

PATENTS ACT 1977

OPPONENT Carillion Construction Limited

PATENTEE Balfour Beatty plc

PROCEEDINGS Opposition under section 27(5) in
respect of an application to amend
granted patent GB2463079

HEARING OFFICER H Jones

COSTS ORDER

- 1 This Order is concerned with costs arising from the opponent's successful opposition of the patentee's application to amend its patent under section 27. In his decision dealing with the substantive issues dated 1 March 2017, the Hearing Officer invited both sides to make submissions on costs before making an Order in favour of the opponent. I have now received those submissions, which I shall summarise very briefly.
- 2 Both sides agree that since proceedings were initiated on 1 September 2015, the scale of costs applicable is not the current scale annexed to Tribunal Practice Notice [TPN 2/2016](#) but is instead the scale annexed to Tribunal Practice Notice TPN 4/2007. Neither side is arguing for off-scale costs to deal with unreasonable behaviour.
- 3 The opponent submits that an award of costs towards the upper end of the range is appropriate for each particular task set out in the Annex. With regard to preparing its grounds for opposition, the opponent notes that the application for post-grant amendment extended to 25 pages and referred to seven prior art documents which all required consideration. It submits that a further award is appropriate for preparing its opposition to the conditional amendments filed with the patentee's counter-statement. In respect of its preparation for the case management conference initially scheduled for 21 January 2016 but later cancelled by the Office, it asks for £500 to cover preparation of submissions and £1500 for the hearing that was cancelled at late notice. Further incidental expenses takes the total amount of costs sought by the opponent to £3625.
- 4 The patentee submits that costs applicable for consideration of the conditional amendments should be lower on the basis that only four paragraphs of the opponent's statement were found to be allowable. It notes that no hearing was held

