

**PATENTS ACT 1977**

BETWEEN

Crime Scene Investigation Equipment Ltd

Claimant

and

Dudley Bryan CrosslingDefendant  
(Patentee)

PROCEEDINGS

Application under section 71 for a Declaration as to Non-Infringement  
in respect of patents EP(UK) 0877990B2 and EP(UK) 1125244B1

HEARING OFFICER      Stephen Probert

Anastasia Fowle (of Shoosmiths) for the claimant  
The defendant, Dudley Crossling, represented himself

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**DECISION — COSTS****Introduction**

- 1 Mr Dudley Crossling is the inventor and proprietor of two EP(UK) patents (0877990 & 1125244) for imprint identification systems. They relate to the kind of equipment that would be used by the Police to analyse and compare shoe prints left at the scene of a crime with those recovered from suspects.
- 2 For a decade or so, the claimant (“CSI”) and the defendant worked together under a Joint Venture & Licensing Agreement to develop Mr Crossling’s invention. The agreement terminated with effect from 1<sup>st</sup> June 2006, and CSI sought a declaration of non-infringement in relation to an imprint identification system (Treadmark<sup>®</sup>) that they claim they have developed independently of Mr Crossling. CSI’s solicitors (Shoosmiths) wrote to Mr Crossling on 16<sup>th</sup> March 2009, and again on 2<sup>nd</sup> April 2009, asking him to acknowledge that CSI’s system would not infringe either of his patents. Mr Crossling did not respond, and therefore CSI initiated these proceedings.
- 3 At a case management conference on 8<sup>th</sup> July 2010, Messrs Michael Sandling and Christopher Tagg of CSI demonstrated their imprint identification system (Treadmark<sup>®</sup> version 4.0) in front of Mr Crossling and myself. Mr Crossling

conceded at the CMC that CSI's system did not infringe either of his patents because it does not have an automatic search facility in relation to randomly generated characteristic damage caused by use and wear. The following day, Mr Crossling wrote to CSI formally acknowledging that their system would not infringe either of his patents. As a result of this agreement, the substantive proceedings fell away, and the only issue left for me to decide is that of costs.

- 4 I have received written submissions on costs from both sides, and as agreed with them, I now give this decision on the basis of those written submissions and the papers on the official file.

### **Costs**

- 5 Tribunal Practice Notice (TPN) 4/2007 explains how costs are to be determined in proceedings before the Comptroller. It includes the standard scale that is usually applied, and also provides guidance concerning situations when the Comptroller may award costs off the scale.
- 6 CSI has requested an award of costs above the standard scale; the exact amount being £21,017.20. But I am satisfied that there has been no "wider breaches of rules, delaying tactics or other unreasonable behaviour" on either side in these proceedings that would justify off scale costs. There have been times when I could have wished that one party or the other had behaved differently, but neither party has even come close to behaviour that would cause me to think about departing from the published scale.
- 7 Mr Crossling has also requested an award of costs. He calculated his costs with reference to the published scale<sup>1</sup>, and arrived at the sum of £1,200.
- 8 The fact that both parties have requested an award of costs conveniently illustrates an unusual aspect of this case. Who won? Or perhaps more significantly in terms of awarding costs, who lost? It is customary to award costs to the successful party, but in this case I am not able to say that one party was any more successful than the other.
- 9 On 18<sup>th</sup> March 2010, and on the basis of the statements of case and evidence already filed, I issued a preliminary evaluation in which I gave my opinion that CSI's system would **not** infringe either of Mr Crossling's patents. Ordinarily this would weigh in CSI's favour in any award of costs, since it reflects the agreement that the parties reached at the CMC on 8<sup>th</sup> July 2010, and the basis on which the substantive proceedings fell way. However, my preliminary evaluation was subject to an important condition which I expressed in paragraph 18 of that document:

"... if CSI's system does function substantially as described in its statement of grounds, then I cannot see how they can be denied a declaration of non-infringement."

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<sup>1</sup> Mr Crossling actually used TPN 6/2008 which supplements TPN 4/2007 specifically in relation to trade mark proceedings. But the relevant figures are the same, and nothing turns on this minor slip.

- 10 One of the problems that these proceedings would have encountered if the parties had not settled when they did, is how to fully and accurately describe CSI's Treadmark<sup>®</sup> system<sup>2</sup>. At the time I wrote the preliminary evaluation, I had my doubts concerning whether the "full particulars" in CSI's statement of grounds was a sufficiently accurate description of the Treadmark<sup>®</sup> system, which is embodied in a large and complex computer program. I did propose that one solution for CSI would be to file a copy of the source code of the Treadmark<sup>®</sup> system to serve as "full particulars". CSI did file a DVD containing the Treadmark<sup>®</sup> source code, but they wanted (quite reasonably in my view) to maintain the confidentiality of the source code. I therefore allowed them to withdraw the DVD from proceedings at the CMC on 8<sup>th</sup> July 2010.
- 11 It is therefore possible that if these proceedings had continued to a substantive hearing, I might not have been in a position to make the declaration sought, because of a lack of clarity or precision relating to the description of the Treadmark<sup>®</sup> system. Furthermore, even if I had been able to make the declaration sought, it would have been strictly in relation to the written description in CSI's statement. I don't think this would have been of much use to CSI since there are one or two significant differences between the system described in CSI's statement and the version of the Treadmark<sup>®</sup> system that they want to take to market (and which was demonstrated at the CMC on 8<sup>th</sup> July 2010): eg. the facility for tagging unique features caused by use or manufacturing defects.
- 12 It appears from his written submissions on costs that Mr Crossling saw version 4.0 of the Treadmark<sup>®</sup> system for the first time at the CMC on 8<sup>th</sup> July. In view of the differences between this version, and the "full particulars" in CSI's statement, I can begin to understand Mr Crossling's confusion, and consequently his reluctance to give an acknowledgement of non-infringement earlier than this date.
- 13 Yet ultimately CSI has come away with an acknowledgement from the patentee that version 4.0 of its Treadmark<sup>®</sup> system does not infringe either of the patents in suit. And Mr Crossling gave that acknowledgement immediately upon seeing the demonstration of the system at the CMC (followed up by a written acknowledgement the next day). For these reasons I do not think either party can claim 'victory' in these proceedings.
- 14 Notwithstanding the above, there could still be good reasons for awarding costs to one party and/or the other; eg. if it has been put to undue or unnecessary expense. CSI points out that Mr Crossling had been invited to inspect and view the Treadmark<sup>®</sup> system at their solicitors' office in Milton Keynes. This offer was

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<sup>2</sup> "When requesting a declaration of non-infringement, it is customary for the claimant to provide one of the articles in respect of which a declaration is sought. Failing that, when the claimant chooses to rely solely on the description contained in his particulars, the description must be sufficiently clear and precise to enable the Comptroller to declare that an article or method corresponding with the description would not infringe. This might be necessary when the "article" concerned cannot realistically be provided (eg. because of size or cost), or when a declaration is being sought in respect of a [hypothetical] article which the claimant has not yet manufactured. Since the burden of proving a lack of infringement rests upon the claimant, it follows that if there is a lack of clarity or precision relating to the description of the claimant's system, then the Comptroller will not be in a position to make the declaration sought." (Paragraph 14 of the Preliminary Evaluation)

made in March 2009 and again in April 2009. In February 2010, CSI offered Mr Crossling a free 30 day licence to use the Treadmark<sup>®</sup> system online via his own PC. CSI complains that Mr Crossling did not take up any of these offers. I can appreciate Mr Crossling's reluctance to accept the first two offers; he is retired, and lives in Torquay, and CSI's invitation does not appear to have included any offer to reimburse his travel expenses. However, he should have responded to the invitation. It is possible that CSI might have offered to refund his travel expenses; but because he did not respond, we will never know. At the very least I think it was unreasonable to refuse the February 2010 offer of a free 30 day licence to use the system on his own PC.

15 Shoosmiths' letter of 19<sup>th</sup> February 2010 (offering the 30 day licence) looks like a genuine attempt on the part of CSI to resolve the differences between the parties, and I consider that Mr Crossling's refusal of the offer in this letter was unreasonable and may have caused unnecessary expense to CSI. Guided by comparable items in the published scale, I believe that Mr Crossling should pay CSI £500 as a contribution towards those wasted costs.

16 But CSI has also put Mr Crossling to unnecessary expense. When Shoosmiths (on behalf of CSI) first wrote to Mr Crossling on 16<sup>th</sup> March 2009, seeking his acknowledgement that the Treadmark<sup>®</sup> system would not infringe either of his patents, the letter<sup>3</sup> stated:

"The System is not able to distinguish between different items of footwear having the same tread patterns, nor does the software have any facility for tagging unique features caused by use or manufacturing defects and using such features for image retrieval."

17 Mr Crossling appears to have replied to the above letter, challenging (at least) the statement I have reproduced in paragraph 16 above. Shoosmiths responded to Mr Crossling on 2<sup>nd</sup> April 2009 as follows:

"With regard your point number 3, our client confirms that footwear expert examiners can indeed process the images using identifying pattern codes and marking up damage and searching on the database to make the scene to scene and scene to suspect links."

18 Notwithstanding the correction in the 2<sup>nd</sup> April letter, when CSI filed its statement initiating these proceedings on 7<sup>th</sup> May 2009, it contained (at para 15) the following statement:

"The System is not able to distinguish between different items of footwear having the same tread patterns, nor does the software have any facility for tagging unique features caused by use or manufacturing defects and using such features for image retrieval."

19 In my view, this clearly conflicts with the response that CSI gave in the 2<sup>nd</sup> April letter, in which they confirmed that the Treadmark<sup>®</sup> system did have a facility for tagging (or "marking up") damage and searching on the database. Mr Crossling

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<sup>3</sup> Shoosmiths actually wrote two letters to Mr Crossling on 16 March 2009. The other letter is headed "*without prejudice save as to costs*". I saw it for the first time as an attachment to CSI's submissions on costs.

was not able to rely on the confirmation in the 2<sup>nd</sup> April letter<sup>4</sup> when preparing his defence in these proceedings because the letter was headed “*without prejudice save as to costs*”. It was not until 15<sup>th</sup> April 2010, nearly a year later, that CSI admitted openly in a letter<sup>5</sup> from Shoosmiths:

“There is a facility for tagging unique features caused by use or manufacturing defects, however, the only purpose for saving the “points of interest” is to draw the analyst’s attention to them when he or she subsequently views the image.”

- 20 This clarification was not accompanied by a request to amend the statement of case, which I can now see has been incorrect (regarding this aspect of CSI’s Treadmark<sup>®</sup> system) throughout the proceedings. I should say, in fairness to CSI, that they attached the “*without prejudice save as to costs*” letters to their submissions on costs, and did not rely on Mr Crossling realising that he was now free to bring them to my attention. Nevertheless, the failure to correct a significant error in the statement of case (which Mr Crossling knew about, but was unable to pursue — because of the privileged status of the letter) for almost twelve months has put Mr Crossling to unnecessary expense. Guided again by comparable items in the published scale, I believe that CSI should pay Mr Crossling £500 as a contribution towards his wasted costs.
- 21 The two awards of costs that I would make cancel each other, and consequently I am not making any order as to costs in these proceedings.

### **Appeal**

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

### **S PROBERT**

Deputy Director acting for the Comptroller

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<sup>4</sup>Shoosmiths also wrote two letters to Mr Crossling on 2<sup>nd</sup> April 2009. The other, which I have mentioned in paragraph 2, was not subject to privilege.

<sup>5</sup> As far as I can tell, Shoosmiths did not copy this letter (dated 15<sup>th</sup> April) to Mr Crossling, but he should have seen it a few days later because the Office sent him a copy.