

# PRACTICE DIRECTION – PATENTS etc.

**THIS PRACTICE DIRECTION SUPPLEMENTS CPR PART 49 AND REPLACES, WITH MODIFICATIONS, RSC ORDER 104, ORDER 100 AND ORDER 93, RULE 24 AND CCR ORDER 48A AND ORDER 49 RULE 4A**

## GENERAL

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- 1.1 This practice direction applies to the business of the Patents Court and proceedings under the Copyright, Designs and Patents Act 1988, the Trade Marks Acts 1938 and 1994 and the Olympic Symbol etc Protection Act 1995 and Olympic Association Right (Infringement Proceedings) Regulations 1995.
- 1.2 The Civil Procedure Rules apply to Patents Court business and proceedings under the Copyright, Designs and Patents Act 1988, the Trade Marks Acts 1938 and 1994 and the Olympic Symbol etc Protection Act 1995 and Olympic Association Right (Infringement Proceedings) Regulations 1995 subject to the provisions of this and any other Patents Court practice direction.
- 1.3 Definitions

In this Practice Direction -

“the 1949 Act” means the Patents Act 1949;

“the 1977 Act” means the Patents Act 1977;

“the Comptroller” means the Comptroller-General of Patents, Designs and Trade Marks;

“the Court,” means the Patents Court;

“existing patent” means a patent mentioned in section 127(2)(a) or (c) of the 1977 Act;

“the journal” means the journal published pursuant to rules made under section 123 (6) of the 1977 Act;

“1977 Act patent” means a patent under the 1977 Act;

“patent” means an existing patent or a 1977 Act patent and includes any application for a patent, supplementary protection certificate granted pursuant to the Patents (Supplementary Protection Certificates) Rules 1997, the Patents (Supplementary Protection Certificate for Medicinal Products) Regulations 1992 and the Patents (Supplementary Protection Certificate for Plant Protection Products) Regulations 1996.

"Patents Court" includes the Patents Court of the High Court and the Patents County Court.

"Patents Court business" includes:

- (a) any claim under the Patents Acts 1949 to 1961 and 1977;
- (b) any claim under the Registered Designs Acts 1949 to 1961;
- (c) any claim under the Defence Contracts Act 1958, and
- (d) all proceedings for the determination of a question or the making of a declaration relating to a patent (or an application for a patent) under the inherent jurisdiction of the High Court.

"the CPR" means the Civil Procedure Rules.

## ALLOCATION OF PATENTS COURT BUSINESS

- 2.1 Patents Court business may be dealt with either in the High Court or the Patents county court.
- 2.2 Before the issue of a claim form relating to Patents Court business, the claim form, whether it is to be issued in the High Court or the county court, should be marked in the top right hand corner "Patents Court" and the claim will then be allocated to the Patents Court.
- 2.3 The Patents Court is a specialist list for the purposes of Part 30 of the CPR but no order for the transfer of proceedings to or from the Patents Court shall be made unless the parties have either:
  - (a) had an opportunity of being heard on the issue, or
  - (b) consented to the order.
- 2.4 Every claim in the Patents Court will be allocated to the Multi-track and the CPR relating to allocation questionnaires and track allocation will not apply.
- 2.5
  - (1) Where a claim has been allocated to the Patents Court either on issue (ie. in every case in which the claim form has been marked Patents Court) or by transfer to the Patents Court, an application for directions (including an application for a fixed date of hearing) shall be made by the claimant within 14 days of the filing by the defendant of an acknowledgement of service or of a defence (whichever is the earlier) or, as the case may be, within 14 days of the date of the order of transfer.
  - (2) If the claimant does not make an application in accordance with paragraph 2.5, any other party may do so or may apply for the claim of the claimant in default to be struck out or dismissed.
  - (3) Any application under this paragraph must be made to a judge of the Patents Court unless a judge of the Patents Court otherwise directs.
  - (4) On the hearing of the application for directions under paragraph 2.5(1) the judge shall give directions for any further directions hearing and direct

the time by which the hearing of any further application for directions is to take place.

- 2.6 Except where inconsistent with the provisions of this Practice Direction, CPR Part 29 and the Multi-track Practice Direction apply to Patents Court business.
- 2.7 This practice direction shall apply with any necessary modifications to proceedings in respect of Registered Designs.

## **SERVICE OF DOCUMENTS**

- 3.1 This rule applies to the service of any document on a party until such time as that party has provided an address for service in accordance with CPR rule 6.5.
- 3.2 Subject to sub-paragraph (3) below, for the purposes of any proceedings relating to a patent or a registered design (including proceedings for revocation, declaration as to non-infringement or groundless threats of infringement proceedings or any other proceedings of a kind mentioned in this Practice Direction) where any document is served in the manner authorised by CPR Part 6 at an address for service given in the register kept under section 32 of the 1977 Act or, as the case may be, section 17 of the Registered Designs Act 1949 -
  - (1) service shall be deemed to have been effected on the registered proprietor of the patent or registered design on the date on which the document was served at the said address;
  - (2) the party on whom service is deemed to have been effected under sub-paragraph (a) shall be treated, for the purposes of any provision of these rules which specifies a time-limit for responding to the document so served (whether by filing or serving an admission, filing a defence, acknowledging service, or otherwise), as having been served on the seventh day after the date on which the document was served at the said address.
- 3.3 Nothing in paragraph 3.2 shall prevent service being effected on the proprietor in accordance with the provisions of Part 6 of the CPR.

## **APPLICATION IN PROCEEDINGS BEFORE THE COURT FOR PERMISSION TO AMEND A PATENT SPECIFICATION UNDER S.30 OF THE 1949 ACT OR S.75 OF THE 1977 ACT**

- 4.1 A patentee or the proprietor of a patent intending to apply in proceedings before the Court under section 30 of the 1949 Act or under section 75 of the 1977 Act for permission to amend his specification must give notice of his intention to the Comptroller accompanied by a copy of an advertisement -
  - (1) identifying the proceedings pending before the Court in which it is intended to apply for such permission;

- (2) giving particulars of the amendment sought;
- (3) stating the applicant's address for service within the United Kingdom;
- (4) stating that a Statement of Reasons is available from that address; and
- (5) stating that any person intending to oppose the amendment who is not a party to the proceedings must within 28 days after the appearance of the advertisement give written notice of his intention to the applicant; such notice to be accompanied by a Statement of Opposition

and the Comptroller shall insert the advertisement once in the journal. A person who gives notice in accordance with the advertisement shall be entitled to be heard on the application subject to any direction of the Court as to costs.

- 4.2 The applicant must at the same time as giving notice to the Comptroller serve a copy of the Statement of Reasons together with a copy of the patent as proposed to be amended on all parties to the proceedings.
- 4.3 The Statement of Reasons referred to in paragraph 4.1(4) shall contain full particulars of the amendment sought, of the reasons therefor and of the reasons why the applicant contends that in the exercise of discretion the amendment should be allowed. In particular the Statement should contain
  - (1) A statement whether the amendment is by way of deletion of claims or re-writing of claims.
  - (2) Insofar as it involve re-writing claims, details as to why the proposed amendment is in accordance with the statutory requirements of an amendment.
  - (3) Insofar as the amendment is sought to distinguish (more clearly) over prior art, an indication of the prior art.
- 4.4 The Statement of Opposition shall contain full particulars of all grounds of opposition to the application to amend.
- 4.5 As soon as may be after the expiration of 35 days from the appearance of the advertisement the applicant must make his application under the said section 30 or 75, as the case may be, by an application notice in the proceedings before the Court; and the application notice, together with a copy of the specification certified by the Comptroller and showing in coloured ink the amendment sought, must be served on the Comptroller, the parties to the proceedings and any person who has given notice of his intention to oppose the amendment.
- 4.6 Not less than two days before the date fixed for the hearing of the application, the applicant, the Comptroller, the parties to the proceedings and any other opponent should serve on all other parties and on the Court a Statement of Directions being the directions which that party seeks for the further conduct of the proceedings. Any of the foregoing not serving a Statement of

Directions shall take no further part in the proceedings without permission of the Court and shall not be liable for the costs thereof.

- 4.7 On the hearing of the amendment application the Court shall give such directions for its further conduct as it thinks necessary or expedient and, in particular, directions -
- (1) determining whether the application shall be heard forthwith or with the other proceedings relating to the patent in question or separately and, if separately, fixing the date of hearing thereof;
  - (2) as to whether any evidence is necessary, and, if so, as to the manner in which the that evidence shall be given and, if written evidence is to be given, fixing the times within which the affidavits or witness statements must be filed;
  - (3) as to whether any disclosure is necessary, and, if so, as to the extent of disclosure and the manner and time within which the same is to be given.
- 4.8 Where the Court allows a specification to be amended, the applicant must forthwith file with the Comptroller an office copy of the order made in the Court and, if so required by the Court or Comptroller, leave at the Patent Office a new specification and drawings as amended, prepared in compliance with the 1949 or 1977 Act, whichever is applicable, and the rules made under those Acts respectively.
- 4.9 The Comptroller shall cause a copy of the order to be inserted at least once in the journal.

## **APPLICATION FOR REVOCATION**

- 5.1 An application under section 72 of the 1977 Act for the revocation of a patent shall be commenced by the issue of a claim form. This direction does not apply to an application made in existing proceedings. An application in existing proceedings shall be made by way of a counterclaim or other Part 20 claim (as defined in CPR rule 20.2(1)).

## **CLAIM FOR INFRINGEMENT**

- 6.1 The claimant in a claim for infringement must serve with his claim form particulars of the infringement relied on, showing which of the claims in the specification of the patent are alleged to be infringed and giving at least one instance of each type of infringement alleged.
- 6.2 If a defendant in such a claim alleges, as a defence to the claim, that at the time of the infringement there was in force a contract or licence relating to the patent made by or with the consent of the claimant and containing a condition or term void by virtue of section 44 of the 1977 Act, he must serve on the claimant particulars of the date of, and parties to, each such contract or licence and particulars of each such condition or term.

## OBJECTIONS TO VALIDITY

- 7.1 A person who presents a claim for the revocation of a patent must serve with his claim form particulars of the objections to the validity of the patent on which he relies.
- 7.2 A party to a claim concerning a patent who either challenges the validity of the patent or applies by counterclaim or other Part 20 claim for revocation of the patent must, serve his defence, counterclaim or other Part 20 claim (as the case may be), together with particulars of the objections to the validity of the patent on which he relies, within 42 days after service upon him of the claim form.
- 7.3 Particulars given pursuant to paragraph 7.1 or 7.2 must state every ground on which the validity of the patent is challenged and must include such particulars as will clearly define every issue (including any challenge to any claimed priority date) which it is intended to raise.
- 7.4 If the grounds stated in the particulars of objections include want of novelty or want of any inventive step, the particulars must state the manner, time and place of every prior publication or user relied upon and, if prior user is alleged, must:
  - (1) specify the name of every person alleged to have made such user,
  - (2) state whether such user is alleged to have continued until the priority date of the claim in question or of the invention, as may be appropriate, and, if not, the earliest and latest date on which such user is alleged to have taken place,
  - (3) contain a description accompanied by drawings, if necessary, sufficient to identify such user, and
  - (4) if such user relates to machinery or apparatus, state whether the machinery or apparatus is in existence and where it can be inspected.
- 7.5 If either (a) in the case of an existing patent one of the grounds stated in the particulars of objections is that the invention, so far as claimed in any claim of the complete specification, is not useful, or, (b) in the case of a patent one of the grounds stated in the particulars of objections is that the specification of the patent does not disclose the invention clearly enough and completely enough for the invention to be performed and it is intended, in connection with either of such grounds, to rely on the fact that an example of the invention which is the subject of any claim cannot be made to work, either at all or as described in the specification, the particulars must state that fact and identify each such claim and must include particulars of each such example, specifying the respects in which it is alleged that it does not work or does not work as described.
- 7.6 In any proceedings relating to a patent in which the validity of the patent has been put in issue on the ground of obviousness a party who wishes to rely on the commercial success of the patent must state in his pleadings the grounds upon which he so relies.

## ADMISSIONS

- 8.1 Where a party desires any other party to admit any facts, he shall, within 21 days after service of a reply or after the expiration of the period fixed for the service thereof, serve on that other party a notice requiring him to admit for the purpose of the claim the facts specified in the notice.
- 8.2 A party upon whom a notice under paragraph 8.1 is served shall within 21 days after service thereof serve upon the party making the request a notice stating in respect of each fact specified in the notice whether or not he admits it.

## DISCLOSURE AND INSPECTION.

- 9.1 CPR Part 31 shall apply in a claim for infringement of a patent or a declaration of non-infringement of a patent or any proceedings where the validity of a patent is in issue.
- 9.2 Standard disclosure does not require the disclosure of documents in the following exempt classes :-
  - (1) documents relating to the infringement of a patent by a product or process if, before serving a list of documents, the party against whom the allegation of infringement is made has served on the other parties full particulars of the product or process alleged to infringe, including if necessary drawings or other illustrations;
  - (2) documents relating to any ground on which the validity of a patent is put in issue, except documents which came into existence within the period beginning two years before the earliest claimed priority date and ending two years after that date; and
  - (3) documents relating to the issue of commercial success.
- 9.3 Where the issue of commercial success arises in any proceedings specified in paragraph 9.1, the patentee shall, within such time limit as the Court may direct, serve a schedule containing the following details -
  - (1) where the commercial success relates to an article or product -
    - (a) an identification of the article or product (for example by product code number) which the patentee asserts has been made in accordance with the claims of the patent;
    - (b) a summary by convenient periods of sales of any such article or product;
    - (c) a summary for the equivalent periods of sales, if any, of any equivalent prior article or product marketed before the article or product mentioned in sub-paragraph (a); and
    - (d) a summary by convenient periods of any expenditure on advertising and promotion which supported the marketing of the articles or products mentioned in sub-paragraphs (a) and (c),



- (2) where the commercial success relates to the use of a process -
  - (a) an identification of the process the patentee asserts has been used in accordance with the claims of the patent;
  - (b) a summary by convenient periods of the revenues received from the use of such process;
  - (c) a summary for the equivalent periods of the revenues, if any, received from the use of any equivalent prior art process; and
  - (d) a summary by convenient periods of any expenditure which supported the use of the process mentioned in sub-paragraphs (a) and (c).

## EXPERIMENTS

- 10.1 Where a party desires to establish any fact by experimental proof he must, at least 21 days before the service of the application notice for directions under paragraph 10.3 or within such other time as the Court may direct at a hearing for further directions pursuant to paragraph 2.5(4), serve on the other party a notice stating the facts which he desires to establish and giving full particulars of the experiments proposed to establish them.
- 10.2 A party upon whom a notice under paragraph 10.1 is served shall, within 21 days after service thereof, serve upon the other party a notice stating in respect of each fact whether or not he admits it.
- 10.3 Where any fact which a party desires to establish by experimental proof is not admitted he shall apply to the Court for directions in respect of such experiments.

## APPLICATION FOR FURTHER DIRECTIONS

- 11.1
  - (1) The parties must comply with any directions given by the judge pursuant to paragraph 2.5(4) in respect of any hearing for further directions.
  - (2) If the claimant does not serve an application notice for further directions in accordance with this paragraph, the defendant may do so.
  - (3) The application notice must be accompanied by minutes of the order proposed, and such other documents as will be necessary for the hearing of the application.
- 11.2 At a further directions hearing under this paragraph the judge may give such directions relating to:
  - (1) the service of further pleadings or of further information pursuant to Part 18 of the CPR;
  - (2) disclosure and inspection of documents;
  - (3) requests for or the making of admissions pursuant to paragraphs 8.1 and 8.2 above and Part 14 of the CPR;



- (4) the obtaining of written evidence relating to matters requiring expert knowledge, and for the filing of affidavits or witness statements and the service of copies thereof on the other parties,
- (5) the holding of a meeting of such experts as the judge may specify, for the purpose of producing a joint report on the state of the relevant art;
- (6) the exchanging of experts' reports, in respect of those matters on which they are not agreed;
- (7) the making of experiments, tests, inspections or reports;
- (8) the determination, as a preliminary issue, of any question that may arise (including any questions as to the construction of the specification or other documents)

and otherwise as the judge thinks necessary or expedient for the purpose of giving effect to the overriding objective. Where evidence is directed to be given by affidavit or witness statement, the witnesses must attend at the trial for cross-examination unless, with the concurrence of the Court, the parties otherwise agree.

- 11.3 On the hearing of an application under this paragraph the judge shall consider, if necessary of his own initiative, whether:
- (a) the parties' advisers should be required to meet for the purpose of agreeing which documents will be required at the trial and of paginating such documents;
  - (b) an independent scientific adviser should be appointed to assist the Court, whether as an assessor under CPR rule 35.15 or otherwise.

## **RESTRICTIONS ON ADMISSION OF EVIDENCE**

- 12.1 Except with the permission of the judge hearing any claim or other proceedings relating to a patent, no evidence shall be admissible in proof of any alleged infringement, or of any objection to the validity, of the patent, if the infringement or objection was not raised in the particulars of infringements or objections, as the case may be.
- 12.2 In any claim or other proceedings relating to a patent, evidence which is not in accordance with a statement contained in particulars of objections to the validity of the patent shall not be admissible in support of such an objection unless the judge hearing the proceeding allows the evidence to be admitted.
- 12.3 If any machinery or apparatus alleged to have been used before the priority date mentioned in paragraph 7.4(2) is in existence at the date of service of the particulars of objections, no evidence of its user before that date shall be admissible unless it is proved that the party relying on such user offered, where the machinery or apparatus is in his possession, inspection of it to the other parties to the proceedings or, where it is not, used all reasonable endeavours to obtain inspection of it for those parties.

## DETERMINATION OF QUESTION OR APPLICATION WHERE COMPTROLLER DECLINES TO DEAL WITH IT.

### 13 Where the Comptroller -

- (1) declines to deal with a question under section 8 (7), 12 (2), 37 (8) or 61 (5) of the 1977 Act;
- (2) declines to deal with an application under section 40 (5) of that Act, or
- (3) certifies under section 72 (7)(b) of that Act that the question whether a patent should be revoked is one which would more properly be determined by the court,

any person entitled to do so may, within 28 days after the Comptroller's decision apply to the Court to determine the question or application.

## APPLICATION BY EMPLOYEE FOR COMPENSATION UNDER SECTION 40 OF THE 1977 ACT

- 14.1 An application by an employee for compensation under section 40 (1) or (2) of the 1977 Act shall be begun by the issue of a claim form within the period which begins when the relevant patent is granted and which expires one year after it has ceased to have effect.

Provided that, where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the period prescribed for the payment thereof and an application for restoration is made to the Comptroller under section 28 of the said Act, the said period shall -

- (1) if restoration is ordered, continue as if the patent had remained continuously in effect, or
- (2) if restoration is refused, be treated as expiring one year after the patent ceased to have effect or six months after the refusal, whichever is the later.

- 14.2 Either at the hearing of an application for directions under paragraph 2.5(1) or at a hearing of an application for further directions under paragraphs 11.1–11.3, the Court must give directions as to the manner in which the evidence (including any accounts of expenditure and receipts relating to the claim) shall be given at the hearing of the claim and, if written evidence is to be given, specify the period within which witness statements or affidavits must be filed.

- 14.3 The Court must also give directions as to the provision by the defendant to the claimant, or a person deputed by him for the purpose, of reasonable facilities for inspecting and taking extracts from the books of account by which the defendant proposes to verify the accounts mentioned in paragraph 14.2 or from which those accounts have been derived.

## PROCEDURE FOR THE DETERMINATION OF CERTAIN DISPUTES

- 15.1 The following proceedings must be begun by the issue of a claim form, that is to say-
- (1) proceedings for the determination of any dispute referred to the court under-
    - (a) section 48 of the 1949 Act or section 58 of the 1977 Act;
    - (b) paragraph 3 of Schedule 1 to the Registered Designs Act 1949;
    - (c) section 4 of the Defence Contracts Act 1958; or
    - (d) section 252 of the Copyright, Designs and Patent Act 1988;
  - (2) any application under section 45(3) of the 1977 Act.

## APPEALS FROM THE COMPTROLLER

- 16.1 In this paragraph "the Court" means the Patents Court of the High Court.
- 16.2 An appeal to the Court from a decision of the Comptroller in any case in which a right of appeal is given by the 1949 or 1977 Act must be brought by issuing a Notice of Appeal. The parties are, in this paragraph, referred to as "appellant" and "respondent" respectively.
- 16.3 The Notice of Appeal shall be issued:
- (1) in the case of a decision on a matter of procedure, within 14 days after the date of the decision; and
  - (2) in any other case, within six weeks after the date of the decision.
- 16.4 The Comptroller may determine whether any decision is on a matter of procedure and any such determination shall itself be a decision on a matter of procedure.
- 16.5 Except with permission of the Court, no appeal shall be entertained unless the Notice of Appeal has been issued within the period specified in paragraph 16.3 or within such further time as the Comptroller may allow upon request made to him prior to the expiry of that period.
- 16.6 The Notice of Appeal may be given in respect of the whole or any specific part of the decision of the Comptroller and must specify the grounds of the appeal and the relief which the appellant seeks.
- 16.7 Except with the permission of the Court the appellant shall not be entitled on the hearing of the appeal to rely on any ground of appeal or to apply for any relief not specified in the Notice of Appeal.
- 16.8 The appellant shall, within 21 days of issuing the Notice of Appeal, serve a copy thereof on the Comptroller and any other party to the proceedings before the Comptroller.

- 16.9 After receiving the Notice of Appeal the Comptroller shall lodge with the Clerk or other person in charge of the Patents Court list all papers relating to the matter which is subject of the appeal.
- 16.10 A respondent who, not having appealed from the decision of the Comptroller, desires to contend on the appeal that the decision should be varied, either in any event or in the event of the appeal being allowed in whole or in part, must give notice to that effect, specifying the grounds of that contention and the relief which he seeks from the Court.
- 16.11 A respondent who desires to contend on the appeal that the decision of the Comptroller should be affirmed on grounds other than those set out in the decision must give notice to that effect, specifying the grounds of that contention.
- 16.12 A respondent's notice shall be served on the Comptroller and on the appellant and every other party to the proceedings before the Comptroller within 14 days after service of the Notice of Appeal by the respondent, or within such further time as the Court may direct.
- 16.13 A party by whom a respondent's notice is given must within 5 days after service of the notice on the appellant, furnish 2 copies of the notice to the Clerk or other person in charge of the Patents List
- 16.14 The Clerk or other person in charge of the Patents list shall give to the Comptroller and to the appellant and every other party to the proceedings before the Comptroller not less than seven days' notice of the date appointed for the hearing of the appeal, unless the Court directs shorter notice to be given.
- 16.15 An appeal shall be by way of rehearing and the evidence used on appeal shall be the same as that used before the Comptroller and, except with the permission of the Court, no further evidence shall be given.
- 16.16 Any notice given in proceedings under this rule may be signed by or served on any patent agent, or member of the Bar of England and Wales not in actual practice, who is acting for the person giving the notice or, as the case may be, the person on whom the notice is to be served, as if the patent agent or member of the Bar were a solicitor.
- 16.17 The Notice of Appeal shall be in the form annexed hereto or in such other form as may be approved by the Court.

## **COMMUNICATION OF INFORMATION TO THE EUROPEAN PATENT OFFICE**

- 17.1 The Court may authorise the communication to the European Patent Office or the competent authority of any country which is a party to the European Patent Convention of any such information in the files of the court as the Court thinks fit.

- 17.2 Before complying with a request for the disclosure of information under paragraph 17.1 the Court shall afford to any party appearing to be affected by the request the opportunity of making representations, in writing or otherwise, on the question whether the information should be disclosed.

## **CLAIM FOR RECTIFICATION OF REGISTER OF PATENTS OR DESIGNS**

- 18.1 Where a claim is made for the rectification of the register of patents, the claimant shall at the same time as serving the other party serve a copy of the claim form and the accompanying documents on the Comptroller, who shall be entitled to appear and to be heard on the application.

## **OTHER INTELLECTUAL PROPERTY MATTERS INCLUDED IN THIS PRACTICE DIRECTION**

### **A. COPYRIGHT MATTERS**

#### **ADDITIONAL DAMAGES UNDER SECTION 97(2) OF THE COPYRIGHT, DESIGNS AND PATENTS ACT 1988.**

- 19.1 Where a claimant seeks to recover additional damages under section 97(2) of the Copyright, Designs and Patents Act 1988, he must so state in his claim form and the particulars of claim must set out the grounds relied upon in support.

#### **APPLICATIONS FOR DELIVERY UP AND FORFEITURE UNDER SECTIONS 99, 114, 195, 204, 230 OR 231 OF THE COPYRIGHT DESIGNS AND PATENTS ACT 1988**

- 20.1 An application under Sections 99, 114, 195, 204, 230 or 231 of the Copyright, Designs and Patents Act 1988 ("CDPA") shall be made by the issue of a claim form or, if made in existing proceedings, an application notice in those proceedings.
- 20.2 Where such an application is made the applicant shall serve the claim form or application notice on all persons having an interest in the goods, material or articles within the meaning of sections 114, 204 or 231 of the CDPA insofar as such persons are reasonably ascertainable.

### **B. TRADEMARK MATTERS**

#### **DEFINITIONS**

- 21.1 In this section of this practice direction -
- "the 1938 Act" means the Trade Marks Act 1938 as amended by the Trade Marks (Amendment) Act 1984 and the Patents, Designs and Marks Act 1986;

"the 1994 Act" means the Trade Marks Act 1994;

"the Olympic Symbol Act" means the Olympic Symbol etc. (Protection) Act 1995;

"the Olympic Symbol Regulations" means the Olympic Association Right (Infringement Proceedings) Regulations 1995;

"the Registrar" means the Comptroller-General of Patents, Designs and Trade Marks;

"the register" means the register of trade marks maintained by the Registrar pursuant to section 63 of the 1994 Act;

"appointed person" means a person appointed by the Lord Chancellor to hear and decide appeals under the 1994 Act.

## **ASSIGNMENT TO THE CHANCERY DIVISION**

- 22.1 Proceedings in the High Court under the 1938 Act, the 1994 Act or the Olympic Symbol Act and Regulations shall be dealt with in the Chancery Division.

## **APPEALS AND APPLICATIONS UNDER THE 1938 ACT, THE 1994 ACT AND THE OLYMPIC SYMBOL ACT AND THE OLYMPIC SYMBOL REGULATIONS**

- 23.1 Every appeal to the High Court under the 1938 Act or the 1994 Act shall be heard and determined by a single judge.
- 23.2 Such appeals shall be brought by a Notice of Appeal in such form as may be approved by the court.
- 23.3 The Notice of Appeal must be issued within 28 days of the decision appealed from.
- 23.4 Within 21 days of issue the Notice of Appeal must be served on the Registrar and any Respondents and lodged with the Clerk or other person in charge of the Chancery List.
- 23.5 Every other application to the High Court under the said Acts and the Olympic Symbol Regulations must be begun by the issue of a claim form under CPR Part 8 or, if made in existing proceedings, an application notice in those proceedings.
- 23.6 Notices of Appeal, claim forms or application notices by which any such application is begun must be served on the Registrar.
- 23.7 Where -
- (1) the Registrar refers to the High Court an application made to him under the 1938 Act or the 1994 Act;

- (2) the Board of Trade under the 1938 Act or an appointed person under section 76 of the 1994 Act refers to that Court an appeal,

then unless within one month after receiving notification of the decision to refer, the applicant or the appellant, as the case may be, makes to that Court the application or appeal referred, he shall be deemed to have abandoned it.

- 23.8 The period prescribed above in relation to an appeal to which paragraph 23.1 applies or the period prescribed by paragraph 23.7 in relation to an application or appeal to which that paragraph applies, may be extended by the Registrar on the application of any party interested and may be so extended although the application is not made until after the expiration of that period, but the foregoing provision shall not be taken to affect the power of the Court to extend that period.
- 23.9 Where under subsection (6) of section 17 or subsection (9) of section 18 of the 1938 Act an appellant becomes entitled and intends to withdraw the application which is the subject-matter of the appeal, he must give notice of his intention to the Registrar and to any other party to the appeal within one month after the Court has given permission under the said subsection (6) or the said subsection (9), as the case may be, for further grounds of objection to be taken.
- 23.10 Where an application is made under section 19 of the 1994 Act or under regulation 5 of the Olympic Symbol Regulations the applicant shall serve the claim form or application notice on all persons having an interest in the goods, material or articles within the meaning of section 19 of the 1994 Act or Regulation 5 of the Olympic Symbol Regulations as the case may be insofar as such persons are reasonably ascertainable.

## **PROCEEDINGS FOR INFRINGEMENT OF REGISTERED TRADE MARK; VALIDITY OF REGISTRATION DISPUTED OR REVOCATION OR RECTIFICATION SOUGHT**

- 24.1 Where in any proceedings a claim is made for relief for infringement of the rights conferred on the proprietor of a registered trade mark by section 9 of the 1994 Act, the party against whom the claim is made may in his defence put in issue the validity of the registration of that trade mark or may apply by counterclaim or other Part 20 claim for an order for revocation of the registration or for a declaration of invalidity of the registration or for rectification of the register, or may do any or all of those things.
- 24.2 A party to any such proceedings who in his pleading (whether a defence or counterclaim or other Part 20 claim) disputes the validity of the registration of a registered trade mark or seeks a declaration of invalidity or an order for revocation of the registration, or rectification of the register, must serve with his pleading particulars of the objections to the validity of the registration or of any grounds for revocation or rectification, on which he relies.



- 24.3 A party to any such proceedings who applies for an order for revocation of the registration or for a declaration of invalidity of the registration or for rectification of the register must serve on the Registrar a copy of his counterclaim or other Part 20 claim together with a copy of the particulars mentioned in paragraph 24.2 and the Registrar shall be entitled to take such part in the proceedings as he may think fit but need not serve a defence or other statement of case unless ordered to do so by the Court.

## SERVICE OF DOCUMENTS

- 25.1 This rule applies to the service of any document on a party until such time as that party has provided an address for service in accordance CPR rule 6.5.
- 25.2 Subject to paragraph 25.3 for the purposes of any proceedings relating to a registered trade mark (including proceedings for revocation, declaration of invalidity or non-infringement or groundless threats of infringement proceedings or any other proceedings under the 1938 Act or the 1994 Act), where any document is served in the manner authorised by Part 6 of the CPR at an address for service given in the register kept under section 63 of the 1994 Act -
- (1) service shall be deemed to have been effected on the registered proprietor of the trade mark on the date on which the document was served at the said address;
  - (2) the party on whom service is deemed to have been effected under subparagraph (1), shall be treated, for the purposes of any provision which specifies a time-limit for responding to the document so served (whether by acknowledging service, giving notice of intention to defend or otherwise), as having been served on the seventh day after the date on which the document was served at the said address.
- 25.3 Nothing in paragraph 25.2 shall prevent service being effected on the proprietor in accordance with the provisions of CPR Part 6.

## SERVICE OF ORDERS ON THE REGISTRAR

Where an order is made by the Court in any case under the 1938 Act or the 1994 Act, the person in whose favour the order is made (if there is more than one, such one of them as the Court shall direct) shall serve an office copy of the order on the Registrar.