

ANNEX 1 - CIVIL PROCEDURE RULES

PART 63

PART 63 – PRACTICE DIRECTION

INTELLECTUAL PROPERTY CLAIMS

Contents of this Part

Rule 63.1 Scope of this Part and interpretation

I PATENTS AND REGISTERED DESIGNS

Rule 63.2 Scope of Section I and allocation

Rule 63.3 Specialist list

Rule 63.4 Omitted

Rule 63.5 Starting the claim

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

Rule 63.7 Defence and reply

Rule 63.8 Case management

Rule 63.9 Disclosure and inspection

Rule 63.10 Application to amend a patent specification in existing proceedings

Rule 63.11 Court's determination of question or application

Rule 63.12 Application by employee for compensation

II REGISTERED TRADE MARKS AND OTHER INTELLECTUAL PROPERTY RIGHTS

Rule 63.13 Allocation

III SERVICE OF DOCUMENTS AND PARTICIPATION BY THE COMPTROLLER

Rule 63.14 Service of documents

Rule 63.15 Participation by the Comptroller

IV APPEALS

Rule 63.16 Appeals from decisions of the Comptroller or the registrar

V PATENTS COUNTY COURT

Rule 63.17 Scope of this Section

Rule 63.18 Transfer of proceedings

Rule 63.19 Patents judge

Rule 63.20 Statements of case

Rule 63.21 Statement of truth

Rule 63.22 Defence and reply

Rule 63.23 Case management

Rule 63.24 Disclosure and inspection

Rule 63.25 Applications

Rule 63.26 Costs

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 1977¹;
 - (b) ‘the 1988 Act’ means the Copyright, Designs and Patents Act 1988²;
 - (c) ‘the 1994 Act’ means the Trade Marks Act 1994³;
 - (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. 1768/92⁴ or of Regulation (EC) No. 1610/96 of the European Parliament and the Council⁵ 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 1981⁶;
 - (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 1949⁷;
 - (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. 40/94⁸;
 - (v) Community designs maintained by the Office for Harmonisation in the Internal Market under Article 72 of Council Regulation (EC) No. 6/2002⁹; and
 - (vi) plant varieties maintained by the Controller under regulation 12 of the Plant Breeders’ Rights Regulations 1998¹⁰; and
 - (k) ‘the registrar’ means –
 - (i) the registrar of trade marks; or
 - (ii) the registrar of registered designs,

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 1958¹; 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

¹ 1953 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.

INTELLECTUAL PROPERTY CLAIMS

This Practice Direction supplements CPR Part 63

Contents of this Practice Direction

- 1.1** This practice direction is divided into five 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 V – Provisions about proceedings in a patents county court

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 Practice Direction 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** Except for claims started in a patents county court, 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.

SECTION V – PROVISIONS ABOUT PROCEEDINGS IN A PATENTS COUNTY COURT

Scope of Section V

- 27.1** Except as provided for in paragraph 27.2 this Practice Direction, as modified by this Section, applies to claims in a patents county court.
- 27.2** Paragraphs 5.10 to 9.1 and paragraph 9.2(3) do not apply to a claim in a patents county court.

Claims for infringement or challenge to validity

- 28.1** Paragraph 4.2(2) is modified so that the grounds for invalidity must be included in the statement of case and not in a separate document.

Case management (rule 63.23)

- 29.1** At the case management conference referred to in rule 63.23 the court may order any of the following –
- (1) specific disclosure;
 - (2) a product or process description (or a supplementary product or process description where one has already been provided);
 - (3) experiments;
 - (4) witness statements;
 - (5) experts' reports;
 - (6) cross examination at trial;

(7) written submissions or skeleton arguments.

29.2 The court will make an order under paragraph 29.1 only –

- (1) in relation to specific and identified issues; and
- (2) if the court is satisfied that the benefit of the further material in terms of its value in resolving those issues appears likely to justify the cost of producing and dealing with it.

Applications (rule 63.25)

30.1 Where the court considers that a hearing is necessary under rule 63.25(3) the court will conduct a hearing by telephone or video conference in accordance with paragraphs 6.2 to 7 of Practice Direction 23A unless it considers that a hearing in person would be more cost effective for the parties or is otherwise necessary in the interests of justice.

Determination of the claim

31.1 Where possible, the court will determine the claim solely on the basis of the parties' statements of case and oral submissions.

31.2 The court will set the timetable for the trial and will, so far as appropriate, allocate equal time to the parties. Cross-examination will be strictly controlled by the court. The court will endeavour to ensure that the trial lasts no more than 2 days.