



PATENTS ACT 1977

BETWEEN

AutoStore Technology AS

Claimant

and

Ocado Innovation Limited

Defendant

PROCEEDINGS

References under sections 12 and 37 of the Patents Act 1977
in respect of patents GB2528568, GB2565239, GB2565240, GB2565241,
EP3152712 and GB2560814

HEARING OFFICER

Phil Thorpe

DECISION

- 1 A reference under sections 12 and 37 for determination of entitlement to GB2528568, GB2565239, GB2565240, GB2565241, EP3152712 and GB2560814 was filed on 6th November 2020 by AutoStore Technology AS. The defendant, Ocado Innovation Limited, responded arguing that the questions to be decided involve matters that would more properly be determined by the Court and asked that the comptroller declines to deal with the references as provided for by sections 12(2) and 37(8).
- 2 The defendant referred to related proceedings before the Patents Court (Claim no. HP-2020-000035) in respect of alleged infringement by Ocado of six AutoStore patents. It notes that whilst the patents in issue in that action differ from those in this reference, part of Ocado's defence in the infringement action is based on prior use that centres on a period of time that is also of particularly relevant to the entitlement claim. It argues that in both actions there is likely to be significant disclosure requests relating to this period and that it is preferable for those to be managed together. It also suggests that the extent of the evidence and the complexity of issues that will arise in the entitlement dispute justify the comptroller declining to deal.

- 3 The claimant initially resisted the request to decline to deal however in the interests of expediency now supports the requests without accepting the submissions of the defendant on this matter.
- 4 Given the parties are now in agreement, the relevant proceedings before the Patents Court and based on a prima facie consideration of the submissions by both sides, I am satisfied that the comptroller should decline to deal with the reference under sections 12 and 37 and that the Court should have jurisdiction to decide the questions of entitlement.
- 5 In accordance with section 12(2) and section 37(8), the comptroller declines to deal with this reference.

Phil Thorpe