



BL O/009/05

11th January 2005

**PATENTS ACT 1977 &
CIVIL PROCEDURES RULES**

BETWEEN

Specialised Petroleum Group Services

Appellant

and

Smith International Inc.

Respondent

PROCEEDINGS

Appeal against the comptroller's decision under section 72 of the
Patents Act 1977 in respect of patent number GB 2335687 B

HEARING OFFICER

P Hayward

DECISION

- 1 The decision is concerned with the time allowed for a respondent to file a respondent's notice following the lodging of an appeal against a decision of the comptroller.
- 2 On 1st December 2004, acting on behalf of the comptroller, I issued decision BL O/352/04 following an application by Smith International Inc. ("Smith") under section 72 of the Patents Act 1977 for revocation of patent GB 2335687 B in the name of Specialised Petroleum Group Services ("SPS"). On 29th December the patentee, SPS, filed a notice of appeal at the High Court, and this was served on the respondent on 31st December. Under the Civil Procedure Rules, the default time limit for Smith to file a respondent's notice would expire on Friday 14th January. However, Smith has asked me to extend the period by a week, to 21st January. It filed its request by fax yesterday afternoon, though because of a problem with our fax it did not reach me until this morning.

Jurisdiction

- 3 Smith say I have jurisdiction to consider its request, and SPS has not disputed this. Nevertheless, I feel I need to look at the law before going any further.

4 The filing of appeals against decisions of the comptroller under the Patents Act 1977 is now governed by part 52 of the Civil Procedure Rules. Rule 52.4(2) says:

“The appellant must file the appellant’s notice at the appeal court within -

- (a) such period as may be directed by the lower court; or
- (b) where the court makes no such direction, 14 days after the date of the decision of the lower court that the appellant wishes to appeal.”

However, in the Practice Direction to part 52, 52PD17.3 overrides subparagraph (a) by setting a fixed 28 day period for appealing against decisions of tribunals such as the comptroller (so-called “statutory appeals”). Paragraphs 17.2 and 17.3 read:

“17.2 Part 52 applies to statutory appeals with the following amendments:

17.3 The appellant must file the appellant’s notice at the appeal court within 28 days after the date of the decision of the lower court he wishes to appeal.”

Thus the comptroller no longer has the power to extend the appeal period, and this was made clear in Patent Office Practice Notice 1/2003 (revised), published at [2003] RPC 46.

5 The filing of a respondent’s notice to an appeal is governed by rule 52.5 of the Civil Procedure Rules. Rule 52.5(4) reads:

“A respondent’s notice must be filed within -

- (a) such period as may be directed by the lower court; or
- (b) where the court makes no such direction, 14 days after the date in paragraph (5).”

For present purposes, the paragraph (5) date is the date on which the respondent was served with the appellant’s notice.

6 The language of rule 52.5(4) is identical to that of rule 54.4(2), apart obviously from the start date for the 14 days. However, whilst the Practice Direction disappplies subparagraph (a) of rule 54.4(2) to statutory appeals, it does not disapply subparagraph (a) of rule 52.5(4). This seems anomalous, and I have to say I cannot believe the discrepancy was the result of a deliberate decision of the rule drafters. It looks very much like an inadvertent oversight. Nevertheless, I have to apply the law as it stands, not as I think it ought to be. Accordingly, I am satisfied that I do have the jurisdiction to direct what the period for filing the respondent’s notice should be.

Consideration of the request

7 The respondent says it is requesting the week's extension because seven of the 14 days were lost as they coincided with their counsel's Christmas break. The appellant points out that the deadline for filing its appellant's notice fell in the middle of the Christmas break (on 29th December) and they managed to meet this. Its representatives also say that they had anticipated the risk that Smith might lodge an appeal, to which their client would have to respond, by preparing their client and counsel for the possibility of deadlines falling over the Christmas period. Nevertheless, it says it is, with reluctance, willing to consent to the 7 day extension.

8 Neither side has made any submissions on the factors I ought to consider in deciding whether to grant the request. I shall therefore assume that, as with any exercise of discretion, I need to take all the circumstances into account. That will include the behaviour of the parties, the length of the extension, the reasons given, the effect on the parties and the implications for the progress of the appeal. However, in my view the mere fact that the parties have agreed to the extension cannot be decisive, because rule 52.6(2) makes clear that extending time limits is not something parties can simply agree between themselves:

“The parties may not agree to extend any date or time limit set by -

(a) these Rules;

(b) the relevant practice direction; or . . .”

9 Of course I could decline to exercise my jurisdiction on the grounds that it only arises from what I perceive to be an anomaly in the Civil Procedure Rules and so it would be inappropriate to exercise it. However, this is an issue on which a very quick decision is needed because of the imminent expiry of the period in question, and so I do not feel a pedantic approach on my part would be in the interests of justice.

10 In the present case the appellant's notice was served on Smith on New Year's Eve, a Friday. This was no doubt in accordance with the requirement under rule 52.4(3) of the Civil Procedure Rules that it be served “as soon as practicable”, though I do not think the appellant could have been criticised if it has deferred service until 5th January, the maximum period allowed under rule 52.4(3). Be that as it may, because the four days immediately following New Year's Eve were non-working days (the Monday and Tuesday being Bank Holidays), the first day on which the respondent could reasonably start considering the appeal was Wednesday 5th January. Thus I have some sympathy with the respondent because it had lost 5 days of the default 14 day period before it could even start.

11 The appellant suggests counsel should nevertheless have been on standby to deal with any appeal promptly because of the risk of deadlines falling in the holiday period, but that seems a little harsh. Thousands of people take an extended break over the holiday period, and it does not strike me as reasonable to expect them to be on standby simply to deal with the possibility of an appeal like this, where the loss of a few days is manifestly not likely to damage either parties' interests to any significant extent. The extension the respondent has requested is a modest one, it is no longer than is reasonably necessary in the light of the reasons given, and I cannot see it will have any

significant effect on the progress of the appeal. Accordingly I am prepared to grant it.

- 12 Strictly, the power available to me is not to extend the default 14 day period but to direct what the period should be. I therefore direct that the respondent's notice be filed at the court by 21st January 2005.

P HAYWARD

Divisional Director acting for the Comptroller