



PATENTS ACT 1977

PROCEEDINGS

References under Section 8 of the Patents Act 1977
concerning entitlement to GB0215832.7 & GB0215833.5 and
Section 12 concerning entitlement to
WO2004/005355, WO2004/004880, EP1519963 and EP1526914

University of Newcastle-Upon-Tyne

Claimant

HEARING OFFICER

Stephen Probert

Decision off the paper

DECISION

Introduction

1. These proceedings are concerned with entitlement to two UK patent applications and two pending international patent applications. Both of the UK patent applications were terminated before publication, after serving as basis for priority claims respectively for the two international (PCT/GB) applications. The international applications have entered the regional phase before the European Patent Office (EPO) as EP1519963 & EP1526914. In the remainder of this decision I will refer to all of these applications collectively as 'the patent applications'.

Background

2. The person named as applicant and inventor on the patent applications is Prof. Galip Akay.¹ Prof. Akay was employed by the claimant between 8th January 1998 and 30th September 2013 as Chair of Chemical and Process Engineering at the University. Prof. Akay was informed of these proceedings by official letter dated 30th May 2014, and invited to file a counter statement if he wished to oppose the proceedings. As there was some doubt as to whether Prof. Akay received this first letter, a second letter containing the same information was sent to Prof. Akay at a different address on 25th July 2014.

¹ One of the terminated UK patent applications also named a research associate from Prof. Akay's research team as a joint applicant, but this person is not named in any of the live applications, and has not taken any part in these proceedings. By virtue of rule 77(9) he or she is treated as supporting the claimant's case.

3. Prof. Akay did not file a counter statement in response to either of these invitations, and consequently the Office wrote to him again on 9th September 2014 advising him that as he had not filed a counter statement, he would not be considered to be a party to these proceedings. Prof. Akay responded to this third official letter in a reply dated 17th September 2014. In his reply, Prof. Akay acknowledged receipt of two earlier official letters, but stated:- "*I haven't the faintest idea what these letters are about and what I am supposed to do about it. I assume that they are to do with my patents but that is all.*" He went on to refer to an on-going legal case between himself and Newcastle University, and questioned the appropriateness of the IPO being involved in these proceedings.
4. This was treated in the Office as a possible request for the Comptroller to exercise his discretion to decline to deal with the reference. Following submissions from the Claimant and Prof. Akay, the Comptroller subsequently refused to decline to deal.² While this was going on, the Office wrote to Prof. Akay again on 27th March 2015, reminding him that he had not filed a counter statement, and re-stating the consequences. Furthermore, Prof. Akay was advised that if he wished to oppose these proceedings, he would need to request a retrospective extension of time (with compelling reasons) in which to file a counter statement. No such request has been received, and therefore these proceedings have continued uncontested.

The Grounds

5. The claimant's grounds for seeking entitlement of the applications are very simple. Prof. Akay was a research professor employed by the claimant, and his normal duties were centred around research in the field of chemical and process engineering. It was very likely that Prof. Akay's research would lead to and/or result in patentable inventions. Prof. Akay co-authored several papers and conference proceedings related to the subject matter of the patent applications; these are listed in the claimant's statement.
6. The claimant says that in numerous instances Prof. Akay filed patent applications relating to inventions arising from his research himself, and the claimant had to take action to ensure that it was correctly named as the applicant. They also say that Prof. Akay was reminded on several occasions that inventions made in the course of his normal duties were the property of his employer - ie. the claimant.
7. The claimant says that the inventions in respect of which the patent applications were filed were made in the course of Prof. Akay's normal duties, and that as such, by virtue of section 39(1)(a)³, the inventions belong to the claimant. That being so, the patent applications relating to those inventions also belong to the claimant.

² See decision BL O/287/16 dated 14th June 2016.

³ **Right to employees' inventions**

39.-(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if -

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

Decision

8. Bearing in mind that these proceedings are uncontested, I accept the claims made by the claimant in relation to the patent applications and the inventions to which they relate.

Order

9. In view of the above, I make the following orders:-
 - a. The University of Newcastle-Upon-Tyne, and not Galip Akay, shall be named as the sole proprietor of GB0215832.7 and GB0215833.5,
 - b. International patent applications WO2004/005355 and WO2004/004880 should proceed solely in the name of the University of Newcastle-Upon-Tyne, and
 - c. The University of Newcastle-Upon-Tyne, and not Galip Akay, is entitled to any and all rights in or under European patent applications EP1519963A0 and EP1526914A0.

Costs

10. The claimant has requested a contribution towards its costs, but I am unable to make an order for costs as there is no other party involved in these proceedings.

Stephen Probert
Deputy Director, acting for the Comptroller