



30 January 2023

## PATENTS ACT 1977

BETWEEN

SRJ Limited and SRJ Technologies Group PLC  
(formerly SRJ Technologies Limited)

Claimant

and

Per-Christian Irgens

Defendant

PROCEEDINGS

Application to amend UK Patent GB2468976B  
under section 75 of the Patents Act 1977

HEARING OFFICER

Mr Phil Thorpe

Mr Matthew Kime, instructed by Hutchinson IP, appeared for the claimant  
Mr Thomas St Quintin, instructed by Ward Hadaway LLP, appeared for the  
defendant

Hearing date: 07 November 2022

## DECISION

### Introduction

- 1 This decision is concerned with the question of whether to allow amendment of UK patent GB2432573 (the patent) under section 75 of the Patents Act 1977 (the Act). In my decision<sup>1</sup> of 17<sup>th</sup> May 2022 (the earlier decision) I found that claims 1-3 and 6 of the patent are invalid in that they lack novelty in the light of the prior art. I also found that claim 4 is invalid as it lacks an inventive step. I dismissed the attack against claim 5 and the attacks based on added matter and sufficiency.
- 2 Accordingly, and in accordance with section 72(4) of the Act, I ordered that patent GB2468976 be revoked unless it is amended under section 75 to the satisfaction of the comptroller. I allowed the patent proprietor (the defendant) 8 weeks from the date of the decision to submit proposals for amendments. I advised the defendant that in considering any amendments, they should be mindful of the guidance provided by Henry Carr QC, sitting as a Deputy Judge in *Monkey Tower Ltd v Ability International*

---

<sup>1</sup> [Patent Decision O/429/22](#)

*Ltd*<sup>2</sup> as to the nature of the type of amendments that would justify the exercise of discretion under section 75.

- 3 The defendant filed amended claims by email on 6<sup>th</sup> July 2022 and these amendments were copied to the claimant at the time of filing. Additionally, the IPO also sent a copy of the proposed amendments to the claimant, inviting them to file any comments on the proposed amendments. Comments were received from the claimant on 12<sup>th</sup> August 2022.
- 4 On 20<sup>th</sup> September 2022 I issued a preliminary evaluation which set out my preliminary views on the following points:
  - i. the comptroller's discretion to allow the amendments,
  - ii. the admissibility of the proposed amendments,
  - iii. the advertisement and scope for opposing of the proposed amendments,
  - iv. and the opposition arguments relying on JP4157413B2 (JP'413) as a stand-alone novelty citation or as an obviousness citation in combination with the common general knowledge.
- 5 The preliminary evaluation, which also referred to costs relating to the proceedings to date, was provided to assist both parties in deciding whether they wished to be heard on any of the matters covered by it.
- 6 Both sides were advised that they could be heard on any of the matters covered by the preliminary evaluation. They were warned that should I maintain my preliminary positions following any hearing, then a decision would be issued to that effect and that will conclude the revocation proceedings including the determination of the amendments made under section 75. Should the decision reach a different position on the admissibility or allowability of the amendments or the scope of any opposition to that indicated in the preliminary direction, then any decision would set out any necessary further directions.
- 7 The claimant requested a hearing which duly took place on 7<sup>th</sup> November 2022. Both sides filed skeleton arguments with authorities in advance of the hearing for which I am grateful.

### **The proposed amendments**

- 8 Amendment is proposed to claims 1, 2, 3, and 4 to introduce the subject matter of claim 5 into each of them. The previous attack on claim 5 had been dismissed. Claims 5 and 6 are proposed to be deleted.
- 9 The proposed amendments with tracked changes to show the amendments are set out below:
  1. Use in a hot-bolting operation of a A flange clamp comprising opposite clamp parts (1 and 2) and a preloading part (4) arranged to preload the opposite clamp parts towards each other,

---

<sup>2</sup> *Monkey Tower Ltd v Ability International Ltd* [2013] EWHC 18 (Pat)

the clamp comprising contraholders (3) arranged to work as a back stop to absorb the preload.

2. Use in a hot-bolting operation of a A flange clamp as claimed in claim 1, wherein the contraholders (3) are adjustable.

3. Use in a hot-bolting operation of a A flange clamp as claimed in claim 1 or 2, wherein the clamps (1 and 2) are provided as whole rings.

4. Use in a hot-bolting operation of a A flange clamp as claimed in claim 1 or 2, wherein the clamps (1 and 2) are split into segments.

5. ~~Use of a flange clamp as claimed in any preceding claim in a hot bolting operation.~~

6. ~~A method of clamping comprising: applying a clamp, the clamp comprising opposite clamp parts, a preloading part and contraholders; and preloading the clamp parts towards each other, wherein the contraholders work as a back stop to absorb the preload.~~

7. A flange clamp, substantially as hereinbefore described with reference to the drawings.

### *Discretion to allow amendments*

- 10 My earlier decision clearly allowed the defendant to submit amendments. That the comptroller has discretion comes from section 75. This has been confirmed by the Court on a number of occasions. In *Nikken Kosakusho Works v Pioneer Trading Co*<sup>3</sup> before the Court of Appeal, Jacob LJ noted:

*8. ....There are different situations in which the exercise of the discretion to allow amendment of a patent may be sought: (a) before a trial; (b) after trial, at which certain claims have been held valid but other claims held invalid, the patentee simply wishing to delete the invalid claims (I would include here also the case where the patentee wishes to re-write the claims so as to exclude various dependencies as in Hallen Co v Brabantia (UK) Ltd [1990] F.S.R. 134 . There the patentee is in effect continuing to claim which he had claimed before but in a much smaller way); and (c) after a trial in which all claims have been held invalid but the patentee wishes to insert what he hopes are validating amendments.*

- 11 Both parties agree that the amendments sought here fall into class b). In respect of such amendments Jacob LJ. went on to note that:

*10. In case (b), after trial but where effectively no more than claim dependency is being dealt with, again the position is clear. Following a conclusion that some claims are valid and others are not, the patentee is normally entitled to relief pursuant to s.63 of the Act. Normally the court will impose as a condition of relief that the invalid claims be amended by deletion. Problems may arise if it were held that the patentee had been covetous in some way or other and ought not to be allowed to amend at all.*

- 12 Whilst section 63 refers to patents found to be partially valid in infringement proceedings, possible amendment of such patents in revocation proceedings is provided for in section 72(4).

### *Admissibility of filed amendments*

---

<sup>3</sup> *Nikken Kosakusho Works v Pioneer Trading Co 2005] EWCA Civ 906, 2005*

- 13 In this instance the comptroller accepted amendments emailed to an address different to that specified in the relevant office directions<sup>4</sup>, but one that had been used throughout the proceedings. That the amendments had been accepted as duly filed was made clear in the IPO correspondence of 8<sup>th</sup> July 2022 to the claimant which read as follows:

*“Date: 08 July 2022*

*GB2468976*

*1. We have received proposed amendments from the defendants filed on 6 July 2022, as per instruction from the decision issued on 17 May 2022.*

*2. The hearing officer now invites you to provide comments on the proposed amendments.*

*3. The deadline to file comments on the proposed amendments is on or before 3 August 2022.*

*4. A copy of this letter has been sent to the defendant.”*

- 14 At no point was the defendant advised that there were any issues regarding the admissibility of the amendments. The claimant was also clearly informed of the amendments and set a clear deadline for filing submissions. Only after the expiration of that deadline did the claimant raise any concerns about how the amendments had been filed. In correspondence dated 12<sup>th</sup> August 2022 the claimant detailed their concerns about the filing of the amendments whilst also setting out their objections should it be deemed that the amendments were admissible.
- 15 As noted by the defendant, Section 124A(3) provides discretion to the comptroller to treat a document as not having been delivered if it was not delivered electronically in accordance with any direction. Through the actions of the Office, it was clear that the Office and hence the Comptroller had in practice treated the document as delivered.
- 16 It is further noted that even if there had been any irregularity in procedure, then the remedy under Rule 107 of the Patent Rules 2007 would have been to either treat the amendments as properly delivered or to invite the defendant to refile using the email address provided in the directions. Procedural efficiency would suggest the former remedy would have applied. The claimant has not presented any scenario where the defendant would have been denied the opportunity to file amendments in accordance with the directions in the decision.
- 17 Hence the amendments are considered to be properly delivered, and so they are admissible.

#### *Advertisement and opposition*

- 18 Rule 75 provides that:

*Publication of notices*

---

<sup>4</sup> [Applications to amend the specification of a patent under sections 27 and 75 of the Patents Act 1977 – Practice Direction](#)

(1) Subject to paragraph (2) and rule 105(5) the comptroller must advertise in the journal any event to which it is possible to object under any of the provisions mentioned in Part 2 or 3 of Schedule 3.

(2) Where an amendment to the specification of a patent is proposed by the proprietor under section 75(1) the comptroller may, if he thinks fit, advertise in the journal the proposed amendment.

19 Rule 75(2) clearly provides the comptroller with discretion as to whether amendments such as those proposed here by the defendant are advertised. In this instance, the proposed amendments are limited in nature, seeking in effect merely to delete the claims found to be invalid. The proposed amendments narrow the scope of the granted patent to the use of the flange clamp in a hot bolting operation. This was clearly described and claimed in the patent as granted. The proposed amended claims were all previously present and have been adjudicated on.

20 Hence there is no need to advertise the amendments. The claimant however still has the right to oppose the amendments in accordance with Section 75(2).

*The general scope of any opposition to the proposed amendments*

21 The nature of any opposition to amendments proposed in proceedings such as here was the subject of much discussion and argument. The claimant argues that the proposed amendments fail to render the patent valid. More particularly the claimant argues that the amended claims lack novelty or lack an inventive step with regard to J'413.

22 It is necessary at this point to briefly revisit the history of this document in the whole proceedings. Importantly JP'413 was not referred to in the original statement of case filed by the claimant which relied on other prior art to challenge the validity of the patent. I covered its subsequent introduction into the proceedings in paragraph 55 of my earlier decision:

“55. I would note that the claimant in its response to the counterstatement referred to a further prior patent document, JP 4157413B2, to inter-alia counter an argument by the defendant in its counterstatement that “C-Clamps” were the de-facto choice when using clamps in hot-bolting applications. As the date of the hearing approached, correspondence from the claimant appeared to suggest that this Japanese document was also to form a stand-alone novelty citation against the claimed invention. I asked Mr Kime whether this was something that had been clearly pleaded or if any request had been made to amend the pleadings in this respect. He confirmed that no such request had been made nor had it been pleaded that JP 4157413B2 formed the basis of a stand-alone challenge against the claimed invention. Unsurprisingly I informed Mr Kime that the hearing would be restricted to the case that had been pleaded”

23 As can clearly be seen I refused the claimant's late attempt to expand its case to cover this document as a stand-alone challenge to the validity of the patent. It was of course open to the claimant to appeal this part of my decision alongside any other part it disagreed with. It chose not to do so.

24 The question before me now is whether it is appropriate for the claimant to raise that document as part of the opposition procedure to the amendments?

25 The scope of possible opposition to amendments under section 75 was considered at length at first instance in *Ability International Limited v Monkey Tower Limited*<sup>5</sup>. In that case the opponent argued that they were:

“entitled to raise any such objections and any such prior art in respect of such claims as deemed fit (rule 76(2)). They contend that not only are they entitled to rely on the prior art pleaded in the original revocation proceedings but they are also entitled to rely on newly cited prior art in their opposition to the proposed amendments.”

26 This argument was rejected by the Hearing Officer who relied on section 74(2) or in the alternative what he considered the very clear steer from the Courts that amendment in such cases as this should not result in further litigation. The Hearing Officer noted that:

“29. The Manual of Patent Practice at paragraph 27.28 suggest that an opponent in section 27 proceedings must address himself solely to the allowability of the proposed amendments and may not attack the validity of the proposed amendment unless the amendment is sought to overcome an admitted defect casting doubt on the validity of the patent. The paragraph has a cross-reference to section 74(2), which states that:

s74(2). The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be initiated (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent.

30. Section 74(1) sets out the proceedings in which validity of a patent may be put in issue. It does not specify proceedings under section 27 or section 75”.

27 Having considered arguments by both sides the Hearing Officer went on to conclude that:

“36 ... I believe that section 74(2) is equally applicable in section 75 proceedings as it is in section 27 proceedings and that it has the effect of limiting an opponent’s ability to attack the validity of a proposed amendment beyond the known defect identified in the original proceedings.”

he further noted that:

“If I am wrong on this point, i.e. that opposition to amendments under section 75 are part of proceedings under section 72 and are not affected by section 74(2), then, as I have indicated above, the possibility exists for third parties to intervene with new grounds for opposition even in cases where the court or comptroller had not anticipated further litigation being likely, which the Court of Appeal has said should be avoided at all costs.”

28 He then went on to conclude that section 75(5) which reads:

“s75(5). In considering whether or not to allow an amendment proposed under this section, the court or the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.”

should be taken to mean that:

“36 .... section 75(5) should be interpreted to mean only those principles which are relevant to the enquiry to hand, i.e. whether the amendment overcomes the validity attack made upon the claim in the revocation proceedings, that the claim is clear and that it does not add subject matter.”

---

<sup>5</sup> [Patent Decision BL O/484/14](#)

- 29 Hence in that case the Hearing Officer denied the opponent the opportunity to introduce objections based on new prior art during the opposition.
- 30 The claimant notes that I am not bound by the decision in *Monkey Tower*. Notwithstanding that that case was the subject of an appeal to the Patents Court, the Court was only asked to consider whether the Hearing Officer had been correct in exercising his discretion to allow amendments to be filed. The appeal did not go to the possible extent of any opposition to those amendments though it did recognise that one factor in whether to exercise discretion to allow amendment was the possible extent of any re-litigation. Hence the *Monkey Tower* decision is not binding on me. The claimant also considers that there are in any event many distinguishing facts and features between the present case and the *Monkey Tower* case. I will come to those shortly.
- 31 The defendant also recognises that *Monkey Tower* is not binding on me but notes that the judgement in *Nikken* referred to above most definitely is. In addition to the passages of that judgement I have already referred to, the claimant highlights the additional statement of Laws LJ at [30] where he notes:

*“I wish only to underline my firm support for the view, which is a major and emphatic theme of my Lord, Jacob L.J.’s judgment, that the result of this appeal is driven by the principle of the general law given by Henderson and clothed with renewed vigour by the overriding objective of the CPR, that in any given litigation the parties are required to bring forward their whole case. It provokes certainty of economy and minimises expense, and it applies as powerfully in this area of the law as any other.”*

- 32 The reference above to *Henderson* refers to the case of *Henderson v Henderson*<sup>6</sup>. A frequently cited paragraph from that case is:

*“In trying this question I believe I state the rule of the Court correctly when I say that, where a given matter becomes the subject of litigation in, and of adjudication by, a Court of competent jurisdiction, the Court requires the parties to that litigation to bring forward their whole case, and will not (except under special circumstances) permit the same parties to open the same subject of litigation in respect of matter[s] which might have been brought forward as part of the subject in contest, but which was not brought forward, only because they have, from negligence, inadvertence, or even accident, omitted part of their case.”*

- 33 I was referred also to the Court of Appeal in *Nokia v ICom*<sup>7</sup> where the Court referred with approval to what it referred to as the *Nikken* principles and where Jacob LJ. went on to note:

*“101. In Nikken I then went on to say that an exercise of discretion to allow two trials would be improper for three reasons which I can summarise here:*

*(a) It would breach the general procedural rule laid down as long ago as 1843. in Henderson v Henderson (1843) 3 Hare 100, that a party should normally not be allowed to advance in a second proceeding matter he could have advanced in the first.*

---

<sup>6</sup> *Henderson v Henderson* Court of Chancery - [1843-60] All E.R. Rep. 378

<sup>7</sup> *Nokia v ICom* [2011] FSR 15

(b) *That rule had been applied in patent cases by this Court in Windsurfing v Tabur Marine [1985] RPC 59 and Aldous J in Lubrizol v Esso [1998] RPC 727 . I said Aldous J had epitomised the position when he said, at p.790:*

*I believe it is a fundamental principle of patent litigation that a party must bring before the court the issues that he seeks to have resolved, so as to enable the court to conclude the litigation between the parties.*

(c) *The general court rules were “dead against” allowing amendment proceedings requiring a second trial after a first trial had determined the patent was invalid. I put it this way:*

*[19] ... The whole code is governed by the overriding objective contained in Part 1.1.1. 1.1.2 specifies some examples of cases of dealing with a case justly. 2(b) is “saving expense”. Plainly a second trial would cause increased expense. 2(d) is ensuring that it is “dealt with expeditiously and fairly”. Having two bites of the cherry is doing neither of those things. [20] The rules descend into more detail. Under the court's duty to manage cases, 1.4 requires the court actively to manage cases and 1.4.2 says that active case management includes “identifying the issues at an early stage and dealing with as many aspects of the case as it can on the same occasion”.*

- 34 Also in *Warner Lamber v Generics*<sup>8</sup> the Supreme Court considered whether on the issue of amendment after trial it should adopt a different approach to that in *Nikken* and *Nokia* and decided that there was no good reason to do so. Lord Sumption went on to comment on amendments to partially valid patents noting:

*“119. I can deal briefly with the second ground, namely that this was an amendment to a partly valid patent. That is literally true, even given our conclusions on insufficiency, since the claims relating to different types of inflammatory pain have survived. But it misses the point of the Nikken principles. They distinguish between (i) amendments merely to delete claims and related material which have been found to be invalid, and (ii) amendments designed to make good a claim not thus far advanced in the amended form. The proposed amendment of claim 3 is not to excise parts found to be invalid. The whole of claim 3 was held invalid. Furthermore it is common ground that it would require a further trial to test the validity of the amended claim 3.”*

- 35 So, what can I take from these precedents? It is clear that proposing amendments of the type here is generally allowable because the assumption is that they will not give rise to a new trial. Amendments going further than deleting the invalid claims from a patent found to be partially invalid, and which would likely give rise to the need for a new trial, are not allowable since to allow them would be contrary to the principle in *Henderson*. It would constitute an abuse of process as the patentee should have proposed the amendments earlier and in sufficient time for them to be considered at the hearing. It is however important to note that the precedents referred to that are binding on me all relate to the allowability of possible amendments after the trial rather than to the question of the scope of any opposition to any allowed amendments.

- 36 However, in *Monkey Tower* the Hearing Officer concluded that any opposition should also be limited and should not give rise to a new trial. As highlighted above, he relied first on a position that section 75 proceedings were separate proceedings to those of section 72 and thus section 74 prevented validity being put in issue in the section 75 proceedings. He also found that if he was wrong on that then the principles in *Nikken*

---

<sup>8</sup> *Warner Lamber v Generics* [2018] UKSC 56

would apply to prevent “at all costs” further litigation. I can see nothing that would cause me to question the reasoning or findings in *Monkey Tower*. If I had to take a particular position on those considered by the Hearing Officer, I would be inclined to treat the amendments under section 75 as part of the original section 72 proceedings however nothing I believe turns on that.

- 37 The claimant seeks however to distinguish the case here from *Monkey Tower*. It notes firstly that there is only one new citation to be introduced here, rather than the “twelve or so” of *Monkey Tower*. In *Monkey Tower*, none of the twelve or so citations had been in the bundle, nor formed part of the claimant’s evidence in the substantive hearing on patentability; wherein in this matter the JP’413 was introduced during the evidence rounds, and certainly in the bundle, before any decision on patentability was issued.
- 38 I find no force in the argument about the number of additional citations. Even if as here it is only one citation there is common ground amongst the parties that it would require a new trial. That the document was referred to in the evidence does not alter that. The claimant as Mr Kime admitted did not plead the objection on that document and consequently it was not considered at the first hearing. Indeed, I went so far as to explicitly exclude consideration of it given the lateness with which the objection was first raised.
- 39 The claimant also argues that in *Monkey Tower* there was no indication that one of the citations was clearly “on point” in invalidating the patent as proposed to be amended. This it argues is not the case with JP’413. Referring to *Withers and Rogers V John Henry Dobson*<sup>9</sup>, the claimant suggests that where an un-pleaded document shows a blatant lack of novelty or obviousness it is still appropriate to consider it in the public interest. I make finding on whether JP’413 shows such a “blatant lack of novelty or obviousness”, though I note that if it does then it is surprising that the claimant did not recognise this when the document was first introduced into the proceedings and sought a corresponding amendment to the pleadings. What is more significant is that in the *Withers and Rogers* case the issue before the hearing office was whether documents that were not properly pleaded should be considered at the substantive hearing. In the event the hearing officer having admitted them “de bene esse” chose not to consider them. In contrast here I explicitly ruled that JP’413 could not be admitted in the substantive hearing. Hence, I do not see any parallels or anything from that case to suggest I should now allow the document to be admitted as part of the opposition irrespective of whether it is “on point” or not.
- 40 The claimant also highlights the Comptroller’s position as the guardian of the public interest in keeping the register free of clearly invalid patents, referring in particular to *American Science & Engineering Inc. and Rapiscan Systems Inc*<sup>10</sup>. It notes that they was no apparent balancing exercise undertaken during the substantive hearing when deciding to exclude JP’416. I do not recall the claimant making such arguments at the substantive hearing and even if it had then this argument essentially still goes to whether the claimant believes my earlier decision was correct. Indeed, I found

---

<sup>9</sup> [Patent Decision BLO/331/06](#)

<sup>10</sup> [Patent Decision BL O/119/16](#)

several of the claimant's arguments as being more about the earlier decision than about the opposition to the amendment.

- 41 A further example of this is the suggestion that I did not follow the practice in the CIPA Guide to the Patents Act "the Black Book" where it refers also to the Comptroller's public interest responsibility. The Black Book notes that in *BOC International's Application*<sup>11</sup> the Court noted that where it occurs to a Hearing Officer only at the stage of writing their decision that an application is clearly anticipated, they should normally recall the parties for further argument, having drawn their attention to the point. As I have noted, if the claimant did not agree with how I handled the issue of JP'413 in my earlier decision, it should have appealed it. I would mention also that there is also a clear public interest in providing finality of litigation.
- 42 I will address a few of the many other points raised by the claimant in their skeleton argument and at the hearing. The claimant notes that the decision at first instance in *Monkey Tower* refers to "the known defect identified in the original proceedings". It argues that here the known defect was a lack of inventive step over AT12838 in combination with the common general knowledge, which was exemplified by JP'413. The claimant goes on to argue that the requirement in *Monkey Tower* was that the issue had been identified and not that the issue has been pleaded or even considered by the claimant, arguing that the mere fact that a defect had been identified is sufficient.
- 43 I am not convinced this really helps the claimant. I dealt with the question of whether JP'413 on its own exemplified the common general knowledge at paragraph 35 of my earlier decision noting that I agreed with the defendant that no evidence had been advanced to support that. Notwithstanding that, it is clear that the defect that I found with the patent, as clearly set out in my findings was that it lacked novelty and inventiveness in light of the prior art ie AT12838. The inventive step finding would of course have regard to the common general knowledge but JP'413 was not that. There is no finding, or identification even, of any defect in respect of JP'413 on its own as prior art or in combination with the common general knowledge.
- 44 So where does this leave me? The claimant has put forward a number of arguments why I should not follow *Monkey Tower* both in its skeleton argument and at the hearing. Those arguments have not always been easy to follow though I have I believe responded to them all above. I have in any event revisited the skeleton argument and the recording of the hearing. Having carefully considered these together with the submissions of the defendant I am satisfied that it would be wholly inappropriate to allow the claimant to challenge the proposed amendments based on JP'413 alone or with the common general knowledge. This is because I have already explicitly rejected the raising of such arguments in my earlier decision on the basis that they were not properly pleaded. To allow them to be introduced now would be to counter to the overriding objective and the principles set out in *Henderson v Henderson* that the parties should bring their whole case at the earliest opportunity.
- 45 The claimant has raised no other objections to the proposed amendments which as discussed above merely in effect delete claims found to be invalid. There is no

---

<sup>11</sup> *BOC International's Application* [1980] RPC 122

suggestion that the amendments are unclear or add matter. The amendments are therefore allowable.

## Costs

- 46 I addressed my initial thoughts on costs in my earlier decision and in the subsequent preliminary evaluation. In respect of the proceedings as a whole the claimant has been successful. The patent was found to be invalid at least in part. It is therefore entitled to its costs in respect of that part of the proceedings. However, it has failed in its efforts to oppose the proposed amendments and that needs also to be considered in any final cost order.
- 47 In respect of the proceeding up to and including the substantive hearing I am satisfied that an award in line with the comptroller's published scale<sup>12</sup> is justified. The defendant did argue that it had been successful in defending what it considers to be the more commercially important claim. It also sought to highlight what it claims was unreasonable behaviour by the claimant including seeking to rely on prior art not clearly pleaded and seeking to exclude the patentee's expert on the basis that he had not been shown the prior art. This according to the claimant resulted in additional costs of £3,327 for the claimant which it argues should be offset against any award to the claimant.
- 48 The claimant in response rightly notes that no evidence has been provided on the commercial significance of the claim deemed valid. If the other claims that were found invalid were not commercially significant then it begs the question, why did the defendant seek to defend them? I do not believe that the defendant's point about the challenge to its expert witness has any real legs. Indeed, there were issues about how the defendant had instructed their witness which I picked up on in my decision. The claimant's efforts to introduce the additional prior art more fully into the proceedings did necessitate more effort by the defendant however I am not persuaded it was that significant noting that the document had been raised already in another context.
- 49 Hence for the period up to and including the earlier substantive decision I am minded to award the claimant the sum of £2600 as a contribution to its costs. This is made up of the following:
- £400 for preparing a statement and considering the other side's statement
  - £1000 for preparing evidence and considering and commenting on the other side's evidence:
  - £1200 for preparing for and attending the hearing.
- 50 I turn now to the costs in relation to the opposition to the amendments. The defendant contends that the Preliminary Evaluation accurately set out the relevant principles, and clearly set out how that law has been applied to the facts of this case. The conclusions reached as a consequence are plainly correct. The consequence of any confirmation of the Preliminary Evaluation will be that all of the costs incurred in

---

<sup>12</sup> [Tribunal practice notice \(2/2016\): Costs in proceedings before the Comptroller](#)

preparing for and attending the second hearing have been unnecessarily incurred because of the Applicant's unreasonable conduct. The claimant should therefore be ordered to pay all of those costs of the Patentee. Subsequent to the hearing the defendant submitted a cost schedule with a total of £8763. Of this it would appear that approximately £5000 appears to have been incurred in preparing for and attending the hearing.

- 51 I am satisfied that the final decision I have reached here is in line with my preliminary views in the Preliminary Evaluation. In the evaluation I also warned the parties that costs off the scale may be payable if either side requested a hearing and the outcome was in line with the preliminary evaluation. That was I believe a fair warning to give and consistent with the guidance given in the Patents Hearing Manual<sup>13</sup>. However ultimately what I need to decide is whether the hearing was unnecessary. On balance I believe it was and that therefore it is appropriate to depart from the scale. That does not mean that the defendant is entitled to its full costs. But it does justify a departure from the published scale.
- 52 Cost awards in proceedings especially before the Comptroller are not an exact science and ultimately it is a question of me arriving at a figure that I think is fair in the circumstances. I believe that the cost award to the defendant outside of preparing and attending the hearing will be less than the comparable costs awarded to the claimant for the earlier part of the proceedings. Whilst the second hearing was slightly shorter than the earlier hearing I will go beyond the published scale and award the defendant £2000 for costs associated with the hearing and a further £600 on-scale costs in respect of its costs on the opposition. The two cost awards therefore cancel each other out.

### **Conclusion and order**

- 53 I have concluded that it would not be appropriate to allow the claimant to oppose the proposed amendments on the basis of JP4157413B2 having already excluded any argument based on that document alone in my earlier decision.
- 54 I am satisfied that the amendments to GB2468976B submitted on 6<sup>th</sup> July 2022 are clear and do not add matter.
- 55 I therefore allow Per-Christian Irgens to amend the patent under section 75(1) and direct that clean amended pages should be filed and incorporated into the specification.
- 56 I order that both sides bear their own costs.

### **Appeal**

- 57 Any appeal must be lodged within 28 days after the date of this decision.

PHIL THORPE  
Deputy Director acting for the Comptroller

---

<sup>13</sup> [Patents Hearing Manual](#)