



**PATENTS ACT 1977**

BETWEEN

Surinder Pal Kaur	Claimant
and	
Bhupinder Seran	Defendant

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PROCEEDINGS

Reference under sections 13 and 37 of the Patents Act 1977 in respect of patent number GB2469819

HEARING OFFICER

J Elbro

Mr Usman Tariq of Ampersand Stable instructed by Cameron Intellectual Property appeared for the claimant

Dr Glen Wilson of Pioneer IP Ltd appeared for the defendant

Hearing date: 31 March 2014

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**DECISION**

**Background**

- 1 Mr Baldave Singh and Mr Bhupinder Seran are named as joint inventors and applicants on a patent application entitled "Intelligent Display" filed on 28 April 2009 and published on 3 November 2010 as GB 2469819 ("the patent"). The patent was granted on 5 April 2011. Mr Baldave Singh died on 27 October 2011. On 27 December 2012 an application was made by Mr Baldave Singh's widow, Mrs Surinder Pal Kaur ("the claimant"), to replace Mr Baldave Singh as co-proprietor, the register being updated on 7 August 2013.
- 2 On 4 April 2013, the claimant made an application under sections 13 and 37 of the Patents Act 1977 to remove Mr Seran ("the defendant") as joint inventor and to name the claimant as the sole proprietor. The defendant opposed this, and after a number of preliminary matters were resolved, the matter came before me at a hearing on 31 March 2014 in Glasgow. It should be noted that for the majority of the proceedings, the defendant was unrepresented, however he obtained representation in the week before the hearing.

## The law

- 3 There was no dispute between the parties as to the law. The approach to be taken when considering requests under section 37 is set out in the House of Lords case *Rhône Poulenc v Yeda*<sup>1</sup>. Paragraphs 18-21 of this judgment outline what questions must be answered and also provide a summary of guidance from other relevant case law which must be considered. Lord Hoffman states:
18. *Section 7(2), and the definition in section 7(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, section 7(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 section 39 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).*
  19. *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 cases, including the present, there will be no issue about paragraphs (b) or (c). If the invention was made by the Weizmann scientists, there is no dispute that Yeda is entitled under paragraphs (b) or (c). Likewise if the invention was made by Dr Schlessinger and his team.*
  20. *The inventor is defined in section 7(3) as "the actual deviser of the invention". The word "actual" denotes a contrast with a deemed or pretended deviser of the invention; it means, as Laddie J said in *University of Southampton's Applications* [2005] RPC 220, 234, 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. *The effect of section 7(4) is that a person who seeks to be added as a joint inventor bears the burden of proving that he contributed to the inventive concept underlying the claimed invention and a person who seeks to be substituted as sole inventor bears the additional burden of proving that the inventor named in the patent did not contribute to the inventive concept. But that, in my opinion, is all. The statute is the code for determining entitlement and there is nothing in the statute which says that entitlement depends upon anything other than being the inventor. There is no justification, in a dispute over who was the inventor, to import questions of whether one claimant has some personal cause of action against the other.*
- 4 Thus entitlement to a patent traces from inventorship, either by a person being an inventor themselves, or because of rights which derive in some manner (such as by an agreement) from an inventor.

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<sup>1</sup> *Rhone Poulenc Rorer International Holdings Inc and another v Yeda Research and Development Company Limited* [2007] UKHL 43

- 5 Applying this to the present case, I issued a Preliminary Evaluation on 12 September 2013 identifying two principal issues:
- i) Is the current statement of Mr Bhupinder Seran as an inventor of the invention in the patent correct, or was Mr Baldave Singh the sole inventor?
  - ii) If Mr Baldave Singh was in fact the sole inventor, is there some other reason why Mr Seran is nonetheless still entitled to be a proprietor of the patent?
- 6 The parties agreed that these were the appropriate questions to ask. They also agreed that the burden of proof to establish Mr Seran was not an inventor lay on the claimant; and if she succeeded in this, the burden of proof that Mr Seran was nonetheless entitled to joint proprietorship would then lie on the defendant.

### **The patented invention**

- 7 Claim 1 of the patent reads:

A self contained stand alone display device comprising:  
a display for displaying at least one image;  
a processor for controlling the display;  
at least one memory arranged to store at least one program for execution by the processor and at least one image displayable by the display;  
at least one interconnect for connecting the display device to at least one further display device identical to the display device to form an interconnected display; and  
at least one input device;  
wherein the display comprises a matrix or array of display pixels, each display pixel comprising one or more LEDs; and  
wherein that the display device is operable to construct and store the at least one image and edit the content of the at least one image responsive to the input device.

- 8 The background to the description describes conventional games consoles, and embodiments include interconnected devices so as to allow users a bird's eye view of a game environment, for example a sports pitch, overcoming prior art problems of users having only a limited field of view.

### **History of the Invention and the Patent and Documentary Evidence**

- 9 It is convenient at this point to set out the broad history of the invention and the patent, and the related documentary evidence submitted by the parties.
- 10 At some point prior to 2003 (the claimant dates it to "on or around 2001"), Mr Baldave Singh begins working on electronic games and display screens. In 2003 he meets with government and independent business advisors with a view to obtaining funding. Confidentiality agreements relating to meetings with the "Innovators Counselling and Advisory Service for Scotland" (ICASS) on 8 and 19 May 2003 were in evidence. The claimant also submitted some 59 pages of Mr Baldave Singh's handwritten notes, which she argued showed Mr Baldave Singh's development of the invention between 2003 and 2007 (which dates the defendant disputed).
- 11 At some point prior to 2009 (the claimant asserted late 2008/early 2009, the defendant asserted a more longstanding relationship) Mr Baldave Singh and Mr Seran come to an agreement (the precise nature of which is in dispute) by which Mr Seran provides a business investment of the order of £8000.

- 12 Mr Baldave Singh continues development work in the area of the invention. Evidence in the form of email printouts and invoices was submitted by the claimant of his sourcing of components in April and July 2009, and paying for PCB layout design in October 2009.
- 13 Disclosure of the invention is made to the patent attorneys Marks and Clerk LLP on 25 March 2009, in a document signed by both Mr Baldave Singh and Mr Seran (which the claimants submitted in evidence). Based on this, Marks and Clerk file the patent application in joint names on 28 April 2009 at the Intellectual Property Office.
- 14 The patent application proceeds through the application process, being published on 3 November 2010. Both parties submitted evidence of various communications relating to this between Mr Baldave Singh and Mr Seran and their representatives – originally Marks & Clerk and later Murgitroyd & Co.
- 15 On 7 August 2009, the patent attorney responsible for the application, Dr Graham McGlashan of Marks and Clerk, sends a letter addressed to Mr Singh in which he clarifies the effect of the order of the names in the listing of inventors and applicants on the published patent application. This letter was produced late on the Friday before the hearing by the defendant and Mr Tariq resisted my admitting it into evidence – I return to this point below.
- 16 Mr Seran makes some enquiries of Mr Stephen Walker of Murgitroyd & Co (by then responsible for the prosecution of the application) between 13 May 2010 and 22 June 2010 about the legal situation in the event of a dispute between himself and Mr Baldave Singh as to ownership of the patent.
- 17 Mr Baldave Singh and Mr Seran meet with Mr Andrew Peacock of Peacock Technologies to arrange for production of a prototype at various points in 2010 and 2011. Confidentiality agreements and purchase orders signed by Mr Baldave Singh (not by Mr Seran) were in evidence.
- 18 The patent was granted on 5 April 2011.
- 19 Mr Baldave Singh (alone) incorporated a company, Garscube Innovations, on 31 May 2011. On his death in October 2011, control of this company passed to his son, Mr Sandeep Singh.

### **The witnesses and their evidence**

#### *The claimant's witnesses*

- 20 The claimant in her evidence-in-chief submitted substantively identical witness statements from herself and her son, Mr Sandeep Singh. Both witness statements were brief and confirm that both witnesses believe “the contents of [the patent] belong solely to Mr [Baldave] Singh”, without giving specific reasons for that belief. The witness statements also assert that each witness was kept apprised of Mr Baldave Singh’s development of the invention, that Mr Baldave Singh confided in each regularly about his relationship with Mr Seran, and that the notes submitted are in Mr Baldave Singh’s handwriting (which last was not disputed).

- 21 Mr Tariq resisted an initial request by the defendant to cross-examine Mrs Kaur, on the basis that her English was not strong enough and there was no time to secure an independent interpreter. The defendant did not in the event pursue this request.
- 22 After the usual rounds of evidence, the claimant submitted in addition witness statements from Mr Andrew Peacock and Mr Stephen Walker. The latter was, as mentioned above, the patent attorney for the latter part of the patent application's prosecution before the Office, and the claimant ultimately did not pursue the submission of his statement.
- 23 Mr Peacock's statement confirms the contracting of his company by Mr Baldave Singh, mentioned above, and asserts that at all times he believed Mr Baldave Singh to be the sole inventor. Again, Mr Peacock's witness statement does not give extensive reasons for this belief, noting only that he was given no technical input by Mr Seran. The defendant initially objected to the late filing of this evidence but in the end this objection was not maintained at the hearing, and nor was a request to cross-examine Mr Peacock.
- 24 In the week prior to the hearing, Mr Tariq indicated that he wished Mr Sandeep Singh to give additional oral evidence to add to his witness statement. At the hearing, he made clear that he considered the claimant's case would be greatly hindered without this evidence. The defendant consented, but asked in return that Mr Seran be also allowed to give additional oral evidence. In these circumstances, I permitted Mr Sandeep Singh and Mr Seran to give this additional evidence at the hearing.
- 25 I have to say that I consider the giving of oral evidence in this way, which is not usual (although certainly possible) for the Comptroller's tribunal, to be highly undesirable, given the greater challenges it posed for the defendant to cross-examine Mr Sandeep Singh effectively. This would have been of even greater concern had the defendant continued to be unrepresented.
- 26 Furthermore, I do not understand why such allegedly crucial evidence was provided by the claimant only at the eleventh hour. The claimant has been represented throughout the case. The witness is the claimant's son who has been (as was apparent from his evidence) deeply involved in recent attempts to commercialise the invention and in the bringing of these proceedings. Having heard all of Mr Sandeep Singh's evidence, there seems to be to be nothing which he could not have put in his original evidence statement. I do not criticise Mr Tariq himself for this as he appears to have only become involved with this case at a relatively late stage.
- 27 Mr Sandeep Singh's oral evidence itself was also not wholly helpful. The bulk of his evidence consisted in an explanation of the invention, and his opinions as to what was inventive about it, along with his opinions as to Mr Seran's lack of relevant qualifications. In this way, he was giving evidence of a form which would be more appropriate for an expert witness. Although he displayed a knowledge of the invention and the surrounding technology, he was not instructed as an expert, and I do not believe I can rely on his unsupported, and somewhat high-level, assertions as to the state of the prior art.
- 28 His factual evidence of his father's work on the invention, and in particular his evidence relating to his father's apparent reaction to discovering the patent to be in

joint names, however, had greater value. His recollections appeared to be given honestly and without elaboration. Dr Wilson established on cross-examination that Mr Sandeep Singh, as chief executive of Garscube Innovations, has a strong vested interest in the outcome of this case, but did not, to my mind, undermine my impression that Mr Sandeep Singh was telling the truth as he saw it. However, he clearly believed certain things (such as his father not having been aware of the patent application being in joint names) and tended to view events he witnessed through that lens, giving an interpretive gloss that a more objective observer might not.

#### *The Defendant's witnesses*

- 29 The defendant submitted four witness statements from witnesses beside himself: one each from a Mr James MacSween and a Mr James Gilmour, and two from a Mr Roderick MacDonald. Each related to the agreement between Mr Baldave Singh and Mr Seran.
- 30 Mr MacSween is the manager of a curry shop. His witness statement states that he had witnessed Mr Seran and Mr Baldave Singh in his restaurant celebrating the grant of the patent, had seen a written agreement between the two of them, and had heard the two men described by Mr Baldave Singh as "joint patentees and inventors". He testified that he later declined to invest £60 000 in the venture. Mr MacDonald's first statement gave a similar account of an encounter at "Tennents Bar".
- 31 Mr Gilmour, described as a bricklayer in his witness statement, is now a controller at the taxi firm where Mr Seran works. His statement describes declining an invitation to invest £60 000 in the venture, and states he saw the "patent document" in joint names, and a business agreement disclosing "equal share of patent rights and equal share of business". Mr MacDonald's second statement describes a similar encounter.
- 32 The claimant sought to cross-examine all three, but the defendant indicated that Mr MacDonald was not available, having had personal difficulties and moved away.
- 33 As Mr Tariq argued, it is apparent that although Mr MacSween's and Mr Gilmour's statements differ from each other, Mr MacDonald's two statements essentially duplicate each of them, including overall structure and slightly odd use of language such as "Mr B. Seran" to refer to Mr Seran. Mr Tariq emphasized this point in argument and cross examination of each of the two men.
- 34 Under cross-examination, both Mr MacSween and Mr Gilmour professed no particular friendship or indeed liking for the defendant, and were resolute in their defence of their statements, making clear that they had originally written them, despite the use of language such as "patentee" that Mr Tariq suggested they would be unfamiliar with. On being confronted with the similarities between each of their statements and those of Mr MacDonald, they offered no explanation for the similarities.
- 35 The apparent duplication of the statements by each witness by Mr MacDonald's statements, and the failure to produce Mr MacDonald when requested, in my mind cast a very grave shadow over the defendant's evidence in this respect. The highly

dubious nature of Mr MacDonald's statements undermines my confidence in the evidence of Mr MacSween and Mr Gilmour. While I am confident that they attempted to give evidence honestly, I cannot escape the impression that some of the detail of it, in particular references to joint patentees, was shaped by the defendant with a view to supporting his case. I thus find myself unable to place great weight on it.

- 36 Mr Seran himself gave evidence as to the nature of the invention, and his relationship and business agreements with Mr Baldave Singh.
- 37 On Mr Tariq's request, Mr Seran was not present while Mr Sandeep Singh gave evidence as to the inventive concept. Mr Tariq made this request on the grounds that he was concerned Mr Seran would use Mr Sandeep Singh's description of the invention to avoid showing that he did not truly understand it. In the event Mr Seran's evidence as to the invention displayed a clear understanding of its operation, according well with Mr Sandeep Singh's description. However, insofar as he was giving an opinion as to the state of the art and the inventive concept, his evidence suffered the same issues as Mr Sandeep Singh's in that it was not proper expert evidence.
- 38 Mr Seran's evidence was given robustly, and he gave the overall impression of considering the claimant's case to be wholly without merit. However, this combined with my concerns over the question marks over the other defence witnesses' evidence meant that I did not feel I could totally rely on it in situations where it conflicted with other evidence.

### **Inventive Concept**

- 39 The claimant argued that the inventive concept lies in three elements of claim 1: the stand-alone nature of the device (i.e. not being a separate screen attached to a computer), the ability to interconnect copies of the device with itself, and the editing function, being put together in combination. The claimant's argument (of which Mr Tariq prayed Mr Sandeep Singh's evidence in support) was that these elements existed in the prior art, but not in combination.
- 40 The defendant also relied on these features, but in addition pointed to the use of LEDs. The defendant contrasted expensive LCD screen with editing functions which the defendant claimed existed in the prior art, with the inexpensive LED device scalable in size (because of the interconnection function) of the invention in the patent. Dr Wilson argued the prosecution history of the patent, highlighting the use of LEDs to overcome novelty and inventive step objections to the patent, supported this interpretation. He pointed to two embodiments in the patent, existing in the application as filed: one a game, the other a sign. As I return to below, he characterised the former idea as coming from Mr Baldave Singh, the latter from Mr Seran.
- 41 In determining the true discontinuity with the art made by the invention in the patent, I have been hindered by a lack of evidence as to the state of the prior art. Mr Sandeep Singh purported to give evidence as to this, but as I note above, he was not an expert witness, and I do not consider that I could rely on his evidence in this respect. Mr Seran's evidence on this point was likewise of little assistance – I am

reminded of the passage *Rhone-Poulenc v Yeda*<sup>2</sup>, quoted above, that “Inventors themselves will often not know exactly where [the inventive concept] lies.”

- 42 It is however apparent from the claimant’s evidence of Mr Baldave Singh’s comments on the examiner’s reports that the use of LEDs was introduced into the claims to overcome the examiner’s objections.
- 43 Overall, I consider the inventive concept to be a LED screen with editing functions which is interconnectable with itself to form a larger device.

### **Inventorship**

- 44 The claimant’s primary assertion is that Baldave Singh devised the invention before the involvement of Mr Seran, which the claimant dates from late 2008/early 2009, Baldave Singh having been working on an LED board for electronic games from 2001. There are two sets of documentary evidence submitted by the claimant to support this argument: the confidentiality agreements with ICASS (from 2003) and Baldave Singh’s collection of notes. In addition, Sandeep Singh’s oral evidence made reference to a number of prototypes developed through this period. The claimant argued that Sandeep Singh’s evidence clearly indicated that his father had devised the invention.
- 45 Taking Sandeep Singh’s evidence first, as I observed above, his written witness statement merely asserted that he believed his father had invented the invention in the patent, without giving any further illumination as to why he believed this. He reiterated this belief in oral evidence, but it became apparent that there were a number of factors that undermined the strength of the reliability of his belief on that point.
- 46 Most importantly, it was apparent that throughout his evidence, Sandeep Singh tended to consider “the invention” as being the entire device developed over the time period from 2001 onwards, rather than being the specific invention defined by the claims of the patent. Thus, for example, he made reference to a number of prototypes developed prior to 2008, and asserted these showed the invention, but when challenged by Mr Wilson, was unable to identify any prototype prior to 2010 that had all the features of the claimed invention.
- 47 It was also clear from his evidence that he had not been continuously living with his father during the development of the invention, and was unable to give a clear picture of how his father had developed the invention, and what features were incorporated at which stage.
- 48 Turning to the documentary evidence, the claimant argues that “it is a safe assumption” that the ICASS confidentiality agreements relate to the early development of the invention. This is based on the agreements referring to the subject matter being a “Programmable Display Screen” and a “Games Unit” and that Baldave Singh patented no invention other than the one in the patent. The defendant in response points to the lack of any specificity beyond this in terms of description in the confidentiality agreements, and argues that they certainly do not

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<sup>2</sup> *Rhone-Poulenc Rorer International Holdings Inc and others v Yeda Research and Development Company Limited* [2007] UKHL 43, paragraph 20.



show that the invention (as defined by the inventive concept) had been devised by the time of the agreements. Mr Seran testified that at this time, Mr Baldave Singh was working on projecting images from television screens, and inferred that it was this that Mr Baldave Singh discussed with ICASS.

- 49 Regarding the notes, the claimant asserts that these show the iterative development of the invention between 2003 and 2007. The defendant challenged this on the basis that the notes are unclear and in large part undated – and include documents (as Sandeep Singh conceded under cross examination) which are clearly dated 2010.
- 50 The claimant attempts to bolster her case by arguing that Mr Seran (in contrast to Baldave Singh) lacked the technical knowledge to create the invention. There were two prongs to this approach: firstly, attacking Mr Seran's technical qualifications, and secondly attempting to show that all technical input in the prosecution of the patent application and development of the prototype came from Baldave Singh, with none from Mr Seran.
- 51 On the first point, Sandeep Singh in his oral evidence gave extensive evidence of his opinion that Mr Seran lacked sufficient technical expertise. I did not find this at all helpful; Sandeep Singh was not an expert witness qualified to take a view on Mr Seran's qualifications and his opinion of Mr Seran's expertise is really neither here nor there. Most pertinently, from the documentary evidence, it was apparent, as Dr Wilson submitted that Mr Seran was at least as technically qualified as Baldave Singh, and certainly capable of understanding the technology in the invention, as he demonstrated on the stand.
- 52 On the second, the claimant argues that there were a number of occasions in the prosecution of the patent application where Baldave Singh alone provided technical responses to the examiner's objections, with Mr Seran providing a "purely administrative" contribution. Evidence of handwritten notes on examination reports of 21 August and 20 October 2009 was in evidence.
- 53 The defendant disputed this, arguing that Mr Seran was involved at a technical level in discussions with the patent attorneys. He provided emails (dated 6 November 2009 and 11 January 2010) of communications with the agent then handling the case, which referred to a meeting the agent had had with Baldave Singh and Mr Seran to discuss the response to an examination report, and in one instance states "Baldave and yourself provided arguments".
- 54 To further bolster this point, the claimant argued, backed by the evidence in the notes and the testimony of Mr Sandeep Singh, that Mr Baldave Singh wrote the software code for the invention, and that this was the heart of the invention – hardware being unusable without software. The defendant did not appear to dispute that Mr Baldave Singh had written the software, but disagreed that the contribution of the software was key to the invention – rather, once the idea was established, any competent coder could come up with the code to implement it.
- 55 The claimant also relied on the written evidence of Mr Peacock, in which he states that he believed that Baldave Singh was the inventor. However, his evidence gives no indication of why he believes this, and the defendant argues this is pure speculation on Mr Peacock's part. The defendant further points to Mr Seran's

testimony that he attended all the meetings between Mr Baldave Singh and Mr Peacock as further evidence that Mr Seran was involved at the technical level.

- 56 Finally, the claimant asks rhetorically, regarding Mr Seran's enthusiasm for the potential of the invention, if it had not already been devised by the time Mr Seran invested, what was he investing in?
- 57 As well as disputing, as noted above, that the claimant's evidence establishes what she claims it does, the defendant put forward an alternative narrative as to the genesis of the invention, as set out by Mr Seran in evidence. The defendant challenged this, Mr Seran testifying that Mr Baldave Singh's focus had been on a "3D football game". Mr Seran described an occasion when he and Mr Baldave Singh had been watching football, and Mr Seran had come up with the idea – based on seeing the signs around the pitch – of standalone, interconnectable, editable LED displays.

#### *Conclusion on inventorship*

- 58 The claimant's documentary evidence is very weak. The non-disclosure agreements give no indication of the detail of the invention beyond a title, and give no indication that the invention as defined by the claims in the patent had been devised at that point. The technical notes are largely undated, and to the extent that they are, clearly post-date the invention. Mr Sandeep Singh's evidence failed to add to this beyond his clear belief.
- 59 The indirect evidence of Mr Baldave Singh's technical contribution to proceedings with the agent also did not greatly advance the claimant's case, as put at its highest it shows only that Mr Baldave Singh made a technical contribution, not that Mr Seran did not. The defendant's evidence of communicating with the agent was also at best ambiguous, with neither side clearly demonstrating either Mr Seran's involvement or lack of it.
- 60 Equally, although the software is clearly important to the function of the invention, and it does appear this element was contributed by Mr Baldave Singh, that does not establish that there are no other aspects of the invention contributed by Mr Seran.
- 61 The claimant's attack on the defendant's qualifications and technical ability goes nowhere, as I noted above. I am similarly unconvinced that Mr Seran would only have become involved if presented with the invention – it is clear that Mr Baldave Singh was developing a device which had potential, regardless of whether the specific invention in the patent had crystallized at the point that Mr Seran came along.
- 62 Putting all this together, on the balance of probabilities I find it more likely than not that Mr Seran provided an inventive contribution to the invention claimed in the patent. I find his account of coming up with the basic idea of interconnectable LED screens credible, which would seem sufficient on its own given my findings as to the inventive contribution above, but I also find it more likely that not in light of the evidence in its totality that he was involved in the technical development of the invention, albeit to a lesser extent than Mr Baldave Singh.

63 It follows that the claimant's attempt to remove Mr Seran as an inventor on the patent fails. This is sufficient to resolve the entitlement action in the defendant's favour. However, in case I am wrong on the question of inventorship, I will go on to consider the question of whether Mr Seran would still have been entitled to joint proprietorship of the patent in the event I had found him not to be an inventor.

### **Entitlement**

64 The defendant maintained that there was both a written and oral agreement between himself and Mr Baldave Singh that they would be joint proprietors of the patent. The claimant argued that no such agreement existed.

#### *The alleged written agreement*

65 In his original counterstatement, Mr Seran asserted that a written agreement to joint proprietorship between himself and Mr Baldave Singh existed. However, he was presently unable to locate it, but would supply it when he had. In the event, he never managed to produce this document. (I should mention that as a result of the document's non-appearance Mr Seran amended his counterstatement, at the direction of the IPO, to delete reference to it. The claimant attempted to make something of this at the hearing, essentially alleging Mr Seran had changed his story, but I think there is nothing in this point; the confusion which arose appears to have been the result of a communication breakdown between the IPO and the then unrepresented defendant).

66 Instead, Mr Seran produced witnesses to testify to the existence of the agreement. Their evidence is discussed above.

67 The claimant denied such an agreement existed and argued the burden was on the defendant to prove its existence. She relied on Mr Sandeep Singh's evidence that although Mr Seran had presented several draft written agreements to Mr Baldave Singh, Mr Baldave Singh had refused to sign any of them. By contrast, Mr Seran insisted in his evidence that such an agreement existed; he was just unable to locate a copy.

#### *Conclusion on written agreement*

68 I find the evidence of the existence of a written agreement agreeing to joint proprietorship of the patent unconvincing. The evidence of the defendant's witnesses (other than Mr Seran himself) was, even if fully accepted, at most only that they had seen an agreement and been given the impression that it entitled Mr Seran and Mr Baldave Singh to joint proprietorship, not that they had carefully perused the agreement. Given the dubious light cast on the evidence by the supposed statements from Mr MacDonald discussed above, and Mr Seran's inability to produce this agreement, I find it more likely than not that no such written agreement existed.

#### *The alleged oral/informal agreement*

69 The claimant's documentary evidence included the initial disclosure made to the patent attorneys which led to the filing of the patent application. This includes a cover sheet, signed by both Mr Baldave Singh and Mr Seran as "The Discloser"

acknowledging that this disclosure occurred on 25 March 2009. This on its face appears to show the filing of the patent as a joint enterprise of Mr Baldave Singh and Mr Seran. The claimant argues that the patent application was made in joint names without the knowledge of Mr Baldave Singh, which Mr Seran was able to accomplish because he was responsible for all administrative tasks.

- 70 Mr Sandeep Singh's evidence was that Mr Baldave Singh did not realise initially that the application was in joint names. He testified that Mr Baldave Singh was "shocked in disbelief" when he realised the situation. However, he stated that Mr Seran managed to "placate" Mr Baldave Singh by offering future funding (which he alleged never materialised). Mr Sandeep Singh's testimony was originally that Mr Baldave Singh was not aware of the application being in joint names until it was published, but in oral evidence indicated that he was not precisely sure of when his father had discovered this, only that it was sometime in 2009 or 2010. When asked why his father took no action subsequently, he indicated that he'd known Mr Seran a long time and was shocked, and that being unemployed even if he'd wanted to take action, he could not have afforded to do so.
- 71 Mr Seran's oral evidence was that there had been some disagreement between him and Mr Baldave Singh caused by Mr Baldave Singh being unhappy as being listed second in the list of inventors, however that once it was clarified that this made no difference in terms of rights, the dispute was resolved. In support of this, the defendant made reference to the August 2009 letter from Mr McGlashan to Mr Baldave Singh submitted just prior to the hearing. In this letter, Mr McGlashan makes clear that the order of the applicants has no legal implications, and also promises to in future send correspondence to both Mr Baldave Singh and Mr Seran.
- 72 While objecting to the admission of this letter at all, Mr Tariq argued that it was consistent with the claimant's account of Mr Baldave Singh being initially ignorant of the situation regarding the application being in joint names, and showed in particular that prior to it, Mr Seran had been corresponding alone with the patent attorneys, with Mr Baldave Singh not receiving copies of the correspondence.
- 73 The claimant also highlights enquiries Mr Seran made of Stephen Walker, then Mr Baldave Singh's and Mr Seran's patent agent, as to what the legal position would be in the event of a dispute between the two of them, in May and June 2010.
- 74 Finally, in further support of her contention that there was no agreement for joint proprietorship between Mr Baldave Singh and Mr Seran, the claimant points to evidence that Mr Baldave Singh was seeking to exploit the patent alone. She points to documentary evidence that Mr Baldave Singh alone signed the agreement with and paid Peacock Technologies in December 2010, and that Mr Baldave Singh alone incorporated Garscube Innovations Ltd in May 2011 to exploit the invention.
- 75 The defendant counters that this is irrelevant to the ownership of the patent. Indeed, Mr Wilson argued that had Mr Baldave Singh and Mr Seran gone their separate ways directly after the filing of the patent, that would not have changed the position with regards to joint ownership.

### *Conclusion on oral/informal agreement*

- 76 I do not consider the evidence relating to Mr Baldave Singh setting up companies and taking actions to exploit the invention takes the claimant's case forward. That Mr Baldave Singh should have been the one taking steps to commercialise the invention says nothing about what agreement had been reached on ownership of the patent previously.
- 77 On Mr Baldave Singh's attitude to Mr Seran being a joint applicant for the patent, there is a clear conflict of evidence between Mr Sandeep Singh and Mr Seran.
- 78 I have to say that standing by itself, I did not find Mr Seran's evidence wholly convincing, especially as he had long denied there was any conflict between himself and Mr Baldave Singh, while his final evidence concedes differently. It is also apparent that he did have some concerns about potential conflict over the ownership of the patent, as reflected in his email conversation with Stephen Walker.
- 79 As against that, Mr Sandeep Singh's evidence was not wholly convincing either. His evidence of his father's actions lacked specificity and seemed tailored to the conclusion he was seeking. It is also apparent that Mr Baldave Singh did not actually take any action to do anything to remove Mr Seran from joint ownership. Suggestions by the claimant (supported by evidence from Mr Sandeep Singh) that he was "bought off" by promises from Mr Seran of further funding do not necessarily assist the claimant in that they point to some form of understanding between Mr Seran and Mr Baldave Singh. Furthermore, the initial disclosure to the patent agent leading to the filing of the patent appears to be very clearly a joint document from Mr Seran and Mr Baldave Singh, bolstering Mr Seran's evidence.
- 80 I believe the August 2009 letter is not inconsistent with either parties evidence as it finally stood. It certainly shows Mr Baldave Singh knew of the joint status earlier than Mr Sandeep Singh originally indicated, but equally does not establish that he was aware at the time of filing. Given its establishing that Mr Sandeep Singh's original impression of when his father learned of the situation was inaccurate, however, I believe I should admit it, although were it excluded it would not change my conclusion below.
- 81 Overall, I believe it to be more likely than not that there was an agreement between Mr Baldave Singh and Mr Seran that the ownership of the patent would be shared between them. It follows that even were I to hold Mr Seran not entitled to be named as inventor, the claimant's entitlement action would still fail.

### **Conclusion**

- 82 I find the claim for entitlement to the patent is not made out and that both inventors' names should remain on the register.

### **Costs**

- 83 The defendant has won and in principle is entitled to a contribution towards his costs. I will allow both parties an opportunity to make submissions on this point.

## **Appeal**

84 Any appeal must be lodged within 28 days

**J ELBRO**

Divisional Director acting for the Comptroller