



BL O/132/06

24th May 2006

PATENTS ACT 1977

BETWEEN

International Fuel Technology Inc.

Claimant

and

Ian Williamson & Clifford Hazel

Defendant

PROCEEDINGS

Reference under Sections 12 and 37 of the Patents Act 1977 in respect of UK Patents GB2361931 and GB2361932 and corresponding foreign patent applications claiming priority therefrom including EP01925713.8 and others

HEARING OFFICER

Peter Back

Preliminary Decision

- 1 A reference under Sections 12 and 37 of the Patents Act 1977 was filed by International Fuel technology Inc ("the Claimant") on 31st January 2005 and a counterstatement was filed by Ian Williamson and Clifford Hazel ("the Defendants") on 29th July 2005.
- 2 In a letter dated 4th November 2005 the Claimant's representatives informed the Patent Office and the Defendants that the entitlement claim was withdrawn. Subsequently, in a letter dated 18th April 2006, the Defendants asked for their costs in full.
- 3 The Claimant was given until 11th May 2006 to submit comments on the Defendants claim for costs. In a letter dated 11th May the Claimant asked for an extension of two weeks to submit these comments. The Defendants opposed the request and both parties agreed that this issue should be decided by me on the papers. It is perhaps unfortunate that a dispute of this nature has to be resolved by a formal decision; nevertheless I will consider the submissions from both sides in detail.
- 4 Put simply, the Claimant is asking for extra time to make submissions on the Defendants' claim for costs and the Defendants are saying that the Claimant

has already had long enough and no extension is justified. The Defendant first submitted its claim for costs in detail on 18th April 2006 which means that if I grant the request for an extension the Defendants will have had a total of just over 5 weeks in which to respond.

5 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.

It is clear that not all of these factors are relevant to this case since there has not been a failure to comply; there has been a request for an extension of time in order to avert such failure.

6 With regard to (a), (b) and (d) the Claimant has said that a draft response has been prepared but that approval of that draft is needed from several quarters in different locations and that time is required for that. The Defendants have objected to any further extension. I do not consider that an additional period of two weeks in a case which started in January 2005 will have any significant impact on the administration of justice. The Defendants have asked for costs considerably above the normal scale costs and a request for a short extension of time in which to respond to such a claim does not appear unreasonable. With regard to (b), the application for an extension of time was made within the original time period.

7 With regard to (e), the Claimant has asked for an extension of time on a previous occasion but that is not unusual in case of this nature and does not appear to indicate any systematic failure. With regard to (f) it is not entirely

clear whether the request for an extension was necessitated by the Claimant or its legal representative and I do not think it has much bearing on this issue. With regard to (g), granting the requested extension of time will cause some small delay in a decision on the costs issue.

- 8 With regard to (h) and (j), if I refuse the request the Claimant will have lost its chance to make submissions on the Defendants' claim for costs which will clearly be to its detriment. If I grant the request, both parties will suffer some small delay in the resolution of the costs issue.
- 9 Having considered these factors it is a matter of striking a balance. The extension of time requested by the Claimant is relatively short and on the papers before me I can see no evidence of bad faith on their part in making it. Given that refusing the request would deprive the Claimant of the opportunity to make submissions on the Defendants' claim for costs, such refusal would result in detriment to the Claimant which far outweighs any detriment to the Defendants which will arise if I grant the request.
- 10 Having taken account of all of the papers before me and for the reasons given above I have come to the conclusion that on balance the Claimant's request for an extension of time is reasonable and justified and that granting it will result in no significant detriment to the Defendants. Accordingly I grant the Claimant an extension of two weeks to the period in which it must make its submissions on costs. That means that those submissions must be made by **25th May 2006** and I understand that the Claimant has already informed the Patent Office that it is in a position to comply with that deadline.

Costs

- 11 The parties have made no submissions on costs in respect of this action.

Appeal

- 12 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