BL O/047/04

19 February 2004

PATENTS ACT 1977

BETWEEN

Hydra-Ject Services UK Limited and Robert Peter Enston — Claimant

and

Eric James Enston — Defendant

PROCEEDINGS

References under sections 8, 12 and 13 of the Patents Act 1977 in respect of patent application number GB 0005558.2 and two others

HEARING OFFICER P Hayward

PRELIMINARY DECISION

1 These proceedings are concerned with the entitlement to, and inventorship of, three related patent applications, GB 0005558.2, GB 0105887.4 and EP 01302193.6. The present decision is concerned solely with the question of whether I should admit some late-filed evidence.

Background

2 The proceedings were launched on 14 October 2002. The claimants filed their evidence in chief on 15 April 2003, followed up by a further witness statement on 3 June to exhibit some documents mentioned in their main evidence. The defendant filed his evidence on 3 June - a single witness statement by the defendant himself with nine exhibits. The claimants then filed their evidence on reply on 26 August, following this up with one more short witness statement two days later.

3 A hearing was then arranged for 19 and 20 January 2004. On 7 January, a week and a half before the hearing, the defendant requested its postponement because his wife was booked into hospital to give birth by Caesarian section on 20 January. The hearing was accordingly re-arranged for 24 and 25 February.

4 On 17 February, just one week before the re-scheduled hearing, the Office and the claimants received by post from the defendant an additional witness statement from the

defendant's father-in-law, David Higton. The covering letter apologised for its late submission but gave no reasons. The claimants objected to its admission because it was so late. Both sides then made further written submissions on the admissibility of this evidence. They have now agreed that I should decide whether or not to admit it on the basis of their written submissions.

The legal principles

5 It is not in dispute that the question of whether I admit this evidence is a matter for my discretion. Neither side has made any comment on the approach they feel I should adopt in exercising that discretion, however it seems to me that I should have careful regard to the criteria set out in rule 3.9 of the Civil Procedure Rules, by which the court would be guided in similar circumstances. This requires the court to take account of all of the circumstances, but lists a number of specific points to consider. In the context of the present case, that boils down to:

- the explanation for the late submission
- the conduct of the defendant in the proceedings
- the potential impact on the hearing date
- the effect on the claimants if I admit it or on the defendant if I do not, both of which require me to take account of the relevance and importance of the evidence.

6 I shall therefore consider the request to admit the evidence against these criteria. I note that under rule 3.9(2) the court expects any request to be supported by evidence. I have no evidence from the defendant to support his request, but I am prepared to gloss over that and take his submissions at face value.

Assessment of the circumstances

7 Although initially the defendant gave no reason for the late submission, in a subsequent submission he said he had not been able to obtain a witness statement from David Higton earlier because of family health problems. He said David Higton had been in hospital twice in recent months, he had been helping to look after his partner's 12 year old daughter who was suffering from leukaemia and having to make regular trips to hospital, and the burdens on him had further increased when his partner had broken her ankle.

8 Whilst I have sympathy for Mr Higton with the problems that have befallen him, a submission like this is simply not good enough because it is far too vague. In particular, it contains no indication of the period or periods during which these problems were having an impact. The proper time at which this evidence should have been prepared was in May/June last year. I have been given no indication that Mr Higton's two spells in hospital, support for his daughter with her leukaemia treatment and partner's broken ankle all occurred at this time, or indeed that any one of them occurred at this time. Moreover, even if one or more of them had occurred then, I would be looking for an explanation as to why a further 8½ months had elapsed

during the whole of which it was not apparently possible to get a witness statement from Mr Higton. I would also be looking for an explanation as to what had changed that suddenly made it possible for Mr Higton to supply a witness statement now. In short, I find that the explanation given for the late submission is woefully inadequate.

9 The second aspect I need to consider is the conduct of the defendant so far in these proceedings, and on a quick look through the file I can see nothing to suggest he has conducted his case in an unreasonable way. The one proviso I would make is that if the defendant knew evidence from Mr Higton was potentially important but was unable to get a statement from him because of his problems, he should have flagged up the position at a much earlier stage. However, I do not feel this one failing should carry any significant weight in the balance.

10 I shall now move on to the third aspect, the potential impact on the hearing date. I have to say at the outset that having already lost the original hearing date of 19 January, I am extremely reluctant to lose a second date in the absence of compelling reasons. However if this evidence were admitted and the hearing date retained, the claimants would potentially be prejudiced to the extent that they would have little time to reflect on and, if necessary, to respond to that evidence. The problem is compounded by the unfortunate circumstance that the claimants are having to brief fresh counsel at this late stage in the proceedings. That said of course, it would remain open to the claimants to cross examine Mr Higton on his evidence, but that may not be sufficient if the nature of Mr Higton's evidence is such that the claimants might reasonably have wanted to do more, eg file their own evidence in reply. Accordingly it seems to me that I cannot decide this point independently of the fourth aspect.

11 I therefore move on to the fourth aspect, the impact of admitting or not admitting the evidence on each side, and to make a judgment here it is necessary to touch upon the substantive issues. At the centre of this dispute is the question of who invented (and when) the subject matter of the patent applications in suit, which for the purpose of this preliminary decision I shall take to be the technique of unsticking valves by applying vibration. In his witness statement, the defendant states that he thought of this technique from his experience in fixing cars and from discussion with his father-in-law (Mr Higton) who runs a rivet manufacturing business; when rivets jam in the exit chute a vibrator is used vibrate the chute and free the rivets. The defendant states that with this in mind he bolted a vibrator to some valves purchased from scrapyards in order to try out his idea. In the new witness statement, Mr Higton describes certain events which support in part the defendant's description of his experiments. The evidence is therefore unquestionably relevant, but it is not crucial in the sense that it is merely supporting evidence that has already been given. Thus whilst the defendant may suffer some disadvantage if the evidence is not admitted, he will not be prevented from presenting his case properly because he will still have the evidence from his prime witness (ie Eric Enston himself).

12 Turning now to the impact on the claimants if I do admit Mr Higton's evidence, it is not clear what they might reasonably need to respond to it. Indeed, the claimants have said quite frankly that at this stage they have not been able to assess what they might want to do. It is possible they could deal with it adequately by cross examination. Equally, I can see there are aspects that might warrant a request for disclosure, because

the evidence contains references to events for which there might well be documentary support (or for which the lack of documentary support might be telling). I conclude that the claimants might be disadvantaged by its admission if they were not given a proper opportunity to reply to it, but that is by no means certain.

13 Returning then to the third aspect, because of the risk of prejudice to the claimants if I admit the evidence and do not give them a proper opportunity to respond to it, I am satisfied that if I were to admit it, the hearing dates would almost certainly be lost. That, of course, would in itself disadvantage the claimants, who are anxious to resolve the dispute quickly.

Conclusions

14 To summarise then, the conduct of the defendant does not swing the decision one way or the other, whilst the adverse impact on the defendant if I refuse to admit the evidence and the adverse impact on the claimants if I do are finely balanced. What weighs heavily against admission is the woeful inadequacy of the explanation for the late submission. Taking all the circumstances into account, therefore, it seems to me that the balance lies against admission.

15 I therefore decline to admit the evidence of Mr Higton.

16 For completeness I feel it necessary to comment on a related matter. The claimants, in a letter dated 18 February 2004, have described a reference made by the defendant to the possibility of his referring at the substantive hearing to witness statements from a co-pending High Court dispute between the parties. The defendant has not yet asked for the admission of any such evidence and therefore I can make no ruling on it. However, he will doubtless now realise that any such request would inevitably require a rigorous application of the principles I have applied above.

Appeal

17 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days. That period, of course, extends well beyond the dates for the substantive hearing. I do not intend to postpone the substantive hearing simply in order to give the defendant 28 days in which to consider whether he wishes to appeal the present decision. That gives the defendant two options if he does indeed want to appeal. He can either go to the court immediately and seek an urgent appeal, or he can lodge his appeal after the substantive hearing and, if he is successful, seek an order remitting the case back to me to take account of the extra evidence before I issue my decision on the substantive matters.

P HAYWARD
Divisional Director, acting for the Comptroller