



**PATENTS ACT 1977**

BETWEEN

Okipa Ltd and John Russell Clearwater

Claimants

and

Aaron Tindall

Defendant

PROCEEDINGS0057

Reference under section 12 in respect of  
international patent application PCT/IB2021/054892  
and related applications

HEARING OFFICER

J E Porter

---

**SUPPLEMENTARY DECISION – COSTS**

**Introduction**

- 1 These proceedings concern a dispute over entitlement to international patent application PCT/IB2021/054892 (published as WO/2021/245607 A1) and a number of related applications. The applications were all filed in the name of Aaron Tindall and concern a composition for eliminating or reducing undesired plant growth.
- 2 Okipa Ltd (“Okipa”) sought to be added as joint applicant for the applications or, if it were found that the inventive concept had not been assigned to Okipa, that John Russell Clearwater be added as joint applicant.
- 3 In a decision dated 17<sup>th</sup> June 2025 ([BL O/0541/25](#)), I found Mr Tindall to be the sole inventor of the inventive concept of the applications which are the subject of these proceedings, and thus to be solely entitled to the applications.
- 4 In my decision, I invited the parties to make submissions in relation to costs. They duly did so, and also agreed that the matter could be decided on the papers.

**The law**

- 5 Section 107(1) of the Act provides for the Comptroller, in proceedings before him under the Act, to award any party such costs as he may consider reasonable.
- 6 In proceedings before the Comptroller, it is long-established practice that only a contribution towards the successful party’s costs should normally be awarded, and

that the amount should be guided by the Comptroller's published scale of costs. The current scale is published in [Tribunal Practice Notice 1/2023](#) ("the TPN"). The TPN also says that there is discretion to award costs off the scale in order to "deal proportionately with unreasonable behaviour".

### **Submissions**

- 7 On 15<sup>th</sup> September 2025, I indicated to the parties my preliminary view that I saw no reason to depart from the standard scale of costs.
- 8 The defendant provided written submissions on 29<sup>th</sup> September 2025 in which he seeks scale costs at the higher end of the scale. He further seeks reimbursement of two renewal fees which became due at the European Patent Office ("EPO") in respect of the pending European patent application which forms one of the applications subject to these proceedings.
- 9 The claimants responded on 16<sup>th</sup> October 2025. Their comments are restricted to the reimbursement of the EPO renewal fees, to which they object. The defendant made some comments in reply to this point on 15<sup>th</sup> December 2025.

### **Assessment**

- 10 Having considered the parties' submissions and the conduct of the proceedings generally, I confirm my preliminary view that there is no reason to depart from scale costs. I proceed to consider the costs on that basis.
- 11 The defendant seeks costs which are the maximum available on the scale, namely £750 for costs relating to the statements, £2600 for costs relating to evidence, and £1900 for hearing preparation and attendance.
- 12 In his submission, these are justified for several reasons. The defendant refers to the complicated "longstanding background to the dispute" and "an extended chronology of events starting in 2002". He also points to the multiple potential inventions and patent applications, the correspondence and meetings between multiple parties and "multiple agreements/assignments between parties". In his submission "it is not the amount of evidence actually submitted in these proceedings which justifies an award at the higher end of the scale, but the lengths required by the Defendant to find and review evidence" pertaining to a 22-year period.
- 13 Thus, he says, a "substantial amount of time and effort was required to find, review and identify evidence from the lengthy period of time to support the defence". As an example, he points to the reference in my decision to the significant amounts of material and argument provided regarding discussions and work between the relevant people and the patent attorney. He also submits that some of the evidence that he identified, found and produced (such as certain email correspondence) was available to the claimants.
- 14 As I have noted, the claimants do not make any submissions on these points.
- 15 The TPN scale for preparing a statement and considering the other side's statement is £250 to £750, depending on factors such as the complexity and relevance. Neither statement was particularly lengthy although both sides included some

supporting documents annexed to their statements, which will have taken time to produce and analyse. The matters at issue covered a lengthy period of many years, and a somewhat complex business relationship with various different aspects to it. I also note that the claimants amended their statement in a few respects, which the defendant and his representatives will have needed to consider. Weighing these factors up, I think an award towards the top of the scale is justified, albeit not at the very top. I award £600 in this regard.

- 16 The TPN scale for preparing and considering evidence ranges from £600 up to £2600 if the evidence is “substantial”. The claimants’ evidence comprised three witness statements along with a number of exhibits. The defendant’s evidence comprised two witness statements also with a number of exhibits (the second witness statement was entitled “Second Counter Statement” but I agreed with the parties that it was evidence and should be treated as such). As the defendant says, the evidence itself was not particularly lengthy. But I agree that the claimants’ case required the defendant and his representatives to consider, review and find evidence going back over a very considerable time and many different meetings, exchanges, trials and other matters. On balance, an award towards the top of the scale is again appropriate, but not at the very top, and so I award £2100 in this respect.
- 17 In terms of preparing for and attending a hearing, the TPN scale sets a limit of £1900 per day. The hearing was a full day with reasonably lengthy cross-examination of the two key witnesses, as well as submissions across the range of issues in play. In the absence of any other submissions, I see no reason for reducing the allowed limit of £1900 as a contribution to the defendant’s work preparing for and attending the hearing.
- 18 Turning to the claim for official fees, as noted above the defendant seeks reimbursement of two renewal fees at the EPO, totalling £1609.48. The defendant says that examination of the pending European application was stayed in light of these proceedings. He argues that he was put to the expense of paying these EPO fees, which fell due for payment during the stay.
- 19 The claimants resist this. First, they say that the TPN heading of “Expenses” in regard to scale costs does not extend to payment of renewal fees but is intended to cover costs directly related to the conduct of the case. Second, they say that control of the European application remained with the defendant throughout the proceedings, and the defendant could have asked the EPO to lift the stay at any time. Nor, they say, did the defendant make enquires of the claimants for their consent to remove the stay.
- 20 Third, the claimants say that incurring of renewal fees was entirely out of their control, and any request for them to pay those fees now is not reasonable and was never foreshadowed. In that respect, they point to paragraph 5.51 of the Patents Hearings Manual which states that “care is needed because the other party will have had no say in the magnitude of the expenses incurred - see, for example, *Du Pont de Nemours and Co (Rebouillat's) Applications* [1996] RPC 740”.
- 21 Finally, the claimants say that the defendant had not requested processing to be resumed at the EPO despite the time elapsed since my decision and it was “not reasonable to claim costs incurred due to their inaction”.

22 In reply, the defendant denies that the TPN “Expenses” heading does not extend to payment of renewal fees, and points to the TPN reference to expenses including “Official fees arising from the action and paid by the successful party (other than fees for extensions of time)”. He says that the stay was “imposed by the [EPO] as a direct consequence of these proceedings”. He also submits that the stay was not entirely outside the claimants’ control, and points to rule 14(1) of the Implementing Regulations to the European Patent Convention, which says this:

*Stay of proceedings*

*(1) If a third party provides evidence that they have instituted proceedings against the applicant seeking a decision within the meaning of Article 61, paragraph 1, the proceedings for grant shall be stayed unless the third party communicates to the European Patent Office in writing their consent to the continuation of such proceedings. Such consent shall be irrevocable. However, proceedings for grant shall not be stayed before the publication of the European patent application.*

23 Thus, he says, the claimants “had the opportunity to communicate to the [EPO] in writing their consent” for processing of the application to continue, but did not do so. In terms of the point regarding paragraph 5.51 of the Patents Hearings Manual, the defendant says that it does not make his request unreasonable and submits that the guidance is concerned at this point with off-scale expenses. He submits that the fees for which reimbursement is sought are not off-scale, and points to section 4 of the TPN and a discussion of unrepresented parties’ costs which, he argues, supports the view that a costs award in relation to official fees is considered by the TPN to fall within the remit of the “contribution-not-compensation” approach of scale costs.

24 The defendant also points to the decision in *Cygnnet Texkimp Limited v Crompton Technology Group Limited* ([BL O/749/22](#)), where the hearing officer awarded costs in relation to the additional renewal fees payable to the EPO as a consequence of the staying of EPO proceedings pending a final determination in the entitlement proceedings in question.

25 On the claimants’ fourth point, the defendant reiterates that he is requesting only those official fees payable during the stay which was caused by these proceedings but not any fees payable outside the stay. He says that the 4<sup>th</sup> year fee was paid on 20 June 2024 and the 5<sup>th</sup> year fee on 13 June 2025.

26 I deal first with the point regarding the TPN and the meaning of “Expenses”. The entry is clearly in the Annex and thus concerns scale costs, rather than an off-scale award. The wording of the entry (“official fees arising from the action”) nevertheless leaves some room for interpretation. As noted above, the claimants say that it is intended to cover costs “directly related” to the present case. The defendant says that the stay was “a direct consequence” of the present proceedings.

27 Clearly the EPO renewal fees did not arise as fees within these proceedings themselves. But, on the basis of the information I have, the EPO stay and resultant fees do appear solely to have “arisen from” the existence of the present proceedings – to use the TPN wording. In light of this, and bearing in mind the *Cygnnet Texkimp* decision in which EPO renewal fees arising from a stay were reimbursed as part of scale costs, I am satisfied that these fees are within the scope of the “Expenses”

entry<sup>1</sup> and so a scale costs award can potentially be made on this basis. There are, however, other points to consider.

- 28 Turning to the points about control, the claimants say that the stay (and therefore the fee expenditure) was outside of their control, and that control regarding the stay remained with the defendant.
- 29 However, it is not entirely clear to me from EPC rule 14(1) (reproduced above) that this is the case. On the assumption that the claimants were the “third party” within the meaning of the rule, whose evidence of instituted proceedings gave rise to the stay in the first place, the rule does not then appear to provide a basis for the defendant to seek lifting of the stay – other than by trying to persuade the claimants to give their consent. The rule suggests that the claimants were free to consent to continuation of the EPO proceedings if they so wished.
- 30 While paragraph 5.51 of the Patents Hearings Manual notes that “care is needed” when considering expenditure over which a party had no control, I do not see anything in the above position and the matter of “control” under rule 14(1) EPC which provides a basis for refusing a reimbursement of the renewal fees in question. That is particularly so given the previous example of the *Cygnnet Texkimp* decision.
- 31 With regard to the claimants’ point that the defendant had not requested processing to be resumed at the EPO after my decision, I do not see this is relevant. The renewal fees in question arose, and were paid, while the present proceedings were ongoing.
- 32 It seems right to me that an award on the scale can and should be made to reimburse the defendant for these fees. However, turning once again to the *Cygnnet Texkimp* decision, I note that the amount awarded as reimbursement of the EPO renewal fees was reduced. This was to recognise that, had the European patent proceeded to grant sooner, renewal fees would in any case have been payable before national offices. The detailed calculation is not presented but the net amount awarded on this front was £1000.
- 33 That seems a fair approach to me. It is equally true in this case that, had the European patent been granted sooner, the defendant would not have had to pay the EPO year 4 and 5 renewal fees but would instead have paid renewal fees at national offices following grant.
- 34 I do not think it feasible to go into a detailed calculation regarding various national renewal fees, nor do I think it proportionate to put the parties to the expense of making further submissions on the point. Given the sum involved and the general contributory nature of scale costs, it is sufficient for me to conclude that the defendant’s expenses with regard to the EPO renewal fees for years 4 and 5 should be reimbursed with an appropriate reduction. On that basis, £1000 is awarded.

---

<sup>1</sup> The hearing officer in the *Cygnnet Texkimp* decision was applying TPN 2/2016 on costs. This was the forerunner to the current TPN but the relevant wording on “Expenses” is identical.

### **Costs order**

- 35 I hereby order the claimants, Okipa Ltd and John Russell Clearwater, to pay the defendant, Aaron Tindall, the sum of £5600 as a contribution towards his costs in this case. The claimants are jointly and severally liable.
- 36 If no appeal is lodged, the sum is to be paid within seven days of the expiry of the appeal period below.
- 37 If an appeal is lodged, my order is then stayed pending the outcome of the appeal.

### **Appeal**

- 38 Any appeal must be lodged within 28 days after the date of this decision.

**Dr J E PORTER**

Chief Hearing Officer, acting for the Comptroller