



BL O/088/06

28th March 2006

PATENTS ACT 1977

BETWEEN

Nigel Melling

Claimant

and

William Butler & David Birkett

Defendant

PROCEEDINGS

Reference under section 13(1)(3) and 37 of the Patents Act 1977 in respect of patent application numbers GB 2383533 and WO/0215981

HEARING OFFICER

Peter Back

DECISION

- 1 The reference was filed on 18 May 2005 by the Claimant, who is unrepresented, together with a statement of case. Several amended statements were subsequently filed and a counterstatement was filed on behalf of the Defendants on 18 August 2005.
- 2 The Claimant wrote to the Patent Office in a letter dated 24th November 2005 confirming his intention to withdraw from the proceedings. Because the reasons given for withdrawal were not at all clear, the Patent Office contacted the Claimant to clarify his position. In response the Claimant wrote to the Patent Office on 28th November 2005 confirming that his withdrawal from the proceedings was unconditional.
- 3 In response, the Defendants have asked for costs on an “exemplary basis”.
- 4 In subsequent correspondence the Claimant appeared to be attempting to re-open the proceedings. It was explained that having unconditionally withdrawn it would be inappropriate to re-open the proceedings after the Defendant had been informed that they were closed and that the only matter remaining to be decided was that of costs. It is normal practice in proceedings before the comptroller, that where proceedings collapse before the substantive hearing because the claimant withdraws, the hearing officer may still need to decide whether to award costs against the Claimant before the proceedings can be finally disposed of [Patent Hearings Manual paragraph 5.37]. Both sides were

invited to make submissions on cost and to agree to the matter being decided on the papers.

- 5 The Defendant agreed to the matter being decided on the papers. However the Claimant initially asked to be heard but after further correspondence he wrote to the Office on 27 March 2006 stating that "*As the other side are not attending the hearing I feel that it is not necessary or appropriate for me to attend.*" It was confirmed with the Claimant that this indicated his willingness for the matter to be decided on the papers.
- 6 The Claimant says in a letter dated 17 February 2006 that he "*will not be submitting any comments regarding*" his costs but he goes on to invite me to order the parties to pay their own costs.
- 7 The defendants have asked for exemplary costs because they say that they have been put to much unnecessary costs as a consequence of what they describe as Mr. Melling's lengthy submissions touching on matters not proper to entitlement proceedings, the spurious ill founded nature of Mr. Melling's entitlement case and the protracted nature of the proceedings consequent on the manner in which Mr. Melling responded to their request for Summary Dismissal.
- 8 The Defendants state that their costs in these proceedings amount to £3,025 (not including VAT).
- 9 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 costs off the scale, such as exemplary costs, may be awarded where the circumstances warrant it. Examples of such circumstances are listed in the Patent Hearings Manual at paragraph 5.47
- 10 Since the Claimant has withdrawn from these proceedings I have no doubt that in accordance with normal practice I should award costs to the Defendant, the question is whether there is any good reason to depart from the scale. The Defendants have argued that they have been put to unnecessary costs which they attribute to what they describe as Claimant's lengthy submissions touching on matters not proper to entitlement proceedings and to what they say was the spurious and ill-founded nature of his case. The Claimant's correspondence was certainly voluminous and not always to the point but I am mindful of the fact that he was unrepresented for most of the proceedings and I think it is this that accounts for the rather unfocussed nature of his correspondence.
- 11 I should also take account of the fact that the Claimant withdrew his claims relatively early in the proceedings when he could have pressed them to a full hearing. Had he done so, the Defendants would have incurred significantly greater costs.
- 12 On balance, and taking full account of the papers before me, I do not consider

that the circumstances of this case are such as to justify departure from the scale. Accordingly I award the Defendants the sum of £500 to be paid by the Claimant not later than 7 days after the expiry of the appeal period. If an appeal is lodged, payment will be automatically suspended pending the outcome of the appeal.

Appeal

- 13 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