the applicant to be an invention at the time he filed his application, on the grounds that this required a subjective assessment of what was in the mind of the applicant rather than the objective assessment of the specification required by *Henry Brothers*.

40 On the latter point, Mr Thorley accepted that a subjective approach was not appropriate and that the test had to be seen as an objective one. However, he also argued it was quite proper to consider what was prior art. The mere fact that one had to do this when assessing patentability did not, he submitted, mean one couldn't also do so in considering inventorship. No one was entitled to a patent for matter that was in the public domain, so even if an invention was triggered by someone drawing the attention of another to prior art, that could not make the first person an inventor. In the present case, Mr Thorley urged, whatever Mr Jevons' contribution was, it was put in the public domain at the demonstration to 3M because that demonstration was not subject to any obligation of confidentiality, quoting the words of Aldous J. in *PLG Research v. Ardon International [1993] FSR 197 at 226*:

“Thus to form part of the state of the art the information given by the prior use must have been made available to at least one member of the public who was free in law and equity to use it”.

Thus Mr Jevons could not claim any entitlement to the application in suit because, legally, his contribution was public and therefore disqualified from patent protection.

41 To reinforce this argument, Mr Thorley took me through three hypothetical scenarios:

(i) publication of Mr Jevons' patent application on 10 November 1997 (ie the day before the demonstration) instead of 13 January 1999 and 3M finding out about it through a patent watching service;

(ii) publication of Mr Jevons' patent application on 10 November 1997 and Mr Jevons directing 3M's attention to the application for the purpose of a potential licence agreement;

(iii) Mr Jevons giving a public lecture on 10 November 1997 at which representatives of 3M were present.

Mr Thorley maintained that in all these scenarios Mr Bouic would be free to draw upon such public disclosures as he saw fit.

- 42 I have carefully considered *Norris*, *Viziball* and *Henry Brothers* in the light of the arguments put forward by Messrs Campbell and Thorley, and have come to the conclusion that, subject to a clarification of what I perceive to be the *Viziball* reasoning which is discussed below, they all point to the same two-step approach. The first step is to identify the inventive concept or concepts. This was done in *Norris*, *Viziball* and *Henry Brothers*, and follows from the fact that under sections 8 and 12 one is considering entitlement to an invention. Further, as *Henry Brothers* teaches, the inventive concept must be identified from the patent specification using the standard rules for construing patent specifications and their claims.
- 43 On this point and as *Norris* recognised, I am not forgetting the fact that entitlement proceedings may be launched before there are any claims. However, it is noteworthy that in all three cases, *Norris*, *Viziball* and *Henry Brothers*, the judges and hearing officers involved did in fact turn to the claims to help them identify the inventive concept. The conclusion I draw from this is that where claims exist, it is quite permissible to use them as an aid to identifying the inventive concept. If there were no claims, of course, one would have to identify the inventive concept from whatever material was available.
- 44 It is also important to remember that one cannot just look at the main claim. As *Viziball* recognised, there may be inventive concepts in other claims, and the entitlement to those may differ from the entitlement to the invention of the main claim. Further, as *Norris* recognised, even the claims cannot be the be all and end all of everything because one has to consider entitlement to all the matter disclosed, although I recognise that if there are claims, one would normally expect to find any other inventive concepts somewhere in those claims. I should also perhaps emphasise again that in identifying the inventive concept, one must not conduct an enquiry into its patentability.
- 45 The second of the two steps is to identify who was responsible for that inventive concept. Again, this was done in *Norris*, *Viziball* and *Henry Brothers*, but it is here that I feel some clarification of *Viziball* might be helpful. What the judges and hearing officers actually did in all three cases was to look at the events that led up to the patent application - the genesis of the application, if you like - and that I am sure is what the hearing officer was getting at in *Viziball* when he said "I regard the invention as that which was conceived by the applicant to be an invention at the time he filed his application". I do not believe he was envisaging an enquiry into what was in the applicant's mind; he was envisaging an objective look at how the patent application had come about.

- 46 This approach of looking at how the patent application came about is, I feel, fully consistent with all three cases, and in particular with *Henry Brothers*. It makes an enquiry into what was and was not 'prior art' in the patent novelty sense irrelevant. It does not mean that everyone who contributed an element in a combination must be regarded as an inventor of the combination (*cf* the comments of Jacob J in *Henry Brothers*), but equally it does not mean that someone whose contribution was to identify or draw attention to some prior art cannot possibly be an inventor - it would depend on the particular facts of the case, including assessments of the circumstances in which the contribution was made and what part the contribution played in the genesis of the application.
- 47 For completeness, I will make a couple of other observations. First, I recognise that the widely-accepted *Viziball* approach of considering the patent application as it stood at the time of filing may well be inevitable if, as in the present case, the application has not been through the examination process. However, I note that in *Henry Brothers* it was the specification as granted that was considered. To what extent this differed from the original application as filed I do not know, but it does suggest that this aspect of the *Viziball* approach may not always be appropriate. Secondly, as hinted in *Norris*, when dealing with a reference under section 12 one cannot rule out the possible need to consider foreign patent laws, and this is perhaps something parties need to bear in mind. Without that information, there may sometimes be difficulty in drafting an appropriate order.

The application of these legal principles to the facts

- 48 Having reviewed the case law, I must now apply the principles I have set out to the facts of the present case. First I must identify the inventive concept or concepts from the patent specification. The specification makes clear on page 1 that the invention is concerned with providing a foam strip masking material which can be used in a wider range of locations on a vehicle than the acknowledged prior art. It does so by providing a strip with the shape, construction and dimensions specified in claim 1 - what one might crudely describe as a foam strip which in cross-section is elongate though fairly thick and with rounded ends, and with a strip of pressure-sensitive adhesive near one edge - and I take this to be the main inventive concept. The claim also requires cold welded seams, though the specification later explains these are to maintain the shape of the rounded ends.
- 49 Claim 3 is directed to a roll of masking material comprising a parallel array of conjoined and manually separable elongate foam strips that meet the requirements of claim 1. Although the specification does not imply that this is highly inventive, rather presenting it as no more than the application of a prior patented process to the strip of claim 1, for present purposes I am prepared to accept there may possibly be some inventive concept here too.
- 50 The specification also puts a lot of emphasis on the way the strip is used, and indeed there are more method claims (claims 4 to 12) than product claims (claims 1 to 3). Moreover, unlike claim 1 the broadest method claim, claim 4, is not even limited to any particular range of dimensions for the strip, though it does require the elongate

cross-section with rounded ends and cold welded seams. The inventive concept of this claim seems to me to be the idea of applying a strip with these properties to an inner surface whilst a movable panel of the vehicle is open, in such a way that when the panel is closed one rounded end projects out of the gap between the panel and an adjacent vehicle part.

- 51 Claim 5 is concerned with a further inventive concept, the idea of being able to push the projecting portion of the strip back into the gap if required. As explained on page 5, sometimes the user will want the strip to project and sometimes they will not, so the option of being able to push the strip back adds versatility. I need say little about the remaining claims because they are concerned with trivial or conventional features for which there is no suggestion of any independent inventive merit. The same applies to the remaining features in the description.
- 52 In short, then, I have identified four inventive concepts: a strip having the properties specified in claim 1, providing such strips in a roll of several joined strips as specified in claim 3, the method of applying a foam strip to mask a gap as specified in claim 4, and the idea of being able to push the projecting portion back as specified in claim 5. I now need to identify who was responsible for those concepts.
- 53 I must now look at who was responsible for these inventive concepts, ie how they came about. Taking the inventive concept of claim 1, on the basis of my findings on the facts Mr Jevons cannot be regarded as wholly responsible for it because I have found he did not come up with the idea of two rounded ends. On the other hand, Mr Bouic cannot be regarded as wholly responsible for it either, because without Mr Jevons' contribution he would have gone on pursuing designs based on the Speedarrive tape. It is Mr Jevons who was responsible for the basic shape and proportions of the tape and the position of the adhesive strip. Of course, given time Mr Bouic might eventually have come up with all these features on his own, but my task is to assess what happened, not what might have happened. Thus I am satisfied that the contributions of both Mr Jevons and Mr Bouic were important in the genesis of the inventive concept of claim 1. Further, given the circumstances in which Mr Jevons' contribution was made, I am satisfied that he should properly be regarded as a joint inventor.
- 54 Exactly the same applies to the concept of claim 4 - the basic idea came from Mr Jevons but the two rounded ends from Mr Bouic. The concept of claim 3 must be attributed to Mr Bouic because Mr Bouic did not rely on any contribution from Mr Jevons for this - he was already working along these lines - but that of claim 5 came from Mr Jevons.

Conclusion

- 55 It follows from my findings that Mr Jevons and 3M are jointly entitled to international patent application PCT/US99/06438. It was agreed at the hearing that if I came to that conclusion, I would provide the parties with an opportunity to make submissions as to what they think the appropriate order might be. Accordingly I allow the parties six weeks in which to make such submissions. Ideally I hope they will be able to agree an order between them, because that way they are more likely to end up with something that best suits the needs of both of them.

56 There is one other matter. So far I have dealt solely with the section 12 reference, but Mr Jevons has also made a reference under section 13. It became clear at the hearing that the section 13 reference had not really been thought through. I have always assumed that this section cannot apply to an international application, and even if it could, I am at a loss to know what order I could make. When I put these points at the hearing, Mr Campbell asked for time to research the issue. I then agreed that since the issue would really only be significant if I came to a conclusion that there was joint entitlement, I would allow the parties to make submissions on how, if at all, my order should reflect the section 13 reference as part of their submissions on the form of order.

Costs

57 Both parties have sought costs and agreed that they should follow the event. The claimant has been successful under section 12, albeit not to the extent of getting sole entitlement. No conclusion has yet been reached under section 13, but since neither side has devoted any significant time to that aspect, I shall ignore it for the purposes of costs.

58 It is long established practice that in proceedings before the comptroller only a contribution towards the successful party's costs should normally be awarded and that the amount should be guided by the comptroller's published scale unless there are special circumstances. Since these proceedings were launched before 22 May 2000 it is the old scale that applies. Mr Campbell argued that the evidence on the Speedarrive tape was a complete red herring and so that justified a deviation from the scale, but I disagree because I feel that evidence was a significant part of the background to this case. Accordingly I have concluded that 3M should pay Mr Jevons £1200 as a contribution towards his costs. However, I will defer making a formal costs order until I make my final order, so that I can take account of any additional costs that may arise.

Appeal

59 As this decision is not a matter of procedure, any appeal to the Patents Court must be made within six weeks.

Dated this 25th day of September 2001

P HAYWARD

Divisional Director acting for the comptroller

THE PATENT OFFICE