



BL O/062/04

8th March 2004

PATENTS ACT 1977

BETWEEN

Eugenie Sergeyevich Aleshin

Claimant

and

Sony United Kingdom Limited

Defendant

PROCEEDINGS

Reference under section 37 and application under section 72 of the Patents Act 1977 in respect of patent number GB 2330747

HEARING OFFICER

D J Barford

PRELIMINARY DECISION

- 1 These proceedings are concerned with the entitlement to patent number GB 2330747, both under section 37 and under section 72(1)(b). The present decision is concerned solely with the question of whether I should allow a request by the defendant, Sony United Kingdom Limited (“Sony”), for an extension of time to file its counter-statement.

Background

- 2 Mr Aleshin filed a Form 2/77 at the Patent Office on 24 October 2002 with a view to initiating these proceedings, however the necessary fee was not received until 24 February 2003. Even then extensive correspondence between the Patent Office and Mr Aleshin was necessary in order to clarify the claim, and as a result it was not until 1 December 2003 that Mr Aleshin’s statement of case was served on Sony. Under rules 54(3) and 75(3), Sony was then given six weeks, that is to say until 12 January 2004, to file a counter-statement if it wished to oppose the claim.
- 3 On 11 December 2003, Sony requested an extension of time to the end of March to file its counterstatement, stating amongst other reasons that “The very serious nature of Mr Aleshin’s assertions are such that we may need to coordinate our response from many different parties in various countries”. An official letter dated 22 December 2003 indicated that in view of the particular circumstances an extension to 31 March 2004 was appropriate, and a copy of that letter was sent to the address for service in the United Kingdom provided by Mr Aleshin who lives in Russia. On 12 January 2004,

Mr Aleshin informed the Patent Office by email that his address for service was no longer operative. In case he had not received the letter of 22 December 2003, the Office emailed him on 19 January 2004 regarding the extension of time.

- 4 In letters of the 25 and 28 January and 19 February 2004 Mr Aleshin objected to an extension of time in extreme terms, alleging criminal conduct by Sony. Mr Aleshin also argued that Sony had already had a year to put its case.
- 5 In a letter dated 20 February 2004, Sony set out in detail its reasons for maintaining the request for an extension of time to 31 March 2004, again noting the severity of Mr Aleshin's allegations, arguing that it is in the interest of both parties that all of the points raised by Mr Aleshin are fully considered, that it will be necessary for Sony to consult people in various countries, and that Mr Aleshin's allegations are based upon his own patent application which Sony argues is difficult to understand and hence requires a study of the application file.
- 6 I understand both parties to be content for this preliminary issue to be decided on the papers.

The principles to apply

- 7 It is not in dispute that the question of whether I allow an extension of time is a matter for my discretion. The periods set by the rules should be sufficient in most cases and there is therefore a general presumption against extending them. It is therefore essential for a party seeking an extension to put forward reasons, and this Sony has done. Equally Mr Aleshin has put forward reasons why I should refuse the request. The task before me is to decide whether it would be reasonable to allow the request taking into account all of the circumstances, and having particular regard to the need to deal with the case fairly and expeditiously.

Argument

- 8 I turn first to the points made by Mr Aleshin. He has made serious allegations of criminal conduct against Sony, and argues that an extension of time would give further opportunity. However all of this is completely unsubstantiated and I am therefore unable to attach any weight to it. He has also argued that Sony has already had a year to put its case, which I assume is based on the fact that his Form 2/77 and the required fee were both in place on 24 February 2003. However as already noted, due to deficiencies in Mr Aleshin's statement it was not served on Sony until 1 December 2003, and it is not until then that the clock started ticking in these proceedings. Hence rather than having already had a year to put its case, if I allow the extension Sony would have a total of four months.
- 9 That said however the onus remains on Sony to justify its request and I turn to the detail of Mr Aleshin's statement. This comprises a four page document with numerous attachments.

- 10 Sony refers to the severity of Mr Aleshin's allegations. Given that there are references in the statement to fraud and bribery, there can be no doubt that this is the case.
- 11 Sony submits that it will be necessary for it consult people in various countries. I note that the attachments include, amongst others, extensive correspondence with lawyers, private corporations and public authorities in Russia, Japan and the United States, which without going into the detail of that correspondence, appears to me to be supportive of Sony's submission.
- 12 Sony also submits that Mr Aleshin's allegations are based upon his own patent application which Sony argues is difficult to understand and hence requires a study of the application file. In paragraph 3 of his statement Mr Aleshin indeed refers to a patent granted to him, GB 2369278. However this patent has just three pages of description, two sheets of drawings and three claims, and even if it is not straightforward to understand, it seems to me that the six week period originally set under the rules is ample time to form a considered view of the contents of the patent. I therefore attach little weight to this strand of Sony's argument.
- 13 The need to deal with the case fairly requires me to consider the effect on each party of allowing or not allowing an extension. It seems to me that Sony is correct in its basic assertion that it is in the interest of both parties that all of the points raised by Mr Aleshin are fully considered. Having considered all of the circumstances of the case and in particular the gravity of Mr Aleshin's allegations and the extensive correspondence he has brought into the proceedings, I am satisfied that the effect on Sony of not allowing an extension would be that it would be denied the opportunity fully to address all of the issues raised and it would be unable properly to present its case. On the other hand I have dismissed the reasons given by Mr Aleshin as to why I should refuse the extension. In consequence it seems to me that the effect on Sony of refusing the request would significantly outweigh the effect on Mr Aleshin of allowing it.
- 14 The extension requested is a long one, and I have to bear in mind that there is a need to deal with the case expeditiously. However, I am not persuaded that the delay in the proceedings that this extension would introduce is significant when set against the overall time that proceedings of this nature typically take, and more particularly when measured against the time that it has taken Mr Aleshin himself to get his case into shape.
- 15 For completeness I should add that it is clearly to be regretted that Mr Aleshin did not receive a copy of the Patent Office letter of 22 December 2003 in good time, and as a consequence was not in a position to oppose the extension until after the original date set for filing the counter-statement had passed. However this circumstance was wholly due to the failure of his address for service in the United Kingdom, and he did not inform the Office of this until 12 January 2004, the date by which the counter-statement was due. In any event he has had ample opportunity to put forward reasons why I should refuse the request, an opportunity he has taken full advantage of through his letters of 25 and 28 January and 19 February 2004. In the event I do not think this is a factor that I need to take into account in this decision.

Conclusion

- 16 Having regard to my findings above, I accede to the request by Sony and extend the period for the filing of its counter-statement to 31 March 2004.

Costs

- 17 Neither side has raised the question of costs in respect of this preliminary issue, and accordingly I make no order in that respect.

Appeal

- 18 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

DAVID BARFORD

Deputy Director acting for the Comptroller