

## **PATENTS ACT 1977**

### **IN THE MATTER OF**

references under Sections 8 and 12

by Dr Christopher Oldfield

in respect of patent applications nos GB 9905668.1, EP97933797.9,

PCT/GB98/02217, PCT/GB97/02055 and PCT/GB00/00841

in the name of The Court of Napier University

### **DECISION ON COSTS**

- 1 This decision relates solely to the question of the award of costs following the withdrawal of a reference made under sections 8 and 12 of the Patents Act 1977 (“the Act”).

#### **Background**

- 2 Dr Christopher Oldfield (“the referrer”) referred to the comptroller under sections 8(1)(a) and 12(1)(a) of the Act the question of entitlement to the grant of patents in respect of one application under the Act, one application under the European Patent Convention and three international applications under the Patent Co-operation Treaty filed in the name of The Court of Napier University (“the opponents”). By number, the applications are GB 9905668.1, PCT/GB98/02217, PCT/GB97/02055, EP97933797.9 and PCT/GB00/00841. The reference was originally filed on 2 March 2000 in respect of the first three applications as I have listed them but was amended on 12 April to cover all five. The opponents filed a counterstatement on 21 June 2000.
- 3 The referrer’s evidence-in-chief began to be filed on 4 September 2000 but was not formally completed until 23 November. The opponent’s evidence-in-chief followed in February 2001. The date of 9 May 2001, which included an extension, was set for the filing of the referrer’s evidence-in-reply. In the meantime, in a letter dated 16 March 2001, the Office took steps to begin arrangements for setting a date for the substantive hearing, to which the opponents responded in letters dated 17 April and 9 May.
- 4 In a letter also dated 9 May, the referrer withdrew the reference, while purporting to maintain the referrer’s entitlement. The withdrawal is explained in the following terms:

“The content of several of the applications, and in particular the most recently filed PCT application (PCT/GB00/00841), was only made available to Dr Oldfield at publication. Following an in-depth review of the content of the published applications it appears that these applications are based upon conceptual work carried out by Dr Oldfield but do not include the required technical information for performance of the inventions which, at the time of filing the applications, had not been fully investigated. Therefore Dr Oldfield considers these applications as prematurely filed, and of limited practical value in protecting commercial developments in the field of interest.”

- 5 In a further letter dated 22 May the opponents acknowledge the referrer's withdrawal and respond to the paragraph I have just quoted. Among other things they argue that the withdrawal of the reference can only be interpreted as an admission that all patents and patent applications in the name of The Court of Napier University are the property of the University.
- 6 In that letter and another of 13 June, the opponents request that a "maximum" or "full" award of costs be awarded in their favour. The referrer in a letter of 11 June believes that both sides should bear their own costs. Both parties have agreed that I decide the matter of costs on the papers, and I shall now do so. I should though make absolutely clear that this decision addresses only that matter of costs, and I make or imply no comment on the referrer's or the opponents' contentions as to any other implications of the withdrawal of the reference.

### **The parties' submissions on costs**

- 7 In seeking a maximum or full award of costs, the opponents variously say that the referrer's claim was vexatious, completely without foundation and opportunistic *ab initio*, and they see the withdrawal of the entitlement claim as confirmation of their view. The referrer says that this action is part of a larger dispute between the two parties and the length of the entitlement proceedings is due in part to the drawn-out nature of the related proceedings. He explains that the present action was prompted by the breakdown in communication between the parties and a reluctance on the part of the opponents to provide information as to the detailed content of the patent applications. This latter allegation is inconsistent with the opponents' version of events which suggests the referrer saw each application from filing. The referrer also says that a hearing arranged earlier this year to deal with the related issues was cancelled by the opponents and has not yet been rearranged, thereby preventing him from discussing the present proceedings in combination with the related matters, and as a result, increasing his costs. He maintains that the present action which is closely related to the other issues would have been discussed at that time and could have rendered the present consideration moot. The referrer also says that he approached the opponents through a potential mediator with a view to resolving the present proceedings and the other outstanding issues including the question of costs. However, he says that the opponents did not take up this offer. The referrer therefore says that each side should bear its own costs.

### **Reasons for decision on costs**

- 8 I have considered the submissions from both sides very carefully, but I note they are just that: they are not evidence. I do not therefore feel able to attach any particular weight to a number of the referrer's comments about parallel proceedings, nor to the opponents' allegations as to the referrer's motivation. To the extent that I can take a view, I would say that the opponents have acted understandably to defend their interests in response to an attack the referrer was entitled to make. The behaviour of neither party has been obviously beyond what is reasonable and usual in proceedings such as these. What is clear is that the reference has been withdrawn at an advanced stage, by which time the opponents (and indeed the referrer) have been put to considerable expense. That said, the referrer has not left its withdrawal to the last breath, so some costs associated with preparing for a hearing will have been saved. To penalise the referrer unduly for that late,

but not too late, withdrawal could I believe send a signal that unwanted proceedings should be pursued to the bitter end; it is far better, and consistent with the overriding object of civil justice, that they should not.

- 9 Looked at in the round, it seems to me that what all this amounts to is that the referrer launched a reference, it was opposed, it proceeded, and was eventually withdrawn. The result was that the opponent was put to trouble and expense by the referrer, and is therefore I believe entitled to an award of costs.
- 10 Costs awards in proceedings before the comptroller are, as the Office's Tribunal Practice Notice 2/2000 explains, not intended to compensate parties for the expense to which they may have been put, but are only a contribution towards it. Costs awards are generally based on scales also set out in the Notice. There is discretion to make an award above the scale in cases where that is justified, for example by the unreasonable behaviour of one of the parties. I take the opponents' request that a "maximum" or "full" award of costs be awarded in their favour to be a submission that I should indeed depart from the scale. However, on the basis of the reasoning I have given earlier, I am not persuaded that this is a case in which I should do so.
- 11 Since the action was launched on 2 March 2000, the scale of costs set out in Annex B of Tribunal Practice Notice 2/2000 applies. Applying the guidance given in that scale to the circumstances of this case, it seems to me that an award of £500 would be appropriate.

#### **Order as to costs**

- 12 For the reasons I have given, I order that the referrer shall pay to the opponents the sum of £500 as a contribution towards their costs. This sum is to be paid within 7 days of the expiry of the appeal period from this decision unless an appeal is launched, in which event this Order will be suspended pending resolution of the appeal.

#### **Appeal**

- 13 This being a decision other than on a matter of procedure, the period within which an appeal may be lodged is six weeks from the date of this decision.

Dated this 11<sup>th</sup> day of December 2001

S N DENNEHEY  
Divisional Director, acting for the comptroller

**THE PATENT OFFICE**