[2021] EWHC 270 (Ch)

Appeal Number: CH-2020-000142

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND & WALES
CHANCERY APPEALS

Royal Courts of Justice, Rolls Building
Fetter Lane, London, EC4A 1NL
11 February 2021

Before
MR DANIEL ALEXANDER QC
(Sitting as a Deputy Judge of the Chancery Division)

B E T W E E N:
MR COREY KAIZEN REAUX-SAVONTE
Appellant
- and –
COMPTROLLER-GENERAL OF PATENTS, DESIGNS AND TRADE MARKS

Respondent

The appellant appeared in person
Dr Stuart Baran instructed by the Treasury Solicitor appeared for the Respondent

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JUDGMENT ON COSTS AND PERMISSION TO APPEAL

Covid-19 Protocol: This judgment was handed down by the judge remotely by circulation to the parties' or their representatives by email and release to BAILII. The date and time for hand-down is deemed to be 14.00 on 11 February 2021.

DANIEL ALEXANDER QC

1. By a decision dated 22 January 2021 ([2021] EWHC 78 (Ch)), I gave reasons for dismissing an appeal from the decision of the hearing officer in which he held that patent application GB1520019.9 should be refused under s.1(2) of the Patents Act 1977 and extended time for consequential applications, making an order in terms sought by the Comptroller. That earlier order did not formally dismiss the appeal which I now do. I invited further submissions in writing.

Costs

2. The Comptroller applies for his costs in the sum of £8,073.00.
3. Mr Reaux-Savonte, the appellant, has requested that there be no order or a reduction in the costs and a payment schedule which I understand is agreed in principle on a confidential basis, if the court considers it appropriate for a costs award to be made.
4. The Comptroller points out that the appellant was put on notice of a potentially significant costs risk in pursuing this appeal. That position is reflected in publications of the UKIPO, including the Patents Hearings Manual which states that it is "normal practice" for the Comptroller to ask for costs where an appeal on *ex parte* proceedings is dismissed. As the Manual states, it is open to the Comptroller not to press for an award of costs for example where the party is likely to suffer some form of hardship if a costs award is made against them or where a significant point of general legal interest is involved.
5. The appellant submits that in this case costs should be "waived" on the basis that "the current rules regarding software patent eligibility were not conceived to cover inventions such as this". The Comptroller has declined to do so and he is entitled to take the position that, beyond agreement of a payment schedule, that would not be appropriate. For the Comptroller to defend an appeal involves the expenditure of further public funds to those required for examination of the application and review by the hearing officer. No submission has been made that an award of costs would involve undue hardship.
6. There is no basis for declining to award costs to the Comptroller. The applicable substantive law has been explained on several occasions by the Court of Appeal and several illustrations of how it is to be applied given in the case law. The hearing officer upheld the examiner's view and the decision on further appeal cannot have come as a surprise on the basis of the existing law.

Amount

7. As to amount, the Comptroller submits that the claim is modest by the standards of patent litigation. He submits that the result should not have been in doubt but the appeal nonetheless required substantial work for the Comptroller's team, concerning a complex question of law engaging judgments of different tribunals. The Comptroller's burden was increased by the fact that the appellant was unrepresented,

meaning that the Comptroller had to do extra work ensuring that points were fully drawn to the court's attention and that the appellant could understand the case advanced. I accept those submissions.

8. Although significant for most people, the sum claimed for what was anticipated to be a 1 day hearing with a substantial skeleton is not high. Cases involving the computer program exclusion from patentability under section 1 of the Patents Act 1977 are not usually entirely straightforward, requiring both detailed understanding the nature of the claimed invention and how the law applies to it. This case raised issues of the claimed contribution and the application of the signposts to a patent application which was not a clear document. No sufficient reason has therefore been shown for making any significant reduction in the amount claimed on summary assessment, save for rounding.

9. The appellant must pay the Comptroller's costs of this appeal, summarily assessed in the sum of £8000, to be paid according to the confidential schedule agreed between the parties.

Permission to Appeal/amendment

10. The appellant submitted a document in which he indicated, somewhat ambiguously, that he wished to appeal but lacked funds to do so. However, the document also states that "Under current patent rules precisely as they are stated to be interpreted and applied, this application should technically be denied" albeit with a qualification with respect to signpost 5 (see also paras. 11-14 of the appellant's written submission). The appellant therefore recognises that the decision is in accordance with the existing law. Clear conclusions about this application have been reached by the examiner, the hearing officer and this court. An appeal would stand no real prospect of success.

11. The appellant's argument implicitly invites the court to consider whether there may be some other reason for an appeal, namely that the law requires reconsideration. His reasons are focussed on the alleged need to consider this issue in the context of "evolutionary robotics". He summarises his argument by saying: "At some point, these issues will need to be addressed and clear rules will need to be set which take into consideration the full range of capabilities of AI technology. If not now, they will undoubtedly be raised again at some point and need to be addressed in the future, which would be unfair to the application in question here if the judgement is maintained as is." However the substantive decision does not hold that inventions in the field of artificial intelligence are not patentable nor does it set out general guidance for evaluating such inventions for compliance with the requirements of section 1 of the Patents Pct 1977. The decision is confined to the specific facts of the case, focussing on the contribution made (and not made) in the patent application in issue. Even if the application of the Act requires wider reconsideration in the light of developments in artificial intelligence, this is not a suitable case for doing so.

12. Finally, there is no basis for the appellant's further requests for what he describes as "leniency" to allow him to amend the scope of the claims. The decisions throughout have been based on the contents of his patent application as a whole and the contribution identified in that application. Amended claims, in respect of which no proposal or application was advanced, would not stand any prospect of being accepted, nor would it be procedurally appropriate to entertain such at this stage following judgment.

13. Permission to appeal and to make further amendments is refused.

14. A consequential relief decision of this kind would ordinarily not merit publication on bailii. This is done to provide a readily available illustration of the potential costs consequences of an unsuccessful appeal of this nature and to emphasise the point in para. [11] above, should attempts be made to deploy the substantive decision by way of analogy or illustration in other cases involving different inventions in the field of artificial intelligence.