

*[Abstract prepared by the PCT Legal Division (PCT-2010-0009)]*

Case Name:

Ernest Ogden, John McKenzie and Projectile Limited

[August 2, 2005](#)

[June 8, 2006](#)

[June 7, 2007](#)

Jurisdiction:

UK - IPO

Abstract:

The issue in these cases is the right of entitlement to the PCT application and to the resulting UK patent.

PCT Legal References:

- Article 4
- Rule 4



BL O/219/05

2 August 2005

## PATENTS ACT 1977

BETWEEN

Ernest Ogden

Claimant

and

John McKenzie and Projectile Limited

Defendants

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PROCEEDINGS

Reference under sections 13 and 37 in  
respect of patent number GB 2378382

HEARING OFFICER

D J Barford

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### PRELIMINARY DECISION

- 1 This decision is concerned with firstly whether this reference in respect of rights in patent number GB 2378382 (“the patent”) should be extended to cover rights in patent application number PCT/GB 2003/000293 (“the PCT application”); and secondly with a question as to what evidence should be admitted into these proceedings.

#### Background

- 2 Patent application number GB0119378.8 was filed on 9 August 2001 by Messrs Ogden and McKenzie and Projectile Limited naming Messrs Ogden and McKenzie as inventors and claiming no earlier priority. It was published on 12 February 2003 and granted on 19 November 2003 as GB 2378382.
- 3 The PCT application was filed on 17 January 2003, also by Messrs Ogden and McKenzie and Projectile Limited, naming Messrs Ogden and McKenzie as inventors and claiming no earlier priority.
- 4 These proceedings were launched on 1 December 2003 under sections 13 and 37. A statement was filed by Mr Ogden on that date followed by a supplementary statement on 18 December 2003. Two counterstatements were filed on 25 March 2004 by Mr McKenzie, one on his own behalf and the other on behalf of Projectile Limited. The usual evidence

rounds followed, with Mr Ogden filing evidence on 18 June 2004, Mr McKenzie filing evidence on 15 September 2004 and Mr Ogden filing evidence on 24 February 2005 and 19 April 2005. Some of this evidence was filed on earlier dates then re-submitted on the dates given, but that is not material to this decision.

- 5 There is a further application, number GB9828516.6 (“the earlier application”), referred to in both the statement and Mr McKenzie’s counterstatement. This was filed on 23 December 1998 by Mr Ogden naming himself as sole inventor and claiming no earlier priority. No request for preliminary examination and search being filed, this earlier application was terminated before publication.

### **The PCT application**

- 6 There is no reference in either the statement or the supplementary statement to the PCT application. It is however referred to in Mr MacKenzie’s counterstatement in the following terms: “I have continued to progress the project and I am still incurring costs on the initial patent GB 2478382 and the additional Patent Application No PCT/GB 2003/000293”. It is also referred to in Projectile Limited’s counterstatement. Indeed this is headed “Reference: GB0119378.8/ GB2478382 and International Patent 2003/000293”. It includes the statement that “Projectile Limited .. claims a third ownership in Patent Number GB 2478382 and the International Patent 2003/000293”. In addition, Mr Ogden has referred to the PCT application in his evidence.
- 7 In view of the above, the Patent Office wrote to the parties on 30 September 2004 enquiring as to whether the PCT application was part of the present dispute. Mr Ogden responded that he wished it to be included. Mr McKenzie responded that its inclusion would “fundamentally alter” the dispute and that Mr Ogden should make a separate reference. The Patent Office followed this up by stating that inclusion of the PCT application would not appear to raise any additional matters to be considered at the substantive hearing, as the content of the patent and that of the PCT application appeared to be essentially the same, and requested detailed reasons from Mr McKenzie if he wished to resist its inclusion.
- 8 In a letter dated 28 November 2004 Mr McKenzie argued that the present proceedings do not in any way demonstrate any disagreement over the PCT, pointed out that, if anything, more work went into making the PCT application than the patent, and argued for the opportunity to file more evidence on the matter so that a judgement is not made without full knowledge of the facts.
- 9 Mr Ogden filed a detailed response in a letter dated 16 January 2005 including two copies of his earlier application, one annotated to show differences between patent application GB0119378.8 and the earlier application, and the other annotated to show differences between the PCT application and the earlier application; and arguing that the differences are negligible.
- 10 Mr McKenzie filed a detailed response in a letter dated 14 February 2005 including a copy of Mr Ogden’s earlier application annotated to show differences between the patent and the

earlier application. Mr McKenzie again points out in this letter the effort he had to put into filing the PCT application and states that he has had no input from Mr Ogden on this.

### **Findings on the PCT application**

- 11 The rights in the PCT application may either be adjudicated on by extending the present reference or in the context of a second, separate reference. It seems to me that in deciding between these two alternatives, which is effectively the task before me, the most important factors that I need to take into account are cost, time and the extent to which - if a separate reference were filed - the comptroller would have to decide what is essentially the same issue in two separate proceedings.
- 12 Both Mr Ogden and Mr McKenzie have gone to a great deal of trouble to compare the text of the earlier application with that of patent application GB0119378.8 and the PCT application (Mr Ogden), and with that of the patent (Mr McKenzie). However the relevant comparison for the matter in issue is none of these; it is that between the patent and the PCT application - one the subject of this reference, the other a possible subject of this reference. On comparing these two documents, it seems to me that they are absolutely identical in wording.
- 13 Given this, I have to reject Mr McKenzie's argument that inclusion of the PCT application would "fundamentally alter" the dispute as ill founded. Equally I attach no weight to his argument that he has put a lot of effort into filing the PCT application unassisted by Mr Ogden. That may well be the case, but who put the effort into filing a patent application is a different matter from the key issue of who put the effort into actually devising the invention covered by the application.
- 14 It is clear that extending the present reference to include the PCT application is essential to avoid the need to adjudicate the same issue in two separate proceedings. Manifestly this will also save time and cost.
- 15 Accordingly I allow Mr Ogden's request to amend the reference to include the PCT application. It follows that as well as section 37, which relates to rights in UK patents, section 12 now comes into play. Section 12 relates to rights in, amongst other things, patent applications made under any treaty, and therefore covers rights in the PCT application.
- 16 For completeness I should add that I see no necessity for either party to file any further evidence as a result of this decision to include the PCT application.

### **The evidence**

- 17 On 8 February 2005 Mr McKenzie stated that he wished to file further evidence going beyond that filed in the usual rounds, and argued that a system in which the claimant has the last word in the evidence rounds is unfair. In letters dated 25 February, 7 April and 17 April 2005 Mr McKenzie submitted further documents setting out in detail which parts of the evidence filed in the final round by Mr Ogden he regarded as not strictly in reply, and providing a response to

those parts of Mr Ogden's evidence.

- 18 Mr Ogden's initial response to this, in a letter dated 3 April 2005, was to argue that his evidence was strictly in reply and to object to the admission of Mr McKenzie's latest submissions. However in a letter dated 29 May 2005 Mr Ogden states that if this new evidence is allowed in it will give him (Mr Ogden) the opportunity to "clear up a couple of points". The points at issue are concerned with what was said in court at divorce proceedings between Mr and Mrs Ogden held on 28 July 2004 and 25 February 2005 concerning the length of time Mr McKenzie had known Mr Ogden and members of Mr Ogden's family. Mr Ogden wishes to file a witness statement from his solicitor on this particular matter.

### **Findings on evidence**

- 19 Rules 8, 14 and 54 deal, amongst other things, with the filing of evidence in proceedings under sections 12, 13 and 37. Rules 8(5) to 8 (7) and rules 54(4) and (5) set out clearly and unambiguously the normal sequence of evidence rounds under sections 12 and 37 to which Mr McKenzie has raised objection - namely claimant's evidence, defendant's evidence and claimant's evidence strictly in reply. As to filing evidence further to these three rounds, rules 8(8) and 54(6) read identically as follows:

*"No further evidence shall be filed by any party except by leave or direction of the comptroller"*.

Rule 14(4) which deals with matters under section 13 following filing of the statement and counterstatement is less prescriptive on the filing of evidence and simply states that:

*"The comptroller may give such directions as he may think fit with regard to subsequent procedure"*.

- 20 It is clear from the above that whether I admit evidence beyond the normal three rounds is a matter for my discretion. Factors that I need to take into account are the reasons for the late submissions, the conduct of the parties in these proceedings, the potential impact on the hearing date, and the effect on the parties of admitting or refusing the evidence having regard to its relevance and importance. There is also the question of whether or not Mr Ogden's evidence was strictly in reply.
- 21 In deciding these questions I am very much aware of the fact that both Mr Ogden and Mr McKenzie are unrepresented in these proceedings; and both it seems to me have been doing their best to comply with complex and unfamiliar procedures. It is difficult at this stage of the proceedings to make a judgement as to the relevance and importance of the evidence in question, and since it is both parties that have requested the opportunity to put in further evidence my inclination is to admit it, that is to say to admit Mr Ogden's evidence in reply, to admit Mr McKenzie's further submissions and to allow Mr Ogden the limited opportunity to file the witness statement from his solicitor to which he has referred. I should make it clear to both parties however that any request to submit yet more evidence would have to be supported by compelling reasons. No date has been arranged for the substantive hearing, so

this proposal will not result in any loss of hearing date; and in fact steps can now be taken to arrange a date.

### **Conclusions and next steps**

- 22 I have decided to allow Mr Ogden's request to amend the reference to include the PCT application, and to admit all of the evidence submitted to date by both parties.
- 23 In addition I allow Mr Ogden six weeks from the date of this decision to file the witness statement from his solicitor to which he has referred in his letter of 29 May 2005.

### **Costs**

- 24 Neither party has asked for costs in respect of these preliminary matters and so I make no award.

### **Appeal**

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

**DAVID BARFORD**

Deputy Director acting for the Comptroller



BL O/142/06

8 June 2006

## PATENTS ACT 1977

BETWEEN

Ernest Ogden

Claimant

and

John McKenzie and  
Projectile Ltd

Defendants

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### PROCEEDINGS

References under sections 12, 13 and 37 in respect of  
patent number GB 2378382 and international patent  
application number PCT/GB 2003/000293

D J Barford

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## DECISION

### Introduction

- 1 Patent application number GB0119378.8 (“the application in suit”) was filed on 9 August 2001 claiming no earlier priority. It was published on 12 February 2003 and granted on 19 November 2003 as GB 2378382 (“the patent”). The GB application was made in the names of Mr Ogden, Mr McKenzie and Projectile Limited (“Projectile”), naming Messrs Ogden and McKenzie as inventors.
- 2 These proceedings were launched by Mr Ogden on 1 December 2003 by way of a reference under sections 13 and 37. In his statement Mr Ogden claims that he is the sole inventor and that he should have sole proprietorship of the patent. In his counterstatement Mr McKenzie claims that he is the sole inventor, and that proprietorship should be equally divided between himself, Mr Ogden and Projectile.
- 3 International patent application number PCT/GB 2003/000293 (“the PCT application”) was filed on 17 January 2003 claiming no earlier priority. It was published as WO 2004/065892 on 5 August 2004. As with the GB application,

the PCT application was made in the names of Mr Ogden, Mr McKenzie and Projectile, naming Messrs Ogden and McKenzie as inventors.

- 4 There was a preliminary dispute as to whether or not the reference should be amended, at Mr Ogden's request, to include the PCT application under section 12. In a preliminary decision dated 1 August 2005, I allowed the request. Also in that decision I allowed both parties to file further evidence outside the normal evidence rounds.
- 5 At issue then are the questions of who invented and who is entitled to the patent and to the PCT application.
- 6 These matters came before me at a hearing on 16<sup>th</sup> March 2006 at which both litigants appeared in person.

### **The law**

- 7 Relevant to the dispute are sections 7, 12, 13, 36 and 37. These read:

#### **Section 7**

*7.- (1) Any person may make an application for a patent either alone or jointly with another.*

*(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.*

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

*(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.*

#### **Section 12**

*12.-(1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made) -*



*(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or*

*(b) any of two or more co-proprietors of an application for such a patent for that invention may so refer the question whether any right in under the application should be transferred or granted to any other person;*

*and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.*

*(2) ....*

### **Section 13**

*13.-(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.*

*(2) ..*

*(3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.*

### **Section 36**

*36.-(1) Where a patent is granted to two or more persons, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.*

*(2) Where two or more persons are proprietors of a patent, then, subject to the provisions of this section and subject to any agreement to the contrary -*

*(a) each of them shall be entitled, by himself or his agents, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would apart from this subsection and section 55 below, amount to an infringement of the patent concerned; and*

*(b) any such act shall not amount to an infringement of the patent concerned.*

*(3) Subject to the provisions of sections 8 and 12 above and section 37 below and to any agreement for the time being in force, where two or more persons are proprietors of a patent one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent or in Scotland cause or permit security to be granted over it.*

*(4) Subject to the provisions of those sections, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.*

(5) *Where a patented product is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.*

(6) *Nothing in subsection (1) or (2) above shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.*

(7) *The foregoing provisions of this section shall have effect in relation to an application for a patent which is filed as they have effect in relation to a patent and -*

*(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and*

*(b) the reference in subsection (5) above to a patented product shall be construed accordingly.*

### **Section 37**

*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.*

*(2) ..*

### **The patent and the PCT application**

8 The patent is entitled "Blast attenuating, blast-directing and extinguishing apparatus".

9 Claim 1 is the only independent claim and at grant reads:

A blast attenuating, blast-directing and extinguishing apparatus, comprising of an open mouthed inner container housed within an open mouthed partially spherical outer container with a cavity defined between the two containers containing a fluid with extinguishing capabilities such as water, the wall of the outer and inner containers being joined by a member having a number of apertures adjacent the mouth of the inner container.

10 The invention finds particular application in dealing with the problem of terrorist bombs placed in litter bins, and to this end the inner container may be used to

receive a bin. In the event of an explosion, the inner container will deform, forcing jets of fluid and debris through the apertures in the member joining the inner and outer containers rather than radially outwards, and dispersing energy from the blast. The apparatus may be made of plastics, fiberglass or metal. The fluid may be water.

11 The PCT application is identical in wording to the patent at grant.

### **Chronology**

12 The following does not appear to be in dispute.

13 Following an incident in Warrington in which two children were killed by a bomb planted in a litter bin, Mr Ogden developed the idea of a bomb proof bin, and a freelance patent agent Ms Arlene Hall assisted him in drafting and filing a patent application (which was subsequently terminated) to protect the idea.

14 This application, number GB9828516.6 (“the terminated application”) entitled “Apparatus and method relating to blast attenuating, blast-directing and extinguishing assembly” was filed on 23 December 1998 by Mr Ogden naming himself as sole inventor and claiming no earlier priority. Due to lack funds Mr Ogden was not in a position to progress the application. No request for preliminary examination and search was made and the earlier application was terminated before publication on 28 February 2000.

15 Mr Ogden subsequently contacted Mr McKenzie for assistance. Mr McKenzie proposed – and Mr Ogden agreed - that the two of them take things forward together on a joint ownership basis with Mr Ogden providing the technical input and Mr McKenzie the administrative input and the finance.

16 Mr McKenzie proposed using a company called Projectile, which Mr Ogden understood to have the two of them as directors, to take the project forward.

17 Applications GB0119378.8 and PCT/GB 2003/000293 were then filed as described above, and the two men cooperated in taking steps to obtain support for the invention, all paid for by Mr McKenzie as agreed. These included meetings with Qinetiq on possible military applications, and a successful demonstration to the Home Office using high explosive.

18 However the relationship subsequently showed signs of strain and the parties agreed to put their agreement in writing through solicitors.

19 Mr Ogden states that when his solicitor, Mr Laurence Pritchard, checked the records of Companies House, he found that Mr Ogden was not in fact named as a director of Projectile. Mr Pritchard, in a letter dated 10 September 2003, wrote to Mr McKenzie pointing this out, and stating that “in order to formalise the arrangements agreed between you [Mr McKenzie] and my client relating to this matter, there needs to be put in place a formal agreement”. Mr Pritchard went on to propose, amongst other things, that the patent should be exploited

only through Projectile, which would be owned in equal shares by the two parties, and that Mr Ogden would be made a director.

20 In a letter dated 1 October 2003, Mr McKenzie's solicitor, Mr Nik White, responded that "I confirm that my client is in principle willing to accept your proposal in broad terms subject to the following comments". Mr White went on to list a number of points, including references to other inventions which he did not describe in detail and which are not in any case the subject of the present dispute. One point which is of relevance to this dispute however is Mr White's proposal that "Both clients will be individually responsible for their own sphere of influence within the company ie Mr McKenzie – Management and Mr Ogden-Technical, as both parties had agreed from inception. Areas such as Policy and Finance will be the responsibility of both clients."

21 However in the event no agreement was signed and at this point the parties' accounts differ. Mr Ogden describes his surprise on learning that he was not named as a director of Projectile. Mr McKenzie however states that Mr Ogden was well aware that he was not named as a director of Projectile, and in fact wanted things that way since he was going through divorce proceedings and did not want any income from the project to be open to a claim from his wife. Mr McKenzie states that Projectile was a dormant company set up several months before he and Mr Ogden started to work together, and was used primarily to give a professional edge when dealing with potential customers.

22 In the event, Mr Ogden initiated these proceedings.

### **Inventorship**

23 Section 7 quoted above states that "inventor" in relation to an invention means "the actual deviser of the invention".

24 Mr McKenzie argues that he contributed to the invention on two counts – firstly through his negotiations with the Patent Office examiner and changes he made to the application in suit which resulted in an application that would have been refused being granted; and secondly through certain development work he has carried out on the invention.

25 It seems to me that McKenzie's first argument must inevitably fail. However skilfully he redrafted his claims and amended his description during prosecution of the application in suit, and however much time and effort he put into this, he can have done no more than re-work material that was present in its entirety when the application was filed. There was no devising going on here as required by section 7, only re-drafting. It is of course conceivable that, contrary to patent law, he introduced additional matter during prosecution of the application before the Patent Office. However he has not pointed me to any such matter and indeed inspection of the relevant documents indicates that there is none.

26 I turn then to Mr McKenzie's second argument, that he contributed to the

development of the invention. He states that he recognised that the invention had wider application than containing the explosions in litter bins eg it could be used for military purposes such as containing explosions from detonated mines. He also describes technical work he carried out on the invention, including changing the position of the apertures in the member joining the inner and outer containers, altering the shape at the top of the structure and using fluids other than water. He states that he contacted the Patent Office regarding these changes and was reassured that they were covered by the application as it stood. He also states that the Home Office trial was unsuccessful when water was used as the fluid and only worked when it was replaced by a slag material.

- 27 There is no dispute that Mr Ogden is the sole inventor of the terminated application. What then is to be found in the patent which is not in the terminated application? The two are clearly very similar – the descriptions are practically identical and the figures are wholly identical. (I note that there are two figures in the application in suit – figures 6 and 7 - which are not in the terminated application and which in fact are also absent from the patent itself. However they appear to show little more than three dimensional views of what is shown in figure 1; and the point was not in any case raised as an issue by Mr McKenzie).
- 28 At the hearing I asked Mr McKenzie to point out any material differences between the patent and the terminated application and he referred me to a passage on page 3 of the patent which states “The inner spherical nature of the device is the fundamental item, which reduces and directs the force of the blast and the debris in a desired direction”. This wording is not to be found in the terminated application, but neither is it to be found in the application in suit. Unless this passage is introducing new matter, contrary to patent law, it can only describe what is already there, and indeed to the extent that I understand its meaning, it appears to be referring to the shape of the outer container. This is clearly shown as spherical in the drawings of the terminated application, and indeed the terminated application at page 2 also refers to “a hollow sphere”.
- 29 One difference is that the terminated application has no claims but the patent does. However the terminated application does have a paragraph on page 2 which sets out the inventive concept. This reads:
- In accordance with the present invention, a blast attenuating, blast-directing and extinguishing assembly comprises a housing for containing fluid or other material having an inner wall and an outer wall structure having one or a plurality of apertures such that force from a blast applied to the inner wall causes an increase pressure in said housing, the rise in fluid pressure causing displacement of fluid and/or material through said apertures. Energy from the blast is thus transformed to energy expended in displacement of the fluid from the housing.
- 30 This clearly bears a close relationship to claim 1 of the patent, and in my view wholly supports the conclusion that both relate to the same invention. For

completeness I note that there is no subject matter in the claims which is not in the description.

- 31 Having regard to the above I conclude that there is no material difference between the invention of the terminated application and that of the patent.
- 32 I understood Mr Ogden not to dispute that Mr McKenzie has introduced some developments to the invention, however none of these is mentioned in the patent; and it is the invention of the patent to which these proceedings relate.
- 33 I have concluded that the invention of the patent is the same as that of the terminated application. Since there is no dispute that Mr Ogden is the sole inventor of the terminated application, it follows that he is the sole inventor of the patent. The patent and the PCT application being identical, it also follows that Mr Ogden is the sole inventor of the PCT application.

### **Entitlement**

- 34 There is no dispute that Messrs Ogden and McKenzie embarked upon this project concerning the invention of the patent and the PCT application on the basis that they would share ownership equally, with Mr Ogden providing the technical input and Mr McKenzie the administrative input and the finance. At the hearing both confirmed that this was the case. It is this agreement which clearly underlies the exchange of solicitors' letters referred to above (although Mr White proposes a somewhat different division of responsibilities). I conclude therefore that there was a contract between Messrs Ogden and McKenzie, albeit an oral one, under which there was a clear understanding that the patent rights were to be shared.
- 35 This exchange of solicitors' letters, in which the parties agreed to formalise their agreement using Projectile as the vehicle, did not however come to fruition. In order to make a contract there must be a clear offer by one party and a clear and unconditional acceptance by the other and here we have an offer but no unconditional acceptance. Accordingly I conclude that Projectile has no contractual entitlement to a share in the patent rights.
- 36 In the light of these conclusions, I find that Messrs Ogden and McKenzie are jointly entitled to the patent and the PCT application, but that no rights fall to Projectile.
- 37 For completeness, I note that the issues as to how long the parties have known each other, what their technical expertise is, and why Mr Ogden was not made a director of Projectile – questions on which the parties' have strongly held and conflicting views – are not material to the above conclusions on inventorship and entitlement, and I need make no decision on them.

### **Declaration and order**

#### **The patent**

- 38 Having regard to my findings above, I hereby declare under section 37 that Mr Ernest Ogden and Mr John McKenzie are jointly entitled to patent number GB 2378382 and were so entitled when the patent was granted; and that Mr Ogden was the sole inventor.
- 39 Accordingly, I direct under section 13 that an addendum for the granted patent be prepared and the register amended to reflect my findings on inventorship.
- 40 As to entitlement, to give effect to the above declaration I could simply direct that the patent proceed in the names of Messrs Ogden and McKenzie as proprietors and that the register be amended accordingly. The terms of section 36 quoted above apply to the co-ownership of UK patents, and in the absence of any agreement to the contrary, Mr Ogden and Mr McKenzie would each have an equal share in the patent and could work it however he pleased without the consent of the other – but consent would be necessary if either wished to licence, assign or mortgage a share in the patent.
- 41 However, it seems to me that before making any order, I should give the parties the opportunity to negotiate an agreement, or at least to make submissions on the form of order I should make – something on which they might be well advised to seek professional advice. Accordingly I allow Messrs Ogden and McKenzie two months from the date of this decision in which to make submissions to this end if they so wish, hopefully in the form of an agreed joint submission. I should add that this should not be taken by either party as an opportunity to put in submissions on any other issue.
- 42 If there are no submissions, or none offering the possibility of a clear alternative way forward, I shall proceed as above and the terms of section 36 will apply. However I should make it clear that this would not in any way preclude the parties from reaching some other agreement in the future.

### **The PCT application**

- 43 Having regard to my findings above, I also declare under section 12 that Mr Ogden and Mr McKenzie are jointly entitled to international patent application number PCT/GB 2003/000293; and that Mr Ogden was the sole inventor. This declaration may if necessary be used in support of any request to the International Bureau, the European Patent Office or other appropriate authority to amend details of inventorship or ownership.

### **Costs**

- 44 Neither party has asked for costs and so I make no award.

### **Appeal**

- 45 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any

appeal must be lodged within 28 days.

**DAVID BARFORD**

Deputy Director acting for the Comptroller



**PATENTS ACT 1977**

BETWEEN

Ernest Ogden

Claimant

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John McKenzie and  
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Defendants

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PROCEEDINGS

References under sections 12, 13 and 37 in respect of  
patent number GB 2378382 and international patent  
application number PCT/GB 2003/000293

HEARING OFFICER

D J Barford

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**DECISION**

**Introduction**

- 1 In a decision dated 8 June 2006, following a hearing on the matter, I found that Mr Ogden and Mr McKenzie were jointly entitled to patent number GB 2378382 (“the patent”) and to international patent application PCT/GB 2003/000293 (“the PCT application”); and that Mr Ogden was the sole inventor. I also found that no rights fell to Projectile Limited.
- 2 In that decision I noted that under section 36, in the absence of any agreement to the contrary, Mr Ogden and Mr McKenzie would each have an equal share in the patent and could work it however he pleased without the consent of the other – but consent would be necessary if either wished to license, assign or mortgage a share in the patent.
- 3 Before making an order, I gave the parties the opportunity to negotiate an agreement, or at least to make submissions on the form of order I should make, and in an attempt to facilitate agreement, the Office proposed mediation. In the event, the parties submitted conflicting proposals and mediation did not go

ahead.

- 4 The matter therefore came before me at a hearing on 16<sup>th</sup> February 2007 at which both litigants appeared in person.

### **The law**

- 5 Relevant to the dispute are sections 12, 13, 36 and 37. These read:

#### **Section 12**

*12.-(1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made) –*

*(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or*

*(b) any of two or more co-proprietors of an application for such a patent for that invention may so refer the question whether any right in under the application should be transferred or granted to any other person;*

*and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.*

*(2) ....*

#### **Section 13**

*13.-(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.*

*(2) ..*

*(3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.*

#### **Section 36**

*36.-(1) Where a patent is granted to two or more persons, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.*

*(2) Where two or more persons are proprietors of a patent, then, subject to the provisions of this section and subject to any agreement to the contrary -*

*(a) each of them shall be entitled, by himself or his agents, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would apart from this subsection and section 55 below, amount to an infringement of the patent concerned; and*

*(b) any such act shall not amount to an infringement of the patent concerned.*

*(3) Subject to the provisions of sections 8 and 12 above and section 37 below and to any agreement for the time being in force, where two or more persons are proprietors of a patent one of them shall not without the consent of the other or others -*

*(a) amend the specification of the patent or apply for such an amendment to be allowed or for the patent to be revoked, or*

*(b) grant a licence under the patent or assign or mortgage a share in the patent or in Scotland cause or permit security to be granted over it.*

*(4) Subject to the provisions of those sections, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.*

*(5) Where a patented product is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.*

*(6) Nothing in subsection (1) or (2) above shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.*

*(7) The foregoing provisions of this section shall have effect in relation to an application for a patent which is filed as they have effect in relation to a patent and -*

*(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and*

*(b) the reference in subsection (5) above to a patented product shall be construed accordingly.*

### **Section 37**

*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.*

(2) ..

### **The invention**

6 The patent (and the PCT application which is identical in wording to the patent) is entitled "Blast attenuating, blast-directing and extinguishing apparatus".

7 Claim 1 is the only independent claim and at grant reads:

A blast attenuating, blast-directing and extinguishing apparatus, comprising of an open mouthed inner container housed within an open mouthed partially spherical outer container with a cavity defined between the two containers containing a fluid with extinguishing capabilities such as water, the wall of the outer and inner containers being joined by a member having a number of apertures adjacent the mouth of the inner container.

8 As described, the invention finds particular application in dealing with the problem of terrorist bombs placed in litter bins, and to this end the inner container may be used to receive a bin. In the event of an explosion, the inner container will deform, forcing jets of fluid and debris through the apertures in the member joining the inner and outer containers rather than radially outwards, and dispersing energy from the blast. The apparatus may be made of plastics, fibreglass or metal. The fluid may be water.

9 Wider applications were also discussed at the two hearings. There is no dispute over this and Mr McKenzie helpfully summarised the position as follows: "The device has only two uses. One of them is to contain the explosive properties from an explosive device placed inside the apparatus by parties wishing to minimise peripheral damage. In other words to contain the explosion. The other is to act as a deterrent and/or contain an explosion from a device placed in the apparatus by unknown persons for terrorist purposes."

### **The issues**

10 Following the first hearing, I invited the parties to make submissions as to the form of order I should make.

11 In response, on 7 August 2006, Mr McKenzie submitted a draft partnership agreement under which 'Both parties to this agreement will have the ability to operate individually without the consent of the other to achieve the common goal of the partnership, including the business of designing, marketing, manufacturing, leasing and selling all & any products associated or linked in any way to the above patents, but with the consent of both being required to grant licences'.

12 On 8 August 2006, Mr Ogden's attorney (Mr Robin Bartle of WP Thompson & Co) submitted a proposal under which each party would have the independent right to work the invention, to license it and to assign his share in it with Mr McKenzie

bearing all future renewals costs. He also proposed that Mr McKenzie should give full details of all other patents and patent applications he has made in respect of the invention and should take the steps necessary to record the parties as joint owners of them.

- 13 Mr McKenzie envisages seeking the approval of the Home Office Science and Development Branch which evaluates such specialist devices for approval and inclusion in a restricted publication known as the "Blue Book". This is made available to the police, security services and government departments who may wish to purchase such devices. Mr McKenzie believes that all parties would need to be included in any agreement with the Home Office for national security reasons, and that this precludes independent operation. He also has concerns over the dilution of what he sees as a limited market that would result from the parties acting independently and/or through having unrestricted freedom to license the invention.
- 14 At the hearing however Mr McKenzie proposed that he be granted the authority to act on behalf of both parties. He also proposed that
- all profit from sales and royalties is divided equally between the parties
  - the consent of both parties is required to grant licences, and a procedure is set up and/or a third party is appointed to deal with the requirements of the Home Office etc
  - if and when Home Office approval is obtained, the parties sell or assign their combined rights to the highest bidder
- 15 Mr Ogden's position is that, in the light of events, he has no trust in Mr McKenzie and any form of co-operative exploitation would be unworkable. He sees no problem with the Home Office, arguing that if they each make a device covered by the patent, the devices can be independently tested and independently approved or rejected; there being a wide market for the invention.

### **Authorities**

- 16 Mr McKenzie referred me, directly or indirectly, to the following authorities: *Florey & Others' Patent* [1962] RPC 186; *Patchett's Patent* [1963] RPC 90; *Oliver Jevons v Minnesota Mining and Manufacturing Company* (BL O/277/02, BL O/220/02, BL O/417/01); *Roger Michael Elliott and BSP International Foundations Limited v Expotech Limited* (BL O/132/05); *Andrew Webb v Sandra Agnes McGriskin* (BL O/410/00, BL O/135/00, BL O/036/00); *Michael Wayne Crabtree v Raph Barclay Ross* (BL O/185/05 and BL O/267/05); and *Derek Hughes v Neil Paxman* [2006] EWCA Civ 818.
- 17 Mr McKenzie pointed out that it is clear from *Florey* and *Patchett* that co-patentees are entitled to equal shares unless there is an agreement to the contrary.
- 18 In *Jevons* (BL O/220/02) he referred me to the statement by the comptroller's hearing officer that "Being judicial means that I must take into account the public interest consideration that my order should endeavour to stimulate exploitation of the invention, not stifle it". He also noted that in the *Jevons* case there was a

very poor relationship between the parties leading the hearing officer to state that “both sides seem to accept that further legal disputes between them are almost inevitable”. Mr McKenzie argued that going through the Home Office route would reduce the risk of that in the present proceedings since matters would effectively be taken out of the parties’ hands.

- 19 In *Elliott*, Mr McKenzie noted that because of the breakdown in communication between the parties, cross licensing was ordered. He also noted that renewal fees were to be shared; as is the case in *Jevons*, *Elliott* and *Webb*.
- 20 Mr McKenzie pointed out that it is clear from the *Crabtree* decisions that section 37(1) provides me with the authority to override the default terms of section 36; and in *Hughes*, the Court of Appeal confirmed that, in the event of a deadlock, section 37 gives the comptroller the power to allow one co-owner to grant licences even when another co-owner refused.
- 21 I think there is no dispute over the key principles to be drawn from these authorities, namely that I have jurisdiction under section 37 to override the default provisions of section 36, and that a major consideration that I need to take into account is the public interest consideration that the invention should be exploited rather than stifled.
- 22 However, I pointed out at the hearing that the decisions in those cited cases which deal with issues similar to those in these proceedings appear in fact to support Mr Ogden’s request for independence of operation rather than Mr McKenzie’s request for cooperation. Mr McKenzie disputed the relevance of these decisions on the grounds that the circumstances in the present case are completely different in terms of the nature of the market and the need to go through the Home office.
- 23 In *Jevons* (BL O/220/02) the hearing officer states that “Being pragmatic ... means that I must take account of the very poor relationship between the parties. Thus as far as possible my order should minimise the need for the parties to liaise with one another and minimise the scope for any further dispute between them”. Accordingly, in his final decision, the hearing officer ordered that each of the parties was deemed to have a royalty-free licence and the right to sub-licence without the consent of the other, ie they could act complete independently of one another.
- 24 In *Elliott*, the hearing officer refers to “the bitter antagonism between the parties” and having directed that the patent in suit be jointly owned, imposed a licence which gave BSP and Expotech freedom to work the patent independently (through the mechanism of royalty free cross-licensing). He then went against the terms of section 36(3) and further in the direction of complete independence by giving each party the right to grant licenses without the consent of the other.
- 25 In *Webb*, again the hearing officer ordered (in BL O/135/00) the patent to proceed in the joint names of the parties (so that both were free to work it); with each having the freedom to license.

- 26 In *Crabtree*, the hearing officer concluded that it was appropriate to make an order such that the parties could work the invention independently of one another in accordance with section 36(2). He said (BL O/267/05) that “with the parties remaining at loggerheads, I believe I should further minimise the potential for one party unreasonably to block a course of action proposed by the other” and ordered that “either party may grant a licence .. without the consent of the other”.
- 27 Thus in these cases, given the circumstances, notably lack of trust between the parties, not only were the terms of section 36(2) applied - ie the parties could work the invention themselves independently of one another – but the terms of section 36(3) were *not* applied; and instead each party was given the right to grant licences without the consent of the other.

### **Other documents**

- 28 Mr McKenzie filed copies of the following documents with his skeleton argument:

*European IP Bulletin, Issue 33, July 2006, published by the international law firm of McDermott, Will and Every.* He drew attention to part 6 of this document which refers to *Derek Hughes v Neil Paxman* [2006] EWCA Civ 818. I have referred to this above.

*The IPR Helpdesk (funded by the European Commission), ‘Joint ownership in Intellectual Property Rights’, April 2006.* This sets out, non-controversially, the legal background in Europe to co-ownership of intellectual property rights with particular reference to copyright and to patents.

*World Patent and Trademark News, 24 November 2006, published by D.P. Ahuja & Co., Patent and Trademark Attorneys of Calcutta, India.* This again quotes the judgement in *Hughes v Paxman*.

*Thailand Law Forum, 13 February 2007.* This quotes sections of what appears to be the patent law in Thailand. Mr McKenzie referred me to a section which sets out the rights of the patentee. However since this relates to a different jurisdiction it can carry no weight under UK law.

*Mutual Co-ownership Patents Agreement.* This was downloaded from a Russian government website and appears to be a model agreement drawn up under French law. This also carries no weight under UK law.

- 29 Mr McKenzie handed up a mass of other documents at the hearing dealing with the subject of joint ownership - in this jurisdiction and in others. In the main these documents are undated and their original source is not clear, they appear to have been drawn largely from the internet. Some but by no means all were referred to at the hearing by Mr McKenzie. Having read them in the light of the submissions at the hearing, it seems to me that they add nothing of significance to an understanding of the key legal principles that underlie this dispute – which I have already summarised above - and to the options open to me in terms of any order I might make. I conclude that I do not need to consider them further.

30 Mr McKenzie also handed up a number of documents relating to the market for the invention and the role of the Home Office. These documents include:

An introduction to the Home office Scientific Development Branch (HOSDB) which describes the work of HOSDB as providing “technical, operational and policy support to all areas of the Home Office, UK police forces, the security services and other government departments”. The document states that HOSDB “works in partnership with universities and industry to develop new equipment and techniques” and may “act as a broker between commercial manufacturers and our customers”.

A draft proposal and business plan for the London Bridge Business Improvement District April 2006 to March 2011, developed by the Pool of London Partnership in June 2005. This refers to investment that has already been made in the local environment covering projects ranging from a new theatre to extra street signs. Included in this list of nine projects is a reference to “extra litter bins to bomb-proof standard”. Mr McKenzie said that this requirement had yet to be met.

A document entitled “The International Crime Science Network” published under the auspices of University College London and including, in a list of four examples of the work it is driving, “design of bomb-proof litter bins”. This document is undated but appears to be current since it advertises conferences scheduled for July 2007.

Two documents relating to the specification and testing of a bomb-proof bins available from a corporation in the United States called Total Security Services International Inc; and a press release dated January 2007 from a US representative Anthony Weiner calling for the introduction of bomb-proof bins in the New York subway. In this context Mr McKenzie said that “there is not one bomb-proof bin in the UK or internationally that has been sanctioned”.

A printout from the Daily Telegraph website dated 19 June 2001 which states that “Litter bins are to return to railway stations and civic centres after scientists have developed bomb-proof bins”. Mr McKenzie said that this did not go ahead since the bins in question were not up to scratch.

31 Although Mr McKenzie has not substantiated his assertion that there are currently no bins fit for purpose on the market, these documents do indicate that there is a level of interest in bomb-proof bins. Indeed if anything I think all of this supports Mr Ogden’s contention that there is a significant market out there, albeit a specialised one.

32 The HOSDB document provides helpful background. However Mr McKenzie has provided no evidence of any dealings he has had with HOSDB and in particular no evidence of any concerns that department might have in dealing with two joint owners acting independently of one another.



## Conclusions

- 33 As noted above, of the precedents quoted where relationships had broken down, none provide any support for Mr McKenzie's preferred model of two parties completely at odds with one another being constrained to work in tandem; or, as he proposed at the hearing, to work under a partnership agreement with one party granted the authority to act for both. On the contrary, invariably the orders made effectively gave the parties complete independence.
- 34 Mr McKenzie's case is that the market for this particular invention is such as to distinguish the present case from these precedents. He argued that the market lay through Home Office approval and sanction and that it made no sense to duplicate the effort involved in gaining sanction.
- 35 Mr Ogden agreed that Home Office sanction would be required but argued that the market was a large one – including use in railway stations, banks, post offices and airports as well as military applications – and he saw no reason why the Home Office should not sanction more than one device
- 36 Mr McKenzie was also concerned that complete independence to grant licences might flood the market and dilute the monopoly under the patent. Mr Ogden accepted the point and proposed that that the number of licences each could grant should be limited, although he saw no reason why he would wish to grant lots of licences and dilute the monopoly, since he was in a position to manufacture the invention himself.
- 37 The two key criteria that I need to bear in mind are the need to be fair to both parties and the need, as already noted, to take into account the public interest by ensuring that the invention is worked.
- 38 Although decisions by the comptroller's hearing officers are not binding on me, given the manifest breakdown in relations between the parties – particularly from Mr Ogden's viewpoint, I would need very strong reasons to depart from the line adopted in those decisions referred to above, namely to give a high degree of autonomy to co-owners.
- 39 I think there is substance in Mr McKenzie's argument in favour of complete cooperation between the parties having regard to the nature of the market, but to my mind that is comfortably outweighed by the improbability of the two working together productively. I am also concerned that by cooperation Mr McKenzie means a partnership in which he is in charge. This last factor also impinges on the question of public interest, since a further breakdown could stop the invention from being worked at all. Regarding Home Office sanction, as noted above, Mr McKenzie has provided no evidence of any dealings he has had with HOSDB and in particular no evidence of any concerns that department might have in dealing with two joint owners acting independently of one another.
- 40 I therefore propose to order that that the terms of section 36(2) apply, namely that the parties shall each have the right to work the patent without the consent of or the need to account to the other.

## **Licensing**

- 41 Here again Mr Ogden wants the freedom to license without consent; Mr McKenzie wants consent. Mr McKenzie stated at the hearing that in his view neither he nor Mr Ogden had the ability to manufacture the invention; Mr Ogden said that he could manufacture. Having decided that each party should have the right to work the patent without the consent of the other, it seems to me that if I take the word of each as regards his own ability to manufacture, then Mr Ogden can go straight ahead and manufacture off his own bat, but Mr McKenzie would have to grant a licence in order to work the patent and would be placed at a potential disadvantage if he needs to secure Mr Ogden's consent to that. I am minded in any case to allow the parties to license without consent for the same reason that I concluded that the terms of section 36(2) should apply, namely that the poor relationship between them does not inspire any confidence that seeking one another's consent to grant licences would be a workable proposition.
- 42 Regarding the possibility of the market's being flooded through the granting of multiple licences, that seems to me to be an unlikely event since it would go against the interests of both parties and of any existing licensees. Limiting the number of licences that could be granted is a possibility, but looks to be an artificial constraint with unpredictable consequences – since the impact of any particular licence will depend on its terms and on the manufacturing capacity etc of any licensee. I conclude that I should simply allow the parties to license without consent.

## **Amendment, assignment etc**

- 43 There was little discussion over the other matters (ie additional to granting licenses) covered by section 36(3); and I am not persuaded that the case has been made for overriding the default position of section 36(3) in these respects. Accordingly I propose to draw a line there and require the consent of the parties if either wishes to amend or revoke the patent, or to assign or mortgage his share in the patent etc.

## **Payment of fees**

- 44 The other principal issue in dispute is who should bear the cost of renewal fees and any other charges. Mr Ogden's position is that the agreement between the parties was that he would provide the invention and Mr McKenzie the administration and the finance. Mr McKenzie said that he provided the finance simply because Mr Ogden was in no position to, and felt that Mr Ogden should contribute half to all fees past and present. Mr McKenzie stated at the hearing 'I originally said I would finance the project up to UK standard because Mr Ogden could not, but I have subsequently been left in the position of being forced into continuing to finance all renewals and national phase applications.' He seeks payment by Mr Ogden of at least 50% of what he has paid to date.
- 45 With regard to renewal fees for maintaining the patent both parties are agreed that from this date forward these should be shared equally. Mr Ogden will not

accept liability for fees incurred up to this date whereas Mr McKenzie believes these fees should also be divided equally.

- 46 In my decision of 8 June 2006, I took the position to be as stated by Mr Ogden and my understanding was that Mr McKenzie had accepted that. Whether or not that was right does not affect the declaration and order in that decision. Mr McKenzie has not at any stage in these protracted proceedings pointed me to any evidence to support his contention that there was a 50/50 agreement on funding from the outset (indeed his own words quoted above appear to indicate that he took responsibility for paying for the UK application at a minimum), and on that basis I see no reason to revisit the question. I conclude that Mr Ogden should be liable for half of any renewal fees paid on or after the date of this decision, but not to any costs incurred prior to that. I shall include in the order what I believe to be uncontentious provisions to smooth procedures for handling the issue of renewal fees.
- 47 If there are other significant expenses, for instance for litigation, then I think that is one case where the parties will need to consult and agree a course of action.

### **Foreign patents and patent applications**

- 48 There remains the question of foreign applications for the invention, in particular those derived from the international patent application, and Mr McKenzie confirmed at the hearing that he has filed several. Mr Bartle on behalf of Mr Ogden has requested full details of these. I understood Mr McKenzie to agree at the hearing that he would provide them, however he has written post-hearing resisting this on the grounds that 'Mr Ogden would have access to information that had cost me many thousands of pounds and provide him with an unfair advantage'; a position which is clearly untenable in the light of my findings.
- 49 Mr Bartle has referred me to the order given in similar circumstances in *Du Pont De Nemours & Co (Rebouillat's) Applications* [1996] RPC 740 (specifically, paragraph 4 of the order on page 755). It is clear from publicly available databases that published applications derived from the international patent application include EP1629250, AU2003303763, CA2513633, and CN1759294. If there are any other applications in the pipeline – for instance Mr McKenzie referred to applications in the United States and Russia - then he will need to provide the essential details. In fact he will need to file full details of all such patent applications and patents and I shall order accordingly. I shall also make provision for such patents and patent applications to be subject to the same declaration and order as the patent, subject in turn to the appropriate national or regional law.

### **Costs**

- 50 Neither side asked for costs in respect of the first hearing and in consequence no award was made. Both have asked for costs in connection with this second hearing. Although both sides have incurred the expense of putting in submissions and attending the hearing, there have been no costs at this second stage associated with statements, counterstatements or evidence rounds; all of

which were filed in connection with the first hearing. Any contribution towards costs would therefore be correspondingly low. Moreover although I have found in favour of Mr Ogden on all the major points at issue, bearing in mind the costs that Mr McKenzie has borne to date in respect of foreign applications – albeit that I have found against him as to his liability on this – I am inclined to make no award and to give the parties the opportunity to begin again with a clean sheet.

## **Order**

51 In accordance with my decision of 8 June 2006, I hereby declare that Mr Ernest Ogden and Mr John McKenzie (hereafter ‘the parties’) are jointly entitled to patent number GB 2378382 (hereafter ‘the patent’) and to international patent application number PCT/GB 2003/000293, published as WO 2004/065892, (hereafter ‘the PCT application’); and that Mr Ogden is the sole inventor.

52 In the light of this declaration and my conclusions above I order as follows:

In respect of the patent:

1. the patent shall proceed in the joint names of Ernest Ogden and John McKenzie as proprietors,
2. an addendum for the patent shall be prepared and the register amended to reflect my findings on entitlement and inventorship, with an address for service for both parties included
3. the parties shall each have the right to work the patent, including the right to license, without the consent of or the need to account to the other
4. neither party shall, without the consent of the other, amend the specification of the patent or apply for such an amendment to be allowed or for the patent to be revoked, or assign or mortgage a share in the patent or in Scotland cause or permit security to be granted over it.
5. the parties shall share the renewal costs equally. If either party does not wish to renew he shall notify the other party in sufficient time to allow that party to continue paying renewal costs if he so wishes. In any event, if either party fails to pay his share of the renewal costs within 30 days of the unextended period determined according to section 25(3) (without prejudice to any existing liabilities), his rights and obligations in respect of the patent under this Order (or otherwise) shall cease; and the other party shall be entitled to apply to the comptroller to be registered as sole proprietor.

I also order that:

6. within seven days Mr McKenzie shall disclose to Mr Ogden any other patent applications or patents claiming priority from the PCT application or from the patent, such disclosure to include all bibliographic data and current status information.

7. subject to the appropriate national or regional law, any such other patents and patent applications (including the PCT application itself) shall be subject to the declaration and order set out above in respect of the patent;

8. this declaration and order may be used by Mr Ogden in support of any request to the International Bureau, European Patent Office or other appropriate authority to amend details of inventorship or ownership; and Mr McKenzie shall do all acts and execute all documents required to support any such request.

9. after this order takes effect, either party may apply to the comptroller to vary its terms if there is any material change in circumstances, or to settle any dispute between them as to the application of the order in particular circumstances.

53 I have made no order in respect of any costs that might be necessary to enforce or defend the patent or patents. The parties will need to agree an approach appropriate to the particular circumstances if that eventuality should arise.

54 If an appeal is lodged, this order will be automatically suspended pending the outcome of the appeal.

### **Appeal**

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

**DAVID BARFORD**

Deputy Director acting for the Comptroller