
STATUTORY INSTRUMENTS

1991 No. 1621 (S.145)

COURT OF SESSION, SCOTLAND

**Act of Sederunt (Rules of the Court of Session
Amendment No.7) (Patents Rules) 1991**

Made - - - - *9th July 1991*
Coming into force - - *1st August 1991*

The Lords of Council and Session, under and by virtue of the powers conferred on them by section 5 of the Court of Session Act 1988(1) and of all other powers enabling them in that behalf, do hereby enact and declare:

Citation and commencement

1.—(1) This Act of Sederunt may be cited as the Act of Sederunt (Rules of the Court of Session Amendment No.7) (Patents Rules) 1991 and shall come into force on 1st August 1991.

(2) This Act of Sederunt shall be inserted in the Books of Sederunt.

Amendment of Rules of the Court of Session

2. For Sections 9 and 9A of Chapter IV (rules 250 to 257J) of the Rules of the Court of Session(2), substitute the following Section and rules:—

“SECTION 9

CAUSES RELATING TO PATENTS, DESIGNS, COPYRIGHT AND TRADE MARKS

Application and Interpretation

250.—(1) This Section applies to any proceedings—

- (a) under the Act of 1938;
- (b) under the Act of 1949;
- (c) under the Registered Designs Act 1949(3);
- (d) under the Act of 1977;

(1) 1988 c. 36.

(2) S.I.1965/321; relevant amendments are S.I. 1978/955 and 1990/705.

(3) 1949 c. 88.

- (e) under the Act of 1988;
 - (f) under the Defence Contracts Act 1958⁽⁴⁾; or
 - (g) for the determination of a question relating to a patent under the inherent jurisdiction of the court.
- (2) In this Section—
- “the Act of 1938” means the Trade Marks Act 1938⁽⁵⁾;
 - “the Act of 1949” means the Patents Act 1949⁽⁶⁾;
 - “the Act of 1977” means the Patents Act 1977⁽⁷⁾;
 - “the Act of 1988” means the Copyright, Designs and Patents Act 1988⁽⁸⁾;
 - “the Comptroller” means the Comptroller-General of Patents, Designs and Trade Marks;
 - “existing patent” means a patent mentioned in section 127(2)(a) or (c) of the Act of 1977;
 - “the Journal” means the journal published in accordance with rules made under section 123(6) of the Act of 1977;
 - “patent” means an existing patent or a patent under the Act of 1977;
 - “patentee” has the meaning assigned to it in section 101(1) of the Act of 1949.

Patents judge

251. All proceedings in the Outer House in a cause to which this Section applies shall be brought before a judge of the court nominated by the Lord President as the patents judge or, where the patents judge is not available, any other judge of the court (including a vacation judge).

Pre-proof hearing

252.—(1) In a cause under the Act of 1949 or the Act of 1977, not later than 6 weeks after—

- (a) in a cause initiated by summons, the closing of the record, or
- (b) in a cause initiated by petition, the expiry of any period of adjustment allowed,

there shall be a pre-proof hearing on such date as the Keeper of the Rolls shall, subject to paragraph (2), fix.

(2) The Keeper of the Rolls shall consult the patents judge and the parties before fixing a date for a pre-proof hearing under paragraph (1) and shall, unless the parties otherwise agree, give 14 days' notice of such a date.

(3) Not less than 7 days before the pre-proof hearing, each party shall lodge in process, and send to every other party a notice of any issue sought to be raised on a preliminary plea against any other party.

(4) At a pre-proof hearing, the court shall consider—

(4) 1958 c. 38.
(5) 1938 c. 22.
(6) 1949 c. 87.
(7) 1977 c. 37.
(8) 1988 c. 48.

- (a) whether to direct that any issue of law or fact (including validity, infringement, an application for amendment of a patent under section 75 of the 1977 Act, damages or other remedies sought) should be determined separately from any other issue;
- (b) whether the cause should be appointed to the Procedure Roll for consideration of any preliminary plea, and may order—
 - (i) a party, whose plea is to be considered, to lodge in process a note of argument consisting of brief numbered paragraphs stating the grounds on which he proposes to submit that the preliminary plea should be sustained and to send a copy of it to every other party within a specified period; and
 - (ii) any other party to lodge in process a note of argument in reply and to send a copy of it to every other party, within a specified period thereafter; and
- (c) whether—
 - (i) to remit to the Patent Office for a report and what the terms of the remit should be;
 - (ii) to order a party to make available to any other party a copy of any documents;
 - (iii) to appoint an assessor or assessors;
 - (iv) a meeting of experts should be held for the purpose of producing a joint report on the general state of the art;
 - (v) to order each party to make available to every other party a copy of any precognitions, or reports, of skilled witnesses on any matter which is not the subject of a joint report under head (iv) and the time by which they are to be made available;
 - (vi) to order the advisers of the parties to meet for the purpose of agreeing and preparing a single paginated inventory of productions, and if necessary to fix a date by which this is to be done;
 - (vii) to make an order regulating the making of any experiment, inspection, test or report;
 - (viii) to fix a date by which a notice under rule 253 shall be served; and
 - (ix) to fix the time within which, notwithstanding rule 107, any production shall be lodged or within which any other step may be taken.
- (5) At a pre-proof hearing, the court may—
 - (a) continue the hearing to another date;
 - (b) without prejudice to paragraph (6), order a further pre-proof hearing on a specified date or a date to be afterwards fixed; or
 - (c) give such further directions as to the conduct of the cause as it considers appropriate.
- (6) The court may order a further pre-proof hearing at any time of its own motion or on the motion of any party.
- (7) Where a party intends to seek a particular order at a pre-proof hearing, he shall give written notice to the court and to every other party not less than 7 days before the hearing, of the order sought and the reason for seeking it.

Notices to admit and notices of non-admission

253.—(1) In a cause under the Act of 1949 or the Act of 1977, at any time after defences or answers have been lodged but not later than such date as has been fixed by the court at a

pre-proof hearing, a party may intimate on any other party to the cause a notice or notices calling on him to admit for the purposes of that cause only—

- (a) such facts relating to an issue averred in the pleadings as may be specified in the notice;
 - (b) that a particular document lodged in process and specified in the notice is—
 - (i) an original document;
 - (ii) where it is not a copy authenticated by the person making the copy, a true copy of an original document;
 - (iii) correct in the particular respects specified in the notice.
- (2) Where a party upon whom a notice has been served under paragraph (1)—
- (a) does not admit any of the facts specified in the notice; or
 - (b) does not admit, or desires to challenge, the authenticity or correctness of any document specified in the notice,

he shall, within 28 days after the date on which the notice under paragraph (1) was intimated on him intimate to the party intimating the notice on him a notice of non-admission to that effect.

(3) A party who fails to serve a notice of non-admission under paragraph (2) shall be deemed to have admitted the matters specified in the notice intimated under paragraph (1) unless the court, on special cause shown, otherwise directs.

(4) A party who intimates a notice of non-admission under paragraph (2) shall, unless the court otherwise directs, be liable to the party intimating the notice under paragraph (1) for the expenses of proving the matters specified in that notice if those matters are held by the court as established in evidence.

(5) The party lodging a notice under paragraph (1) or a notice of non-admission under paragraph (2) shall lodge a copy of it in process.

(6) An admission, or a deemed admission under paragraph (3), shall not be used against the party by whom it was made or deemed to be made other than in the cause for the purpose of which it was made or deemed to be made or in favour of any person other than the party by whom the notice was given under paragraph (1).

(7) The court may, at any time, allow a party to amend or withdraw an admission made by him on such conditions, if any, as it considers appropriate.

Applications for leave to amend specifications

254.—(1) A patentee or the proprietor of a patent intending to apply to the court under section 30 of the Act of 1949 or section 75 of the Act of 1977 (which provide for leave to amend specification) shall give notice of his intention to the Comptroller and at the same time deliver to him a form of advertisement—

- (a) identifying the proceedings depending before the court in which it is intended to apply for such leave;
- (b) giving particulars of the amendment sought;
- (c) stating the address of the applicant 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 that intention to the applicant and to the Deputy Principal Clerk.

- (2) On receipt of a form of advertisement under paragraph (1), the Comptroller shall cause the advertisement to be inserted once in the Journal.
- (3) A person who gives notice of intention to oppose the amendment in accordance with the advertisement shall be entitled to be heard on the application subject to any order of the court as to expenses.
- (4) Not later than 35 days after the appearance of the advertisement, the applicant shall make his application under section 30 of the Act of 1949⁽⁹⁾ or section 75 of the Act of 1977⁽¹⁰⁾, as the case may be, by motion intimated, together with a copy of the specification certified by the Comptroller and showing in coloured ink the amendment sought, to—
- (a) the Comptroller;
 - (b) every other party; and
 - (c) any person who has intimated his intention to oppose the amendment.
- (5) On enrolling a motion under paragraph (4), the applicant shall lodge in process—
- (a) a copy of the Journal containing the advertisement referred to in paragraph (2); or
 - (b) a certificate of publication by the publisher stating the date of publication and the text of the advertisement.
- (6) At the hearing of a motion under paragraph (4)—
- (a) where there is no opposition to the amendment sought, the court may—
 - (i) grant the application; or
 - (ii) make such order for further procedure as it considers necessary; or
 - (b) where there is opposition to the amendment sought, the court shall ordain the applicant to lodge a minute setting forth the grounds of his application within such period as the court considers reasonable, and allow any party or person opposing the amendment to lodge answers to the minute in process within a specified period thereafter.
- (7) Within 7 days after the expiry of the time for lodging answers under paragraph (6) (b), the applicant shall enrol a motion for an order for further procedure.
- (8) On a motion under paragraph (7), the court may—
- (a) grant the application;
 - (b) determine whether the motion shall be heard at the same time as the hearing of the depending cause relating to the patent in question or at a different time;
 - (c) determine the manner in which evidence shall be given and, if the evidence is to be given by affidavits, the period within which the affidavits must be lodged; or
 - (d) make such other order for further procedure as it considers necessary.
- (9) Where the court allows the specification to be amended, the applicant shall forthwith—
- (a) lodge with the Comptroller a certified copy of the interlocutor; and
 - (b) if so required by the court or the Comptroller, leave at the Patent Office a new specification and drawings as amended, prepared in compliance with the Act of 1949 or the Act of 1977, as the case may be, and any rules made under either of those Acts.
- (10) On receiving the certified copy interlocutor under paragraph (9), the Comptroller shall cause it to be inserted at least once in the Journal.

⁽⁹⁾ 1949 c. 87.

⁽¹⁰⁾ 1977 c. 37.

Applications for revocation of patents

255.—(1) Subject to paragraph (2), an application under section 72 of the Act of 1977⁽¹¹⁾ (revocation of a patent) shall be made by petition presented in the Outer House.

(2) Where an action is depending before the court between the same parties in relation to the patent in question, such an application may be made by counterclaim in that action; and rule 84 shall apply to any such counterclaim.

Proceedings for infringement

256.—(1) In any cause where it is alleged that a patent has been infringed, the person alleging infringement must aver in the petition or summons, as the case may be, particulars of the infringement relied on, showing which of the claims in the specification of the patent are alleged to have been infringed and giving at least one instance of each type of infringement alleged.

(2) Where, as a defence to such an allegation, it is averred that at the time of the infringement there was in force a contract or licence relating to the patent—

- (a) made by or with the consent of the person alleging the infringement, and
- (b) containing a condition or term void by virtue of section 44 of the Act of 1977,

the person stating that defence must aver particulars of, the date of, and the parties to, each such contract or licence and particulars of each such condition or term.

Objections to validity of patent

257.—(1) A person who—

- (a) presents a petition under section 32 of the Act of 1949⁽¹²⁾ or makes an application under section 72 of the Act of 1977 for revocation of a patent, or
 - (b) being a party to an action relating to a patent—
 - (i) challenges the validity of the patent, or
 - (ii) applies by counterclaim in an action for revocation of the patent,
- shall aver the grounds on which the validity of the patent is challenged.

(2) Where the grounds in respect of which averments are required under paragraph (1) include—

- (a) want of novelty, or
- (b) want of any inventive step,

the averments shall include the matters specified in paragraph (3).

(3) The matters referred to in paragraph (2) are—

- (a) the manner, time and place of every prior publication or use relied on; and
- (b) where prior use is alleged—
 - (i) specification of the name of every person alleged to have made such use;
 - (ii) an averment as to whether such use is alleged to have continued until the priority date of the claim in question or of the invention, as the case may be, and, if not, the earliest and latest date on which such use is alleged to have taken place;

⁽¹¹⁾ Section 72 was amended by the Act of 1988 (c. 48), Schedule 5, paragraph 18 and Schedule 8.

⁽¹²⁾ Section 32 of the Act of 1949 was amended by Schedule 6 to the Act of 1977, and is to be read subject to section 127 and Schedule 1, paragraph 6 of that Act.

- (iii) a description accompanied, if necessary, by drawings sufficient to identify such use; and
- (iv) if such use relates to machinery or apparatus, an averment as to whether the machinery or apparatus is in existence and where it can be inspected.

(3) Where, in the case of an existing patent—

- (a) one of the grounds on which the validity of the patent is challenged 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 averments shall specify that fact and identify each such claim and shall 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.

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

257A. Where the Comptroller—

- (a) declines to deal with a question under the following sections of the Act of 1977:—
 - (i) section 8 (entitlement to patents, etc.),
 - (ii) section 12 (entitlement to foreign and convention patents),
 - (iii) section 37(**13**) (right to patent after grant), or
 - (iv) section 61(3) (infringement of patent),
- (b) declines to deal with an application under section 40 of that Act (compensation of employees for certain inventions), or
- (c) issues a certificate under section 72(7)(b) of that Act (revocation of patent should be determined by the court),

any person entitled to do so may, within 28 days after the decision of the Comptroller, apply by petition presented in the Outer House to have the question or application, as the case may be, determined by the court.

Applications by employees for compensation under section 40 of the Act of 1977

257B.—(1) An application under section 40(1) or (2) of the Act of 1977 (compensation of employees for certain inventions) shall be made by summons commenced within the period which begins when the relevant patent is granted and which expires one year after it has ceased to have effect.

(2) 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 of that fee and an application is made to the Comptroller under section 28 of the Act of 1977(**14**) (restoration of lapsed patent), the period within which the application by summons is to be made shall—

- (a) if restoration is ordered, continue as if the patent has remained continuously in effect; or
- (b) if restoration is refused, be treated as if expiring one year after the patent ceased to have effect or 6 months after the refusal, whichever is the later.

(13) Section 37 of the Act of 1977 was amended by the Act of 1988, Schedule 5, paragraph 9.

(14) Section 28 of the Act of 1977 was amended by the Act of 1988, Schedule 5, paragraph 6 and Schedule 8.

Proceedings for determination of certain disputes

257C. A reference or application under the following enactments shall be made by petition presented in the Outer House:—

- (a) a reference under—
 - (i) section 48 of the Act of 1949 or section 58(15) of the Act of 1977 (which provide for disputes as to Crown use);
 - (ii) paragraph 3 of Schedule 1 to the Registered Design Act 1949(16), disputes as to Crown use);
 - (iii) section 4 of the Defence Contracts Act 1958(17) (payments for use and determination of disputes); or
 - (iv) section 251(1) (design right matters), or section 252(1) (disputes as to Crown use), of the Act of 1988(18);
- (b) an application under section 45(3) of the Act of 1977 (variation of certain contracts).

Applications for rectification of Register of Designs or Patents

257D.—(1) Subject to paragraph (2), an application under section 20(1) of the Registered Designs Act 1949 (rectification of Register of Designs) or section 34(1) of the Act of 1977 (rectification of Register of Patents) shall be made by petition presented in the Outer House.

(2) Where an action for infringement of a patent is depending before the court, such an application may be made by a counterclaim in that action.

(3) In an application under section 34(1) of the Act of 1977, the applicant shall intimate the application to the Comptroller, who may lodge answers in process and be heard on the application.

Counterclaim for rectification of Register of Designs

257E.—(1) Where, in any cause, an infringement of the copyright in a registered design is alleged, the party against whom the allegation is made may—

- (a) put in issue the validity of the registration of that design;
- (b) counterclaim for an order that the Register of Designs be rectified by cancelling or varying the registration; or
- (c) put in issue such validity and make such a counterclaim.

(2) A party to any such cause who counterclaims for an order that the Register of Designs be rectified shall intimate to the Comptroller a copy of the counterclaim; and the Comptroller may, or (if ordered to do so by the court) shall, lodge answers in process and be heard in any such cause.

Appeals from Comptroller

257F.—(1) Subject to the following paragraphs of this rule, an appeal under the Act of 1949, the Act of 1977 or the Act of 1988 from a decision of the Comptroller shall be heard by the patents judge.

(15) Section 58 of the Act of 1977 was amended by the Act of 1988, Schedule 5, paragraph 16(2) and (3).

(16) 1949 c. 88; paragraph 3 of Schedule 1 was amended by the Act of 1988, Schedule 3, paragraph 37(3) and Schedule 8. The text of the Registered Designs Act 1949 as amended is set out in Schedule 4 to the Act of 1988.

(17) 1958 c. 38.

(18) 1988 c. 48.

(2) Rule 290 shall apply to any such appeal as if it were an appeal under that rule, with the substitution for references to the Inner House of references to the Outer House and for references to the single bills of references to the Motion Roll.

(3) Subject to paragraph (4), an appeal shall be lodged in the General Department—

(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 6 weeks after the date of the decision.

(4) Except with leave of the court, no appeal under this rule shall be entertained unless it has been lodged within the period specified in paragraph (3) or within such further period as the Comptroller may allow on an application made to him before the expiry of that period.

(5) Any determination by the Comptroller that a decision is on a matter of procedure shall be treated as being itself a decision on a matter of procedure.

(6) Intimation under rule 290(e) shall be ordered to be made to the Comptroller and to every other party to the proceedings before the Comptroller.

(7) On receiving intimation of the appeal, the Comptroller shall forthwith transmit to the Deputy Principal Clerk all the papers relating to the matter which is the subject of the appeal.

(8) A respondent who, not having appealed from the decision of the Comptroller, wishes to contend at the hearing of the appeal that the decision or the grounds of the decision should be varied shall—

(a) specify the grounds of that contention in his answers; and

(b) intimate those answers to the Comptroller and to every other party to the proceedings before the Comptroller.

(9) Intimation of the date of the hearing of the appeal shall be made to the Comptroller by the appellant not less than 7 days before that date, unless the court otherwise directs.

(10) An appeal under this rule shall be a re-hearing and the evidence led on appeal shall be the same as that led before the Comptroller; and, except with the leave of the court, no further evidence shall be led.

Intimation to Comptroller of reclaiming motion

257G. The marking of a reclaiming motion from a decision of the patent judge on an appeal from a decision of the Comptroller shall be intimated by the claimer to the Comptroller as well as to the other parties to the appeal.

Communication of information to European Patent Office

257H.—(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(19) of any such information in the records of the court as the court considers appropriate.

(2) An application for such information shall be made by letter addressed to the Deputy Principal Clerk.

(3) Before complying with an application for the disclosure of information under paragraph (1), any person appearing to be affected by the application shall be given the opportunity of making representations to the patents judge in chambers on the question whether the information should be disclosed; and the decision of the patents judge shall be final and not subject to review.

(4) In this rule, “the European Patent Convention” has the meaning assigned in section 130(1) and (6) of the Act of 1977⁽²⁰⁾.

Applications under the Act of 1938 and the Act of 1988

257I.—(1) An application under section 99, 195 or 230 of the Act of 1988⁽²¹⁾ (which provide for orders for delivery in respect of infringement of copyright, rights in performances and design rights) shall be made—

- (a) in a cause depending before the court, by motion; or
- (b) where there is no depending cause, by petition presented in the Outer House.

(2) An application under section 114, 204 or 231 of the Act of 1988 (which provide for orders for disposal in respect of infringement of copyright, rights in performances and design rights) shall be made—

- (a) in a cause depending before the court, by motion; or
- (b) where there is no depending cause, by petition presented in the Outer House; and

the applicant shall intimate the application to all persons, so far as known to the petitioner or reasonably ascertainable, having an interest in the copy, article, recording or other thing which is the subject of the application, including any person in whose favour an order could be made in respect of the copy, article, recording or other thing under any of the said sections of the Act of 1988 or section 58C of the Act of 1938⁽²²⁾ (order for disposal in respect of infringement of trademarks).

(3) An application under section 58C of the Act of 1938 shall be made by petition presented in the Outer House and the petitioner shall intimate the petition to all persons, so far as known to the petitioner or reasonably ascertainable, having an interest in the goods or material which are the subject of the application, including any person in whose favour an order could be made in respect of the goods or material under that section or section 114, 204 or 231 of the Act of 1988.

Applications for leave to proceed

257J.—(1) Where leave of the court is required under the Act of 1988 before an action may proceed, the pursuer shall apply by motion for leave to proceed before the summons is signeted.

(2) A motion under paragraph (1) shall be heard in chambers.

(3) Where such leave is granted, a copy of the interlocutor allowing leave shall be attached to the copy of the summons served on the defender.

Assessors

257K. In any proceedings before the patents judge, the number of assessors to be summoned, if any, shall be such as the court considers appropriate.”.

Repeal

3. Section 103(2) of the Patents Act 1949 (proceedings for revocation of a patent in Scotland)⁽²³⁾ is hereby repealed.

⁽²⁰⁾ 1977 c. 37.

⁽²¹⁾ 1988 c. 48.

⁽²²⁾ 1938 c. 22; section 58C was inserted by section 300 of the Act of 1988.

⁽²³⁾ 1949 c. 87.

Edinburgh
9th July 1991

J.A.D. Hope
Lord President, IPD

Status: This is the original version (as it was originally made). This item of legislation is currently only available in its original format.

EXPLANATORY NOTE

(This note is not part of the Act of Sederunt)

This Act of Sederunt amends the Rules of the Court of Session to make new rules for causes relating to Patents, Designs, Copyright and Trade Marks. In particular it introduces, in relation to causes relating to patents, a pre-proof hearing at which the court will consider the future progress of the case. It also repeals section 103(2) of the Patents Act 1949 so that (a) an application to the Court of Session for revocation of a patent under the Act of 1949 or under the Patents Act 1977 shall in either case be by petition and (b) the current rules for service shall apply to such a petition.