



BL O/056/06

1st March 2006

PATENTS ACT 1977

BETWEEN

Black & Decker Inc.

Applicant

and

GMCA Pty Ltd.

Opponent

PROCEEDINGS

Application under Section 27 of the Patents Act 1977 to amend
EP (UK) 0673730 B1

HEARING OFFICER

Peter Back

DECISION ON COSTS

Background

- 1 European patent EP (UK) 0673730 B1 ("the patent") was granted on 17 June 1998. The proprietor, Black & Decker Inc. ("the Applicant"), filed a request to amend the patent under section 27(1) on 8 October 2002. The proposed amendments were advertised in the Patents and Designs Journal on 5 March 2003. On 2 May 2003, a notice of opposition under section 27(5) to the proposed amendments was filed by GMCA Pty Ltd. ("the Opponent") and their statement of grounds of opposition followed on 15 May 2003.
- 2 The matter came before me at a hearing on 19th December 2005. The Applicant was represented by their patent attorney, Mr. Ian Bell. The Opponent did not appear and was not represented at the hearing but had made clear before the hearing that it still maintained its opposition to the amendment.
- 3 In my decision following that hearing I concluded that the comptroller's discretion should be exercised to permit amendment, and that the proposed amendments are such as to cure the defect identified by the Applicant. I therefore allowed the request to amend EP (UK) 0673730 B1 in the manner sought.

Costs

- 4 The Applicant has successfully made its case and it follows that according to normal practice they will be awarded costs. At the hearing, Mr. Bell requested that costs be awarded to the Applicant at the comptroller's discretion. Costs in proceedings before the comptroller are usually awarded to the successful party on a contributory basis from a standard published Patent Office scale and I indicated in my substantive decision that my preliminary view was that I could see no clear reason to depart from that practice. However, as I had had no submission on costs from the Opponent who, as I have said, was not present at the hearing, I allowed the Opponent 7 days from the date of the substantive decision to make submissions on cost.
- 5 Submissions were received from the Opponent's patent attorney on 28th February in which they submit that costs should be awarded on a "reduced scale" in view of a number of factors. These factors being what the Opponent refers to as repeated amendments of the Claimant's statement of case, confusion over its evidence and the addition of new dependent claims, subsequently withdrawn.
- 6 I have considered the submissions on costs from both sides. The Claimant has been successful and I order the Opponent, GMCA Pty Ltd, to pay the Applicant, Black & Decker Inc, £2000 as a contribution to its costs. This sum should be paid within seven days after the expiry of the period for appeal against this decision. If an appeal is lodged, payment is automatically suspended pending the outcome of the appeal.

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