



HM Courts &  
Tribunals Service

# The Intellectual Property Enterprise Court Guide

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By authority of the Chancellor of the High Court

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# 1. General

## 1.1 Introduction

This is the general Guide to the Intellectual Property Enterprise Court (the IPEC). It is written for all users of the IPEC, whether a litigant in person or a specialist IP litigator.

The Guide aims to help users and potential users of the IPEC by explaining how the procedures will operate, providing guidelines where appropriate and dealing with various practical aspects of proceedings before the IPEC.

The IPEC has a multi-track and a small claims track. This means that there are two alternative procedures for making a claim in the IPEC. The IPEC multi-track has a limit on damages of up to £500,000. Costs orders will be made which are proportionate to the nature of the dispute and subject to a cap of no more than £50,000. The small claims track is for suitable claims in the IPEC with a value of up to £10,000. Costs orders on the small claims track are highly restricted.

The focus of this Guide is the IPEC's multi-track. There is a separate Guide for the IPEC's small claims track.

The Guide cannot be wholly comprehensive of all issues which may arise on the multi-track in the IPEC. In circumstances which are not covered by this guide, reference may be made to the Patents Court Guide and the Chancery Guide. See paragraph 3.12 below for where to find these and also the IPEC Small Claims Guide.

### Civil Procedure Rules

Throughout this Guide there will be reference to the Civil Procedure Rules and also to Practice Directions which set out how the Rules are to be applied. These are generally abbreviated to 'CPR' and 'PD' respectively. The Civil Procedure Rules are divided into 'Parts', each of which is concerned with an aspect of the rules.

A rule is identified by the Part in which it is found and the number of the rule. Thus, for instance, 'CPR r63.2' is rule 2 in Part 63 and 'CPR r63.27(1)(a)' refers to sub-rule (1)(a) of rule 27 in Part 63. The Parts are also often divided into 'Sections' and where it is appropriate the relevant Section of the Part will be identified. In most instances in this Guide 'CPR' will be taken as read, so the rule and sub-rule just mentioned, for example, will be referred to as 'r63.2' and 'r63.27(1)(a)'.

Practice Directions are also identified by the Part in which they fall, by paragraph number and sometimes by the relevant Section of the Practice Direction, e.g. 'PD 30 para. 9.1' or 'PD 45 Section IV'.

The Civil Procedure Rules, including the Practice Directions, are contained in a publication usually referred to as 'The White Book' and are also available on the court service website, see paragraph 3.12 below.

### History of the IPEC

Following the report of the Committee chaired by Sir Derek Oulton in 1987, the Patents County Court (PCC) was set up in 1990. The PCC was intended to provide a less costly and less complex alternative to the High Court, Patents Court. The Patents Court is intended for larger and more complex claims.

Based initially in Wood Green in North London, the PCC moved to Park Crescent near Regent's Park in the West End of London in the mid 1990s. In 2002 the court moved to Field House, Breams

Buildings, and to St Dunstan's House, Fetter Lane in 2008.

In June 2009, the Intellectual Property Court Users' Committee (IPCUC) published a consultation paper setting out proposals for reform of the PCC and in July 2009 the working party's final report was published. The proposals were adopted in the final report of the Review of Civil Litigation Costs by Lord Justice Jackson and on 1st October 2010 a new set of procedures was implemented in the PCC.

In 2011 the PCC moved to the Rolls Building along with the Chancery Division of the High Court (including the Patents Court), the Commercial Court and the Technology and Construction Court.

Following on from the proposals set out in the Jackson Review and in response to a further recommendation made in the Hargreaves Review, a small claims track within the PCC was set up and came into effect on 1 October 2012.

On 1st October 2013 the PCC was reconstituted as a specialist list in the Chancery Division of the High Court to form the Intellectual Property Enterprise Court (IPEC). The reference to "intellectual property" in the name of the court is intended to recognise its broad intellectual property jurisdiction.

The practices and procedures in the IPEC after reconstitution are and are intended to be the same as the practices and procedures in the PCC before reconstitution. Save for a few minor adjustments to the rules which would have been desirable even if the court had not been reconstituted, the provisions of the Rules and Practice Directions applicable in the IPEC are identical to the Rules and Practice Directions which were applicable in the PCC.

### **Transitional provisions**

The transitional provisions governing the reconstitution of the PCC as the IPEC are set out in The Civil Procedure (Amendment No. 7) Rules 2013, SI 2013 No. 1974 (L.19) paragraph 30. Generally it will be sufficient to know the following. Proceedings which were already in the PCC as at 1st October 2013 will continue in the IPEC afterwards as if they had been started in that court (paragraph 30(a)). Anything done in accordance with the rules which applied in the PCC before reconstitution will be treated as being done in accordance with the corresponding rules of the IPEC (paragraph 30(b)) and any judgment or order of the PCC has the same effect as if it had been a judgment or order of the IPEC (paragraph 30(c)).

## **1.2 Jurisdiction**

The IPEC is set up to handle intellectual property cases of all kinds including patents, designs (registered and unregistered, Community and UK national), trade marks (UK and Community), passing off, copyright, database right, other rights conferred by the Copyright Designs and Patents Act 1988 and actions for breach of confidence.

For example, the IPEC may hear and determine actions and counterclaims for:

- Infringement of patents, designs, trade marks, copyright and other intellectual property rights
- Revocation or invalidity of patents, registered designs and trade marks
- Amendment of patents
- Declarations of non-infringement
- Determination of entitlement to a patent, design or any other intellectual property
- Employee's compensation in respect of a patented invention
- Unjustified threats of proceedings for infringement of patents, designs or trade marks
- Misuse of trade secrets and other breaches of confidence.

As part of the Chancery Division the IPEC has jurisdiction over any case which can be heard before that Division. Consequently the IPEC may hear proceedings primarily concerned with intellectual property but covering other subject matter, such as breach of fiduciary duty, defamation or malicious falsehood.

### **(a) Legal basis for jurisdiction of the IPEC**

The IPEC is as specialist list within the Chancery Division of the High Court and is administered at the Rolls Building. Whereas the basis for the jurisdiction of its predecessor court, the PCC, was a complex matter derived in part from the Copyright Designs and Patents Act 1988 and from other sources, the nature of the IPEC as a specialist list in the Chancery Division, means it has the same jurisdiction as the High Court and the former complexities relating to the jurisdiction of the PCC, no longer arise.

### **The small claims track**

The jurisdiction of the IPEC small claims track is a subset of the normal jurisdiction of the IPEC available on the IPEC multi-track. CPR r63.27(1)(a) limits the kinds of intellectual property claim which may be allocated to the IPEC small claims track. The IPEC small claims track may deal with any IP claim within the jurisdiction of the IPEC save for those referred to in r63.2. In practice this means the small claims track may hear claims relating to copyright, trade marks and passing off, and unregistered designs (UK or Community) and breach of confidence. Claims relating to patents, registered designs (UK or Community) and plant varieties may only be heard on the IPEC multi-track.

### **(b) Applicable rules of procedure**

The rules applicable to proceedings started in or transferred to the IPEC are as follows:

- The general Civil Procedure Rules (CPR) provide the framework for proceedings in the IPEC as they apply to all civil courts in England and Wales.
- CPR Part 63 – Intellectual Property Claims applies to all intellectual property claims. Part 63 includes rules specific to intellectual property cases and in some areas modifies the general parts of the CPR.
- Practice Direction 63 (PD 63) supplements CPR Part 63.
- Part 63 and PD 63 are arranged in sections as follows:
  - Section I relates to proceedings which concern patents and registered designs (Community or national). It is applicable to proceedings in the IPEC which relate to those rights.
  - Section II allocates all other IP cases to particular courts including the Chancery Division, the IPEC and certain county courts where there is a Chancery District Registry.
  - Section III deals with service of documents and participation by the Comptroller.
  - Section IV does not relate to proceedings in the IPEC.
  - Section V relates to all proceedings started in or transferred to the IPEC. This section contains the new procedural rules applicable after 1st October 2010 with minor modifications introduced since then.
- Attention is drawn to two other parts of the general CPR which contain provisions specific to the IPEC:
  - Part 30 and in particular PD 30 paras. 9.1 and 9.2 which relate to the transfer of proceedings to the IPEC from other courts and vice versa. Part 30 includes r30.5 which, when it applies to transfers to the IPEC from the County Court or from the Chancery Division, is modified by Part 63 r63.18.
  - Part 45 Section IV and Section IV of PD 45 which relate to costs.

### Transition between the PCC and the IPEC

Parts 63 and 45 of the CPR, and the relevant PDs have been amended to reflect the reconstitution of the IPEC as a specialist list of the Chancery Division and the renaming of the court from the PCC to the IPEC, with effect from 1<sup>st</sup> October 2013. Since the procedures in the IPEC are the same as the procedures in the PCC before reconstitution, the cases decided in the PCC before 1<sup>st</sup> October 2013 will generally remain applicable as precedents in the IPEC after 1<sup>st</sup> October 2013.

#### (c) Legal remedies

All the remedies available in the High Court are available in the IPEC including preliminary and final injunctions, damages, accounts of profits, delivery up and disclosure. In particular search and seizure (Anton Piller) and asset freezing (Mareva) orders are available in the IPEC.

There is one exception. The IPEC small claims track has the power to order final injunctions (and award damages and other final remedies) but not preliminary injunctions, search and seizure (Anton Piller) and asset freezing (Mareva) orders (r63.27(4)). All these remedies are however available on the IPEC multi-track.

#### (d) Enforcement

Orders of the IPEC are generally enforced in the same way as any other orders of the High Court in England and Wales. Orders for the payment of money can be enforced by obtaining information from judgment debtors (CPR rule 71), making charging orders (CPR rule 73) and in the other ways available under the CPR. All proceedings for the enforcement of any financial element of an IPEC judgment are dealt with by a district judge (r63.18(2)(c)). The IPEC has the power to commit for contempt of court and has the power to issue a bench warrant to secure attendance at court (see e.g. *Westwood v Knight* [2012] EWPC 14).

#### (e) The cap on damages in the IPEC

There is a cap on the damages recoverable in the IPEC of £500,000. The same cap also applies to the sum recoverable on an account of profits. The £500,000 figure does not include interest (save for interest due under an agreement) or costs (CPR r63.17A). The cap is a limit on the amount or value of the claim for damages (or an account). It is not an automatic cap on the value of the proceedings as a whole (such as the value of any injunction which may be sought).

The cap itself may be waived by agreement of the parties (CPR r63.17A(3)).

## 1.3 Allocation

The limit on damages available in the IPEC provides a clear distinction between that court and the other parts of the High Court such as the Patents Court and general Chancery Division. Otherwise there is no sharp dividing line between cases which should be brought in the IPEC and actions which should be brought in other courts.

In deciding which is the appropriate court in which to commence a claim, users should bear in mind that the IPEC has been established to handle the smaller, shorter, less complex, less important, lower value actions and the procedures applicable in the court are designed particularly for cases of that kind. The court aims to provide cheaper, speedier and more informal procedures to ensure that small and medium sized enterprises and private individuals are not deterred from innovation by the potential cost of litigation to safeguard their rights. Longer, heavier, more complex, more important and more valuable actions belong in the Patents Court or the general Chancery list of the High Court.

Parties may agree with each other to maintain a case in the IPEC if they wish to make use of the procedures available in it. The court will endeavour to accommodate parties in that respect. The

court will, however, maintain its list in such a way as to ensure that it maintains access to justice for small and medium sized enterprises and individuals.

If a party to litigation in either the IPEC or a different court believes that the other court is a more appropriate forum for the case, they should apply to transfer it. In the IPEC an application to transfer to a different court must be made at or before the case management conference (CPR rule 63.25(4)). There are a number of cases in which the transfer provisions now applicable were considered in the PCC. They include *ALK Abello v Meridian* [2010] EW PCC 014, *Caljan Rite-Hite v Solvex* [2011] EW HC 669 (Ch), *A.S. Watson v The Boots Company* [2011] EW PCC 26, *Comic Enterprises v Twentieth Century Fox* [2012] EW PCC 13, *Environmental Recycling v Stillwell* [2012] EWHC 2097 (Pat), *Destra v Comada* [2012] EW PCC 39.

The following guidelines are provided to assist users in determining which court is suitable:

- Size of the parties. If both sides are small or medium sized enterprises then the case may well be suitable for the IPEC. If one party is a small or medium sized enterprise but the other is a larger undertaking then again the case may be suitable for the IPEC but other factors ought to be considered such as the value of the claim and its likely complexity.
- The complexity of the claim. The procedure in the IPEC is streamlined and trials will seldom last more than 2 days. A trial which would appear to require more time than that even with the streamlined procedure of the IPEC is likely to be unsuitable.
- The nature of the evidence. Experiments in a patent case may be admitted in the IPEC but a case which will involve substantial complex experimental evidence will be unsuitable for the IPEC.
- Conflicting factual evidence. Cross-examination of witnesses will be strictly controlled in the IPEC. The court is well able to handle cases involving disputed factual matters such as allegations of prior use in patents and independent design as a defence to copying; but if a large number of witnesses are required the case may be unsuitable for the IPEC.
- Value of the claim. Subject to the agreement of the parties, there is a limit on the damages available in the IPEC of £500,000. However, assessing the value of a claim is not only concerned with damages. Putting a value on a claim is a notoriously difficult exercise, taking into account factors such as possible damages, the value of an injunction and the possible effect on competition in a market if a patent was revoked. As a general rule of thumb, disputes where the value of sales, in the UK, of products protected by the intellectual property in issue (by the owner, licensees and alleged infringer) exceeds £1 million per year are unlikely to be suitable for the IPEC in the absence of agreement.

### **Allocation between the IPEC multi-track and small claims track (r63.27)**

If the claim has a value of £10,000 or less and if it is concerned with the intellectual property rights applicable in the IPEC small claims track (essentially copyright, trade marks and passing off or unregistered design rights (UK or Community)) then that track is likely to be the appropriate track in the IPEC. Otherwise the case should proceed on the normal IPEC multi-track.

If the claimant in its Particulars of Claim states that it wishes the claim to be allocated to the small claims track and the defendant does not object, the claim will go to the small claims track provided it has the necessary features just referred to (value not more than £10,000 and it concerns appropriate intellectual property rights) (r63.27(1)). If the claim has those necessary features but the parties disagree about whether the claim should be heard in the small claims track, the court will allocate the claim to the appropriate track in accordance with Part 26 and in particular the criteria listed in r26.8 (r.63.27(3)).

The separate Guide to the IPEC small claims track deals with cases proceeding on that track.



### 1.4 The judges of the Intellectual Property Enterprise Court

The Enterprise Judge of the IPEC is a Specialist Circuit Judge. The judges of the High Court, Patents Court are able to sit as judges of the IPEC as necessary. Certain senior members of the Intellectual Property Bar are qualified and able to sit in the IPEC when the need arises.

Cases on the IPEC small claims track are handled by district judges (r63.18(2)(b)).

### 1.5 Judges able and willing to sit out of London

If the parties so desire, for the purpose of saving time or costs, the IPEC will sit out of London. Before any approach is made to the Judge's Clerk, 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 Judge's Clerk should be contacted as soon as possible so that arrangements can be put in place well before the date of the proposed hearing.

### 1.6 Intellectual Property Enterprise Court Users' Committee

The IPEC has a Users' Committee which considers the problems and concerns of intellectual property litigators in the IPEC. Anyone having views concerning the improvement of intellectual property litigation in the IPEC is invited to make his or her views known to the committee, preferably through the relevant professional representative on the committee or its secretary (contact details are in Annex A).

If matters relate to intellectual property litigation more widely, then this may be a matter for the Intellectual Property Court Users' Committee. Views can be expressed to the IPEC Users' Committee, who will refer on matters outside its remit, or direct to representatives of the Intellectual Property Court Users' Committee or its secretary.

### 1.7 Representation

A person may represent themselves in litigation in the IPEC as a litigant in person. However, intellectual property matters are often quite complex and cases will often benefit from the assistance of a knowledgeable legal representative.

Patent and trade mark attorneys<sup>1</sup> and solicitors all have rights to represent clients in the IPEC. These professionals may additionally instruct barristers to help prepare the case and/or argue the case in court. In some instances, a barrister may accept instructions directly from the public.

Each of these professions has a different qualification and skill set. So, in some cases, it may be appropriate to instruct more than one legal representative to act as a team.

More information about these different professions can be found at the following websites:

- Chartered Institute of Patent Attorneys – [www.cipa.org.uk](http://www.cipa.org.uk) regarding patent attorneys and patent attorney litigators
- Law Society – [www.lawsociety.org.uk](http://www.lawsociety.org.uk) regarding solicitors; and for IP specialist solicitors the IPLA – [www.ipla.org.uk](http://www.ipla.org.uk)

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<sup>1</sup> The rights of patent attorneys and trade mark attorneys to conduct litigation and appear in the IPEC are determined by the Intellectual Property Regulation Board (IPREG) ([www.ipreg.org.uk](http://www.ipreg.org.uk)). Attorneys with an Intellectual Property Litigation Certificate may conduct litigation and appear in the IPEC. The equivalent rights of solicitors are governed by the Solicitors Regulation Authority (SRA). Discussions between the judiciary and the SRA have made clear that notwithstanding the constitution of the IPEC as a part of the High Court all solicitors have right of audience in the IPEC.

- Institute of Trade Mark Attorneys – [www.itma.org.uk](http://www.itma.org.uk) regarding trade mark and design litigators
- Bar Council – [www.barcouncil.org.uk](http://www.barcouncil.org.uk) regarding barristers, and for IP specialist barristers – [www.ipba.co.uk](http://www.ipba.co.uk)

Where a person bringing or defending a case in the IPEC cannot afford to pay for their own legal representative, then they may be eligible to seek free or pro bono advice. The National Pro Bono Centre houses national clearing houses for legal pro bono work delivered in England and Wales: i.e. the Bar Pro Bono Unit, LawWorks (the Solicitors' Pro Bono Group) and ILEX Pro Bono Forum. The website is at: [www.nationalprobonocentre.org.uk](http://www.nationalprobonocentre.org.uk).

A litigant wishing to seek pro bono legal assistance should approach the Citizens Advice Bureau or a Law Centre first. There is a CAB office in the Royal Courts of Justice, Strand, London.

The IPEC Users Committee is working with CIPA to look at setting up a CIPA pro bono scheme and also actively considering other ways to widen the availability of pro bono legal assistance in the IPEC.

## 1.8 Appeals (rule 52)

If a party wishes to appeal, permission is generally required. Permission may be sought from the judge making the order or from the court to which the appeal is addressed.

### **Appeals from the multi-track in the Intellectual Property Enterprise Court**

Depending on the nature of the order being appealed, the destination of an appeal from the multi-track in the IPEC is either the Court of Appeal or the High Court. Final orders are appealed to the Court of Appeal whereas interim orders are appealed to the High Court (Chancery Division). See r63.19(1A) which provides that for the purposes of Practice Direction 52A, a decision of the enterprise judge shall be treated as a decision by a circuit judge hearing a specialist claim in the County Court. Paragraphs 3.6 to 3.8 of PD 52A explain the difference between a final order and an interim order.

When permission is sought from the judge making the order, the order must identify the route of appeal (r40.2(4)).

### **Appeals from the IPEC small claims track**

The destination of an appeal from a decision on the IPEC small claims track is to the Enterprise Judge in the IPEC. Although r63.19(3) provides that for the purposes of Practice Direction 52A a decision of district judge shall be treated as a decision by a district judge hearing a specialist claim in the County Court, it also expressly provides that an appeal from such a decision (by implication whether interim or final) shall be heard by an Enterprise Judge.

## 2. Procedure in the Intellectual Property Enterprise Court

### 2.1 Before issuing proceedings

Attention is drawn to the Practice Direction – Pre-Action Conduct. This is to be found at the start of Section C of Volume 1 of the White Book and is also available on the internet – see paragraph 3.12 below.

Compliance with this Practice Direction will affect the timetable, once proceedings are issued (see further below). However, as unjustified threats to bring legal proceedings in respect of many IP rights can themselves be subject to litigation, each claimant will have to make their own decision as to whether it is appropriate to write to a prospective defendant to see if matters can be settled before any proceedings are issued.

### 2.2 Issuing proceedings

‘Issuing proceedings’ is the term used for starting proceedings. The IPEC is situated in the Rolls Building in London at the address in Annex A and this is where proceedings in the IPEC must be started.

Most proceedings are issued using claim form N1 which can be obtained from the public counter at the Rolls Building or downloaded from the court website (see paragraph 3.12 below). A claimant should ensure that there is a copy of the claim form for the court, one for each defendant, as well as a copy for itself. The claim form must be completed and then filed at the Rolls Building. This may be done by post.

### 2.3 Service of the claim form

‘Service’ of a document means delivering it to another party in the proceedings. A copy of the claim form should be served by the claimant on each defendant together with a response pack. A response pack consists of the documents that a defendant will need to read and complete in order to make its initial response to the claim, namely (a) a form for defending the claim, (b) a form for admitting the claim and (c) a form for acknowledging service. The response pack may also be downloaded from the court website (see paragraph 3.12 below). The claimant should make sure the defendant’s copy of the claim form is obtained from the court at issue.

CPR Part 6 and the associated Practice Direction deal with how to make sure that documents are correctly served. A typical means of service on a company is by first class post to the company’s principal or last known place of business, although CPR Part 6 sets out a number of alternative methods. Attention is also drawn to r63.14 where a party is being served at an address for service for a registered right and with regard to when a copy of a document should also be sent to the UK Intellectual Property Office.

Generally a claimant should serve its Particulars of Claim with the claim form (see below).

### 2.4 Response by a defendant

A defendant served with Particulars of Claim has a choice as to how to respond. It may serve its Defence within 14 days of service of the Particulars of Claim. But if the defendant either needs more time to serve its Defence or wishes to challenge the jurisdiction of the Court, it should file an Acknowledgment of Service with the Court. CPR r10.3 sets out the period for filing an Acknowledgment of Service. Generally it must be done within 14 days of service of the claim form

or, if the claim form states that the Particulars of Claim are to follow, within 14 days of service of the Particulars of Claim. The CPR only requires the Acknowledgement of Service to be filed with the Court, although subsequent documents, such as the Defence, must both be filed with the Court and served on the other parties (see r15.6). In any event it may often be helpful to send a copy of any document filed with the court to the other party, to ensure that those documents are received in a timely manner.

### 2.5 Statements of Case

#### (a) Introduction

The statements of case are the documents where each party sets out its case. For the claimant this will primarily be the Particulars of Claim. The defendant responds with the Defence or the Defence and Counterclaim. The claimant may then serve a Reply or a Reply and Defence to Counterclaim, as appropriate.

These statements of case need to be full, but not unnecessarily lengthy. Statements of case can stand as evidence at trial in the IPEC, where relevant individuals have verified them with a statement of truth, as discussed further below.

#### (b) Time limits for filing and serving statements of case

The relevant time limits are necessarily but unfortunately dispersed across different Parts of the CPR. The following is a summary guide.

The better practice is for a claimant to file the Particulars of Claim with the court along with the claim form and to serve the Particulars of Claim on the other parties at the same time as serving the claim form. However the Particulars of Claim can be served up to 14 days later (r7.4(1)). If served later, the Particulars of Claim must be filed with the court no later than 7 days after service on the defendant (r7.4(3)).

If no Acknowledgement of Service has been filed, the period for filing the Defence with the court is 14 days after service of the Particulars of Claim (r15.4(1)(a)). If an Acknowledgement of Service has been filed, then the time limit for filing the Defence depends on whether the Particulars of Claim confirms that the Pre-Action Conduct Practice Direction has been complied with (r63.22(2) and (3)). The time limit is 42 days if it does and 70 days if it does not. In the event that the defendant also wishes to make a counterclaim against the claimant, this should follow on from the Defence in the same document and should be headed 'Counterclaim' (PD 20, para. 6.1).

The Defence (or Defence and Counterclaim) must be served on every other party (r15.6). This should be done at the same time as filing the Defence. The CPR does not specify a time limit for serving the Defence but undue delay may cause adverse consequences in costs later.

The time limit for the claimant filing a Reply with court is 28 days from the service of the Defence. The same time limit applies to service of the Reply on other parties (r63.22(4)).

If the claimant has been served with a Defence and Counterclaim it must respond with a Reply and Defence to Counterclaim. This should follow on from the Reply in the same document and should be headed 'Defence to Counterclaim' (PD 20, para. 6.2). The time limits for a Reply and Defence to Counterclaim are the same as for a Reply.

An optional final statement of case from the defendant is a Reply to the Defence to Counterclaim. This must be both filed and served 14 days from the service of the Defence to Counterclaim (r63.22(5)).

Some time limits are stricter than others in the IPEC. The parties are not at liberty to extend the time limits set out in r63.22 without the prior consent of the judge. Applications for any extension of time must be made in good time and set out good reasons as to why they are required. They are almost always dealt with without a hearing.

### **(c) Content of statements of case**

Statements of case must comply with the requirements of CPR Part 16, with an important modification: a particular feature of statements of case in the IPEC is that they must comply with r63.20 (1). They must set out concisely all facts and arguments relied on. A key purpose of this requirement is to facilitate the conduct of the case management conference which will be conducted on an issue by issue basis. The court and the parties need to know what the issues are going to be in sufficient detail for that process to take place. Therefore the facts and arguments that all parties intend to present at trial should have been finalised by the time of the CMC and set out in the statements of case.

However, attention is drawn to the requirement for the matters to be set out concisely. Unnecessarily lengthy statements of case will not be permitted. It is unlikely that legal arguments will need to be set out in any detail; all that is likely to be required is a brief statement of the nature of the argument to be relied on.

In proceedings relating to a patent or registered design the statements of case should also comply with PD 63 paras. 4.1-4.6 (r63.6).

In all proceedings copies of important documents referred to in a statement of case (e.g. an advertisement relied on 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.

Guidance on the preparation of a statement of case for particular proceedings is as follows:

#### ***Patent proceedings***

- Statements of case should comply with PD 63 paras. 4.1-4.6 (r63.6).
- Lengthy expositions of construction of patent claims are unlikely to be necessary or desirable. However the parties will be expected to identify the claims in issue (for infringement and validity) and identify the relevant features of those claims.
- It is likely to be necessary to break down a patent claim into suitable integers (i.e. separate parts) in order to explain a case on infringement with reference to specific elements of the alleged infringing product or process. This may be most conveniently done in the form of a table or chart annexed to the statement of case. Points on construction should emerge from this exercise and may need to be identified but lengthy argument on them is not required.
- A submission of lack of novelty of a patent is likely to require a similar approach to infringement (i.e. a claim break down, perhaps in the form of a table, with the claim integers compared with the relevant parts of the prior art disclosure(s) relied upon).
- A case of obviousness of a patent is likely to require a statement addressing the allegedly obvious step(s).
- Where a 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 in his reply (or defence) to the allegation of invalidity.
- A specific statement of what facts are said to be relevant and common general knowledge is likely to be necessary. A short summary of the relevant technical background may be helpful.

### **Registered design proceedings**

- Statements of case should comply with PD 63 paras. 4.1-4.6 (r63.6).
- The nature and characteristics of the informed user should be identified.

### **Trade Mark proceedings**

- Similarities relied on between a mark and a sign will not generally require elaboration. But in an appropriate case some detail may be necessary in relation to allegations that goods or services are similar. Parties to trade mark cases should identify the nature and characteristics of the relevant consumer (if relevant).

### **Copyright proceedings**

- A defence of independent design in a copyright case (or similar) will need to be addressed in appropriate detail.

### **(d) Statements of truth**

Attention is drawn to r63.21, which modifies Part 22 in its application to the IPEC. The statement of truth must be made by a person with knowledge of the facts alleged (or by persons who between them have such knowledge). If more than one person signs the statement of truth, the individuals should indicate in some suitable manner which parts of the statement of case they are verifying.

Statements of case (or parts of them) suitably verified may be permitted to stand as evidence at trial. The court's permission to do so is required (r32.6) but will generally be given. This is a matter to raise at the case management conference (see e.g. *Westwood v Knight* [2010] EW PCC 16).

Attention is drawn to r32.14 which sets out the consequences of verifying a statement of case containing a false statement without an honest belief in its truth, and to the procedures set out in PD 32 para. 28.

## **2.6 Case management (r63.23)**

The case management conference ("CMC") in the IPEC is conducted by a judge. The purpose of the CMC is to manage the conduct of the case in order to bring the proceedings to a trial in a manner proportionate to the nature of the dispute, 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. At the first CMC, the court will identify the issues and decide whether to make orders under paragraph 29.1 of PD 63. These include orders permitting the filing of further material in the case such as witness statements, experts' reports, disclosure and orders permitting cross-examination at trial and skeleton arguments. The trial date will be fixed at the CMC.

### **(a) Directions questionnaire**

All cases are allocated to the multi-track automatically by operation of r63.1(3) unless the case is to be allocated to the small claims track in which case r63.27 applies (see the Guide to the IPEC small claims track).

The effect of these provisions means that for cases on the multi-track the IPEC generally dispenses with the need for a directions questionnaire.

### **(b) The date for the case management conference**

The date for the CMC will normally be arranged as follows. The claimant should apply for a CMC within 14 days after all defendants who intend to file and serve a Defence have done so. Where a case has been transferred from another court, the claimant should apply for a CMC within 14 days of the transfer. Any party may apply for a CMC at an earlier date than these dates. If the claimant

has not applied for a CMC within 14 days then the defendant should do so. In any event the Court can and will aim to fix a date for a CMC if the parties have not done so within a reasonable period. These requirements are mandatory for cases within Section I of Part 63 (essentially patents and registered designs; see PD 63 para 5.3 – 5.7) but should be followed in all cases in the IPEC as a matter of efficient case management.

### **(c) The case management conference**

The CMC will be conducted as a hearing in open court. However where all parties consent the court may determine the CMC on paper (r63.23(3)).

A bundle of documents (see Annex C) should be filed with the court at the Rolls Building (full address in Annex A) in advance. Two days before the CMC is usually sufficient.

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 manifest reason for doing so.

The CMC is an important part of the procedure because no material may be filed in the case by way of evidence, disclosure or written submissions unless permission is given for it by the judge and the proper time for that permission to be given is the CMC (see e.g. *Westwood v Knight* [2010] EWPC 16). Save in exceptional circumstances the court will not permit a party to submit material in a case in addition to that ordered at the CMC (r63.23(2), see e.g. *Liversidge v Owen Mumford* [2012] EW PCC 33 and *Redd v Red Legal* [2012] EW PCC 50).

The basis on which the court will decide whether to permit material to be filed in a case is by applying the cost-benefit test (PD 63 para 29.2(2)) and by giving permission in relation to specific and identified issues only ((PD 63 para 29.2(1)). PD 63 para 29.1 lists the material which the court may order: disclosure of documents, a product or process description, experiments, witness statements, experts' reports, cross-examination at trial, and written submissions or skeleton arguments. The parties need to attend the CMC in a position to assist the court in making appropriate orders on this basis. In particular, the parties should consider:

- (a) The need for and scope of any evidence from factual or expert witnesses. Note the court will consider whether there is sufficient evidence in the statements of case or whether further evidence is required.
- (b) The need for and scope of any oral testimony and cross-examination. Note that the court will confine any permitted cross-examination to particular issues and to time limits.
- (c) The need for, and scope of, any disclosure of documents. No disclosure reports are required in the IPEC. Only specific disclosure will be ordered, i.e. disclosure of particular documents or particular classes of document, in relation to one or more of the issues in the proceedings identified in the CMC. In some cases a class of documents can be identified solely by reference to an issue or issues to which the documents relate.
- (d) The need for any experiments, process or product descriptions or supply of any samples.
- (e) The need for written submissions or skeleton arguments.
- (f) The likely timetable up to trial. This may include dates on which disclosure of documents, product and process description and experiments is to take place as well as a schedule for witness statements and experts reports including provisions for any evidence in reply (if required).
- (g) 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 will order that the hearing be of a fixed duration of no more than 2 days.

A specimen CMC order is attached to this Guide at Annex B.

### **(d) A review of the issues**

At the case management conference the court will identify the issues in the proceedings (r63.23(1)). This is an important part of the CMC. The parties should exchange their proposed list of the issues. These need not be lengthy documents. They should be agreed if possible in advance but rather than incurring the cost debating lists of issues before the CMC, the most cost effective approach is generally to leave the argument over to the CMC itself.

### **(e) Matters arising in particular cases before the IPEC**

The following specific matters come up regularly and experience has shown that the approaches described below may be reasonable and proportionate.

In patent cases:

- to require the patentee to rely on no more than three independently valid claims; and
- to require a party challenging validity to rely on no more than three items of prior art.

These limits are intended to be flexible and in an appropriate case they can and have been relaxed. The reference to prior art includes all starting points for the obviousness analysis. In other words it does not encompass a party's general reliance on common general knowledge as part of its case on obviousness but it does include an argument of obviousness over common general knowledge alone.

Also in patent cases, evidence over and above the material in the statement of case may well only be required in relation to common general knowledge and obviousness.

In copyright and unregistered design right cases, if the issues include a defence of independent design, cross-examination and a measure of disclosure is likely to be required.

In registered design cases, there may be no need for cross-examination at all.

In Community design cases there is likely to be a limit on the extent to which the design corpus may be explored.

In general, if expert evidence is required, it may be possible for that evidence to be given by "in house" experts.

### **(f) Amendments to the statement of case**

On occasions a party may wish to amend its statement of case. If the other parties agree then generally no difficulties arise. If not then the court's permission is needed. This is best sought at the CMC but if the need for amendment arises after the CMC then it can be done by a separate application. In considering whether to permit the amendment the court will consider all the circumstances including proportionality and the cost-benefit test (see *Temple Island v New English Teas* [2011] EWPC 19).

### **(g) Expression of a preliminary, non-binding opinion on the merits**

If both parties wish the court to do so, if it is likely to assist the parties in reaching a settlement, the IPEC is willing to express a preliminary and non-binding opinion on the merits of the case (see *Weight Watchers v Love Bites* [2012] EWPC 12 and *Fayus v Flying Trade* [2012] EW PCC 43).



### (h) Costs in a multi-party case

If the case includes more than one defendant or group of defendants who are separately represented, the parties should consider the question of the likely effect of the costs capping provisions (see *Gimex v Chillbag* [2012] EW PCC 34 and *Liversidge v Owen Mumford* (costs) [2012] EWPC 40). If in doubt the parties should raise the matter at the CMC.

### (i) Security for costs

In certain circumstances it is open to a defendant to seek security for costs. This means requiring the claimant to safeguard a sum of money to ensure that, in the event that the defendant were to win the action, the defendant's entitlement to its costs is secured. The rules relating to security for costs are set out at r25.12-14.

### (j) Alternative dispute resolution

At the CMC the parties may apply for time in which to seek alternative dispute resolution (see paragraph 2.12 below) before the proceedings progress further. Occasionally the court may invite the parties to explore alternative means of resolving the case.

## 2.7 Transfers to and from the IPEC (r63.18 and r63.25(4) and (5))

Applications to transfer a case to another court should be made at the case management conference. The court will have regard to the provisions of PD 30 (Transfer) and in particular paragraph 9.1 which relates to transfers to and from the IPEC. The considerations set out above in the section on Allocation will be taken into account. In addition, in considering an application to transfer to another part of the High Court the following further matters will be taken into account:

- The holder of an intellectual property right who does not wish to incur costs on the normal High Court scale but apprehends that an alleged infringer may seek to have the matter transferred to another part of the High Court, may consider an undertaking to limit the enforcement of their rights; e.g. by foregoing an injunction or by reference to a certain value of sales (cf. *Liversidge v Owen Mumford* [2011] EWPC 34).
- A defendant seeking transfer to another part of the High Court when the claimant cannot afford the cost of normal High Court litigation may offer to allow the claimant to withdraw their claim without prejudice to a right to restart litigation and/or without an adverse costs award.

An application to transfer a case after the CMC will only be considered in exceptional circumstances.

A judge sitting in the County Court or the general Chancery Division has the power to transfer a case to the IPEC (r63.18(1) modifying r30.5).

## 2.8 Re-allocation of cases within the IPEC between the multi-track and the small claims track (r63.27 and r26.10)

A case proceeding on one track in the IPEC may subsequently be re-allocated to the other track if it is appropriate to do so. A case will be re-allocated from the small claims track to the multi-track if it emerges that the nature of the claim makes it inappropriate for the small claims track. Circumstances in which it may be appropriate to re-allocate a case between the multi-track and the small claims track could arise if it emerges that the current track is inappropriate having regard to the value of the case or to its complexity or the relief sought.

A claim will not be re-allocated (unless it has to be) if that would cause substantial disruption to the progress of litigation.

### 2.9 Applications (r63.25)

Any application to the court except for the CMC will be dealt with without a hearing unless the court considers it necessary to hold a hearing (r63.25(3)). Provisions relating to telephone hearings of applications are set out at paragraph 3.5 below.

Once the application is received by a respondent, by r63.25(2) the respondent to the application must file and serve on all relevant parties a response within 5 days of service of the application notice. When an application is to be resolved on paper, it is imperative that the applicant tells the court the date on which the application notice was served. This is necessary so that the court can know when the 5 day period provided for by r63.25(2) has expired. Unless the matter is urgent or for some other good reason, the court will generally not deal with a paper application until it can be seen that the 5 day period provided for by r63.25(2) has expired.

#### Applications for judgment in default

If a defendant fails to file either an Acknowledgment of Service or a Defence within two weeks of service on it of the Particulars of Claim the claimant may make an application for judgment in default. A claimant may also make an application for a default judgment if the defendant files an Acknowledgment of Service but fails to file a Defence within the relevant time limit (see above). These can generally be dealt with as paper applications, provided the application notice has been served on the relevant defendant and the court is informed of the date on which this took place in order to give effect to the 5 day period provided for by r63.25(2).

### 2.10 Fast track and expedition

The IPEC does not operate a separate Part 28 “fast track”, a procedure confined to the County Court. All cases in the IPEC are either on the multi-track or the small claims track.

The normal operation of the procedure on the IPEC multi-track is intended to ensure that trials and applications are heard and dealt with in a timely fashion. Nevertheless the court can accommodate urgent applications (such as applications for interim remedies) and, when necessary, trials can be dealt with on an expedited (speedy) basis. Applications for expedited trials may be made at any time but should be made as soon as possible and notice given to all parties.

### 2.11 The trial

At trial the Court will take an active part in controlling the proceedings and setting limits on the time allocated during a trial. To facilitate this process the court will consider the timetable for the trial at the CMC, subject to revision at the beginning of trial. The timetable will be set taking into account the parties’ time estimates but the time estimates will not be determinative of the trial timetable. So far as appropriate the court will allocate equal time to the parties. Cross-examination will be strictly controlled.

Because costs are capped there is no requirement for costs budgets in the IPEC.

The court will endeavour to ensure that the trial lasts no more than 2 days. Many cases in the IPEC are heard in a single day.

#### Trial on paper

In an appropriate case and if the parties consent, the IPEC is able and willing to conduct a trial entirely on paper (for an example see *Hoffmann v DARE* [2012] EW PCC 2).

### 2.12 Costs

Costs in the IPEC are subject to a cap provided by Part 45 rules 45.30-45.32 and see also PD 45 Section IV. Subject to certain limited exceptions the court will not order a party to pay total costs of more than £50,000 on the final determination of a claim in relation to liability and no more than £25,000 on an inquiry as to damages or account of profits.

Tables A and B of PD 45 Section IV set out the maximum amount of scale costs which the court will award for each stage of a claim in the IPEC. However these tables only apply to proceedings started on or after 1 October 2013. Proceedings begun earlier than that date are subject to the lower scale costs set out in Tables A and B of PD 45 Section 25C, even in relation to matters occurring after 1 October 2013 (*PPL v Hamilton (No.2)* [2013] EWHC 3801 (IPEC)).

In proceedings started on or after 1 October 2013 court fees, costs relating to enforcement of an order and wasted costs are excluded from the costs cap (r45.31(4A)).

The Costs Management procedures in CPR Part 3 Section II r3.12 – r3.18 including the provisions for costs budgets and the like, do not apply in the IPEC (CPR r3.12(1), because proceedings in the IPEC are subject to scale costs).

In the IPEC all costs are assessed summarily (r45.41(3)). In preparing their statement of costs, parties should bear in mind that they will need to explain which stage of the claim the costs were incurred in relation to. The general approach to the summary assessment process is explained in *Westwood v Knight* [2011] EW PCC 11.

The application of an issue based approach to costs in the context of the IPEC scales and the cap is addressed in *BOS v Cobra* [2012] EW PCC 44.

For cases which have been transferred to the IPEC from elsewhere, either the County Court or another part of the High Court, the IPEC will deal with costs incurred in proceedings before transfer on a case by case basis. Costs incurred in the High Court before transfer are usually dealt with by being summarily assessed as High Court costs (e.g. *Westwood v Knight* [2011] EW PCC 11).

#### Costs at the interim stage

At the interim stage costs of an application in the IPEC will be reserved to the conclusion of the trial (r63.26(1)). When a party has behaved unreasonably in relation to an application the court may make an order for costs at the conclusion of the hearing and such costs will not be part of the costs covered by the cap (r63.26(2)).

### 2.13 Alternative Dispute Resolution

The primary role of the IPEC is as a forum for deciding intellectual property rights cases. However, the IPEC 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.

Settlement of a dispute by ADR has many advantages. It can result in significant saving of costs. It also has the potential to provide the parties with a wider range of solutions than can be offered by litigation. For example, while the solution to litigation is usually limited to “win/lose” on the issues put in front of the court, ADR may provide a creative “win/win” solution, as some forms of ADR can explore other ways for the parties to co-operate. ADR can also explore settlement in several countries at the same time.

Legal representatives should consider and advise their clients as to the possibility of seeking to resolve the dispute via ADR. However not all cases are suitable for settlement this way. In an appropriate case, the IPEC has the power to adjourn a case for a specified period of time to

encourage and enable the parties to use ADR. At the Case Management Conference, the IPEC Judge will sometimes ask whether the parties have been advised about ADR and whether an adjournment in the proceedings is being sought. However, this will not usually be a reason to delay the CMC itself.

There are many forms of ADR. Most of these are not free. They include:

- (a) Conciliation – This can involve the use of a third party to see if agreement may be reached or to offer a non-binding opinion on the dispute. Some trade bodies offer conciliation services.
- (b) Mediation – This involves the appointment of a trained mediator to see whether a legally binding agreement can be negotiated. The parties will usually sign a framework agreement for the procedure of the mediation. Mediation can involve the mediator meeting with both parties together and/ or meeting the parties in separate rooms and shuttling between them. The UKIPO offers a specialist IP mediation service (details on the IPO website). Other mediation services are also available.
- (c) Arbitration – This involves the appointment of an arbitrator or private decision maker, under a set of procedural rules. The arbitrator will then make a binding decision on the case. Arbitration replaces the court action, but the decision of the arbitrator is private to the parties. NB since arbitration is a private matter between the parties, arbitrators cannot revoke intellectual property rights.
- (d) Early Neutral Evaluation – This involves the appointment of an expert to give an opinion about one or more issues in a dispute. Such opinions are not binding but assist the parties in reaching a settlement of the case.
- (e) Binding expert determination – This involves the appointment of an expert to make a decision about one or more issues in a dispute. Such decisions can be legally binding, by agreement between the parties.
- (f) IPO Opinions – The UK IPO runs a scheme to give non-binding opinions on patent infringement and patent validity. The opinion is given on the basis of written papers provided by the party applying for the opinion. The other party has the right to file observations, but does not become a party to proceedings before the IPO. The parties can agree to be bound by the outcome of any such opinion.

## 3. General arrangements

### 3.1 Issuing proceedings and applications

#### (a) Issuing proceedings

Claim forms are issued at the public counter of the Rolls Building (address in Annex A). A claim form may also be issued by post.

The fee for issuing proceedings depends on the nature of the claim, including its value. Guidance may be sought from the Court. Information on the latest court fees can be found at [www.justice.gov.uk](http://www.justice.gov.uk).

#### (b) Transferring proceedings to the Intellectual Property Enterprise Court

Cases transferred to the IPEC will be taken to the Rolls Building (address in Annex A).

#### (c) Issuing interim applications

The issue of all interim process is dealt with at the public counter of the Rolls Building (address in Annex A). Users are reminded that:

- The first case management conference (r63.23) will be conducted at a hearing unless all parties consent to determination on paper.
- The court will deal with all other applications without a hearing unless it considers one necessary (r63.25(3)). A party may nonetheless request a hearing.

The fee will be determined on the face of the application notice when it is issued and prior to consideration (if any) by the court of whether a hearing is necessary. Accordingly applications marked for determination at a hearing will be charged the appropriate fee for a hearing. Applications marked for determination otherwise than at a hearing will be charged the appropriate fee for a paper application.

#### Personal attendance to issue process

The Fee and the application notice should be taken to the public counter at the Rolls Building. The Application will be issued and returned.

#### Postal application to issue process

Applications should be sent to the address in Annex A. The Clerk will issue and return the application.

### 3.2 Arrangements for listing

#### (a) First case management conference (r63.23)

If the application is for the first case management conference (r63.23), the date for the hearing will be fixed by liaison with the Chancery Listing Office at the Rolls Building (address in Annex A).

#### (b) Interim Applications when a hearing has been ordered

For applications marked for determination at a hearing, the court will promptly consider whether a hearing is necessary. If the court considers it necessary to hold a hearing, the date will be fixed by the Chancery Listing Office at the Rolls Building (address in Annex A).

### (c) Trials

Trial dates will be fixed at the Case Management Conference (CMC) and parties attending the Case Management Conference should have the necessary information in order to fix a trial date. This may include dates relating to the availability of witnesses and parties as well as the availability of legal representatives.

The trial fee must be paid within 14 days of the trial date being set.

## 3.3 Time Estimates for applications

The parties must provide time estimates for all applications in respect of which a hearing is sought. Parties must appreciate the need to give a realistic and accurate time estimate and ensure that it includes a discrete reading time for the court to read the papers prior to the hearing of the application.

Where parties and their legal advisors consider that a time estimate that has been provided is unrealistic, they have a duty to notify the new time estimate to the Judge's Clerk as soon as possible.

## 3.4 Documents and trial timetable

The preparation of papers for the hearing of applications and trials is of considerable importance and should be approached intelligently. Annex C hereto provides guidance to the preparation of the bundle of documents for use at trial or an application, which should be followed. Legal representatives and litigants in person who fail to do so may be required to explain why and may be penalised personally in costs.

Papers for the hearing should be lodged directly at the Rolls Building. If there is insufficient time to lodge hard copies before the deadline, documents of significance (and particularly skeleton arguments) should be supplied by email to the Judge's Clerk. As an alternative documents may also be faxed to the Judge's Clerk followed up by hard copies.

It is the responsibility of both parties to ensure that all relevant documents are lodged 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.

The judge requests that all important documents also be supplied on a USB stick or via e-mail in a format convenient for the judge's use (normally the current or a recent version of Microsoft Word or as a text searchable pdf). For trial, these will usually include skeleton arguments, important patents and drawings, the witness statements and expert reports.

Prior to trial the parties should ensure that they comply with the requirements of PD 63 para 9, namely that a trial bundle, reading guide and detailed trial timetable are provided for the judge. These will generally have been specifically dealt with in the Order following the CMC but if not, the directions on timing in PD 63 para 9 should be followed.

If they are used, skeleton arguments should be lodged in time for the judge to read them before an application or trial. Any skeleton argument must also be served on the other parties in the case:

- (a) In the case of applications, if a skeleton argument is used, it should normally be filed by 10:30am the previous working day (or, in the case of short applications, 3pm).
- (b) In the case of trials, skeletons may only be used where they have been ordered at the CMC and they should normally be lodged at least three working days before commencement of the trial.

#### 3.5 Telephone applications

The IPEC will hear applications by telephone conference in accordance with the Practice Direction under Part 23 and PD 63 para 30.1. The party making the application is responsible for setting up the telephone application and informing the parties, Counsels' clerks (where barristers are instructed) and the Judge's Clerk or the Chancery Listing Office of the time of the conference call.

It is possible for the application to be recorded, and if recording by the court rather than by British Telecom (or other service provider) is requested, arrangements should be made with the Judge's Clerk. The recording will not be transcribed. The tape will be kept by the Judge's Clerk for a period of six months. Arrangements for transcription, if needed, must be made by the parties.

This procedure should be used where it will save costs.

#### 3.6 Consent Orders

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 or their respective legal representatives should be supplied to the Judge's Clerk. Unless the judge assigned to hear the application considers a hearing is needed, he or she will make the order in the agreed terms by signing it. It will be drawn up accordingly and sent to the parties.

#### 3.7 The trial

The Court will normally hear trials from 10.30am to 4.15pm with a break from 1pm to 2pm for lunch. CMCs and other hearings will normally be heard at 10.30am but may be heard at a different time if appropriate.

If appropriate, arrangements can be made for witnesses to give their oral evidence by video link. This needs to be arranged well in advance with the parties and the court.

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.

#### 3.8 Draft judgments

Many judgments, particularly after a full trial, will be reserved and handed down at a later date, as advised by the Judge's Clerk or the Chancery Listing Office. Where possible the date for handing down the judgment will be set at the CMC. Usually the parties' legal representatives (or litigants in person) will be provided with a copy of the draft judgment in order 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. If the parties would prefer not to be shown the draft judgment on this basis they should inform the court at the time the judgment is reserved.

#### 3.9 Orders following judgment

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.

### 3.10 Enforcement

Enforcement of orders is undertaken at the IPEC in the Rolls Building. Enforcement of any financial element of an IPEC judgment will be dealt with by a district judge. Where appropriate, cases may be transferred elsewhere for enforcement.

### 3.11 Contacting the Intellectual Property Enterprise Court

Contact details for the IPEC are in Annex A.

### 3.12 Information available on the Internet

Copies of this Guide, the Guide to the Intellectual Property Enterprise Court Small Claims Track, the Guide to the Patents Court, the Chancery Guide and all other IPEC guidance and forms are available at <http://hmctsformfinder.justice.gov.uk/HMCTS/FormFinder.do>

The Civil Procedure Rules (CPR) and Practice Directions are at:  
[www.justice.gov.uk/courts/procedure-rules/civil/rules](http://www.justice.gov.uk/courts/procedure-rules/civil/rules)

Statutes and other legislation are at: [www.legislation.gov.uk](http://www.legislation.gov.uk)

The IPEC daily list of court hearings appears at the end of the Chancery List on the Daily Court Lists page at [www.justice.gov.uk](http://www.justice.gov.uk). The full address is: <http://www.justice.gov.uk/courts/court-lists/list-chancery-judges>

A link to a diary setting out a list of the forthcoming trials in the IPEC as well as a list of recent trials and applications is available at:  
<http://www.justice.gov.uk/courts/rcj-rolls-building/intellectual-property-enterprise-court>

Judgments of the IPEC are usually available at the bailli website at: <http://www.bailli.org/ew/cases>



## Annex A – Contact details

### **The Intellectual Property Enterprise Court**

The home of the IPEC is in the Rolls Building at this address:

The Rolls Building  
7 Rolls Building Fetter Lane  
London  
EC4A 1NL  
DX160040 Strand 4

The IPEC is presided over by a specialist circuit judge, at present His Honour Judge Hacon.

The contact details for the Clerk to the Intellectual Property Enterprise Court, Christy Irvine, are:

Christy.Irvine@hmcts.gsi.gov.uk  
Tel: 020 7947 6265

### **Chancery Listing Office**

The Chancery Listing Office may be contacted at:

Michael Mcilroy  
Chancery Listing Officer  
7 Rolls Buildings  
EC4A 1NL  
DX 160040 Strand 4

Tel: 020 7947 7717/6690

Team email [chanceryjudgeslisting@hmcts.gsi.gov.uk](mailto:chanceryjudgeslisting@hmcts.gsi.gov.uk)

Whether you contact listing by fax, e-mail or by post please avoid duplication of work by only sending documents once.

### **Postal application to issue process**

Applications should be addressed to the Issue Section at the Rolls Building (address above) and clearly marked Intellectual Property Enterprise Court.

### **The public counter**

The public counters are on the ground floor of the Rolls Building (address above). The counters are open Monday to Friday (except public holidays) from 10am-4.30pm.

### **General Enquiries**

A general email address for the IPEC is: [ipec@hmcts.gsi.gov.uk](mailto:ipec@hmcts.gsi.gov.uk)

Apart from the issuing of proceedings, all communications with the Court should be addressed to the Clerk to the Intellectual Property Enterprise Court.

Enquiries relating to a case which has been allocated to the IPEC small claims track may be made to the clerks in the IPEC small claims track (see the Guide to the IPEC small claims track).

Please note the court staff cannot give legal advice.

**Intellectual Property Enterprise Court Users Committee**

The secretary to the IPECUC is:

Alan Johnson,  
Bristows,  
100 Victoria Embankment,  
London  
EC4Y 0DH

Tel: 020 7400 8000

Fax: 020 7400 8050

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**IP Court Users Committee**

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## Annex B – Specimen CMC Order

UPON HEARING the Case Management Conference on [ date ]

UPON the issues being identified in the Schedule to this order

IT IS ORDERED THAT:

### Disclosure

1. The parties will make and serve on the other of them by 4pm on [date] a list in accordance with form N265 of [the following categories of] documents in their control which relate to issues X:
  - (a)
  - (b)
  - (c)
2. 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 14 days of the request, upon the undertaking of the party requesting the copies to pay the reasonable copying charges.

### Evidence

3. The statements of case shall stand as evidence in chief.
4. The parties may serve witness statements dealing with [issues X] on or before 4pm on [date].
5. The parties may serve witness statements in reply on or before 4pm on [date].
6. The parties may each serve an expert's report dealing with [issues Y] on or before 4pm on [date].
7. The parties may serve an expert's report in reply on or before 4pm on [date].
8. The witnesses dealing with [issues X and Y] may be cross-examined at trial. No other witness will be cross-examined.

### Trial

9. The time allocated for the trial is [1] day.
10. Time estimates for the cross-examination and speeches of the parties and a reading guide for the judge will be filed by 4pm on [date]. The court will consider the time estimates and allocate time taking them into account.
11. The parties shall file skeleton arguments, on or before 4pm on [date].
12. The claimant shall no less than 4 weeks before the date of the trial serve on the other parties a list of all documents that it proposes to include in the trial bundle.
13. The other parties shall each no less than 3 weeks before the date of the trial serve on the claimant a list of any additional documents that it proposes should be included in the trial bundle.

14. The claimant shall no less than 2 weeks before the date of the trial serve on the other parties an agreed bundle of documents for use at the trial and no less than 1 week before the date of the trial file the agreed bundle with the court. The bundle shall be prepared in accordance with Annex C to the IPEC Guide.
15. The trial of the Claim shall take place on [date].
16. Judgment in the action shall be handed down on [date].

**Costs**

17. Costs are reserved to the trial.

**Schedule**

List of issues:

1. Infringement of claim 5
2. Novelty of claim 1 over [citation 1]
3. Inventive step of claim 1 over [citation 1]
4. Inventive step of claim 1 over [citation 2]
5. Inventive step of claim 5 over [citation 2]

## Annex C – Guidelines on bundles

### Guidelines on bundles

1. The 'bundle' is the name given to the one or more files containing the documents to be used at a trial or other hearing. Preparation of the bundle is primarily the responsibility of the claimant unless the court has directed otherwise. This must be done in consultation with the other parties. It is the duty of all parties to co-operate in order to agree the content of the bundle in good time before the trial or other hearing.
2. In no circumstances should rival bundles be presented to the court.

### Typical content of a bundle

3. Below is set out a typical list of the documents that should go into the bundle for the trial, for the case management conference (CMC) or for any other hearing. Some hearings will not require all the indicated documents. For example at the CMC there will not normally yet exist any experts' reports, disclosure documents or earlier orders of the court and there may be no witness statements.

The parties are also free to agree that types of document other than those listed below should go into the bundle if it is important for the judge to see them.

#### Statements of Case

Claim Form and Particulars of Claim

Defence and Counterclaim

Reply and Defence to Counterclaim

Part 18 Requests for further information and Responses

#### Orders

All earlier orders of the court made in the proceedings

#### Evidence

Witness statements

Experts' reports

#### Exhibits

Documents exhibited to the statements of case, witness statements and experts' reports

#### Disclosure

Documents produced in disclosure on which any party seeks to rely

#### Correspondence

Correspondence between parties or their legal advisors may be included, but strictly only to the extent that will be relevant at the trial or other hearing.

### Avoidance of duplication

4. No more than one copy of any one document should be included, unless there is good reason for doing otherwise.

### Chronological order

5. In general the documents in each of the categories (statements of case, witness statements, orders, etc) should be arranged in date order starting with the earliest document.
6. The sequence of exhibits in an exhibits file (see paragraph 18 below) should reflect the order in which they are referred to in the relevant statement of case, witness statement or expert's report.

### Pagination of a bundle for a trial

7. The bundle prepared for a trial should be paginated continuously from start to finish, i.e. beginning with 1 for the first page of the first file and continuing the numbering up to the last page of the last file. (This is not necessary for other hearings).
8. These page numbers should be inserted in bold figures, at the bottom of the page and in a form that can clearly be distinguished from any other pagination on the document.

### Format and presentation

9. Where possible, the documents should be in A4 format.
10. Where the colour of any image or writing in a document is important, the document must be copied in colour.
11. Documents in a foreign language should be translated; the translation should immediately follow the document translated. The translation should be agreed or, if it cannot be agreed, each party's proposed translation should be included.
12. Subject to paragraph 18 below, the bundle should contain the minimum convenient number of files with appropriate use of dividers for each file. The size of each file should be tailored to its contents. It is not useful to have a large lever-arch file with just a few pages inside; on the other hand bundles should not be overloaded as they tend to break. **No bundle should contain more than 300 pages.**
13. Large documents, such as plans, should be placed in a file in a way such that the document is easily accessible.

### Contents lists and labels

14. Each file in the bundle should have a list of contents at the front. It is not necessary to put the full heading of the action on the contents list. Documents should be identified briefly but enough to know what each document is, e.g. "AGS3 – Defendant's Accounts".
15. The contents list of a correspondence file need not identify each letter, email etc. if these are presented in chronological order.
16. Labels on the outside of files should use large and clearly visible lettering, e.g. "File A. Statements of Case." A label should be used on the front as well as on the spine.
17. A label should also be stuck on to the front inside cover of a file, in such a way that it can be clearly seen even when the file is open.

### Exhibits in a separate bundle

18. Exhibits to statements of case, witness statements or experts' reports should generally be put in a separate bundle so that the reader can see both the text of the statement and the document referred to at the same time. This need not be done if there are very few exhibits; in such cases exhibits should immediately follow the document to which they are exhibited.