



15 July 2011

PATENTS ACT 1977

BETWEEN

David Rose

Claimant

and

Ability International Limited

Defendant

PROCEEDINGS

Reference under section 37 of the Patents Act 1977 in
respect of patent number GB 2432573B

HEARING OFFICER

A C Howard

DECISION

Introduction

- 1 These proceedings are concerned with who is entitled to patent GB 2432573 (“the patent”) which was filed on 23 November 2005 and granted on 27 May 2009. The original application was filed in the name of the defendant company Ability International Limited (“Ability”) naming Mr Michael Holborn and Mr Graham Alston as inventors. A corrected Form 7 was filed on 5 December 2008 naming the claimant Mr Rose as an additional inventor, although the proprietorship details were not changed.
- 2 These proceedings were launched on 29 April 2010 by Mr Rose, who claims he should be named as a proprietor of the patent on the ground that he is an inventor. This is resisted by Ability, who say that Mr Rose is not an inventor, notwithstanding that he is named as such.
- 3 Prior to the hearing, I issued a Written Preliminary Evaluation to clarify the issues that needed to be addressed at the hearing. In particular, I drew the attention of the parties to the case law on entitlement and made the point that, having agreed to name him as inventor, it was for Ability to explain and prove that Mr Rose is not, in fact, an inventor.

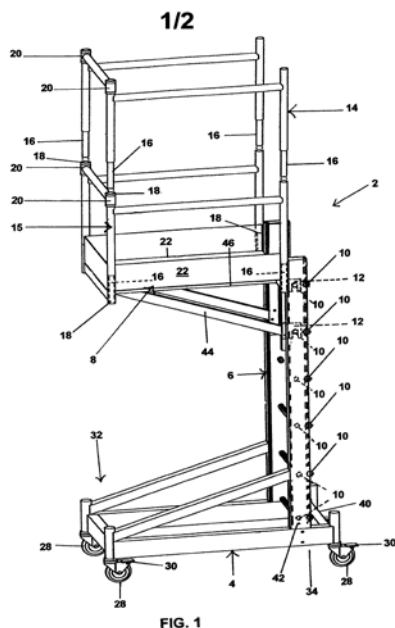
4 The case came before me at a hearing on 23rd and 24th March 2011. Stephen Carter of Mewburn Ellis appeared for the claimant and Alan Johnson of Bristows appeared for the defendants. Much of the two days was taken up with cross-examination of witnesses and this was of considerable assistance in my task.

The Patent

5 The patent is essentially concerned with providing equipment to allow overhead access especially in large open-plan offices where space is at a premium. Claim 1 of the patent reads:

Apparatus for permitting overhead access for a workperson, which apparatus comprises a base section, mast means which in use upstands from the base section, and a platform which is secured to the mast means remote from the base section, and the apparatus being such that in use the platform extends outwardly from the mast means, the base section extends underneath the platform and thereby enables the platform to be stable when occupied by the workperson, the base section is constructed so that it is able to extend underneath at least desk tops whereby the platform then provides access over desk areas, the mast means is a telescopic mast means which is adjustable in height in order to support the platform at different working heights, and the mast means includes rungs whereby the person is able to climb to the platform when the platform is at a desired height.

6 Typically, desks in an office are located back-to-back and crowded with computer and other equipment. To provide access to ceiling fittings and the ceiling void, scaffolding with platforms that bridge over the desk area often has to be used and requires at least two people to erect and dismantle it safely. The present invention seeks to overcome these drawbacks by providing apparatus for overhead access which comprises a base, a height-adjustable mast upstanding from the base and a platform secured to the mast which extends over the base. An embodiment is shown in the following figure.



7 The apparatus is such that, in use, base 4 is positioned underneath platform 8

and is constructed so that base 4 can extend under a desk and the platform provides overhead access above the desk. Mast 6 is telescopic to support platform 8 at different working heights and includes rungs 10 which the worker can climb when the platform is at the desired height. The apparatus is typically narrow so that it can pass through doorways and enter lifts and can be moved and operated by one person.

Background

- 8 Mr Rose was appointed in 2002 as a contract manager with Norland Managed Services. It is common ground that in 2003 or thereabouts, he contacted Mr Holborn of Ability, a specialist supplier of access equipment, to discuss a possible solution to problems relating to over desk access being experienced on site. Mr Rose purchased some Folding Steps on Ability's advice but these proved to be ineffective and were returned.
- 9 In view of impending changes to the Health and Safety Working at Height Regulations due to take effect in April 2005, Mr Rose contacted Mr Holborn again in late 2004 to enquire about suitable equipment for over desk access. Although the details of Mr Holborn's response to this enquiry are not agreed, it is clear that there was nothing on the market suitable for precisely what Mr Rose had in mind.
- 10 Mr Rose says that he had some ideas of his own about how to solve the problem and asked whether if he drew something up, Mr Holborn could make it. According to Mr Rose, Mr Holborn agreed to this and a site visit was subsequently arranged at the premises of Schrodgers, the client of Norland where Mr Rose was based. Mr Holborn fixes the date of this meeting as 27 April 2005. It is common ground that Mr Holborn and Mr Rose were present although accounts differ over who else participated.
- 11 Whether or not Mr Rose actually took a sketch to the meeting is not clear; evidence from one of Mr Rose's colleagues (Lee Fredericks) suggests that drawings existed prior to the meeting, but it seems that they are either lost or no longer exist. Mr Holborn asserts that sketches were prepared on the spot, and his evidence includes what he says is a page from his note book bearing drawings and notes. The provenance of one of these drawings was the focus of considerable attention in the hearing and it is argued that it was contributed to by both Mr Rose and Mr Holborn. In any event it is clear that Mr Holborn went away from the meeting armed with at least one sketch which he passed to his employee Graham Alston (the other inventor named in the original application) with the intention of producing a prototype.
- 12 Mr Holborn says that he and Mr Alston delivered a prototype of what became known as the "Desksurfer" to Mr Rose and Mr Fredericks on 2 September 2005. This was followed by email communication in the course of which Mr Rose passed feedback to Mr Holborn and asked for some alterations and additions. These included a better means to raise the mast section rather than the rope and pulley arrangement then fitted; and a seat to enable some operations to be carried out in a sitting position. Once these issues had been addressed, orders for four units were placed with Ability. Mr Rose was promoted before the units were delivered but he was informed by former colleagues that they were proving

to be a great success, being actively used daily with greatly improved time efficiencies.

- 13 Mr Rose says that he felt a great sense of pride and excitement at the large part he had played in the design and development the Desksurfer. He says he would mention the unit to colleagues at every opportunity and would point out his name on the Ability literature as proof of his involvement. Many managers did purchase units and gave positive feedback on their performance which deepened his sense of pride.
- 14 In 2008, Mr Rose came into contact with Mr Holborn again and learned of the patent application which had been filed by Ability in November 2005. He says that over the following weeks he became increasingly disappointed that he had not been approached or considered to be included in the patent application process, to the point where he telephoned Mr Holborn and told him that he felt “mised, overlooked and cheated”. As a result, Mr Holborn offered to have him acknowledged in the patent application (and the resultant patent) as an inventor, although Mr Holborn now says that he did not do this in the belief that Mr Rose was a true inventor, but simply to get Mr Rose off his back, and he now realizes this was an error. Mr Alston’s witness statement says that he thought Mr Holborn was making a huge mistake and that Mr Rose did not deserve any recognition as he had contributed nothing to the invention.
- 15 In subsequent discussions, Mr Rose unsuccessfully attempted to reach an agreement with Mr Holborn about a potential commercial arrangement, following which he launched these proceedings.

The law

- 16 The procedural rules applicable to these proceedings are set out in Part 7 of the Patents Rules 2007.
- 17 The claim is brought under section 37 of the Patents Act 1977 (“the Act”), section 1 of which reads:

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) whether the patent should have been granted to the person or persons to whom it was granted, or

(c) whether any right in or under the patent should be transferred or granted to any other person or persons;

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

- 18 The defendant is also relying on the provisions of section 39 of the Act which reads:

(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as

between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if –

(a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

19 Section 7 of the Act sets out who is entitled to be granted a patent. The relevant paragraphs read as follows:

7(2) A patent for an invention may be granted –

(a) primarily to the inventor or joint inventors;

(b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;

(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned; and to no other person.

7(3) In this Act “inventor” in relation to an invention means the actual deviser of the invention and “joint inventor” shall be construed accordingly.

20 These provisions have been interpreted by Hoffman LJ. In *Yeda*¹. In paragraphs 18-20 of *Yeda*, he states that:

S7(2) and the definition in s7(3), are in my opinion an exhaustive code for determining who is entitled to the grant of a patent. That is made clear by the words “and to no other person”. In saying that the patent may be granted “primarily” to the inventor, s7(2) emphasises that a patent may be granted only to the inventor or someone claiming through him. The claim through an inventor may be made under one of the rules mentioned in paragraph (b), by which someone may be entitled to patent an invention which has been made by someone else (the right of an employer under s39 is the most obvious example) or the claim may be made under paragraph (c) as successor in title to an inventor or to someone entitled under paragraph (b).

In my opinion, therefore, the first step in any dispute over entitlement must be to decide who was the inventor or inventors of the claimed invention. Only when that question has been decided can one consider whether someone else may be entitled under paragraphs (b) or (c). In many casesthere will be no issue about paragraphs (b) or (c).

¹ *Yeda Research and Development Company Limited (Appellants) v. Rhone-Poulenc Rorer International Holdings Inc and others (Respondents)* [2007] UKHL 43.

The inventor is defined in s7(3) as “the actual devisor of the invention”. The word “actual” denotes a contrast with a deemed or pretended devisor of the invention; it means, as Laddie J. said in *University of Southampton’s Application* [2005] RPC 11[39], the natural person who “came up with the inventive concept”. It is not enough that someone contributed to the claims, because they may include non-patentable integers derived from prior art: see *Henry Brothers (Magherafelt) Ltd v Ministry of Defence* [1997] RPC 693, 706; [1999] RPC 442. As Laddie J. said in the *University of Southampton* case, the “contribution must be to the formulation of the inventive concept”. Deciding upon inventorship will therefore involve assessing the evidence adduced by the parties as to the nature of the inventive concept and who contributed to it. In some cases this may be quite complex because the inventive concept is a relationship of discontinuity between the claimed invention and the prior art. Inventors themselves will often not know exactly where it lies.

21 Thus, *Yeda* at paragraph 20 emphasises a two-step approach to determine inventorship. One must first identify the inventive concept and then determine who devised that concept. The inventor is defined in section 7(3) as “the actual devisor of the invention”. The inventor is the natural person who “came up with the inventive concept” and the “contribution must be to the formulation of the inventive concept”. It is not enough that someone contributed to the claims, because they may include non-patentable integers derived from prior art.

22 In *Henry Brothers* at 706, Jacob J. says:

“Thus argues Mr Pumfrey, anyone who contributes to the claim in a substantial way must be regarded as an inventor. Mr Pumfrey would exclude merely an author of the prior art of an improvement invention on the grounds that he took no part in the actual devising. What is critical, says Mr Pumfrey, is whether an alleged co-inventor took part in the actual devising of a significant extent. I do not agree. I do not think it right to divide up the claim for an invention which consists of a combination of elements and then to seek to identify who contributed which element. I think the inquiry is more fundamental than that. One must seek to identify who in substance made the combination. Who was responsible for the inventive concept, namely the combination? That was solely Mr Z. It was his idea which turned a useless collection of elements into something which would work.”

23 Further guidance on the approach to identify the inventive concept is offered by *Stanelco Fibre Optics Ltd’s Applications* [2005] RPC 15. At paragraph 15A we are told:

“It is clear that a mechanistic, element by element approach to inventorship will not produce a fair result. If A discloses a new idea to B whose only suggestion is to paint it pink, B should not be a joint inventor of a patent for A’s product painted pink. That is because the additional feature does not really create a new inventive concept at all. The feature is merely a claim limitation, adequate to overcome a bare novelty objection, but having no substantial bearing on the inventive concept.Some stripping of the verbiage may be necessary to determine the inventive concept, and consequently the inventor. But one must keep in mind that it is the inventive concept or concepts as put forward in the patent with which one is concerned, not their inventiveness in relation to the state of the art.”

24 Thus, I shall first of all need to determine the inventive concept of the patent and then go on to identify who devised that concept. If it is determined that Mr Rose is not an inventor, his case will be over at that point. But if he is an inventor, I shall need to determine his employment status *at the time when the invention was devised*, this being the material time rather than the time the application was actually filed.

25 In my written preliminary evaluation I observed that in a case such as this, the

starting point is the presumption that what is shown in the Register as regards inventorship and proprietorship is true, and it will be for a party seeking to overturn any part of this to prove their case. Neither party has taken issue with this. The present reference is somewhat unusual in that the defendant's case is that Mr Rose did not devise the invention even though he has been named as an inventor and that is reflected in the Register. Accordingly the burden of proof is on the defendant to prove through the evidence adduced that Mr Rose did not devise the invention. Likewise, assuming it continues to be Mr Rose's case that Ability did not somehow derive title from him (which the corrected Form 7 states is "by virtue of agreement"), he must prove this if I am to find him to be entitled to an interest in the patent. The standard of proof in all cases is the balance of probabilities.

The evidence

- 26 In addition to statements from Mr Rose, Mr Fredericks, Mr Holborn and Mr Alston, written statements have been provided from Ms Noreen Mehmood and Mr Ken Greene for the claimant and by Mr Christopher Russell and Mr Christopher Donovan for the defendants.
- 27 It was agreed between the parties before the hearing that Mr Rose, Mr Fredericks and Mr Holborn would be cross-examined; that the evidence of Messrs Alston, Donovan and Russell would stand as unchallenged; and that submissions on the reliability of the statements by Ms Mehmood and Mr Green could be made in closing statements, notwithstanding that no cross-examination of these witnesses had taken place. In the event Mr Alston was also cross-examined, by agreement between the parties.
- 28 Mr Rose came across as a down to earth person but when challenged under cross-examination as to precisely what happened in the run up to and at the meeting at Schrodgers, his answers became vague and at odds with his written statements. For example, he changed his story as to who attended this meeting and much of his evidence was qualified by the use of "would have" and "might have". I did not get the impression that he was being deliberately untruthful or evasive, but I did feel that his responses were coloured by his firm belief that the Desksurfer was his baby. Accordingly, I conclude that I must treat his evidence with care.
- 29 Mr Holborn gave his evidence clearly and precisely and was well-prepared. There were no inconsistencies in his evidence. He came across as a credible witness, confident in dealing with the technical and engineering issues.
- 30 Mr Fredericks was employed as part of Mr Rose's team both before and after the genesis of the Desksurfer and was involved in the trialling of the prototype. He came across as an honest and credible witness but his evidence added little of substance to that given by Mr Rose.
- 31 Mr Alston came across as honest and helpful. He answered in a measured way and would not be drawn into making unsubstantiated statements. His evidence included his view as to the provenance of the sketch drawn at the meeting at Schrodgers, and when pressed as to who he thought drew the sketch, he agreed

that he was as certain as he could be – based on his experience of seeing hundreds of drawings – that a key part was not consistent with Mr Holborn's style. While Mr Alston is clearly not in a position to give expert testimony on such matters, I am prepared to give his opinion some weight in the light of his experience of working with Mr Holborn.

32 Ms Mehmood worked with Mr Rose and, in her statement, says she attended a meeting with him and Mr Holborn. This is not corroborated by Mr Holborn.

33 Mr Greene worked a shift maintenance engineer with Mr Rose and, in his statement, says that Mr Rose asked him to test some ceiling access platforms that were provided by Ability and provide feedback which resulted in the Desksurfer. I have no reason to question his evidence, although it has been of only limited assistance to me in resolving the central question at issue.

34 Both Mr Donovan and Mr Russell worked with Mr Alston in the development of the Desksurfer. Their evidence corroborates that given by Mr Alston.

The inventive concept

35 It is clear from the authorities discussed above that any analysis of the inventive concept must take account of the state of knowledge at the time the invention was devised. In the present case, the following documents have been referred to:

GB 2404217: this discloses foldable access equipment where height adjustment of the platform is provided by mounting it on rungs of the ladder that it is used to access the platform. The base is mounted on castors and is said to be useful for "low level access".

WO 82/02570: this describes a portable lift having a mobile base assembly with a telescopic, multistage tower with a platform at its top and a ladder that extends and retracts as the tower is raised or lowered using a winch. The lift is said to be useful for construction or maintenance work.

US4015686: this shows a portable multi-stage lift for a platform having a winch-operated system to extend the lift operable from ground level or from the lift carriage. The lift is said to be useful for heavy construction or repair work at a working height of around 25 feet.

Exhibit MJSH-1: this shows a platform mounted on a telescopic mast on a base with castors where access is provided via steps with a telescopic handrail.

Exhibit MJSH-2: this shows a flat-pack unit for use with a Harrier jet to enable dressers to get access to the cockpit to plug in the pilot's equipment.

36 MJSH-1 and MJSH-2 are bespoke products manufactured by Ability that are mentioned in Mr Holborn's written evidence. Under cross-examination, he elaborated on their use. MJSH-1 relates to a unit to get access to fuel cells in a satellite which, according to Mr Holborn, would have been too big to fit into most offices or lifts. The task of MJSH-2 was to provide enough platform to

accommodate the pilot and the dresser and had to be flat-pack so that the “wash” of the aircraft would not blow it away and cause a hazard on runways.

- 37 Mr Holborn emphasised that both of these commissions were built to a customer brief and stressed that it was not in the nature of his company to be proactive. Quoting from the transcript Mr Holborn said:

“We need to look and fulfil the customer requirements and because we have done so many different schemes, we need to look at it afresh and not be influenced by previous work we have done.”

By that statement, I understand Mr Holborn to mean that it would not occur to him that something along the lines of these earlier products might be appropriate for Mr Rose.

- 38 Mr Holborn was also asked to comment on whether two of the above documents, (GB 2404217 and WO 82/02570), which were cited during the prosecution of the patent application, would be suitable for providing access over desks. He agreed that the structure of GB 2404217 could provide access over desks, but in his view it was primarily designed as podium steps so that work people had a platform rather than working off a stepladder. It was also made of scaffolding components ie tubular, and it did not have an adjustable mast. The unit of WO 82/02570 showed a platform that was raised using a cable and winch arrangement to extend a ladder but, in Mr Holborn’s view, was not suitable for providing over desk access. He also noted that the platform did not oversail the base to any great extent.

- 39 Mr Carter submitted to me that one should look at what was “the heart” of the invention to identify the inventive concept and argued that the relevant contribution was not necessarily the claimed feature that distinguished the invention from the prior art. He said that it was clear from the opening passages of the patent that it is concerned with addressing the problem of access over desks to light fittings at ceiling level and services in voids above ceiling tiles. The introductory portion of the patent went on to describe the problems associated with known apparatus for access over desks, in particular, ladders and the more commonly used scaffolding. The patent states that: “it is an aim of the present invention to reduce the abovementioned problem”. Mr Carter argued that the inventive concept must be identified with this aim of the invention firmly in mind. In particular, one must consider what it is about the problem that the inventor or inventors set out to address. This was how one found the “heart” of the invention.

- 40 In Mr Carter’s submission, the inventive concept lay in the provision of an apparatus for access to ceilings and above-ceiling voids over desks which has a base section that can extend underneath the desk, a mast that upstands from the base, and an adjustable height platform secured to and extending from the mast, over the base section (and therefore over the desk when the apparatus is in position). It was the recognition that such a “C-shaped” construction could solve the problem (*i.e.* how to provide over desk access), with which the patent was concerned that amounted to the inventive contribution. More specifically, it was the height adjustable C-shaped structure that lay at the heart of the invention.

Although the provision of a telescopic mast with rungs conferred novelty on claim 1, he argued that these were trivial features, well known in the art as exemplified by the documents cited by the examiner during prosecution of the application, and that this combination of features was therefore not part of the inventive concept.

- 41 Mr Carter highlighted that prior to the Desksurfer, scaffolding and folding steps were the two recognized ways of giving access over desks (which is not in dispute). Even though he acknowledged that the prior art (specifically the documents referred to above) disclosed generally C-shaped structures for other purposes, he argued that no-one had contemplated that sort of structure to solve the over desk access problem which was what the patent was concerned with; and it was that recognition that provided the inventive concept.
- 42 If the above formulation of the inventive concept were accepted, Mr Carter submitted that it followed that the dependent claims did not add anything of real substance to the inventive concept. The inventors could therefore be decided based on who contributed to the inventive concept of claim 1. If however, the inventive concept were found to lie in more specific details of the claimed apparatus, such as the rungs and the telescopic mast, then he submitted that the dependent claims took on more significance because many of them related to features that bore no particular relation to the telescopic mast or rungs. He therefore suggested that dependent claims 5 (guard rail) and claim 21 (seat) should be considered to add substance to the inventive concept.
- 43 Mr Johnson agreed that it was necessary to look at the specification as a whole to determine the inventive concept. However, he argued that this inventive concept must be judged by reference to the prior art so as to determine that part of the description and claims which were already known. Specifically, he said that we needed to look at the combination of elements in the patent and ask (using the words in *Henry Brothers*) who turned this “useless collection of elements into something that would work”.
- 44 Referring to GB 2404217 (which was cited during prosecution of the patent application), Mr Johnson noted that it disclosed a rigid structure comprising a foldable access platform mounted on a moveable base but did not have height adjustability. He therefore submitted that the provision of an adjustable mast with rungs was a key feature of the patent in suit. Looking at US 4015686 (which discloses a platform mounted on extendable nesting ladders and operated by a winch arrangement on the platform) and the prior used equipment at MJSH-1, again Mr Johnson highlighted that the distinguishing feature was the mast with rungs. He added that it was irrelevant that this equipment could not have been used over desks; he contended it was the apparatus – not the use – that was the subject of the enquiry.
- 45 Mr Johnson submitted that having the rungs on the mast was important for quite different reasons in terms of the particular application that Mr Rose was seeking at the time, namely, to get a piece of equipment physically into offices. Having an integral adjustable mast decreased the footprint substantially so as a practical matter it was important for the application. It was a reason why the design came to be as it was. In his view, Mr Carter’s formulation of the inventive concept,

which included no mention of rungs going up the mast, was no different from the use of the apparatus of US 4015686 to provide access over desks. He therefore dismissed Mr Carter's view of the inventive step as being too broad as it encompassed the prior art. At the very least, it should also include the combination of the mast with rungs. In particular, he submitted that Mr Carter's argument that the inventive concept lay in a second use for known equipment, which he likened to a second medical use claim of the form "a new use of a known substance for a new purpose", was wrong.

46 Mr Johnson further submitted that I did not need to consider any other claims of the patent beyond claim 1 as the inventive concept was embodied in claim 1. In particular, he argued that claim 5 could not amount to a contribution since the presence of a guard rail was mandatory by the relevant Health and Safety legislation and claim 21, the inclusion of a seat on the platform, was a design choice.

47 In considering this point, the first thing I should make clear is that the fact that the concept of the "C-shape" is known in other contexts in apparatus used to provide access at height, does not, it seems to me, necessarily exclude the possibility that it could be at the heart of an invention for providing over-the-desk access. I therefore accept Mr Carter's view of how I should approach the question and am not simply prepared to conclude without further thought that any elements conferring novelty on the claims over the prior art must be at the heart of the invention. The invention must, however, encompass at least those elements which, together, solve the problem which has been posed. In the present case, there is no dispute that apparatus for providing over-the-desk access has to be both compact and stable. For the reasons advanced by Mr Johnson, I believe that the elements which meet these needs comprise, in addition to the basic C-shaped configuration, the mast and rungs; all are known from the prior art separately but it is the combination which enables the apparatus in practice to fulfil its desired function. Here I would make a distinction with the guard rail, seat and other features of the subordinate claims. These features are not necessary for the apparatus to perform as required at its most basic level, and although they could conceivably form the basis for further inventive refinements, for the reasons put to me by Mr Johnson, I am satisfied they are non-inventive design features.

48 I therefore conclude that the inventive concept is the combination of the C-shaped structure with the mast and rungs.

Who devised the invention?

49 In order to answer this question it is necessary to focus on the events around the time of the on-site meeting between Mr Rose and Mr Holborn on 27 April 2005 and the subsequent development of the prototype. In this connection it seems to me that there are two main areas in respect of which evidential conflict will need to be resolved:

- a. Firstly, what transpired at the on-site meeting in April 2005, and in particular the provenance and relevance of the sketch in the centre of Ability's Exhibit MJSH-6, which Mr Holborn says is a page from his notebook.

- b. Secondly, the extent of each party's involvement in the development and refinement of the prototype.

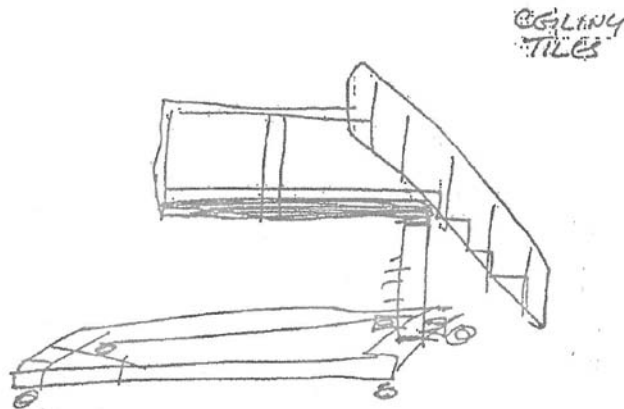
50 As I have said, the parties differ in their accounts of what happened at the April 2005 meeting. Mr Holborn says that he brought a set of Folding Steps to the meeting although Mr Rose says he has no recollection of this. Mr Holborn says he unfolded the steps by the desks and asked Mr Rose what he needed. Quoting from the transcript:

“Dave [Mr Rose] said, “There is the desk, there is the ceiling height”, and I [Mr Holborn] said, “Yes, what do you need?”. He said, “The platform is a bit small, can you give me more reach?”. I said, “Hold it, Dave”, I went back to my position, I got out my tape measure and measured his arm length and noted that down, and that was it.”

51 When giving evidence about the brief for the equipment, Mr Holborn said that the initial arm-over-the-desk basis provided the brief in the sense that he knew what the customer required. He and Mr Rose started to draft out ideas and it was this that gave rise to the sketches on Mr Holborn's notepad. The key thing, Mr Holborn said, was to take measurements of the desks and the ceiling heights which he did. He also asked questions about how the equipment would get to the desks and measured the lift dimensions. He added that Mr Rose pointed out that the equipment would also need to get down the narrow spaces between the chairs and office cabinets. All of these factors therefore determined the overall size of the product to ensure it could fit into the lift and go through the normal office doors.

52 Prior to the hearing, but after the issue of my Written Preliminary Evaluation, both parties had appeared to have agreed it was common ground that there was, and only ever had been, one sketch drawn by Mr Rose and communicated to Ability. However, at the hearing, it became apparent that things were not so clear-cut. Under cross-examination, Mr Rose stated that he had drafted a drawing in advance but could not remember whether he did or did not give that sketch to Mr Holborn. Also under cross-examination, Mr Fredericks said he recalled seeing a sketch done by Mr Rose but was unable to give any specific details.

53 At the hearing, the cross-examination of Mr Rose and Mr Holborn focussed on the sketch in the centre of exhibit MJSH-7 (which is an annotated copy of MJSH-6). The sketch (reproduced below) shows a platform with a guard rail and a set of inclined steps (both of which are highlighted in yellow in the exhibit) together with a base section and a mast.



- 54 Mr Rose stated unequivocally that he had drawn the whole of the drawing. When questioned about why he drew the angled steps, he said there were two options for getting an operator to the platform: either by an inclined set of steps or a vertical set of steps. He simply drew an angled ladder, conscious that the means of accessing a scaffold was by a vertical ladder. There was a flap on the platform that was pushed open to access the platform and closed once you reached it. Mr Rose agreed that the drawing on the bottom left hand side of the exhibit MJSH-7 (not reproduced above) was very similar to photographs of some steps (exhibit MJSH-1) manufactured by Ability around 4 years before. I note that these steps show a height-adjustable platform mounted on a telescopic mast mounted on a base with castors where access to the platform is provided by an inclined set of telescopic steps.
- 55 Mr Holborn disputed Mr Rose's claim to have drawn the whole of the sketch in the centre. He asserted the part relating to the mast and the base was his, saying that it was in his normal isometric style similar to the drawing on the bottom left hand side. However he accepted that the highlighted part of the sketch was definitely not in his style because the guard rail shown would not meet mandatory requirements and the details of the staircase were not feasible.
- 56 Mr Holborn said that the mast he envisaged at the time of the meeting was

“a mast section of either a round tube with another tube inside it, so it was telescopic or adjustable, and the little lines, or “ticks” that you see on the vertical part of the mast, are the location pins that would actually be the pegs, if you like, that went into the locating holes to extend the mast for the adjustment that was needed”.

He said that it ran through his mind (although he did not express it to Mr Rose) that putting the mast at the front of the base so the base extended backwards (as shown in the drawing) would need a counter-balanced arrangement that would be too heavy for one person to move. Mr Holborn added that he checked whether there was room to extend the base under the desk but there was a limit to how far you could extend the platform over the desk without running into a

tipping hazard.

- 57 Different parts of the drawing in the centre of MJSH-6 do appear to me to be in different styles. This is consistent with the view expressed by Mr Alston, and although it is denied by Mr Rose, his recollection of the events at that meeting is at best hazy. I therefore consider it to be more probable than not that the drawing in question is a work of joint authorship. In the light of Mr Holborn's testimony and given that the drawing is on a page from his own notebook, the conclusion I reach on the balance of probabilities is that Mr Rose and Mr Holborn both contributed, Mr Holborn having drawn at least the base portion which is in an isometric style.
- 58 While I believe that the drawing in the centre does amount to a disclosure of a "C-shaped" structure, it is not, however, clear to me that the configuration of the base was discussed in any detail at that site meeting. In particular, I note Mr Alston's evidence that "As I considered the sketches, I discounted the one in the centre of the page as it did not look in any way a practical proposition"; and Mr Donovan's unchallenged evidence that "the angled ladder was dropped at a very early stage of development to minimise the length of the base and to negate the problems of the instability inherent in the design". While I have no reason to doubt Mr Rose's contention that he had thought of a C-shaped configuration before the meeting, the evidence leads me to conclude on the balance of probabilities that the discussions that took place at the meeting focussed on an adjustable height platform that can oversail a desk, and did not include any substantive consideration of the base.
- 59 In addition, and importantly, no drawing in MJSH-6 shows the rungs which I have concluded are an essential component of the invention. All have inclined steps which would make the design unsuitable in practice for use in a crowded office environment and would make the base section far too long to fit into lifts.

Development of the prototype

- 60 According to Mr Rose's evidence there were communications concerning "specific dimensions, height requirements and other restrictions or improvements to ensure that the prototype was as effective and suitable as it could be". According to his witness statement, these comprise: using a winch to raise the mast rather than a rope and pulley; adding insulating sleeving to the platform handrails; adding a rubber mat to the platform tray; adding a seat to the platform; adjustment of the angle of the main supporting brace; adding an extension piece to the platform (not in fact done); making the guard rails adjustable in height; adding a guard chain across the end of the platform; provision of a tool storage facility; and adding insulation to the base unit.
- 61 Under cross-examination, Mr Holborn denied that Mr Rose had contributed anything of substance to the design process during this period (this has to be understood in the context of Mr Holborn's belief that the provision of a seat was a built-in customer requirement to make it more comfortable for the operator when working and that the other modifications requested by Mr Rose were merely design choices). This is corroborated by the evidence of Mr Alston and Mr Donovan. Thus, it appears to me that although there were clearly

communications between Mr Rose and Ability about features of the Desksurfer during this period, and these concerned some design features, the feature of the ladder and rungs was originated entirely within Mr Holborn's team, and this is accordingly the point at which the "collection of elements", comprising the C-shaped structure, the mast and the rungs, which together solve the problem of over-desk access, were turned into something which would work.

- 62 It is therefore my conclusion that Mr Rose did not contribute to the inventive concept and cannot therefore have any entitlement to the patent. In the light of this conclusion it is not necessary to consider the submissions I received as to his employment status at the time the invention was made.

Decision

- 63 I have found that Mr Rose is not entitled to any rights in the patent. His claim under section 37(1) to be named as a proprietor therefore fails and I make no order for the amendment of the Register.

Costs

- 64 At the hearing, both sides indicated that they were content for me to award costs to the winning party based on the Comptroller's scale. On that basis I award the sum of £2,500 to Ability and accordingly order Mr Rose to pay Ability the sum of £2,500 as a contribution to its costs. This sum should be paid within 7 days of the expiry of the appeal period below. Payment will be suspended in the event of an appeal.

Appeal

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

A C HOWARD

Divisional Director acting for the Comptroller