

4 August 2008

PATENTS ACT 1977

BETWEEN

Rita Rusk Innovations

Claimant

and

Wilson Gunn LLP

Opponent

PROCEEDINGS

Application under Section 27 of the Patents Act 1977
To amend GB 2414932 B

HEARING OFFICER

Peter Back

DECISION ON COSTS

Introduction

1. UK patent GB 2414932 B (“the patent”) was granted on 23 May 2006. The proprietor, Rita Rusk Innovations Ltd. (“the Applicant”), filed a request to amend the patent under section 27(1) on 19 January 2007. The proposed amendments were advertised in the Patents and Designs Journal on 4 April 2007. On 4 June 2007, a notice of opposition under section 27(5) to the proposed amendments was filed by Wilson Gunn LLP (“the Opponent”) and their statement of grounds of opposition followed on 18 June 2007.
2. The Applicant was informed that under Rule 40(4) of the Patent Rules 1995 it had until the 20 August 2007 to file a counter statement. A request for an extension of time of one month, for the period for reply and filing of a counterstatement was made on 8 August 2007. The Opponent objected to the request for an extension of time of one month but was prepared to agree to an extension of two weeks and this was duly allowed giving a response date of 3 September 2007.

3. No counterstatement was received by 3 September 2007 and the Attorney for the Applicant stated that it had not been instructed to file a counter statement in the proceedings on 29 September 2007. No further submissions from the applicant had been received by the 14 October 2007 so the proceedings were then treated as unopposed. The Opponents then stated their wish to be heard. The Opponent's attention was drawn to *Norsk Hydro AS's Patent* [1997] RPC 1989 ("Norsk Hydro") which is a decision where the Hearing Officer found that an application to amend a granted patent was considered to be withdrawn when no counter statement was filed in response to an opposition to the allowance of the amendments filed by another party. The Opponent stated that it still wished to be heard and was given an opportunity to make further submissions to address the hearing officer on *Norsk Hydro*. Further submissions were received on the 10 January 2008.
4. The matter came before me at a hearing on 24th January 2007. The Opponent was represented by its patent attorney, Mr David Slattery. The Applicant did not appear and was not represented at the hearing.
5. In Decision BL O/109/08, after carefully considering all of the arguments and submissions before me and in the absence of any arguments from the Applicant, I concluded that the amendments should not be considered withdrawn, as in the *Norsk Hydro* case, but that the proposed amendments were not such as to cure the defect identified by the Applicant in that they did not distinguish the amended patent from the cited prior. Accordingly, the request to amend the patent was refused.
6. No application for costs was made at the hearing but I agreed to allow the Opponent the opportunity to make submissions on costs once the decision had issued. Accordingly I allowed the Opponent 14 days from the date of the decision to make submissions on costs and, although they were not present at the Hearing, I allowed the Applicant the same period to make such submissions as they may wish on the issue of costs.
7. In a letter dated 28 April 2008 the Opponent asked for an award of costs on the standard scale. Nothing has been submitted by the Applicant. Since I found in favour of the Opponent, I am satisfied that that an award of costs against the Applicant is appropriate. However, since there was no counterstatement for the Opponent to consider and the Applicant did not attend the hearing, I consider an award at the lower end of the scale to be justified. As the Opponent noted in its letter of 28 April, these proceedings were started prior to 3 December 2007 and it is the scale published in TPN 2/2000 which applies. On that basis I award the sum of £500 to the Opponent and order the Applicant, Rita Rusk Innovations, to pay the Opponent the sum of £500 as a contribution to its costs. This sum should be paid within 7 days of the expiry of the appeal period below. Payment will be suspended in the event of an appeal.

Appeal

8. 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