



BL O/374/04

21st December
2004

PATENTS ACT 1977

BETWEEN

Donald M Western Claimant

and

Oliver Jevons Defendant

PROCEEDINGS

Application under section 72 of the Patents Act 1977 in
respect of patent number GB 2327052

HEARING OFFICER D J Barford

DECISION

Background

- 1 Patent application number GB 9719091.2 was filed on 10 September 1997, claiming no earlier priority date, and was granted as patent number GB 2327052 B (“the patent”) on 25 May 1999 under the title “Masking tape and application method”.
- 2 An application for revocation under section 72 was filed by the claimant on 8 January 2002. Matters proceeded, although it would not be true to say that they proceeded smoothly. The claimant filed a statement on 8 January 2002 and an amended statement on 22 February 2002. In response the defendant filed a counterstatement on 19 March 2002. The claimant then filed a supplementary statement on 1 May 2002 giving rise to an amended counterstatement filed on 15 July 2002. The evidence rounds followed, culminating in the claimant’s evidence in reply which was filed on 22 July 2003. This raised further matters which were addressed in a supplementary counterstatement filed on 11 September 2003.

Security for costs

- 3 A further issue to arise was that of security for costs. Section 107(4) provides as follows:

If any of the following persons, that is to say -

(a) ...

(b) *any person by whom an application is made to the comptroller for the revocation of a patent;*

(c) ...

neither resides nor carries on business in the United Kingdom, the comptroller may require him to give security for the costs or expenses of the proceedings and in default of such security being given may treat the reference, application or notice as abandoned.

4 The defendant initially raised the issue of security for costs in a letter dated 4 June 2003. Further, upon Mr Western's stating in a letter dated 30 July 2003 that he had "sold his house and was off overseas for two months", the defendant in a letter dated 31 July 2003 questioned whether the claimant satisfied either of the criteria set out in section 107(4). Mr Western responded on 4 September 2003 with a bald statement that he satisfied both. The Office requested Mr Western to substantiate this, and when he failed to do so proposed in a letter dated 19 December 2003 that he provide security of £2000.

5 Following further exchanges with the Office - primarily through an email address which Mr Western accessed in South Africa - Mr Western in a letter dated 7 April 2004 stated that he would not provide security; made it clear that he had decided "not to carry out any business in the UK for the next few years or so"; and pointed out that he had commenced the action "prior to moving to South Africa".

6 It became clear from subsequent correspondence that Mr Western was withdrawing from the proceedings, and in a letter dated 12 August 2004 the Office indicated that in accordance with normal procedure, the issues raised under section 72 would be considered in the public interest. For completeness, I note that under section 107(4) it would in any case have been appropriate to treat this application for revocation as abandoned in these circumstances, where again the next step would have been to consider the issues in the public interest.

Revocation issues

7 I turn then to the issues raised under section 72, namely that the invention is not patentable due to lack of novelty through prior publication and prior use.

8 Mr Western has filed in evidence a number of documents, including statements by several witnesses. Much of this evidence is not in the required form and this was pointed out to Mr Western during the course of the protracted proceedings summarised above. Notwithstanding that, I have carefully considered all of the correspondence and documents received from and referred to by Mr Western, and having so considered, I decide to make no order for revocation of the patent.

Costs

9 The defendant has asked for costs. Submissions were invited on the matter but no detailed arguments were received from either side. In the circumstances it seems to me

right to award an appropriate sum to the defendant. I take note that, unlike the defendant, Mr Western was unrepresented in these proceedings. However Mr Western has introduced new matters at various intervals during the proceedings which have required the defendant to file amended and supplementary counterstatements. In addition, Mr Western has been given a considerable amount of advice on procedural matters by the Office, much of which he has chosen not to follow. As a consequence of all this, the defendant has in my view been put to unnecessary inconvenience and expense. That said however, I see no reason to depart from the published scale of costs, and guided by that scale, I award the defendant the sum of £1100 to be paid by Mr Western not later than 7 days after the expiry of the appeal period. If an appeal is lodged, payment will be automatically suspended pending the outcome of the appeal.

Appeal

- 10 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

DAVID BARFORD

Deputy Director acting for the Comptroller