
STATUTORY INSTRUMENTS

1986 No. 1187

The Rules of the Supreme Court (Amendment No. 2) 1986

Patents procedure

15. Order 104 shall be amended as follows:

(1) For rule 6(1) there shall be substituted the following:

“(1) A person who presents a petition under section 32 of the 1949 Act or section 72 of the 1977 Act for the revocation of a patent must serve with his petition particulars of the objections to the validity of the patent on which he relies.”.

(2) After rule 6(1) there shall be inserted the following new paragraph:

“(1A) A party to an action concerning a patent who either challenges the validity of the patent or applies by counterclaim in the action for revocation of the patent must, notwithstanding Order 18, rule 2, serve his defence or counterclaim (as the case may be), together with particulars of the objections to the validity of the patent on which he relies, within 42 days after service upon him of the statement of claim.”.

(3) Rule 6(2) shall be amended by inserting, after the words “paragraph (1)”, the words “or (1A)” and by substituting, for the word “questioned”, the word “challenged”.

(4) After rule 6(4) there shall be inserted the following new paragraph:

“**5.** In any action or other proceedings relating to a patent in which the validity of the patent has been put in issue on the ground of obviousness a party who wishes to rely on the commercial success of the patent must state in his answer or in his pleadings the grounds upon which he so relies.”

(5) The following new rules shall be inserted after rule 8:

“Application of rules 10 to 14

9. Rules 10 to 14 of this Order apply to any action for infringement of a patent (whether or not any other relief is claimed) and to any proceedings by petition for the revocation of a patent.

Admissions

10.—(1) Notwithstanding anything in Order 27, where a party desires any other party to admit any facts, he shall, within 21 days after service of a reply or answer or after the expiration of the period fixed for the service thereof, serve on that other party a notice requiring him to admit for the purpose of the action or proceedings the facts specified in the notice.

(2) A party upon whom a notice under paragraph (1) is served shall within 21 days after service thereof serve upon the party making the request a notice stating in respect of each fact specified in the notice whether or not he admits it.

Discovery of documents

11.—(1) Order 24, rules 1 and 2 shall apply in an action for infringement of a patent except that the list of documents must be served by each party within 21 days after service of the notice of admissions under rule 10(2), or within 21 days after the close of pleadings.

(2) Order 24, rules 1 and 2 shall apply in proceedings for the revocation of a patent as they apply to actions begun by writ except that the period prescribed by rule 2(1) shall be that which is prescribed by paragraph (1) of this rule.

Experiments

12.—(1) Where a party desires to establish any fact by experimental proof he shall within 21 days after service of the lists of documents under rule 11 serve on the other party a notice stating the facts which he desires to establish and giving full particulars of the experiments proposed to establish them.

(2) A party upon whom a notice under paragraph (1) is served shall, within 21 days after service thereof, serve upon the other party a notice stating in respect of each fact whether or not he admits it.

(3) Where any fact which a party desires to establish by experimental proof is not admitted he may at the hearing of the summons for directions apply for directions in respect of such experiments.

Experts

13. Where a party intends to adduce oral expert evidence he shall not later than 14 days before the hearing of the summons for directions under rule 14 give notice to every other party and to the Court of the name of each expert he intends to call as a witness.

This rule is without prejudice to the power of the Court to restrict the number of expert witnesses.

Summons for directions

14.—(1) The plaintiff or petitioner must, within 21 days after the expiration of all the periods specified in rules 10 to 12, take out a summons for directions as to the place and mode of trial returnable before a judge of the Patents Court in not less than 21 days, accompanied by minutes of the order proposed, a copy of the specification of any patent in issue, copies of the pleadings and of any documents referred to therein and copies of all documents served under rules 10 and 12 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.

(2) The judge hearing a summons under this rule may give such directions:

- (a) for the service of further pleadings or particulars;
- (b) for the further discovery of documents;
- (c) for securing the making of further 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 holding of a meeting of such experts as the judge may specify, for the purpose of producing a joint report on the state of the relevant art;

- (g) for the exchanging of experts' reports, in respect of those matters on which they are not agreed;
- (h) for the making of experiments, tests, inspections or reports;
- (i) for the hearing, as a preliminary issue, of any question that may arise (including any questions as to the construction of the specification or other documents)

and otherwise as the judge 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 judge shall consider, if necessary of his own motion, whether:

- (a) the parties' advisers should be required to meet for the purpose of agreeing which documents will be required at the trial and of paginating such documents;
- (b) an independent scientific adviser should be appointed under rule 15 to assist the court.

(4) Part IV of Order 38 shall not apply to an action or proceedings to which this rule applies.

(5) No action or petition to which this rule applies 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 judge for carrying them out has expired.”.

(6) The present rule 10 shall be revoked.

(7) The present rule 11 shall be re-numbered as rule 15, the present rule 9 shall be re-numbered as rule 16 and the present rules 12 to 18 shall be renumbered as rules 17 to 23.