

**PATENTS ACT 1977**

BETWEEN

Sterling IP Ltd

Claimant

and

Commonwealth Scientific and Industrial  
Research Organisation

Respondent

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PROCEEDINGSApplication under section 72 of the Patents Act 1977 to  
revoke patent N<sup>o</sup> GB 2353282 B

HEARING OFFICER

Stephen Probert

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**DECISION — COSTS**

- 1 The substantive issue between the parties in these proceedings has gone away, following amendment of the patent under section 75. Proceedings did not get as far as evidence rounds, but there were several amendments to the statements of case as the parties refined the issues in dispute, and there has also been at least one Case Management Conference (CMC). The only issue that remains for me to decide is that of costs. At the most recent CMC on 16<sup>th</sup> April 2012, it was agreed that the parties would provide written submissions on costs, and that I would then issue this decision on the basis of those submissions.

**And the winner is ...**

- 2 The first issue to decide is who won, and which side (if any) is entitled to an award of costs. The claimant's statement requested that the patent be revoked in its entirety. But the claimant did not succeed in this regard, because the patent has survived, albeit in an amended form. On the other side, the respondent's counterstatement asked for the patent to be maintained as granted. So to the extent that the patent has been amended, and the scope of its claims reduced, the respondent also has been unsuccessful. Nevertheless, at the CMC on 16<sup>th</sup> April, and in the written submissions that followed, the respondent has agreed that the claimant is entitled to a contribution to its costs. I think this is right. Notwithstanding the customary adversarial positions adopted by both sides in their statements of case, the scope of a granted patent has been either clarified or

reduced, and this would not have happened if the claimant had not brought these proceedings. So on that basis I consider that the claimant is entitled to a contribution towards its costs.

### **Costs**

- 3 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.
- 4 The claimant has asked for costs in line with the standard scale, and specifically referred to the official fees associated with Patents Form 2 (£50) and Patents Form 4 (£350) which the claimant had to file in order to launch, and continue with, these proceedings.
- 5 At the CMC on 16<sup>th</sup> April 2012, I expressed a preliminary (non-binding) view that a costs award of around £500 would appear to be appropriate in this case. The respondent has confirmed in writing that they “... *agree to this amount, but no more*”. Having carefully considered the written submissions on costs provided by both sides, and in all the circumstances of this case (particularly bearing in mind the number of amendments that had to be made to the statements of case before the parties settled), I have concluded that £500 is indeed the appropriate award to make. In reaching this conclusion, I have not been influenced by the respondent’s statement that it would “*not agree*” to a higher award; if I felt that the claimant was entitled to more than £500, I would have so ordered — whether the claimant agreed or not.

### **ORDER**

- 6 I order the respondent, Commonwealth Scientific and Industrial Research Organisation, to pay the claimant, Sterling IP Limited, five hundred pounds (**£500**) as a contribution to its costs in these proceedings.

### **Appeal**

- 7 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