



BL O/260/06

15<sup>th</sup> September 2006

## PATENTS ACT 1977

BETWEEN

Victor Ifejika Claimant

and

Charles Ifejika Defendant

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PROCEEDINGS

Reference under sections 13(1) and 37(1)  
in respect of UK patent EP0394254B1

HEARING OFFICER Peter Back

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## DECISION

### Introduction

- 1 This reference under sections 13(1) and 37(1) of the Patents Act 1977 stems from a dispute between two brothers regarding who devised the invention set out in UK patent EP0394254B1 and who is entitled to ownership of the intellectual property rights granted therein.
- 2 The patent relates to an invention for an electrically operated contact lens cleaner and was granted by the European Patent Office on 3rd May 1995. The patent designates UK and remains in force to this day. The patent derives from a PCT application filed on 18th July 1988 and takes priority from a UK application, GB8716886, filed on 17th July 1987. The PCT application was published as WO 89/00429 on 26th January 1989.
- 3 The patent was granted to Charles Ifejika as the sole inventor and proprietor.
- 4 The claimant, Victor Ifejika, believes that the contribution he made in developing the invention set out in the patent deserves to be both recognised and rewarded, and has referred the matter to the Comptroller to decide. The claimant requests to be recorded as an inventor in the patent and either be granted an exclusive license under the patent, be recorded as sole proprietor of the patent or be granted a sole license under the patent.
- 5 Statements of case and counterstatements were filed, and evidence in the form of witness statements from both Charles and Victor were supported by exhibited documents. In his counterstatement, Charles Ifejika challenges Victor's right to bring entitlement proceedings on the basis of the time limit for doing so provided by section

37(5) - Victor's reference to the Comptroller was filed in April 2004, some 9 years after the grant of the patent. In any case, Charles argues that the delay in bringing such proceedings means that there is also the defence of laches to be considered.

- 6 Both parties requested to be heard in the matter and appeared before me on 30th January 2006. Mr Richard Davies, instructed by Mewburn Ellis, appeared as counsel on behalf of the claimant, and Mr Benet Brandreth, instructed by Jensen & Son, appeared as counsel on behalf of the defendant. At the hearing both Charles and Victor Ifejika agreed that it would be convenient for me to refer to them by their first names and I did so at the hearing and will do so in this decision.

### **Preliminary issue**

- 7 Before considering the substance of this case, I shall note the outcome of a preliminary issue I dealt with at the hearing. Mr Brandreth submitted that the claimant's amended statement of case acknowledges that subject matter was added to the patent application after it was filed, and that this addition of subject matter is supported in the evidence of Victor Ifejika. In the light of the Court of Appeal's judgment in *Markem v Zipher*<sup>1</sup>, with reference in particular to Lord Justice Jacob's comments at paragraphs 87-90, Mr Brandreth submitted that the pleaded case had the inevitable consequence of leading to invalidity of the patent and that the claim to entitlement should fail. In response, Mr Davis accepted that the claimant's pleading was not as clear as it might be and offered to amend the statement of case to make clear the claimant's pleading that additional matter was not explicitly disclosed in the application as filed.
- 8 After adjourning the hearing for a short while to consider the matter, I decided to proceed on the basis of the amended pleadings offered by Mr Davies, and to take full account of Mr Brandreth's *Markem* and added matter points in my substantive decision. Both Mr Davis and Mr Brandreth were content to proceed on this basis.

### **Cross-examination**

- 9 Both Charles and Victor were cross-examined at length on their evidence, and both appeared to make a genuine attempt to answer the questions put to them as truthfully as possible. However, it was clear that the significant passage of time since the filing of the original priority application had affected their recollection of events, which led to inconsistencies between their own account of events leading to the granting of the patent and the contemporaneous documentary evidence filed in support of their witness statements. There was also a tendency for them to contradict their own testimonies in the face of some fairly robust questioning, although I did not get the impression that this was done deliberately in an attempt to avoid getting at the truth. I need, therefore, to be extremely careful when relying solely on the testimony of the two witnesses under cross-examination.

### **The law**

- 10 The relevant law in this dispute are sections 7, 13, 37 and 125 of the Patents Act 1977 ("the Act"), and the applicable parts of these sections are reproduced below:

*Section 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*

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<sup>1</sup> [2005] RPC 31

*patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.*

*Section 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.*

*Section 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.*

*Section 37(5): On any such reference no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) above on that ground, if the reference was made after the end of the period of two years beginning with the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.*

*Section 125(1): For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.*

- 11 The doctrine of laches provides a defence when there has been unreasonable delay in enforcing an equitable right. Equitable remedies will not be granted if the claimant has delayed unduly in seeking them, and a court may strike out an action if it is satisfied that the claimant has taken an unnecessarily long time in pursuing a claim.

### **The patent**

- 12 The patent relates to an apparatus for cleaning contact lenses that comprises an electro-mechanical arrangement for agitating contact lenses within a tank of cleaning solution. The patent has two independent claims, claims 1 and 13, which read as follows:

1. A cleaning apparatus for cleaning contact lenses, comprising; tank means for receiving contact lens cleaning fluid; an electrically operated motor; and a contact lens holder for insertion therein of at least one contact lens, the contact lens holder communicating with the tank means to enable unimpeded transfer of cleaning fluid to take place therebetween; the apparatus being characterised by vibration generating means operating within a frequency range of 10-100Hz; and a support arm, the contact [lens] holder being directly coupled to said motor by means of the support arm, the support arm being drivable by the motor to impart reciprocating motion to the holder within the tank means in a rotational or

linear sense, in which apparatus the vibration generating means is operable during said reciprocating motion such that vibration is imparted to the at least one contact lens simultaneously with the reciprocating motion.

13. A method for cleaning at least one contact lens, said method comprising the steps of charging lens-receiving tank means with contact lens cleaning fluid, inserting said at least one contact lens into the cleaning fluid, supporting the tanks means on a support arm and driving the support arm by means of an electrically operated motor to subject the tank means to reciprocating motion in a rotational or linear sense, the electrically operated motor imparting vibration to the tank means at a frequency of 10-100Hz, preferably 20-45Hz, more preferable 35 to 45Hz, simultaneously with said reciprocating motion thereby to effect cleaning of the or each lens and, subsequently removing the or each lens from the tank means.

- 13 At the hearing, a great deal of time was spent in attempting to properly construe these claims and to understand the nature of the invention. This was made difficult by the lack of precision in the terminology used in the patent and the changes made to the specification since the original filing of the priority document in July 1987. As I have already noted above, there is also a suggestion that subject matter had been added to the specification during the course of prosecution of the application, and that the granted claims rely on this added matter. It is necessary, therefore, that I consider the relationship between the original PCT application and the final European patent, and to identify the subject matter contained in the priority application filed 12 months earlier.

### The applications

- 14 The priority application describes a cleaning apparatus for cleaning contact lenses comprising a vibrator arrangement physically associated with what has since become the de facto contact lens case. Figure 1 of the drawings, reproduced below, clearly shows a contact lens case mounted on an electrically driven vibrator, the description stating that the vibrator may take the form of a motor provided with an eccentric arrangement or cam arrangement. The vibrator provides a reciprocating motion on the arm 9, which in turn shakes the contact lens case and the contents therein. The vibrator may be controlled by a simple on-off switch or by a timer arrangement that switches off once the vibrator has been on for a pre-determined length of time.

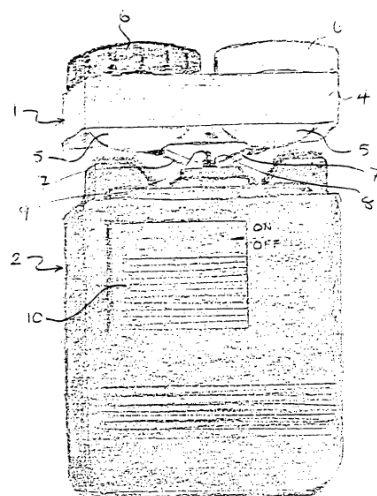
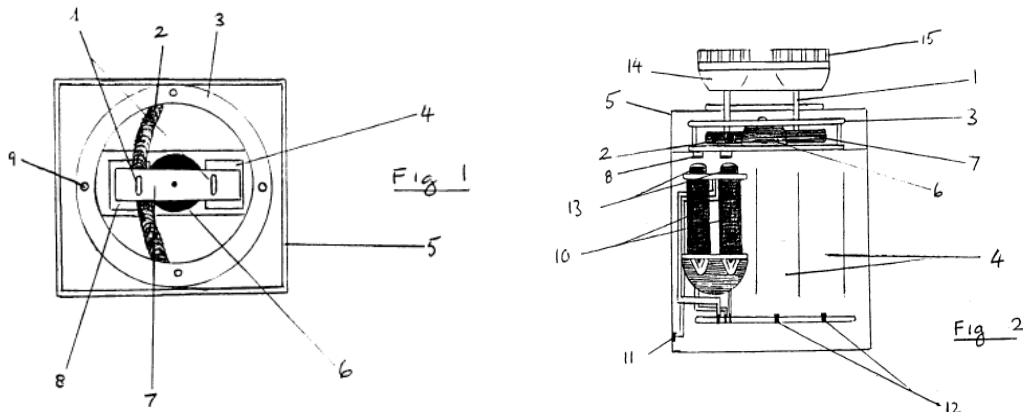


FIGURE 1

- 15 The PCT application filed in July 1988 differs from the priority application in a number of respects, as is clear from figures 1 and 2 of the drawings reproduced below.



- 16 The cleaning apparatus comprises a similar contact lens case mounted on a mechanism that provides a rotating, reciprocal or linear agitation at its output. Rotational agitation is described at page 2, line 5 as effecting a figure of eight movement of the contact lens case, while a linear reciprocating agitation causes a rotating or side-to-side motion of the case. Agitation may be brought about by electrical means, for example by a mains or battery powered electric motor provided with an eccentric/cam arrangement. The description at page 5, line 34 to page 6, line 3 says:

“In any event the agitator provides a reciprocating motion on the arm 7. The arm is received within the supporting wheel 3 and thus the rotational motion of the arm 7 is transferred to the storage case 14 and will thus shake the case and the contents of the concave recess vigorously from side to side.”

- 17 The description also makes clear that the agitator may be adapted for use with other types of contact lens case, for example the barrel type case comprising a single tank of cleaning fluid and two central perforated baskets that hold the individual contact lenses. The description at page 6, line 28 says:

“As previously mentioned the agitator may be of any suitable design, so long as it effects vigorous shaking of the casing. In an alternative embodiment there may be a single tank chamber divided into two separate regions by a perforated screen or mesh. The cleaning apparatus may provide electrical means for vibrating the tank means, s[a]id vibrating means reciprocating, so that the contact lenses move about and wash themselves automatically within the cleaning fluid provided. In all cases the frequency should be between 10-100Hz and preferably between 35-45Hz.”

- 18 A key difference between the priority and PCT applications appears in the final two sentences of the latter application. Up until this point, the application is concerned with preferred features of an electro-mechanical arrangement for agitating a contact lens casing. However, the final two sentences on page 7 say that:

“the connection between the motor and the arm of the drive mechanism may comprise a gear train designed to reciprocate the arm. This gear train will allow the contact lens holder to agitate rotationally within the tank.”

- 19 This is the only explicit reference to a contact lens “holder” found in the application as filed, although the description of the barrel type casing at pages 2 and 6 does refer to two central perforated baskets that “hold” individual contact lenses within the tank of cleaning fluid.

### **Inventorship**

- 20 Section 7(3) of the Act states that the inventor in relation to an invention means the actual deviser of the invention. In order to determine who devised an invention, it is first necessary to determine the precise nature of the invention that led to the patent. Section 125(1) of the Act points to the invention being defined by the claims of the patent as interpreted by the description and any drawings contained in the specification, and that this is the case unless the context otherwise requires. Once the invention that led to the patent has been determined, it is then possible to assess the evidence to determine who devised it.
- 21 As will become clear, relying on the granted claims as a definition of the invention that led to this patent is not straightforward, since many of the essential features of the claims are not explicitly disclosed in the application as filed. This was raised by Mr Brandreth at the start of the hearing and is acknowledged in the claimant’s amended pleadings. There is also the suggestion that the claims rely on subject matter not contained in the application as filed, and so cannot be relied upon as a true indication of the invention that led to the patent. I should note, however, that despite this suggestion that the claims rely on subject matter not contained in the application as filed, neither party has put the validity of the patent in issue. Since the Comptroller’s power to revoke patents on his own initiative does not extend to the revocation of invalid patents, the question of validity is not a matter that I need to dwell on further.
- 22 At the hearing, both parties referred to case law that deals with the question of what is the invention in the context of inventorship. In *Collag Corp v Merck & Co Inc*<sup>2</sup>, Mr Justice Pumfrey says at paragraph 70:

“The leading modern authority is *Henry Brothers (Magherafelt) v Ministry of Defence* [1999] RPC 442, an appeal from a judgment of Jacob J itself reported at [1997] RPC 693. It is clear that it is the function of the Court to identify the inventive concept of the specification, and then to determine who devised the inventive concept. The approach is simply stated: the problem is to apply it when there are a number of distinct concepts disclosed by the specification, including an important commercial embodiment.”

And then at paragraph 78:

“In the case of a patent application, the inventive concept cannot be identified by reference only to the claims, a course which is possible when one considers a granted patent, and was followed in *Henry Brothers* and *Viziball* cases (above). The inventive concept or concepts must be identified from the application as a whole. More than one inventive concept may be present in the application.”

- 23 A similar conclusion was arrived at by the Court of Appeal in *Markem*, which considered the relevance of claims in entitlement proceedings under section 8 and the interpretation to be given to section 125(1). At paragraph 92 of the judgment, Jacob LJ says:

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<sup>2</sup> [2003] FSR 16

“So if one goes on a claim-by-claim approach, one can assert of a particular claim that “that claim is Markem’s because it was first proposed at Markem”. We have already identified why that approach is not good enough. On top of that, however, we think the claim-by-claim approach is itself fallacious and not what is called for by the Act.”

At paragraphs 101 and 102, Jacob LJ goes on to say:

“Accordingly we think one is driven to the conclusion that section 8 is referring essentially to information in the specification rather than the form of the claims. It would be handy if one could go by the claims, but one cannot. Section 8 calls for identification of information and the rights in it. Who contributed what and what rights if any they had in it lies at the heart of the inquiry, not what monopolies were actually claimed.

It is not possible to be very specific about how this is to be done. But as a general rule one will start with the specific disclosure of the patent and ask whether that involves the use of information which is really that of the applicant, wholly or in part or as joint owner. Here the specific disclosure of the Zipher patents is clearly Mr. McNestry’s basic idea, his particular “clever way.” Without that the disclosure would be near valueless. True the patent would have claims covering bi-directional or dual-purpose printers, but without any practical way of achieving them. What one is normally looking for is “the heart” of the invention. There may be more than one “heart” but each claim is not to be considered as a separate “heart on its own.”

24 Although neither side addressed me on the point, it is clear to me that the approach set out in *Markem* is equally relevant when considering inventorship under section 7. This is clear from section 7(2) of the Act, which states that it is the inventor that is primarily entitled to the patent unless this is overridden by any rule of law or any legally enforceable agreement existing at the time the invention is made - it would make no sense at all to apply one approach to entitlement and a different one to inventorship. This leads to the inevitable conclusion that in order to determine the deviser of an invention, it is necessary to find the person who made the contribution at the heart of the invention, or in the words of Mr Justice Pumfrey in *Collag*, determine who was responsible for the inventive concept of the specification. Often it will be possible to identify the inventive concept by consideration of the granted claims alone, but sometimes it may not; the granted claims serve merely to define the monopoly to which the proprietor is entitled and are crafted in the light of both the inventive concept and the state of the art.

25 So what affect does subject matter added to the application after the filing date have in determining the invention that led to the patent? This was not an issue that arose in *Collag* or *Markem*, and neither side referred to any authority to guide me on this. Both *Collag* and *Markem* say that I can rely on the specification to determine the inventive concept that led to the patent, but does that necessarily point to the specification as filed or, alternatively, to that published at grant? I consider that section 76 of the Act provides clear guidance on this, with section 76(2) saying that:

“No amendment of an application for a patent shall be allowed [...] if it results in the application disclosing matter extending beyond that disclosed in the application as filed.”

26 Any amendment that discloses subject matter not present in the application as filed would, in normal circumstances, be refused by the Patent Office under section 76 of

the Act (in the UK, or under Article 123(2) of the EPC at the European Patent Office). So there is a clear requirement that the specification of a granted patent should contain no more information than it did when filed - any additional disclosure that manages to slip through the net must, therefore, be ignored, because it should not have been there in the first place. This is a strict requirement, as is clear from the sanction of revocation available under section 72 of the Act.

27 In summary therefore, in order to determine the deviser of the invention I must first identify the inventive concept or concepts disclosed in the specification as filed and then assess the evidence available to me to find out where, or with whom, the concept or concepts originated. Anything added to the specification after filing cannot form a part of the invention that led to the patent.

28 Mr Davis helpfully suggested that the inventive concept disclosed in the specification is the combination of a) the agitation of the contact lens holder within a container of cleaning fluid ("the within feature"), b) the imparting of vibrations at a frequency of 10-100Hz to the contact lenses ("the parameter feature"), and c) the simultaneous reciprocation and vibration of the contact lenses ("the Vib/Rec feature"). These features are all found in claim 1 of the granted patent.

*"The within feature"*

29 Claim 1 defines a support arm that directly couples the motor and the contact lens holder so that the motor is able to impart reciprocating motion to the holder within the tank of cleaning solution "in a rotational or linear sense". The only reference in the description to a contact lens holder being rotated within a tank of cleaning solution appears, as I have noted above, in the final sentence of the specification. Up until this point, it is quite clear from the description that the function of the support arm is to transfer reciprocating motion generated by the motor directly to the casing thereby allowing the contact lenses to slosh around inside. However, the final sentence says that the gear train connecting the motor and support arm allows the contact lens holder to agitate rotationally within the tank means.

30 The claimant accepts that there is no explicit disclosure in the application as filed of a direct coupling between the support arm and the holder in order to agitate it within the contact lens case, and I am satisfied that this is correct. But can this direct coupling between the support arm and the holder be found to be implicitly disclosed in the PCT application? In other words, what precisely does this "within feature" mean in the context of the application as filed?

31 As Mr Davies rightly pointed out, this presents me with some difficulty because no evidence has been provided of what implicit disclosure would be apparent to the skilled person from reading the application as filed. Having already accepted that there was no explicit disclosure of this feature in the application as filed, it is somewhat surprising that the claimant failed to provide evidence in support of any such implied disclosure. Nevertheless, whilst the task may be difficult in the absence of such evidence, it is by no means impossible, and it is necessary therefore that I look in detail at what the specification does and doesn't say.

32 Looking more closely at the final paragraph of the application as filed, it is by no means clear to me how the contact lens holder is allowed to agitate rotationally within the contact lens case. For example, the holder could be caused to agitate freely within the tank by direct agitation of the arm on the contact lens case, or, alternatively, the arm could act directly on the holder to agitate it within the contact lens case. Claim 1 defines this second alternative, but I cannot see how this direct agitation of the holder



within the case can be arrived at by careful reading of the limited information provided at the end of the application. A skilled man reading the application as filed could easily arrive at a number of alternatives where the lens holder is allowed to agitate within the tank, and would, it seems to me, require a degree of ingenuity in order to arrive at the “within feature” set out in claim 1.

33 This then begs the question of why was the PCT application amended prior to filing to say that the contact lens holder could be allowed to agitate rotationally within the tank? This clearly meant something to the defendant at the time of filing the application, because it was he, according to his first witness statement, who sought the advice of a patent attorney and arranged for the revised priority application to be filed. It could well have been the case that Charles was referring to the direct coupling of the support arm and contact lens holder in the final two sentences of the PCT application, and it could also have been the case that this idea was, as he suggests, his own. Equally, when Victor says in his first witness statement that it was he, at a meeting in May 1988, who introduced to Charles the idea of reciprocating the lens holder within the tank (rather than just agitating the tank), this may well be true. However, since it is only what can be understood from the specification that is important, such analysis of the evidence is pointless.

34 Having read the specification very carefully, I am satisfied that the skilled man would imply nothing from the final two sentences of the application as filed other than that which is explicitly disclosed. I therefore consider that the direct coupling between the support arm and the holder in order to agitate it within the contact lens case constitutes subject matter added to the application after the filing date and cannot form part of the inventive concept. The “within feature”, which Mr Davies suggests is possibly the most important feature of the inventive concept, has to be interpreted in light of the application as filed, and means nothing more than the ability of the gear train to allow the lens holder to agitate rotationally within the tank.

*“The Vib/Rec feature”*

35 Claim 1 defines a vibration generating means operating at a particular frequency for imparting vibrations to the contact lenses simultaneously with the reciprocating motion provided by the support arm and motor. The only reference to “vibrating” a contact lens case or holder found in the application as filed, i.e. as opposed to the many references to agitating a case, appears at page 6, lines 31 to page 7, line 3 of the description (see paragraph 17 above). It is clear that this passage of the description does not explicitly disclose the simultaneous vibration and rotational agitation of the contact lens case, lenses or holders required by claim 1, and, in that respect, I agree with the claimant’s amended pleadings. So what precisely does this “Vib/Rec feature” mean in the context of the application as filed?

36 At the hearing, Mr Davis suggested that had the claims been drafted differently, they would make clear that the reciprocating motion was different to the vibrating motion, and that the two motions were different and additional. This suggestion can be readily accepted in the case where a gear arrangement is placed between the motor and the support arm for the purpose of stepping up (or down) the rotational motion of the motor acting on the support arm. In such a case, vibrations from the motor would be mechanically transmitted to the contact lens case through the gear mechanism and the support arm, and the frequency of vibrations would be different and additional to the frequency of the reciprocating motion. The possibility of there being a gearing arrangement between the motor and the support arm is clearly envisaged at lines 4-6 of the PCT application as filed.

37 The fundamental difficulty I have with Mr Davis' suggestion is that I can find nothing in the application as filed to suggest that the inventive concept lies in providing simultaneous rotational agitation and vibration to the lenses. Although fairly vague, the wording "s[a]id vibrating means reciprocating," at page 6, line 35 suggests to me that the vibrating and reciprocating motions are both one and the same, and that rather than there being two vibrations acting on the contact lens, only one is intended. It is only with the benefit of hindsight, I believe, that it is possible to see that two vibrational components are at play in the geared arrangement of the lens cleaner. There is nothing in the application which steers or vaguely points the skilled reader to the benefits of having simultaneous rotational agitation and vibration of the lenses, not even with regard to the description of the geared lens cleaner. In view of this, I consider that the "Vib/Rec" feature advanced by Mr Davis relates to subject matter not contained in the application as filed, and that the statements by both Charles and Victor claiming to have devised such an inventive concept are not relevant - Charles' belief that the "Vib/Rec" feature was disclosed in the priority application (see paragraph 6 of his first witness statement) does not, it seems to me, stand up to scrutiny.

*"The parameter feature"*

38 Claim 1 defines a vibration generating means operating within a frequency range of 10 to 100 Hz. The PCT application as filed refers specifically to an electrical motor for imparting vibration to the tank of cleaning solution, i.e. the contact lens case, at a frequency of 10-100Hz, and preferably within the limited ranges of 20-45Hz and 35-45Hz.

**The inventive concept**

39 In view of the above analysis, I have found that two of the three key features of the invention advanced by Mr Davis, i.e. the "within" and "Vib/Rec" features, were not disclosed in the application as filed, and cannot be relied upon to determine the inventive concept or concepts disclosed in the specification. As a result, claims 1 and 13, which define the invention in terms of either one or both of the "within" and "Vib/Rec" features, cannot provide an accurate indication of the inventive concept or concepts disclosed in the specification. I must therefore look elsewhere for the inventive concept that led to the PCT application, and, in accordance with both *Collag* and *Markem*, I will look to the description of the invention set forth in the application as filed.

40 At the very outset, the description suggests that the invention provides "a convenient, safe but more importantly quick and effective method of cleaning lenses." There is provided "a cleaning apparatus comprising tank means containing contact lens fluid and electrical means that provide a rotating agitation at its output." It then discusses the nature of the rotating agitation, i.e. as a linear reciprocating agitation or as a figure of eight movement, which causes the contact lenses to move about and wash themselves automatically in the lens cleaning fluid. A further preferred embodiment is described which provides a "linear reciprocating agitation at its output", which later on in the description is described as a side-to-side motion. The description goes on to say that "whatever motion is employed, whether rotating or side to side, causes the contact lenses to move about and wash themselves automatically in the lens cleaning fluid". The preferred frequency of agitation is said to be between 10-100Hz, and ideally in the range of 20-45Hz.

41 In order to set the invention into context, an outline is given of some prior art lens cleaners which transmit ultrasonic or high frequency vibrations into the cleaning fluid,

and it is suggested that such devices might not be as effective at successfully removing dirt and other foreign bodies adhering to the lenses.

- 42 Taking all of this into account, it seems to me that it is the concept of cleaning contact lenses by agitating a lens casing at a particular frequency that sets the invention apart from the prior art, and is, I consider, at the heart of this invention.
- 43 From the evidence submitted, there is little doubt in my mind with whom the concept of agitating the contact lens case originated. By Victor's own account of events leading up to the filing of the priority application (e.g. at paragraph E1 of his first witness statement), Charles had already developed a contact lens cleaner comprising a flat contact lens case mounted on top of an electric shaver, the lens case being shaken rapidly from side to side and causing the lenses and cleaning fluid to move about inside. This cleaner was the subject of Charles' priority application. However, there is no specific mention in the priority application of the preferred frequency of agitation of the lens case, other than the requirement that the lens case be shaken gently from side to side.
- 44 In his evidence, Victor says that one of the inventive contributions he made to the patent application was in suggesting the rotational agitation of a contact lens holder within a tank. He describes the time in 1987 when he discovered the effectiveness of turning a lens holder clockwise and counter-clockwise in alternating rotations within a tank of cleaning solution, and how he later realized that the lens holder could be turned by a motor. However, as I have already found, none of this is disclosed in the PCT application as filed, and is not relevant in determining who devised the invention.
- 45 He goes on to say that the other inventive contribution he made to the patent was in measuring and determining the desired frequency of agitation. According to his first witness statement, Victor says that he used a pulsed light meter to measure "incidental" vibrations in the lens holder of his barrel cleaner. This measurement was carried out in the period between August and December 1988, which clearly occurred after the filing date of the PCT application. In his second witness statement, he says that he bought a pulsed light meter to measure the frequency of vibrations of Charles' flat contact lens cleaner (measured at 45Hz), and in the period leading up to June 1987 had experimented with a number of shaver arrangements with frequencies ranging from 45Hz to 70Hz. In the end he concluded that Charles' cleaner was ineffective and developed his own barrel cleaner. This seems at odds with what he says in his first witness statement that he did not become involved in the design of the lens cleaner until May 1988. Nevertheless, what Victor says is that he measured the frequency of Charles' cleaner, carried out some experiments and then decided to develop his own more effective cleaner. Under cross-examination, Victor confirmed that Charles' cleaner operated at a frequency of 45Hz and became ineffective at higher frequencies.
- 46 Charles, on the other hand, says that he discovered from the technical specification of the shaver that it operated at 45 Hz. He says that the frequency ranges referred to in the application were introduced by his patent attorney, Warren Silverman, who advised that the frequency of operation should be generalized in case the claims had to be limited to 45Hz to overcome prior art. A letter from Warren Silverman addressed to Victor in relation to an equivalent US application (US458638) discusses how his associates might be inclined to "take out the preferred ranges whose importance, nevertheless, I have stressed and included in alternative claims". This letter is dated after the filing date of the PCT application.
- 47 Setting aside for one moment the precise date when Victor claimed to have

determined a preferred frequency range of agitation, it is clear from his own account of events that Victor's only contribution to the development of a lens cleaner which agitates a lens case at a particular frequency was to measure the frequency of operation of Charles' lens cleaner and to demonstrate that frequencies higher than 45Hz were ineffective. In contrast, the PCT application describes the preferred frequency of operation to be between 10-100Hz (and preferably between 20-45Hz), and makes no mention whatsoever of Victor's alleged discovery. In fact, the reference in the application to a frequency of 10-100Hz points away from Victor's alleged discovery. So regardless of when Victor made his alleged discovery, there is nothing in his evidence to suggest that he made a contribution towards determining the preferred frequency of agitation of the lens cleaner. He admits that the lens cleaner was Charles' idea and that Charles' cleaner operated at 45Hz - nothing that Victor did before, or indeed after, the filing of the PCT application had any impact in determining the frequency of agitation of the lens cleaner.

48 On balance, I consider that Charles' explanation of where the 10-100Hz frequency range originated to be the more credible. Patent attorneys are skilled at identifying key features of an invention and drafting claims which provide the broadest monopoly possible, and Warren Silverman's letter to Victor just goes to confirm the ability of patent attorneys to generalize non-essential features of an invention. The preferred frequency of operation of the lens cleaner is described in the application as being between 20-45Hz, which clearly encompasses Charles' design. It was Charles who made the key contribution at the heart of this invention, not Victor, and whatever generalizations were introduced into the application prior to filing were made in relation to Charles' inventive concept.

49 Taking all of this into account, I find that that the evidence points to Charles being the sole deviser of the inventive concept disclosed in the PCT application.

### **Entitlement**

50 In view of my finding on inventorship, the question of entitlement becomes a relatively straightforward one to answer. As I have already mentioned above, section 7(2) of the Act states that it is the inventor that is entitled to a patent unless this is overridden by any rule of law or any legally enforceable agreement existing at the time the invention is made. In the absence of any such legally enforceable contract existing at the time the invention was made, I find that Charles, as the sole deviser of the invention, is entitled to the patent. In view of this finding, I do not need to consider the defendant's arguments in relation to both section 37(5) and the doctrine of laches.

### **Conclusion**

51 I have found that the invention disclosed in the PCT application which gave rise to the UK patent in dispute was made solely by Charles Ifejika, and that it was Charles alone who was entitled to be granted the patent. I have also found that the claims rely on subject matter not contained in the application as filed, but since validity of the patent has not been put in issue by either party, the Comptroller does not have the authority to revoke the patent on his own initiative.

### **Costs**

52 The defendant has succeeded in this action and has asked for an award of costs in its favour. At the hearing, Mr Brandreth made the point that had the amendments I allowed to the statement of case been made at first pleading, the costs incurred by Charles in defending the case would have been far less. Mr Brandreth argued that

this unnecessary expense ought to be reflected by an award of costs that departs from the standard scale of costs applied by the Patent Office.

- 53 I do not accept this argument – the consequence of the amendment would have been to establish evidence relating to what the skilled man would have implied from the application as filed, which neither side addressed. As such, I find no compelling reason to depart from the standard scale and order the claimant (Victor Ifejika) to pay the defendant (Charles Ifejika) the sum of £2000 as a contribution towards its costs. This sum should be paid within 7 days of the expiry of the appeal period below. Payment will be suspended in the event of an appeal.

### **Appeal**

- 54 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days from the date of this decision.

**Peter Back**

Divisional Director acting for the Comptroller