



27 February 2009

**PATENTS ACT 1977**

BETWEEN

William Ford

Claimant

and

Threeway Pressings Ltd

Defendant

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PROCEEDINGS

Reference under section 8 of the Patents Act 1977 in  
respect of patent application number GB 0709447.7

HEARING OFFICER

J Elbro

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**DECISION ON COSTS**

**Introduction**

- 1 UK patent application GB 0709447.7 was filed on 17 May 2007 in the name of Threeway Pressings Ltd (“Threeway”). Mr William Ford filed a reference under section 8 of the Patents Act 1977 on 2 October 2007 accompanied by a statement of grounds alleging that he was entitled to the patent application as the true inventor and various documents to support this. Various allegations were also made about the potential validity of any granted patent as a result of which the Office wrote to Mr Ford on 17 December 2007 asking him to clarify his grounds.
- 2 Mr Ford filed an amended statement on 4 January 2008, and in response to further queries from the Office, a re-amended statement on 30 January 2008. In response, Threeway filed a counterstatement on 11 April 2008, and in response to an Office request for clarification, an amended counterstatement on 29 April 2008.
- 3 The Office asked the parties if they were prepared to try mediation in a letter of 7 May 2008. Mr Ford replied on 16 May 2008 indicating he was “prepared to give it

a try” but doubting that a satisfactory conclusion could be reached. Threeway replied on 21 May 2008 stating they had discussed mediation with Mr Ford, but no agreement about mediation or a timetable for proceedings could be reached and suggesting the Office propose a timetable.

- 4 As a result, a hearing date of the third week in November was set. Mr Ford filed evidence-in chief on 4 August 2008, and Threeway filed evidence on 19 September 2008, with some supplemental evidence following on 29 September 2008.
- 5 At this point, Mr Ford withdrew his request by letter of 29 September 2008. As a result, the hearing was cancelled. Threeway did not immediately become aware of this and notified the Office that they had appointed Counsel to represent them in a letter of 17 October 2008. On learning of the withdrawal, they requested costs in a letter of 29 October 2008.
- 6 Both parties were invited to make submissions on the question of costs for a decision to be made on the papers. Mr Ford argued in a letter of 10 December 2008 that no costs should be awarded. Threeway argued in a letter of 18 December 2008 that they should be awarded “the maximum costs available”
- 7 The patent application was published as GB 2449279 on 18 November 2008. Mr Ford has also submitted a number of observations on the validity of the patent under section 21 of the Act. These will be considered by an examiner should the application come to substantive examination (which has not yet been requested) and I am not in a position to consider the merits of them here.

### **Arguments and Analysis**

- 8 No argument has been made by either party that the conduct in the proceedings by either side has been such as to warrant the award of off-scale costs; I take the reference to “maximum” made by Threeway to refer to the scale.
- 9 Mr Ford argues that his entitlement action was fully justified; he has only withdrawn it because he has been advised by “a leading firm of patent agents” that it would be a waste of time to continue as the patent would (he says) be invalid if granted. He has submitted section 21 observations, as noted above, to deal with the validity question. He alleges that Threeway’s patent agent knows the patent application is flawed. Further, he notes his communication was always timely, that Threeway could have saved money by not using a patent agent, that he was willing to try mediation, and that he withdrew in plenty of time before the hearing.
- 10 In response, Threeway observes that Mr Ford did not provide evidence on validity prior to starting the entitlement proceedings and that “unsubstantiated suggestions” that the patent is invalid do not provide a good reason for abandoning the section 8 application. Further, on the subject of professional representation, they argue that if Mr Ford had himself obtained the professional advice earlier which led him to drop the claim, then the whole proceedings could have been avoided. Finally, they indicate that they were of the view, after discussions with Mr Ford, that mediation would be unlikely to resolve matters

quicker than continuing the proceedings – and consider the current outcome a vindication of that stance.

- 11 In my view, Threeway has been put to expense by Mr Ford starting and pursuing this application. Even if I were to accept his argument that he is now dropping proceedings because he can show the patent application should not be granted (and I make no finding on validity), Threeway is correct that that implies he could have avoided even starting the proceedings had he sought advice sooner. However, it is also true that Mr Ford withdrew in good time before the hearing, thus reducing the overall potential costs of proceedings, although the evidence rounds had already been completed. The volume of evidence on each side appears average for a case of this nature and although proceedings were not entirely smooth, this was not entirely the responsibility of either side and neither appears to have behaved unreasonably. In my view, it is appropriate that I make an award in the middle of the scale.
- 12 These proceedings were started prior to 3 December 2007, and therefore it is the scale published in TPN 2/2000 which applies. On that basis I award the sum of £1000 to Threeway and order Mr William Ford to pay Threeway Pressings Ltd the sum of £1000 as a contribution to its costs. This sum should be paid within 7 days of the expiry of the appeal period below. Payment will be suspended in the event of an appeal.

### **Appeal**

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

**J ELBRO**

Deputy Director acting for the Comptroller