

BL O/401/10

18 November 2010

### **PATENTS ACT 1977**

APPLICANT Mr Nigel Melling

ISSUE Whether Section 117 may be used to correct the Register of Patents in respect

of GB 2383533B

HEARING OFFICER Mrs S E Chalmers

### **DECISION**

- GB 2383533B was granted on 3 March 2004 naming Mr David Birkett and Mr William Anthony Butler as the joint proprietors and inventors. On 27 July 2009, Mr Melling filed a request under section 117 to correct the Patent Register to name himself as the sole proprietor. Mr Melling subsequently amended that request in his letter dated 25 January 2010 to name himself as the sole proprietor and inventor. In a further letter of 3 September 2010, he requested that he be named as the sole inventor.
- From the outset, the Office considered Mr Melling's request went beyond the scope of section 117 and took the view that it was concerned essentially with who is entitled to be named as the patent proprietor. The Office wrote to Mr Melling on 19 November 2009 stating that it was unable to action his request and advised him that he needed to file entitlement proceedings under section 37 if he disputed ownership of the patent. Following further correspondence, the Office wrote again to Mr Melling on 29 January 2010 setting out its preliminary view that his request was not allowable under section 117. This letter also gave information on inventorship and entitlement proceedings. Mr Melling replied on 3 September re-iterating his request for correction of the Register.
- The Office's letter of 30 September invited Mr Melling to ask for a hearing and, in the absence of a reply, the matter has come to me for a decision on the papers. For the purpose of this decision, I shall assume that Mr Melling is asking for the Register to be corrected to show him as the sole inventor in accordance with his letter of 3 September 2010.

#### The law

4 Section 117 is concerned with the correction of errors in specifications and in other documents filed in connection with patents and applications:

**Section 117(1)** The comptroller may, subject to any provision of rules, correct any error of translation or transcription, **clerical** [emphasis added] error or mistake in any specification

of a patent or application for a patent or any document filed in connection with a patent or such an application.

# **Analysis**

- From inspection of the case file, it is clear that Mr Melling's request is the latest round in a long running dispute stretching back to 2005 over who owns the patent. Furthermore, it is equally clear that Mr Melling is firmly of the view that his request relates to correction of an administrative error and is non-contentious. I also note that he has filed no evidence to support his request.
- It is true that section 117 is concerned with the correction of errors in specifications and in other documents filed in connection with patents and applications. However, the essential point is that this section deals with **clerical** errors or mistakes. For example, section 117 may be used to correct a spelling mistake in a name and the Register of Patents will be updated accordingly if the correction is allowed.
- Contrary to Mr Melling's belief, section 117 cannot be used as the way to substitute one named inventor or proprietor for another as this goes far beyond what is meant by a correction of a clerical or "administrative" error (to use Mr Melling's word). If I were to allow his request, the effect of my decision would be to deprive Mr Birkett and Mr Butler of their rights as named inventors without giving them an opportunity to challenge Mr Melling's assertions. To do so would be contrary to natural justice. I therefore refuse the request.
- In my view, this request is essentially about who is entitled to be named as the inventor in patent GB 2383533B. If so, then the proper course for Mr Melling, if he wishes to pursue that issue, is for him to file proceedings under section 13(3) which is the section of the Patents Act concerned with the removal of an inventor mentioned in a patent. I should add that, in the event I have misunderstood Mr Melling's request and he is seeking also to be named as the sole proprietor of the patent, I would also refuse that request under section 117. The proper course of redress in that instance is for him to file proceedings under section 37 as he is already aware.

#### **Decision**

I refuse Mr Melling's request under section 117 to correct the Register of Patents to name him as the sole inventor in respect of patent GB 2383533B.

# Appeal

10 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days. I would strongly urge Mr Melling to think carefully before pursuing this course of action as the costs are likely to be high should he be unsuccessful.

# MRS S E CHALMERS

Deputy Director acting for the Comptroller