

Cast

BLO/86/95

Dr P Ferdinando  
3Y46

**PATENTS ACT 1977**

**IN THE MATTER OF** an application under section 46(3) by C.I.S (Cast Iron Services) Ltd for settlement of the terms of a licence of right under Patent No 1585498 in the name of Douglas Lunan Stewart

5/5/95

**DECISION**

The application was filed on 18 July 1994. A statement of objection was filed by the patentee on 4 October 1994. The applicant wrote to the Office on 1 December 1994 requesting an extension of the period for filing a counterstatement for the reason that a similar application for settlement of the terms of a licence of right on the same patent had just been concluded and the applicant was in negotiation with the patentee with a view to coming to a settlement without the need to progress the application before the comptroller. In the absence of any objection from the patentee, the requested extension was granted.

On 17 January 1995 the applicant wrote to the Office formally withdrawing the application. The patentee then belatedly asked for an award of costs because the applicant had withdrawn unilaterally. Both parties agreed that the matter of an award of costs should be determined on the papers on file without recourse to a hearing.

The applicant requested the following comments to be taken into account:

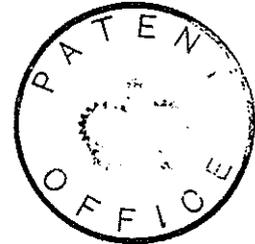
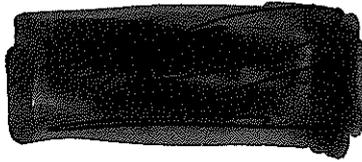
"Firstly, the Proprietors included no request for costs when filing their Statement of Objection, and, as it is our understanding that costs are not normally an issue in a Section 46(3) Application, the Applicants could not possibly have been aware that costs might be requested if they were to withdraw the Application unilaterally. In other circumstances, the Applicants may have decided to negotiate an agreement for withdrawal. We submit therefore that no award of costs should be made in respect of the belated request.

Secondly, in the event that an award of costs is considered, we would draw the Hearing Officer's attention to the fact that the documentation in this case is the same

as that in the prior Application under Section 46(3) filed by Fabrikat (Nottingham) Limited. The actual costs incurred by the Proprietors should therefore have been minimal."

It is quite correct that no relief by way of an award of costs was requested in the patentee's Statement of Objection and that it is not normally the practice of the comptroller to make an award of costs when settling the terms of a licence under section 46(3). However, it is not unknown for the comptroller to make an award of costs against an applicant under section 46(3) who withdraws his application after the patentee has been involved in a measurable amount of work. In this particular case however the amount of work which the patentee has been obliged to put into the case, as the applicant has pointed out, has been minimal, and for that reason I make no award of costs.

Dated this 5 day of May 1995



K E PANCHEN  
Superintending Examiner, acting for the Comptroller

**THE PATENT OFFICE**