

2002 No. 3219 (L.18)

SUPREME COURT OF ENGLAND AND WALES COUNTY COURTS, ENGLAND AND WALES

The Civil Procedure (Amendment No. 2) Rules 2002

Made - - - - - *14th December 2002*

Laid before Parliament *24th December 2002*

Coming into force *1st April 2003*

The Civil Procedure Rule Committee, having power under section 2 of the Civil Procedure Act 1997(a) to make rules of court under section 1 of that Act, after consulting in accordance with section 2(6)(a) of that Act, make the following Rules—

Citation, commencement and interpretation

1. These Rules may be cited as the Civil Procedure (Amendment No. 2) Rules 2002 and shall come into force on 1st April 2003.

2. In these Rules a reference to a Part or rule by number alone means the Part or rule so numbered in the Civil Procedure Rules 1998(b).

Amendments to the Civil Procedure Rules 1998

3. In rule 25.13(2)—

(a) for sub-paragraph (a) substitute—

“(a) the claimant is—

(i) resident out of the jurisdiction; but

(ii) not resident in a Brussels Contracting State, a Lugano Contracting State or a Regulation State, as defined in section 1(3) of the Civil Jurisdiction and Judgments Act 1982(c);”;

(b) omit sub-paragraph (b).

4. In rule 36.6—

(a) for paragraph (3) substitute—

“(3) The offeror must—

(a) serve the Part 36 payment notice on the offeree; and

(b) file a certificate of service of the notice.”; and

(b) omit paragraph (4).

5. In rule 37.1, for paragraph (1) substitute—

(a) 1997 c. 12.

(b) S.I. 1998/3132. There are relevant amendments in S.I. 2000/221, S.I. 2001/356, S.I. 2001/4015 and S.I. 2002/2058.

(c) 1982 c. 27, as amended by the Civil Jurisdiction and Judgments Act 1991 (c. 12) and by S.I. 1989/1346, S.I. 1990/2591, S.I. 1993/603, S.I. 2000/1824 and S.I. 2001/3929.

- “(1) A party who makes a payment into court under a court order must—
(a) serve notice of the payment on every other party; and
(b) in relation to each such notice, file a certificate of service.”.
6. In Part 49, in paragraph (2), omit sub-paragraph (d).
7. In rule 56.4—
(a) at the end of sub-paragraph (c) omit “and”; and
(b) after sub-paragraph (d) insert—
“; and
(e) the Commonhold and Leasehold Reform Act 2002(a)”.
8. After Part 62, insert Part 63 (Patents and other Intellectual Property Claims) as set out in the Schedule to these Rules.

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I allow these Rules

Dated 14th December 2002

Irvine of Lairg, C.

(a) 2002 c. 15.

SCHEDULE

Rule 8

PART 63

PATENTS AND OTHER INTELLECTUAL PROPERTY CLAIMS

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Scope of this Part and interpretation

63.1(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 the practice direction.

(2) In this Part—

- (a) “the 1977 Act” means the Patents Act 1977(a);
- (b) “the 1988 Act” means the Copyright, Designs and Patents Act 1988(b);
- (c) “the 1994 Act” means the Trade Marks Act 1994(c);
- (d) “the Comptroller” means the Comptroller General of Patents, Designs and Trade Marks;

(a) 1977 c. 37.

(b) 1988 c. 48.

(c) 1994 c. 26.

- (e) “patent” means a patent under the 1977 Act and includes any application for a patent or supplementary protection certificate granted under—
 - (i) the Patents (Supplementary Protection Certificates) Rules 1997(a);
 - (ii) the Patents (Supplementary Protection Certificate for Medicinal Products) Regulations 1992(b); and
 - (iii) the Patents (Supplementary Protection Certificate for Plant Protection Products) Regulations 1996(c);
- (f) “Patents Court” means the Patents Court of the High Court constituted as part of the Chancery Division by section 6(1) of the Supreme Court Act 1981(d);
- (g) “Patents County Court” means a county court designated as a Patents County Court under section 287(1) of the 1988 Act;
- (h) “the register” means whichever of the following registers is appropriate—
 - (i) patents maintained by the Comptroller under section 32 of the 1977 Act;
 - (ii) designs maintained by the registrar under section 17 of the Registered Designs Act 1949(e);
 - (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) 40/94(f); and
 - (v) Community designs maintained by the Office for Harmonisation in the Internal Market under Article 72 of Council Regulation (EC) 6/2002(g); and
- (i) “the registrar” means—
 - (i) the registrar of trade marks; or
 - (ii) the registrar of registered designs,
 whichever is appropriate.

Application of the Civil Procedure Rules

63.2 These Rules and their practice directions apply to intellectual property claims unless this Part or a practice direction provides otherwise.

I PATENTS AND REGISTERED DESIGNS

Scope of Section I

- 63.3(1) This Section of this Part applies to claims in—
 - (a) the Patents Court; and
 - (b) a Patents County Court.
- (2) Claims in the court include any claim relating to matters arising out of—
 - (a) the 1977 Act;
 - (b) the Registered Designs Act 1949; and
 - (c) the Defence Contracts Act 1958(h).

Specialist list

63.4 Claims in the Patents Court and a Patents County Court form specialist lists for the purpose of rule 30.5.

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- (a) S.I. 1997/64.
 - (b) S.I. 1992/3091.
 - (c) S.I. 1996/3120.
 - (d) 1981 c. 54.
 - (e) 1949 c. 88.
 - (f) OJ No. L11, 14.1.1994, p 1.
 - (g) OJ No. L3, 5.1.2002, p 1.
 - (h) 1958 c. 38.

Starting the claim

63.5 Claims to which this Section of this Part applies must be started—

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

Defence and reply

63.6 Part 15 applies with the modification—

- (a) to rule 15.4 that in a claim for infringement under rule 63.9, the defence must be filed within 42 days of service of the claim form; and
- (b) to rule 15.8 that the claimant must—
 - (i) file any reply to a defence; and
 - (ii) serve it on all other parties,within 21 days of service of the defence.

Case management

63.7(1) Claims under this Section of this Part are allocated to the multi-track.

(2) Part 26 and any other rule that requires a party to file an allocation questionnaire do not apply.

(3) The following provisions only of Part 29 apply—

- (a) rule 29.3(2) (legal representatives to attend case management conferences and pre-trial reviews);
- (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 rule 29.5(1)(c).

(4) As soon as practicable the court will hold a case management conference which must be fixed in accordance with the practice direction.

Disclosure and inspection

63.8 Part 31 is modified to the extent set out in the practice direction.

Claim for infringement and challenge of validity

63.9(1) In a claim for infringement or an application in which the validity of a patent or registered design is challenged, the statement of case must contain particulars as set out in the practice direction.

(2) In a claim for infringement, the period for service of the defence or Part 20 claim is 42 days after service of the claim form.

Application to amend a patent specification in existing proceedings

63.10(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 amendment are valid; and
 - (c) be served by the applicant on all parties and the Comptroller within 7 days of its issue.
- (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 forthwith 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 made under section 123(6) of the 1977 Act.

Court’s determination of question or application

63.11 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,

any person seeking the court’s determination of that question or application must issue a claim form within 14 days of the Comptroller’s decision.

Application by employee for compensation

63.12(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) and (3).

(2) The prescribed period begins on the date of the grant of the patent and ends one year after the patent has ceased to have effect.

(3) Where a patent has ceased to have effect as a result of failure to pay the renewal fees within the period prescribed under rule 39 of the Patents Rules 1995(a), and an application for restoration is made to the Comptroller under section 28 of the 1977 Act, the period prescribed under paragraph (2)—

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

II REGISTERED TRADE MARKS AND OTHER INTELLECTUAL PROPERTY RIGHTS

Allocation

63.13(1) This Section of this Part applies to—

- (a) claims relating to matters arising out of the 1994 Act; and
- (b) other intellectual property rights as set out in the practice direction.

(2) Claims under the 1994 Act must be brought in the Chancery Division.

(3) Other claims to which this Section of this Part applies must be brought in—

(a) S.I. 1995/2093.

- (a) the Chancery Division;
- (b) a Patents County Court; or
- (c) a county court where there is also a Chancery district registry.

Claims under the 1994 Act

63.14 In a claim under the 1994 Act, the claim form or application notice must be served on the registrar where the relief sought would, if granted, affect an entry in the United Kingdom register.

Claim for infringement of registered trade mark

63.15(1) In a claim for infringement of a registered trade mark the defendant may—

- (a) in his defence, challenge the validity of the registration of the trade mark; and
- (b) apply by Part 20 claim for—
 - (i) revocation of the registration;
 - (ii) a declaration that the registration is invalid; or
 - (iii) rectification of the register.

(2) Where a defendant applies under paragraph (1)(b) and the relief sought would, if granted, affect an entry in the United Kingdom register, he must serve on the registrar a copy of his claim form.

III SERVICE

Service

63.16(1) Part 6 applies to service of a claim form and any document under this Part.

(2) A claim form relating to a registered right may be served in accordance with rule 6.19(1) or (1A) at the address for service given for that right in the appropriate register at—

- (a) the United Kingdom Patent Office; or
- (b) the Office for Harmonisation in the Internal Market.

IV APPEALS

Appeals from the Comptroller

63.17(1) Part 52 applies to appeals from the Comptroller.

(2) Patent appeals are to 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.

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules insert into the Civil Procedure Rules 1998, as Part 63, new rules governing the procedure for intellectual property rights, in particular patents, registered designs and registered trade marks. They supersede the provisions in Practice Direction 49E.

The opportunity has been taken to make the following minor amendments to the rules currently in force:

- to rule 25.13 (security for costs where the claimant is resident out of the jurisdiction and not in a convention state) to comply with the judgment of the Court of Appeal in *De Beer v. Kanaar & Co.*;
- to rules 36.6 and 37.1, in anticipation of changes to the rules governing payments into court; and
- to rule 56.4 (miscellaneous provisions about land).

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