

BL O/105/07

17th April 2007

PATENTS ACT 1977

BETWEEN

James Duncan Kelly Kwok Wai Chiu

Claimants

and

GE Healthcare Ltd

Defendant

PROCEEDINGS

Claim for compensation under section 40 of the Patents Act 1977 in respect of patents EP 0311352 and EP 0337654 and related patents

HEARING OFFICER

P Hayward

DECISION

- The claimants, Dr Kelly and Dr Chiu, have applied for compensation under section 40 of the Patents Act 1977 on the grounds that two families of patents have been of outstanding benefit to their former employer, GE Healthcare Limited (previously Amersham International plc). The European members of the two families are EP 0311352 and EP 0337654, but there are equivalent patents in a number of countries across the world. Dr Kelly and Dr Chiu are two of the named inventors for each family.
- The proceedings are fairly well advanced. Each side has filed its evidence in chief, and in the normal course of events, the claimants would file their evidence in reply and the case would proceed to a hearing. However, both sides have now concluded that they would prefer to continue the case in court rather than before the comptroller. They have therefore asked me to exercise my powers under section 40(5) and decline to deal with it.
- It would be perverse of me to insist on going ahead when both sides have asked me not to, so accordingly I agree to their request and decline to deal with the application for compensation. The parties should note that this does not

automatically transfer the action to the High Court – the claimants will need to launch an action in the court. However, it should not be necessary to start from scratch because it should be possible for all the evidence filed before the comptroller to be transferred into the court proceedings.

There remains the question of costs. Assuming the evidence gets transferred, I would expect the High Court to treat the costs incurred by the parties so far as costs in the court proceedings. If, and only if, that does not happen, either side is at liberty to come back to the comptroller, after the proceedings have been disposed of by the court, to seek an order for costs.

P HAYWARD

Divisional Director acting for the Comptroller