

followed by a short form of assignment, only the latter being submitted for stamping and then registration at the Patent Office then the patentee would be caught by the arguments he had to meet. Furthermore he said, even if the parties were aware of the problem and had to bring the original international sale agreement into the country for stamping there would be substantial practical difficulties.

Mr Pumfrey provided a two part submission by way of answer to this general plea *ad inconveniens*. First he said there was no problem if the original agreement is merely an agreement to assign (as was the case, for instance, here). Such an agreement operates in English law to create and vest in the buyer an immediate equitable interest in the patent. Such an agreement may be entered in the register as a transaction affecting rights in it (see s.32(2)(b), r.44(4) of the Patents Rules 1990, and *Re Casey's Patents*⁵). But it is not itself an assignment or any of the other transactions, instrument or events specified in s.33. So it is simply not within s.33 and accordingly not within s.68. I think that must be right.

Mr Miller's submission also covered the case where the original sale agreement itself constituted an assignment. He said many people entering global deals would have little concern whether their agreement was an actual assignment or merely an agreement to assign. He may be right. I do not know whether there are in fact many global sale agreements which are in themselves assignments. Nor did Mr Pumfrey. He said that if there were such documents then they are within s.33 and so s.68. He submitted that parties who enter this kind of arrangement know there are local formalities to be complied with in various countries. Here the formality is that the assignment must be registered and failure to do so results in the s.68 sanction. If people enter into a short form after the patent has already been assigned, they have not done that which is required by s.33. So that may be an unintended consequence of s.68, but it is the consequence all the same. Mr Pumfrey, if he is otherwise right, must be right about this too. Whether that in practice could create problems in a large number of cases I do not know.

⁵ [1892] 1 Ch.104