

STATUTORY INSTRUMENTS

1998 No. 3132

The Civil Procedure Rules 1998

[^{F1}PART 63 **E+W**

INTELLECTUAL PROPERTY CLAIMS

[^{F1}1 PATENTS AND REGISTERED DESIGNS

Textual Amendments

- F1** Pt. 63 substituted (1.10.2009) by [The Civil Procedure \(Amendment\) Rules 2009 \(S.I. 2009/2092\)](#), rule 1(2), [Sch. 1](#)

Scope of Section I and allocation **E+W**

- 63.2.**—(1) This Section applies to—
- (a) any claim under—
 - (i) the 1977 Act;
 - (ii) the Registered Designs Act 1949;
 - (iii) the Defence Contracts Act 1958; and
 - (b) any claim relating to—
 - ^{F2}(i)
 - (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) [^{F3}the Intellectual Property Enterprise Court].

Textual Amendments

- F2** Rule 63.2(1)(b)(i) omitted (31.12.2020) by virtue of [The Civil Procedure Rules 1998 \(Amendment\) \(EU Exit\) Regulations 2019 \(S.I. 2019/521\)](#), regs. 1(1), **13(3)** (with reg. 24) (as amended by S.I. 2020/1493, regs. 1(1), 9(2)(g); 2020 c. 1, Sch. 5 para. 1(1)
- F3** Words in rule 63.2(2)(b) substituted (1.10.2013) by [The Civil Procedure \(Amendment No.7\) Rules 2013 \(S.I. 2013/1974\)](#), rules 2, **26(d)**

Specialist list **E+W**

63.3. Claims in the Patents Court^{F4} form a specialist list] for the purpose of rule 30.5.

Textual Amendments

F4 Words in rule 63.3 substituted (1.10.2013) by [The Civil Procedure \(Amendment No.7\) Rules 2013 \(S.I. 2013/1974\)](#), rules 2, **26(e)**

Patents judge **E+W**

^{F5}**63.4.**

Textual Amendments

F5 Rule 63.4 omitted (1.10.2010) by virtue of [The Civil Procedure \(Amendment No.2\) Rules 2010 \(S.I. 2010/1953\)](#), rules 1(2), **8(b)**

Starting the claim **E+W**

63.5. Claims to which this Section applies must be started—

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

Claim for infringement or challenge to validity of a patent or registered design **E+W**

63.6. 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 [^{F6}Practice Direction 63].

Textual Amendments

F6 Words in rule 63.6 substituted (6.4.2010) by [The Civil Procedure \(Amendment No.2\) Rules 2009 \(S.I. 2009/3390\)](#), rules 1(2), **38(a)**

Defence and reply **E+W**

63.7. 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
 - (ii) serve it on all other parties,within 21 days of service of the defence.

Case management **E+W**

- 63.8.**—(1) Parties do not need to file [^{F7}a directions 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 [^{F8}(the parties must endeavour to agree case management directions)]; 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 [^{F9}Practice Direction 63].

Textual Amendments

- F7** Words in rule 63.8(1) substituted (1.10.2013) by [The Civil Procedure \(Amendment No.7\) Rules 2013 \(S.I. 2013/1974\)](#), rules 2, **26(f)(i)**
- F8** Words in rule 63.8(2)(b) substituted (1.10.2013) by [The Civil Procedure \(Amendment No.7\) Rules 2013 \(S.I. 2013/1974\)](#), rules 2, **26(f)(ii)**
- F9** Words in rule 63.8(3) substituted (6.4.2010) by [The Civil Procedure \(Amendment No.2\) Rules 2009 \(S.I. 2009/3390\)](#), rules 1(2), **38(a)**

Disclosure and inspection **E+W**

- 63.9.** Part 31 is modified to the extent set out in [^{F10}Practice Direction 63].

Textual Amendments

- F10** Words in rule 63.9 substituted (6.4.2010) by [The Civil Procedure \(Amendment No.2\) Rules 2009 \(S.I. 2009/3390\)](#), rules 1(2), **38(a)**

Application to amend a patent specification in existing proceedings **E+W**

- 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 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.

Court’s determination of question or application **E+W**

63.11.—(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.

Application by employee for compensation **E+W**

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), (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.]

Changes to legislation:

There are currently no known outstanding effects for the The Civil Procedure Rules 1998, Cross
Heading: I PATENTS AND REGISTERED DESIGNS.