

INTELLECTUAL PROPERTY CLAIMS

This Practice Direction supplements CPR Part 63

Contents of this Practice Direction

1.1 This practice direction is divided into four sections –

- Section I – Provisions about patents and those other rights within the scope of Section I of Part 63
- Section II – Provisions about registered trade marks and other intellectual property rights
- Section III – Provisions about appeals
- Section IV – Provisions about final orders

SECTION I – PROVISIONS ABOUT PATENTS AND THOSE OTHER RIGHTS WITHIN THE SCOPE OF SECTION I OF PART 63

Scope of Section I

2.1 This Section applies to claims within the scope of Section 1 of Part 63.

Starting the claim (rule 63.5)

3.1 A claim form to which this Section applies must –

- (a) be marked ‘Chancery Division Patents Court’ or ‘Patents County Court’ as the case may be, in the top right hand corner below the title of the court, and
- (b) state the number of any patent or registered design to which the claim relates.

Claim for infringement or challenge to validity (rule 63.6)

4.1 In a claim for infringement of a patent –

- (1) the statement of case 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 statement of case, and where necessary a translation of the document, must be served with the statement of case.

4.2 Where the validity of a patent or registered design is challenged –

- (1) the statement of case must contain particulars of –
 - (a) the remedy 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 attached to and forming part of it headed 'Grounds of Invalidity' which must –
 - (a) specify the grounds on which validity of the patent or registered design is challenged; and
 - (b) include particulars that will clearly define every issue (including any challenge to any claimed priority date) which it is intended to raise; and
 - (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.
- 4.3** Where in an application in which the validity of a patent or a registered design 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 include an inventive step, the particulars must specify details of the matter in the state of the art relied on, as set out in paragraph 4.4;
 - (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; or
 - (3) that the registered design is not new or lacks individual character, the particulars must specify details of any prior design relied on, as set out in paragraph 4.4.
- 4.4** The details required under paragraphs 4.3(1) and 4.3(3) are –
- (1) in the case of matter or a design made available to the public by written description, the date on which and the means by which it was so made available, unless this is clear from the fact of the matter; and
 - (2) in the case of matter or a design 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) the place of such use;
 - (d) any written material which identifies such use;
 - (e) the existence and location of any apparatus employed in such use; and
 - (f) all facts and matters relied on to establish that such matter was made available to the public.
- 4.5** In any proceedings in which the validity of a patent is challenged, where a party alleges that machinery or apparatus was used before the priority date of the claim the court may order inspection of that machinery or apparatus.
- 4.6** If the validity of a patent is challenged 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 in the statement of case the grounds on which that party so relies.

Case management (rule 63.8)

- 5.1** The following paragraphs 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).
- 5.2** Case management will be dealt with by –
- (1) a judge of the Patents Court, a patents judge or a Master, but
 - (2) a Master may only deal with the following matters –
 - (a) orders by way of settlement, except settlement of procedural disputes;

- (b) applications for extension of time;
- (c) applications for permission to serve out of the jurisdiction;
- (d) applications for security for costs;
- (e) other matters as directed by a judge of the court; and
- (f) enforcement of money judgments.

5.3 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.

5.4 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 held or gave directions for a case management conference when it made the order transferring the claim.

5.5 Any party may, at a time earlier than that provided in paragraphs 5.3 and 5.4, apply in writing to the court to fix a case management conference.

5.6 If the claimant does not make an application in accordance with paragraphs 5.3 and 5.4, any other party may apply for a case management conference.

5.7 The court may fix a case management conference at any time on its own initiative.

5.8 Not less than 4 days before a case management conference, each party must file and serve an application notice for any order which that party intends to seek at the case management conference.

5.9 Unless the court orders otherwise, the claimant, or the party who makes an application under paragraph 5.6, in consultation with the other parties, must prepare a case management bundle containing –

- (1) the claim form;
- (2) all other statements of case (excluding schedules), except that, if a summary of a statement of case has been filed, the bundle must contain the summary, and not the full statement of case;
- (3) a pre-trial timetable, if one has been agreed or ordered;
- (4) the principal orders of the court; and
- (5) 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 4 days before the first case management conference or any earlier hearing at which the court may give case management directions.

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

- (1) a scientific adviser under section 70(3) of the Senior Courts Act 1981 or under section 63(1) of the County Courts Act 1984 be appointed; and
- (2) a document setting out basic undisputed technology should be prepared.

(Rule 35.15 applies to scientific advisers.)

5.11 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).

- 5.12** The claimant, in consultation with the other parties, must revise and update the documents, referred to in paragraph 5.9 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 63.9)

- 6.1** Standard disclosure does not require the disclosure of documents that relate to –
- (1)** the infringement of a patent by a product or process where –
 - (a)** not less than 21 days before the date for service of a list of documents the defendant notifies the claimant and any other party of the defendant's intention to serve –
 - (i)** full particulars of the product or process alleged to infringe; and
 - (ii)** any necessary drawings or other illustrations; and
 - (b)** on or before the date for service the defendant serves on the claimant and any other party the documents referred to in paragraph 6.1(1)(a);
 - (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.
- 6.2** The particulars served under paragraph 6.1(1)(b) must be accompanied by a signed written statement which must state that the person making the statement –
- (1)** is personally acquainted with the facts to which the particulars relate;
 - (2)** verifies that the particulars are a true and complete description of the product or process alleged to infringe; and
 - (3)** understands that he or she may be required to attend court in order to be cross-examined on the contents of the particulars.
- 6.3** 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).

Experiments

- 7.1** A party seeking to establish any fact by experimental proof conducted for the purpose of litigation must, at least 21 days before service of the application notice for directions under paragraph 7.3, or within such other time as the court may direct, serve on all parties a notice –
- (1) stating the facts which the party seeks to establish; and
 - (2) giving full particulars of the experiments proposed to establish them.
- 7.2** A party served with a notice under paragraph 7.1 –
- (1) must within 21 days after such service, serve on the other party a notice stating whether or not each fact is admitted; 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 7.1.
- 7.3** Where any fact which a party seeks to establish by experimental proof is not admitted, that party must apply to the court for permission and directions by application notice.

Use of models or apparatus

- 8.1** A party that intends to rely on any model or apparatus must apply to the court for directions at the first case management conference.

Time estimates for trial, trial bundle, reading guide and detailed trial timetable

- 9.1** 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.
- 9.2** At least four days before the date fixed for the trial, the claimant must file –
- (1) the trial bundle;
 - (2) a reading guide for the judge; and
 - (3) a detailed trial timetable which should be agreed, if possible.
- 9.3** The reading guide filed under paragraph 9.2 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 in which they should be read;
 - (3) identify the relevant passages in text books and cases, if appropriate; and
 - (4) not contain argument.

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

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

Request to limit a European patent (UK) under the European Patent Convention

- 11.1** Paragraphs 11.2 to 11.4 apply where there are proceedings before the court in which the validity of a European patent (UK) may be put in issue.
- 11.2** Where the proprietor of the European patent (UK) intends to file a request under Article 105a of the European Patent Convention to limit the European patent (UK) by amendment of the claims, the proprietor must serve on all the parties to the proceedings a copy of the intended request (including a copy of the intended complete version of the amended claims and, as the case may be, of the amended description and drawings) at least 28 days prior to filing the request with the European Patent Office.
- 11.3** Where a copy of an intended request is served on the party in accordance with paragraph 11.2, any party may apply to the court for such directions or other order as may be appropriate.
- 11.4** Reference to ‘European Patent Convention’ means the Convention on the Grant of European Patents of 5th October 1973 as amended from time to time.

Application by employee for compensation (rule 63.12)

- 12.1** Where an employee applies for compensation under section 40(1) or (2) of the 1977 Act, the court will 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 must be filed; and
 - (2)** the provision to the claimant by the defendant or a person deputed by the defendant, of reasonable facilities for inspecting and taking extracts from the accounts by which the defendant proposes to verify the accounts in sub-paragraph (1) or from which those accounts have been derived.

Communication of information to the European Patent Office

- 13.1** 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.
- 13.2** Before authorising the communication of information under paragraph 13.1, the court will 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

- 14.1** Where any order of the court affects the validity of an entry in the register, the party in whose favour the order is made, must serve a copy of such order on the Comptroller within 14 days.
- 14.2** 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.

European Community designs

- 15.1** The Patents Court and the patents county court at the Central London County Court are the designated Community design courts under Article 80(5) of Council Regulation (EC) 6/2002.

- 15.2** Where a counterclaim is filed at the Community design court, for a declaration of invalidity of a registered Community design, the Community design court will 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.
- 15.3** On filing a counterclaim under paragraph 15.2, the party filing it must inform the Community design court in writing that it is a counterclaim to which paragraph 15.2 applies and that the Office for Harmonisation in the Internal Market needs to be informed of the date on which the counterclaim was filed.
- 15.4** 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 will 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.
- 15.5** The party in whose favour judgment is given under paragraph 15.4 must inform the Community design court at the time of judgment that paragraph 15.4 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)

- 16.1** The other intellectual property rights referred to in rule 63.13 are –
- (1) copyright;
 - (2) rights in performances;
 - (3) rights conferred under Part VII of the 1988 Act;
 - (4) design right;
 - (5) Community design right;
 - (6) association rights;
 - (7) moral rights;
 - (8) database rights;
 - (9) unauthorised decryption rights;
 - (10) hallmarks;
 - (11) technical trade secrets litigation;
 - (12) passing off;
 - (13) protected designations of origin, protected geographical indications and traditional speciality guarantees;
 - (14) registered trade marks; and
 - (15) Community trade marks.
- 16.2** There are Chancery district registries at Birmingham, Bristol, Caernarfon, Cardiff, Leeds, Liverpool, Manchester, Mold, Newcastle upon Tyne and Preston.
- 16.3** The county courts at Caernarfon, Mold and Preston do not have jurisdiction in relation to registered trade marks and Community trade marks.

Starting the claim

- 17.1** A claim form to which Section II of Part 63 applies must be marked in the top right hand corner 'Intellectual Property' below the title of the court in which it is issued.
- 17.2** In the case of claims concerning registered trade marks and Community trade marks, the claim form must state the registration number of any trade mark to which the claim relates.

Reference to the court by the registrar or the Comptroller

- 18.1** This paragraph applies where –
- (1) an application is made to the registrar under the 1994 Act and the registrar refers the application to the court; or
 - (2) a reference is made to the Comptroller under section 246 of the 1988 Act and the Comptroller refers the whole proceedings or a particular question or issue to the court under section 251(1) of that Act.
- 18.2** Where paragraph 18.1 applies, the applicant under the 1994 Act or the person making the reference under section 246 of the 1988 Act, as the case may be, must start a claim seeking the court's determination of the reference within 14 days of receiving notification of the decision to refer.
- 18.3** If the person referred to in paragraph 18.2 does not start a claim within the period prescribed by that paragraph, that person will be deemed to have abandoned the reference.
- 18.4** The period prescribed under paragraph 18.2 may be extended by –
- (1) the registrar or the Comptroller as the case may be; or
 - (2) the court
- where a party so applies, even if the application is not made until after the expiration of that period.

Application to the court under section 19 of the 1994 Act

- 19.1** Where an application is made under section 19 of the 1994 Act, the applicant must serve the 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.

Order affecting entry in the register of trade marks

- 20.1** Where any order of the court affects the validity of an entry in the register, the provisions of paragraphs 14.1 and 14.2 apply.

European Community trade marks

- 21.1** The Chancery Division, the patents county court at the Central London County Court and the county courts where there is also a Chancery district registry, except Caernarfon, Mold and Preston, are designated Community trade mark courts for the purposes of Article 91(1) of Council Regulation (EC) 40/94.
- 21.2** 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 will 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.

- 21.3** On filing a counterclaim under paragraph 21.2, the party filing it must inform the Community trade mark court in writing that it is a counterclaim to which paragraph 21.2 applies and that the Office for Harmonisation in the Internal Market needs to be informed of the date on which the counterclaim was filed.
- 21.4** 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 will 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.
- 21.5** The party in whose favour judgment is given under paragraph 21.4 must inform the Community trade mark court at the time of judgment that paragraph 21.4 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), section 191J(2) or section 229(3) of the 1988 Act

- 22.1** Where a claimant seeks to recover additional damages under section 97(2), section 191J(2) or section 229(3) 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

- 23.1** An applicant who applies under section 99, 114, 195, 204, 230 or 231 of the 1988 Act for delivery up or forfeiture 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 section 114, 204 or 231 of the 1988 Act.

Association rights

- 24.1** Where an application is made under regulations made under section 7 of the Olympic Symbol etc (Protection) Act 1995, the applicant must serve the claim form or application notice on all identifiable persons having an interest in the goods, materials or articles within the meaning of the regulations.

SECTION III – PROVISIONS ABOUT APPEALS

Reference to the court by an appointed person

- 25.1** This paragraph applies where a person appointed by the Lord Chancellor to hear and decide appeals under section 77 of the 1994 Act, refers an appeal to the Chancery Division under section 76(3) of the 1994 Act.
- 25.2** The appellant must file a claim form seeking the court's determination of the appeal within 14 days of receiving notification of the decision to refer.

- 25.3** The appeal will be deemed to have been abandoned if the appellant does not file a claim form within the period prescribed by paragraph 25.2.
- 25.4** The period prescribed under paragraph 25.2 may be extended by –
- (1) the person appointed by the Lord Chancellor; or
 - (2) the court
- where the appellant so applies, even if such application is not made until after the expiration of that period.

SECTION IV – PROVISIONS ABOUT FINAL ORDERS

Costs

- 26.1** Where the court makes an order for delivery up or destruction of infringing goods, or articles designed or adapted to make such goods, the person against whom the order is made must pay the costs of complying with that order unless the court orders otherwise.
- 26.2** Where the court finds that an intellectual property right has been infringed, the court may, at the request of the applicant, order appropriate measures for the dissemination and publication of the judgment to be taken at the expense of the infringer.