



23 January 2014

## PATENTS ACT 1977

BETWEEN

Enviroform Solutions Limited

Claimant

And

Mr Glenn Melvin

Defendant

PROCEEDINGS

Application under section 72 of the Patents Act 1977  
for revocation of patent number GB 2479023

HEARING OFFICER

Phil Thorpe

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## DECISION ON COSTS

### Introduction

- 1 In a decision dated 14<sup>th</sup> November 2013<sup>1</sup> I concluded that GB 2479023, in the name of Mr Glenn Melvin, is as proposed to be amended both novel and involves an inventive step having regard to the prior disclosures put forward by the claimant. I was also satisfied that the amended specification discloses the invention clearly and completely enough for it to be performed by a person skilled in the art and that matter disclosed in the amended specification of the patent does not extend beyond that disclosed in the application for a patent as filed. I therefore dismissed the application filed under section 72 of the Patents Act 1977 by Enviroform Solutions Limited (Enviroform) on 16<sup>th</sup> May 2012.
- 2 On the matter of costs I made the following observations:

“Costs

66. This appears, prima facie, to have been a relatively straightforward revocation action that was not without merit and which elicited unconditional amendment. The claimant however continued to pursue its case following the amendment and was ultimately unsuccessful. Hence a cost order against it would seem to be justified.

67. It is long-established practice that costs awarded in proceedings before the comptroller are guided by a standard published scale. The scale costs are not intended to compensate parties for the expense to which they may have been put, but merely represent a contribution to that expense. This reflects the fact that the comptroller ought to provide a tribunal which, as

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<sup>1</sup> BL O/437/13

far as possible, has low and predictable levels of costs. Tribunal Practice Notice 4/2007<sup>2</sup> sets out the standard scale and explains how costs are to be determined. Subject to any convincing arguments to the contrary an award in accordance with the published scale would seem appropriate. Given the lightness of the evidence, the short duration of the hearing and that amendments were submitted, a cost award of the order of £800 to the defendant appears about right. I will however allow the parties 2 weeks from the date of this decision to make further submissions solely on the issue of costs. If no submissions are filed then I will make an order consistent with my preliminary assessment above.”

3 Only Enviroform made any submission.

### **The law**

4 Section 107(1) of the Act says:

*The comptroller may, in proceedings before him under this Act, by order award to any party such costs or, in Scotland, such expenses as he may consider reasonable and direct how and by what parties they are to be paid.*

Costs awarded in proceedings before the comptroller are as noted above guided by a standard published scale and are not intended to compensate parties for the expense to which they may have been put, but merely represent a contribution to that expense.

### **Argument and analysis**

- 5 Enviroform argues that both sides should bear their own costs. It notes firstly that it was only made aware of the unconditional section 75 amendments filed by Mr Melvin shortly prior to the preparation of its skeleton argument. It argues that it was not able to properly consider the amendments prior to “making our decision to attend the hearing”.
- 6 Secondly it notes that its preference was for a decision to be made on the papers without a hearing. I take this to mean that it does not believe it should have to bear the costs associated with the hearing.
- 7 I will consider the section 75 amendments first. These were submitted by the patent proprietor on the 16<sup>th</sup> July 2012 though as noted due to an error on the part of the IPO, the claimant was not copied in on the amendments until much later. The first point to note is that the filing of these unconditional amendments means that the claimant was successful up to that point in its action and is entitled to a cost award in its favour for the period up until 16<sup>th</sup> July 2012. This covers its preparation of its original statement. In line with the published scale and taking account of the relatively straight forward nature of the case an award of £300 to the claimant in this respect is justified.
- 8 If the claimant had ceased its action at that point then that would have been the end of the matter. It did not do this. Rather it continued to pursue its claim and lost. It is now arguing that it might not have pursued its case as it did if it had been properly copied in on the section 75 amendments. What the claimant does not make clear is precisely what would have been different. If it would have accepted the amendments

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<sup>2</sup> See [www.ipo.gov.uk/p-tpn-42007](http://www.ipo.gov.uk/p-tpn-42007)

then that would clearly be significant. But there is nothing to suggest this is what it would have done. Indeed its skeleton argument taking into account the section 75 amendments continues to argue that the patent with these amendments is still invalid. I also held a brief telephone case management conference just prior to the hearing to confirm whether the claimant was content to proceed with the hearing given the confusion about the section 75 amendments. It said it was.

- 9 I would add also that the section 75 amendments were referred to extensively in the defendant's counterstatement which was filed in July 2012. This was correctly copied to the claimant. A careful reading of this document would have in my view clearly identified the nature of the amendments proposed under section 75. The claimant's response to the counterstatement gives no indication that it was minded to accept any of the amendments.
- 10 Hence the failure by the IPO to properly copy in the claimant when the section 75 amendments were first filed, whilst regrettable, is not I believe significant on the matter of costs.
- 11 The second point is that the claimant was prepared to accept a decision on the papers and thus it should not have to cover costs associated with the hearing. That argument would have some strength if the claimant had been able to show that the hearing was unnecessary. It has not done that. I would observe that the hearing did in my view help to clarify the issues in hand. Hence I do not consider that the defendant acted unreasonably in asking to be heard and therefore I will need to reflect the cost of the hearing in my cost award.
- 12 I turn now to the quantum of the cost award. In accordance with the published scale and taking account of the relatively straightforward nature of the dispute I award the defendant £300 for preparing an amended counterstatement and dealing with the other side's statement and £500 for preparing for and attending the hearing. This is offset by £300 awarded to the claimant as a contribution to its expenses before the unconditional amendments were filed. This results in an award of £500 to the defendant. This is slightly less than the preliminary figure I suggested in the substantive decision but is based on a more detailed assessment of the proceedings and represents in my view a fair contribution to the Mr Melvin's overall expenses.

### **Conclusion**

- 13 I conclude that £500 is awarded to the Mr Melvin as a contribution to his costs in this matter. This sum is to be paid by the Enviroform Solutions Limited within 7 days of the expiry of the appeal period set out below.

### **Appeal**

- 14 Any appeal must be lodged within 28 days.

Phil Thorpe  
Deputy Director Acting for the Comptroller