



PATENTS ACT 1977

PROCEEDINGS

Application under section 74B for
review of Opinion 17/16 in respect of
GB 2423145B

BETWEEN

Tim Jarvis

Proprietor

and

Ticknall Solar Ltd

Opponent

HEARING OFFICER

Stephen Probert

DECISION ON COSTS

1. My decision of 15th May 2017¹ dealt with the substantive issue in this opinion review, concluding that there were no grounds for setting the opinion aside. After that decision was issued, the opponent (Ticknall Solar Ltd) requested an award of costs in respect of the review proceedings.

The request

2. In their letter dated 22nd June 2017, the opponent refers to an official letter from the IPO to the parties earlier in the proceedings which says:-

“... the proprietor should be aware that, if he/she applies for a review and the hearing officer then upholds the opinion, the proprietor may have to contribute to the legal costs of any other party involved in the review”.

3. In view of this warning, the opponent says that the patent proprietor was well aware of the risk they were taking by seeking a review of the opinion. They also say that the opinion was clear in its reasoning, and the outcome of the review confirmed that the opinion was ‘*correct and well-reasoned*’. In the opponent’s view, the opinion was ‘*contested unnecessarily*’.

¹ BL O/228/17

4. This may well be true, but it is a lot easier to state with the benefit of hindsight. For example, it seems to me that if the opponent had been so confident that the opinion was being contested unnecessarily, then I would not have expected them to spend '*valuable time, effort and money on being party to the review*' proceedings. I assume they filed a counter-statement in the review proceedings in order to protect their position. That was a reasonable thing to do. Similarly, I do not think it was unreasonable for the patent proprietor to seek a review of an unfavourable opinion.
5. In *Watermist v Protec*², the Comptroller's Hearing Officer made the following comments in relation to a request for costs in a review of a statutory opinion:-

"16. Both sides have asked for an award of costs in their favour. Given the nature of the review and the fact that both sides agreed for it to be made on the basis of the papers, I would not normally consider it necessary to make an award of costs to the winning party. Also, since most of the grounds for review are similar to those made in BLO/472/13, I do not think that Protec would have been put to too much additional effort to set out their counterarguments for this case. I therefore make no award for costs."
6. I am not bound to follow the earlier decision, even though the circumstances of this case are very similar. Nevertheless I believe that it is the right approach to take in this case for the same reasons as given in the earlier decision. In particular, I note that the opponent has not had to pay any official fees in connection with the review, and that they chose (sensibly in my view) not to file any written submissions other than the comments made in their counter-statement, which comments are broadly in line with the observations they presented during the original opinion process.
7. For these reasons I make no award for costs.

Appeal

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

Stephen Probert

Deputy Director, acting for the Comptroller

² *Watermist Limited v Protect Fire Detection Limited* - BL O/473/13. Dated 26 November 2013.