



**PATENTS ACT 1977**

BETWEEN

Susan Grant

Claimant

and

Teifion Emlyn James

Defendant

PROCEEDINGS

Reference under sections 13 and 37 of the Patents Act 1977 in respect of  
GB2421687

HEARING OFFICER

P R Slater

---

**PRELIMINARY DECISION**

- 1 These proceedings relate to a reference under section 37(1) of the Patents Act 1977 and an application made under section 13(3) of the Act and rule 10(2), filed on 20 August 2013 by Susan Grant (“the claimant”) in respect of GB2421687 (“the patent”). The patent was filed in the name of Teifion Emlyn James (“the defendant”) on 6 December 2005, claiming an earliest priority date of 8 December 2004.
- 2 The invention relates to a medical device for use in the treatment of Meibomian Gland Dysfunction (MGD). The device comprises a flexible mask containing flax seeds which can be heated and placed over the eyes.
- 3 The defendants filed their counterstatement on 16 October 2013, this was followed by the claimant’s evidence on 27 December 2013 and the defendants evidence on 13 February 2014. However, prior to filing their evidence the defendants submitted an amended counterstatement on 12 February 2014 for my consideration. The claimant has objected to this and has asked me to refuse the amendment. Both parties have indicated that they were prepared for this matter to be decided on the basis of the papers without the need for a formal hearing.
- 4 The defendant’s arguments as to why I should allow the amendments to the counterstatement to be made are set out in detail in their letters of 12 February 2014 and 11 March 2014 respectively. Whilst I do not feel it necessary to repeat them here, in summary, they argue that the proposed amendments seek to clarify the

nature of the dispute between the parties, expanding upon paragraph 44 of their counterstatement and providing more details as to the business relationship which exists between the parties and the claimant's agreement to transfer rights in the invention to the defendant in exchange for a royalty payment. They argue that the amendments do not introduce any new issues, were proposed in a timely fashion some three months before the date of the hearing and do not disadvantage the claimant in any way.

- 5 The claimant's objections are dealt with in detail in their letter filed on 20 March 2014. The following is a summary of their arguments. The claimant questions why, despite having filed his counterstatement on 15 October 2013, the defendant had taken until 31 January 2014 to file his amended statement. The claimant argues that the amendments were not made at the earliest possible opportunity, are late, and that the defendant's delay in filing the amended statement would prejudice the hearing date. The claimant also believes that the proposed amendments were not set out in sufficient detail and in their view the proposed amendments present new arguments of a complex contractual nature.
- 6 As recognised by both parties, a request to amend a statement of case or specifically as in this case a counterstatement is a matter for the comptroller's discretion. In exercising that discretion what matters is the overriding principle to deal with the case justly.
- 7 In *Cobbold v London Borough of Greenwich* (Court of Appeal, 9 August 1999, unreported) Peter Gibson L J considered the approach that should be adopted under the Civil Procedure Rules 1998 to requests to amend (see paragraph 17.3.5 of "Civil Procedure"):

*"The overriding objective is that the court should deal with cases justly. That includes, so far as practicable, ensuring that each case is dealt with not only expeditiously but also fairly. Amendments in general ought to be allowed so that the real dispute between the parties can be adjudicated upon provided that any prejudice to the other party or parties caused by the amendment can be compensated for in costs, and the public interest in the efficient administration of justice is not significantly harmed."*
- 8 In considering the arguments put forward by the parties, it seems to me that I will need to take into account the substance of the amendment, the diligence of the defendant, the extent to which the amendment might disadvantage or prejudice the claimant, and the more general question of public interest.
- 9 I have no doubt in my mind, that the proposed amendments seek to expand upon the contractual agreements which exist between the parties and that matters such as these have a bearing on issues of entitlement and that their clarification will aid in settling the real dispute between the parties.
- 10 Were the proposed amendments filed "late" or was the defendant diligent in his actions? Whilst it is true to say that the hearing date has had to be postponed, I do not think this is entirely due to the actions of the defendant. Furthermore, I do not think the filing of the amended counterstatement on 12 February 2014 constitutes a "late" filing in the true meaning of the word.

- 11 Would the claimant be subject to any significant disadvantage should I allow the proposed amendments? It is inevitable that the application to amend the counterstatement will cause the claimant some inconvenience and additional cost. However, I am not persuaded that the claimant would be disadvantaged to such an extent that would justify refusal on these grounds alone. Any additional costs and where appropriate compensation can be dealt when assessing costs following the hearing.
- 12 I do not think I need to say very much on the question of public interest, other than that it is clearly in the public interest for these proceedings to be taken forward to a conclusion with all relevant issues taken into account.
- 13 In my summary then, I find that the proposed amendments will aid in settling the dispute between the parties, that the public interest would be best served by taking these proceedings forward to a conclusion with all relevant issues taken into account and that the claimant would not be significantly disadvantaged thereby. I conclude therefore that in order to deal with this case in a just fashion, the comptroller's discretion should be exercised in favour of the defendant and that the proposed amendments to counterstatement should be allowed,
- 14 Having acceded to the defendant's request, I think it only appropriate for me to allow the claimants six weeks from the date of this decision to file their evidence in reply and any additional submissions they feel necessary.

### **Costs**

- 15 Whilst the comptroller has discretion to award costs at any point in the proceedings, I do not think it is appropriate for me to do so at this time. However, I acknowledge that my decision to allow the amendments may well give rise to additional costs on the claimants part and that this is something which should be borne in mind when determining costs following the substantive hearing. I therefore defer consideration of costs to a later date in the proceedings.

### **Appeal**

- 16 Any appeal must be lodged within 28 days

**P R SLATER**

Deputy Director acting for the Comptroller