



BL/028/06

23rd January
2006

PATENTS ACT 1977

BETWEEN

Gerkros Boilers (Tipperary) Limited

Claimant

and

Alley Enterprises Ltd

Defendant

PROCEEDINGS

Application under Section 72 for revocation
of patent number EP 0616676

HEARING OFFICER

Peter Back

PRELIMINARY DECISION

Costs

- 1 Further to the preliminary decision dated 15th November 2005, I have now considered the matter of costs relating to the preliminary hearing. Submissions have been received from both parties.
- 2 The defendant has requested that it should be awarded a contribution to its costs in the order of £1250 which is commensurate with the figures given in the Patent Office's scale of costs. However, the claimant has requested that the Hearing Officer exercise his discretion to award them costs in excess of those provided for in the scale of costs.
- 3 It is long-established practice for costs awarded in proceedings before the comptroller to be guided by a standard published scale. The scale costs are not intended to compensate parties for the expense to which they may have been put but merely represent a contribution to that expense. However, the scale is not mandatory and I have the power to award costs off the scale where the circumstances warrant it. Examples of such circumstances are listed in the Patent Hearings Manual at paragraph 5.47. These includes

issues relating to the reasonableness of the parties' behaviour and the Claimants say in their submission that the Defendants adopted an unreasonable position. Perhaps not surprisingly, the Defendants suggest that the Claimants have themselves behaved unreasonably although, as I have said, they are not claiming off-the-scale costs.

- 4 Having considered the issues carefully it is my view that the behaviour of the parties was no more or less unreasonable than is usual in such disputes and neither party was any better or worse than the other in this respect. Accordingly I can see no reason to justify departure from the scale.
- 5 In their submissions both parties appear to be arguing that they were the successful party at the preliminary hearing. However, that is not what emerges from a reading of directions 16 to 24 of my decision. That decision related to a number of directions requested by the Defendant. Some of these were granted albeit in modified form. Some were not and some issues were resolved by mutual agreement at the hearing. Thus, it is my view that no clear "winner" has emerged, and nor in my view has one party gained substantially more than the other.
- 6 Having taken careful consideration of the submissions from both sides and for the reason set out above I have decided to make no award for costs and direct that each party bear its own costs in respect of this preliminary hearing.

Appeal

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

Peter Back

Divisional Director acting for the Comptroller