Award of costs in proceedings before the Comptroller: A look at the factors affecting the decision

1. Introduction

1.1 The UK Intellectual Property Office (UKIPO) has the power to hear cases and make decisions in *inter partes* proceedings on some matters of patent law (entitlement, infringement, revocation).

1.2 The powers of the UKIPO are somewhat restricted in comparison to those of the court (for example, only the court may award an injunction), but proceedings before the UKIPO are in general less costly.

1.4 The UKIPO also differs from the court in awarding costs against an unsuccessful party: the court has much broader powers to award realistic compensatory costs, while the UKIPO is more strictly governed and usually will only award costs on a standard published scale.[1]

2. Departure from the scale

2.1 In exceptional circumstances, the UKIPO may award costs above the standard scale.

2.2 For example, in one particular case[2] the UKIPO considered that the unsuccessful party had submitted a vast number of documents, the majority of which were irrelevant to the proceedings but which nevertheless the opposing party had been obliged to spend time reviewing and considering.[3] However, the unsuccessful party had repeatedly suggested mediation, which the successful party had refused to consider, despite the encouragement of the UKIPO.[4]

2.3 It was accepted that submitting large numbers of irrelevant documents was a reason for awarding off-scale costs, but it did not in the event lead to a departure from the published scale because of the refusal to consider mediation.

[1] TPN 6/2008
[2] BL O/274/08
[3] Ibid, Paragraph 40
[4] Ibid, Paragraph 42

3. Summary

3.1 The UKIPO is not averse to awarding off-scale costs in the event of unnecessary or unreasonable behaviour by a party to the proceedings.

3.2 Any party requesting costs must ensure that their own behaviour will withstand scrutiny; making a good-faith suggestion of alternative dispute resolution may have a tactical effect if the other side refuses to engage.

3.3 To this end, parties should ensure that they are properly advised and that their representatives are capable of taking an overall view of the proceedings, rather than simply focussing on winning the litigation.

3.4 As highlighted in a previous article[5], it is possible that behaviour in proceedings before the UKIPO will be taken into account in the event that the matter proceeds to court. Parties are therefore strongly advised to check with their representatives whether alternative dispute resolution has been considered and suggested during proceedings before the Comptroller.

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The information provided in this document is, of course, of a general nature and should not be considered as legal advice; if you have any specific questions, please contact us as set out above.

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[5] "*A Closer Look at Patent Office Opinions*" paragraphs 6.1 & 6.2