

PATENTS ACT 1977

BETWEEN

Northern Light Music Limited

Claimant

and

Conversor Products Limited

Defendant

PROCEEDINGS

Reference made under section 37 in respect of
patent number GB2267412 and
under section 8 in respect of its priority document,
patent application GB 9027784.9.

HEARING OFFICER

Peter Back

PRELIMINARY DECISION

- 1 This is a long running dispute in which a number of preliminary issues have arisen. In an earlier preliminary decision dated 26 February 2007 (BLO/060/07) I issued an order for specific disclosure by the Defendant of certain documents.
- 2 The Defendant supplied the Claimant with a very substantial file of documents in response to the order within the time limit specified and has stated that it considers that it has now complied in full with that order.
- 3 On 14 March 2007 I called a Case Management Conference (“CMC”) to address a range of outstanding issues not least of which was the very considerable delay that there has been in the filing of the Claimant’s evidence-in-chief, the Claimant arguing that the delay was due, in part, to its need to obtain disclosure of certain documents. Amongst a number of matters it was agreed at the CMC by all parties that the Claimant would submit its evidence-in-chief by 9 April 2007 provided that the order for disclosure was complied with on time. I note here that 9 April is a bank Holiday so in reality the deadline is 10 April 2007.
- 4 Very regrettably a dispute has now arisen between the parties over whether or

not the order for specific disclosure has been complied with. As a result, on 3 April 2007 the Claimant simultaneously submitted a request for disclosure of documents which it claims were not included in the file supplied by the Defendant and a request for an extension of time in which to file its evidence. The defendant maintains that it has complied in full and is opposing the request for an extension of time.

- 5 Given that the agreed date for the Claimant's evidence is imminent, it is imperative that the extension of time issue is decided promptly and I am grateful to the parties for agreeing to this being decided on the papers. That is the only issue which I will decide in this decision. I appreciate that this will leave the issue of disclosure unresolved at this stage but there is insufficient time for the Claimant to particularise its claim and for the Defendant to respond before the deadline for submission of the Claimant's evidence.
- 6 Accordingly, I need to decide whether the possibility that there are documents falling within my order that have not been disclosed to the Claimant is sufficient reason to justify granting the Claimant an extension of time in which to file its evidence.
- 7 In deciding this issue I think it appropriate for me to go to Rule 3.9(1) of the Civil Procedure Rules as set out in the Patent Hearings Manual paragraph 1.44 which gives a useful checklist of factors which should be considered. Those factors are:-
- (a) the interests of the administration of justice;
 - (b) whether the application for relief has been made promptly;
 - (c) whether the failure to comply was intentional;
 - (d) whether there is a good explanation for the failure;
 - (e) the extent to which the party in default has complied with other rules, practice directions and court orders and any relevant pre-action protocol;
 - (f) whether the failure to comply was caused by the party or his legal representative;
 - (g) whether the trial date or the likely date can still be met if relief is granted;
 - (h) the effect which the failure to comply had on each party; and
 - (i) the effect which the granting of relief would have on each party.

I appreciate that some of these factors relate to a "failure to comply" with a requirement where I am faced with a request for an extension of time in which to comply with a requirement. Nevertheless, the issues are similar.

- 8 Of course, none of these factors are decisive on their own, it is a matter of striking a balance and I will consider each factor in turn. With regard to (a), the interests of the administration of justice, on the one hand there is the possibility that an order for further disclosure, if such is forthcoming, might reveal documents which strengthen the Claimant's case and which it would wish to include in its evidence. On the other hand there is the very considerable delay that has already occurred in the filing of the Claimant's evidence.
- 9 On (b), the request for an extension of time was submitted by e-mail on the afternoon of 3rd April. Between that date and the deadline for filing evidence on

10th April are two bank holidays and a weekend leaving only two working days for the Defendant to respond to the request and for a decision to issue. I have no reason to suppose that the Claimant deliberately left this request to the last minute but it is nevertheless unhelpful that it did.

- 10 With regard to (c) and (d) I do not think there is anything to suggest that the Claimant is doing anything other than seeking an extension of time for what it considers to be perfectly valid reasons. On the face of it the Claimant believes that there are undisclosed documents that will help its case.
- 11 Turning to factors (e) and (f), the Claimant is unrepresented and there is no doubt in my mind that this has contributed to some of the delay and confusion that has already occurred in these proceedings.
- 12 If I grant an extension of time, it does not automatically follow that the substantive hearing will be set back but that is clearly likely given that the Defendant will expect to be allowed the standard period in which to submit its evidence and the Claimant is likely to require the same for its evidence in reply.
- 13 Finally I must look at the consequences for both parties if I grant an extension of time and if I do not. As I have said, it is the Claimant's case that the Defendant has not fully complied with the specific disclosure order of 26 February 2007. It is asking for an extension of time so that further disclosure can take place and so it can have time to consider any further documents revealed and to incorporate that in its evidence. Clearly it is the Claimant's view that if I refuse an extension it will be denied an opportunity to identify evidence which it believes will help its case. On the other hand, if I grant an extension, the Defendant will be subjected to yet further delay in the prosecution of this case. There is a balance to be struck here which I need to probe a little further.
- 14 The Claimant believes that there are documents helpful to its case which have not been disclosed and has set out reasons for this view in a 9 page letter dated 3 April 2007. Although I am not deciding the issue of disclosure here, my preliminary view is that the letter of 3 April does not contain all of the information I would need to decide that issue in that the precise identity of some documents is not clear, neither is it clear whether all of the document actually exist or are merely suspected to exist. This means that it is inevitable that there will be further submissions from both sides before the issue of disclosure can be decided, indeed, the Defendant has not yet had the opportunity to file a response. It is very difficult to predict, particularly given the conduct of these proceedings to date, how long that will take which makes it equally difficult to decide what period of extension would allow the Claimant to achieve its aims. I note in this respect that the Claimant has not specified an extension period, which leaves me in a position of having to guess at what a suitable extension might be or to consider granting an open ended extension.
- 15 In the normal course of events, had these proceedings run smoothly, the Claimant's evidence would have been filed many months ago. The Claimant has never maintained that the entirety of its evidence hinges on the allegedly undisclosed documents. Accordingly I do not think it unreasonable to suppose that the Claimant must be in a position where it can file the bulk, or at least a

significant portion, of its evidence by the agreed deadline.

- 16 In summary, as I see it, the Claimant believes that there are relevant undisclosed documents. What this comes down to is that **if** there is a further order for disclosure, that disclosure **may** reveal further documents, some of which **may** be helpful to the Claimant's case. If all of that was to happen then the Claimant may find itself in a strong position to request leave to file additional evidence but I do not think that this amounts to a strong case for delaying the submission of the entirety of the Claimant's evidence particularly given the lengthy period which the Claimant has already had to prepare the rest of its evidence.
- 17 For all of the reasons given above I do not consider that an extension of time for the filing of the Claimant's evidence is justified and the request is refused.

Costs

- 18 The parties have not made any submissions on cost in respect of this issue.

Appeal

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

Peter Back

Divisional Director acting for the Comptroller