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SCOTTISH STATUTORY INSTRUMENTS

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**2012 No. 275**

**Act of Sederunt (Rules of the Court of Session  
Amendment No. 5) (Miscellaneous) 2012**

**Causes relating to intellectual property**

**3.—**(1) The Rules are amended in accordance with the following subparagraph.

(2) In rule 55.1 (application and interpretation of Chapter 55)(1)—

(a) in paragraph (1), after subparagraph (h), insert—

“or

(i) involving a claim for passing off.”;

(b) in paragraph (2), in the appropriate places insert the following definitions—

““intellectual property cause” means a cause to which this Chapter applies and, except where the context otherwise requires, “cause” means an intellectual property cause;

“intellectual property judge” means a judge nominated as such in accordance with rule 55.2 and, except where the context otherwise requires, “judge” means an intellectual property judge or such other judge before whom proceedings are brought in accordance with rule 55.2;

“preliminary hearing” means a hearing under rule 55.2E;

“procedural hearing” means a hearing under rule 55.3.”.

(3) For rule 55.3 (procedural hearings)(2) substitute—

**“Disapplication of certain rules**

**55.2B.—**(1) The requirement in rule 4.1(4) for a step of process to be folded lengthwise does not apply in a cause to which this Chapter applies.

(2) An open record shall not be made up in, and Chapter 22 (making up and closing records) shall not apply to, an intellectual property cause initiated by summons unless otherwise ordered by a judge.

(3) The following rules shall not apply to an intellectual property cause—

rule 6.2 (fixing and allocation of diets in Outer House),

rule 14.8 (procedure where answers lodged),

rule 25.1(3) (form of counterclaim),

rule 25.2(1) (authority for diligence etc. on counterclaims),

rule 36.3 (lodging productions).

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(1) Rule 55.1 was substituted by [S.I. 1996/1756](#).

(2) Rule 55.3 was substituted by [S.I. 1991/1621](#).

### **Procedure in intellectual property causes**

**55.2C.**—(1) Subject to the other provisions of this Chapter, the procedure in an intellectual property cause shall be such as the judge shall order or direct.

(2) All proceedings in an intellectual property cause shall, in the Outer House, be heard and determined on such dates and at such times as shall be fixed by the judge.

(3) The fixing of a hearing for a specified date in an intellectual property cause shall not affect the right of any party to apply by motion at any time under these Rules.

### **Pleadings in intellectual property causes**

**55.2D.**—(1) In an intellectual property cause, the following paragraphs apply without prejudice to any specific requirements laid down elsewhere in this Chapter.

(2) A summons in such a cause shall—

- (a) specify, in the form of conclusions, the orders sought;
- (b) identify the parties to the action and the transaction or dispute from which the action arises;
- (c) specify any special capacity in which the pursuer is bringing the action or any special capacity in which the action is brought against the defender;
- (d) summarise the circumstances out of which the action arises; and
- (e) set out the grounds on which the action proceeds.

(3) A petition in such a cause shall specify, in the prayer of the petition, the orders sought and shall provide the same information as is specified in paragraph (2)(b) to (e) of this rule in relation to a summons.

(4) Defences (to a summons) and answers (to a petition) shall be in the form of answers to the summons or petition (as the case may be) with any additional statement of facts or legal grounds on which the defender or respondent intends to rely.

(5) A party seeking to lodge a counterclaim or serve a third party notice shall apply by notice to do so.

(6) The judge shall, on a motion to lodge a counterclaim or to serve a third party notice, make such order and give such directions as he thinks fit with regard to—

- (a) the time within which a counterclaim may be lodged or a third party notice served and any answers lodged;
- (b) where the motion is made before the preliminary hearing, a date for the preliminary hearing if it is to be a date other than the date referred to in rule 55.2E(1);
- (c) any application for a warrant to use any form of diligence which would have been permitted under rule 14A.2 (application for interim diligence) had the warrant been sought in a summons in a separate action.

(7) Paragraph (2) of this rule shall apply to the form of a counterclaim as it applies to a summons.

(8) There shall be appended to any pleadings referred to in this rule a schedule listing the documents founded on or adopted as incorporated therein, which should also be lodged as an inventory of productions.

### **Preliminary hearings**

**55.2E.**—(1) An intellectual property cause shall call for a preliminary hearing within 14 days after defences or answers (as the case may be) have been lodged.

- (2) At the preliminary hearing, the judge—
- (a) shall determine whether, to what extent and in what manner further specification of the claim and defences or answers should be provided;
  - (b) may—
    - (i) order a party to make detailed written pleadings, either generally or in relation to particular issues;
    - (ii) order one or more parties to make a statement of facts, either generally or in relation to particular issues;
    - (iii) allow a party to make an amendment to his pleadings;
    - (iv) order disclosure of the identity of witnesses and the existence and nature of documents relating to the cause or authority to recover documents, either generally or in relation to specific matters;
    - (v) order any party to lodge in process within a specified period documents constituting, evidencing or relating to the subject-matter of the cause or any invoices, correspondence or similar documents relating to it;
    - (vi) order each party to lodge in process, and send to every other party, a list of witnesses;
    - (vii) order any party to lodge in process reports of skilled persons or witness statements;
    - (viii) order any party to lodge in process affidavits relating to any of the issues in the cause;
    - (ix) except as provided for elsewhere in these Rules, order the cause to proceed to a hearing without any further preliminary procedure either in relation to the whole or any particular aspect of the cause;
  - (c) may fix the period within which any order under subparagraph (b) shall be complied with;
  - (d) may continue the preliminary hearing to a date to be appointed by him; and
  - (e) may make such other order as he thinks fit for the speedy determination of the cause.
- (3) In an intellectual property cause the judge may ordain the pursuer to—
- (a) make up a record; and
  - (b) lodge that record in process within such period as he thinks fit.
- (4) At the conclusion of the preliminary hearing, the judge shall, unless he has made an order under paragraph (2)(b)(ix) (order to proceed without a further hearing), fix a date for a procedural hearing to determine further procedure.
- (5) The date fixed under paragraph (4) for a procedural hearing may be extended on cause shown by application to the court, by motion, not less than two days prior to the date fixed for the procedural hearing.

### **Procedural hearings**

**55.3.**—(1) In an intellectual property cause, not less than 3 days, or such other period as may be prescribed by the judge at the preliminary hearing, before the date fixed under rule 55.2E(4) for the procedural hearing, each party shall lodge in process and send to every other party—

- (a) a written statement of his proposals for further procedure which shall state—
  - (i) whether he seeks to have any issue of law or fact (including validity, infringement, an application for amendment of a patent under section 75 of the

- Act of 1977, damages or other remedies sought) to be determined separately from any other issue;
- (ii) whether he seeks to have the cause appointed to debate or to have the cause sent to proof on the whole or any part of it;
  - (iii) what the issues are which he considers should be sent to debate or proof; and
  - (iv) the estimated duration of any debate or proof;
- (b) where it is sought to have the cause appointed to proof, a list of the witness which the party proposes to cite or call to give evidence, identifying the matters to which each witness will speak;
  - (c) where it is sought to have the cause appointed to proof, the reports of any skilled persons he proposes to call to give evidence;
  - (d) where it is sought to have the cause appointed to debate, a note of argument consisting of concise numbered paragraphs stating the legal propositions on which it is proposed to submit that any preliminary plea should be sustained or repelled, with reference to the principal authorities and statutory provisions to be founded on; and
  - (e) where it is sought to have any particular order made at a procedural hearing, a note giving written intimation of the order sought and the reason for seeking it.
- (2) At the procedural hearing, the judge—
- (a) shall determine 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 Act of 1977, damages or other remedies sought) should be determined separately from any other issue;
  - (b) shall determine whether the cause should be appointed to debate or to proof on the whole or any part of it;
  - (c) shall determine whether to remit to the Patent Office for a Report and what the terms of the remit should be;
  - (d) where the cause is appointed to debate, or is sent to proof, may order that written arguments on any question of law should be submitted;
  - (e) where the cause is sent to proof, may determine whether evidence at the proof should be by oral evidence, the production of documents or affidavits on any issue;
  - (f) where the cause is sent to proof, may direct that parties serve on one another and lodge in process signed witness statements or affidavits from each witness whose evidence they intend to adduce, setting out in full the evidence which it is intended to take from that witness, and fix a timetable for the service (whether by exchange or otherwise) and lodging of such statements or affidavits as may be thought necessary;
  - (g) may direct that such witness statements or affidavits shall stand as evidence in chief of the witness concerned, subject to such further questioning in chief as the judge may allow;
  - (h) where the cause is sent to proof, may appoint parties to be heard By Order at a date prior to the proof date;
  - (i) may make an order regulating the making of any experiment, inspection, test or report;
  - (j) may make an order restricting the number or disciplines of expert witnesses to be called by each party;
  - (k) may direct that skilled persons should meet with a view to reaching agreement and identifying areas of disagreement, and may order them thereafter to produce a joint

note, to be lodged in process by one of the parties, identifying areas of agreement and disagreement, and the basis of any disagreement;

- (l) may determine, in the light of any witness statements, affidavits or reports produced, that proof is unnecessary on any issue;
- (m) without prejudice to Chapter 12 (assessors), may appoint an expert to examine, on behalf of the court, any reports of skilled persons or other evidence submitted and to report to the court within such period as the judge may specify;
- (n) may remit an issue to a person of skill appointed by the court;
- (o) may fix a date by which, notwithstanding rule 36.3 (lodging productions for proofs) any documents intended to be relied on by a party shall be lodged in process or, if more appropriate, be intimated to all other parties with a view to those documents being lodged in process as part of an agreed bundle of documents;
- (p) may make an order for parties to produce a joint bundle of productions arranged in chronological order or such other order as will assist in the efficient conduct of the proof;
- (q) may fix a date by which a notice under rule 55.4 (notice to admit and notices of non-admission) shall be served;
- (r) where the cause is sent to proof, may make an order fixing the time allowed for the examination and cross-examination of witnesses;
- (s) may, on the motion of a party, direct the cause to be determined on the basis of written submissions, or such other material, without any oral hearing;
- (t) may continue the procedural hearing to a date to be appointed by the judge;
- (u) may order and fix a date for a further procedural hearing or fix a date for the hearing of any debate or proof; and
- (v) may make such other order as the judge thinks fit.

(3) Chapter 28 (procedure roll) shall apply to a debate ordered in an intellectual property cause under this rule as it applies to a cause appointed to the Procedure Roll.

### **Pre-proof By Order**

**55.3A.** Not less than two days prior to any hearing appointed under rule 55.3(2)(h) parties shall lodge in process an estimated timetable for the conduct of the proof together with a note of any issues which are to be addressed prior to the proof.”

(4) In rule 55.4 (notices to admit and notices of non-admission), for “In a cause under the Act of 1949 or the Act of 1977” substitute “In an intellectual property cause”.

(5) After rule 55.5 (applications for leave to amend specifications) insert—

### **“Hearings for further procedure**

**55.5B.** At any time before final judgment, the intellectual property judge may, at his own instance or on the motion of any party, have an intellectual property cause put out for hearing for further procedure; and the intellectual property judge may make such order as he thinks fit.

### **Failure to comply with rule or order of intellectual property judge**

**55.5C.** Any failure by a party to comply timeously with a provision in these Rules or any order made by the intellectual property judge in an intellectual property cause shall entitle the judge, at his own instance—

- (a) to refuse to extend any period for compliance with a provision in these Rules or an order of the court;
- (b) to dismiss the cause or counterclaim, as the case may be, in whole or in part;
- (c) to grant decree in respect of all or any of the orders sought; or
- (d) to make an award of expenses,

as he thinks fit.”.

- (6) In rule 55.6 (applications for revocation of patents), for paragraph (2) substitute—

“(2) Where a cause 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 cause in accordance with rule 55.2D (pleadings in intellectual property causes).”.

- (7) In rule 55.12 (applications for rectification of Register of Designs or Patents), for paragraph (2) substitute—

“(2) Where a cause for infringement of a patent is depending before the court, an application mentioned in paragraph (1) may be made by counterclaim in that cause in accordance with rule 55.2D (pleadings in intellectual property causes).”.

- (8) In rule 55.13 (counterclaim for rectification of Register of Designs)—

- (a) in paragraph (1), omit “the copyright in”;
- (b) for paragraph (3), substitute—

“(3) Such a counterclaim shall be made in accordance with rule 55.2D (pleadings in intellectual property causes).”.