

The Patents Court Guide

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By authority of the Chancellor of the High Court

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1. Introduction

This guide applies to the Patents Court only. The Intellectual Property Enterprise Court has its own guide to which users of that court are referred.

The general guidance applicable to matters in the Chancery Division, as set out in the Chancery Guide also applies to patent actions unless specifically mentioned below. “PD63” refers to the Practice Direction - Patents and Other Intellectual Property Claims which supplements CPR Part 63. Thus practitioners should consult this guide together with the Chancery Guide.

2. Allocation

Actions proceeding in the Patents Court are allocated to the multi-track (Part 63.1(3)). Attention is drawn to Part 63.8 and PD63.5 (case management). Since October 2014, claims issued in the Patents Court have received claim numbers with the prefix HP-.

3. The judges of the Patents Court

The judges of the Patents Court and their clerks are set out in Annex B to this guide, together with their contact details.

Trials of cases with a technical difficulty rating of 4 or 5 will normally be heard by Arnold J, Birss J or Henry Carr J or by suitably qualified deputy High Court judges.

4. Judges able and willing to sit out of London

If the parties so desire, for the purpose of saving time or costs, the Patents Court will sit out of London. Before any approach is made to the Chancery Listing Officer, the parties should discuss between themselves the desirability of such a course. If there is a dispute as to venue, the court will resolve the matter on an application. Where there is no dispute, the Chancery Listing Officer should be contacted as soon as possible so that arrangements can be put in place well before the date of the proposed hearing.

5. Intellectual Property Court Users’ Committee

This committee (the “IPCUC”) considers the problems and concerns of intellectual property litigators. Membership of the committee includes the judges of the Patents Court and the Intellectual Property Enterprise Court, representatives of the Intellectual Property Bar Association, the Intellectual Property Lawyers Association, the Chartered Institute of Patent Attorneys, the Institute of Trade Mark Attorneys and the IP Federation. Anyone having views concerning the improvement of intellectual property litigation is invited to make his or her views known to the committee, preferably through the relevant professional representative on the committee. They may also be communicated to the secretary, whose details are in Annex B to this guide.

Procedure in the Patents Court

6. Statements of case

Time limits

6.1 In general, the time limits set out in Part 15 apply to litigation of patents and registered designs. However, Part 63.7 modifies Part 15 in respect of the time limits for filing defences and replies.

Content of statements of case

6.2 In general, statements of case (i.e. the pleadings of all parties) must comply with the requirements of Part 16. Furthermore, they should comply with Part 63.6 and PD63.4. Copies of important documents referred to in a statement of case (e.g. an advertisement referred to in a Particulars of Infringement or documents cited in Grounds of Invalidity) should be served with the statement of case. Where any such document requires translation, a translation should be served at the same time.

Service on the Comptroller

6.3 Parties are reminded of the requirement in Part 63.14(3) that where a remedy is sought that would if granted affect an entry in any United Kingdom Patent Office register (for example the revocation of a patent or reregistered design), they are required to serve on the Comptroller: the claim form, counterclaim or application notice; any other relevant statement of case (including any amended statement of case); and any accompanying documents. In addition, PD63.14.1 requires that when such an order is made, the party in whose favour the order is made must serve it on the Comptroller within 14 days.

Independent validity of claims

6.4 Where one party raises the issue of validity of a patent, the patentee (or other relevant party) should identify which of the claims of the patent are alleged to have independent validity as early as possible.

7. Active case management and streamlined procedure

7.1 The claimant should apply for a case management conference (“CMC”) within 14 days of the date when all defendants who intend to file and serve a defence have done so (PD63.5.3). If the claimant fails to do so, then any other party may apply for a CMC (PD63.5.6). Any party may apply in writing for a CMC prior to the above periods. Where a case has been transferred from another division or from another court, the claimant must file for a CMC within 14 days of the transfer (PD63.5.4).

7.2 Almost invariably CMCs in the Patents Court will be conducted by a judge. However, in the limited circumstances set out in PD63.5.2(2) (see also para.15 below), a Master may conduct a CMC. Bundles in accordance with PD63.5.9 should be filed with the court.

7.3 In general, parties should endeavour to agree directions prior to the date fixed for the CMC. Although the court has the right to amend directions which have been agreed, this

will only happen where there is good reason for doing so. A specimen order for directions is Annex A to this guide.

7.4 In accordance with the overriding objective, the court will actively manage the case. In making any order for directions, the court will consider all relevant matters and have regard to the overriding objective with particular emphasis on proportionality, the financial position of the parties, the degree of complexity of the case, the importance of the case and the amount of money at stake.

7.5 The parties are reminded of their continuing obligation to assist the court to further the overriding objective. Moreover, it is the duty of the parties' advisors to remind litigants of the existence of mediation or other forms of alternative dispute resolution as a possible means to resolve disputes. In particular, the parties should consider:

- (a) The need for and/or scope of any oral testimony from factual or expert witnesses. The court may confine cross-examination to particular issues and to time limits. The parties should consider whether oral testimony of witnesses should be given by video facility.
- (b) The need for, and scope of, any disclosure of documents. The requirements of Part 31.5(3)-(5) relating to disclosure reports apply to actions in the Patent Court.
- (c) The need for any experiments, process or product descriptions.
- (d) The need for an oral hearing or whether a decision can be made on the papers. If an oral hearing is considered to be appropriate, the court may order that the hearing be of a fixed duration.
- (e) Whether all issues should be tried together or whether it would be advantageous for one or more issues to be tried in advance of the remaining issues
- (f) Whether there is a need for a document setting out the basic undisputed technology (a "technical primer", as to which see para. 13.6 below), and if so, its scope and the steps to be taken to achieve agreement of it.
- (g) Whether a scientific adviser should be appointed.
- (h) The technical complexity of the action. Technical complexity is measured on a scale of 1 to 5, with 1 being the least complex and 5 the most.
- (i) Whether a costs-capping order should be made.
- (j) Whether there should be a stay of proceedings for mediation or other form of alternative dispute resolution.
- (k) Whether the case is of sufficient value that it ought to be exempt from the costs management provisions in Part 3.12-3.18.

Streamlined procedure

7.6 Any party may at any time apply to the court for a streamlined procedure in which:

- (a) all factual and expert evidence is in writing;
- (b) there is no requirement to give disclosure of documents;
- (c) there are no experiments;
- (d) cross-examination is only permitted on any topic or topics where it is necessary and is confined to those topics;

or for any variant on the above.

7.7 Prior to applying for a streamlined procedure, the party seeking it should put its proposal to other parties in the proceedings and should endeavour to agree a form of order.

7.8 If the parties agree to a streamlined procedure, the proposed form of order should be put to the judge for approval as a paper application.

8. Admissions

8.1 With a view to early elimination of non-issues, practitioners are reminded of the necessity of making admissions as soon as possible. This should be done as early as possible, for instance, in a defence or reply. Thus, in a defence, a party may admit the acts complained of or that his article/process has certain of the features of a claim. In a reply a patentee may be able to admit prior publication of cited documents. For the effect of admissions, see Part 14.

8.2 Parties should also consider serving a notice to admit facts in accordance with Rule 32.18 for the purpose of identification of points not in dispute. By asking whether or not the defendant disputes that his article/process has certain features of the claim the real dispute can be narrowed. Thus the ambit of disclosure and of witness and expert statements will be narrowed.

8.3 Parties are reminded that when deciding the issue of costs, a court can take into account the conduct of the parties, including whether it was reasonable for a party to contest a particular issue, see Rule 44.2(5)(b).

8.4 The position should be kept under constant review. If there is any alteration in the admissions that can be made, the identity of the claims said to have independent validity, or the claims alleged to be infringed, that information should be communicated forthwith to the other parties.

9. Alternative Dispute Resolution (“ADR”)

9.1 While emphasising its primary role as a forum for deciding patent and registered design cases, the Patents Court encourages parties to consider the use of ADR (such as, but not confined to, mediation and conciliation) as an alternative means of resolving disputes or particular issues within disputes. A fuller list of the different types of ADR can be found in section 2.12 of the Guide to the Intellectual Property Enterprise Court.

9.2 Settlement of dispute by ADR has many advantages including significant saving of costs and providing parties with a wider range of solutions than can be offered by litigation. Legal representatives should consider and advise their clients as to the possibility of attempting to resolve the dispute via ADR. In an appropriate case, the Patents Court may adjourn a case for a specified period of time to encourage and enable the parties to use ADR.

10. Disclosure

10.1 Parties are obliged to provide disclosure in accordance with Part 31 as modified by Rule 63.9 and PD63.6.1-6.3.

Process and/or product description

10.2 Where appropriate, parties are encouraged to provide a process and/or product description (“PPD”) instead of standard disclosure relating to processes or products which are alleged to infringe or are otherwise relevant to proceedings.

10.3 Subject to 10.5 below, PPDs must be adequate to deal with the nature of the allegation that has been advanced by the other party or parties. The parties have joint responsibility at an early stage to determine the nature of the case advanced so that the PPD is adequate to deal with that case.

10.4 Parties should bear in mind when preparing a PPD that they may be called on to prove it at trial. Any material omission or inaccuracy could result in a costly adjournment with consequential adverse orders, including as to costs. A PPD ought to be accompanied by a signed written statement which:

- (i) states that the person making the statement is personally acquainted with the facts to which the description relates;
- (ii) verifies that the description is a true and complete description of the product or process; and
- (iii) contains an acknowledgement by the person making the statement that he may be required to attend court in order to be cross-examined on the contents of the description.

10.5 Insofar as a party is not able to verify that the PPD is a true and complete description of all relevant aspects of his product or process (for example because he does not make certain components in his product and does not know how they work), then the correct course is for the party to verify such parts as he is able, and to serve a disclosure list (which may or may not contain any documents) in relation to the remainder.

Descriptions and drawings of processes or products

10.6 Parties are encouraged to agree descriptions and drawings of processes and/or products which are the subject of infringement proceedings or are alleged to constitute relevant prior art.

Models or apparatus of processes or products

10.7 If a party wishes to adduce a model or apparatus at trial, it should, if practicable, ensure that directions for such are given at the first CMC (PD63 para. 8.1). Parties should endeavour to view and agree the accuracy of such models or apparatus where possible well in advance of the date of trial.

General matters relating to hearings of applications and trials

11. Arrangements for listing

11.1 Attention is drawn to the Practice Statement: Listing of Cases for Trial in the Patents Court issued by the Judge in Charge of the Patents Court on 7 December 2015 reproduced in Annex E to this Guide.

11.2 The Chancery Listing Officer is responsible for the listing of all work of the Patents Court. The Chancery Listing Officer and his staff are located in the Rolls Building. The office is open to the public from 10.00 am to 4.30 pm each day. The telephone number is 020 7947 7717 and the fax number is 0870 739 5868.

11.3 Appointments to fix trials and interim applications are dealt with between 11.00 am and 12.00 noon each working day. The applicant should first obtain an appointment from the Chancery Listing Officer and give 3 clear days' notice to all interested parties of the date and time fixed.

11.4 A party should not seek to list an application or cause the opposing advocate or counsel's clerk to "pencil in" a date for hearing prior to raising with the proposed respondent the subject-matter of the application so that, where possible, agreement may be reached on the subject-matter of the application. Applicants who fail properly to consult with the respondents prior to listing an application may be met with an adverse costs order.

Short applications

11.5 Short applications (i.e. those estimated to last no more than 1 hour) will usually be heard before the normal court day starts at 10.30 am e.g. at 9.30 or 10 am. These can be issued and the hearing date arranged at any time by attendance at the Chancery Listing Office. Attention is drawn to PD63.5 about the filing of documents and skeleton arguments.

Urgent applications and without notice applications

11.6 A party wishing to apply without notice to the respondent(s) should contact the Chancery Listing Office. In cases of emergency in vacation or out of normal court hours, the application should be made to the duty Chancery judge.

September sittings

11.7 The Patents Court will endeavour, if the parties so desire and the case is urgent, to sit in September.

Interim injunction hearings and expedited trials

11.8 Applicants for interim remedies (in particular, interim injunctions) and respondents are encouraged to consider whether an expedited (speedy) trial would better meet the interests of justice. Applications for expedited trials may be made at any time but should be made as soon as possible and notice given to all parties. Parties are reminded that varying degrees of expedition are possible. Some cases may warrant extreme expedition, others a lesser degree.

11.9 When an application for an interim injunction is made the applicant should, where practicable, make prior investigations with the Chancery Listing Officer about trial dates on an unexpedited and expedited basis having regard to the estimated length of trial.

Pre-trial reviews (PTR)

11.10 As with other cases in the Chancery Division, a pre-trial review should be held between 4-6 weeks before trial in all cases estimated to last five days or more. An important issue to be discussed at the pre-trial review will be the preparation of the trial timetable.

12. Time estimates and technical complexity ratings

12.1 In providing appropriate time estimates, parties must appreciate the need to give realistic and accurate time estimates and ensure that the time estimate includes a discrete reading time for the court to read the papers prior to the hearing of the application or trial. In general, the court will wish to read the skeleton arguments, the patent (where relevant), the prior art (where relevant), expert reports and other key documents (e.g. important witness statements). Advisors should bear in mind the technical difficulty of the case when considering the reading time estimate. The court will consider the imposition of guillotines where time estimates are exceeded.

12.2 Similarly, in providing technical complexity ratings, the parties must appreciate the need to give realistic and accurate estimates of the technical complexity of the case. The technical complexity rating should take account of the complexity of both the patent and the prior art as well as the complexity of the infringement issues and likely evidence.

Revised time estimates and technical complexity ratings

12.3 Where parties and their legal advisors consider that a time estimate that has been provided (e.g. at the CMC) has become unrealistic, they have a duty to notify the new time estimate to the Chancery Listing Office or, where appropriate, the judge's clerk as soon as possible. The same applies to estimates of technical complexity.

13. Documents and timetable

13.1 Bundling for the hearing of applications and trials is of considerable importance and should be approached intelligently. The Direction in Annex F on Standard Trial Bundles in the Patents Court shall be followed. Subject to that, the general guidance given in Appendix 6 Chapter 21 of the Chancery Guide, paragraphs 21.34 to 21.72, should be followed. Solicitors or patent attorneys who fail to follow this Direction and the general guidance do so may be required to explain why and may be penalised personally in costs.

13.2 If it is known which judge will be taking the hearing, papers for the hearing should be lodged directly with that judge's clerk. If there is insufficient time to lodge hard copies before the deadline, documents of significance (and particularly skeleton arguments) should be supplied by e-mail to the clerk of the judge concerned, followed up by clean hard copies.

13.3 It is the responsibility of both parties to ensure that all relevant documents are lodged with the clerk of the judge who will be taking the hearing by noon two days before the date fixed for hearing unless some longer or shorter period has been ordered by the judge or is prescribed by this guide.

13.4 The judges request that all important documents also be supplied to them on a USB stick in a format convenient for the judge's use (normally the current or a recent version of Microsoft Word for Windows or as a text searchable pdf). These will usually include skeleton arguments, important patents, prior art and drawings, the witness statements and expert reports.

13.5 Prior to trial, parties should ensure that they comply with the requirements of PD63.9 concerning the provision of a trial timetable, trial bundle and reading guide for the judge. The trial timetable should be detailed and set out the times and dates that witnesses will be required to give evidence, as well as any days that any witness is unavailable to give evidence.

13.6 The parties are encouraged to produce a technical primer setting out the agreed basic undisputed technology relevant to the case. This should be produced in advance of the expert reports to avoid substantially the same material being described by each expert. Ideally primers should be agreed documents. Generally, where the parties are not able to agree whether to include a particular issue ought to be included in the primer, rather than having a "marked-up" primer showing the areas of dispute, the issue should be omitted and dealt with by the experts in their reports. Where a technical primer has been produced, the parties should identify those parts which are agreed to form part of the common general knowledge. Usually, this should be done either in, or shortly after exchange of, the expert reports but in any event a reasonable time prior to trial.

13.7 Skeleton arguments should be lodged in time for the judge to read them before an application or trial.

(a) In the case of applications, this should normally be 10:30am the previous working day (or, in the case of short applications, 3pm)

(b) In the case of trials, this should normally be at least two working days before commencement of the trial. In substantial cases, a longer period (to be discussed with the clerk to the judge concerned) may be needed.

13.8 Where any party wishes to put documents to a witness in cross-examination, these should generally be supplied to the witness sufficient time in advance so that the witness has time to consider them before giving evidence. Generally, documents for cross-examination should be supplied at least 48 hours before the witness gives evidence. However, more time may be required depending on the nature and number of the documents intended to be relied upon. The number of documents should be kept within manageable bounds. In documents over 4 pages long, there should be an indication of which parts will be put to the witness.

13.9 Following the evidence in a substantial trial, a short adjournment may be granted to enable the parties to summarise their arguments in writing before oral argument.

Transcripts

13.10 In trials where a transcript of evidence is being made and supplied to the judge, the transcript should be supplied by e-mail and in hard copy. Where real time transcription is being used, the Court should be provided with a terminal.

14. Telephone applications

14.1 For short (20 minutes or less) matters, the judges of the Patents Court are willing to hear applications by telephone conference in accordance with the Practice Direction under Part 23. The party making the application is responsible for setting up the telephone application and informing the parties, Counsels' clerks and Chancery Listing of the time of the conference call.

14.2 It is possible for the application to be recorded, and if recording by the court rather than by BT (or other service provider) is requested, arrangements should be made with the Chancery Listing Officer. The recording will not be transcribed. The tape will be kept by the clerk to the judge hearing the application for a period of six months. Arrangements for transcription, if needed, must be made by the parties.

14.3 This procedure should be used where it will save costs.

Miscellaneous

15. Jurisdiction of Masters

15.1 Masters have only a limited jurisdiction in patent matters (see PD63.5.2(2)). Generally it is more convenient for consent orders (on paper or in court) to be made by a judge even where a Master has jurisdiction to do so.

15.2 Where a Master makes a consent order disposing of an action which has been fixed, it is the duty of all the parties' representatives to inform the Chancery Listing Officer that the case has settled. Where the validity of the patent was in issue, the United Kingdom Intellectual Property Office (“UKIPO”) should also be informed.

16. Consent orders

16.1 The court is normally willing to make consent orders without the need for the attendance of any parties. A draft of the agreed order and the written consent of all the parties' respective solicitors or counsel should be supplied to the Chancery Listing Office. Unless the judge considers a hearing is needed, he will make the order in the agreed terms by initialling it. It will be drawn up accordingly and sent to the parties.

17. Draft judgments

17.1 Many judgments, particularly after a full trial, will be reserved and handed down at a later date, as advised by the Chancery Listing Office. Prior to that, the practice has arisen to provide the parties' legal representatives (or litigants in person) with a copy of the draft judgment for advocates to notify the court of typographical and obvious errors (if any). The text may be shown, in confidence, to the parties, but only for the purpose of obtaining instructions and on the strict understanding that the judgment, or its effect, is not to be disclosed to any other person, or used in the public domain, and that no action is taken (other than internally) in response to the judgment. Reference is invited to PD40E paras 2.1 to 2.9.

18. Orders following judgment

18.1 Where a judgment is made available in draft before being given in open court the parties should, in advance of that occasion, exchange drafts of the desired consequential order. It is highly undesirable that one party should spring a proposal on the other for the first time when judgment is handed down. Where the parties are agreed as to the consequential order and have supplied to the judge a copy of the same signed by all parties or their representatives, attendance at the handing down of the judgment is not necessary. If it is not possible for there to be an effective hearing to determine the consequential relief when a judgment is handed down, the hearing will be adjourned for a short period. A standard order for such situations is Annex C to this guide.

19. Appeals from the Comptroller-General of Patents, Designs and Trade Marks (“the Comptroller”)

Patents

19.1 By virtue of statute, these lie only to the High Court and not the Intellectual Property Enterprise Court. They are now governed by Part 52 (see Rule 63.16). Permission to appeal is not required. Note that the Comptroller must be served with a Notice of Appeal (Rule 63.16(3)). The appellant has the conduct of the appeal and he or his representative should, within 2 weeks of lodging the appeal, contact the Chancery Listing Officer with a view to arranging a hearing date. The appellant must ensure that the appeal is set down as soon as is reasonably practicable after service of the notice of appeal. Parties are reminded that the provisions about the service of skeleton arguments apply to appeals from the Comptroller.

Registered Designs

19.2 Appeals in registered designs cases may be brought before the High Court or the Appointed Person. Appeals to the High Court are currently assigned to the Chancery Division as a whole, not the Patents Court (Rule 63.16(2)). Permission to appeal is not required

Trade Marks

19.3 Appeals in trade mark cases may be brought before the High Court or the Appointed Person. Appeals to the High Court are assigned to the Chancery Division as a whole, not the Patents Court (Rule 63.16(2)). Permission to appeal is not required.

Appeals on paper only

19.4 The court will hear appeals on paper only if that is what the parties desire. If the appellant is willing for the appeal to be heard on paper only, he should contact the respondent and UKIPO at the earliest opportunity to discover whether such a way of proceeding is agreed. If it is, the Chancery Listing Office should be informed as soon as possible. The parties (and the Chancery Listing Officer if he/she desires) should liaise amongst themselves for early preparation of written submissions and bundles and provide the court with all necessary materials.

20. Appeals to the Court of Appeal

20.1 The Court of Appeal has recently issued guidance as to the procedure for all intellectual property appeals, including appeals from the Patents Court. This is reproduced in Annex D to this guide.

Annex A: Specimen order for directions

Commentary

A draft order is annexed below covering most normal eventualities. The directions are intended only as a guide and are not “standard directions”. Not all paragraphs will be applicable in every case.

Order for directions

UPON the parties’ legal advisors having advised the litigants of the existence of mediation as a possible means of resolving this claim and counterclaim

IT IS ORDERED THAT

Transfer

1. [This claim and counterclaim be transferred to the Intellectual Property Enterprise Court.] (If this order is made, no other order will generally be necessary, though it will generally be desirable for procedural orders to be made at this time to save the costs of a further conference in the Intellectual Property Enterprise Court.)

Service on the Comptroller

2. The [claimants/defendants] shall serve on the Comptroller: (a) the claim form, counterclaim or application notice; (b) any other relevant statement of case (including any amended statement of case); and (c) any accompanying documents of any claim for a remedy which would, if granted, affect an entry in any United Kingdom Patent Office register.

Costs management

3. These proceedings are exempt from the costs management provisions contained in section II of CPR 3 and Practice Direction 3E.

Amendments to statements of case

4. The claimants have permission to amend their claim form shown in red on the copy [annexed to the application notice/as signed by the solicitors for the parties/annexed hereto] and [to re-serve the same on or before [date]/and that re-service be dispensed with] and that the defendants have permission to serve a consequentially amended defence within [number] days [thereafter/hereafter] and that the claimants have permission to serve a consequentially amended reply (if so advised) within [number] days thereafter.

Further Information and Clarification

5. (a) The [claimants/defendants] do on or before [date] serve on the [defendants/claimants] the further information or clarification of the [specify statement of case] as requested by the [claimants/defendants] by their request served on the [defendants/claimants] on [date] [and/or]

(b) The [claimants/defendants] do on or before [date] serve on the [defendants/claimants] [a response to their request for further information] [do answer the requests in their request for further information] or clarification of the [identify statement of case] served on the [defendants/claimants] on [date].

Admissions

6. The [claimants/defendants] do on or before [date] state in writing whether or not they admit the facts specified in the [defendants'/claimants'] notice to admit facts dated [date].

Security

7. The claimants/defendants do provide security for the defendants'/claimants' costs for its claim/counterclaim in the sum of £[state sum] by [paying such sums into court] [specify manner in which security to be given] and that:

(i) in the meantime the claim [counterclaim] be stayed [and/or];

(ii) unless security is given as ordered by the above date, the claim [counterclaim] be struck out without further order with the defendants'/claimants' costs of the claim [counterclaim] to be the subject of detailed assessment if not agreed.

Lists of Documents

8. (a) The claimants and the defendants respectively do on or before [state date] make and serve on the other of them a list in accordance with form N265 of the documents in their possession custody or control which they are required to disclose in accordance with the obligation of standard disclosure in accordance with Part 31 as modified by paragraph 5 of the Practice Direction - Patents etc. supplementing Part 63.

(b) In respect of those issues identified in Schedule [number] hereto disclosure shall be limited to those [documents/categories of documents] listed in Schedule [number].

Inspection

9. If any party wishes to inspect or have copies of such documents as are in another party's control, it shall give notice in writing that it wishes to do so and such inspection shall be allowed at all reasonable times upon reasonable notice and any copies shall be provided within [number] working days of the request upon the undertaking of the party requesting the copies to pay the reasonable copying charges.

Experiments

10. (a) Where a party desires to establish any fact by experimental proof, including an experiment conducted for the purposes of litigation or otherwise not being an experiment conducted in the normal course of research, that party shall on or before [date] serve on all the other parties a notice stating the facts which it desires to establish and giving full particulars of the experiments proposed to establish them.

(b) A party upon whom a notice is served under the preceding sub-paragraph shall within [number] days, serve on the party serving the notice a notice stating in respect of each fact whether or not that party admits it.

(c) Where any fact which a party wishes to establish by experimental proof is not admitted that party shall apply to the court for further directions in respect of such experiments.

[Or where paragraph 9 of the Practice Direction - Patents etc. supplementing CPR Part 63 has been complied with.]

10. (a) The claimants/defendants are to afford to the other parties an opportunity, if so requested, of inspecting a repetition of the experiments identified in paragraphs [specify them] of the notice[s] of experiments served on [date]. Any such inspection must be requested within [number] days of the date of this order and shall take place within [number] days of the date of the request.

(b) If any party shall wish to establish any fact in reply to experimental proof that party shall on or before [date] serve on all the other parties a notice stating the facts which it desires to establish and giving full particulars of the experiments proposed to establish them.

(c) A party upon whom a notice is served under the preceding sub-paragraph shall within [number] days serve on the party serving the notice a notice stating in respect of each fact whether or not that party admits it.

(d) Where any fact which a party wishes to establish by experimental proof in reply is not admitted the party may apply to the court for further directions in respect of such experiments.

Notice of Models, etc.

11. (a) If any party wishes to rely at the trial of this claim and counterclaim upon any model or apparatus, that party shall on or before [date] give notice thereof to all the other parties; shall afford the other parties an opportunity within [number] days of the service of such notice of inspecting the same and shall, if so requested, furnish the other party with copies or illustrations of such model or apparatus.

(b) No further or other model or apparatus shall be relied upon in evidence by either party save with consent or by permission of the court.

Product or Process Description

12. (a) The defendants/claimants do provide a written description together with relevant drawings of the following [product(s)] [process(es)] to the claimants/defendants by [date].

i. [description of product or process];

ii. [description of product or process]; etc.

(b) The description served under paragraph (a) shall be accompanied by a signed written statement which shall:

- (i) state that the person making the statement is personally acquainted with the facts to which the description relates;
- (ii) verify that the description is a true and complete description of the product or process; and
- (iii) contain an acknowledgement by the person making the statement that he may be required to attend court in order to be cross-examined on the contents of the description.

Technical Primer

13. The parties shall use their best endeavours to agree on or before [date] a single technical primer setting out the basic undisputed technology.

Scientific Adviser

14. A.B is appointed a scientific adviser to assist the court in this claim and counterclaim, his/her costs to be met in the first instance in equal shares by the parties and to be costs in the claim and counterclaim, subject to any other order of the trial judge.

Written Evidence

15.(a) Each party shall on or before [date] serve on the other parties [signed] written statements of the oral evidence which the party intends to lead on any issues of fact to be decided at the trial, such statements to stand as the evidence in chief of the witness unless the court otherwise directs;

(b) Each party shall on or before [date] serve on the other parties [signed] written statements of the oral evidence which it intends to lead at trial in answer to facts and matters raised in the witness statements served on it under paragraph (a) above;

(c) Each party may call up to [number] expert witnesses in this claim and counterclaim provided that the said party:

- (i) supplies the name of such expert to the other parties and to the court on or before [date]; and

- (ii) no later than [date]/[[number days] before the date set for the hearing of this claim and counterclaim] serve upon the other parties a report of each such expert comprising the evidence which that expert intends to give at trial.

- (iii) no later than [date]/[[number of days] before the date set for the hearing of this claim and counterclaim] serve upon the other parties any report of such expert in reply to a report served under paragraph 15(c)(ii) above.

[(d) The claimant shall, with the cooperation of the other parties, arrange for the experts to meet on or before [date] to determine on what issues they agree and on what they disagree and the experts shall before [date] file a report stating where they agree and where they disagree and in the latter case, their reasons for disagreeing].

Civil Evidence Act Notices

16. Each party shall, no later than [date], serve upon the other parties any Civil Evidence Act Notices upon which it intends to rely at trial.

Admissibility of Evidence

17. A party who objects to any statements of any witness being read by the judge prior to the hearing of the trial, shall serve upon each other party a notice in writing to that effect setting out the grounds of the objection.

Non-Compliance

18. Where either party fails to comply with the directions relating to experiments and written evidence it shall not be entitled to adduce evidence to which such directions relate without the permission of the court.

Pre-trial review

19. There shall be a pre-trial review shall take place not more than [] weeks prior to the date of the trial of this action.

Trial Bundles

20. Each party shall no later than [28] days before the date fixed for the trial of this claim and counterclaim serve upon the other parties a list of all the documents to be included in the trial bundles. The claimants shall no later than [21] days before the date fixed for trial serve upon the defendants ... sets of the bundles for use at trial.

21. The claimants must file with the court no later than [4] days before the date fixed for the trial:

- (i) the trial bundle; and
- (ii) a reading guide for the judge.

Trial

22. The trial of these proceedings shall be before an assigned judge alone in [London], estimated length [number] days which shall include a pre-trial reading estimate for the judge of [number] days. The technical difficulty rating is [].

Liberty to Apply

23. The parties are to be at liberty on three days' notice to apply for further directions and generally.

Costs

24. The costs of this application are to be costs in the claim and counterclaim.

25. This Order shall be served by the [] on the [].

Service of the Order

The court has provided a sealed copy of this order to the serving party: [NAME] at [ADDRESS]
[REFERENCE]

Annex B: Contact details

1. The judges of the Patents Court, their clerks and their contact details

Mann J (Clerk: Susan Woolley - tel 020 7947 7964; *Susan.Woolley@hmcts.gsi.gov.uk*)

Warren J (Clerk: Pauline Drewett - tel 020 7073 1789;
Pauline.Drewett@hmcts.gsi.gov.uk)

Morgan J (Clerk: Supriya Saleem - tel 020 7947 6419;
Supriya.Saleem@hmcts.gsi.gov.uk)

Norris J (Clerk: Katie Dunkley – tel 020 7073 1728; *Katie.Dunkely@hmcts.gsi.gov.uk*)

Arnold J [Judge in charge of the Patents Court] (Clerk: Pauline Drewett - tel 020 7073 1789; *Pauline.Drewett@hmcts.gsi.gov.uk*)

Roth J (Clerk: Jessie Davidson - tel 020 7947 5694; *Jessie.Davidson@hmcts.gsi.gov.uk*)

Birss J (Clerk: Gwilym Morris – tel 020 7947 7379; *Gwilym.Morris2@hmcts.gsi.gov.uk*)

Rose J (J (Clerk: Rebecca Segrist - tel 020 7947 6794;
Rebecca.Segrist@hmcts.gsi.gov.uk)

Nugee J (Clerk: Gary Clark – tel 020 7947 7200; *Gary.Clark@hmcts.gsi.gov.uk*)

Henry Carr J (Clerk: Jas Kahlon – tel 020 7947 6339; *Jas.Kahlon@hmcts.gsi.gov.uk*)

2. Secretary of the Intellectual Property Court Users Committee and current contact details

Michael Burdon, Simmons & Simmons LLP, CityPoint, One Ropemaker Street, London, EC2Y 9SS Tel: 020 7628 2020 Fax: 020 7628 2070.

Annex C: Specimen order on handing down of judgment

UPON THIS ACTION [AND COUNTERCLAIM] having been tried before the Honourable [Mr/Mrs] Justice [] on the [] of []

AND UPON the Court handing down Judgment on [DATE]

IT IS ORDERED THAT:

1. The hearing to determine the appropriate form of Order following the handing-down of Judgment in these proceedings ('the Form of Order Hearing') be adjourned to the first available date convenient to the parties but no later than [DATE].
2. Such adjournment is an adjournment within paragraph 4.1(a) of the Practice Direction 52A to Part 52; and accordingly the time for making any application for permission to appeal be extended until the Form of Order Hearing and pending that hearing the time for service of any Appellant's Notice shall not run.
3. Until the Form of Order Hearing the documents [referred to in / scheduled to] the Order dated [] shall remain confidential and shall only be used for the purpose of these proceedings notwithstanding that they have been, or may have been, read to or by the Court or referred to at a hearing which has been held in public.
4. Costs are in the case.
5. This Order shall be served by the [] on the [].

Service of the Order

The court has provided a sealed copy of this order to the serving party: [] at [ADDRESS]
[REFERENCE]

Annex D: Procedure in Intellectual Property Appeals in the Court of Appeal

Applications for Permission to Appeal

The appellant's notice, skeleton argument and bundle should be lodged as required by CPR PD52C, sections 2, 4 and 7.

Appeals

Where permission to appeal has been given by the lower court or granted by the Court of Appeal:

- The Civil Appeals Office will ask the parties to provide an agreed time estimate where possible or, where agreement cannot be reached, separate time estimates for the hearing of the appeal together with an agreed time estimate for any necessary pre-reading.
- The case will then be referred to the Supervising Lord Justice for listing directions.
- Once the appeal is listed, the parties will be asked to lodge an agreed timetable for the filing of skeleton arguments, appeal bundles and bundles of authorities for approval by the Supervising Lord Justice.
- Any subsequent request by the parties to amend the approved timetable will be referred to the Supervising Lord Justice for determination.

Annex E: Practice Statement: Listing of Cases for Trial in the Patents Court

Issued 7 December 2015

The Patents Court endeavours bring patent cases on for trial where possible within 12 months of the claim being issued. To this end, the following procedure will be adopted.

1. The parties will be expected (a) to start to consider potential trial dates as soon as is reasonable practicable after the service of the proceedings and (b) to discuss and attempt to agree trial dates with each other when seeking to agree directions for trial.
2. The starting point for listing trials is the current applicable Trial Window advertised by the Chancery List Office. Patent cases will be listed on the basis that the Trial Windows are divided as follows: estimated hearing time (excluding pre-reading and preparation of closing submissions) up to 5 days; estimated hearing time (excluding pre-reading and preparation of closing submissions) 6 to 10 days; and estimated hearing (excluding pre-reading and preparation of closing submissions) over 10 days.
3. Where it will enable a case to be tried within 12 months, or shortly thereafter, the Court may list a trial up to one month earlier than the applicable Trial Window without the need for any application for expedition.
4. The Court will use its case management powers in a more active manner than hitherto, with a view to dealing with cases justly and at proportionate cost in accordance with CPR rule 1.1. This may have the effect of setting limits on hearing times that enable cases to be listed promptly. For example, the Court may direct that a case estimated at 6 days will be heard in 5 days, and may allocate time between the parties in a manner which enables that to be achieved.
5. Where it makes a significant difference to the time which cases must wait to be listed for trial and it will not cause significant prejudice to any party, cases may be listed without reference to the availability of counsel instructed by the parties.

These steps do not exclude the possibility of cases being expedited where expedition is warranted. Nor do they exclude the possibility of the parties opting to use the streamlined procedure or the Shorter Trial pilot scheme or the Flexible Trial pilot scheme.

This Practice Statement is issued with the concurrence of the Chancellor of the High Court. It supersedes the Practice Statement issued on 28 January 2015.

Arnold J
Judge in Charge of the Patents Court

Annex F: Standard Trial Bundles in the Patents Court

Introduction

The objective of this direction is to have a standard arrangement of bundles so that, as every document is produced in the course of the litigation, it is put in its place in the standard arrangement and the bundles do not subsequently have to be re-arranged or re-ordered, and the lawyers can continue using the same bundles, from the CMC up to and during the trial (recognising that for some interim applications it may be appropriate to have an application bundle specific for the hearing in addition to the standard bundles). Therefore, all that will be needed for trial would be preparation of additional copies for the judge, witnesses and stenographer.

There is a conflict between the need to avoid re-doing bundles as a case progresses, which requires documents to be added to the end of existing bundles, and the desire for documents to be in a sensible order, which in pleadings or technical literature bundles may not follow the order in which the documents are produced in the litigation. It has to be accepted that this direction requires a degree of prescriptiveness, but there also needs to be some sensible flexibility and co-operation between the parties' solicitors, particularly in multi-patent cases.

A new document should generally be added to the end of an existing bundle, and bundles should generally not require re-ordering; the new document either adds to an existing bundle or starts a new bundle. Therefore, whenever any party serves a document they should also serve a new index page for the bundle(s) in which the document being served is to be placed. Amended documents should replace the unamended version in the bundle, and Responses to Part 18 Requests and Responses to Notices to Admit should replace the Request or Notice in the bundle.

Confidentiality

Confidential material can appear in a number of places – within a skeleton, pleading, PPD, witness statement or exhibit to a witness statement. The objective is that all confidential material is contained in a separate confidential bundle, with a redacted version or cross-referenced page in the relevant main bundle.

The preferred practice is that sections of a document which contain confidential information are contained in a separate confidential annex or exhibit, which is placed in the separate confidential bundle. In some cases, where this is not feasible, the party serving a document should provide a redacted version to go in the main bundle, and include a full version containing the confidential material (highlighted or underlined), or at least particular sections containing the confidential information, for inclusion in the confidential bundle. This has the additional advantage that the parties will then have redacted versions of witness statements or expert reports, which can be made available in Court under CPR 32.13.

In cases where the confidential material is voluminous or confidentiality regimes are complex the parties should agree as early as possible on the way in which it can be dealt with.

Cross-referencing

It should be possible to include bundle references (in bold) for all documents referred to in witness statements and expert reports, since the location in the bundles of all exhibits will be determined when the evidence is finalised. Separate side annotation can thus be avoided.

All references to exhibits and other documents, including those in reply evidence, should refer to the actual bundle and tab number.

Duplication of exhibits

Where more than one of a party's witnesses or experts refers to the same document, it should be exhibited to only one statement or report, and the others should refer to that exhibit.

If the defendant's witnesses refer to documents which are also exhibited to the claimant's evidence, the duplicated exhibit should be removed from the defendant's exhibits bundle and replaced by a placeholder which cross-refers to the claimant's exhibits bundle.

Technical literature

Copies of all technical literature and other documents referred to in an expert report or witness statement should be provided in the bundles, usually as exhibits or in the technical literature bundle, but possibly elsewhere (eg prior art bundle).

Since in most cases there is little technical literature, the default position is to exhibit technical literature to an expert report or witness statement.

If it appears to either party's solicitors that there is likely to be a suitable amount of technical literature for a separate bundle, they should raise it with the other side. If they all agree, then there will be a separate Technical Literature bundle, Bundle L.

Since cross-references to the bundles are included in expert reports and witness statements when served, the bundle(s) L need to be divided between:

- i. publications referred to in Claimant's evidence in chief,
- ii. publications referred to in Defendant's evidence in chief
- iii. publications referred to in Claimant's evidence in reply
- iv. publications referred to in Defendant's evidence in reply

Rearranging the literature into chronological order following service of the reply evidence should be avoided; it would involve re-jigging the bundle(s), and re-doing the cross-references in the expert reports and witness statements, at a busy period in a case, and is an expenditure of time which this direction is designed to avoid.

Amendment of the patent

If the patentee applies to amend the patent in suit, the parties will need to agree where the relevant documents will be included in the bundles (eg proposed amended specification and claims in the "A.n" series of bundles, statements of case in the "B.n" etc series: or in some cases, all in one separate bundle may be more sensible).

Pagination

Separate pagination should be used within in each tab. Where a document already has clear page numbers, like a technical publication, then it does not need separate pagination. Documents (eg bundles of correspondence) should be paginated before service.

Standard bundles

- A.1** **Patent(s)** (usually comb-bound)
- A.2** **Priority documents and application(s) as filed** (when priority and added matter are in issue).

- B.1** **Pleadings, Orders and Notices.** This will include pleadings, documents referred to in the pleadings (except the pleaded prior art), orders, lists of documents, PPDs, any technical primer and any Civil Evidence Act Notices (without annexed documents).

The bundle should be filled chronologically for the pleadings. Thereafter, tabs can be held open for documents which the parties know will be served (eg Order for Directions, Lists of Documents, Product/Process Description, Primer) and other documents can be added chronologically after these tabs.

To avoid re-arranging the bundle, Part 18 Requests should be added to the end of the bundle at the time of service, and replaced by the Response when served. The same applies *mutatis mutandis* to Admissions.

[NB: for the judge, a comb-bound copy of the technical primer should be provided.]

- B.2** **Pleaded Prior Art.**

- C.1** **Claimant's Evidence.** This bundle will include both fact and expert evidence (including witness statements served with a Civil Evidence Act Notice). Reply evidence should be added to bundle **C.1** when it is served.

- C.2, C.3, etc.** **Exhibits to the Claimant's evidence**

The principle with exhibits is that the exhibits to each witness statement or report are contained in one bundle (or section of a bundle), and the tab numbers follow the exhibit numbers, even when split over two bundles.

All documents referred to in a statement or report should be referred to as exhibits; to refer to some as annexes or appendices can cause confusion.

The preference is that each bundle contains the exhibits of one witness/expert, so that reply exhibits can be added to the end. This avoids the inconvenience of subdividing bundles, which would result in two runs of tab numbers.

Where this is not practicable, it may be better to abandon the principle of tab numbers matching exhibit numbers, in the interest of avoiding two runs of the same tab numbers in a single bundle. In such a case, reply exhibits would have to follow the exhibits to all the evidence in chief, as trying to insert each witness's reply exhibits immediately after their exhibits in chief will require too much rearrangement of bundles.

If one expert's exhibits go over more than one (sensibly filled) bundle then it should continue to the next bundle (C.2/C.3, and so on).

CONF-C This bundle will include the claimant's documents which contain confidential information of either Party.

D.1 **Defendant's Evidence** (as above).

D.2, D.3, etc. **Exhibits to the Defendant's Evidence** (as above).

CONF-D This bundle will include the defendant's confidential documents (as above).

E. **Documents referred to in Civil Evidence Act Notices** (or E.1, E.2 etc. if more than one bundle)(other than witness statements).

F, G. **Selected documents from Claimant's / Defendant's Disclosure** (to the extent not exhibited to witness statements)

H. **Documents from Interim Hearings** (only if required). These could include, for example, evidence from interim injunctions or other interim applications, transcripts of hearings, or interim judgments to the extent that these are going to be referred to at trial. Where evidence in the form of witness statements is included, the exhibits should be in a separate bundle **H.2**.

I. **Selected Inter-Solicitor correspondence** (only if and to the extent required)

L. **Technical Literature** (if agreed by parties).

S. **Skeletons**

T. **Transcripts**

X. **Documents handed up at trial**

CXX[witness initials] – those documents provided by the Claimant for cross examination

DXX[witness initials] – those documents provided by the Defendant for cross-examination

Any other documents which are case specific can be included with the parties' agreement in bundles using any of the remaining letters.

Notes on bundles

Bundle indices

There is no need to repeat the whole title of the action on the index: it is better to aim to get the entire index to a bundle on one sheet.

An index should be intelligent: thus "Exhibit AGS3 to the first affidavit of Anthony Graham Snooks" is not as helpful as "AGS3 - 1989 Accounts".

It should be made clear in the index if documents are amended, redacted/non-confidential or contain confidential information.

Front- and back-sheets

Front- and back-sheets should be discarded from copy documents in the bundles. For exhibits, the exhibit number should instead be written in the top right-hand corner of the first page. This makes it easier to identify the document when looking for it in the bundle.

Bundle labels

Bundles should be clearly labelled with a brief description of their contents. There is no need to repeat the entire title of the action. Ideally a large sticker, legible at a distance (e.g. "B.1 PLDGS") should be used. Remember people have to find bundles in a rack or stand.

A similar sticker should appear in the top left inside of the bundle - so that the reader can see which bundle he is looking at without having to look at the front.

Binders

All bundles should be strong enough for practical use. Both ring binders (preferably with locking devices) and lever-arch are suitable. Do not use large lever-arch files for a small quantity of documents. In the case of both, do not overload. Binding techniques which mean that the bundle will not lie open should be avoided.

Different colours for different volumes aids ready identification, although clear labels can do the same job. A different colour for the confidential bundles is much encouraged.