



BL O/070/04

17th March 2004

PATENTS ACT 1977

BETWEEN

Shannon Biotechnologies Ltd

Claimant

and

John Anthony Walters

Defendant

PROCEEDINGS

Reference under sections 8 and 12 and application under Section 13 of the Patents Act 1977 in respect of patent application numbers GB 0215532.3, 0217130.4, 0227595.6, 0229315.7 and 0300052.8

HEARING OFFICER

R C Kennell

STATEMENT OF REASONS

- 1 In these proceedings, each party having filed its statement of case, the Patent Office wrote to the claimant on 13 January 2004 giving until 24 February 2004 to file its evidence in accordance with rules 7(4) and 14(4) of the Patents Rules 1995. In a letter to each party dated 11 March 2004 I gave a preliminary decision allowing the claimant an extension of this period until 18 March 2004. In that letter I agreed to provide a statement of reasons for my decision and this now follows.

Background

- 2 It will be helpful to explain this in some detail. On 24 February 2004, the last day of the evidence period, the agents for the claimant (who is based in Ireland), wrote to the Patent Office asking for an extension of the period until 13 April 2004. The reasons for the request were that a large number of the claimant's assertions were disputed and that obtaining corroborative evidence "from outside the jurisdiction and independent parties" had been time consuming.
- 3 The defendant's agent replied on 27 February 2004 saying that this extension, amounting to 7 weeks to a 6-week term, was completely unreasonable in the light of the attitude taken by the claimant when the defendant requested an extension of the period taken to file his counter-statement, and that they were not prepared to accept an

extension any longer than one week.

- 4 Subsequent correspondence between the parties and with the Patent Office produced some movement, in that the claimant believed it could now file its evidence by 30 March 2004, whilst the defendant was prepared to accept an extension until 10 March 2004. The defendant said this date was one day before a meeting with counsel which had been arranged before it became apparent, after the deadline of 24 February 2004 had passed, that the claimant would seek an extension.
- 5 The parties were not prepared to compromise any further but agreed that I should determine the matter on the papers on file. In a letter to the parties dated 5 March 2004 I stated that I was minded to allow an extension to 10 March, but before I could consider any further extension the claimant would need to explain why some of the difficulties could not have been foreseen, bearing in mind the lateness of the request for extension, and the defendant would need to explain why it was not possible to postpone the meeting with counsel.
- 6 This elicited further letters from each party on 9 March 2004. The claimant's agent said that the proceedings were only part of the dispute between the parties, and the relationship between them was so poor that there was no co-operation between them. They explained that (i) because of a police investigation concerning the activities of the defendant and impending criminal proceedings against him, it had not been possible to get any documents from him until 9 February, (ii) that further highly relevant material had only just been received, and (iii) it had been necessary before filing some of the evidence to seek assurances, not received until 5 March, that its use and disclosure would not prejudice the police investigations. The agent also said that the request for extension was filed late because, although they were aware that an extension would probably be required, they did not know the likely length.
- 7 The defendant's agent explained that at the time they arranged the meeting with counsel, 10 and 11 March were the only available dates before June at the earliest, and that it would now prove difficult to reorganise a meeting before the end of July.

Reasoning

- 8 In the aforesaid letter of 9 March, the claimant's agent drew attention to the provisions of rules 1.1, 3.1.2(a) and 3.9 of the Civil Procedure Rules, and the recent decision of the comptroller in *Hydra-Ject Services UK Limited v Enston* BL O/047/04. Whilst the comptroller is not bound by the provisions of the Civil Procedure Rules, the overriding objective of rule 1.1 to deal with cases justly is as relevant to proceedings before the comptroller as to proceedings before the court. Further, in the *Hydra-Ject* decision the hearing officer felt that he should have careful regard to the criteria in rule 3.9 for allowing relief from sanctions when considering a request to admit late-filed evidence, without necessarily requiring evidence in support of the request as required by rule 3.9(2).
- 9 The present case is not quite on all fours with *Hydra-Ject* since it concerns a request to extend the period which has been set for filing evidence, rather than a request to admit further evidence after the initial evidence has been filed. A power to extend a period

of time is provided by rule 3.1.2(a) as part of the case management powers of the court. The parties have not addressed me on whether and to what extent regard should be had to the rule 3.9 criteria when considering a request under rule 3.1.2(a). However (although I glean little assistance from it) I note the discussion on this point in "Civil Procedure 2003", Volume 1 at 3.1.2, contrasting the judgments of the Court of Appeal in *Sayers v Clarke Walker* [2002] 3 All ER 490 and *Robert v Momentum Services Ltd* [2003] 2 All ER 74.

10 Whether the comptroller is bound to consider all, or even any, of the rule 3.9 criteria in considering whether to exercise discretion to extend a time period seems to me to be a moot point, but it is not, I think, one which I need to formally decide. In all the circumstances of the present case, it seems to me that these criteria constitute a sensible starting point, and that the following are especially significant:

- the interests of the administration of justice;
- whether the request to extend the period was made promptly;
- whether there was a good explanation for the failure to meet the original time limit;
- the effect which that failure to comply had on each party; and
- the effect which the granting of an extension would have on each party.

As mentioned above, rule 3.9(2) requires the filing of supporting evidence. None has been filed, but I am content to take the claimant's explanation at face value.

11 If justice is to be administered fairly, the parties should as far as practicable be on an equal footing and I should not therefore lightly deprive a party of the opportunity to file evidence in support of its case. However, in proceedings before the comptroller there is a general presumption that the evidence periods prescribed by the Patents Rules should suffice in the majority of cases, having regard to the public interest in the expeditious conduct of the proceedings. If a coach and horses are not to be driven through the provisions of the Rules, there must therefore be a sufficient reason to allow an extension and that extension should be no longer than is necessary.

12 As to whether the request was made promptly it must count against the claimant that the request was not made until the very last day of the period. I am not convinced that the claimant was prevented from earlier action because it did not know the length of the extension that would be required. Difficulties in getting the evidence together appear to have manifested themselves well before the expiry date, and I see no reason why the claimant could not at an earlier stage have formed some estimate of the time that might be needed.

13 Nevertheless, I am satisfied that points (i) and (iii) at least in the agent's letter of 9 March 2004 constitute a good reason for failure to meet the time limit. However, it is not clear to me whether these factors have affected all the evidence that the claimants might wish to file, or that the need to get clearance for use and disclosure of some of

the evidence prevented at least some work being done to prepare it. I am not therefore convinced that these reasons necessarily justify the length of the extension which is sought.

- 14 As to the effect on the parties of the failure to meet the time limit and the granting of an extension, there would be a prejudice to the claimant if an extension was not granted since it would be prevented from filing its evidence. I have considered this above in relation to the interests of the administration of justice.
- 15 The granting of an extension, at least beyond 10 March, would however prejudice the defendant in that its meeting with counsel would almost certainly need to be postponed. Whilst I recognise that the claimant's late request may well have wrong-footed the defendant, and that the defendant has gone some way to meet the claimant by agreeing to an extension to 10 March, I do not consider that this should be decisive of the matter. It has not been explained why everything should hinge on one meeting at this stage of the proceedings, or whether any contingency plan to brief other counsel had been made in view of the expected absence of the counsel of choice for such a long period after 11 March. I have to say that I would find it surprising if the claimant did not have such a plan - even if the evidence rounds had proceeded normally, the absence of counsel might be just as likely to cause difficulties later in the proceedings, say at the evidence in reply stage.
- 16 Having considered all these reasons, I said in my decision allowing an extension to 18 March 2004 that I did not consider the claimant's reasons sufficiently exceptional to justify the full extension sought, or the prejudice to the defendant in having to postpone the meeting sufficient to deny a further short extension. I should add that in their agent's letter of 9 March 2004, the claimant suggested that the extension to 30 March was justified because the likely hearing date would not be affected by the extension request and the defendant's counsel was unavailable until July in any event. However, I do not consider that these reasons are sufficiently compelling to outweigh the matters which I have mentioned above.

Costs

- 17 In my decision I made no award of costs.

Appeal

- 18 As explained in the decision itself, under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days from the date of the decision (11 March 2004).

R C KENNEL

Deputy Director acting for the Comptroller