

PRACTICE DIRECTION – PATENTS AND OTHER INTELLECTUAL PROPERTY CLAIMS

THIS PRACTICE DIRECTION SUPPLEMENTS CPR PART 63

Contents of this Practice Direction

- 1.1 This practice direction is divided into three sections –
 - Section I – Provisions about patents and registered designs
 - Section II – Provisions about registered trade marks and other intellectual property rights
 - Section III - Provisions about appeals

SECTION I - PROVISIONS ABOUT PATENTS AND REGISTERED DESIGNS

- 2.1 This Section of this practice direction applies to claims in the Patents Court and a Patents County Court.
- 2.2 The following claims must be dealt with in the court –
 - (1) any matter arising out of the 1977 Act, including –
 - (a) infringement actions;
 - (b) revocation actions;
 - (c) threats under section 70 of the 1977 Act; and
 - (d) disputes as to ownership;
 - (2) registered designs;
 - (3) Community registered designs; and
 - (4) semiconductor topography rights.

Starting the claim (rule 63.5)

- 3.1 A claim form to which this Section of this Part applies must be marked in the top right hand corner 'Patents Court' below the title of the court in which it is issued.

Case management (rule 63.7)

- 4.1 The following parts only of the practice direction supplementing Part 29 apply –
 - (1) paragraph 5 (case management conferences) –
 - (a) excluding paragraph 5.9; and

- (b) modified so far as is made necessary by other specific provisions of this practice direction; and
- (2) paragraph 7 (failure to comply with case management directions).
- 4.2 Case management shall be dealt with by –
 - (1) a judge of the court; or
 - (2) a Master or district judge where a judge of the court so directs.
- 4.3 The claimant must apply for a case management conference within 14 days of the date when all defendants who intend to file and serve a defence have done so.
- 4.4 Where the claim has been transferred, the claimant must apply for a case management conference within 14 days of the date of the order transferring the claim, unless the court –
 - (1) held; or
 - (2) gave directions for
 a case management conference, when it made the order transferring the claim.
- 4.5 Any party may, at a time earlier than that provided in paragraphs 4.3 and 4.4, apply in writing to the court to fix a case management conference.
- 4.6 If the claimant does not make an application in accordance with paragraphs 4.3 and 4.4, any other party may apply for a case management conference.
- 4.7 The court may fix a case management conference at any time on its own initiative.
- 4.8 Not less than 7 days before a case management conference, each party must file and serve –
 - (1) a completed case management information sheet; and
 - (2) an application notice for any order which that party intends to seek at the case management conference, other than directions referred to in the case management information sheet.
- 4.9 Unless the court orders otherwise, the claimant, in consultation with the other parties, must prepare –
 - (1) a case memorandum, containing a short and uncontroversial summary of what the case is about and of its material case history;
 - (2) a list of issues, with a section listing important matters which are not in dispute; and
 - (3) a case management bundle containing –
 - (a) the claim form;

- (b) all statements of case (excluding schedules), except that, if a summary of a statement of case has been filed, the bundle should contain the summary, and not the full statement of case;
- (c) the case memorandum;
- (d) the list of issues;
- (e) the case management information sheets and, if a pre-trial timetable has been agreed or ordered, that timetable;
- (f) the principal orders of the court; and
- (g) any agreement in writing made by the parties as to disclosure,

and provide copies of the case management bundle for the court and the other parties at least 7 days before the first case management conference or any earlier hearing at which the court may give case management directions.

4.10 At the case management conference the court may direct that –

- (1) a scientific adviser under section 70(3) of the Supreme Court Act 1981 be appointed; and
- (2) a document setting out basic undisputed technology should be prepared.

(Rule 35.15 applies to scientific advisers)

4.11 Where a trial date has not been fixed by the court, a party may apply for a trial date by filing a certificate which must –

- (1) state the estimated length of the trial, agreed if possible by all parties;
- (2) detail the time required for the judge to consider the documents;
- (3) identify the area of technology; and
- (4) assess the complexity of the technical issues involved by indicating the complexity on a scale of 1 to 5 (with 1 being the least and 5 the most complex).

4.12 The claimant, in consultation with the other parties, must revise and update the documents referred to in paragraph 4.9 appropriately as the case proceeds. This must include making all necessary revisions and additions at least 7 days before any subsequent hearing at which the court may give case management directions.

Disclosure and inspection (rule 63.8)

5.1 Standard disclosure does not require the disclosure of documents where the documents relate to –

- (1) the infringement of a patent by a product or process if, before serving a list of documents, the defendant has served on the claimant and any other party –
 - (a) full particulars of the product or process alleged to infringe; and

- (b) drawings or other illustrations, if necessary;
 - (2) any ground on which the validity of a patent is put in issue, except documents which came into existence within the period –
 - (a) beginning two years before the earliest claimed priority date; and
 - (b) ending two years after that date; and
 - (3) the issue of commercial success.
- 5.2 Where the issue of commercial success arises, the patentee must, within such time limit as the court may direct, serve a schedule containing –
- (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 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 in sub-paragraphs (a) and (c); or
 - (2) where the commercial success relates to the use of a process –
 - (a) an identification of the process which the patentee asserts has been used in accordance with the claims of the patent;
 - (b) a summary by convenient periods of the revenue 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 in sub-paragraphs (a) and (c).

Short applications

- 6.1 Where any application is listed for a short hearing, the parties must file all necessary documents, skeleton arguments and drafts of any orders sought, by no later than 3.00 pm on the preceding working day.
- 6.2 A short hearing is any hearing which is listed for no more than 1 hour.

Timetable for trial

- 7.1 Not less than one week before the beginning of the trial, each party must inform the court in writing of the estimated length of its –

- (1) oral submissions;
 - (2) examination in chief, if any, of its own witnesses; and
 - (3) cross-examination of witnesses of any other party.
- 7.2 At least four days before the date fixed for the trial, the claimant must file –
- (1) the trial bundle; and
 - (2) a Reading Guide for the judge.
- 7.3 The Reading Guide filed under paragraph 7.2 must –
- (1) be short and, if possible, agreed;
 - (2) set out the issues, the parts of the documents that need to be read on each issue and the most convenient order that they should be read;
 - (3) identify the relevant passages in text books and cases, if appropriate; and
 - (4) not contain argument.

Jurisdiction of Masters

- 8.1 A Master may deal with –
- (1) orders by way of settlement, except settlement of procedural disputes;
 - (2) orders on applications for extension of time;
 - (3) applications for leave to serve out of the jurisdiction;
 - (4) applications for security for costs; and
 - (5) other matters as directed by a judge of the court.

Experiments

- 9.1 Where a party seeks to establish any fact by experimental proof conducted for the purpose of litigation he must, at least 21 days before service of the application notice for directions under paragraph 9.3, or within such other time as the court may direct, serve on all parties a notice –
- (1) stating the facts which he seeks to establish; and
 - (2) giving full particulars of the experiments proposed to establish them.
- 9.2 A party served with notice under paragraph 9.1 –
- (1) must within 21 days after such service, serve on the other party a notice stating whether or not he admits each fact; and
 - (2) may request the opportunity to inspect a repetition of all or a number of the experiments identified in the notice served under paragraph 9.1.

- 9.3 Where any fact which a party seeks to establish by experimental proof is not admitted, he must apply to the court for permission and directions by application notice.

Use of models or apparatus

- 10.1 Where a party intends to rely on any model or apparatus, he must apply to the court for directions at the first case management conference.

Claim for infringement and challenge of validity (rule 63.9)

- 11.1 In a claim for infringement of a patent –
- (1) the claim form must –
 - (a) show which of the claims in the specification of the patent are alleged to be infringed; and
 - (b) give at least one example of each type of infringement alleged; and
 - (2) a copy of each document referred to in the claim form, and where necessary a translation of the document, must be served with the claim form.
- 11.2 Where the validity of a patent or registered design is challenged –
- (1) the statement of case must contain particulars of –
 - (a) the relief sought; and
 - (b) the issues except those relating to validity of the patent or registered design;
 - (2) the statement of case must have a separate document annexed to it headed 'Grounds of Invalidity' specifying the grounds on which validity of the patent is challenged;
 - (3) a copy of each document referred to in the Grounds of Invalidity, and where necessary a translation of the document, must be served with the Grounds of Invalidity; and
 - (4) the Comptroller must be sent a copy of the Grounds of Invalidity and where any such Grounds of Invalidity are amended, a copy of the amended document, at the same time as the Grounds of Invalidity are served or amended.
- 11.3 Where, in an application in which validity of a patent is challenged, the Grounds of Invalidity include an allegation –
- (1) that the invention is not a patentable invention because it is not new or does not involve an inventive step, the particulars must specify such details of the matter in the state of art relied on, as set out in paragraph 11.4; and

- (2) that the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art, the particulars must state, if appropriate, which examples of the invention cannot be made to work and in which respects they do not work or do not work as described in the specification.

11.4 The details required under paragraph 11.3(1) are –

- (1) in the case of matter made available to the public by written description –
 - (a) the date on which and the means by which it was so made available, unless this is clear from the face of the matter; and
 - (b) the identifying information allowing the public to access the matter; and
- (2) in the case of matter made available to the public by use –
 - (a) the date or dates of such use;
 - (b) the name of all persons making such use;
 - (c) any written material which identifies such use;
 - (d) the existence and location of any apparatus employed in such use; and
 - (e) all facts and matters relied on to establish that such matter was made available to the public.

11.5 In any proceedings in which validity of a patent is challenged –

- (1) on the ground that the invention did not involve an inventive step, a party who wishes to rely on the commercial success of the patent must state the grounds on which he so relies in his claim form; and
- (2) the court may order inspection of machinery or apparatus where a party alleges such machinery or apparatus was used before the priority date of the claim.

Application to amend a patent specification in existing proceedings (rule 63.10)

- 12.1 Not later than two days before the first hearing date the applicant, the Comptroller if he wishes to be heard, the parties to the proceedings and any other opponent, must file and serve a document stating the directions sought.
- 12.2 Where the application notice is served on the Comptroller electronically under rule 63.10(3), it must comply with any requirements for the sending of electronic communications to the Comptroller.

Application by employee for compensation (rule 63.12)

- 13.1 Where an employee applies for compensation under section 40(1) or (2) of the 1977 Act, the court must at the case management conference give directions as to –

- (1) the manner in which the evidence, including any accounts of expenditure and receipts relating to the claim, is to 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; and
- (2) the provision to the claimant by the defendant or a person deputed by him, of reasonable facilities for inspecting and taking extracts from the accounts by which the defendant proposes to verify the accounts in subparagraph (1) or from which those accounts have been derived.

Communication of information to the European Patent Office

- 14.1 The court may authorise the communication of any such information in the court files as the court thinks fit to –
 - (1) the European Patent Office; or
 - (2) the competent authority of any country which is a party to the European Patent convention.
- 14.2 Before authorising the disclosure of information under paragraph 14.1, the court shall permit any party who may be affected by the disclosure to make representations, in writing or otherwise, on the question of whether the information should be disclosed.

Order affecting entry in the register of patents or designs

- 15.1 Where any order of the court affects the validity of an entry in the register, the court and the party in whose favour the order is made, must serve a copy of such order on the Comptroller within 14 days.
- 15.2 Where the order is in favour of more than one party, a copy of the order must be served by such party as the court directs.

Claim for rectification of the register of patents or designs

- 16.1 Where a claim is made for the rectification of the register of patents or designs, the claimant must at the same time as serving the other parties, serve a copy of –
 - (1) the claim form; and
 - (2) accompanying documents
 on the Comptroller or registrar, as appropriate.
- 16.2 Where documents under paragraph 16.1 are served on the Comptroller or registrar, he shall be entitled to take part in the proceedings.

European Community designs

- 17.1 The Patents Court and the Central London County Court are the designated Community design courts under Article 80(5) of Council Regulation (EC) 6/2002.
- 17.2 Where a counterclaim is filed at the Community design court, for a declaration of invalidity of a registered Community design, the Community design court shall inform the Office for Harmonisation in the Internal Market of the date on which the counterclaim was filed, in accordance with Article 86(2) of Council Regulation (EC) 6/2002.
- 17.3 On filing a counterclaim under paragraph 17.2, the party filing it must inform the Community design court in writing that it is a counterclaim to which paragraph 17.2 applies and that the Office for Harmonisation in the Internal Market needs to be informed of the date on which the counterclaim was filed.
- 17.4 Where a Community design court has given a judgment which has become final on a counterclaim for a declaration of invalidity of a registered Community design, the Community design court shall send a copy of the judgment to the Office for Harmonisation in the Internal Market, in accordance with Article 86(4) of Council Regulation (EC) 6/2002.
- 17.5 The party in whose favour judgment is given under paragraph 17.4 must inform the Community design court at the time of judgment that paragraph 17.4 applies and that the Office for Harmonisation in the Internal Market needs to be sent a copy of the judgment.

SECTION II - PROVISIONS ABOUT REGISTERED TRADE MARKS AND OTHER INTELLECTUAL PROPERTY RIGHTS

Allocation (rule 63.13)

- 18.1 Any of the following claims must be brought in the Chancery Division, a Patents County Court or a county court where there is also a Chancery district registry –
 - (1) copyright;
 - (2) rights in performances;
 - (3) rights conferred under Part VII of the 1988 Act;
 - (4) design right;
 - (5) Community design right;
 - (6) Olympic symbols;
 - (7) plant varieties;
 - (8) moral rights;
 - (9) database rights;

- (10) unauthorised decryption rights;
- (11) hallmarks;
- (12) technical trade secrets litigation;
- (13) passing off; and
- (14) geographical indications.

- 18.2 There are Chancery district registries at Birmingham, Bristol, Cardiff, Leeds, Liverpool, Manchester and Newcastle upon Tyne.
- 18.3 Registered trade mark and Community registered trade mark claims must be brought in the Chancery Division.

Starting the claim

- 19.1 A claim form to which this Section of this Part applies must be marked in the top right hand corner 'Chancery Division, Intellectual Property' below the title of the court in which it is issued.

Claims under the 1994 Act (rule 63.14)

- 20.1 Where the registrar refers to the High Court an application made to him under the 1994 Act, then unless within one month of receiving notification of the decision to refer, the applicant makes the application to the High Court, he shall be deemed to have abandoned it.
- 20.2 The period prescribed under paragraph 20.1 may be extended by –
- (1) the registrar; or
 - (2) the court
- where a party so applies, even if such application is not made until after the expiration of the period prescribed.
- 20.3 Where an application is made under section 19 of the 1994 Act, the applicant must serve his claim form or application notice on all identifiable persons having an interest in the goods, materials or articles within the meaning of section 19 of the 1994 Act.

Claim for infringement of registered trade mark (rule 63.15)

- 21.1 Where a document under rule 63.15(2) is served on the registrar, he –
- (1) may take part in the proceedings; and
 - (2) need not serve a defence or other statement of case, unless the court otherwise orders.

Order affecting entry in the register of trade marks

- 22.1 Where any order of the court affects the validity of an entry in the register, the provisions of paragraphs 15.1 and 15.2 shall apply.

Claim for rectification of the register of trade marks

- 23.1 Where a claim is made for the rectification of the register of trade marks, the provisions of paragraphs 16.1 and 16.2 shall apply.

European Community trade marks

- 24.1 The Chancery Division of the High Court is the designated Community trade mark court under Article 91(1) of Council Regulation (EC) 40/94.
- 24.2 Where a counterclaim is filed at the Community trade mark court, for revocation or for a declaration of invalidity of a Community trade mark, the Community trade mark court shall inform the Office for Harmonisation in the Internal Market of the date on which the counterclaim was filed, in accordance with Article 96(4) of Council Regulation (EC) 40/94.
- 24.3 On filing a counterclaim under paragraph 24.2, the party filing it must inform the Community trade mark court in writing that it is a counterclaim to which paragraph 24.2 applies and that the Office for Harmonisation in the Internal Market needs to be informed of the date on which the counterclaim was filed.
- 24.4 Where the Community trade mark court has given a judgment which has become final on a counterclaim for revocation or for a declaration of invalidity of a Community trade mark, the Community trade mark court shall send a copy of the judgment to the Office for Harmonisation in the Internal Market, in accordance with Article 96(6) of Council Regulation (EC) 40/94.
- 24.5 The party in whose favour judgment is given under paragraph 24.4 must inform the Community trade mark court at the time of judgment that paragraph 24.4 applies and that the Office for Harmonisation in the Internal Market needs to be sent a copy of the judgment.

Claim for additional damages under section 97(2) of the 1988 Act

- 25.1 Where a claimant seeks to recover additional damages under section 97(2) of the 1988 Act, the particulars of claim must include –
- (1) a statement to that effect; and
 - (2) the grounds for claiming them.

Application for delivery up or forfeiture under the 1988 Act

- 26.1 Where a claimant applies under sections 99, 114, 195 or 204 of the 1988 Act for delivery up or forfeiture he must serve –

- (1) the claim form; or
- (2) application notice, where appropriate,

on all identifiable persons who have an interest in the goods, material or articles within the meaning of sections 114 or 204 of the 1988 Act.

Olympic symbols

- 27.1 In this practice direction ‘the Olympic Symbol Regulations’ means the Olympic Association Right (Infringement Proceedings) Regulations 1995.
- 27.2 Where an application is made under regulation 5 of the Olympic Symbol Regulations, the applicant must serve his claim form or application notice on all identifiable persons having an interest in the goods, materials or articles within the meaning of regulation 5 of the Olympic Symbol Regulations.

SECTION III - PROVISIONS ABOUT APPEALS

Appeals and references from the Comptroller (rule 63.17)

- 28.1 Where –
 - (1) a person appointed by the Lord Chancellor to hear and decide appeals under section 77 of the 1994 Act, refers an appeal to the court under section 76(3) of the 1994 Act; or
 - (2) the Comptroller refers the whole proceedings or a question or issue to the court under section 251(1) of the 1988 Act,
 the appeal or reference must be brought within 14 days of the reference.