
STATUTORY INSTRUMENTS

1998 No. 3132

The Civil Procedure Rules 1998

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

INTELLECTUAL PROPERTY CLAIMS

[^{F1}I 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—
 - (i) Community registered designs;
 - (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) a patents county court.

Specialist list **E+W**

63.3. Claims in the Patents Court and a patents county court form specialist lists for the purpose of rule 30.5.

Patents judge **E+W**

63.4.—(1) Subject to paragraph (2), proceedings in a patents county court will be dealt with by the patents judge of that court.

(2) When a matter needs to be dealt with urgently and it is not practicable or appropriate for the patents judge to deal with such a matter, the matter may be dealt with by another judge with appropriate specialist experience nominated by the Chancellor of the High Court.

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 the practice direction.

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 an allocation 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 (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 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 the practice direction.

Disclosure and inspection E+W

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

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—

Status: Point in time view as at 01/10/2009.

Changes to legislation: There are currently no known outstanding effects for the The Civil Procedure Rules 1998, Cross Heading: 1 PATENTS AND REGISTERED DESIGNS. (See end of Document for details)

- (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.]

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