

PATENTS ACT 1977

IN THE MATTER OF references
under sections 12 and 13 by Oliver
Jevons in respect of the invention
disclosed in International Patent
Application PCT/US99/06438 in the
name of Minnesota Mining and
Manufacturing Company

DECISION

- 1 This decision arises out of a request by the Minnesota Mining and Manufacturing Company (3M) for extensions to the periods for making submissions as to an appropriate order and lodging any appeal following my decision of 25 September 2001 in respect of an entitlement and inventorship claim concerning the invention disclosed in International Patent Application PCT/US99/06438.
- 2 In my decision of 25 September 2001, I found in respect of the section 12 reference that Mr Jevons, the claimant, and 3M, the patent applicant and defendant, were jointly entitled to International Patent Application PCT/US99/06438. It had been agreed at the hearing held on 6 August 2001 that if I came to that conclusion, I would provide the parties with an opportunity to make submissions as to what they thought the appropriate order might be. Those submissions were also to cover the question of how, if at all, the order should reflect the section 13 reference. I allowed the parties six weeks to make their submissions, and that was also the period within which any appeal to the Patents Court against my decision would normally have to be lodged. The six weeks expires tomorrow, on 6 November.
- 3 The request for an extension was received from 3M on 29 October 2001 and was as follows:
 - (i) that the date for making submissions on the terms of the appropriate order should be extended by four weeks to allow the parties time to try to reach agreed terms; and
 - (ii) that the date in which any Notice of Appeal must be lodged be extended to 21 days after the order is made.
- 4 3M stated that the parties had now commenced discussions as to the form of an appropriate order, but was concerned that agreement might not be possible in the short time available if the 6 November deadline remained. Moreover, since the time periods for both making submissions and lodging any appeal were identical, this meant that the parties must consider whether or not to appeal the decision before the actual terms of the order were known. 3M submitted that it would be better if the appeal deadline were subsequent to the date on which the order is made, especially as there remained the outstanding reference under section 13 to consider.

My conclusion

- 5 I am satisfied I have the jurisdiction to grant the extensions requested. In particular, whilst the period for lodging an appeal is prescribed by the High Court in Practice Direction Part 49E made under the Civil Procedure Rules 1998, paragraph 16.5 of that Practice Direction does give me the power to extend the period if a request is made prior to the expiry of the prescribed period, as it has been in this case. Further, I do not read paragraph 16.5 as limiting me to granting extensions of a specified length or to a specified date, so I believe I have the power to make the extension dependant on another event - in this case, the making of my order.
- 6 The question, therefore, is whether I should exercise my discretion to grant the extensions. In doing so I believe I should pay due regard to the objectives of rule 1.1 of the Civil Procedure Rules 1998. In particular, I should only grant an extension if there is a reason which is sufficiently strong to outweigh potential harm to other parties and the public that may be caused by further delay.
- 7 So far as other parties are concerned, Mr Jevons has agreed orally to 3M's request. However, there is a public interest as well, and I have to say that there is little in the information I have been given to suggest that the two sides have been pursuing this matter vigorously throughout the 5½ weeks that has elapsed so far. Nevertheless, as I indicated in my original decision, it would clearly be better if the parties were to be able to agree a form of order between them, and I have therefore decided to grant the extensions requested. I must warn them, however, that because of the public interest I am not likely to look very kindly on any further request to extend the period for making submissions.
- 8 Accordingly, I hereby extend the period for making submissions allowed in paragraph 55 of my decision dated 25 September 2001 by four weeks, so it will now expire on 4 December. Further, I extend the period within which any appeal against that decision must be lodged at the Patents Court to 21 days after I make my order following receipt of those submissions.

Appeal

- 9 As the present decision is a matter of procedure, any appeal to the Patents Court must be made within 14 days.

Dated this 5th day of November 2001

P HAYWARD

Divisional Director acting for the comptroller

THE PATENT OFFICE