



BL O/296/04

28<sup>th</sup> September  
2004

## PATENTS ACT 1977

BETWEEN

M-Systems Flash Disk Pioneers, Ltd. Claimant

and

Trek Technology (Singapore) Pte. Ltd. Defendant

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PROCEEDINGS

Application under section 72 of the Patents Act 1977  
for revocation of patent number GB 2371653

HEARING OFFICER R C Kennell

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## SECOND PRELIMINARY DECISION

### Background

- 1 In these proceedings, both parties have filed statements and evidence in chief. The defendant's evidence in chief was filed on 24 June 2004, together with a request to amend the patent specification, a statement of reasons for the amendment and a consequentially amended counter-statement. The Office wrote on 20 August 2004 inviting the claimant to file any amended or supplementary statement or comments on the amendments by 20 September 2004, and to file its evidence in reply by 1 October 2004. The claimant wrote on 10 September 2004 seeking an extension of the latter period to 1 November 2004, giving reasons.
- 2 The defendant considered that no extension was justified and wrote on 22 September 2004 giving its reasons, which the claimant disputed in a letter dated 24 September 2004. The parties have not been able to reach agreement on this matter, but both are willing for me to decide the matter on the basis of the papers on file.

### Arguments

- 3 Summarising the arguments which have been put forward, the claimant says that the amendments submitted by the defendant have in effect resulted in a new case against which the claimant has to file evidence. It bases its request of 10 September 2004 on

(i) the existence of invalidity/infringement proceedings in Singapore on a corresponding Singapore patent for which they are preparing evidence following a ruling from the judge that further evidence may be submitted by both parties, (ii) the re-opening of the examination procedure in the European Patent Office on the defendant's corresponding European application following an amendment request by the defendant, oral proceedings being set down for 12 November 2004, and (iii) the delay of the defendant in seeking amendment to the patent in suit.

- 4 The defendant (22 September 2004 letter) denies any delay and believes it unclear why the proceedings in Singapore and the proceedings before the European Patent Office should require an extension of time to file evidence in the present proceedings - if the claimant considered that the outcome of the European patent was relevant, it should have delayed filing the present revocation action. The defendant comments, that by virtue of the facts that amendments were sought, the claimant had already had more time than would normally have been expected. The defendant accepts that its own evidence contained a significant number of documents, but believes that these have been known to the claimant from the proceedings in other jurisdictions, and so the claimant should not require as much time to consider them as would otherwise be expected.
- 5 The claimant says in reply (24 September 2004 letter) that it could not have made advance preparation based on the Singaporean litigation, since it had no inkling of which art might be evidenced before the Office, and the Singapore patent was not initially the subject of amendment. Nor did the claimant think it should have delayed in bringing the present revocation action, since the equivalent product in Singapore was being asserted against the claimant.

### **Analysis and conclusion**

- 6 Having considered all the arguments submitted by the parties, I do not think that the claimant's arguments are well founded. In the letter of 10 September 2004 it is suggested that the extension was not unreasonable in the public interest because "such full and complete evidence-in-chief will assist the Office to come to a decision on the allowability of the patentees' amendment application and hence on the validity of the patent".
- 7 However, the claimant has not been asked to file further evidence in chief. To paraphrase rule 75(5), it has been asked to file evidence confined strictly to matters in reply to the evidence filed by the defendant. The filing of any further evidence in chief is a distinct matter, and the comptroller will require compelling reasons to justify it.
- 8 I cannot see that any of the arguments advanced by the claimant have any bearing on why the claimant is unable to file evidence in reply to the defendant's evidence, as distinct from further evidence in relation to the allowability of the amendments. Further, as the defendant points out, the claimant has in effect already had a substantially longer period than is usual for the filing of evidence in reply. The defendant sent a copy of its evidence to the claimant on 24 June 2004 and, because the Office appears to have delayed in issuing the usual letter to the claimant, the claimant has effectively had a period of around 14 weeks to consider the defendant's evidence.

- 9 It also I think counts against the claimant that the request for an extension was not made until 10 September 2004, some 11 weeks after the claimant had seen the defendant's evidence and the request for amendment. It is not at all clear from the claimant's explanation why the request could not have been made earlier than this.
- 10 I therefore decline to grant the claimant's request, and its evidence in reply should therefore be filed by 1 October 2004. It is of course open to them to seek the leave of the comptroller to file further evidence in chief. However, as I have mentioned above, this will require compelling reasons (as explained in paragraphs 3.29 - 3.35 of the Office's "Patent Hearings Manual")

### **Costs**

- 11 Neither party has raised the matter of costs in relation to this preliminary issue and I do not in any case consider that an order for costs is warranted at this stage.

### **Appeal**

- 12 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

**R C KENNELL**

Deputy Director acting for the Comptroller