



BL O/002/06

5th January 2006

PATENTS ACT 1977

BETWEEN

Shannon Biotechnologies Limited

Claimant

v

Dr John Anthony Walters and Shannon
Biotechnology Limited UK

Defendant

PROCEEDINGS

Reference under sections 8(1), 12 (1), 13 (1) and 13 (3) in respect of patent applications: GB0215532.3, GB0217130.4, GB0227595.6, GB 0229315.7 and GB0300052.8 (PCTGB/2003/002866 admitted in revised grounds).

HEARING OFFICER Peter Back

DECISION ON COSTS

- 1 On 12th October 2005 I issued a decision in which I found that the Claimant was not entitled to be named as sole or joint inventor of any of the above applications. I found that the Claimant was entitled to ownership of the GB applications referred to above and I found that the Claimant and the Defendant are entitled to joint ownership of the PCT application.
- 2 I ordered that each of the five GB applications namely GB0215532.3, GB0217130.4, GB0227595.6, GB 0229315.7 and GB0300052.8 shall proceed in the sole name of Shannon Biotechnologies Limited.
- 3 With regard to the PCT application, I am acutely aware that joint ownership causes problems at the best of times, and is a recipe for disaster if the joint owners are at daggers drawn and I urged the parties, in their own interests, to try and negotiate some settlement or compromise in the light of my findings. I allowed the parties six weeks to consider this and come back to me.

4 I also allowed the parties six weeks in which to make submissions on costs in the light of my decision.

5 Submissions on the PCT application and on costs were due on 23rd November 2005 but a short extension of time to 28th November 2005 was granted in response to a request from the Defendant who claimed to have received the decision only a day before the deadline. It would appear that any delay in the Defendant's receipt of the decision was due to the fact that he had moved to Zimbabwe and had not informed the Patent Office of his change of address. The Claimant did not object to the requested extension and submissions were received from both parties on 28th November 2005.

The PCT Application

6 The Defendant has offered no submissions on this issue. In their letter of 28th November the Claimant states that it "consents to the proposed order for joint proprietorship of the PCT application". Accordingly in the light of my findings in the substantive decision and in the absence of any submission from the Defendant, I order that PCT application number PCTGB/2003/002866 proceed jointly in the names of Shannon Biotechnologies Limited and Dr John Anthony Walters.

Costs

7 The Claimant has asked for costs on the standard scale for the substantive hearing and for the "wasted" costs of an earlier hearing in December 2004 which was adjourned at the Defendant's request.

8 The Claimant was successful in its claim under Section 8 and has asked for costs in this respect with an allowance made for its unsuccessful claim under Section 13. They argue that the evidence was primarily directed to the Section 8 claim and say they believe they should be entitled to a substantial proportion of the scale costs.

9 Although the Defendant was successful in defending the Section 13 action, as I indicated in my decision neither party submitted much in the way of evidence on the issue of inventorship. Accordingly I can see little justification for anything more than a token allowance in this respect.

10 Costs in proceedings before the comptroller are usually awarded to the successful party on a contributory basis derived from a published scale. I see no reason in the present case to depart from that standard practice with respect to costs relating to the substantive hearing. Applying the standard scale [*as published in the Patent Hearings Manual paragraph 5.46*] I award the Claimant £2,000 as a contribution towards its costs.

- 11 With regard to the Claimant's claim for wasted costs, Dr Walters requested postponement of the hearing scheduled for 8th December 2004 late in the afternoon of the day before the hearing. The Claimant argued that the hearing should go ahead and in the event the request for an adjournment was taken as a preliminary issue. For reasons set out in my preliminary decision resulting from that hearing I granted a short adjournment of two working days.
- 12 Dr Walter's main reason for requesting an adjournment was that he claimed to have only just become aware that the Claimant's main witness, Mr O'Mara, would be available for cross-examination. As I have stated in my decision Dr Walter's is clearly an intelligent man and the reasonable person would recognise the principal importance of the attendance of a key witness as a major element of the hearing. He was aware of the hearing date and had been in contact with the Patent Office in the days preceding the hearing. In particular, Dr Walters wrote to the patent office on 2nd December indicating he was preparing for the hearing. In this respect I have some sympathy with the claimant's submission that Dr Walter's caused unnecessary work for the claimant.
- 13 I am not however convinced that the full amount of wasted costs claimed, £1,250, is justified. The hearing was adjourned for only a few days so much of the work done in preparation would not have been wasted. Accordingly, I award the Claimant £750 as a contribution towards the costs incurred as a result of the adjournment.
- 14 This amounts to a total of £2,750 and I order that the Defendant, Dr Walters, to pay this sum to The Claimant, Shannon Biotechnologies Limited, within seven days after the expiry of the period for appeal against this decision, except that if an appeal is lodged, payment is suspended pending the outcome of the appeal.

Appeal

- 104 Under the Practice Direction to Part 52 of the Civil Procedure Rules any appeal must be lodged within 28 days of this decision.

Peter Back
Divisional Director acting for the Comptroller