

# INTELLECTUAL PROPERTY CLAIMS

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### 63.1 Scope of this Part and interpretation

- (1) This Part applies to all intellectual property claims including –
- (a) registered intellectual property rights such as –
    - (i) patents;
    - (ii) registered designs; and
    - (iii) registered trade marks; and
  - (b) unregistered intellectual property rights such as –
    - (i) copyright;
    - (ii) design right;
    - (iii) the right to prevent passing off; and
    - (iv) the other rights set out in Practice Direction 63.
- (2) In this Part –
- (a) ‘the 1977 Act’ means the Patents Act 1977<sup>1</sup>;
  - (b) ‘the 1988 Act’ means the Copyright, Designs and Patents Act 1988<sup>2</sup>;
  - (c) ‘the 1994 Act’ means the Trade Marks Act 1994<sup>3</sup>;
  - (d) ‘the Comptroller’ means the Comptroller General of Patents, Designs and Trade Marks;
  - (e) ‘patent’ means a patent under the 1977 Act or a supplementary protection certificate granted by the Patent Office under Article 10(1) of Council Regulation (EEC) No. 1768/92<sup>4</sup> or of Regulation (EC) No. 1610/96 of the European Parliament and the Council<sup>5</sup> and includes any application for a patent or supplementary protection certificate;
  - (f) ‘Patents Court’ means the Patents Court of the High Court constituted as part of the Chancery Division by section 6(1) of the Senior Courts Act 1981<sup>6</sup>;
  - (g) ‘patents county court’ means a county court designated as a patents county court under section 287(1) of the 1988 Act;
  - (h) ‘patents judge’ means a person nominated under section 291(1) of the 1988 Act as the patents judge of a patents county court;
  - (i) omitted
  - (j) ‘the register’ means whichever of the following registers is appropriate –
    - (i) patents maintained by the Comptroller under section 32 of the 1977 Act;
    - (ii) designs maintained by the registrar under section 17 of the Registered Designs Act 1949<sup>7</sup>;
    - (iii) trade marks maintained by the registrar under section 63 of the 1994 Act;
    - (iv) Community trade marks maintained by the Office for Harmonisation in the Internal Market under Article 83 of Council Regulation (EC) No. 40/94<sup>8</sup>;
    - (v) Community designs maintained by the Office for Harmonisation in the Internal Market under Article 72 of Council Regulation (EC) No. 6/2002<sup>9</sup>; and
    - (vi) plant varieties maintained by the Controller under regulation 12 of the Plant Breeders’ Rights Regulations 1998<sup>10</sup>; and
  - (k) ‘the registrar’ means –
    - (i) the registrar of trade marks; or
    - (ii) the registrar of registered designs,

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1 1977 c. 37.

2 1988 c. 48.

3 1994 c. 26.

4 OJ No L182, 2.7.1992, p.1.

5 OJ No L198, 8.8.1996, p.30.

6 1981 c. 54.

7 1949 c. 88.

8 OJ No L11, 14.1.1994, p.1.

9 OJ No L3, 5.1.2002, p.1.

10 S.I. 1998/1027.

whichever is appropriate.

- (3) Claims to which this Part applies are allocated to the multi-track.

## I PATENTS AND REGISTERED DESIGNS

### 63.2 Scope of Section I and allocation

- (1) This Section applies to –
- (a) any claim under –
    - (i) the 1977 Act;
    - (ii) the Registered Designs Act 1949;
    - (iii) the Defence Contracts Act 1958<sup>1</sup>; and
  - (b) any claim relating to –
    - (i) Community registered designs;
    - (ii) semiconductor topography rights; or
    - (iii) plant varieties.
- (2) Claims to which this Section applies must be started in –
- (a) the Patents Court; or
  - (b) a patents county court.

### 63.3 Specialist list

Claims in the Patents Court and a patents county court form specialist lists for the purpose of rule 30.5.

### 63.4 Omitted

### 63.5 Starting the claim

Claims to which this Section applies must be started –

- (a) by a Part 7 claim form; or
- (b) in existing proceedings under Part 20.

### 63.6 Claim for infringement or challenge to validity of a patent or registered design

A statement of case in a claim for infringement or a claim in which the validity of a patent or registered design is challenged must contain particulars as set out in Practice Direction 63.

### 63.7 Defence and reply

Part 15 applies with the modification –

- (a) to rule 15.4(1)(b) that in a claim for infringement under rule 63.6, the period for filing a defence where the defendant files an acknowledgment of service under Part 10 is 42 days after service of the particulars of claim;
- (b) that where rule 15.4(2) provides for a longer period to file a defence than in rule 63.7(a), then the period of time in rule 15.4(2) will apply; and
- (c) to rule 15.8 that the claimant must –
  - (i) file any reply to a defence; and

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<sup>1</sup> 1958 c. 38.

- (ii) serve it on all other parties,  
within 21 days of service of the defence.

### **63.8 Case management**

- (1) Parties do not need to file an allocation questionnaire.
- (2) The following provisions only of Part 29 apply –
  - (a) rule 29.3(2) (legal representatives to attend case management conferences);
  - (b) rule 29.4 (the court's approval of agreed proposals for the management of proceedings); and
  - (c) rule 29.5 (variation of case management timetable) with the exception of paragraph (1)(b) and (c).
- (3) As soon as practicable the court will hold a case management conference which must be fixed in accordance with Practice Direction 63.

### **63.9 Disclosure and inspection**

Part 31 is modified to the extent set out in Practice Direction 63.

### **63.10 Application to amend a patent specification in existing proceedings**

- (1) An application under section 75 of the 1977 Act for permission to amend the specification of a patent by the proprietor of the patent must be made by application notice.
- (2) The application notice must –
  - (a) give particulars of –
    - (i) the proposed amendment sought; and
    - (ii) the grounds upon which the amendment is sought;
  - (b) state whether the applicant will contend that the claims prior to the amendment are valid; and
  - (c) be served by the applicant on all parties and the Comptroller within 7 days of it being filed.
- (3) The application notice must, if it is reasonably possible, be served on the Comptroller electronically.
- (4) Unless the court otherwise orders, the Comptroller will, as soon as practicable, advertise the application to amend in the journal.
- (5) The advertisement will state that any person may apply to the Comptroller for a copy of the application notice.
- (6) Within 14 days of the first appearance of the advertisement any person who wishes to oppose the application must file and serve on all parties and the Comptroller a notice opposing the application which must include the grounds relied on.
- (7) Within 28 days of the first appearance of the advertisement the applicant must apply to the court for directions.
- (8) Unless the court otherwise orders, the applicant must within 7 days serve on the Comptroller any order of the court on the application.
- (9) In this rule 'the journal' means the journal published pursuant to rules under section 123(6) of the 1977 Act.

### **63.11 Court's determination of question or application**

- (1) This rule applies where the Comptroller –
  - (a) declines to deal with a question under section 8(7), 12(2), 37(8) or 61(5) of the 1977 Act;
  - (b) declines to deal with an application under section 40(5) of the 1977 Act; or
  - (c) certifies under section 72(7)(b) of the 1977 Act that the court should determine the question whether a patent should be revoked.
- (2) Any person seeking the court's determination of that question or application must start a claim for that purpose within 14 days of receiving notification of the Comptroller's decision.
- (3) A person who fails to start a claim within the time prescribed by rule 63.11(2) will be deemed to have abandoned the reference or application.
- (4) A party may apply to the Comptroller or the court to extend the period for starting a claim prescribed by rule 63.11(2) even where the application is made after expiration of that period.

### **63.12 Application by employee for compensation**

- (1) An application by an employee for compensation under section 40(1) or (2) of the 1977 Act must be made –
  - (a) in a claim form; and
  - (b) within the period prescribed by paragraphs (2), (3) and (4).
- (2) The prescribed period begins on the date of the grant of the patent and ends 1 year after the patent has ceased to have effect.
- (3) Where the patent has ceased to have effect as a result of failure to pay renewal fees, the prescribed period continues as if the patent has remained continuously in effect provided that –
  - (a) the renewal fee and any additional fee are paid in accordance with section 25(4) of the 1977 Act; or
  - (b) restoration is ordered by the Comptroller following an application under section 28 of the 1977 Act.
- (4) Where restoration is refused by the Comptroller following an application under section 28 of the 1977 Act, the prescribed period will end 1 year after the patent has ceased to have effect or 6 months after the date of refusal, whichever is the later.

## **II REGISTERED TRADE MARKS AND OTHER INTELLECTUAL PROPERTY RIGHTS**

### **63.13 Allocation**

Claims relating to matters arising out of the 1994 Act and other intellectual property rights set out in Practice Direction 63 must be started in –

- (a) the Chancery Division;
- (b) a patents county court; or
- (c) save as set out in Practice Direction 63, a county court where there is also a Chancery District Registry.

### III SERVICE OF DOCUMENTS AND PARTICIPATION BY THE COMPTROLLER

#### 63.14 Service of documents

- (1) Subject to paragraph (2), Part 6 applies to service of a claim form and any document in any proceedings under this Part.
- (2) A claim form relating to a registered right may be served –
  - (a) on a party who has registered the right at the address for service given for that right in the United Kingdom Patent Office register, provided the address is within the United Kingdom; or
  - (b) in accordance with rule 6.32(1), 6.33(1) or 6.33(2) on a party who has registered the right at the address for service given for that right in the appropriate register at –
    - (i) the United Kingdom Patent Office; or
    - (ii) the Office for Harmonisation in the Internal Market.
- (3) Where a party seeks any remedy (whether by claim form, counterclaim or application notice), which would if granted affect an entry in any United Kingdom Patent Office register, that party must serve on the Comptroller or registrar –
  - (a) the claim form, counterclaim or application notice;
  - (b) any other statement of case where relevant (including any amended statement of case); and
  - (c) any accompanying documents.

#### 63.15 Participation by the Comptroller

Where the documents set out in rule 63.14(3) are served, the Comptroller or registrar –

- (a) may take part in proceedings; and
- (b) need not serve a defence or other statement of case unless the court orders otherwise.

### IV APPEALS

#### 63.16 Appeals from decisions of the Comptroller or the registrar

- (1) Part 52 applies to appeals from decisions of the Comptroller and the registrar.
- (2) Appeals about patents must be made to the Patents Court, and other appeals to the Chancery Division.
- (3) Where Part 52 requires a document to be served, it must also be served on the Comptroller or registrar, as appropriate.

### V PATENTS COUNTY COURT

#### 63.17 Scope of this Section

This Part, as modified by this Section, applies to claims started in or transferred to a patents county court.

#### 63.18 Transfer of proceedings

When considering whether to transfer proceedings to or from a patents county court, the court will have regard to the provisions of Practice Direction 30.

### **63.19 Patents judge**

- (1) Subject to paragraph (2), proceedings in a patents county court will be dealt with by the patents judge of that court.
- (2) When a matter needs to be dealt with urgently and it is not practicable or appropriate for the patents judge to deal with it, the matter may be dealt with by another judge with appropriate specialist experience nominated by the Chancellor of the High Court.

### **63.20 Statements of case**

- (1) Part 16 applies with the modification that a statement of case must set out concisely all the facts and arguments upon which the party serving it relies.
- (2) The particulars of claim must state whether the claimant has complied with paragraph 7.1(1) and Annex A (paragraph 2) of the Practice Direction (Pre-Action Conduct).

### **63.21 Statement of truth**

Part 22 applies with the modification that the statement of truth verifying a statement of case must be signed by a person with knowledge of the facts alleged, or if no one person has knowledge of all the facts, by persons who between them have knowledge of all the facts alleged.

### **63.22 Defence and reply**

- (1) Rule 63.7 does not apply and Part 15 applies with the following modifications.
- (2) Where the particulars of claim contain a confirmation in accordance with rule 63.20(2), the period for filing a defence is 42 days after service of the particulars of claim unless rule 15.4(2) provides for a longer period to do so.
- (3) Where the particulars of claim do not contain a confirmation in accordance with rule 63.20(2), the period for filing a defence is 70 days after service of the particulars of claim.
- (4) Where the claimant files a reply to a defence it must be filed and served on all other parties within 28 days of service of the defence.
- (5) Where the defendant files a reply to a defence to a counterclaim it must be filed and served on all other parties within 14 days of service of the defence to the counterclaim.
- (6) The periods in this rule may only be extended by order of the court and for good reason.

### **63.23 Case management**

- (1) At the first case management conference after those defendants who intend to file and serve a defence have done so, the court will identify the issues and decide whether to make an order in accordance with paragraph 29.1 of Practice Direction 63.
- (2) Save in exceptional circumstances the court will not consider an application by a party to submit material in addition to that ordered under paragraph (1).
- (3) The court may determine the claim on the papers where all parties consent.

### **63.24 Disclosure and inspection**

- (1) Rule 63.9 does not apply.
- (2) Part 31 applies save that the provisions on standard disclosure do not apply.

### **63.25 Applications**

- (1) Part 23 applies with the modifications set out in this rule.
- (2) Except at the case management conference provided for in rule 63.23(1), a respondent to an application must file and serve on all relevant parties a response within 5 days of the service of the application notice.
- (3) The court will deal with an application without a hearing unless the court considers it necessary to hold a hearing.
- (4) An application to transfer the claim to the High Court or to stay proceedings must be made before or at the case management conference provided for in rule 63.23(1).
- (5) The court will consider an application to transfer the claim later in the proceedings only where there are exceptional circumstances.

### **63.26 Costs**

- (1) Subject to paragraph (2), the court will reserve the costs of an application to the conclusion of the trial when they will be subject to summary assessment.
- (2) Where a party has behaved unreasonably the court will make an order for costs at the conclusion of the hearing.
- (3) Where the court makes a summary assessment of costs, it will do so in accordance with Section VII of Part 45.