



PATENTS ACT 1977

CLAIMANT Brian Clarke & Strumat Limited
RESPONDENT Globally Greener Solutions Limited
ISSUE Reference under section 37 in respect
of EP1409166
HEARING OFFICER H Jones

DECISION

Introduction

- 1 This is a reference under section 37 by Brian Clarke and Strumat Limited regarding ownership of European patent EP1409166 (and all its derivatives), which was granted to Globally Greener Solutions Limited on 10th February 2010. There is no dispute concerning who devised the invention the subject of the patent: the inventor is Peter Thomas, who filed the application through the PCT route in the name of Strumat Limited on 3rd July 2002 (with a claim to priority from a UK patent application filed on 3rd July 2001).
- 2 From the various statements and exhibits submitted as part of this reference, it would appear that Brian Clarke became a shareholder in Strumat Limited after the PCT patent application was filed. Mr Clarke alleges that rights in the application were transferred by Peter Thomas, the inventor and the then Managing Director of Strumat Limited, to Globally Greener Solutions Limited without his knowledge and contrary to Strumat Limited's Shareholder Agreement dated 17th December 2003. Globally Greener Solutions Limited appears to have instructed patent attorneys and paid the relevant fees necessary to prosecute the application through to grant, and is named as the proprietor on the granted patent specification.

The issue

- 3 The key issue to be resolved in this reference is whether rights in the patent application were transferred from Strumat Limited to Globally Greener Solutions Limited contrary to Strumat's Shareholder Agreement. This is a non-patent law issue, which will require the inevitable resolution of factual issues unconcerned with the technical issues of the invention. Following the reasoning in *Luxim Corporation v Ceravision Limited*¹, my initial view was that this issue would be more properly dealt with by the court and that the comptroller should decline to deal with the reference under section 37(8).

¹ [2007] EWHC 1624

- 4 The claimant was invited to submit further observations on whether the comptroller should decline to deal with this reference. Further arguments were received on 5th April 2013, but apart from a general request for the matter to be dealt with by the hearing officer because all of the evidence has been provided, none of the arguments specifically address the question of whether the matter would be more properly dealt with by the comptroller than before the Court. In the absence of any further arguments on the point, I remain of the view that the comptroller should decline to deal with this particular reference for the reasons given above.

Conclusion

- 5 I have decided that the comptroller should decline to deal with this reference under section 37(8). Under Civil Procedure Rule 63.11, any person seeking the court's determination of the reference would need to do so by issuing a claim form within fourteen days of this decision.

Appeal

- 6 Any appeal must be lodged within 28 days.

H Jones

Deputy Director acting for the Comptroller