

## PATENTS ACT 1977

IN THE MATTER OF a reference under section 37 by Cinpres Gas Injection Limited in respect of patent no EP(UK) 0424435 in the name of Melea Limited

### DECISION

- 1 In this reference, made on 2 July 2003, the referrers, Cinpres Gas Injection Limited, allege that the named inventor in the patent in suit (James Watson Hendry) fraudulently gave false evidence in an earlier, and ultimately unsuccessful, reference by themselves and Tamworth Moulding Limited to the comptroller under section 12(1) of the 1977 Act. This related to the entitlement to the international patent application PCT/US89/02815 from which the patent in suit derives. In consequence, the referrers wish to re-open the question of their entitlement to the patent. The patent was granted to the present defendants, Melea Limited, as assignee from Michael Ladney, the defendant in the earlier action and the applicant for the international application.
- 2 The referrers in their statement say that Mr Ladney brought financial pressure and physical and verbal intimidation to bear on Mr Hendry to give false evidence. The defendants in the counter-statement deny this and say that the matter is *res judicata*. No evidence has yet been filed by either party, but in a letter to the Office dated 15 October 2003 the defendants have asked the comptroller to decline to deal with the reference under section 37(8) of the Act, which states:

“If it appears to the comptroller on a reference under this section that the question referred to him would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so.”
- In their letter dated 22 October 2003 the referrers support the defendants' request.
- 3 In the earlier reference, made on 23 January 1991, the decision given by the Superintending Examiner acting for the comptroller was overturned by Laddie J on appeal but restored by the Court of Appeal in a judgment dated 23 July 1997. The defendants believe that the question now referred to the comptroller would be more properly determined by the Patents Court because of (i) the nature and the allegations made by the referrers and the possibility of serious criminal and civil consequences, (ii) difficult legal issues as to the extent to which the court is bound by its earlier decision, and (iii) the existence in the Patents Court of proceedings brought by the referrers seeking revocation of the patent.
- 4 Whilst the decision whether to decline jurisdiction is a matter for the comptroller, it would be perverse to seek to maintain it against the wishes of both parties without very good reason. In the present case to do so would be manifestly undesirable, since it would require the comptroller to pronounce on the propriety of an action which has been litigated before both the Patents Court and the Court of Appeal.

- 5 Accordingly under section 37(8) I decline to deal with the present reference.
- 6 In the parties' statements only the referrers have asked for costs, and in the matter of the requests under section 37(8) neither side has made any reference to the costs of these proceedings. I make no order for costs, and will leave the parties to raise this matter before the court in any ensuing proceedings should they wish to do so.
- 7 Although under Practice Direction 52 to the Civil Procedure Rules the period for appeal is 28 days from the date of this decision, the parties are reminded that in accordance with rule 63.11 of the Rules any person seeking the court's determination of the question referred to the comptroller must issue a claim form within 14 days of that date.

Dated this 5<sup>th</sup> day of November 2003

**R C KENNELL**  
Deputy Director acting for the Comptroller

**THE PATENT OFFICE**