BL O/320/06

9 November 2006

PATENTS ACT 1977

BETWEEN

I.D.A. Limited, Colin Thomas Metcalfe, David Julian Lax and Polymer Powder Technology (Licensing) Limited	Claimants
and	Defendants
The University of Southampton, Philip Edwin House and Roger Edward Ashby	

PROCEEDINGS

Reference and application under section 8, 12 and 13 of the Patents Act 1977 in respect of UK application GB 9814507.1, international application PCT/GB99/02090, European application 99929525.6, Australian application 4631799 and applications deriving or claiming priority therefrom

HEARING OFFICER R C Kennell

DECISION AND ORDER

1 These proceedings relate to a bundle of applications relating to the trapping and killing of insects such as cockroaches. Following the judgment of the Court of Appeal that Colin Metcalfe is the sole deviser of the invention and that I.D.A. Limited is entitled to the patent applications instead of the defendants, the case was remitted to the comptroller to make such orders as he thought fit in order to determine the rights of the parties in accordance with the judgment and order of the court, and the costs before the comptroller.

2 The matter came before me at a hearing on 6 November 2006. James St Ville, instructed by Raworth, Moss & Cook, appeared for the claimants and Daniel Alexander QC, instructed by the University of Southampton's Legal Services, appeared for the defendant. A preliminary telephone hearing had already been held on 3 October 2006 at the instigation of the claimants with a view to compelling the defendants to release a petition concerning a pending US application that was with them for the signature of the originally named inventors, Philip Howse and Roger Ashby. This resulted in an order by the hearing officer (Mr Probert, decision BL O/292/06) that the defendants should

bring the signed petition to the hearing on 6 November, which they duly did.

Costs

3 Mr St Ville's argument was essentially that the claimants were entitled to costs off the comptroller's normal scale on account of the defendant's unreasonable behaviour. This has generated substantial evidence from both parties. In the event, the hearing was brought forward from 23 November to 6 November but the defendants did not file their evidence in chief until 2 November; Mr St Ville said that this had left insufficient time to reply to points of substance raised in the defendant's evidence. Mr Alexander made the point, which I wholly concur with, that the issue of costs should not be allowed to become an area for "satellite litigation". However, he did not in the end resist, and I accepted, Mr St Ville's proposal for costs to be settled at a further hearing to be arranged as soon as possible after 30 November (any earlier date now being impracticable).

Order

4 Both Mr St Ville and Mr Alexander provided drafts for me to consider at the hearing, and made strenuous attempts to narrow as far as possible the gap between the parties. On the day after the hearing they submitted to me a further draft recording the terms on which they had been able to agree and alternative wording for the areas of disagreement which remained. I am most grateful for their assistance.

5 It was agreed that I should settle the areas of disagreement. Having considered these, my order is appended to this decision. My reasoning is given below concerning the areas where the parties did not agree, or where (apart from minor clarification) I have differed from the wording agreed by the parties.

Reasons

6 *First recital.* The telephone hearing on 3 October 2006 was not included in the list of hearings before the Comptroller, but it should in my view be included as it is part of the proceedings for which costs fall to be determined.

7 *Second recital.* It seems to me desirable to include in the recitals the terms of paragraph 5 of the Court of Appeal's order of 22 March 2006 which specifically remit to the comptroller the determination of the parties' rights and the costs before the comptroller. I have expanded the second recital accordingly.

8 *Fourth recital*. I have added this to provide a basis for paragraph 4 of the order, on which I comment below.

9 *Paragraphs 1*-2. By the time of the hearing on 6 November the defendants had, without prejudice to anything else and to any other disputes between the parties, decided not to dispute that an order under section 12 should be made in respect of the US application.

10 However they did have an issue with the precise wording of the declaration which needed to be provided. The version sent to them by the defendants merely required statements of "no deceptive intent" as regards the incorrect statement of inventorship. The claimants have put in evidence a letter from their US patent attorney (Sue Shaper) saying that having consulted with the Legal Office of the USPTO this was all that Messrs Howse and Ashby and the University as assignees were required to execute. However, the defendants wanted a version which was purely factual as regard what happened in the proceedings and avoided saying anything from which inferences could be drawn by the claimants for use in other proceedings. To this end they had put in evidence a version which their US patent attorney (Richard Fichter) believed to be acceptable to the USPTO. This required Messrs Howse and Ashby also to confirm that the UK Patent Office has, in a decision upheld by the Court of Appeal, held that Colin Metcalfe was the sole deviser of the invention of the European application and international application in suit and that they are not inventors. Alternatively they were prepared to use the claimants' version but for me to order that the claimants should not make use of the forms for purposes other than effecting assignments and correcting inventorship.

11 However, it seems to me that the claimants' version has the merits of saying precisely what is required by the USPTO, and I do not think that the defendants' concerns are sufficiently pressing as to warrant including the extra confirmation that they seek. I am far from convinced that this would really change the position, and I think that it runs a real risk of complicating the matter unduly and causing further delays. I therefore opt for the claimants' version (and also for the Australian and Brazilian applications), without the further restrictive order proposed by the defendants.

12 As regards the time for the corrections and assignments to be completed, the claimants wanted this to be done by 10 November and the defendants by 27 November. I understand there to be concern on the part of the claimants that because of delay by the defendants in returning the signed petition, there is a risk of the claimants incurring a further, possibly heavy, fee for a not-easy-to get extension of time by the USPTO. As I understood it the defendants thought it would be necessary for them to have the petition back in around a week's time in order to deal with everything in time to avoid this. Not unsurprisingly there is dispute between the parties as to whether the claimants' fears are grounded and whether there has been culpable delay on the part of the defendants making the claimants' task more difficult. This forms part of the evidence before me for the assessment of costs, and will need to be considered in depth in due course, but I am not making any finding on that at this stage as to whether either party has acted unreasonably.

13 My concern at this stage is that the matter should not be drawn out longer than is really necessary and that the position of the claimants (who are after all now entitled to the invention) should not be unduly prejudiced by further delays. Therefore, whilst I am prepared to allow a period of 14 days for the various assignments to be made and the inventorship to be corrected, I consider that this should be subject to a requirement for the defendants to cooperate to

avoid the necessity to seek any more extensions of time before the various Offices.

14 That apart I do not see the need for any order along the lines proposed by the claimants requiring the defendants to take reasonable steps to transfer the benefit of the applications and patents and to correct the inventorship details. I cannot see that this adds anything useful to paragraphs 1 and 2: if anything further is required, I believe that this would be better dealt with under a general power to seek further directions and orders (paragraph 7 of the order).

15 *Paragraphs 3 and 4*. I have re-ordered these paragraphs from the draft supplied by counsel to bring together the procedure for the further hearing and to amplify the concerns about confidentiality and privilege. Some of the documents supplied for the hearing contain material which is still confidential in accordance with my various directions in 2002 before the substantive hearing in the Patent Office, but which may now warrant reconsideration. Also, the evidence includes at least one document which may be a "without prejudice" negotiating document relevant to the issue of the reasonableness of the defendants' conduct when considering whether off-scale costs should be awarded. It was agreed at the hearing that, given this rather confused situation, it would be preferable as a holding measure to extend the period of 14 days prescribed by rule 93(4)(a) of the Patents Rules 1995 pending further directions at the hearing.

16 *Paragraph 5*. I agree with the defendants that any evidence filed by the claimants shall be strictly in reply to the defendants' evidence.

17 *Paragraph 6*. With the exception of some slight modification I have left this in the form agreed by the parties.

18 *Paragraph 7*. With some modification of wording I have opted for the defendants' proposal for a general power to seek further directions and orders if this proves necessary, but for the avoidance of doubt I am prepared to include the specific provision proposed by the claimants in relation to PCT national or regional phase applications should there be any which need to be revived.

Other matters

19 No order is made in respect of the European patent application in suit, but it appears that the necessary changes have already been made pursuant to the Court of Appeal's decision and no further order from the comptroller appears necessary at present.

20 The petition which was left with me at the hearing requires execution by the University of Southampton as assignees; also it appears that Messrs Howse and Ashby may not have dated their signatures correctly. In case it is still required, this document will therefore be returned as a matter of urgency to the defendants for any further action that is necessary, and on this I would remind them of the terms of paragraph 2 of my order.

21 In relation to paragraph 4 of the order, I confirm that I have not read the negotiating document referred to above, but I would ask the parties to indicate before the further hearing whether they are content for any privilege in this document to be waived to the extent to allow me to consider it in relation to the assessment of costs.

22 The solicitors acting for Exosect Limited have notified the Office in a letter dated 9 March 2006 that Exosect hold a licence to work the invention which is the subject matter of applications GB 9814507.1 and PCT/GB99/02090, and wish to make a request for a licence pursuant to section 11(3) of the Act. Rule 9 of the Patents Rules 1995 requires the comptroller to give notice of the making of an order to any licensee of the original applicant(s) of whom he is aware, and accordingly a copy of this decision and order will be sent to Exosect Limited.

Appeal

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

R C KENNELL
Deputy Director acting for the Comptroller

PATENTS ACT 1977

IN THE MATTER OF UK application No. GB 9814507.1 and International application No. PCT/GB99/02090, European application No. 99929525.6 and Australian application No. 4631799 in the name of the University of Southampton, and of applications for a patent deriving or claiming priority therefrom

AND IN THE MATTER OF a reference under section 8, 12, 13 and 82 by I.D.A. Limited, Colin Thomas Metcalfe, David Julian Lax and Polymer Powder Technology (Licensing) Limited in relation thereto

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ORDER

UPON the hearing of this reference before the Comptroller on 31st March 2003 to 4th April 2003, 10th April 2003, 3rd October 2006 and 6th November 2006;

AND UPON the Court of Appeal, by its Judgment and Order dated 2nd March 2006 and by its Order dated 22nd March 2006, declaring that:

(a) The Second Claimant, Mr Colin Thomas Metcalfe, was the sole devisor of the invention of European Patent Application No. 99929525.6 and International Patent Application No. PCT/GB99/02090.

(b) The Defendants (the University of Southampton, Philip Howse and Roger Ashby) obtained said invention from the Second Claimant.

(c) The First Claimant, IDA Limited, is (without prejudice to any other rights of the Appellant) entitled to said patent applications instead of the First Defendant,

and remitting the matter to the Comptroller to make such further orders as he thinks fit in order to determine the rights of the parties in accordance with the said Judgment and Orders including under sections 12 and 13 of the Patents Act 1977 and as to the costs of proceeding before the Comptroller;

AND UPON the Defendants undertaking to write to the Claimants by 4pm on 17th November 2006 stating whether relations with third parties affect whether or not the Confidentiality Directions of Mr Kennell dated 20th December 2002 in so far as they relate to the witnesses X and Y should remain in place and, if so, their nature;

AND HAVING REGARD TO the likelihood that the evidence filed for the hearing on 6th November 2006 contains confidential and/or privileged material;

IT IS ORDERED THAT:

1. Subject to paragraph 2 below, the Defendants shall by 4pm on 23rd November 2006 correct the inventorship of and assign to the First Claimant free of any licence, mortgage or any other encumbrance UK application No. GB 9814507.1, International Patent Application No. PCT/GB99/02090, Australian Patent Application No.s 748355, 2006202675 and 2006300936 (by the form of assignment for Application No. 2006202675 attached at Schedule A and a similar form assignment for Application No.s 748355 and 2006300936), US Patent Application No. 09/736023 (by the form of petition and assignment attached at Schedule B), Brazilian Patent Application No. PI 9911813-0 (by the form of affidavit and assignment attached at Schedule C), Japanese Patent Application No. 557692/2000, South African Patent No. 2000/7781 and any patent petty patent design patent or similar form of protection (or application therefor) claiming priority from any of the aforesaid or any priority document in respect of any of them.

2. In respect of the above the Defendants shall cooperate with the claimants by taking all reasonable steps as lie within the Defendants' power and the Claimants may request to ensure that the corrections and assignments are completed without having to seek extensions of time or further extensions of time from the relevant intellectual property Offices.

3. The determination of costs and any other matters outstanding before the Comptroller shall be adjourned to a further hearing which shall take place on the first suitable date on or after 30th November 2006.

4. The evidence filed for the hearing on 6th November 2006 shall not be open to public inspection before the further hearing takes place, when such further directions shall be given in relation to confidentiality and privilege as the Comptroller considers necessary after hearing the parties.

5. The following timetable for subsequent evidence and submissions shall apply:

(1) the Claimants shall file a chronological bundle of correspondence and their evidence strictly in reply to the Defendants evidence dated 2 November 2006 by 4pm on Friday 17th November 2006;

(2) any supplemental skeleton arguments shall be served 2 days before the date fixed for the hearing.

6. The parties shall have permission to apply, or restore any application, to the Comptroller for an order that documents provided by way of disclosure in proceedings before him may be used for the purposes of other proceedings (either specific documents or more generally) upon 14 days notice supported if the Comptroller requires it by evidence, whereupon the Comptroller shall make such determination as he sees fit on such application including orders preserving the confidentiality of any such documents and by whom they may be seen, and in the absence of such an order the restrictions on the use of disclosure documents for the purposes of other proceedings shall continue to apply.

7. The parties shall have liberty to apply to the Comptroller for further directions and orders concerning the reference and the implementation of this Order, including directions with a view to ensuring that any rights that can be obtained or revived in countries or regional offices in which the said PCT application was not pursued to grant or are in the national or regional phase are obtained or revived to the maximum extent possible.

R C KENNELL

Deputy Director acting for the Comptroller

9 November 2006

SCHEDULE A

ASSIGNMENT OF APPLICATION

THIS ASSIGNMENT made this day of two thousand and six

BETWEEN University of Southampton, of Highfield, Southampton, Hampshire, SO9 5NH, United Kingdom (hereinafter called "the Assignor") of the first part AND;

I.D.A Limited, of Unit 4 Henson Road, Yarm Road Business Park, Darlington, Durham, DL1 4QD, United Kingdom (hereinafter called "the Assignee") of the second part.

WHEREAS the Assignor has made an application for a Patent in Australia, particulars of which are listed hereunder:

Australian Patent Application No. 2006202675

Entitled "A method and apparatus for controlling pests"

AND WHEREAS the Assignor has agreed to assign the invention the subject of the application, the application and any Letters Patent which may be granted in respect thereof or based upon the application to the Assignee.

NOW THIS DEED WITNESSETH that in consideration of the sum of $1.00 and other good and valuable consideration now paid by the Assignee to the Assignor the receipt whereof is hereby acknowledged the Assignor as beneficial owner hereby assigns to the Assignee the benefit of the invention, the application, and all the rights, powers, liberties and immunities arising or accrued therefrom free from all encumbrances and including the right to sue for damages and other remedies in respect of any infringement of the Letters Patent which may have accrued prior to the date hereof to the intent that the Letters Patent pursuant to the application shall be in the name of and shall vest in the Assignee.

IN WITNESS WHEREOF the parties hereto have executed this assignment as of the day and year first above written.

Signed, sealed and delivered for and on behalf of the said University of Southampton in the presence of:)

)

)_____

)

) **Name:**

)

) **Position:**

_____

Witness

Signed, sealed and delivered
for and on behalf of the said
I.D.A. Limited
in the presence of:

)
)
)
)
) **Name:**
)
) **Position:**

Witness

SCHEDULE B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Howse et al	
Serial No.: 09/736,023 National Stage of PCT/GB99/02090 Filed: 7/1/99	Art Unit: 3643
Title: A Method and Apparatus for Controlling Pests	Examiner: D. Ark
Attorney Docket No.:	

PETITION
REQUEST TO CORRECT INVENTORSHIP UNDER 37 C.F.R. 1.48

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The undersigned request correction of inventorship for the above referenced patent application to the inventorship set forth below:

Corrected Inventorship -

Philip Edwin Howse **(delete)**
14 Western Way,
Alverstoke Gosport PO12 2 NG
Great Britain
UK Citizen

Roger Edward Ashby **(delete)**
66 High Street,
Sidford, Devon EX10 9SQ
Great Britain
UK Citizen

Colin Thomas Metcalfe **(add)**
58 Earlsdon Avenue
Acklam, Cleveland TS5, 8JR
Great Britain
UK Citizen

I, Colin Thomas Metcalfe, state that the errors in inventorship in the above referenced patent application (of commission and omission) occurred without any deceptive intention on my part.

We, Phillip Edwin Howse and Roger Edward Ashby, state that the errors in inventorship in the above referenced patent application (of commission and omission) occurred without any deceptive intention on our part.

The University of Southampton, the assignees of Howse and Ashby, and IDA Ltd., the assignee of Metcalfe, hereby confirm and consent to this Petition and Request.

A Supplemental Declaration from the corrected inventor is attached.

The processing fee ($130.00) set forth in Section 17 (i) is attached.

Deleted Inventor's Signature: _____ Date: 4/10/06

Philip Edwin Howse

Deleted Inventor's Signature: _____ Date:
Philip H. Howse

Roger Edward Ashby

Added Inventor's Signature: _____ Date:
Roger E. Ashby

Colin Thomas Metcalfe

University of Southampton, Assignee of Howse and Ashby:

Name: _____ Title: _____

Date: _____ Authorised signature of UoS

IDA, Ltd., Assignee of Colin Metcalfe:

Name: _____ Title: Director

Date: 4.15.06 John L. Firth

PATENT APPLICATION ASSIGNMENT

THIS ASSIGNMENT, effective as of 2nd March 2006, between Philip Edwin Howse and Roger Edward Ashby, individuals residing in Great Britain, and The University of Southampton, a university organized under the laws of the country of Great Britain, with offices at _____, (hereinafter together referred to as ASSIGNORS); and I.D.A. Limited, a company organized under the laws of the country of Great Britain, with offices at _____, hereinafter referred to as ASSIGNEE):

WITNESSETH THAT;

WHEREAS, ASSIGNORS asserted right, title and interest in and to certain inventions, improvements and patent rights (hereinafter Invention) incorporated in a patent application filed in the Patent Office of the United States of America as a US national stage of PCT/GB99/02090, (said US national stage application believed filed on February 28, 2001, believed assigned US serial number 09/736,023 and believed entitled A Method and Apparatus for Controlling Pests;)

WHEREAS, Colin Thomas Metcalfe has been found, held and declared the sole inventor of the said Invention by the SUPREME COURT OF JUDICATURE, COURT OF APPEAL (CIVIL DIVISION) of Great Britain, in a Judgment dated 2nd March 2006;

WHEREAS, the said Colin Metcalfe has assigned all of his right, title and interest in and to said Invention, including all patent applications that may by filed based thereon and all patents that may issue thereof, to ASSIGNEE;

NOW THEREFORE: ASSIGNOR hereby assigns to ASSIGNEE all of its right, title and interest in and to the inventions and/or improvements set forth in said US national stage (believed assigned US Application Serial No. 09/736,023 and entitled A Method and Apparatus for Controlling Pests and filed 2/28/2001,) including the right to obtain United States patents thereon, including divisions, reissues, substitutions and continuations thereof.

IN WITNESS WHEREOF, ASSIGNOR has caused this agreement to be executed this __ day of _____, _____.

The University of Southampton

_____ _____

Date (Name)
(Job Title)

PLACE:)
) SS
COUNTRY OF:)

On this _____ day of _____, _____, before me personally came the above named _____ who is personally known by me or proved to me on the basis of satisfactory evidence to be the same individual who executed the foregoing assignment, and who acknowledged to me that he/she executed the same of his/her own free will for the use and purposes therein set forth.

NOTARY PUBLIC _____
My Commission Expires: _____

Philip Edwin Howse _____ Date _____

Roger Edward Ashby _____ Date _____

Notary for both

50180 assmt aft lit

SCHEDULE C

AFFIDAVIT	**DECLARAÇÃO**
We, **Roger Edward Ashby** and **Philip Edwin Howse**, Research Scientists, hereby declare before the Brazilian Patent and Trade Mark Office that we were incorrectly named as inventors in the PCT Application **PCT/GB99/02090** and consequently in the Brazilian National Phase Application **PI 9911813-0** and we agree that the correct inventor of PCT/GB99/02090 application is **Colin Thomas Metcalfe**, (occupation), with address at (complete with the full address) and thus consent that he be nominated as sole inventor for the said Patent Application.	Nós **Roger Edward Ashby** and **Philip Edwin Howse**, Cientistas Pesquisadores, por meio desta, declaramos perante o Instituto Nacional da Propriedade Industrial que nós fomos incorretamente nomeados como inventores no Pedido PCT **PCT/GB99/02090** e consequentemente no Pedido da Fase Nacional Brasileira **PI 9911813-0** e concordamos que o inventor correto para o pedido PCT/GB99/02090 é **Colin Thomas Metcalfe**, (occupation), com endereço em (complete with the full address) e assim concordamos que ele seja nomeado como único inventor para o dito Pedido de Patente.
In witness whereof, we have signed this declaration	Em fé do que, assinamos esta declaração

Roger Edward Ashby

(name)

(signature)

(place/local) *(date/data)*

Philip Edwin Howse

(name)

(signature)

(place/local) *(date/data)*

Colin Thomas Metcalfe

(name)

(signature)

(place/local) *(date/data)*

Page 2/2

This document must be notarized by a public notary and then legalized at the Brazilian Consulate.

Clarke, Modet & Cº

BRAZIL

Av. Marechal Câmara, 160, 12° andar (Edifício Le Bourget) - Centro - Rio de Janeiro, RJ - CEP 20020-080 BRAZIL Email:brj@clarkemodet.com.br

PATENT APPLICATION ASSIGNMENT

By this private instrument,
UNIVERSITY OF SOUTHAMPTON
established at
Highfield, Southampton, SO17 1BJ GB

before the two witnesses qualified below, assigns and transfers all rights related to its (their) patent application(s) entitled **A method and apparatus for controlling pests**

filed under No(s). **PI 9911813-0**

On **July 01, 1999**

before the INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL (The Brazilian Patent and Trade Mark Office) to
IDA Ltd.

established at (please complete with the full address)
Unit 4 Henson Road, Yarm Road Business Park, Darlington, Durham, DL1 4QD, GB

The above-mentioned Assignee receives this authorized Assignment to apply on its behalf for the necessary transfer with the INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL.

This being true, this document is signed by the Assignor and by the Assignee before the witnesses referred to below.

CESSÃO DE PEDIDO DE PATENTE

Por este instrumento particular,
UNIVERSITY OF SOUTHAMPTON
estabelecida em
Highfield, Southampton, SO17 1BJ GB

perante as duas testemunhas abaixo qualificadas, cede e transfere todos os direitos relativos a(s) seu(s) pedido(s) de patente intitulado(s) **Método de aprisionamento ou de eliminação de pragas, composição pesticida em forma de partículas, e armadilha para insetos.**
depositado(s) sob No(s). **PI 9911813-0**

Em **01 de Julho de 1999**

perante o INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL (a repartição brasileira de patentes e marcas) a
IDA Ltd.

estabelecida em (please complete with the full address)
Unit 4 Henson Road, Yarm Road Business Park, Darlington, Durham, DL1 4QD, GB

A Cessionária acima mencionada recebe esta competente Cessão para requerer em seu nome a necessária transferência junto ao INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL.

Em testemunho do que precede, este documento, assinado pelo Cedente e pela Cessionária perante as testemunhas abaixo referidas.

ASSIGNOR CEDENTE	name nome	nationality nacionalidade	profession profissão
	place and date local e data	signature assinatura	
ASSIGNEE CESSIONÁRIA	name nome	nationality nacionalidade	profession profissão
	place and date local e data	signature assinatura	
WITNESS TESTEMUNHA	name nome	nationality nacionalidade	profession profissão
	place and date local e data	signature assinatura	
WITNESS TESTEMUNHA	name nome	nationality nacionalidade	profession profissão
	place and date local e data	signature assinatura	

This document must be notarized by a public notary and then legalized at the Brazilian Consulate.