



**COPYRIGHT DESIGNS AND PATENTS  
ACT 1988**

BETWEEN

Rolson Tools Limited

Claimant

and

Monument Tools Limited

Defendant

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PROCEEDINGS

Reference under section 246 in  
respect of certain design rights

HEARING OFFICER

P Thorpe

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**Preliminary Reasoned Decision**

1. On 18 November 2008, Rolson Tools Limited (“Rolson”) made a reference under section 246 of the Copyright, Designs and Patents Act 1988 in respect of the subsistence of design right in various aspects of the shape and configuration of products produced by Monument Tools Limited (“Monument”). In accordance with rule 3 of The Design Right (Proceedings before Comptroller) Rules 1989 (“The Rules”), Monument was required to file a counter-statement within 28 days of receiving a copy of the statement from the Office.
2. Shortly before the expiry of that deadline, Monument wrote to the Office requesting a 4 weeks extension. This was resisted by Rolson. However after further discussions both sides agreed to an extension of 8 days. This meant that the counter-statement needed to be filed by close on the 6 February 2009.
3. On the 4 February, Monument wrote again to the Office seeking a further extension of 7 days. Rolson objected. Both sides agreed that I should decide the matter on the basis of the papers already filed.

4. I subsequently decided not to allow any further extension. This decision was communicated to the parties in a short communication on the morning of 6 February. I also indicated that I would provide my reasoning at a later date. This is what I will now do.

### **Reasoning**

5. The period provided for filing the counter-statement, and the timetable set for the filing of evidence are expected to provide sufficient time for the parties to complete the required actions. There is consequently a presumption against extending deadlines. Nevertheless there is provision for them to be extended, retrospectively if necessary, under rule 20 of the Rules.
6. However in order to justify any extension the party requesting it must be able to demonstrate it has taken steps to meet the original deadline but that for convincing reasons it is unable to do so or that it would be unjustified for it to be required to do so.
7. In its letter of 4 February Monument stated that the reason it was seeking a further extension of 7 days was to enable it to issue court proceedings against Rolson and also to allow, as it put it, “the IPO to clarify its position” on two other matters. The matters in question are firstly a request by Rolson that these design right proceedings be consolidated with related proceedings between the same parties relating to a number of Registered Designs. And secondly, an enquiry by Monument as to whether if it did launch proceedings before the court, the office would stay these proceedings. At that point no proceedings had been launched before the court.
8. In a subsequent letter dated 5 February, Monument confirmed that it had as of that date launched proceedings before the court. In that letter it also formally requested a stay to these proceedings. The letter repeats the request for a 7 day extension for filing the counter-statement but also goes on to suggest that any extension should be consistent with “the time required by the IPO to address and determine” the issues of the stay and the consolidation.
9. In effect Monument was asking for a temporary stay until such time as its request for a stay and Rolson’s request for consolidation had been determined. This it argued would prevent duplication and wasted costs.
10. Had the court case been pending prior to the launch of these proceedings or even if it had been commenced at an earlier stage of these proceedings, then Monument may at least have had some sort of case. But the simple fact is that the court case was not filed until the day before the 36 day<sup>1</sup> period for filing the counterstatement was due to end. By that

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<sup>1</sup> 28 days plus the 8 days agreed extension

time it seems reasonable to assume that most if not all of the work on the counterstatement should have been completed. And as Rolson pointed out, the material on which Monument will presumably base its court case will also presumably cover the same ground as that necessary to address the issues raised by Rolson in its statement in these proceedings. Hence I cannot see where the wasted costs or duplication that Monument refers to could come from, other than that is from the cost of sending the same material to both the office and court,.

11. On the issue of the consolidation of the two sets of proceedings I had a little more sympathy for the position of Monument. Whilst Registered Designs and Design Right are two separate rights, there is a possibility of some overlap in the arguments and evidence that will be put forward. Whether this is sufficient to justify consolidation is yet to be decided. Indeed before I can respond to the request from Rolson, I need to know the position of Monument. So far, despite a number of communications on the issue, it has not stated whether it supports or opposes consolidation. Rather all it has done is enquire whether consolidation is possible. I understand both sides have now been told that it is. I have asked both sides to address me on the question of consolidation at a hearing on 25 February 2009 at which the issue of the stay will also be addressed.
12. For now it is sufficient for me to note that it is not necessary for this issue to be resolved for Monument to be able to file its counterstatement. Nor could I see any justification for staying these proceedings until such time as it is resolved. The two sets of proceedings are currently at different stages. The respective procedures applicable to the two sets of proceedings are, at least in the early stages, somewhat different. Indeed should it be decided to consolidate then there is a case for not doing it until the evidence stages. That however is a matter that can be explored at the forthcoming hearing. For the purpose of this decision it is sufficient for me to note that I did not consider this an issue that justified any further extension of time.
13. I would add that Monument's position was not helped at all by the fact that the issue of consolidation was raised in its original request for a 4 week extension of time. As I have noted, that request led to an agreement between the parties to extend the relevant period by 8 days. To subsequently come back with a request for a further extension on the same ground was never likely to be looked on favourably.
14. Hence having carefully weighed up all the arguments put forward by both sides I could see no justification for further delaying these proceedings. I therefore decided that no further extension of time should be allowed.
15. I would add that in the event Monument filed its counterstatement within the required period.

## **Costs**

16. Rolson has requested an award of costs. As it was successful it is entitled to an award. My inclination is to make an award, in line with the comptroller's normal scale, of £200. I am however conscious that Monument in particular has not had an opportunity to address me fully on this. Hence I will defer making a formal decision on costs until after the hearing on 25 February, at which both sides can, if they wish, make oral representations.

## **Appeal**

17. Under Section 251(4) of the Copyright Designs and Patents Act 1988, any appeal against this decision is to the High Court; and under the Practice Direction to Part 52 of the Civil Procedure Rules, any such appeal must be lodged within 28 days.

**P THORPE**

Deputy Director acting for the Comptroller