



Neutral Citation Number: [2023] EWHC 1535 (Pat)

Case No: HP-2022-000024

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS IN ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)
PATENTS COURT

Rolls Building
Fetter Lane
London, EC4A 1NL

Date: 26/06/2023

Before :

MR JUSTICE ZACAROLI

Between :

DAVID PARSONS

Claimant

- and -

CONVATEC LIMITED

Defendant

Patrick Green KC and Ben Norton (instructed by Kingsley Napley LLP) for the Claimant
Adam Gamsa (instructed by Bird and Bird LLP) for the Defendant

Hearing date: 8 June 2023

Mr Justice Zacaroli:

Introduction

1. From February 1991 until 2022, the claimant, Dr David Parsons, an analytical chemist, was employed by the defendant, Convatec Limited (“Convatec”). During that time, he claims to have made, alone or jointly with others, various inventions which belonged to Convatec, for which patents were subsequently granted mostly (but not all) to Convatec. The inventions mainly related to the use of silver in antimicrobial plasters and/or dressings and related products.
2. On 5 September 2022, Dr Parsons commenced this action, seeking compensation from Convatec pursuant to section 40 of the Patents Act 1977 (the “1977 Act”).
3. Convatec applies to strike out (or for summary judgment in respect of) certain aspects of Dr Parsons’ claim.

The statutory provisions relating to a claim under s.40

4. Section 40(1) of the 1977 Act, as amended by the Patents Act 2004 (the “2004 Act”), provides as follows:

“Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that—

(a) the employee has made an invention belonging to the employer for which a patent has been granted,

(b) having regard among other things to the size and nature of the employer’s undertaking, the invention or the patent for it (or the combination of both) is of outstanding benefit to the employer, and

(c) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer,

the court or the comptroller may award him such compensation of an amount determined under section 41 below.”

5. Section 40(2) of the 1977 Act (as amended) applies where a patent has been granted for an invention made by and belonging to the employee, and the rights in the patent or invention are subsequently assigned or licensed to the employer.
6. Section 41(1) of the 1977 Act (as amended) provides as follows:

“An award of compensation to an employee under section 40(1) or (2) above shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which the employer has derived, or may reasonably be expected to derive, from any of the following—

(a) the invention in question;

- (b) the patent for the invention;
- (c) the assignment, assignation or grant of—
 - (i) the property or any right in the invention, or
 - (ii) the property in, or any right in or under, an application for the patent,
 to a person connected with the employer.”

7. The claim in respect of certain of the older patent families in dispute in this case is governed by the version of s.40 as it applied prior to the amendments introduced by the 2004 Act. That provided as follows:

“Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that the employee has made an invention belonging to the employer for which a patent has been granted, that the patent is (having regard among other things to the size and nature of the employer’s undertaking) of outstanding benefit to the employer and that by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer, the court or the comptroller may award him such compensation of an amount determined under section 41 below.”

- 8. The original version of s.41(1) provided that an award of compensation under s.40(1) in relation to a patent for an invention “...shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which the employer has derived, or may reasonably be expected to derive, from the patent or from the assignment, assignation or grant to a person connected with the employer of the property or any right in the invention or the property in, or any right in or under, an application for that patent....”.
- 9. By s.40(7) (in both the original and amended versions), reference to an invention belonging to the employer are to it so belonging “as between the employer and the employee.”
- 10. By s.40(6) (in both the original and amended versions), the “prescribed period”, in relation to proceedings before the court, means “the period prescribed by rules of court.” CPR 63.12(2) defines the prescribed period as beginning on the date of the grant of the patent and ending 1 year after the patent has ceased to have effect.
- 11. The prescribed period for applications to the comptroller is similarly the period beginning with the date of the grant of the patent and ending one year after the patent ceased to have effect: Rule 91 of the Patents Rules 2007. By rule 108(1), the comptroller may, if he thinks fit, with certain exceptions which do not apply here, extend or further extend any period of time prescribed by the Rules. By s.99 of the 1977 Act, the Court may, for the purposes of determining any question in the exercise of its original or appellate jurisdiction, make any order or exercise any other power which the comptroller could have made or exercised for the purpose of determining

that question. It is common ground that the Court has a discretion, pursuant to these provisions, to extend the prescribed period.

12. In relation to certain aspects of his claim, Dr Parsons accepts that it is necessary that the prescribed period is extended, as his claim was made more than one year after the relevant patent ceased to have effect. For that purpose, he has made an application to extend the prescribed period.
13. Accordingly, the elements of Dr Parsons' claim for compensation under s.40 are as follows:
 - (1) Dr Parsons, alone or jointly with others, made an invention;
 - (2) The invention – as between Dr Parsons and Convatec – belongs to Convatec;
 - (3) A patent has been granted for the invention;
 - (4) The patent (or, in relation to claims governed by s.40 as amended by the 2004 Act, the invention, or the combination of both) is of outstanding benefit to Convatec;
 - (5) It is just that Dr Parsons should be awarded compensation by the employer; and
 - (6) The claim is brought within the prescribed period, or such extended period as the Court allows.

The test for strike-out and/or summary judgment

14. Convatec accepts that its application for strike-out and/or summary judgment must be decided on the basis of the pleaded facts being assumed in Dr Parsons' favour, where there is any factual dispute. Accordingly, but only for the purposes of its application, Convatec accepts that Dr Parsons was the inventor, alone or jointly with others, of the various inventions in issue, for which patents have been granted, and that the patents and/or (where relevant) inventions are of outstanding benefit to Convatec.
15. CPR 32.42(a) permits the Court to strike out a statement of case if it appears to the Court that the statement of case discloses no reasonable grounds for bringing the claim. CPR 24.2 permits the Court to give summary judgment against a claimant on the whole of a claim, or a particular issue, if it considers that the claimant has no real prospect of succeeding on the claim or issue, and that there is no other compelling reason why the case or issue should be disposed of at trial.
16. The approach to summary judgment is summarised in the seven principles set out by Lewison J in *Easyair Ltd v Opal telecom Ltd* [2009] EWHC 339 (Ch) at §15:
 - i) The court must consider whether the claimant has a “realistic” as opposed to a “fanciful” prospect of success: *Swain v Hillman* [2001] 2 All ER 91;
 - ii) A “realistic” claim is one that carries some degree of conviction. This means a claim that is more than merely arguable: *ED & F Man Liquid Products v Patel* [2003] EWCA Civ 472 at [8]

iii) In reaching its conclusion the court must not conduct a “mini-trial”:
Swain v Hillman

iv) This does not mean that the court must take at face value and without analysis everything that a claimant says in his statements before the court. In some cases it may be clear that there is no real substance in factual assertions made, particularly if contradicted by contemporaneous documents: ED & F Man Liquid Products v Patel at [10]

v) However, in reaching its conclusion the court must take into account not only the evidence actually placed before it on the application for summary judgment, but also the evidence that can reasonably be expected to be available at trial: Royal Brompton Hospital NHS Trust v Hammond (No 5) [2001] EWCA Civ 550;

vi) Although a case may turn out at trial not to be really complicated, it does not follow that it should be decided without the fuller investigation into the facts at trial than is possible or permissible on summary judgment. Thus the court should hesitate about making a final decision without a trial, even where there is no obvious conflict of fact at the time of the application, where reasonable grounds exist for believing that a fuller investigation into the facts of the case would add to or alter the evidence available to a trial judge and so affect the outcome of the case: Doncaster Pharmaceuticals Group Ltd v Bolton Pharmaceutical Co 100 Ltd [2007] FSR 63;

vii) On the other hand it is not uncommon for an application under Part 24 to give rise to a short point of law or construction and, if the court is satisfied that it has before it all the evidence necessary for the proper determination of the question and that the parties have had an adequate opportunity to address it in argument, it should grasp the nettle and decide it. The reason is quite simple: if the respondent's case is bad in law, he will in truth have no real prospect of succeeding on his claim or successfully defending the claim against him, as the case may be. Similarly, if the applicant's case is bad in law, the sooner that is determined, the better. If it is possible to show by evidence that although material in the form of documents or oral evidence that would put the documents in another light is not currently before the court, such material is likely to exist and can be expected to be available at trial, it would be wrong to give summary judgment because there would be a real, as opposed to a fanciful, prospect of success. However, it is not enough simply to argue that the case should be allowed to go to trial because something may turn up which would have a bearing on the question of construction: ICI Chemicals & Polymers Ltd v TTE Training Ltd [2007] EWCA Civ 725.”

17. Convatec’s application relates to five distinct patents, or families of patents, which I address under the following sub-headings. The details of the inventions, and of the patents granted in respect of them, do not matter save for the limited description provided under each of the following sub-headings.

Bray 2003

18. The pleaded facts relevant to this family of patents include the following: in around 1999-2000, Convatec was in a joint venture with Acordis Speciality Fibres (“ASF”); Dr Parsons “devised the inventive concept of producing a partial and homogenous conversion of a Hydrocel fibre to a silver/sodium Hydrocel fibre (without degrading the physical form) by the rapid and simultaneous addition of the Hydrocel fibres to a carefully managed solution of aqueous/alcoholic silver nitrate”; as between Dr Parsons and Convatec, the invention belonged to Convatec; it was patented by ASF, and was exploited by Convatec; subsequently, in 2004 when Convatec acquired the share capital of ASF, it also acquired the legal ownership of the patent in respect of Bray 2003.
19. Convatec seeks to strike this claim out on three bases:
 - (1) The patent was granted to ASF, not Convatec;
 - (2) Dr Parsons was not named as an inventor;
 - (3) It is *partially* barred by the operation of s.9 of the Limitation Act 1980 (“LA 1980”).

The patent was not granted to Convatec

20. Mr Gamsa, who appeared for Convatec, submitted that it is a necessary component of a claim under s.40 that the patent granted in respect of the relevant invention belonged, at the time of its grant, to the employer.
21. The short answer to this submission is that it is not what s.40 says. The section is clear in requiring that the *invention* belongs to the employer. In contrast, all that it says about the patent is that it is granted for that invention. On its face, it is not a requirement of s.40 that the patent is granted to the employer.
22. Mr Gamsa submitted that when s.40 is read together with s.39 it nevertheless should be read as requiring that the patent, too, belongs to the employer from the outset.
23. S.39, however, is concerned only with the question as to when an invention made by an employee will be taken to belong to the employer. It reinforces the conclusion that it is the invention, and the invention alone, which must – under s.40 – belong to the employer. That is further reinforced by the amended version of s.40, under which the concept of outstanding benefit is extended to that resulting from the invention.
24. It is true that, under s.40(1) as it applied prior to 2005, outstanding benefit had to be derived from the patent alone. That does not necessitate, however, that the patent was granted at the outset to the employer: it is entirely feasible that an employer could derive a benefit from a patent granted to another, for example where the patent was granted to a joint venture partner but on terms that enabled the employer to benefit from its subsequent exploitation.
25. It is accordingly unnecessary to consider Dr Parsons’ alternative contention that, if it is a requirement of s.40 that the patent belongs to the employer, that was satisfied in this case by the subsequent acquisition of the patent by Convatec in 2004.

Dr Parsons was not named as an inventor

26. Mr Gamsa submitted that an employee cannot make a claim under s.40 in respect of a patent unless he is named as inventor within the patent.
27. There is a similarly short answer to this point: nothing in s.40 refers to the need for the employee to be named as inventor within the patent. The only requirement is that the employee has in fact made an invention.
28. Mr Gamsa relied on section 32(9) of the 1977 Act, which provides that “the register shall be prima facie evidence of anything required or authorised by this Act or rules to be registered...”
29. Assuming in Convatec’s favour that the name of the inventor is something required or authorised by the Act or rules to be registered, this does not assist Convatec, since “prima facie evidence” may be rebutted by evidence to the contrary.
30. In any event, while s.13 of the 1977 Act grants an inventor the *right* to be mentioned in the patent, it does not impose any obligation on the inventor to be mentioned. Rule 10 of the Patent Rules 2007 reflects the inventor’s right by imposing an obligation on the owner of a patent, where an inventor is not mentioned in the patent or an application for a patent, to mention the inventor in an “addendum or erratum to the application or patent”. Rule 11, however, reflecting the right of an inventor *not* to be named, permits an inventor to apply to the comptroller to waive his right to be mentioned as inventor. A requirement that an inventor must be named as such in the relevant patent before he or she could make a claim under s.40 would not sit happily with the above provisions.
31. Mr Gamsa also relied on a passage in the Manual of Patents Practice which, at para 10.02, suggests that an employee who wishes to make a claim under s.40 should be named as inventor of the patent. As Mr Green pointed out, however, the manual has no legal force. In view of the conclusion I have reached above, I consider that the manual is in this respect wrong.

Time-barred under LA 1980

32. It is common ground that Dr Parsons’ claim was brought within the prescribed period for the purposes of s.40. Convatec contends, however, that to the extent that outstanding benefit accrued to it more than six years prior to the commencement of these proceedings, the claim is barred by s.9 of LA 1980. That section provides that an action to recover any sum recoverable by virtue of any enactment shall not be brought after the expiration of six years from the date on which the cause of action accrued.
33. Mr Gamsa submitted that a cause of action accrues under s.40 when each of the elements of the cause of action is established; that the last (in time) of the elements to be established will invariably be the accrual of outstanding benefit to the employer; and that where, therefore, any outstanding benefit accrued to Convatec more than six years prior to the commencement of the action, it cannot be relied on for the purposes of the claim under s.40.

34. I reject this submission on the grounds that s.9 of LA 1980 does not apply to a claim under s.40 at all. By s.39 of LA 1980, the other provisions of that act are disapplied where “a period of limitation is prescribed by or under any other enactment”. The “prescribed period” under s.40 by CPR Rule 63.12, and by Rule 91 of the Patents Rules 2007, is in my judgment plainly a period of limitation prescribed under the 1977 Act.
35. Mr Gamsa submitted that the prescribed period under s.40 is not a period of limitation, because the comptroller and the Court have a discretion to extend the limitation period, under Rule 108(1) of the Patent Rules 2007 and s.99 of the 1977 Act respectively. He submitted that a limitation period, as described in McGee on Limitation Periods, 9th ed., at §1.001, “specifies a time-limit within which legal proceedings of a particular kind must be brought.” To qualify as a provision imposing a limitation period, therefore, the provision must preclude proceedings being brought after the end of the period. The prescribed period for the purposes of s.40 does not satisfy that requirement, he submitted, because proceedings can be commenced after the end of the prescribed period if time is extended.
36. I do not accept this. The “prescribed period” in s.40(1) is in terms stated to be the period within which an employee may bring a claim. The fact that, pursuant to the rules of court, the prescribed period may be extended does not preclude it being a “limitation period” under LA 1980. It is just that it is a limitation period that is itself capable of being extended. The fact is that s.40, and the rules made under s.40(6), provide a self-contained regime for when claims under s.40 can be made, which therefore oust the provisions of LA 1980.
37. Any other conclusion would in any event be unworkable. I can see how the application of s.9 LA 1980 might in theory work if it was said (by analogy with an action for damages in tort) that the action is barred six years from the first time an outstanding benefit accrues to the employer. That, however, is (rightly) not the way Mr Gamsa put the point: it would be in direct conflict with CPR 63.12 and Rule 91 of the Patent Rules. He submitted instead that while the action itself is not barred, an employee cannot “rely” on any outstanding benefit that accrued more than six years before the commencement of the proceedings. The concept of “outstanding benefit” is not one, however, that can readily be divided into time periods. It is likely to be answered in any given case by having regard to the cumulative benefits accruing to the employer over the life of the patent. If at the end of the life of the patent it can be said that the cumulative benefit derived from it has been outstanding, then it would make no sense to exclude from consideration any benefit derived from the patent more than six years ago if it could be said that such benefit was – at that time – outstanding, but not if it was a benefit that fell short of that epithet. The employee is entitled to claim, not to recover any part or parts of the “outstanding benefit” itself, but to be paid compensation calculated by reference to various factors, once it is established that the employer has derived outstanding benefit from the patent and/or invention.
38. Mr Gamsa referred to a passage in the CIPA Guide to the Patents Acts, at §41.08, which suggested it might be possible to argue, as with an infringement action, that the LA 1980 should restrict the period of time over which the compensation is assessed. For the reasons I have set out above, I consider that suggestion – which refers only to the possibility of such an argument – to be wrong.

39. Mr Green KC, who appeared for Dr Parsons, pointed to s.33(1) of LA 1980 which confers a discretion on the court to disapply the time limits prescribed by ss.11, 11A, 11B and 12 of LA 1980. The effect of the disapplication of the time limits would be to permit actions to be brought after the relevant time limit. Although Mr Gamsa submitted that there is a distinction between a discretion to extend a time period and a discretion to disapply it, the latter would permit a claim to be brought after the end of the relevant time limit as much as the former, and it is that possibility which, on Mr Gamsa's argument, prevents the relevant time limit being a period of limitation for the purposes of s.39(1) of LA 1980. The fact that a limitation period contained within LA 1980 allows for that possibility reinforces the conclusion that the prescribed period under s.40 is a "period of limitation" within s.39(1).
40. While not determinative, since Mr Gamsa's argument was not advanced in the case, I note that the Court of Appeal in *Coletta v Bath Hill Court (Bournemouth) Management Co Ltd* [2019] EWCA Civ 1707, had no difficulty in regarding the period identified in s.23(2) of the Employment Rights Act 1996 (which provided that the Employment Tribunal "shall not consider" a complaint presented after the specified period) as a limitation period for the purposes of s.39 of LA 1980, notwithstanding that the tribunal had a discretion, under s.23(4), to extend it.

Bowler, Jacques & Parsons 2002 ("BJP 2002") and Bowler, Parsons and Walker ("BPW 2004")

41. According to the Particulars of Claim, BJP 2002 relates to an inventive concept designed by Dr Parsons in 2000-2001 of forming a silver complex on the surface of silver Hydrocel fibres as an intermediate to enable photo-reduction as opposed to the observed oxidation process. BPW 2004 relates to an inventive concept designed by Dr Parsons in or around May 2002 of defining how incorporating silver into Hydrocel and similar anionic polymers at an appropriate level by ion exchange can lead to controlled and sustained silver release at a low but therapeutic level.
42. It is common ground that the European patents under these families of patents were revoked more than one year before the commencement of proceedings (in February 2016 in the case of EP1343510 (BJP 2002), and in January 2011 in the case of EP1539070 (BPW 2004)), such that the prescribed period for bringing a claim under s.40 expired in February 2017 and January 2012 respectively. Dr Parsons accepts, therefore, that to bring this claim he needs an extension of time (which I deal with separately below).
43. Convatec also contends that these claims should be struck out, in part, on the basis of s.9 LA 1980. I reject that contention for the reasons set out above.

Percival, Bowler and Parsons 2007 ("PBP 2007")

44. According to the Particulars of Claim, in or around 2005 Dr Parsons devised the inventive concept of utilising the synergy between EDTA and iodine to reduce the concentration of the antimicrobial and EDTA.
45. In addition to the limitation point under s.9 LA 1980 (which I reject for the same reasons as above), Convatec contends that this claim should be struck out because it is accepted by Dr Parsons that the invention to which these patents related was not used

in any commercial product. Mr Gamsa submitted that, in those circumstances, there is no prospect of Dr Parsons establishing that any outstanding benefit accrued to Convatec as a result of the invention or patent.

46. Mr Green pointed, in response, to the fact that benefit can accrue from an invention or patent in ways other than the invention being used in a product. It is contended in the Particulars of Claim, for example, that Convatec benefitted from the patent by preventing others from entering into the market so as to compete with its related commercial products, and thus used the patent to increase the price and/or market share for those products. That point is reinforced by the fact that Convatec successfully fought off a challenge to this patent, from which it might be inferred that the patent was of benefit to it.
47. Convatec accepts – for the purposes of this application only – that these factual allegations are true. In my judgment, Mr Green is correct that the fact this invention was not used in any product marketed by Convatec is not in itself a bar to the claim that outstanding benefit accrued to Convatec from the patent.

Bonnefin, Buggedo, Parsons and Thompson (“BBPT 2013”)

48. According to the Particulars of Claim, Dr Parsons (with the others mentioned in the title of the patent above) devised the inventive concept of strengthening the needle-punched nonwoven fabric of the gelling fibre in wound dressings with non-gelling yarn stitching.
49. The only point taken by Convatec in relation to this patent is that because the filing date for the patent was *after* the launch of one of the products in which it was used (namely a product called AQUACEL Extra), the success of that product “cannot be due to the patented technology ... On the Claimant’s case, BBPT 2013 was invalidated by prior use and BBPT 2013 lacks novelty by reason of sections 1 and 2 [of the 1977 Act]”. Mr Gamsa submitted that by making the products available in the market, sufficient information was disclosed about the invention to enable others to replicate it, so that a valid patent could not subsequently be obtained.
50. There are, as Mr Green submitted, two answers to this contention.
51. First, there is a dispute of fact as to whether the “launch” of AQUACEL Extra disclosed sufficient information about the invention to enable others to replicate it, prior to the priority date of the patent. It is not known whether the “launch” included making available the product itself to the market or, if it did, whether that resulted in disclosure of sufficient information about the invention.
52. Second, even if there had been sufficient prior disclosure to invalidate the patent, in fact no-one has so far sought to revoke the patent on that ground. Mr Gamsa initially argued that because a successful challenge to a patent results in it being revoked *ab initio*, there can never be a claim for compensation under s.40 in respect of an invalid patent. In the face of s.43(5A) of the 1977 Act (which excludes, for the purposes of ss.40 and 41, any benefit derived from a patent after it has been revoked, and thus implies that a claim for benefit in relation to a revoked patent lies in respect of the period prior to it being revoked), however, he abandoned that argument.

53. The first of these points is one which can only be resolved after an investigation of the facts at trial. The second is a complete answer to the way the point was advanced at the hearing.

Application to extend time in respect of EP1343510 (BJP 2002) and EP1539070 (BPW 2004)

54. Both parties agreed that the Court has an unfettered discretion to extend time, but that it should be exercised on a principled basis. Neither side could point to any authority which identified the principles that should be applied in exercising the discretion. Both submitted that the question is simply to be answered in light of all the circumstances.
55. This action was commenced more than five years after the end of the prescribed period in relation to EP1343510 (BJP 2002) and more than eight years after the prescribed period in relation to EP1539070 (BPW 2004). A very long period of extension is required, on any view. The status of the patents was publicly available, and Dr Parsons was aware of Convatec's products during the prescribed period. It is true that an employee is likely to have less visibility than an employer as to whether the latter has obtained an outstanding benefit from the relevant patents, but that will be the case both during and after the prescribed period.
56. There is in fact no evidence of the reasons why Dr Parsons did not bring a claim within the prescribed period for either patent, or why he delayed doing so for many years after they were revoked. The evidence in support of the application consists of points of principle made in the witness statement of his solicitor. These, as summarised by Mr Green, consist of four main points.
57. First, the claim is made in respect of a number of different patents, all but two of which remained in force for the full twenty-year period. It would have been impractical and disproportionate to bring a separate claim in respect of the two revoked patents. Mr Green relied in particular on the risk to Dr Parsons' employment, if he had made a claim within the prescribed period in respect of either of the revoked patents. He submitted that Dr Parsons had therefore acted reasonably and proportionately in bringing his claims together.
58. I do not accept that these are good reasons for extending time. Where a claim is brought in respect of different patents, to succeed in respect of any one of them it must be shown that the employer derived outstanding benefit from it. As I have already noted, any benefit derived from a patent after it has been revoked is ignored. Section 40 envisages the possibility of multiple claims being brought in respect of the same patent, and *a fortiori* permits multiple separate claims relating to different patents. I accept that an employee will not necessarily have enough information, during the year after the revocation of one patent, to decide to bring a claim relating to other, continuing, patents. I do not think, however, that waiting to see whether there may be a claim in relation to other patents provides a good reason for not having launched a claim in relation to the revoked patent during the prescribed period. Nor, in my view, does the fear that the employer may react inappropriately to a claim being brought. In any event, in the absence of evidence of Dr Parsons' reasons for not bringing a claim earlier, I do not know whether he was in fact influenced by such considerations.

59. Second, claims within the BJP 2002 and BPW 2004 patent families will anyway continue to trial. For example, only the European patents were revoked, and the US patents were maintained until expiry (in the case of the BJP 2002 family, in 2021). All questions relating to the invention of the patents, and many (but probably not all) questions relating to outstanding benefit, will therefore be explored at trial irrespective of whether time is extended in relation to the two revoked patents.
60. While I accept that extending time in relation to the two revoked patents would not add materially to many of the matters that need to be investigated at trial, in considering whether to extend time the Court should also take into account the substantive protection which the prescribed period provides to employers against the risk of liability being imposed many years after the event. I am not in a position to form any view as to the merits of Dr Parsons' claims, but must assume that extending time would at least potentially increase the amount, if any, awarded against Convatec. I do not consider that the lack of impact on the trial process is sufficient reason to remove that protection by extending time for what is undoubtedly a very substantial period.
61. Third, Dr Parsons would be prejudiced without an extension of time, because he would then be unable to bring a claim in respect of the two patents. Any person whose claim is time barred is prejudiced if they are not relieved from the consequences of that time bar, however. Accordingly that cannot in itself be a material factor in deciding whether to extend time.
62. Fourth, there is (as may often be the case as between employer and employee) an asymmetry of resources as between Dr Parsons and Convatec, and the Court should lean in favour of the employee. In support of that submission, Mr Green pointed to the special costs regime relating to claims under s.40. S.106 of the 1977 Act requires the Court to take into account all the circumstances, including the financial resources of the parties, in determining whether to make a costs award and, if so, in what amount. I do not accept that this provides a persuasive reason either: asymmetry of resources might be a more important factor if it led to the employee being unaware of matters necessary for their claim to be brought, but that is not alleged here. Some mitigation against it is in any event provided by the costs provisions to which Mr Green referred.
63. Having regard to all the circumstances, I do not think there is sufficient reason to exercise my discretion by extending time. It follows that the claims in respect of EP1343510 (BJP 2002) and EP1539070 (BPW 2004) are out of time and should be struck out.