



PATENTS ACT 1977

PROCEEDINGS

Application under Section 72 of the Patents Act 1977
to revoke UK Patent No. GB 2 543 968 B

BETWEEN

Cocogreen (UK) LTD
and

Claimant

Botanicoir Limited

Defendant/
Proprietor

HEARING OFFICER

Stephen Probert

For the claimant: Mr William Jensen of Marks & Clerk Solicitors LLP
For the defendant: Mr Jim Robertson of Wynne-Jones IP

Hearing date: 6 March 2019

PRELIMINARY DECISION

1. Following a preliminary hearing on 6th March, I granted the claimant an unconditional two week extension of time to the deadline for filing its evidence-in-chief in these proceedings. I also agreed to grant a further two week extension of time on condition that the claimant files certain specified evidence within the period of the unconditional two week extension. This decision explains my reasons for granting these extensions, and also deals with consequential changes to the timetable for the remaining evidence rounds in this case.

Background

2. The claimant, Cocogreen (UK) LTD, has applied to revoke patent GB 2543968B under section 72 on the grounds of lack of novelty and/or inventive step. The patent relates to a coir substrate made from coconut husks (a by product of the coconut food industry), and apparatus and methods for producing the coir substrate. The claimant also provided, with its statement of grounds, a witness statement by a Director from the Coconut Development Authority of Sri Lanka.
3. The defendant in these proceedings (and registered proprietor of the patent), Botanicoir Limited, filed a counter statement denying the grounds for revocation.

4. A timetable for filing evidence was agreed at a Case Management Conference on 15th January 2019, and the claimant was due to file its evidence-in-chief on or before 26th February. On 15th February, the claimant's new patent attorneys (Marks & Clerk) wrote to the Office stating that they had now been instructed to act on behalf of the claimant in place of the previous firm of patent attorneys, and requested a one month extension of time to allow them to review the files, consider the issues and determine the scope of the evidence that would be required.
5. The Office wrote to the defendant, who indicated that it would consent to an extension of one week or (if I deemed it necessary and appropriate) an extension of two weeks. The claimant maintained that two weeks would not provide sufficient time to complete its evidence, and requested a hearing on the issue. That hearing was held (by telephone) earlier this week. After hearing submissions from Mr Jensen (for the claimant) and Mr Robertson (for the defendant), I told them what my decision would be, and that (in view of the timescales) I would issue this written decision with my reasons as soon as possible.

Arguments in support of the request

6. Mr Jensen presented two main reasons to justify the one month extension of time. The recent change of legal representative was the first reason, and the second reason was the difficulty he has experienced discussing the case with the expert witness in Sri Lanka. I don't need to say much more about the first reason — it is not unusual for parties in litigation to change their legal representatives during proceedings. Whether it is a good enough reason to justify an extension of time will depend on the particular circumstances and the amount of extra time being requested.
7. As for the second reason, Mr Jensen told me that the claimant's expert witness, Mr Edirimanne, has a demanding job working for the Coconut Development Authority of Sri Lanka. Mr Edirimanne does not work for Cocogreen, and has been assisting the claimant in his own time. Mr Jensen said that he cannot compel Mr Edirimanne to prepare evidence for his client, and is wholly dependent on his good will. Moreover, in order to gather some of the information required in a further witness statement, Mr Edirimanne will probably need to travel over a large geographic area, as the coconut industry is widely spread across Sri Lanka.
8. Mr Jensen also said that although Mr Edirimanne can read and speak English, it is not his native tongue, and he requires some linguistic assistance when reading and analysing complex technical documents in the English language. Added to this, Sri Lanka is five and a half hours ahead of Greenwich Mean Time, and this imposes certain restrictions on telephone conversations with Mr Edirimanne.
9. Mr Jensen was able to assure me that he has received some emails and WhatsApp® messages from Mr Edirimanne. Furthermore, a telephone conference call with Mr Edirimanne is booked for Friday morning and employees from Cocogreen (UK) LTD will be travelling to Sri Lanka in time for the telephone conference.

Arguments against the request

10. Mr Robertson explained why the defendant was opposed to an extension of time longer than two weeks. He referred to paragraph 2.55 of the Patents Hearings Manual ¹, quoting the first three sentences. Mr Robertson submitted that the claimant did not appear to have done anything to prepare its evidence in the period from 15th January (the CMC) to the 15th February (when Marks & Clerk came on board).
11. Mr Robertson also pointed out that it was the claimant who initiated this revocation action in September 2018, and that it should have had the evidence ready before starting proceedings. While this is correct, I noted at the hearing that the issues in dispute between the parties had changed quite significantly in light of the defendant's counter statement, and were further clarified at the CMC on 15th January. For example, until that point, the claimant had assumed that the composition of the coir substrate itself is the invention, and not the machinery used to produce it. In my preliminary view, that was not an unreasonable assumption to make having regard to the way in which the invention is described in some parts of the patent specification.²
12. Consequently, at the CMC I suggested that it would be useful if the claimant were to provide evidence identifying one or more of the machines that Mr Edirimanne says have been used in Sri Lanka to produce coconut coir substrate for at least ten years. I do not think the claimant could be expected to anticipate the need for this specific evidence prior to receipt of the defendant's counter statement, and possibly not even before the CMC (at which I suggested it).
13. Also, Mr Robertson very fairly admitted that machinery that has been used in the coconut industry in Sri Lanka for over ten years is not going to be clean and shiny. So it may not be a simple task to ascertain the manufacturer name and model number from the machines themselves.

The Law

14. The comptroller's discretion to extend the period for filing evidence comes from rule 81 of the Patents Rules 2007 (as amended), which states:-

Alteration of time limits

81.—(1) 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.

¹ 2.55 The period provided for filing the counter-statement, and the timetable set for the filing of evidence are expected to provide sufficient time for the parties to complete the required actions. In particular, the timetable for the evidence rounds will be known from the outset, and the parties are expected to be diligent in adhering to it in order that the hearing can take place on the appointed date. There is consequently a presumption against extending deadlines. Nevertheless (apart from the periods in relation to oppositions prescribed in rules 76 (2)(b) , 77(7) and 77(10)), there is provision for them to be extended, retrospectively if necessary, under rule 81 of the Patents Rules 2007. In considering any request for an extension of time that does arise, the hearing officer will apply the general principles and the case law underlying the exercise of discretion explained in Chapter 1 and will seek to keep delay to a minimum. It is not expected that any delay of the hearing itself would be allowed.

² Eg. Expressions such as: "Depending on the machinery used" at page 6 line 21.

(2) An extension may be granted under paragraph (1) notwithstanding the period of time specified has expired.

15. The last two sentences of paragraph 2.55 of the Patents Hearings Manual¹ usefully summarise the approach that I should take in considering this request for an extension of time.

Unconditional 2 week EOT

16. Following the approach indicated above, I accepted that the claimant has experienced significant logistical difficulties preparing evidence with the expert witness in Sri Lanka. These difficulties have probably not been helped by the change of legal representative part way through the evidence round. Having regard to everything that I heard from Messrs Jensen and Robertson, I considered that it was reasonable to extend the original deadline for the claimant's evidence by two weeks (ie. until 12th March). By that time I expect the claimant to be in a position to provide some form of evidence identifying at least one of the machines to which Mr Edirimanne refers in his witness statement. Such evidence need not be provided directly by Mr Edirimanne; it could be a copy of an email or WhatsApp® message exhibited to a witness statement by eg. Mr Jensen.

Conditional 2 week EOT

17. If the claimant files the evidence specified in the paragraph above, I will grant the full extension requested by the claimant, extending the deadline for its evidence-in-chief until 26th March. This will allow the claimant the additional time that it has requested to complete its evidence, while at the same time giving the defendant an opportunity to make a start on its evidence. However, any benefit that this partial overlap of evidence rounds provides should not be at the defendant's cost. I am therefore resetting the deadline for the defendant's evidence to 7th May, and the claimant's evidence-in-reply to 4th June (ie. both four weeks later than the dates agreed at the CMC).

Appeal

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

Stephen Probert

Deputy Director, acting for the Comptroller