INTELLECTUAL PROPERTY OFFICE

BL O/040/09

11 February 2009

PATENTS ACT 1977

PARTIES Lancaster University Business Enterprises Limited and the University of Lancaster

PROCEEDINGS

Reference under section 12(1)(a) of the Patents Act 1977 in respect of patent application number PCT/GB2007/002611

HEARING OFFICER S M WILLIAMS

DECISION

Introduction

1 International patent application number PCT/GB2007/002611 was filed on 12 July 2007 in the name of University of Lancaster (UL) for all designated states except the US. For the US, Michael Richard Roberts, Nigel Duncan Paul, Jane Elizabeth Taylor, Patricia Croft and Jason Paul Moore were named as both applicants and inventors.

2 Lancaster University Business Enterprises Limited (LUBEL) have now filed proceedings under section 12(1)(a) of the Patents Act 1977 requesting that an order be made *ex tunc* by the comptroller for the PCT application to proceed in their name.

3 The reference itself stands unopposed as attested by declarations from UL and each of the named inventors.

4 In their statement of grounds, the claimant comments specifically on the relief sought. They note, for example, that section 12 of the Patents Act 1977 appears to permit the comptroller to make any such orders he thinks fit to give effect to the determination and that there is no requirement that such orders be *ex nunc*. They point out that third parties would not be adversely affected by the order being sought and add that in principle an alternative permissible order would be the filing of a new replacement PCT application in the name of LUBEL with a deemed filing date of the pending PCT application. However given that the reference is unopposed, they say that this approach would complicate matters unnecessarily.

Background

5 The facts of this case as set out in the claimant's statement can be summarised as follows. On 13 July 2006 patent application number GB 06313901.8 was filed in the name of University of Lancaster (UL). The PCT application filed on 12 July 2007 claims priority from the GB application. On 21 July 2006, UL assigned patent application number GB 0631301.8 to its wholly owned subsidiary LUBEL. The assignment transferred the right to apply for, prosecute and obtain patent or similar protection throughout the world for the intellectual property covered in application number GB 0613901.8 and included the right to claim priority therefrom. Based on the assignment, LUBEL claim that they, and not UL, are entitled to be named as applicant for all designated states except the US in respect of international patent application number PCT/GB2007/002611. They also point out that it was always the intention of both these closely related parties to file the PCT application in the name of LUBEL and that the application was filed in the name of UL as a result of an oversight.

The Law

6 The reference has been made under section 12(1)(a), the relevant part of which reads:

Section 12

12.(1) At any time before a patent has been granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not an application has been made) –

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) [not relevant]

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

The reference

7 In support of the reference, evidence in the form of a witness statement has been provided on behalf of LUBEL by Roderick O'Brien, Director of LUBEL. In his witness statement, Mr O'Brien confirms the facts set out above. A witness statement has also been filed by Máire Nolan, Contracts Manager at Lancaster University on behalf of UL. As well as consenting to the reference, Ms Nolan states that UL always intended LUBEL to be named as applicant for patent application number PCT/GB2007/002611 and confirms that an oversight was made resulting in UL being named as applicant in place of LUBEL. For their part, each of the inventors named in the PCT application have also confirmed that they consent to the reference.

Findings

8 In view of the evidence filed, I conclude that all the relevant parties agree that international patent application number PCT/GB2007/002166 should proceed in the name of Lancaster University Business Enterprises Limited and indeed

should be treated as having been originally filed by LUBEL.

Declaration

9 In terms of the order requested, section 12(1) provides the comptroller with broad powers, as the claimants have pointed out. I therefore declare that international patent application number PCT/GB2007/002166 be treated for each jurisdiction designated as having been filed by Lancaster University Business Enterprises Limited on 12 July 2007 and that Lancaster University Business Enterprises Limited is entitled to the invention the subject of the international application . As such, the claimant may use this declaration in support of a request to the International Bureau on this matter or to any national and /or regional authority in respect of any national and/or regional phase application(s) the international application matures into.

S M WILLIAMS
B3 Head of Litigation Section, acting for Comptroller