



PATENTS ACT 1977

BETWEEN

Guy Jackson-Ebben

Claimant

and

(1)James Nash

Defendant

(2)Wine Innovations Ltd

PROCEEDINGS

Reference under sections 8, 12 and 37 of the Patents Act 1977, and application under section 13 and rule 10(2), in respect of patent number GB 2469554 B and related patents or applications

HEARING OFFICER

Julyan Elbro

Schlich LLP for the claimant

MJP Deans for the defendant

Hearing date: Decision on the papers

DECISION ON COSTS

Introduction

- 1 In a Decision dated 30 October 2014¹ I concluded that the claimant's claim for entitlement to GB 2469554 B was not made out. I noted that the defendants had therefore won and were in principle entitled to a contribution to their costs in accordance with the Comptroller's standard scale, and indicated that I would give both parties an opportunity to make submissions on this point. The parties made submissions in letters dated 27 November 2014, and submissions in reply in letters of 16 December 2014.
- 2 The Comptroller's standard scale of costs is set out in Tribunal Practice Notice 4/2007². The scale costs are not intended to compensate parties fully for the expense to which they have been put, but to represent a contribution to that expense. This policy reflects the intention that the IPO be a low cost tribunal for litigants, and builds a degree of predictability as to how much proceedings before the

¹ BL O/465/14 http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-os/p-challenge-decision-results-bl?BL_Number=O/465/14

² See <http://www.ipo.gov.uk/p-tpn-42007.htm>

IPO may cost them. The hearing officer retains discretion, however, to depart from the scale in exceptional circumstances.

Costs

- 3 The published scale contains a number of categories for which scale costs may be awarded. I consider each in turn.

Preparing a statement and considering the other side's statement

- 4 The scale in this category is £200-£600. The claimant argues that this case was not overly complex, being a straightforward dispute between two alleged inventors, and relating to a simple invention, and that therefore an award in the middle of the scale is appropriate. The defendants argue simply that actual costs for the relevant stage of the proceedings were £2780 and therefore the maximum £600 is appropriate.
- 5 I agree with the claimant about the level of complexity of the case. Furthermore, the scale costs are not intended, as the defendants implicitly suggest, to compensate actual expenditure within the limits of the scale, but rather to provide a contribution relating to the relative size of those costs. I consider an award of £400 appropriate in this case under this heading.

Preparing evidence and considering and commenting on the other side's evidence

- 6 The scale in this category is £500-£2000.
- 7 For the main body of the evidence, the defendants request the maximum of £2000, asserting actual costs were £3560. In addition, the defendants highlight the additional evidence rounds in these proceedings, which they allege arose from the claimant's evidence-in-reply really being evidence-in-chief in at least some respects. For this, they assert actual costs were a further £4600, and they consider an award above the scale would be justified because, in their view, the claimant should have served the evidence at the evidence-in-chief stage, and that one witness, Mr Kiefer, was found to be an unsatisfactory witness³. Failing off-scale costs, they submit that they should at least have an additional scale costs award of £2000 relating to these costs.
- 8 The claimant responds that the technology in this case was a straightforward one and not difficult to grasp, and that the claimant's case in essence focused on a simple scenario. He considers a sum of £1000 or less to be appropriate. He rejects the defendant's characterisation of the claimant's evidence, considering the claimant's evidence-in-reply to be a response to the defendant's evidence that the invention was embodied in a previous machine. Furthermore, he submits that the scale costs under this category should encompass the compensation for all the evidence rounds, and thus a scale costs award should not exceed £2000 under this category in total.
- 9 I agree with the claimant that a single award under the scale should be made to reflect all the evidence filed. Furthermore, although I consider some of the claimant's evidence-in-reply to have gone beyond strict evidence in reply, which is

³ See paragraphs 45-48 of my earlier Decision BL O/465/14.

why I allowed the defendants to file further evidence in response in an earlier oral Decision, I do not consider the claimant to have acted in a way that would justify departing from the scale in respect of this. Furthermore, as in the previous category, the award is intended to represent a contribution to costs and not a full compensation.

- 10 I agree with the claimant that the evidence in this case ultimately revolved around a straightforward scenario, but I do consider that some of the claimant's evidence, particularly that of Mr Kiefer, created a somewhat increased level of complexity, particularly given its unreliability. I consider an award of £1200 to be appropriate under this category.

Preparing for and attending the hearing

- 11 The scale under this heading is up to £1500 per day of the hearing, capped at £3000. The substantive hearing in this case lasted three days (the first two of which were extended working days), going beyond an initial two day estimate.
- 12 The defendants seek £3000 scale costs for the two initial hearings days (while asserting actual costs of those days of £38037.31). In addition, they argue that the third day was necessary because of the approach taken under cross-examination by the claimant's witnesses. They seek either by application of the scale, taking the third day as a separate hearing, or by exercise of the comptroller's discretion, an award either of actual costs of £3803.25 or scale costs of £1500 for the third day.
- 13 The claimant argues that the third day should be included in the £3000 cap for the hearing as a whole, and that the third day was caused by the "unnecessarily protracted nature of the submissions and cross-examination by the defendants' counsel". He submits an award in the middle of the scale, around £1500 or less.
- 14 In my view, it is clear that while there are potentially criticisms which could be levelled at both sides for the hearing running into a third day, at least two full days of argument and cross-examination were justified, meriting an award of £3000. I further agree with the claimant that the cap is intended to apply to the hearing, however long it takes, and I see nothing in the claimant's behaviour which would justify departing from the scale in this respect. I therefore consider an award of £3000 to be appropriate under this heading.

Witness expenses

- 15 The scale allows for reasonable "travel and accommodation" expenses for a successful party's witnesses. The defendants made no claim for costs under this heading.

Conclusion and Order

- 16 I conclude that the claimant should pay the defendants a total of £4600 as a contribution to their costs in this matter. This sum is to be paid within 7 days of the expiry of the appeal period set out below.

Appeal

- 17 Any appeal must be lodged within 28 days

JULYAN ELBRO

Divisional Director acting for the Comptroller