

DETERMINATION OF INVENTORSHIP

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Icon Plastics Pty Ltd v Laurence Clifford Scott [2011] APO 84

Implications

This decision is significant as it suggests that the Australian Patent Office (Patent Office) has adopted a preferred view in determining inventorship. Previously, it was ambiguous as to whether inventorship was determined with regard to the disclosure of the specification or with regard to the invention as claimed. This decision suggests that the Patent Office is moving toward the US approach of determining the inventorship in relation to the invention as claimed.

This decision does not appear to be well-founded on Australian case law and highlights the lack of clarity surrounding determination of inventorship in Australia.

From a practical perspective it is important to ensure that the names of any individuals that have contributed to the inventive aspects as claimed are named. If the claims are amended during prosecution to incorporate additional features from the specification to differentiate over prior art, and those features were contributed by a person who is not listed as an inventor, it will be necessary to amend the inventorship details of the application prior to grant.

Summary of case

Australian patent AU 2006246325 was filed in the name of Laurence Clifford Scott on 11 May 2006. This application was entitled 'Air Duct' and was related to a moulded air duct and a method for making the moulded air duct.

On 28 January 2010, Icon Plastics Pty Ltd (Icon) served a notice of opposition to the grant of the patent under s59 of the Patents Act, in particular this case focussed on s59(a)(i) and s59(a)(ii).

S59(a)(i) provides a ground of opposition on the basis that the nominated person is not entitled to the grant of a patent. S59 (a)(ii) provides a ground of opposition on the basis that the nominated person is entitled to the grant of a patent but only in conjunction with some other person.

In determining inventorship, the delegate of the Commissioner applied the following three part inventorship determination test:

1. identify the 'inventive concept' of the invention as defined in the claims,
2. determine inventorship including the person responsible for the inventive concept and [should read 'at' instead of 'and'] the time of conception as distinct from its verification and reduction into practice, and
3. determine if contractual or fiduciary relationships between the parties at the time of the inventorship give rise to proprietary rights in the invention.

The delegate cited *UWA v Gray* in support of this methodology¹.

In this case, the delegate identified that the inventive concept in claim 1 was the incorporation of an enlarged cross-section joint portion intermediate the ends. Based on the submitted evidence, the delegate ruled that Royston Douglas Bull of Icon was the sole inventor, and that Laurence Clifford Scott was not entitled to the invention.

Legal principles

The decision in *Polwood v Foxworth* provides the basis for determination of inventorship in Australia. In *Polwood v Foxworth*, it was stated that The invention or inventive concept of a patent or patent application should be discerned from

the specification, the whole of the specification including the claims². Furthermore, it was stated that To ascertain the inventor for the purposes of entitlement to the grant of the patent it is therefore necessary to determine the contributions to the invention described in the patent application. The claims may assist in that determination, bearing in mind that the claims may be to less than the totality of the invention³.

In light of the above, it seems that the recent Office decision to apply the three part test has resulted in a departure from the test established in the Polwood v Foxworth decision. The Patent Office has cited UWA v Gray as providing grounds for

adopting the three part inventorship determination test.

The three part test was initially adopted by French J in the UWA v Gray single judge decision⁴. This approach was one of the grounds appealed by UWA in the Full Court decision on the basis that French J did not consider the specification as a whole, as required by Polwood v Foxworth⁵.

In the Full Court decision, the approach adopted by French J was affirmed⁶. The Full Court decision states Contrary to UWA's submissions on the appeal, French J did not consider the claims to the exclusion of all other material⁷. Indeed, it is clear from the initial ruling that French J considered both the description and claims of the specification to identify the inventive concept⁸.

Accordingly it appears that the test espoused by the Patent Office has been taken out of context and does not find legal basis in UWA v Gray.

Endnotes

1. University of Western Australia v Gray [2009] FCAFC 116 at 253
2. Polwood Pty Ltd v Foxworth Pty Ltd (2008) 165 FCR 527 at 61
3. Polwood Pty Ltd v Foxworth Pty Ltd (2008) 165 FCR 527 at 36
4. University of Western Australia v Gray (No 20) [2008] FCA 498
5. University of Western Australia v Gray [2009] FCAFC 116 at 224
6. University of Western Australia v Gray [2009] FCAFC 116 at 257
7. University of Western Australia v Gray [2009] FCAFC 116 at 223
8. University of Western Australia v Gray (No 20) [2008] FCA 498 at 1442 to 1470

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