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STATUTORY INSTRUMENTS

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**2007 No. 3291**

**The Patents Rules 2007**

**PART 7**

**PROCEEDINGS HEARD BEFORE THE COMPTROLLER**

*Introductory*

**Scope and interpretation**

- 73.**—(1) This Part applies to the following proceedings heard before the comptroller—
- (a) applications, references and requests under the provisions mentioned in Part 1 of Schedule 3;
  - (b) oppositions under the provisions mentioned in Part 2 of that Schedule.
- (2) The rules listed in Part 4 of that Schedule apply to any proceedings heard before the comptroller under the Act.
- (3) In this Part—
- “claimant” means a person who starts proceedings or is treated as starting proceedings under rule 76(1);
  - “defendant” means a person who files a counter-statement under rule 77(6) or (8);
  - “statement of case” means the statement of grounds or the counter-statement and references to a statement of case include part of the statement of case;
  - “statement of grounds” means a statement filed by the claimant;
  - “statement of truth” means a statement that the person making the statement believes that the facts stated in a particular document are true; and
  - “witness statement” means a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

**Overriding objective**

- 74.**—(1) The rules in this Part set out a procedural code with the overriding objective of enabling the comptroller to deal with cases justly.
- (2) Dealing with a case justly includes, so far as is practicable—
- (a) ensuring that the parties are on an equal footing;
  - (b) saving expense;
  - (c) dealing with the case in ways which are proportionate—
    - (i) to the amount of money involved,
    - (ii) to the importance of the case,
    - (iii) to the complexity of the issues, and

- (iv) to the financial position of each party;
  - (d) ensuring that it is dealt with expeditiously and fairly; and
  - (e) allotting to it an appropriate share of the resources available to the comptroller, while taking into account the need to allot resources to other cases.
- (3) The comptroller shall seek to give effect to the overriding objective when he—
- (a) exercises any power given to him by this Part; or
  - (b) interprets any rule in this Part.
- (4) The parties are required to help the comptroller to further the overriding objective.

### **Publication of notices**

**75.** The comptroller must advertise in the journal any event to which it is possible to object under any of the provisions mentioned in Part 2 or 3 of Schedule 3, subject to rule [105\(5\)](#).

### *Conduct of hearings*

### **Starting proceedings**

- 76.**—(1) Proceedings are started when a person files in duplicate—
- (a) the relevant form; and
  - (b) his statement of grounds.
- (2) Any person may give notice of opposition—
- (a) in the case of section 75(2), before the end of the period of two weeks beginning with the date of the relevant notice; and
  - (b) in the case of any of the other provisions mentioned in Part 2 of Schedule 3, before the end of the period of four weeks beginning with the date of the relevant notice.
- (3) For the purposes of this rule and rule [77](#)—
- “relevant form” means—
- (a) in relation to applications or requests under the provisions of the Medicinal Products Regulation or the Plant Protection Products Regulation mentioned in Part 1 of Schedule 3, Patents Form SP3;
  - (b) in relation to applications, references or requests under any other provision mentioned in Part 1 of that Schedule, Patents Form 2; and
  - (c) in relation to oppositions under the provisions mentioned in Part 2 of that Schedule, Patents Form 15; and
- “relevant notice” means the advertisement in the journal mentioned in rule 75.
- (4) A statement of grounds must—
- (a) include a concise statement of the facts and grounds on which the claimant relies;
  - (b) in the case of rule 89(5), include the grounds of objection to the draft licence;
  - (c) where appropriate, include the period or terms of the licence which he believes are reasonable;
  - (d) specify the remedy which he seeks;

- (e) where it accompanies an application under the Compulsory Licensing Regulation<sup>(1)</sup>, include any information required by that Regulation;
- (f) be verified by a statement of truth; and
- (g) comply with the requirements of Part 1 of Schedule 2.

### **Notification of the parties**

77.—(1) The comptroller must notify the applicant for, or proprietor of, the patent which is the subject matter of the case that proceedings have started.

(2) In addition, the comptroller may notify any persons who appear to him to be likely to have an interest in the case that proceedings have started.

(3) But where a person mentioned in paragraph (1) or (2)—

- (a) is the claimant; or
- (b) has indicated in writing to the comptroller that he supports the claimant's case,

the comptroller has no duty to notify him.

(4) The comptroller must send the relevant form and the statement of grounds with the notification under paragraph (1) or (2).

(5) In that notification, the comptroller must specify a period within which the persons notified may file a counter-statement.

(6) Any counter-statement must be filed in duplicate before the end of the period specified under paragraph (5).

(7) But paragraphs (5) and (6) do not apply to an opposition under any of the provisions mentioned in Part 3 of Schedule 3.

(8) In such oppositions, any counter-statement must be filed in duplicate before the end of the period of four weeks beginning with the date of the relevant notice.

(9) Where—

- (a) a person was notified under paragraph (1) or (2); and
- (b) that person fails to file a counter-statement under paragraph (6) or (8),

the comptroller shall treat him as supporting the claimant's case.

(10) The period prescribed for the purposes of giving notice to the comptroller under section 47(6) of opposition to cancellation of an entry made under section 46 that licences are available as of right is the period prescribed by paragraph (8).

### **The counter-statement**

78.—(1) Any counter-statement filed by the defendant must—

- (a) state which of the allegations in the statement of grounds he denies;
- (b) state which of the allegations he is unable to admit or deny, but which he requires the claimant to prove;
- (c) state which of the allegations he admits;
- (d) be verified by a statement of truth; and
- (e) comply with the requirements of Part 1 of Schedule 2.

(2) Where the defendant denies an allegation—

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(1) OJ No L 157, 9.6.2006, p1.

- (a) he must state his reasons for doing so; and
  - (b) if he intends to put forward a different version of events from that given by the claimant, he must state his own version.
- (3) A defendant who fails to deal with an allegation in a counter-statement shall be taken to admit that allegation.
- (4) But a defendant who—
- (a) fails to deal with an allegation; but
  - (b) has set out in his counter-statement the nature of his case in relation to the issue to which the allegation is relevant,
- shall be taken to require the allegation to be proved.

### **Copies of documents**

- 79.**—(1) Where a relevant statement refers to any other document, a copy of that document must accompany the relevant statement.
- (2) Where more than one copy of a relevant statement is filed, each copy of the statement must be accompanied by a copy of any document referred to in the statement.
- (3) But paragraphs (1) and (2) do not apply where—
- (a) the relevant statement is sent to the comptroller; and
  - (b) the document referred to in the relevant statement was published by the comptroller or is kept at the Patent Office.
- (4) In this rule “relevant statement” means a witness statement, statement of case, affidavit or statutory declaration.

### **Evidence rounds and the hearing**

- 80.**—(1) When the defendant files a counter-statement, the comptroller must as soon as practicable—
- (a) send the counter-statement to the claimant; and
  - (b) specify the periods within which evidence may be filed by the claimant and the defendant.
- (2) The comptroller may, at any time he thinks fit, give leave to either party to file evidence upon such terms as he thinks fit.
- (3) Under this rule, evidence shall only be considered to be filed when—
- (a) it has been received by the comptroller; and
  - (b) it has been sent to all the other parties to the proceedings.
- (4) The comptroller must then give the parties an opportunity to be heard.
- (5) If any party requests to be heard, the comptroller must send to the parties notice of a date for the hearing.
- (6) When the comptroller has decided the matter he must notify all the parties of his decision, including his reasons for making the decision.

### **Alteration of time limits**

- 81.**—(1) The comptroller may extend or shorten (or further extend or shorten) any period of time which has been specified under any provision of this Part.

(2) An extension may be granted under paragraph (1) notwithstanding the period of time specified has expired.

### **General powers of the comptroller in relation to proceedings before him**

**82.**—(1) Except where the Act or these Rules otherwise provide, the comptroller may give such directions as to the management of the proceedings as he thinks fit, and in particular he may—

- (a) require a document, information or evidence to be filed;
  - (b) require a translation of a specification of a patent or application or any other document which is not in English;
  - (c) require a party or a party's legal representative to attend a hearing;
  - (d) hold a hearing and receive evidence by telephone or by using any other method of direct oral communication;
  - (e) allow a statement of case to be amended;
  - (f) stay the whole, or any part, of the proceedings either generally or until a specified date or event;
  - (g) consolidate proceedings;
  - (h) direct that part of any proceedings be dealt with as separate proceedings; and
  - (i) direct that the parties attend a case management conference or pre-hearing review.
- (2) The comptroller may control the evidence by giving directions as to—
- (a) the issues on which he requires evidence;
  - (b) the nature of the evidence which he requires to decide those issues; and
  - (c) the way in which the evidence is to be placed before him,

and the comptroller may use his power under this paragraph to exclude evidence which would otherwise be admissible.

- (3) When the comptroller gives directions under any provision of this Part, he may—
- (a) make them subject to conditions; and
  - (b) specify the consequence of failure to comply with the directions or a condition.

### **Striking out a statement of case and summary judgment**

**83.**—(1) A party may apply to the comptroller for him to strike out a statement of case or to give summary judgment.

- (2) If it appears to the comptroller that—
- (a) the statement of case discloses no reasonable grounds for bringing or defending the claim;
  - (b) the statement of case is an abuse of process or is otherwise likely to obstruct the just disposal of the proceedings; or
  - (c) there has been a failure to comply with a section, a rule or a previous direction given by the comptroller,

he may strike out the statement of case.

(3) The comptroller may give summary judgment against a claimant or defendant on the whole of a case or on a particular issue if—

- (a) he considers that—
  - (i) that claimant has no real prospect of succeeding on the case or issue, or

- (ii) that defendant has no real prospect of successfully defending the case or issue; and
- (b) there is no other compelling reason why the case or issue should be disposed of at a hearing.

### **Hearings in public**

**84.**—(1) Subject to paragraphs (3) and (4), any hearing before the comptroller in proceedings relating to an application for a patent, or a patent, shall be held in public.

(2) Any party to the proceedings may apply to the comptroller for a hearing to be held in private.

(3) The comptroller may grant an application under paragraph (2) where—

- (a) he considers there is good reason for the hearing to be held in private; and
- (b) all the parties to the proceedings have had an opportunity to be heard on the matter,

and where the application is granted the hearing must be held in private.

(4) Any hearing—

- (a) of an application under paragraph (2); or
- (b) relating to an application for a patent which has not been published,

shall be held in private.

(5) For the purposes of this rule a reference to a hearing includes any part of a hearing.

### *Miscellaneous*

### **Security for costs or expenses**

**85.**—(1) The conditions prescribed for the purposes of making an order for security for costs under section 107(4) are that the party against whom the order is made—

(a) is resident outside the United Kingdom, but not resident in—

- (i) a Brussels Contracting State,
- (ii) a Lugano Contracting State, or
- (iii) a Regulation State,

as defined in section 1(3) of the Civil Jurisdiction and Judgments Act 1982(2);

- (b) is a company or other body (whether incorporated inside or outside the United Kingdom) and there is reason to believe that it will be unable to pay another party's costs if ordered to do so;
- (c) has changed his address for service with a view to evading the consequences of the litigation;
- (d) has furnished an incorrect address for service; or
- (e) has taken steps in relation to his assets that would make it difficult to enforce an order for costs against him.

(2) In relation to proceedings in Scotland, references in this rule to costs are references to expenses.

(2) 1982 c. 27; section 1(3) was substituted by SI 1990/2591, and then amended by section 2(5) and (6) of the Civil Jurisdiction and Judgments Act 1991 (c. 12) and by SI 2000/1824 and 2001/3929.

### **Powers of comptroller to compel attendance of witnesses and production of documents**

**86.** The comptroller shall have the powers of a judge of the High Court (in Scotland, the Court of Session) as regards—

- (a) the attendance of witnesses; and
- (b) the discovery and production of documents,

but he shall have no power to punish summarily for contempt.

### **Evidence in proceedings before the comptroller**

**87.**—(1) Subject to paragraphs (2) to (5), evidence filed under this Part may be given—

- (a) by witness statement, statement of case, affidavit, statutory declaration; or
- (b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement or a statement of case may only be given in evidence if it includes a statement of truth.

(3) Evidence is to be by witness statement unless the comptroller directs or any enactment requires otherwise.

(4) A witness statement, affidavit or statutory declaration must comply with the requirements of Part 1 of Schedule 2, unless the comptroller otherwise directs.

(5) For the purposes of this Part a statement of truth must be dated and signed by—

- (a) in the case of a witness statement, the person making the statement; and
- (b) in any other case, the party or his legal representative.

### **Proceedings in Scotland**

**88.**—(1) Where there is more than one party to proceedings, a party to the proceedings may apply to the comptroller to hold proceedings in Scotland.

(2) An application made under paragraph (1) must be granted—

- (a) where all the parties consent to the proceedings being held in Scotland; or
- (b) where the comptroller considers it appropriate.

(3) A refusal of an application made under paragraph (1) is excepted from the right of appeal conferred by section 97.

### **Proceedings started under section 46(3) by a person other than the proprietor**

**89.**—(1) An application by a person other than the proprietor to the comptroller under section 46(3)(a) or (b) must be—

- (a) made on Patents Form 2; and
- (b) accompanied by two copies of the draft of the licence he proposes should be granted.

(2) The comptroller must notify the proprietor of the patent that an application has been made.

(3) The comptroller must send a copy of the draft licence with the notification.

(4) In the notification, the comptroller must specify a period within which the proprietor may file a statement of grounds.

(5) The proprietor must file a statement of grounds in accordance with rule 76(4); otherwise he shall be treated as supporting the applicant's case.

(6) Proceedings shall continue under this Part as if they had been started under rule 76(1) and for those purposes the proprietor shall be “the claimant” and the applicant shall be “the defendant”.

**Licences following entitlement proceedings**

**90.**—(1) The period prescribed for the purposes of section 11(3) and (3A) shall be two months beginning with—

- (a) where section 11 is applied by section 12(5), the date on which the order under section 12(1) was made; and
- (b) in any other case, the date on which the order under section 8 was made.

(2) The period prescribed for the purposes of section 38(3) shall be two months beginning with the date on which the order mentioned in section 38(2) was made.

**Period prescribed for applications by employee for compensation**

**91.**—(1) The period prescribed for the purposes of section 40(1) and (2) shall be the period beginning with the date of grant of the patent and ending one year after the patent ceased to have effect.

(2) But if an application for restoration is made under section 28 and—

- (a) the application is granted, the period prescribed under paragraph (1) shall continue as if the patent had remained continuously in effect; or
- (b) the application is refused, the period prescribed for the purposes of section 40(1) and (2) shall be—
  - (i) the period prescribed under paragraph (1), or
  - (ii) if it expires later, the period of six months beginning with the date on which the application was refused.