

PATENTS ACT 1977

CLAIMANT	Bridle IP Ltd
DEFENDANT	Anthony Thomas James
PROCEEDINGS	Application under section 72 for revocation of patent GB2577960
HEARING OFFICER	H Jones

DECISION ON COSTS

Introduction

- 1 This is a decision on costs arising from an application for revocation that was decided in the claimant's favour ([BL O/0110/24](#)). At paragraph 66 of the earlier decision, I indicated that the claimant was entitled to an award of costs in their favour and that I did not expect the award to depart from the comptroller's standard scale of costs, i.e. the scale of costs set out in [TPN 2/2016](#) (given that proceedings commenced before January 2023). I invited written submissions from both sides before making a final order: these further submissions, i.e. the parties' main submissions and the claimant's further submissions in reply, were received on 13 March 2024. I take these submissions into account in my assessment of the appropriate award of costs set out below.

Assessment on costs

- 2 The claimant says that they will accept an award of costs based on the standard scale and do not wish to request a departure from normal circumstances.
- 3 The defendant says that it would be appropriate to discount their contribution to the claimant's costs on a number of grounds. First, in view of the fact that the statement of grounds was a reutilisation of the submissions made in the Opinion proceedings, the claimant should be denied an award in respect of this task. Second, they say that a failure to serve a statement of grounds in numbered paragraphs focusing on the issues lengthened the time and increased the expense of settling a counterstatement; a discount figure of £500 is suggested for this task. Third, the defendant's costs were increased unnecessarily due to the large number of documents (twenty-five) relied upon in the statement of grounds, which I commented upon in my decision; a further discount of £500 is suggested for this task. Finally, the hearing took less than the original two days that had been estimated and instead took less than half a day.

4 In reply, the claimant submits that the statement of grounds met formal requirements and that work undertaken in separate proceedings is not relevant. The claimant notes that I did not suggest in my decision that any of the twenty-five documents in the statement of grounds were irrelevant or that the number was excessive. They say that they should not be penalised for not requesting cross-examination of the defendant's witnesses, which facilitated conclusion of the hearing in good time.

5 The scale of costs is set out below:

Task	Cost
Preparing a statement and considering the other side's statement	From £200 to £650 depending on the nature of the statements, for example their complexity and relevance.
Preparing evidence and considering and commenting on the other side's evidence	From £500 if the evidence is light to £2200 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.
Preparing for and attending a hearing	Up to £1600 per day of hearing, capped at £3300 for the full hearing unless one side has behaved unreasonably. From £300 to £550 for preparation of submissions, depending on their substance, if there is no oral hearing.
Expenses	(a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time). (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.

6 I accept the defendant's point that the statement of grounds reused much of the material submitted in the Opinion proceedings. Nevertheless, a cost was incurred in preparing the original submissions and further work necessary in editing those submissions in the light of the examiner's Opinion. The nature of the case was not complex, and I agree with the defendant that it ought to have been possible to identify the most relevant documents, or at least filter out those of similar relevance, when considering the best possible case for revocation. That said, none of the documents would have come as a surprise to the defendant given that they were available in the Opinion proceedings. Given that the scale of award is not intended to compensate for the expense incurred, I think that, on balance, a fair amount would be around £700 (£200 for preparing the statement of grounds and £500 for preparing the evidence).

7 I accept the defendant's point about the duration of the hearing and will adjust the award for this task accordingly. I consider that an amount of £800 is fair and reasonable. This brings the total award to £1500.

Order

8 I hereby order Anthony Thomas James to pay Bridle IP Ltd the sum of £1500, this sum to be paid within seven days of the expiry of the appeal period below.

Appeal

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

H Jones

Deputy Director, acting for the Comptroller