

Review

Intellectual Property



Caselaw - Unjustified extension request denied

In *Rolson Tools Limited v Monument Tools Limited (Case BL O/041/09, 13 February 2009)* the Comptroller has ruled that there was no justification for delaying proceedings and that therefore no further extension of time should be granted.

BACKGROUND

In November 2008, Rolson Tools Limited (Rolson) made a reference to the Comptroller under s.246 of the CDPA 1988 in relation to the subsistence of a design right in various aspects of the shape and configuration of products produced by Monument Tools (Monument). Monument requested an extension in order to file its counterstatement. Rolson agreed to an extension of 8 days. In February 2009, Monument requested a further extension of 7 days and Rolson objected.

THE CASE BEFORE THE COMPTROLLER

Monument argued that a further extension would enable it to issue court proceedings against Rolson. In addition, it argued that the IPO would clarify its position regarding Rolson's request to consolidate these proceedings with proceedings between the same parties in relation to registered designs, since there was a possibility of overlap in the arguments and evidence, and also Monument's enquiry regarding the staying of these proceedings if it launched court proceedings.

Furthermore, Monument in a subsequent letter not only requested an extension for filing the counterstatement but also confirmed that it had commenced proceedings before the court and requested a stay of the proceedings before the IPO. Accordingly, it added that this would prevent duplication and wasted costs.

THE PRELIMINARY DECISION

The Comptroller held that the periods provided for filing the counterstatement and evidence were expected to provide sufficient time for the parties to complete the required action, and thus there was a presumption against extending deadlines. On the other hand, the Comptroller highlighted that extensions could be granted but that the requesting party should demonstrate convincing reasons for being unable to meet the original deadline or that there was no justification for requiring it to do so.

In particular, the Comptroller noted that by the day before the 36-day period for filing the counterstatement (28 days plus 8 days extension) all of the work on the counterstatement should have been completed and that therefore there should be no duplication and wasted costs.

Furthermore, it stated that the issue of consolidation did not have to be resolved for Monument to file its counterstatement nor could it justify any staying of these proceedings since the two sets of proceedings were at different stages.

Consequently, the Comptroller decided not to grant a further extension to the already extended period and ruled that Monument should file its counterstatement within the required period, with an award of costs of £200 in favour of Rolson.

FURTHER INFORMATION

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