

- an “apprehension” about the UK legal system is not a reason to try to invoke the provisions of rule 81. The claimant has not set out extenuating circumstances for allowing an alteration of the time limit;
- if the attorney had “apprehension” about the UK legal system then it could have instructed, or at least sought the advice of, the UK patent attorney registered as the address for service (HGF Ltd);
- the counter-statement itself is dated 16 November and therefore there was no reason why it could not have been filed, e.g. by fax, on 16 November, nor any reason why the Office was not informed before the deadline that there were likely to be problems in submitting the document on time;
- the fact that the counter-statement is dated 16 November suggests in itself that there was no difficulty understanding the UK legal system;
- the claimant’s position could be materially impacted by the decision to allow the counter-statement to be accepted;
- rule 74, which sets out the overriding objective of enabling the comptroller to deal with cases justly, should be applied equally to the claimant as well as to the proprietor.

5 These proceedings are being conducted under Part 7 of the Patents Rules (2007), and rule 81 of these Rules states that the comptroller may extend or shorten (or further extend or shorten) any period of time which has been specified under any provision of this Part and that an extension may be granted notwithstanding the period of time specified has expired. In other words, the comptroller has the power to change any period of time which has been specified under this Part even when the deadline has already passed. In doing so, the comptroller is also bound by the overriding objective set out in Rule 74, which I set below:

Overriding objective

74(1) The rules in this Part set out a procedural code with the overriding objective of enabling the comptroller to deal with cases justly.

(2) Dealing with a case justly includes, so far as is practicable -

- (a) ensuring that the parties are on an equal footing;*
- (b) saving expense;*
- (c) dealing with the case in ways which are proportionate -*
 - (i) to the amount of money involved,*
 - (ii) to the importance of the case,*
 - (iii) to the complexity of the issues, and*
 - (iv) to the financial position of each party;*
- (d) ensuring that it is dealt with expeditiously and fairly; and*
- (e) allotting to it an appropriate share of the resources available to the comptroller, while taking into account the need to allot resources to other cases.*

(3) The comptroller shall seek to give effect to the overriding objective when he -

- (a) exercises any power given to him by this Part; or*
- (b) interprets any rule in this Part.*

(4) The parties are required to help the comptroller to further the overriding objective.

- 6 The principles to apply in deciding whether to allow the proprietor's request for an extension of time to file its counter-statement were set out neatly at paragraph 7 of the Hearing Officer's preliminary decision in *Aleshin v Sony*¹:

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.

- 7 The proprietor has provided a reason why it was unable to file a counter-statement by the initial deadline. On the basis of where the proprietor and his attorney are located, i.e. Poland, the explanation appears reasonable and I do not doubt that there would be more of an effort involved in preparing the proprietor's case due to familiarising themselves with UK legislation than might be the case for the defendant. However, the proprietor ought to have been aware of this difficulty as soon as the statement of case was served, but has provided no explanation as to why the request for an extension was not made sooner, before the deadline, or why arrangements had not been put in place to mitigate the consequential delay, e.g. by instructing a UK patent attorney.
- 8 I give little weight to Mr Moore's suggestion that there must have been another reason for failing to file the counter-statement in time given that the covering letter bears the date of 16 November 2017 and was still filed late. As I have said, the reason provided by the claimant seems a reasonable one on its face.
- 9 Mr Moore rightly refers to the overriding objective of ensuring that both sides are on an equal footing and treated fairly, which requires me to consider the effect on each party of allowing or not allowing an extension. The effect on the proprietor of not allowing the extension would be that it would be denied the opportunity to address fully all of the claimant's reasons why the comptroller should make a declaration of non-infringement of his patent. The comptroller would not be bound to agree with the claimant's arguments or to find against the proprietor, but the comptroller could, in theory, come to a different conclusion if not presented with arguments to the contrary.
- 10 The effect on the claimant of not allowing the extension would be that proceedings would become uncontested and the comptroller would likely be able to reach an earlier decision with regard to a declaration than would otherwise be the case. If the extension were to be allowed then the delay in receiving the counter-statement, if any at all given the time it might take the Office to formally serve it on the claimant, would unlikely have an impact given the length of the extension. Mr Moore does not specify how a delayed response would have a material impact on the claimant.
- 11 I think the length of the extension is an important factor to consider. The fact that the proprietor is asking for only an extension of one day, albeit retrospectively, implies that he was aware of the deadline and was making an attempt to meet this deadline to the best of his ability. It might have been better if the proprietor had warned the

¹ BL O/062/04

Office and the claimant that he needed some extra time to file the counter-statement in advance of the deadline, but the process of deciding whether to allow such an extension and the claimant's opportunity to oppose such a request would have been exactly the same regardless, i.e. I'm not convinced that any time would have been saved if the claimant had requested the extension in advance of the deadline as opposed to when he did. Rule 81 does allow for requests to be considered notwithstanding the fact that the period of time has expired, although it is generally good practice and a matter of business courtesy to request an extension in advance, and even then the extension is not a formality.

- 12 Taking all of this into account, I consider that the interest of deciding the case justly is best served by allowing the proprietor's request for an extension. I note again that the counter-statement was filed within the extended period, so the Office will now formally serve the counter-statement on the claimant and specify the period within which it should file a Patents Form 4 to continue proceedings.
- 13 Neither side has addressed me in relation to costs. Based on the amount of correspondence received from the proprietor in relation to the extension, I would expect that the cost he has incurred is so trivial that I would not expect to award any costs in his favour at this stage. However, I am prepared to consider the question in more detail if and when the matter reaches the point of a substantive decision.

Appeal

- 14 Any appeal must be lodged within 28 days after the date of this decision.

H Jones

Deputy Director, acting for the Comptroller