



BL O/299/05

9 November 2005

PATENTS ACT 1977

BETWEEN

Lawrence Sutherst
Mackie

Claimant

and

George Charles Faulder
Richard Martin Faulder

Defendants

PROCEEDINGS

Reference under section 13 of the Patents Act 1977 in
respect of patent number GB 2348609 B

HEARING OFFICER

Phil Thorpe

DECISION

Introduction

- 1 This dispute is concerned with who should be named as inventor on patent GB 2348609. The patent, which is derived from an international filing under the PCT, was granted on 14 May 2003 and named Lawrence Sutherst Mackie, George Charles Faulder and Richard Martin Faulder as inventors. The sole named proprietor is Lawrence Sutherst Mackie.
- 2 The invention set out in GB 2348609 relates to an incontinence appliance comprising a substantially flat reservoir which is able to collect and vent urine. The invention also provides the wearer of the apparatus with a warning when the reservoir is nearly full.

The pleadings, submissions and evidence

- 3 On 23 June 2003 one of the named inventors, Lawrence Sutherst Mackie (Mr Mackie), filed the present reference under section 13 of the Act requesting the comptroller name him as sole inventor.
- 4 The initial statement of case was filed on 24 July 2003 however this contained information of a personal nature and also a request that certain parts of the statement be treated as confidential. Following discussions between Mr Mackie and the Patent Office, it was agreed that the Office would treat that statement as withdrawn. A further amended statement was filed by Mr Mackie on 24 September 2003. This too contained deficiencies and consequently Mr Mackie was asked to file a further amended statement which he did on 17 October 2003. The statement and the supporting documents referred to in it were copied to Mr Charles Faulder and Mr Richard Faulder (the Faulders) in an official letter of 7 November 2003. In a telephone conversation shortly afterwards the Office provided Mr Charles Faulder with information on inventorship. He was also advised to seek the advice of a patent agent.
- 5 The Faulders responded with a counterstatement filed on 8 December 2003 contesting the claim that Mr Mackie was the sole inventor. A copy of the counterstatement and the supporting documents was sent to Mr Mackie on 23 December 2003. In the covering letter Mr Mackie was invited to file evidence in support of his case. He was advised that the evidence should be in the form of statutory declaration(s), affidavit(s) or witness statement(s) in accordance with Rules 103 & 104 and the Patents (Amendments)(No.2) Rules 1999. He was also advised that if any of the documents supplied with the respective statements are to form part of the evidence they will need to be re-filed as sworn evidence. A copy of the letter was also sent to the Faulders.
- 6 On 21 January 2004 Mr Glaister, the nephew of the claimant, wrote to the Office to request a stay in proceedings because of the poor health of Mr Mackie. The Faulders acceded to this request.
- 7 In a letter dated 13 February 2004 Mr Glaister informed the Office that Mr Mackie had requested that the statement of case filed on 17 October 2003 together with the supporting documents should form the basis of his evidence. Mr Mackie recognized that the “inability to prove all the documents in the prescribed manner may render some inadmissible and that this will be a matter for the Comptroller’s discretion”. A copy of this letter was sent to the Faulders. In the covering letter the Faulders were advised by the Office that the statement of Mr Mackie cannot itself constitute evidence and so the Office will proceed on the basis that Mr Mackie does not wish to file evidence. The letter goes on to say that the question will not be whether the facts in the statement are admissible or not but of the weight which the hearing officer can attach to these in the absence of evidence to support them. A copy of this letter was sent to Mr Mackie.
- 8 On 10 March 2004 the Faulders filed their evidence. This comprised the last page of their counterstatement amended to include a statement of truth and a number of accompanying

documents signed by the defendants. These documents corresponded largely to the documents already filed in support of the counterstatement. There were four documents not mentioned in the counterstatement. Two of these had however already been filed by the claimant to accompany his statement whilst the other two were new to the proceedings.

- 9 In a letter dated 12 April 2004 Mr Mackie sought to address, with the aid of a number of additional documents, some of the points raised in the defendants' evidence. Mr Mackie referred to this letter and the accompanying documents as "further evidence in support of the application and, more specifically, my response to the issues raised by G C Faulder and R M Faulder in their letter dated 9th March" (this was the defendants' evidence filed 10 March 2004). The letter was not sworn nor were the accompanying documents verified.
- 10 Both sides have agreed that the matter should be decided on the basis of papers.
- 11 Turning now to the history of the matter that is the subject of this dispute. According to Mr Mackie he started thinking about the issue of incontinence around 1980 after a member of his family was diagnosed as suffering from Multiple Sclerosis. According to his statement he began a programme to develop a "more sophisticated" approach to dealing with the problem of incontinence. This involved an automated pump activated by a moisture sensor. He further developed his ideas and reached a stage where he "began to see the beginnings of an entirely practical and discreet device that met the design specification"
- 12 He then set up a company called Incontinence Comfort Control Systems (ICCS). All of this is accepted by the defendants with the exception of the claim by Mr Mackie that he had at that time conceived the idea of using an automated pump in the device.
- 13 In 1997 Mr Mackie was admitted to hospital. It is there that he first met Mr Charles Faulder who was a fellow patient. There is common ground that whilst the two men were patients at the hospital they discussed ICCS and aspects of the device and its future development. Neither side has explained precisely what the "device" was at that time. I will come back to that point later. There is a question over Mr Charles Faulder personal qualifications and how these were first perceived by Mr Mackie. Neither side has however put forward any argument to suggest that this point is relevant to the issue of inventorship and therefore I do not believe it is not necessary to say anything more about it.
- 14 Following their release from hospital, Mr Charles Faulder wrote to Mr Mackie in a letter dated 29 January 1997 offering to help Mr Mackie with a patent application as he apparently already had knowledge of the patenting process.
- 15 At some point, and it is not clear when precisely this was, Mr Mackie took up the offer of help from Mr Faulder. According to Mr Charles Faulder when they came together in February 1997 there was "no actual invention".
- 16 There then appears to have been some form of cooperation between Mr Mackie, Mr Charles Faulder and his son Mr Richard Faulder. Mr Mackie claims that the Faulders took no part in "design and development". This is contested by the Faulders who claim that

“inventive steps and designs produced from each individual”.

- 17 Early in 1997 Mr Mackie made initial contact with Michael Ajello a Chartered Patent Agent. Although Mr Mackie does not specify precisely when this contact took place, there is a reference to a meeting on the 27th February. In a letter to Mr Mackie dated 4 March 1997, Mr Ajello reported on the results of a search that he had performed to determine whether the device which Mr Mackie had described to Mr Ajello was known.
- 18 On June 13 1997, a patent application GB 9712234.5 was filed naming Charles and Richard Faulder and Lawrence Sutherst Mackie as co-applicants and co-inventors. The title of this application was “Incontinence Comfort Control Systems”. This application was terminated before publication on 17 August 1998.
- 19 A further application GB 9812491.0 was filed on 11 June 1998 again naming Charles and Richard Faulder and Lawrence Sutherst Mackie as co-applicants and co-inventors. The title of this application was “Urinary incontinence apparatus”. This application was published as GB 2327355 on 27 January 1999 and was terminated before grant on 20 October 1999.
- 20 A yet further application GB9826561.4 also entitled “incontinence comfort control systems” and also naming Charles and Richard Faulder and Lawrence Sutherst Mackie as co-applicants and co-inventors was filed on 4 December 1998. This application too was terminated before publication however it did serve as the basis for a claim to priority on a subsequent international patent application, PCT/GB1999/000258, filed on 26 January 2001. This application, titled “An incontinence appliance”, was published as WO 00/33773 on 15 June 2000 and subsequently entered the national phase in the United Kingdom as application GB0019129.6. This particular application gives rise to the patent, GB2348609 at issue in this case.
- 21 There is some disagreement between the parties about the circumstances leading up to the filing of the PCT application. The Faulders claim that the PCT application papers were filled in by Mr Ajello at Mr Mackie’s home. Mr Ajello apparently asked who the inventors were and it was agreed, although it is not entirely clear by whom it was agreed, that it was Mr Charles Faulder, Mr Richard Faulder and Mr Mackie. They claim also that all three of these people were named as applicants after Mr Charles Faulder had challenged an initial attempt by Mr Mackie to name just ICCS as the applicant.
- 22 Mr Mackie disputes this arguing instead that Mr Charles Faulder and Mr Richard Faulder were named as inventors only because Mr Ajello had “misread the papers”. Mr Mackie goes on to say that whilst Mr Ajello did not admit his error in writing he did nevertheless seek a degree of damage recovery by writing to the Faulders on 16th April 1999.
- 23 Towards the end of 1998 relations between Mr Mackie and the Faulders appear to have deteriorated from what previously seems to have been an amicable relationship. There followed an exchange of correspondence between the two sides which led to the Faulders, in a letter dated 3 August 2000, relinquishing “all rights and ownership” of the PCT patent application. An application to amend the register to name just Mr Mackie as the proprietor

of GB 2348609 was filed on 25 April 2002. Mr Mackie was informed that the register had been so change in an official letter dated 31 May 2002.

The Law

24 Neither side has put forward any arguments or referred me to any previous cases to show how I should go about determining the question of inventorship. I will nevertheless briefly set out the established legal basis by which such disputes are dealt with. I will start with the law. The part of the Act dealing with the rights of inventors is section 13. The relevant parts of this section so far as this case is concerned are as follows:

(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.

(2).....

(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 subsection (1) above.

25 Also of relevance is section 7(3) which reads:

“In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.”

26 Mr Mackie has brought this action under section 13(3) and has requested that I name him as sole inventor. In inventorship actions the burden of proof lies with the claimant which in this case is Mr Mackie. This is a long established principle based on case law¹. For Mr Mackie to succeed with his action he needs to show that neither Charles nor Richard Faulder contributed anything to any of the inventive concepts.

27 The first thing I need to do is to identify the inventive concept or concepts in the patent. This point is one that is often not addressed adequately by the parties in disputes about inventorship and this alas is also the situation in the present case. In the absence of any guidance on this from the parties, it is necessary for me to look to the patent to identify the inventive concepts. The Court of Appeal² has recently shed further light on how I should go about identifying the inventive concept or concepts in a granted patent. What I need to do is

¹ See for example *Viziball Ltd's Application* [1988] RPC 213 by the hearing officer and endorsed on appeal by Whitford J in the Patents Court.

² *Marken Corp v Zipher* Court of Appeal [2005] RPC 31.

to look for the “heart” of the invention and to do this I need to look at the information in the specification (the description, drawings and claims as a whole) rather than simply seeking to define the inventive concept from a narrow reading of the claims. I shall now try to do that.

The specification

28 The introductory paragraphs in the patent explain how conventional methods of dealing with urinary incontinence using absorbent pads or leg-mounted collection bags can restrict the movement or undermine the confidence of the user. The invention seeks to overcome these problems by providing an alternative type of collection device. This is in the form of a substantially flat reservoir which is intended to be incorporated within or attached to a pair of briefs. The reservoir is comprised either of a length of lay-flat ducting arranged in a serpentine like path or of a larger void divided into compartments. The arrangement of the lay-flat duct or the various compartments serves to distribute and limit the free movement the collected urine. A battery powered pump is provided to draw urine from the patient into the reservoir. A warning device is also provided to alert the user when the reservoir is nearly full.

29 There are 11 claims in total only one of which, claim 1, is independent of the others. Claim 1 reads:

An incontinence appliance comprising a reservoir for the temporary containment of urine, means for removably connecting the reservoir to the user's urethra and means enabling voiding of the reservoir, the reservoir being substantially flat and including means to prevent excessive free movement of urine within the reservoir characterized by means to provide an audible, visual or tactile warning to the user when the reservoir is approaching full condition.

30 The other 12 claims introduce by way of limiting the scope of claim 1 further features. These include the particular design of the reservoir, the inclusion and control of a pump to direct urine from the urethra into the reservoir, the design of the warning device and details on how the device is attached to the user's urethra.

31 So what is the heart of the invention? In this case I think that reading the specification as a whole would suggest that the heart of the invention is:

A reservoir that is flat and which is also able to prevent excessive free movement of the urine contained within it in combination with a warning device to indicate when the reservoir is approaching full.

32 I also need to consider whether there are any other inventive concepts. The specification identifies a number of features which can be added on to the inventive concept above and it is possible that these additions may be inventive concepts in their own right. I think it is necessary for me only to highlight one of these other possible inventive concepts since it is the subject of some argument between the parties which I discuss below. This is the inclusion of a moisture activated pump to direct urine to the reservoir.

- 33 Having determined what the main inventive concept is I must now decide who actually invented it.
- 34 So who did invent or devise it? Again neither party in their submissions and evidence has really assisted me much in answering this question. There are as I have already noted a number of general statements from both sides along the lines of Mr Mackie saying that the Faulders provided no inventive contribution and the Faulders saying that they did. But these general statements are not adequately developed with the support of credible evidence. The Faulders have not for example identified any particular aspect of the invention that they believe to have been devised by them. Indeed neither the Faulders nor Mr Mackie for that matter actually identifies what the invention is.
- 35 Instead much of the argument in their statements and evidence concerns issues that are simply not relevant to the issue of inventorship. For example there is much argument about who paid for various things such as the patent fees and also what was the status of the Faulders within ICCS. None of this goes to the question of inventorship. It might be of relevance to any issue of entitlement; however that is not something that I am being asked to decide upon. Indeed the issue of entitlement between the Faulders and Mr Mackie appears to have been resolved when the Faulders relinquished any proprietary rights in the patent.
- 36 So what in the various statements is relevant? I will start with what the parties have to say about the status of the invention at the time Mr Mackie first met Mr Charles Faulder, which both sides agree was towards the end of January 1997. Clearly if the invention was known before Mr Mackie met Mr Charles Faulder then the Faulders can have no right to be named as co-inventors of the invention.
- 37 In his statement Mr Mackie says that he had by this time begun a “programme to develop an approach to assist with the practicalities of incontinence based on the use of an automated pump activated by a moisture sensor”. He talks about “many months of design and much trial and error on prototypes” from which he began to see the beginnings of “an entirely practical and discreet device that met the design specification”. He does not however offer any specific detail on the actual features present in these “prototypes” or in this “device” other than perhaps the moisture activated pump. There are no drawings, plans or photographs or any other evidence to show how these “prototypes” or “device” compared with the invention set out in the patent at issue.
- 38 For their part the Faulders contend only that Mr Mackie had not had the idea of including a pump in the device prior to his first meeting Mr Charles Faulder. They base this assertion on the contents of correspondence between Mr Mackie and his patent agent Mr Ajello which I shall come to shortly. Other than this the defendants have not submitted any other evidence of their own to show what Mr Mackie had or had not invented by the time he first met Mr Charles Faulder.
- 39 So what can I deduce about the development of the invention at the time Mr Mackie first met Mr Charles Faulder? The answer must be very little. Mr Mackie had clearly given the problem some thought but he has not provided any real evidence to show how far

progressed the invention was at that time.

- 40 We then have the first meeting between Mr Charles Faulder and Mr Mackie whilst they were both hospitalised. It seems clear that Mr Mackie discussed his company ICCS and also the subject of patenting inventions. Whether Mr Mackie told Mr Charles Faulder anything about the device he was developing is not clear. What is clear though is that Mr Charles Faulder wrote to Mr Mackie shortly after they had met. In this letter Mr Charles Faulder explains, with I may say both detail and clarity, the process for obtaining a patent under the Patent Cooperation Treaty. He also offers to help Mr Mackie. Mr Mackie has highlighted parts of this letter where Mr Charles Faulder refers to “your invention” and “your idea”. This according to Mr Mackie is recognition by Mr Charles Faulder that the invention was the work of just Mr Mackie. I think it is clear that both Mr Charles Faulder and Mr Mackie were under that assumption at that time. However it is still not clear what the invention was that Mr Charles Faulder was referring to in this letter and how did it then compare with what was ultimately patented. The invention that Mr Charles Faulder was referring to could have been quite different from that in GB 2348609.
- 41 It seems common ground that Mr Mackie then contacts Mr Charles Faulder to take up his offer of assistance. The precise date on which the collaboration started is however unclear although it appears to be around February 1997. The Faulders have referred to a letter from Mr Mackie to Mr and Mrs Charles Faulder dated 16 March 1997 which mentions a meeting between Mr Mackie, Mr Charles Faulder and his son Mr Richard Faulder which according to the letter involved a “tri-partite in depth discussion”.
- 42 Some time around then Mr Mackie also made contact with a patent agent, Mr Ajello. It would seem that Mr Ajello met with at least Mr Mackie on 27 February 1997. Mr Ajello then performed a patent search, the results of which he reported back to Mr Mackie in a letter dated 4 March 1997.
- 43 The Faulders believe that this letter is significant for two reasons. The first is because it makes no reference to a pump. This they claim indicates that Mr Mackie had not at that time “conceived the notion of incorporating an automatic pump”. If he had they argue, why had he not mentioned it to Mr Ajello at their meeting on the 27 February 1997. It is important to note that the Faulders do not provide any evidence of what was or was not discussed between Mr Mackie and Mr Ajello at that meeting. They are merely drawing their own conclusion from the contents of Mr Ajello’s letter. Are they right to draw this conclusion?
- 44 Mr Ajello sets out in some detail the nature of the search that he performed. The search was firstly limited to a specific classification mark A61F-005/44 which is the IPC mark for “Devices worn by the patient for reception of urine”. He further limited the search by using in various ways the search terms LEVEL, FULL, ALARM, WARNING and INCONTINENCE with the appropriate truncation. In reporting the results of the search he notes that it is known to give an alarm as a bag fills up. He goes on to advise Mr Mackie that in his opinion an incontinence pouch connected via a tube to a receiving bag is generally known and that if he filed a patent for this device it was likely that the Patent Office would find examples of very similar devices. He concludes by stating that:

“the device at least as a general concept is represented in the existing patent literature and that any patent obtained would be limited to fairly precise detail of, for example, the alarm device or the features of the pouch rendering it perhaps more comfortable or more reliable than existing devices”

- 45 So does any of this help me in deciding who the inventors are? The Faulders suppose that if Mr Mackie had had the idea to use an automated pump then he would have told Mr Ajello and he would have in turn referred to it in the context of the search. This is however all supposition. It is possible that Mr Mackie did not mention the possibility of having a pump to Mr Ajello. Equally he may have mentioned it but Mr Ajello chose not to refer to it in the letter. Neither side has submitted a witness statement from Mr Ajello which might have perhaps shed some more light on this. It is nevertheless also a possibility that as the Faulders argue, the idea of using a pump had not yet be envisaged. However even if the latter was true, then it does not necessary mean that the Faulders were behind this part of the invention. It is still possible that Mr Mackie could be the sole inventor of that particular aspect of the invention.
- 46 The second reason that the Faulders believe this letter to be significant is that it demonstrates that there was actually no invention at that time. I am prepared to accept that what Mr Ajello was looking for appeared to be known however as I have indicated above this does not necessarily mean that the invention as set out in GB 2348609 had not in fact been made at that time. One does not necessarily lead to the other.
- 47 So what does all this tell me about the invention and who invented it? It seems clear that Mr Ajello performed a search for a device including a pouch to collect urine in association with a warning device that is related in some way to the fullness of the pouch. I do not think that what Mr Ajello seems to be looking for equates to the main inventive concept that I identified above. There is for example nothing to suggest that the particular features of the reservoir were searched for. It may be a step on the road to the invention but it does not yet appear to be the invention. Even if was, there is still the question of who devised it. By the time the search was performed by Mr Ajello, Mr Mackie had already met and discussed the invention with Mr Charles Faulder and possibly also Mr Richard Faulder.
- 48 The next significant event appears to have been the filing of a number of patent applications. I have provided details of these above so will not repeat them here. I should say that I was slightly surprised that neither side thought it worthwhile to include in their submissions copies of any of these earlier applications as a way perhaps of showing how the invention evolved. The Faulders in their evidence did include a copy of the Form 1/77 filed in respect of the first application to show that they had been named as co-inventors. As I have already mentioned both the Faulders and Mr Mackie were also named as co-inventors on the other two UK patent applications filed in 1998.
- 49 Of these three UK patent applications, only one GB 9812491.0 was published. The invention disclosed in this application is almost identical to one of the main embodiments in GB 2348609. Indeed the figures in this application have essentially been duplicated in GB

2348609. I would note in passing that the disclosure in this particular application appears to bring into question the novelty of the invention set out in GB 2348609. I will come back to this at the end of this decision.

- 50 In respect of the other two UK applications, although neither was published, a copy of the specification of GB 9826561.4 is, for the purpose of supporting a claim to priority, present on the open part of the case file of the GB 2348609. An examination of this specification shows not surprisingly similarities with GB 2348609.
- 51 I turn now to the PCT application that gave rise to the patent in issue. Mr Mackie claims that Mr Charles Faulder and Mr Richard Faulder were named as inventors on this application only because Mr Ajello had “misread the papers”. Mr Mackie seeks to find support for this in a letter from Mr Ajello to Mr Charles Faulder dated 16 April 1999. In this letter Mr Ajello states that he is “concerned that an error may have occurred in the filing of the international application insofar as the concept described and claimed in this application was originally created by Lawrie (Mackie) and I am not at all clear whether any inventive contribution as such was made by yourself or Richard (Faulder)”. He goes on to say that “if you or Richard had contributed any inventive concept then there is the possibility that your respective employers might claim ownership of those contents under Section 39 of the Patents Act 1977”.
- 52 I need to consider whether this letter really does show that the Faulders were mistakenly included as co-inventors on the PCT application because of an error by Mr Ajello. Mr Charles Faulder claims in his witness statement that he was at the meeting with Mr Mackie and Mr Ajello when the PCT application forms were completed and that there was agreement that both he and Richard Faulder should be named as co-inventors with Mr Mackie. There is therefore a clear conflict between the parties on this point. Neither side however has provided any credible evidence to support their version of events. As I have mentioned there is no witness statement from Mr Ajello. Mr Mackie does however refer to a letter to him from Mr Ajello dated 28 September 1999 in which Mr Ajello claims to have “acted in good faith following instructions received from yourself [Mr Mackie] and Charles Faulder”. Mr Ajello goes on to say that “the instructions he received from Charles Faulder were also in effect from his own son Richard”. This to me would seem to point to something more than a simple misreading of the papers. I would perhaps add here that even if Mr Ajello had been able to clarify the circumstances that led to the naming of the Faulders as inventors on this PCT application, I am not sure that he would have been able to assist on the main issue of whether the Faulders had or had not contributed to the invention. I say this on the basis of the uncertain language that he used in the letter to Charles Faulder and even allowing for the cautious way lawyers sometimes draft letters.
- 53 In addition there is also the question of the three earlier applications all of which have both the Faulders and Mr Mackie named as co-inventors. I have already said that at least two of these disclosed many of the features of the invention and going from the title of the other it seems likely that it is also relevant to the invention. The Forms 1/77 which detailed who the inventors were in respect of these applications were all signed by both Mr Mackie and the Faulders. It is of course possible, though not likely, that the forms were mistakenly

completed by Mr Mackie and the Faulders on the basis of a misunderstanding of how the names of the inventors should be recorded.

- 54 I must also take note of a document forming part of the defendants' evidence which comprises a "submission of suggestions" form to a company called C R Bard Inc. An internet search would lead me to believe that this company is, among other things, a promoter of innovation in the healthcare field. That however is not really relevant. What is though is the clear indication in this form which was again signed by both Mr Mackie and the Faulders that the inventors of the Incontinence Comfort Control System conceived February 1997 were both Mr Mackie and the Faulders.
- 55 I have also been pointed by the Faulders to a letter to them from Mr Mackie dated 24 December 1998 in which Mr Mackie expresses his thanks and appreciation to the Faulders "for your time and help in formulating, and patenting, a design system for incontinence".
- 56 So where does this leave us? Mr Mackie contends that the PCT application referred to the Faulders as inventors only because Mr Ajello had misread the papers and that neither Charles nor Richard Faulder took any part in the design or development of the invention. In his statement he goes on to say that the Faulders involvement "has been limited to assisting me for a limited period, in preparation of the patent application". I find it difficult to reconcile this with the evidence available to me. On no less than three occasions over a period of 18 months, Mr Mackie has signed UK patent application forms identifying the Faulders as co-inventors in respect of inventive concepts similar and in some cases identical to those claimed in GB 2348609. As noted above Mr Mackie has also indicated elsewhere a greater level of involvement by the Faulders. I believe this all points away from the suggestion by Mr Mackie that the Faulders were only involved in the preparation of the patent applications and towards them having a more active participation in the development of the invention. That does not necessarily mean they devised the invention at issue. Equally however it does not mean they didn't.
- 57 Both parties have also referred to a demonstration of a prototype in front of a third party, Mr P O Reilly, that took place in 1999. Neither side has however put forward any argument as to why I should view this demonstration as relevant to the question of inventorship.
- 58 Mr Mackie also refers to his son-in-law Dr Rowland Mitchell. His precise role in the development of the invention is however not clear although it would appear from a letter from Mr Mackie to Mr Charles Faulder dated 10th May 1999 that his involvement was mainly in developing the electronic control for the incontinence device. This is not really a feature of the patent in issue and indeed as Mr Mackie himself notes Mr Mitchell is not making any claims in respect of the invention.
- 59 As for the other evidence, well it really has not helped me. I have already mentioned that much of it relates to issues that simply have no bearing on the question of inventorship.
- 60 So what can I conclude? As I have explained neither side has been able to provide clear proof to show either what they themselves devised or what the other side did not. In

particular, I have not been able to determine who devised the main inventive concept or indeed any other aspects of the invention which may or may not have been inventive concepts in their own right. As I have already noted, in cases such as this the onus is on the claimant to prove his case. This means it is on Mr Mackie to prove that neither Charles nor Richard Faulder contributed anything to any of the inventive concepts. If he is not able to do this then his claim must fail. Having carefully considered all the material before me, and for the reasons given above, I do not believe he has discharged that onus.

- 61 There is one point that I wish to return to. This is the relevance of GB 2327355 to the patent at issue here. An examination of the case file of the GB 2348609 shows that the examiner was aware of the existence of GB 2327355 and indeed discussed its relevance with the applicants. The claims as originally filed with the description and drawings on GB 2327355 were however not published due to an error by the Office. It is possible therefore that the examiner examining the patent at issue was unaware of the contents of the claims in this earlier application. I have therefore asked the examiner to reconsider the relevance of this document and to advise Mr Mackie as the proprietor as soon as possible whether any amendment of GB 2348609 is necessary.

Conclusion

- 62 I have considered the reference under section 13 and have decided that Mr Lawrence Sutherst Mackie, Mr George Charles Faulder and Mr Richard Martin Faulder are all correctly named as inventors. I therefore decline to issue any certificate to the contrary.

Costs

- 63 Neither side has requested that an order for costs be made and I therefore make no award.

Appeal

- 64 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

Phil Thorpe
Deputy Director acting for the Comptroller.

