



20 February 2009

PATENTS ACT 1977

PARTIES The Australian National University and
 The Commonwealth of Australia

PROCEEDINGS
 Reference under section 37(1)(a) of the
 Patents Act 1977 in respect of
 patent number GB 2406396

HEARING OFFICER S M WILLIAMS

DECISION

Introduction

- 1 Patent number GB 2406396 was granted on 7 June 2006 and named The Commonwealth of Australia as the sole patent proprietor. The patent originated as a PCT application (international patent application number PCT/AU2003/000915) and named The Commonwealth of Australia as the sole applicant for all designated states except the US. Javaan Singh Chahl, Friedrich Gert Stange and Naig Le Bouffant were named as joint inventors.
- 2 The Australian National University (ANU) has now filed a reference under section 37(1)(a) of the Patents Act 1977 to the effect that they should be named as co-proprietor by virtue of the employment of Friedrich Gert Stange and an assignment agreement with Naig Le Bouffant.
- 3 In support of the reference, a Statutory Declaration has been filed by Anthony Alan Lee of Madderns Patent and Trade Mark Attorneys, the Australian representatives of The Commonwealth of Australia.
- 4 Statutory Declarations have also been filed by Debra Anne Barnett, the Defence Patents Officer for the Business and Commercialisation Office of the Australian Defence Science and Technology Organisation (DSTO), on behalf of The Commonwealth of Australia, and Lawrence Edward Cram, Deputy Vice-Chancellor of The Australian National University. Ms Barnett and Mr Cram have both confirmed that Mr Lee's Declaration properly reflects the circumstances governing the entitlement of the ANU to be named as a co-proprietor of patent number GB 2406396.

5 Each of the named inventors were sent a copy of the reference and were invited to file a counter-statement if they wished to object to it. No response has been received. Therefore I must treat them as supporting the claimant's case as required by rule 77(9) of the Patents Rules 2007. This rule says:

77(9) Where-

(a) a person was notified under paragraph (1) or (2); and

(b) that person fails to file a counter-statement under paragraph (6) or (8), the comptroller shall treat him as supporting the claimant's case.

6 On 22 December 2008 the Office wrote to each of the inventors and advised them that in the absence of a counter-statement, the proceedings would be treated as unopposed. Accordingly in the absence of any counter-statements and in view of the declarations filed, the reference stands as uncontested.

Background

7 The facts of this case as set out in the Statutory Declaration of Anthony Alan Lee are as follows.

8 In May 2002, Madderns Patent and Trade Mark Attorneys were instructed by the Defence Science and Technology Organisation (DSTO) Business Office acting for and on behalf of The Commonwealth of Australia to prepare and file an Australian provisional patent application directed to a novel method and means for reducing the effects of a source of electromagnetic radiation when viewing a scene that contained this source of electromagnetic radiation. Mr Lee explains that the DSTO is The Commonwealth of Australia's body responsible for scientific research and development that may have defence applications.

9 The provisional application was prepared largely on the basis of an invention disclosure statement entitled "New Technology - An Optical Stabilization System" prepared by the inventors:

- Javann Chahl, an employee of DSTO and hence The Commonwealth of Australia and who at the time was located at The Australian National University (ANU) in Canberra, Australia
- Friedrich Gert Stange who at the relevant time was an employee of the ANU and
- Naig Le Bouffant, who at the relevant time was a student of the ANU

10 Mr Lee states that since 1996 there have been a number of contracts in place whereby the DSTO (ie The Commonwealth of Australia) and similar US Government entities have funded research conducted jointly by the ANU and DSTO into the particular area of technology referred to above.

11 The provisional application entitled "Optical Stabilization System" was duly filed with the Australian Patent Office on 19 July 2002. The Commonwealth of Australia was listed as the assignee pursuant to what was thought at that time to be the terms of the funding contracts and hence was named as the applicant in the provisional application. As there was no requirement to name the inventors at this time, no assignment agreements were prepared. The provisional

application was allocated Australian patent application No. 2002950271.

- 12 The PCT application was filed on 18 July 2003. Again, as there was no requirement to lodge assignment agreements at this stage, no such agreements were filed with the International Bureau.
- 13 On 7 January 2005, instructions were sent to Urquart-Dykes & Lord LLP (UDL) instructing them to initiate the national phase of the PCT application in the UK. The application entered the national phase on 11 January 2005 under application number GB 0500437.9.
- 14 During the course of preparing assignment agreements for the counterpart Canadian and US applications which entered the national phase in Canada on 11 January 2005 and the United States on 18 January 2005 respectively, it became apparent that the assignment of Friedrich Gert Stange's and Naig Le Bouffant's rights in the invention was not necessarily clear and /or governed by the terms of the funding contracts.
- 15 Having sought legal advice and following further commercial negotiations, the Commonwealth of Australia and the ANU agreed in March 2006 that each of the Canadian, US, UK and Australian applications should continue in joint names and that the ANU should have been named as an applicant in the original PCT application by virtue of the employment of Friedrich Gert Stange and an assignment agreement with Naig Le Bouffant.
- 16 The Commonwealth of Australia, through the DSTO Business Office, then instructed Mr Lee to commence adding the ANU as a co-applicant to the Australian application and the UK, Canadian and US applications. UDL acting on behalf of the ANU subsequently filed the current reference under section 37 of the Patents Act 1977, the UK application having proceeded to grant.
- 17 Mr Lee states that any rights to the invention the subject matter of the PCT application (and hence the UK patent) of the inventor Jaavan Chahl will automatically devolve in accordance with Australian law to The Commonwealth of Australia by virtue of the employer/employee relationship between Jaavan Chahl and The Commonwealth of Australia at the time of the invention. Similarly any rights of the inventor Freidrich Gert Stange will devolve to the ANU by virtue of the employer/employee relationship that existed between them at the time of the invention. With regard to the inventor Naig Le Bouffant, any rights to the invention the subject matter of the PCT application (and hence the UK patent) will devolve in accordance with Australian law to the ANU by virtue of an assignment agreement which assigned her rights in any intellectual property developed in her capacity as a student of the ANU at the time of the invention to the ANU.
- 18 Mr Lee further states that as a result of the ANU having rights in the invention the subject matter of the PCT application, the ANU should have been named as an applicant on the original PCT request form pertaining to the PCT application.

The law

- 19 The question of entitlement to UK granted patents is governed by section 37, the relevant part of which states:

Section 37

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) ..

(c) ..

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

Findings and Order

- 20 In view of the absence of any counter-statement, I accept the facts of the case as set out in Mr Lee's Statutory Declaration and supported by Debra Anne Barnett and Lawrence Edward Cram. I therefore find that The Australian National University should be named as a co-proprietor in respect of patent number GB 2406396.
- 21 Accordingly I order that The Australian National University should be named as co-proprietor with The Commonwealth of Australia in respect of patent number GB 2406396 and direct that the register be rectified to reflect this order and an addendum for the patent be prepared.

S M WILLIAMS

B3 Head of Litigation Section, acting for Comptroller