



## PATENTS ACT 1977

PATENTEE	Ability International Limited
OPPONENT	Monkey Tower Limited
PROCEEDINGS	Opposition to a proposed amendment of UK Patent GB2432573B under section 75

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## DECISION ON COSTS

### Introduction

- 1 In my decision of 23 June 2015 concerning an application to amend UK GB243257B under section 75 of the Act (BLO/291/15), I decided that amendments proposed by the patentee, Ability International Limited (AIL), were allowable and that an award of costs should be made in their favour. I invited parties to make final submissions concerning the quantum of costs taking into account such matters as the standard scale of costs and the protracted nature of the proceedings.

### Arguments and analysis

- 2 AIL argue that an award of costs toward the upper end of the standard scale is appropriate on the basis that: i) the opposition should never have been brought; ii) the extensive nature of the opponent's statement of case and the need to respond accordingly; and iii) the need for written submissions to deal with detailed arguments of added matter. They say that the actual costs incurred by the patentee are higher than the costs sought, but they do not wish to press for off-scale costs in order to avoid drawing out proceedings any longer.
- 3 The opponents, Monkey Tower Limited (MTL), argue for an award of costs towards the bottom end of the standard scale. They say that the protracted nature of the hearing should have no bearing in an award of costs and that even if this was the case then the protracted nature was not their fault. They point out that they are not represented by a professional attorney and that I should take this into account if any point of law has been missed.
- 4 As noted in my earlier decision, costs have already been awarded to MTL for their partially successful case for revocation and to AIL for their successful case to strike out parts of MTL's grounds for opposing amendments under section 75.

- 5 The comptroller's standard scale of costs is set out in Tribunal Practice Notice 4/2007<sup>1</sup>. The scale costs are not intended to compensate parties fully for the expense to which they have been put but to represent a contribution to that expense. The hearing officer retains discretion, however, to depart from the scale in exceptional circumstances. Paragraphs 5.47 to 5.51 of the Office's Hearings Manual<sup>2</sup> describes circumstances where it may be appropriate to depart from the standard scale of costs, and may include cases where one side has been put to disproportionate expense after the other side has resorted to delaying tactics or has acted unreasonably.
- 6 An award of costs at the top end of the scale would amount to a sum of £1100, made up of £600 for preparing a statement and considering the other side's statement, and £500 for preparation and consideration of submissions in advance of a decision on the papers. An award of costs at the bottom end of the scale would amount to a sum of £500, although MTL suggest that a slightly higher award of £600 would be appropriate. Even though AIL are not pressing for off-scale costs, I do not consider, on balance, that the behaviour of either side would have justified a departure from the standard scale. As to AIL's argument that the opposition should never have been brought given my earlier finding concerning a possible saving amendment, Mr Carr QC, in his judgment on appeal of my finding, noted that MTL would be entitled to object to whatever amendment is proposed by AIL, and this is exactly what they did. The question of whether MTL needed to formally commence opposition proceedings in order to make such observations has not been specifically addressed by AIL, although I suspect that this is what lies at the heart of their argument. The point being made is, I believe, that if MTL had exercised their right to submit observations concerning the proposed amendment as an existing party to revocation proceedings then AIL would not have had to incur the additional expense of having to respond formally with counterstatements and written submissions in the separate proceedings under section 75. Section 75 of the Act does allow for any person to give notice to the comptroller of his opposition to a proposed amendment and rule 75 of the Patents Rules 2007 says that proceedings are started when a person gives notice of such opposition, so there is an arguable case that the path chosen by MTL to oppose AIL's proposed amendments was legitimate. However, this point has not been fully argued by either side and, if it had, I would have expected it to have arisen as a preliminary point before any detailed submissions concerning the amendments had been prepared. As it stands, MTL were entitled to oppose the amendments proposed by AIL and AIL would have needed to justify their amendments more or less to the same extent whatever the route.
- 7 MTL's amended statement of opposition subsequent to AIL's application to strike out runs to fourteen pages of relevant and well-presented argument. AIL's amended counterstatement comprises only seven pages. I consider that an award of £450 to be appropriate for the preparation of statements. AIL responded to MTL's further written submissions with some brief written submission of their own, and I consider that an award of £400 to be appropriate for this.

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<sup>1</sup> <http://webarchive.nationalarchives.gov.uk/tna/20140603093547/http://www.ipo.gov.uk/pro-types/pro-tm/t-law/t-tpn/t-tpn-2007/t-tpn-42007.htm>

<sup>2</sup> [https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/320984/Hearings\\_manual\\_web.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/320984/Hearings_manual_web.pdf)

### **Conclusion and Order**

- 8 I conclude that MTL should pay AIL the sum of £850 as a contribution to their costs in making amendments under section 75. I order that this sum be paid within 7 days of the expiry of the appeal period set out 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