STATUTORY INSTRUMENTS

1978 No. 955 (S.84)

COURT OF SESSION, SCOTLAND

Act of Sederunt (Rules of Court Amendment No. 8) (Patent Rules) 1978

Made - - - -	*7th July* 1978
Coming into Operation	*1st August* 1978

The Lords of Council and Session, under and by virtue of the powers conferred upon them by section 16 of the Administration of Justice (Scotland) Act 1933**(a)**, and Section 34(3), 40(6), 92(4) and 94 of the Patents Act 1977**(b)** and of all other powers enabling them in that behalf, do hereby enact and declare:

Citation, commencement and interpretation

1.—(1) This Act of Sederunt may be cited as the Act of Sederunt (Rules of Court Amendment No. 8) (Patent Rules) 1978 and shall come into operation on 1st August 1978.

(2) This Act of Sederunt shall be entered in the Books of Sederunt.

(3) The Interpretation Act 1889**(c)** applies to the interpretation of this Act of Sederunt as it applies to the interpretation of an Act of Parliament.

(4) In this Act of Sederunt, unless the context otherwise requires, "rule" means a rule contained in the Rules of the Court of Session**(d)**.

Amendments relating to assessors

2.—(1) In rule 37 (assessors), for the words "in an action for the infringement of a patent" and the words "in any action for the infringement of a patent" substitute in each case the words "in any proceedings under the Patents Act 1949 or the Patents Act 1977".

(2) In rule 44 (remuneration of assessors), in paragraph (4), insert after the words "nautical assessor" the words "or an assessor in any proceedings under the Patents Act 1949 or the Patents Act 1977".

Amendment relating to officer of European Patent Office

3. In rule 102A, at the end add the following paragraph—

"(4). Where, on an application under section 1 of the Evidence (Proceedings in Other Jurisdictions) Act 1975 as applied by section 92 of the Patents Act 1977, an order is made for the evidence of witnesses to be taken, the Court may, on an application in that behalf made to it by way of motion before that evidence is taken, allow an officer of the European Patent Office to attend the hearing and examine the witnesses or to request the Court or Commissioner before whom the hearing takes place to put specified questions to the witnesses".

(a) 1933 c. 41. **(b)** 1977 c. 37. **(c)** 1889 c. 63. **(d)** S.I. 1965/321.

Amendment relating to petitions

4. In rule 189 (Outer House Petitions), in sub-paragraph (xvii) of paragraph (*a*), at the end add the words "and the Patents Act 1977;".

New Patent Rules

5. In the Rules of the Court of Session in Chapter IV (Petitions) for Section 9 substitute—

"SECTION 9—Petitions and other proceedings under the Patents Acts 1949 to 1961 and 1977 and the Registered Designs Acts 1949 to 1971 and the Defence Contracts Act 1958.

250. *Interpretation*

In this Section of these rules—

"the 1949 Act" means the Patents Act 1949;

"the 1977 Act" means the Patents Act 1977;

"the comptroller" means the Comptroller-General of Patents, Designs and Trade Marks;

"existing patent" means a patent mentioned in Section 127(2)(*a*) or (*c*) of the 1977 Act;

"the journal" means the journal published pursuant to rules made under section 123(6) of the 1977 Act;

"1977 Act patent" means a patent under the 1977 Act;

"patent" means an existing patent or a 1977 Act patent.

251. *Assignment of proceedings*

All proceedings under the Patents Acts 1949 to 1961 and 1977, the Registered Designs Acts 1949 to 1961 and the Defence Contracts Act 1958, and all proceedings for the determination of a question relating to a patent under the inherent jurisdiction of the Court, shall be assigned to such Lord Ordinary as the Lord President may for the time being appoint to hear such proceedings, and who shall be known as the Patent Judge.

252. *Affidavits*

(1) In all proceedings under this Section evidence submitted in the form of affidavits shall be admissible in place of parole evidence, if on an application by a party in that behalf, the Court so directs.

(2) Subject to the terms of any such direction, or of any subsequent order of the Court, the deponent of any affidavit in respect of which such a direction is made shall not be subject to cross-examination and need not attend any hearing for that purpose.

253. *Application for leave to amend specification under section 30 of the 1949 Act or section 75 of the 1977 Act*

(1) A patentee or the proprietor of a patent intending to apply under section 30 of the 1949 Act or under section 75 of the 1977 Act for leave to amend his specification shall give notice of his intention to the comptroller accompanied by a copy of an advertisement—

(*a*) identifying the proceedings pending before the Court in which it is intended to apply for such leave;

(*b*) giving particulars of the amendment sought;

(*c*) stating the applicant's address for service within the United Kingdom, and

(*d*) stating that any person intending to oppose the amendment who is not a party to the proceedings must within 28 days after the appearance of the advertisement give written notice of his intention to the applicant;

and the comptroller shall insert the advertisement once in the journal.

(2) A person who gives notice in accordance with the advertisement shall be entitled to be heard on the application subject to any order of the Court as to expenses.

(3) As soon as may be after the expiration of 35 days from the appearance of the advertisement the applicant shall make his application under the said section 30 or 75, as the case may be, by motion in the proceedings pending before the Court; and intimation of the motion, together with a copy of the specification certified by the comptroller and showing in coloured ink the amendment sought, must be made to—

(*a*) the comptroller;

(*b*) the other parties to the proceedings; and

(*c*) any person who has intimated his intention to oppose the amendment.

(4) On the hearing of the motion the Court shall make such order for further procedure as it thinks necessary or expedient, and any such order shall—

(*a*) require the applicant and any party or person opposing the amendment to exchange statements by way of Minute and Answers or otherwise, of the grounds for allowing the amendment and for refusing it;

(*b*) determine whether the hearing of the motion shall be heard at the same time as the hearing of the pending proceedings before the Court relating to the patent in question or at different times;

(*c*) determine the manner in which the evidence shall be given and, if the evidence is to be given by affidavits, the times within which the affidavits must be lodged.

(5) Where the Court allows a specification to be amended, the applicant shall forthwith lodge with the comptroller an office copy of the order made by the Court and, if so required by the Court or comptroller, leave at the Patent Office a new specification and drawings as amended, prepared in compliance with the 1949 or 1977 Act, whichever is applicable, and the rules made under those Acts respectively. The comptroller shall cause a copy of the order to be inserted at least once in the journal.

254. *Application for revocation of patent*

(1) An application under section 72 of the 1977 Act for the revocation of a patent shall be made by way of petition, except that where there are pending proceedings between the same parties before the Court in relation to the patent in question such application may be made by way of counterclaim in those proceedings and rule 84 shall apply to any such counterclaim.

(2) The respondent to a petition under section 32 of the 1949 Act or section 72 of the 1977 Act must lodge answers to the petition within 21 days after service of the petition on him.

255. *Proceedings for infringement*

(1) In any proceedings where it is alleged that a patent has been infringed, the person alleging infringement must aver in the petition or summons, as the case may be, particulars of the infringement relied on, showing which of the claims in the specification of the patent are alleged to have been infringed and giving at least one instance of each type of infringement alleged.

(2) If, as a defence to that allegation, it is averred that at the time of the infringement there was in force a contract or licence relating to the patent made by or with the consent of the person alleging the infringement and containing a condition or term void by virtue of section 44 of the 1977 Act, the person stating that defence must aver particulars of the date of, and the parties to, each such contract or licence and particulars of each such condition or term.

256. *Objections to validity of patent*

(1) A person who—

(*a*) presents a petition under section 32 of the 1949 Act or section 72 of the 1977 Act for revocation of a patent, or

(*b*) being a party to an action concerning a patent, either questions the validity of the patent or applies by counterclaim in the action for revocation of the patent,

must make specific averments in his pleadings of the objections to the validity of the patent on which he relies, including the grounds on which the validity of the patent is questioned and the issues which it is intended to raise.

(2) If those grounds include either—

(*a*) want of novelty; or

(*b*) want of any inventive step,

the averments must include the manner, time and place of every prior publication or user relied upon, and, if prior user is alleged, must—

(i) specify the name of every person alleged to have made such user,

(ii) state whether such user is alleged to have continued until the priority date of the claim in question or of the invention, as may be appropriate, and, if not, the earliest and latest date on which such user is alleged to have taken place,

(iii) contain a description accompanied, if necessary, by drawings sufficient to identify such user, and

(iv) if such user relates to machinery or apparatus, state whether the machinery or apparatus is in existence and where it can be inspected.

(3) If in the case of an existing patent—

(*a*) one of those grounds is that the invention, so far as claimed in any claim of the complete specification, is not useful, and

(*b*) it is intended, in connection with that ground, to rely on the fact that an example of the invention which is the subject of any such claim cannot be made to work, either at all or as described in the specification,

the averments must specify that fact and identify each such claim and must include particulars of each such example, specifying the respects in which it is alleged that it does not work or does not work as described.

257. *Determination of question or application where comptroller declines to deal with it*

(1) 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 that Act, or

(*c*) certifies under section 72(7)(*b*) of that Act that the question whether a patent should be revoked is one which would more properly be determined by the Court,

any person entitled to do so may, within 28 days after the comptroller's decision, commence proceedings by way of petition to have the question or application determined by the Court.

(2) A petition under paragraph (1)(*a*) or (*c*) shall specify the question to be determined by the Court, and shall set out in the prayer the determination the petitioner requests the Court to make in relation to that question.

257A. *Application by employee for compensation under Section 40 of the 1977 Act*

An application by an employee for compensation under section 40(1) or (2) of the 1977 Act shall be made by way of an action commenced within the period which begins when the relevant patent is granted and which expires one year after it has ceased to have effect: Provided that, where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the period prescribed for the payment thereof and an application for restoration is made to the comptroller under section 28 of that Act, the said period shall—

(*a*) if restoration is ordered, continue as if the patent had remained continuously in effect, or

(*b*) if restoration is refused, be treated as expiring one year after the patent ceased to have effect or 6 months after the refusal, whichever is later.

257B. *Appeals from the comptroller*

(1) Subject to the provisions of this rule, an appeal to the Court from a decision of the comptroller in any case in which a right of appeal is given by the 1949 or 1977 Act shall be heard by the Patent Judge; and rule 290 shall apply to any such appeal as if it were an appeal under that rule to the Inner House, with the substitution for references to the Inner House of references to the Outer House, and for references to single bills of references to the motion roll.

(2) A note of appeal shall be lodged in the General Department—

(*a*) in the case of a decision on a matter of procedure, within 14 days after the date of the decision; and

(*b*) in any other case, within 6 weeks after the date of the decision.

(3) Any decision of the comptroller that any particular decision is a matter of procedure shall be treated by the Court as itself being a decision on a matter of procedure.

(4) Intimation under rule 290(*e*) shall be ordered to be made on the comptroller and any other party to the proceedings before the comptroller within 5 days of the making of the order for intimation.

(5) On receiving intimation of the appeal the comptroller shall forthwith transmit to the Deputy Principal Clerk of Session all the papers relating to the matter which is the subject of the appeal.

(6) A respondent who, not having appealed from the decision of the comptroller, proposes to contend at the hearing of the appeal that the decision or the grounds of the decision should be varied must specify the grounds of that contention in his answers, and shall intimate those answers to the comptroller and the other parties to the proceedings on lodging them.

(7) Intimation of the date of the hearing of the appeal shall be made to the comptroller by the appellant not less than 7 days prior to that date, unless the Court otherwise directs.

(8) An appeal under this rule shall be by way of rehearing but no matter shall be raised at the rehearing that was not raised before the comptroller, unless the Court otherwise directs.

(9) Except with leave of the Court, no appeal under this rule shall be entertained unless the time limits specified in paragraph (2) have been complied with, or within such further time as the comptroller may allow upon request made to him within those limits.

257C. *Appeals to the Inner House*

In the case of an appeal to the Inner House from a decision of the Patent Judge on an appeal from a decision of the comptroller, the appellant must intimate the appeal to the comptroller.

257D. *Communication of information to European Patent Office*

(1) The Court may authorise the communication to the European Patent Office or the competent authority of any country which is a party to the European Patent Convention of any such information in the records of the Court as the Court thinks fit.

(2) Before complying with a request (made by way of letter or otherwise) for the disclosure of information under paragraph (1), the Court shall afford to any party appearing to be affected by the request the opportunity of making representations on the question whether the information should be disclosed.

257E. *Proceedings for determination of certain disputes*

A reference or application to the Court under the following enactments shall be made by way of petition, that is to say—

(*a*) any reference under

(i) Section 48 of the 1949 Act or section 58 of the 1977 Act;

(ii) paragraph 3 of Schedule 1 to the Registered Design Act 1949, or

(iii) section 4 of the Defence Contracts Act 1958;

(*b*) any application under section 45(3) of the 1977 Act

and any such reference or application may, on the application of any party to the proceedings, be treated as a commercial cause in accordance with the provisions of rule 148.

257F. *Applications for Rectification of Register of Patents or Designs*

(1) An application to the Court for an order that the Register of Patents or the Register of Designs be rectified must be made by way of petition, except where it is made by a counter claim in proceedings for infringement.

(2) Where the application relates to the Register of Patents, the applicant shall forthwith intimate the application to the comptroller, who shall be entitled to lodge answers and be heard on the application.

257G. *Counter claim for Rectification of Register of Designs.*

(1) Where in any proceedings an infringement of the copyright in a registered design is alleged, the party against whom the allegation is made may put in issue the validity of the registration of that design or may counter claim for an order that the Register of Designs be rectified by cancelling or varying the registration or may do both those things.

(2) A party to any such proceedings who counter claims for an order that the Register of Designs be rectified must intimate to the comptroller a copy of the counter claim and the comptroller shall be entitled to take such part in the proceedings as he thinks fit but need not lodge answers unless ordered to do so by the Court.

257H. *General Power of Court to Direct Procedure*

Notwithstanding the provisions contained in this section, the Court may on cause shown given such order or different directions in matters of procedure as it may consider just and expedient in the circumstances."

G. C. Emslie,
I.P.D.

Edinburgh.
7th July 1978.

EXPLANATORY NOTE

(This Note is not part of the Act of Sederunt.)

This Act of Sederunt makes new provision in the Rules of the Court of Session in respect of proceedings under the Patents Act 1949 (c. 87) and the Patents Act 1977.

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