PATENTS ACT 1977

IN THE MATTER OF patent application GB 9613736.9 in the name of Mr Tony Hancock and a reference under section 8(1) and an application under Section 13(1) by Mr Francis James McGrath.

DECISION ON COSTS

1. When patent application GB 9613736.9 was made in July 1996 the applicant, Mr Tony Hancock, declared that he was the sole inventor. Subsequently Mr McGrath disputed this by applying in November 1996 under section 13(1) to be named as a co-inventor. Further, in January 1997 he referred to the comptroller under section 8(1) the question of whether he ought to be a co-proprietor with Mr Hancock of any patent granted on the application. These two related actions have been consolidated.

2. Mr McGrath was acting on his own behalf without professional assistance and his unfamiliarity with proceedings before the Office, and indeed at least one error made in this Office, created some confusion in the minds of Mr Hancock's representatives, Urquhart-Dykes & Lord, as to exactly what applications and references Mr McGrath had made. This gave rise to further correspondence and some delays but in the result, Mr Hancock filed appropriate counterstatements on the 30 June 1997 and Mr McGrath was given until the 17 September to file his evidence in chief.

3. Mr McGrath responded on the 7 September with what he referred to as a "reply" to Mr Hancock's counterstatement. The Office wrote back to Mr McGrath pointing out that this letter was not in the correct form and that evidence had to be given in the form of a statutory declaration or affidavit. At this point, Mr Hancock's representatives expressed concern that the specified procedures were not being followed resulting in the proceedings being unduly extended and asked whether security of costs should be provided by Mr McGrath whom they believed to be an undischarged bankrupt. This request was refused by the Office on the grounds that the circumstances were not such as to justify this step being taken.

4. Mr McGrath then wrote on the 31 October enclosing a statutory declaration and explaining why this had been delayed. At this point, however, it became known that the patent application had in fact lapsed and the Office accordingly wrote to Mr McGrath on 27 November pointing this out and suggesting that he should consider whether he wished to proceed with his actions as the relief which would now be available would be limited. The Office also pointed out to Mr McGrath that his statutory declaration was seriously defective in that it was not in fact evidence at all but little more than a statement that certain matters would be introduced into evidence later. The Office explained that this was not acceptable because now was the time for him to submit all his evidence in chief, and that while the Hearing Officer would consider any requests for evidence to be admitted later, there was no guarantee that any such request would be allowed.

5. Mr Hancock formally opposed the admittance of Mr McGrath's "evidence" on the basis that it was out of time and that the delays and extensions of time were not in accordance with the Rules and should not be allowed. However, on 12 January 1998 Mr McGrath responded to the Official letter of 27 November by withdrawing the application under section 13 and the reference under section 8.

6. As the actions have been withdrawn, the only question remaining for me is that of costs. Mr Hancock has asked for costs because he considers the proceedings were frivolous and vexatious. Indeed he asked the comptroller to exercise his discretion as to the level of costs as in *Rizla's Application 1993 RPC 365* in which the comptroller awarded compensatory costs because he believed that the action had been continued without any genuine belief that it could have succeeded. In support of this view he alleged that Mr McGrath had made no serious effort to establish a case, that there was in fact no case to be tried, and that the proceedings were overly drawn out by extensions of time. He also provided some unsworn evidence as to what the proceedings had cost him by way of agents' fees. Mr McGrath on the other hand disputed the claim to costs, observing in a letter that had not the patent application lapsed he would have continued with his actions.

7. Having considered all the circumstances I see no grounds for making any costs order. While it is true that there have been certain delays in the prosecution of this case I do not think any have been wholly unreasonable, either in nature or in duration. It is also true that Mr McGrath's unfamiliarity with procedures and the kind of hard evidence which would be needed to support his actions has caused some difficulties but I see absolutely nothing to suggest that Mr McGrath

has done other than his level best to take matters forward. Further, when he was told that the patent application had been terminated and that as a result the relief available to him was limited, he very sensibly withdrew the actions rather than involve both sides in more expense.

8. As to whether there is in fact an issue to be tried, though I accept that the wholly unsatisfactory nature of the "evidence" Mr McGrath submitted might appear to suggest that he has no case, it is equally possible that the defects in his evidence are solely the result of Mr McGrath's inexperience in legal matters and it would I think be quite incorrect for me to penalise him for this without at least having had the benefit of hearing the parties. Thus, I do not think that at this stage I can possibly say that there was no case.

9. Thus, in conclusion, I shall make no order for costs in these proceedings, which are now terminated.

10. As this decision is not on a matter of procedure, under the Rules of the Supreme Court any appeal against it must be filed within six weeks.

Dated this 24th day of April 1998.

P HAYWARD
Superintending Examiner, acting for the Comptroller.
THE PATENT OFFICE