
STATUTORY INSTRUMENTS

1978 No. 579

The Rules of the Supreme Court (Amendment No. 3) 1978

PART III

PATENTS ACT 1977

- 8.** Paragraph (d) of Order 5, rule 2, shall be revoked.
- 9.**—(1) Order 59 shall be amended as follows:—
- (a) In rule 17(1), the words from “made” to the end shall be omitted.
 - (b) For rule 18 there shall be substituted the following rule:—

“Appeal from Patents Court on appeal from Comptroller

18. In the case of an appeal to the Court of Appeal from a decision of the Patents Court on an appeal from a decision of the Comptroller-General of Patents, Designs and Trade Marks the notice of appeal must be served on the Comptroller-General as well as on the party or parties required to be served under rule 3.”

(2) Nothing in sub-paragraph (1)(b) above shall apply in relation to any appeal to the Court of Appeal which, pursuant to paragraph 12 or 13 of Schedule 4 to the Patents Act 1977, is to be prosecuted under the old law as defined by paragraph 16 of that Schedule.

- 10.** The following paragraph shall be added to Order 70, rule 2:—

“(3) Where on an application under section 1 of the Act of 1975 as applied by section 92 of the Patents Act 1977 an order is made for the examination of witnesses, the Court may allow an officer of the European Patent Office to attend the examination and examine the witnesses or request the Court or the examiner before whom the examination takes place to put specified questions to them.”

11. Order 103 shall be revoked except in relation to proceedings under section 23, 24 or 25 of the Patents Act 1949, and in relation to those proceedings Order 103 shall have effect with the following modifications:—

- (a) In rule 4(4) the words “assigned to Group A and” shall be omitted.
- (b) In rule 8(2) for the word “patents” there shall be substituted the words “Patents Court”.
- (c) In rule 10(1) the words “The summons shall be assigned to Group A” shall be omitted.
- (d) Paragraph (3) of rule 16 shall be omitted.
- (e) Order 104, rule 2, and the definition of “the Court” in Order 104, rule 1, shall apply for the purposes of Order 103 as they apply for the purposes of Order 104.

12. Order 104 shall be re-numbered as Order 105 and before that Order there shall be inserted the following Order:—

“ORDER 104

THE PATENTS ACTS 1949 TO 1961 AND 1977; THE REGISTERED DESIGNS ACTS 1949 TO 1971; THE DEFENCE CONTRACTS ACT 1958

Definitions

1. In this Order—

“the 1949 Act” means the Patents Act 1949;

“the 1977 Act” means the Patents Act 1977;

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

“the Court”, without prejudice to Order 1, rule 4(2), means the Patents Court;

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

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

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

“patent” means an existing patent or a 1977 Act patent.

Assignment of proceedings

2.—(1) All proceedings in the High Court under the Patents Acts 1949 to 1961 and 1977, the Registered Designs Acts 1949 to 1961 and the Defence Contracts Act 1958, and all proceedings for the determination of a question or the making of a declaration relating to a patent under the inherent jurisdiction of the High Court, shall be assigned to the Chancery Division and taken by the Court.

(2) Nothing in Order 4, rule 1, shall apply in relation to any proceedings mentioned in paragraph (1) but every writ, summons, petition, notice, pleading, affidavit or other document relating to such proceedings must be marked in the top left-hand corner with the words “Patents Court”.

Application for leave to amend specification under s. 30 of the 1949 Act or s. 75 of the 1977 Act

3.—(1) A patentee or the proprietor of a patent intending to apply under section 30 of the 1949 Act or under section 75 of the 1977 Act for leave to amend his specification must give notice of his intention to the comptroller accompanied by a copy of an advertisement—

- (a) identifying the proceedings pending before the Court in which it is intended to apply for such leave;
- (b) giving particulars of the amendment sought;
- (c) stating the applicant's address for service within the United Kingdom, and
- (d) stating that any person intending to oppose the amendment who is not a party to the proceedings must within 28 days after the appearance of the advertisement give written notice of his intention to the applicant;

and the comptroller shall insert the advertisement once in the journal.

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

(2) As soon as may be after the expiration of 35 days from the appearance of the advertisement the applicant must make his application under the said section 30 or 75, as the case may be, by motion in the proceedings pending before the Court; and notice of the motion, together with a copy of the specification certified by the comptroller and showing in coloured ink the amendment sought, must be served on the comptroller, the parties to the proceedings and any person who has given notice of his intention to oppose the amendment.

(3) On the hearing of the motion the Court shall give such directions for the further conduct of the proceedings on the motion as it thinks necessary or expedient and, in particular, directions—

- (a) requiring the applicant and any party or person opposing the amendment sought to exchange statements of the grounds for allowing the amendment and of objections to the amendment;
- (b) determining whether the motion shall be heard with the other proceedings relating to the patent in question or separately and, if separately, fixing the date of hearing thereof;
- (c) as to the manner in which the evidence shall be given and, if the evidence is to be given by affidavit, fixing the times within which the affidavits must be filed.

(4) Where the Court allows a specification to be amended, the applicant must forthwith lodge with the comptroller an office copy of the order made by the Court and, if so required by the Court or comptroller, leave at the Patent Office a new specification and drawings as amended, prepared in compliance with the 1949 or 1977 Act, whichever is applicable, and the rules made under those Acts respectively.

The comptroller shall cause a copy of the order to be inserted at least once in the journal.

Application for revocation of patent

4.—(1) An application under section 72 of the 1977 Act for the revocation of a patent shall be made by petition.

This paragraph does not apply to an application made in pending proceedings.

(2) The respondent to a petition under section 32 of the 1949 Act or section 72 of the 1977 Act must serve an answer on the petitioner within 21 days after service of the petition on him.

Action for infringement

5.—(1) Notwithstanding anything in Order 5, rule 4, proceedings in which a claim is made by the plaintiff in respect of the infringement of a patent shall be begun by writ.

(2) The plaintiff in such an action must serve with his statement of claim particulars of the infringement relied on, showing which of the claims in the specification of the patent are alleged to be infringed and giving at least one instance of each type of infringement alleged.

(3) If a defendant in such an action alleges, as a defence to the action, that at the time of the infringement there was in force a contract or licence relating to the patent made by or with the consent of the plaintiff and containing a condition or term void by virtue of section 44 of the 1977 Act, he must serve on the plaintiff particulars of the date of, and parties to, each such contract or licence and particulars of each such condition or term.

Objection to validity of patent

6.—(1) A person who—

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- (a) presents a petition under section 32 of the 1949 Act or section 72 of the 1977 Act for the revocation of a patent, or
- (b) being party to an action concerning a patent, either questions the validity of the patent or applies by counterclaim in the action for revocation of the patent,

must serve with his petition or other pleading particulars of the objections to the validity of the patent on which he relies.

(2) Particulars given pursuant to paragraph (1) must state every ground on which the validity of the patent is questioned and must include such particulars as will clearly define every issue which it is intended to raise.

(3) If the grounds stated in the particulars of objections include want of novelty or want of any inventive step, the particulars must state the manner, time and place of every prior publication or user relied upon and, if prior user is alleged, must—

- (a) specify the name of every person alleged to have made such user,
 - (b) state whether such user is alleged to have continued until the priority date of the claim in question or of the invention, as may be appropriate, and, if not, the earliest and latest date on which such user is alleged to have taken place,
 - (c) contain a description accompanied by drawings, if necessary, sufficient to identify such user, and
 - (d) if such user relates to machinery or apparatus, state whether the machinery or apparatus is in existence and where it can be inspected.
- (4) If in the case of an existing patent—
- (a) one of the grounds stated in the particulars of objections is that the invention, so far as claimed in any claim of the complete specification, is not useful, and
 - (b) it is intended, in connection with that ground, to rely on the fact that an example of the invention which is the subject of any such claim cannot be made to work, either at all or as described in the specification,

the particulars must state that fact and identify each such claim and must include particulars of each such example, specifying the respects in which it is alleged that it does not work or does not work as described.

Amendment of particulars

7. Without prejudice to Order 20, rule 5, the Court may at any stage of the proceedings allow a party to amend any particulars served by him under the foregoing provisions of this Order on such terms as to costs or otherwise as may be just.

Further particulars

8. The Court may at any stage of the proceedings order a party to serve on any other party further or better particulars of infringements or of objections.

Restrictions on admission of evidence

9.—(1) Except with the leave of the judge hearing any action or other proceeding relating to a patent, no evidence shall be admissible in proof of any alleged infringement, or of any objection to the validity, of the patent, if the infringement or objection was not raised in the particulars of infringements or objections, as the case may be.

(2) In any action or other proceeding relating to a patent, evidence which is not in accordance with a statement contained in particulars of objections to the validity of the

patent shall not be admissible in support of such an objection unless the judge hearing the proceeding allows the evidence to be admitted.

(3) If any machinery or apparatus alleged to have been used before the priority date mentioned in rule 6(3)(b) is in existence at the date of service of the particulars of objections, no evidence of its user before that date shall be admissible unless it is proved that the party relying on such user offered, where the machinery or apparatus is in his possession, inspection of it to the other parties to the proceedings or, where it is not, used all reasonable endeavours to obtain inspection of it for those parties.

Proceedings for infringement or revocation: summons for directions

10.—(1) In an action for infringement of a patent (whether or not any other relief is claimed) and in proceedings by petition for the revocation of a patent the plaintiff or petitioner must, within one month after service of a reply of answer or after the expiration of the period fixed for service thereof, take out a summons for directions as to the place and mode of trial returnable in not less than 21 days, and if the plaintiff or petitioner does not take out such a summons in accordance with this paragraph, the defendant or respondent, as the case may be, may do so.

The summons may be heard in chambers or in court as the Court thinks fit.

- (2) The Court hearing a summons under this rule may give such directions—
- (a) for the service of further pleadings or particulars,
 - (b) for the discovery of documents,
 - (c) for securing the making of admissions,
 - (d) for the service of interrogatories and of answers thereto,
 - (e) for the taking by affidavit of evidence relating to matters requiring expert knowledge, and for the filing of such affidavits and the service of copies thereof on the other parties,
 - (f) for the service on the other parties, by any party desiring to submit experimental proof, of full and precise particulars of the experiments proposed and of the facts which he claims to be able to establish thereby,
 - (g) for the making of experiments, tests, inspections or reports,
 - (h) for the hearing, as a preliminary issue, of any question that may arise (including any question as to the construction of the specification or other documents),

and otherwise as the Court thinks necessary or expedient for the purpose of defining and limiting the issues to be tried, restricting the number of witnesses to be called at the trial of any particular issue and otherwise securing that the case shall be disposed of, consistently with adequate hearing, in the most expeditious manner.

Where the evidence is directed to be given by affidavit, the deponents must attend at the trial for cross-examination unless, with the concurrence of the Court, the parties otherwise agree.

(3) On the hearing of a summons under this rule the Court shall consider, if necessary of its own motion, whether an independent scientific adviser should be appointed under rule 11 to assist the Court.

(4) Order 24, rules 1 and 2, shall not apply in an action for infringement of a patent.

(5) Order 38, rule 36, shall not apply to an action or proceedings in which a summons for directions is required to be taken out under this rule and, without prejudice to its powers under paragraph (2), the Court hearing the summons may exercise the powers conferred by Order 38, rule 38, as if the summons were an application under the said rule 36.

(6) No action for infringement of a patent or petition for the revocation of a patent shall be set down for trial unless and until a summons under this rule in the action or proceedings has been taken out and the directions given on the summons have been carried out or the time fixed by the Court for carrying them out has expired.

Appointment of a scientific adviser

11.—(1) In any proceedings under the 1949 or 1977 Act the Court may at any time, and on or without the application of any party, appoint an independent scientific adviser to assist the Court, either—

- (a) by sitting with the judge at the trial or hearing of the proceedings, or
- (b) by inquiring and reporting on any question of fact or of opinion not involving a question of law or construction,

according as the Court may direct.

(2) The Court may nominate the scientific adviser and, where appropriate, settle any question or instructions to be submitted or given to him.

(3) Where the Court appoints a scientific adviser to inquire and report under paragraph (1)(b), Order 40, rules 2, 3, 4 and 6 shall apply in relation to his report as they apply in relation to a report made by a Court expert.

Determination of question or application where comptroller declines to deal with it

12. 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 that Act, or
- (c) certifies under section 72(7)(b) of that Act that the question whether a patent should be revoked is one which would more properly be determined by the court,

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

Application by employee for compensation under s. 40 of the 1977 Act

13.—(1) An application by an employee for compensation under section 40(1) or (2) of the 1977 Act shall be made by originating summons issued within the period which begins when the relevant patent is granted and which expires one year after it has ceased to have effect:

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

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

(2) On the day fixed for the hearing of the originating summons under Order 28, rule 2, the Court shall, without prejudice to the generality of Order 28, rule 4, give directions as to the manner in which the evidence (including any accounts of expenditure and receipts

relating to the claim) shall be given at the hearing of the summons and, if the evidence is to be given by affidavit, specify the period within which the affidavit must be filed.

(3) The Court shall also give directions as to the provision by the defendant to the plaintiff, or a person deputed by him for the purpose, of reasonable facilities for inspecting and taking extracts from the books of account by which the defendant proposes to verify the accounts mentioned in paragraph (2) or from which those accounts have been derived.

Appeals from the comptroller

14.—(1) An appeal to the Court from a decision of the comptroller in any case in which a right of appeal is given by the 1949 or 1977 Act must be brought by originating motion and the notice of motion is referred to in this rule as “notice of appeal”.

(2) Notice of appeal shall be lodged with the proper officer—

- (a) in the case of a decision on a matter of procedure, within 14 days after the date of the decision; and
- (b) in any other case, within six weeks after the date of the decision.

(3) The comptroller may determine whether any decision is on a matter of procedure and any such determination shall itself be a decision on a matter of procedure.

(4) Notice of appeal may be given in respect of the whole or any specific part of the decision of the comptroller and must specify the grounds of the appeal and the relief which the appellant seeks.

(5) Except with the leave of the Court the appellant shall not be entitled on the hearing of the appeal to rely on any ground of appeal or to apply for any relief not specified in the notice of appeal.

(6) The appellant shall, within 5 days of lodging notice of appeal, serve a copy thereof on the comptroller and any other party to the proceedings before the comptroller.

(7) On receiving notice of appeal the comptroller shall forthwith transmit to the proper officer all the papers relating to the matter which is the subject of the appeal.

(8) Except by leave of the Court, no appeal shall be entertained unless notice of appeal has been given within the period specified in paragraph (2) or within such further time as the comptroller may allow upon request made to him prior to the expiry of that period.

(9) A respondent who, not having appealed from the decision of the comptroller, desires to contend on the appeal that the decision should be varied, either in any event or in the event of the appeal being allowed in whole or in part, must give notice to that effect, specifying the grounds of that contention and the relief which he seeks from the Court.

(10) A respondent who desires to contend on the appeal that the decision of the comptroller should be affirmed on grounds other than those set out in the decision must give notice to that effect, specifying the grounds of that contention.

(11) A respondent's notice shall be served on the comptroller and on the appellant and every other party to the proceedings before the comptroller within 14 days after receipt of notice of appeal by the respondent, or within such further time as the Court may direct.

(12) A party by whom a respondent's notice is given must within 5 days after service of the notice on the appellant, furnish 2 copies of the notice to the proper officer.

(13) The proper officer shall give to the comptroller and to the appellant and every other party to the proceedings before the comptroller not less than seven days' notice of the date appointed for the hearing of the appeal, unless the Court directs shorter notice to be given.

(14) An appeal shall be by way of rehearing and the evidence used on appeal shall be the same as that used before the comptroller and, except with the leave of the Court, no further evidence shall be given.

(15) The proper officer may exercise any of the powers of a Chancery registrar to draw up, pass and enter any judgment or order of the Court relating to an appeal from the comptroller.

(16) Any notice given in proceedings under this rule may be signed by or served on any patent agent, or member of the Bar of England and Wales not in actual practice, who is acting for the person giving the notice or, as the case may be, the person on whom the notice is to be served, as if the patent agent or member of the Bar were a solicitor.

(17) In this rule “proper officer” means the officer of the Chancery Division nominated for the purpose of this rule by the chief master.

(18) Nothing in Order 42, rule 7 (except paragraph (1)), Order 55 (except rule 7(2) and (3) and (5) to (7)) or Order 57 shall apply in relation to an appeal under this rule.

Communication of information to European Patent Office

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

(2) Before complying with a request for the disclosure of information under paragraph (1) the Court shall afford to any party appearing to be affected by the request the opportunity of making representations, in writing or otherwise, on the question whether the information should be disclosed.

Proceedings for determination of certain disputes

16.—(1) The following proceedings must be begun by originating motion, that is to say—

- (a) proceedings for the determination of any dispute referred to the Court under—
 - (i) section 48 of the 1949 Act or section 58 of the 1977 Act;
 - (ii) paragraph 3 of Schedule 1 to the Registered Designs Act 1949, or
 - (iii) section 4 of the Defence Contracts Act 1958;
- (b) any application under section 45(3) of the 1977 Act.

(2) There must be at least 10 clear days between the serving of notice of a motion under this rule and the day named in the notice for hearing the motion.

(3) On the hearing of a motion under this rule the Court shall give such directions for the further conduct of the proceedings as it thinks necessary or expedient and, in particular, directions for the service of particulars and as to the manner in which the evidence shall be given and as to the date of the hearing.

Application for rectification of register of patents or designs

17.—(1) An application to the Court for an order that the register of patents or the register of designs be rectified must be made by originating motion, except where it is made in a petition for the revocation of a patent or by way of counterclaim in proceedings for infringement or by originating summons in proceedings for an order under section 51 of the Trustee Act 1925.

(2) Where the application relates to the register of patents, the applicant shall forthwith serve an office copy of the application on the comptroller, who shall be entitled to appear and to be heard on the application.

Counterclaim for rectification of register of designs

18.—(1) Where in any proceedings a claim is made for relief for infringement of the copyright in a registered design, the party against whom the claim is made may in his defence put in issue the validity of the registration of that design or may counterclaim for an order that the register of designs be rectified by cancelling or varying the registration or may do both those things.

(2) A party to any such proceedings who in his pleading (whether a defence or counterclaim) disputes the validity of the registration of a registered design must serve with the pleading particulars of the objections to the validity of the registration on which he relies in support of the allegation of invalidity.

(3) A party to any such proceedings who counterclaims for an order that the register of designs be rectified must serve on the comptroller a copy of the counterclaim together with a copy of the particulars mentioned in paragraph (2); and the comptroller shall be entitled to take such part in the proceedings as he thinks fit but need not serve a defence or other pleading unless ordered to do so by the Court.”

13. In Forms 104 and 105 for “0.104”, wherever it appears, there shall be substituted “0.105”.