

Contents

| | |
|---|--------------------------------------|
| 1. General | 3 |
| 1.1 Introduction | 3 |
| 1.2 Multi-track and small claims track | 3Error! Bookmark not defined. |
| 1.3 Intellectual property cases | 4 |
| 1.4 Remedies | 4Error! Bookmark not defined. |
| 1.5 The judges | 4 |
| 1.6 Trials outside London | 4 |
| 1.7 Representation | 5 |
| 2. Civil Procedure Rules | 6 |
| 2.1 The CPR | 6 |
| 2.2 Abbreviations | 6 |
| 2.3 Rules of particular relevance to IPEC | 6 |
| 3. The court in which to bring proceedings | 7 |
| 3.1 The options | 7 |
| 3.2 IPEC or elsewhere in the High Court | 7 |
| 3.3 The IPEC multi-track or small claims track | 8 |
| 4. Procedure in IPEC | 9 |
| 4.1 Before starting proceedings | 9 |
| 4.2 Starting proceedings | 9 |
| 4.3 Service of the claim form | 170 |
| 4.4 Response by the defendant | 10 |
| 4.5 Statements of case | 11 |
| 4.6 Case management | 14 |
| 4.7 Applications | 17 |
| 4.8 Urgent applications | 18 |
| 4.9 The trial | 18 |
| 4.10 Costs | 18 |

| | |
|---|-----------|
| 4.11 Alternative dispute resolution | 19 |
| 5. General Arrangements | 20 |
| 5.1 Filing documents with the court | 20 |
| 5.2 Court fees | 20 |
| 5.3 Arrangements for listing | 20 |
| 5.4 Time Estimates for applications | 20 |
| 5.5 Documents bundles and skeletons for trials and applications | 21 |
| 5.6 Consent orders | 21 |
| 5.7 Evidence at the trial | 21 |
| 5.8 Draft judgment | 22 |
| 5.9 Order following judgment | 22 |
| 5.10 Enforcement | 22 |
| 5.11 Appeals | 22 |
| 5.12 Information available on the Internet | 23 |
| Annex A – Contact details | 24 |
| Annex B – Example CMC Order | 26 |
| Annex C – Guidelines on bundles | 29 |

1. General

1.1 Introduction

This is the Guide to the Intellectual Property Enterprise Court (IPEC). It primarily concerns the IPEC multi-track (explained further below, see section 1.2). There is a separate Guide for the IPEC's small claims track, available at www.gov.uk/government/publications/intellectual-property-enterprise-court-a-guide-to-small-claims

The Guide is written for all users of IPEC, whether a litigant in person (i.e. a litigant who acts on their own behalf without professional representation) or a specialist intellectual property litigator. It explains how the court's procedures work and provides guidelines where appropriate.

IPEC is part of the High Court. It is a specialist list of the Chancery Division within the Business and Property Courts of England and Wales. It hears only cases concerning intellectual property.

IPEC aims to provide a procedure for intellectual property litigation which is speedier and less costly than is the case in the rest of the High Court. It is also designed to safeguard parties from the risk of paying large sums in costs to the opposing party at the conclusion of the proceedings. The intention is to ensure that parties without the benefit of large financial resources are not deterred from seeking access to justice because of the high cost of litigation.

1.2 Multi-track and small claims track

IPEC has two sets of procedures or 'tracks'. They are known as the 'IPEC multi-track' and the 'IPEC small claims track'. They differ in that the small claims track deals with cases of a simpler nature with a claim for a lower level of damages.

The IPEC multi-track

In the IPEC multi-track, litigants may claim up to £500,000 in compensation for infringement of their rights. This cap on compensation may be waived by agreement of the parties.

At the end of the trial the losing party may be required to pay the winning party's legal costs, but with very limited exceptions such costs will not exceed £60,000 in the IPEC multi-track. The procedure not only caps the overall costs which a losing party will have to pay, it also limits costs payable for each stage of the proceedings. These 'costs caps' – limiting the extent of any adverse order on costs – form a significant feature of IPEC.

The IPEC small claims track

The IPEC small claims track is for suitable claims in which the compensation sought is no more than £10,000. Generally, at the end of the case the losing party will be required to pay little or none of the winning party's legal costs. There is thus even greater protection from an adverse order on costs in the event that a party is not successful. The procedure in the small claims track is shorter and less formal than in the multi-track and the court fees are lower.

Small claims cases are heard by specialist district judges who sit in London and in Business and Property Court centres out of London, namely Birmingham, Bristol, Leeds, Liverpool, Manchester, Newcastle and Wales (Cardiff). Matters to be heard outside London can be issued using the Business and Property Courts' electronic filing system (see Annex A).

Guidance is given below as to whether the multi-track or small claims track is likely to be the more appropriate forum for a dispute (see section 3.3).

Unless stated otherwise, the remainder of this Guide concerns only the IPEC multi-track.

1.3 Intellectual property cases

IPEC hears intellectual property cases of any kind. For the most part this means cases concerning patents, registered designs, unregistered designs, trade marks, passing off, copyright, database rights, performance protection rights, trade libel and breach of confidence. There are other intellectual property rights less often relied on, such as moral rights, semiconductor topography rights and the protection of plant varieties, and all of these may also be litigated in IPEC. IPEC deals with disputes which involve matters other than intellectual property, such as contractual claims, but only if associated with an intellectual property claim.

Since the end of the Brexit transition period on 31 December 2020, EU registered and unregistered intellectual property rights ceased to be enforceable in the courts of England and Wales. Proceedings for enforcement of such rights started before that date will still be heard and enforced.

1.4 Remedies

All the remedies available elsewhere in the High Court can be claimed in IPEC. These include preliminary and final injunctions, orders for the payment of damages or an account of profits, the latter being an order that a defendant found to infringe should disclose and pay over the profits made from the infringement. Search and seizure orders, asset freezing orders and orders requiring the dissemination of a judgment (such as publication on a website) may also be granted in IPEC.

1.5 The judges

The Presiding Judge of IPEC is a specialist circuit judge. Nominated barristers and solicitors, all experienced in intellectual property law, sit as deputy IPEC judges. Judges who sit in the Patents Court also sit in IPEC when the need arises.

1.6 Trials outside London or heard by video link

IPEC trials can be heard outside London and this will happen in particular where it saves costs. If the parties wish the trial to be heard at a place other than London, they should contact the clerk of the Presiding IPEC Judge as soon as possible and in any event no later than the case management conference (see below) so that arrangements can be put in place well before the date of the proposed hearing. (Contact details are given at the end of this Guide.) Before making such an approach, the parties should discuss this between themselves.

Alternatively, trials may be heard remotely, i.e. by video link using software such as Teams or Skype.

If any party has a view as to where a trial should be heard or whether it should be heard remotely, the matter should be raised at the case management conference (see below). If the circumstances of a party alter after the case management conference, the matter can be raised by an application to the court.

The default arrangement for all interim applications, including case management conferences, is

that a hearing will be conducted remotely. Any party can apply to the court for the hearing to be held in a courtroom, although subject to very unusual circumstances IPEC judges will not sit outside London for interim applications because hearings are too short to make this practical. Parties can also apply for a hearing to be conducted by telephone.

1.7 Representation

A person may represent themselves in litigation in IPEC as a litigant in person. However, intellectual property disputes can be complex and litigants will often benefit from the assistance of a professional representative.

Solicitors and patent and trade mark attorneys¹ are all entitled to represent clients in IPEC. These professionals may additionally instruct barristers to help prepare the case and/or to argue the case in court. In some instances, a barrister may accept instructions directly from the public.

Each of these professions has its own qualifications and a particular set of skills. It may be appropriate to instruct more than one legal representative to act as a team.

A company or other corporation may be represented at trial by an employee, whether or not the employee is director, provided the employee has been authorized by the company and the court gives permission, see CPR Part 39 rule 6.

IP Pro Bono

Where a person bringing or defending a case in IPEC cannot afford to pay for their own legal representative, they may be eligible to seek free or 'pro bono' advice. A scheme has been set up which provides free professional assistance for those involved in intellectual property litigation who do not have the resources to pay for advice. The IP Pro Bono scheme was organized with IPEC particularly in mind. It has a website at www.ipprobono.org.uk which explains how the scheme works and how a party may obtain free assistance from a professional adviser experienced in the relevant area of intellectual property law. Those who wish to use the scheme should apply as soon as is reasonably possible.

¹ The rights of patent attorneys and trade mark attorneys to conduct litigation and appear in IPEC are determined by the Intellectual Property Regulation Board (IPREG) (www.ipreg.org.uk). Attorneys with an Intellectual Property Litigation Certificate may conduct litigation and appear in IPEC.

2. Civil Procedure Rules

2.1 The CPR

Like all proceedings in the High Court, procedure in IPEC is governed by the Civil Procedure Rules ('the CPR') which can be found at: www.justice.gov.uk/courts/procedure-rules/civil/rules.

It would be unwise for a litigant to navigate the rules in detail without informed advice. Users of IPEC should be aware that this Guide cannot and does not attempt to cover every issue which may arise in the course of litigation. However, the rules which are most relevant to litigants in IPEC are referred to in the course of explaining how IPEC works.

2.2 Abbreviations

The CPR are divided into numbered Parts. Each Part has numbered rules. Most Parts have at the end of them guidelines relevant to that Part, called 'practice directions'.

By way of example, rule 23 of Part 63 will be referred to as 'Part 63 rule 23'. The practice direction at the end of Part 63 will be referred to as 'PD 63' and its paragraphs as 'PD 63 para.1', and so on.

2.3 Rules of particular relevance to IPEC

- Part 63 applies to all intellectual property claims. It includes rules specific to intellectual property cases and also modifies some Parts of the CPR which would otherwise apply generally to all claims.
- Practice Direction 63 (PD 63) supplements Part 63.
- Attention is drawn to two other parts of the CPR which contain provisions specific to IPEC:
 - Part 30 and in particular PD 30 paras. 9.1 and 9.2. These apply to the transfer of proceedings to and from IPEC. Part 30 rule 5, when applied to IPEC transfers, is modified by Part 63 rule 18.
 - Part 46 Section VII and PD 46 paragraph 11.1 relate to costs in IPEC.

3. The Court in which to bring proceedings

3.1 The options

A litigant wishing to start an intellectual property claim must decide on the court in which to bring the proceedings. First, should the claim be brought in IPEC or elsewhere in the High Court?

If the case is to be brought in IPEC there is a second decision to be made: should it be started in the IPEC multi-track or the IPEC small claims track?

3.2 IPEC or elsewhere in the High Court

The following guidelines are provided to assist users in determining whether a case is suitable for IPEC:

- The financial resources of the parties. A party may have limited financial resources and may therefore require the lower cost of litigating in IPEC and the protection of costs caps in order to gain access to justice. If this can be shown, it is likely to be treated as a strong (though not overriding) reason to have the case heard in IPEC. This will be particularly the case if the court reaches the view that there is a risk of a better funded opponent being able to bring unfair financial pressure to bear should the case be heard outside IPEC. That said, a party wishing for the proceedings to be in IPEC remains under an obligation to tailor their case to ensure that all the issues in the proceedings will not give rise to a trial lasting more than 2 days, or exceptionally, 3 days.
- The overall complexity of the claim. Where the claim is such that it will require a trial of more than 2 days, it is unlikely to be suitable for IPEC. Exceptionally, a trial of 3 days may be permitted. A litigant with a complex claim or a complex defence and/or counterclaim who wishes the case to be heard in IPEC, should give strong consideration to pruning their case down to the essentials. A failure to do so may result in the action being heard elsewhere in the High Court purely because there are too many issues for a 2 or 3 day trial.
- The nature of the evidence. If it is anticipated that a large number of witnesses will be required on either or both sides, all to be cross-examined, there may be a significant risk that the limit of a 2 or 3 day trial will be exceeded.
- The value of the claim. The value of the claim, though relevant, is generally not a major factor in the evaluation of whether a case is suitable for IPEC, in part because it is often difficult to give an accurate estimate of the overall value. The value of a claim is not necessarily the same as the amount of compensation claimed since it may include the value of an injunction.

A defendant sued in the Patents Court or in the general Chancery Division is entitled to apply to have the case transferred to IPEC, and vice versa. This should be raised in correspondence first. If the parties agree that the case should be transferred it still requires the approval of a judge in the court in which the case is currently listed, but is likely to happen. If there is no agreement, an application to transfer must be made. This should be done at the latest at the case management conference (see below).

Parties may take the joint view that a case which would not normally be suitable for IPEC should

nonetheless be heard there. They are also free to agree that the £500,000 limit on compensation for infringement will be waived. In such a case the court will usually accommodate the parties' wish provided that the trial will not take excessively longer than is usual for an IPEC trial.

3.3 The IPEC multi-track or small claims track

Where a claimant has decided to bring their case in IPEC, consideration should be given to whether it should be in the IPEC multi-track or small claims track.

The small claims track never hears cases involving patents, registered designs, semiconductor topography rights or plant varieties. A claim in relation to those rights can only be brought in the IPEC multi-track (or the Patents Court).

Broadly speaking, if the case does not concern any of those rights and the compensation sought does not exceed £10,000, the claim will be heard in the small claims track. However, £10,000 does not constitute a hard and fast ceiling; the small claims track is entitled to order compensation above that amount. So although the level of damages (or defendant's profits) at stake is important, other matters also have to be taken into account.

If a case involves a point of law of some complexity or importance, or if it requires extensive cross-examination or for other reasons the trial is liable to last more than one day, the case will be unsuitable for the small claims track even if less than £10,000 is claimed in compensation. On the other hand, a straightforward case with no significant issue of law that can easily be heard in less than a day may be suitable for the small claims track even if the claimant seeks somewhat more than £10,000.

A defendant sued in either track may apply to have the case transferred. Before doing so, the defendant should seek the agreement of the claimant as to which track is appropriate.

Where the court is called upon to decide whether the case should be heard in the multi-track or the small claims track, in addition to the matters already discussed the size of the party seeking to have the case heard in the small claims track is often a significant factor. The court is more likely to allocate a case to the small claims track where an individual or a small company with limited financial means would benefit from the less formal procedure in the small claims track and/or the greater protection from exposure to an adverse costs order, provided the opposing side would still have sufficient opportunity to present their case. Another factor could be that judges who hear IPEC small claims are based more locally to the parties, thus affording a saving in costs.

CPR Part 63 rule 27 deals with allocation to the small claims track.

4. Procedure in IPEC

4.1 Before starting proceedings

Attention is drawn to the Practice Direction – Pre-Action Conduct, which can be found at http://www.justice.gov.uk/courts/procedure-rules/civil/rules/pd_pre-action_conduct. This sets out steps to be taken before starting a claim.

Paragraph 6 of the practice direction is of particular relevance and is set out here:

“Steps before issuing a claim at court

6. Where there is a relevant pre-action protocol, the parties should comply with that protocol before commencing proceedings. Where there is no relevant pre-action protocol, the parties should exchange correspondence and information to comply with the objectives in paragraph 3, bearing in mind that compliance should be proportionate. The steps will usually include –
 - (a) the claimant writing to the defendant with concise details of the claim. The letter should include the basis on which the claim is made, a summary of the facts, what the claimant wants from the defendant, and if money, how the amount is calculated;
 - (b) the defendant responding within a reasonable time - 14 days in a straight forward case and no more than 3 months in a very complex one. The reply should include confirmation as to whether the claim is accepted and, if it is not accepted, the reasons why, together with an explanation as to which facts and parts of the claim are disputed and whether the defendant is making a counterclaim as well as providing details of any counterclaim; and
 - (c) the parties disclosing key documents relevant to the issues in dispute.”

This practice direction, including paragraph 6, was drafted to apply generally in civil litigation, not just in IPEC. In the context of IPEC proceedings there is no ‘relevant pre-action protocol’ as mentioned in the first sentence, so the remainder of the paragraph applies. With regard to 6(b), defendants in an IPEC case are expected to respond within 14 days save in exceptional circumstances.

Threats

Potential claimants should be aware that while they should notify the intended defendant of their proposed claim, this should not take the form of an unjustified threat of infringement proceedings. In relation to some intellectual property rights a party making such a threat can be sued. It is beyond the scope of this Guide to explain the (sometimes fine) distinction between informing another party of your intellectual property right and threatening to bring proceedings for its infringement. It is wise to seek professional advice.

4.2 Starting proceedings

Proceedings are started when the court issues a claim form. To have this done, the intended claimant must complete Form N1 (the Claim Form) and send it to the court. The Claim Form and notes for completing it can be found at www.gov.uk/government/publications/form-n1-claim-form-cpr-part-7.

The Claim Form and any other document can be filed with the court online, see Section 5 of this Guide 'General Arrangements' below. It may be filed in London or in any of the Business and Property Court Centres outside London at Birmingham, Bristol, Leeds, Liverpool, Manchester, Newcastle or Wales (Cardiff). Alternatively, the Claim Form may be posted to, or presented at the public counter at any of the foregoing centres.

The Rolls Building is a court building in London which contains IPEC. Its address, which is also the address of IPEC in London, is given in Annex A at the end of this Guide. Annex A also provides the addresses of the Business and Property Court Centres outside London.

4.3 Service of the claim form

'Service' of a document means delivering it to another party in the proceedings. This is to be distinguished from 'filing' a document with the court.

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. It contains (a) a form for defending the claim, (b) a form for admitting the claim and (c) a form for acknowledging service. The response pack is supplied to the claimant by the court along with the claim form.

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 rule 3 sets out a number of alternative methods. These include email provided that the party being served, or their solicitor, has previously indicated in writing that they are willing to be served by email.

If the relief sought involves a change to any UK registered right (such as its revocation or amendment), attention is also drawn to Part 63 rule 14(3), which requires that copies of certain documents should also be sent to the UK Intellectual Property Office.

It is good practice for a claimant to serve their Particulars of Claim with the claim form, but see Section 4.5(b) of this Guide for details of timing.

4.4 Response by the defendant

A defendant served with Particulars of Claim has a choice as to how to respond. They may serve their Defence within 14 days of service of the Particulars of Claim. More usually a defendant will file an Acknowledgment of Service with the court. This is a form contained within the response pack which will have been served on the defendant along with the claim form. Filing an Acknowledgment of Service extends the time allowed for serving the Defence (see below). If the defendant wishes to challenge the jurisdiction of the court, they should only file an Acknowledgment of Service.

CPR Part 10 rule 3 sets out the period for filing an Acknowledgment of Service. 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 Part 15 rule 6). It is always helpful to send a copy of any document filed with the court to the other party to ensure that those documents are received by the other party in a timely manner.

4.5 Statements of Case

(a) Introduction

The statements of case are the documents in which each party sets out their case, often called pleadings. For the claimant this will be the Particulars of Claim. The defendant responds with the Defence. Alternatively, the defendant can serve a Defence and Counterclaim where the defendant wishes not only to defend the claim but also to respond with a claim of their own. The claimant may then serve a Reply or a Reply and Defence to Counterclaim, as appropriate.

Part 63 rule 20(1) requires that a statement of case in IPEC must set out concisely all the facts and arguments upon which the party serving the statement relies. This is sometimes misunderstood. All relevant facts and arguments must be stated. But they should not be set out in a manner which includes every detail. There will be an opportunity by the time of the trial to explain to the court everything that matters. A good approach is to make the statement of case as concise as is possible, while considering whether any argument to be run at trial, or matter to be relied on, will come as a surprise to an opponent who has read the statement of case. If not, the statement of case has probably been drafted in sufficient detail.

Copies of important documents referred to in a statement of case (e.g. a patent, a design registration or an image of a design, or a contract relied on) should be served with the statement of case. Where any such document requires translation, a translation should be served at the same time.

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

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

The better practice is for a claimant to file and serve the Particulars of Claim with the court together with the claim form. However, the Particulars of Claim can be served up to 14 days later (Part 7 rule 4(1)) or, if the time for service of the claim form is due to expire in less than 14 days (see Part 7 rule 5) no later than the latest time for serving the claim form (Part 7 rule 4(2)). The Particulars of Claim must be filed with the court no later than 7 days after service on the defendant (Part 7 rule 4(3)).

If no Acknowledgement of Service has been filed by the defendant, the period for filing the Defence with the court is 14 days after service of the Particulars of Claim (Part 15 rule 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 paragraph 6 of the Pre-Action Conduct Practice Direction (set out above) has been complied with. The time limit is 42 days if it does and 70 days if it does not (Part 63 rule 22(2) and (3)). 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 (Part 15 rule 6). This should be done at the same time as filing the Defence.

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 (Part 63 rule 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 (Part 63 rule 22(5)).

Some time limits are stricter than others in IPEC. The parties are not at liberty to extend the time limits set out in Part 63 rule 22 without the prior consent of the judge. An application for an extension of time must be made before the expiry of the relevant period and set out good reasons why the extension is required. Such applications are almost always dealt with without a hearing.

(c) Content of statements of case for different types of claim

The following is guidance on the preparation of a statement of case for particular types of claim.

Patent proceedings

- A statement of case alleging infringement of a patent must (a) state which of the claims are alleged to be infringed and (b) give at least one example of the defendant's infringing product or process.
- A statement of case alleging that a patent is invalid must specify the grounds on which the validity of the patent is challenged, including any challenge to a priority date. All prior art relied on must be specified and a copy of each item of prior art must be attached to the pleading. Only very rarely will more than 3 items of prior art be permitted. If it is alleged that a patent does not disclose the invention clearly and completely enough for it to be performed, the pleading must state which aspects of the invention cannot be made to work and in which respects the invention cannot be made to work.
- A statement of case served in response to an allegation that the patent is invalid must state which claims are said to be independently valid.
- By the time the pleadings are closed and before the case management conference (CMC, see below), it should be clear which claims are in issue. They will be the claims which are alleged to be infringed and the claims which are alleged to have independent validity. The parties should bear in mind that at the CMC the court may require the number of claims in issue to be reduced, so consideration should be given to which of them is or are the most important to the party's case.
- Before the CMC the claim or claims in issue should be broken down into suitable integers (i.e. separate parts). The party alleging infringement should create a document stating which integers of the claim are embodied in the allegedly infringing product or are incorporated in the allegedly infringing process. This is often best done by a chart. In the case of a product claim the argument on infringement can be made even more clearly by using a diagram to identify where each integer of the claim is to be found in the allegedly infringing product. (It is not necessary to wait until pleadings are closed to do this. Particularly where it is apparent which claim or claims will be in issue, it is helpful to create the claim chart in the Particulars of Claim).
- Likewise the party alleging that a patent is invalid because it lacks novelty or inventive step over prior art should create a chart identifying which integers of the claim are present in the pleaded prior art. Again, sometimes a diagram of a prior art product may make the point even more clearly. It is helpful to create the chart as part of the Defence, but this must be done before the CMC at the latest.
- All parties should state what they understand to be the inventive concept – the core of the invention – in relation to the patent claim(s) in issue. The inventive concept may well form an essential part of arguments at trial and each side's definition should be clear by the time of the CMC.
- There should be a statement from both sides as to the facts which are said to be relevant common general knowledge. The nature and characteristics of the skilled person should be identified.

Registered design proceedings

- Where the defendant alleges the registered design is not new or lacks individual character, the Defence must specify the details of any prior design relied on, including full details of the date on which and the manner in which the prior design was made available to the public.
- The parties should be aware that at the CMC the number of items of prior art relied on may be limited by the court. If a party wishes to allege that an item of prior art is typical of other items available to the public and that all such items are relevant to the design corpus, consideration should be given as to how such typicality is to be proved at trial.
- Both the Particulars of Claim and the Defence should set out the relevant party's case as to the nature and characteristics of the informed user.

UK unregistered design right proceedings

- The Particulars of Claim should unambiguously identify the design or designs relied on. There is usually no difficulty if the design is of a specified entire article. If the claimant relies on the design of part of an article, or a combination of parts, the design in question must be clearly identified. A marked diagram may be essential.
- The claimant should bear in mind that at the CMC the court is likely to impose a limit on the number of designs relied on. Five is a usual maximum.
- The claimant should set out in their Particulars of Claim the significant features of each design relied on. The claimant should identify which of the significant features are to be found in the allegedly infringing article and where. For clarity it may be appropriate to do this by means of an annotated diagram.
- In the Defence, the defendant should indicate whether they agree the list of significant features of the claimant's design and, if appropriate, add to the list. By reference to the list, the defendant should identify which of the significant features are admitted to be present in the design of the accused article. It may be convenient to use a chart to do this (though it is not obligatory).
- If the defendant alleges that the design in issue lacks originality (in the copyright sense), one item of prior art should be identified in support of the allegation. The defendant should identify where each of the significant features is to be found in that item of prior art. It may be appropriate to use an annotated diagram.
- If the defendant alleges that the design in issue or any part of it is commonplace, all prior art relied on should be identified. By any clear and convenient means, the defendant should indicate which of the significant features of the design in issue are to be found in each item of prior art. Parties should be aware that the number of items of prior art which may be relied on may be limited by the court at the CMC.
- If alleged, the defendant should clearly identify which of the significant features of the design constitute a method or principle of construction, or are features which either (i) enable the article to be connected to, or place in, around or against, another article so that either article may perform its function, or (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part. Any clear and convenient means of identification may be used.
- It may be helpful for the claimant to respond in the Reply.

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 average consumer (if relevant).

Copyright proceedings

- A defence of independent design in a copyright case should to be addressed in appropriate detail.

(d) Statements of truth

Attention is drawn to Part 63 rule 21, which modifies Part 22 in its application to 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. The knowledge of the person signing the statement of truth should be direct knowledge, so it will seldom be appropriate for that person to be a legal advisor.

Part 32 rule 14 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.

4.6 Case management

The case management conference (CMC) is a preliminary hearing in court which gives the judge, with the assistance of the parties, the opportunity to manage the conduct of the case. This is so that the proceedings will move forward to the trial in an efficient way proportionate to the nature of the dispute.

At the CMC the court will identify the issues of fact and law to be resolved at the trial and will 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 disclosure, witness statements, experts' reports and skeleton arguments. The trial date will be fixed at the CMC as will the date on which judgment is to be handed down (unless this falls within a court vacation, in which case the date of judgment will be given at the end of the trial).

(a) Directions questionnaire

No directions questionnaire is required.

(b) The application for the case management conference

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. However, any party may apply for a CMC at any point if there is good reason. If the claimant has failed to apply for a CMC within 14 days of service of the Defence, the defendant should do so.

An application for a CMC is made in the same way as any other application to the court (see below). Once the application has been made, the judge's clerk will contact the parties to fix a date which is available in the court diary and which is convenient to the parties.

(c) Preparation for the CMC

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

section 5.5 of the Guide below on the preparation of bundles.

The CMC is a particularly important part of IPEC procedure. No material may be filed in the case by way of evidence, disclosure or written submissions unless permission is given by the judge. The first and last opportunity to obtain such permission is likely to be at the CMC. Save in exceptional circumstances the court will not permit a party to submit material in addition to that ordered at the CMC (Part 63 rule 23(2)). A cost-benefit test is applied to the filing of material in support of a case, see PD 63 para 29.2(2).

It is important that before the CMC the parties have given full consideration to the following:

The issues

The issues in dispute. These should clearly emerge from the statements of case. The parties must draw up a list of issues which the court will have to resolve at trial. It is not necessary to list every sub-issue that may arise and this should not be done. The parties will be permitted to argue at trial any point which is both covered by the pleadings and which the opposing side should reasonably contemplate as falling within one or more of the listed issues. The trial judge may refuse to hear argument at trial on a point which does not satisfy those criteria.

Disclosure

Whether disclosure of documents by the opposing side will be required and if so, which documents and why. Only specific disclosure is available in IPEC, i.e. disclosure of either particular documents or particular classes of documents, often identified by reference to one or more of the list of issues. Usually, whether or not other disclosure is ordered, the parties will be expected to disclose any 'known adverse documents' within the meaning of paragraph 2 of PD 51U (which can be found at www.justice.gov.uk/courts/procedure-rules/civil/rules/practice-direction-51u-disclosure-pilot-for-the-business-and-property-courts#2).

The disclosure pilot scheme in operation in other Business and Property Courts does not apply to IPEC.

Evidence of fact

Whether there is a need for evidence from one or more witnesses of fact and if so, the number of witnesses that will be required and, in broad terms, the factual matters which each witness will address. Generally, each issue of fact should be covered by only one witness. Where possible a single witness should deal with as many matters as possible so that the number of witnesses is kept to a minimum.

Expert evidence

Whether there is a need for evidence from one or more experts and if so, the number of experts that will be required and, in broad terms, the topics on which each expert will express an opinion. If expert evidence is permitted at all, only where it is clearly shown that different and distinct areas of expertise are relevant to the issues at trial will more than one expert be allowed.

Experiments, process descriptions, samples

Whether there is a need for any party to perform any experiments, provide a process description or supply a sample of any product or design.

Timetable

The timetable for the stages up to trial, in particular the dates for disclosure of documents, factual evidence and where appropriate, expert evidence, the supply of samples and any other relevant event. The court will not usually approve a timetable containing an automatic right to

serve evidence in reply, but it may include a date by which the parties may apply to the court serve evidence in reply. Such an application, when later made, must state the topics in the evidence of the opposing side to be addressed in reply.

Draft order

The parties should attempt to agree a proposed order for directions, including the list of issues, to be made at the CMC in advance of the hearing. If agreed, a draft should be supplied to the court with the bundle of documents. If not agreed, each of the parties' proposed orders should be supplied with the bundle. In such a case it is helpful to have a single document marked up to show the alternative proposals of the parties.

(d) The hearing of the CMC

The CMC will almost always be conducted as a hearing in court. Where all parties consent, the judge may determine the CMC on paper. But even where the proposed order has been agreed by the parties the judge may require submissions in court to be sure that the issues have been correctly identified and that the directions are appropriate.

An example CMC order is attached to this Guide at Annex B.

(e) Amendments to a statement of case

On occasion a party may wish to amend its statement of case. If the other parties agree then generally no difficulties arise. If not, permission to amend may be sought at or before the CMC. Amending a statement of case after the CMC is difficult under IPEC procedure, so parties must be sure by the time of the CMC that their pleadings are in final form.

(f) Alternative dispute resolution

The parties are required to give consideration to alternative dispute resolution (ADR) before the CMC. Either party may apply for time in which to pursue ADR before the proceedings progress further. Unless the court is satisfied that ADR is likely to be futile, time will usually be given. ADR is considered in more detail below.

(g) 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. If in doubt the parties should raise the matter at the CMC.

(h) 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 Part 25 rules 12-14.

(i) Expression of a preliminary, non-binding opinion on the merits

If it is likely to assist the parties in reaching a settlement, IPEC is willing to express a preliminary and non-binding opinion on the merits of the case. This is often called an 'early neutral evaluation'. The court will almost certainly not take this course unless agreed by both sides. If there is agreement, the request to give the non-binding opinion should be made in advance of the CMC so that the court may consider whether it is appropriate. It is unlikely to be appropriate, for example, if the outcome of the proceedings will largely depend on unpredictable evidence that may emerge at trial.

(j) **Expedited trial**

In a suitable case, the court may order that the trial will be heard sooner than would normally happen. Such an order has the effect of jumping the queue of other litigants, so will not be ordered unless a good reason for expedition is shown. An application for an expedited trial is best made at the CMC but may be made at any time.

4.7 Applications

An application to the court, including an application for a CMC, is made according to the procedure set out in Part 63 rule 25. This rule applies Part 23 with modifications, so Part 23 must also be considered. In brief, Part 23 requires the applicant to serve an application notice, a standard form N244 in which the applicant states their intention to apply to the court and which sets out the nature of the application. Form N244 can be downloaded at: www.gov.uk/government/publications/form-n244-application-notice

With the exception of applications made at the CMC, once the application notice is received by the party on whom it is served – the respondent – the respondent to the application must file and serve a response on all relevant parties within 5 working days of service of the application notice, see Part 63 rule 25(2). This rule is specific to IPEC and is significant. If 5 working days elapse and the respondent has done nothing, the applicant is entitled to ask the court to make the order sought without further delay. It is therefore imperative that there is a response as soon as possible. Usually it is sufficient to contact the applicant and state the respondent's position with regard to the application. If a resolution cannot be agreed, the applicant will contact the court and arrange a hearing.

An applicant should take care to serve the application notice on the respondent. If the applicant notifies the court that 5 working days have elapsed without a response, they should also inform the court of the date on which the application notice was served and how this was done. Unless the court is shown that 5 working days have undoubtedly elapsed since service of the application notice, no action will be taken by the court.

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. This is an application to have judgment in the entire claim entered against the defendant because the defendant has not engaged with the court process.

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).

An application for judgment in default which seeks an order for an injunction must be made by an application notice. This will allow the defendant the usual 5 working days in which to respond. Such applications can generally be dealt with on paper. It is important to satisfy the court (a) that the claim form and Particulars of Claim were properly served and the date on which this was done and (b) the date and means of service of the application notice for judgment in default.

If judgment in default is granted, the order will be served on the defendant. The defendant has the right to apply to set aside such an order. This is done by filing an application notice. Setting aside an order for judgment in default will not follow automatically. Broadly speaking, the court will have to be satisfied that the defendant has an arguable defence and that the defendant ought to be given the opportunity to advance their defence. The longer the defendant takes in seeking to set aside a judgment in default, the less likely it is that the judgment will be set aside.

4.8 Urgent applications

An application for an interim injunction or other urgent relief, should be made by filing an application notice in the usual way (save in cases of extreme urgency, discussed below). Once the application notice has been served, the applicant should contact the judge's clerk (see Annex A). The clerk will find a date for the hearing which is appropriate to the urgency of the matter and, if possible, is convenient to all parties. In the meantime, the parties should make every effort to agree a timetable for evidence to be filed and served in relation to the application and any question of relief pending the hearing. Failing agreement, the judge's clerk should be informed. The court will then finalise the timetable and deal with any application for relief pending the hearing. This may be done on paper, by a video application, or in a short hearing, as appropriate.

In cases of extreme urgency, an application may be made without an application notice. This is done by contacting the clerk to IPEC. No such application will be entertained unless the judge is given very good reason why the matter is extremely urgent.

The court will always fix a date and time for hearings appropriate to the urgency of the application. This may mean that the application will be heard by a judge other than the Presiding Judge of IPEC. The convenience of the parties and their advisors will be taken into account but will not be of paramount importance.

4.9 The trial

At the 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 parties are required to file a timetable for the conduct of the trial shortly in advance. If agreed by the judge, this timetable is likely to be enforced strictly. Unless there is good reason not to, the court will allocate equal time to the parties.

Trial on paper

In an appropriate case and if the parties consent, the trial may be conducted on paper, i.e. there is no hearing. The judgment is delivered in the usual way once the judge has read the papers.

4.10 Costs

There is no requirement for costs budgets in IPEC.

Costs are subject to the cap provided by Part 46 rules 46.20 to 22. With certain limited exceptions the court will not order a party to pay total costs of more than £60,000 on the final determination of a claim in relation to liability and no more than £30,000 on an inquiry as to damages or account of profits.

Tables A and B of PD 46 paragraph 11.1 sets out the maximum amount of scale costs which the court will award for each stage of a claim.

There are exceptions: court fees, costs relating to enforcement of an order and wasted costs are excluded from the costs cap (Part 46 rule 46.21(5)). Any recoverable VAT is not included in the capped stage costs (Part 46 rule 46.21(6)) but the overall caps of £60,000 and £30,000 are inclusive of VAT. For further details, see *Response Clothing Ltd v The Edinburgh Woollen Mill Ltd* [2020] EWHC 721 (IPEC).

In IPEC all costs are assessed summarily (Part 46 rule 46.20(3)). To enable the court to assess costs, the parties should prepare a statement of costs in advance of any hearing in which costs will be claimed. It is essential that the statement of costs breaks down the costs by reference to the stage of the claim in which they were incurred, see Table A and B of PD 46 paragraph 11.1.

The foregoing provisions regarding costs came into force on 1 October 2022. Proceedings started before that date will continue to be governed by the earlier cost cap rules (see the previous IPEC Guide for details.)

Costs of an interim application

Costs of the case management conference or any other interim hearing will almost always be reserved to the conclusion of the trial (Part 63 rule 26(1)). The most usual exception arises when a party is found to have behaved unreasonably. In such a case the court may make an order for costs at the conclusion of the hearing, to be paid shortly thereafter. These costs will be awarded in addition to the totality of the capped costs which the receiving party is entitled to at the end of the trial, see Part 45 rule 32.

4.11 Alternative dispute resolution

Settlement of a dispute by alternative dispute resolution (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. 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. This should be recorded in a recital to the order made at the case management conference (see Annex B). In an appropriate case, the IPEC judge will adjourn a case for a specified period of time to encourage and enable the parties to use ADR.

5. General arrangements

5.1 Filing documents with the court

(a) Filing documents online

Documents may be filed at the court online. A guide as to how this may be done is at www.gov.uk/guidance/ce-file-system-information-and-support-advice.

This does not apply to bundles of documents to be used at the hearing of an application or at the trial. These must be taken or sent in hard copy to the court (see (b) and (c) below).

(b) Posting documents to the court

Documents may be posted to the court at the address given at Annex A below.

(c) Filing in person

Documents may also be filed by presenting them at the public counter of the Rolls Building, the court building in which IPEC is located. The address is given at Annex A below.

5.2 Court fees

Fees are charged by the court for starting proceedings, for the trial and for making an application. The current fees are set out at www.gov.uk/government/publications/fees-in-the-civil-and-family-courts-main-fees-ex50.

5.3 Arrangements for listing

(a) Applications including the case management conference

Once the application notice has been filed and served on the opposing side, the applicant should contact the judge's clerk (contact details given below) in order to fix a date for the hearing. If the matter is urgent, the clerk should be notified, giving reasons for the urgency. Where possible a date be fixed which is convenient to the parties. However, if one or both parties offer only a limited range of suitable dates, the court may fix a date without reference to both parties' convenience, particularly where otherwise there would be an unreasonable delay before the hearing.

(b) Trials

Trial dates are fixed at the case management conference (CMC). Parties attending the CMC should have their diaries and other necessary information available so that an appropriate date for the trial is fixed, such information to include the availability of witnesses. After the CMC the court will contact the parties confirming the trial date and requesting payment of the trial fee. The trial fee must be paid within 14 days of the trial date being set.

5.4 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 time estimate.

Where parties and their legal advisors consider that a time estimate provided by the opposing side is not realistic, they have a duty to notify the judge's clerk as soon as possible, giving their own time estimate.

5.5 Documents bundles and skeletons for the trial and applications

The preparation of papers for the hearing of applications and trials is important and should be approached intelligently. Annex C provides guidance to the preparation of the bundle of documents for use at trial or an application. This 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.

It is the responsibility of both parties to ensure that all relevant documents are lodged by noon two working days before the date fixed for hearing unless some longer or shorter period has been ordered by the judge.

At the trial it is the responsibility of the claimant to prepare the bundles. A timetable for doing this will be set out in the order following the CMC. For an application it falls to the applicant to prepare the bundle in good time so that a copy may be provided to the court by noon two working days before the hearing and to the opposing side.

Where the party responsible for preparing the bundles is a litigant in person and the opposing side is professionally represented, it is helpful for the professional representatives to offer to undertake the task of preparing the bundles.

Bundles should be taken or sent to the court at the Rolls Building. Skeleton arguments should be supplied by email to the judge's clerk. Where the matter is urgent, the judge's clerk may be asked whether documents may be sent by email.

It is helpful if all important documents in trial bundles are also 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). These will usually include skeleton arguments, important patents and drawings, the witness statements and expert reports.

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. 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).

In the case of trials, the deadline for filing skeleton arguments will be stated in the order following the CMC. The court will frequently be assisted by a chronology of relevant facts in the trial skeleton. It should be included unless the chronology is short enough to be self-evident or would contribute nothing of value.

5.6 Consent Orders

The court will usually make orders proposed with the consent of all parties without the need for the parties to attend. 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. It will be drawn up accordingly and sent to the parties.

5.7 Evidence at the trial

Evidence will usually be given by witnesses present at the trial. However, the judge may give permission for a party to provide evidence by video link. Permission must be sought well in advance of the trial, generally at the CMC, so that the court may make suitable arrangements.

Where a transcript of the evidence is made, it should be supplied to the judge by e-mail and in hard copy.

5.8 Draft judgment

Some judgments, almost always those after a trial, will be reserved and handed down at a later date. Usually the parties' legal representatives (or litigants in person) will be provided with a copy of the draft judgment in advance of the date of handing down so that they may 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, and its effect, are 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.

5.9 Order following judgment

There will often be a hearing after the judgment has been handed down in order to finalise the order to be made in consequence of the judgment. This may be immediately after the judgment is handed down or may be at a later date. The timing may depend on other commitments of the court. The parties should contact the court to be notified of or to arrange the date. The parties must exchange drafts of the desired consequential order in advance of the hearing. Where the parties are agreed as to the consequential order and have supplied to the judge a copy signed by all parties or their representatives, no hearing will be necessary.

5.10 Enforcement

A party seeking to enforce an injunction or procedural order should make an application to the court.

Enforcement of Financial Element of an Order

Enforcement of a financial element of an order (an order entitling a party to receive payment from another party) will be done by a district judge. Special provisions apply. A party seeking to enforce a financial element must take or send the documents set out below **in hard copy** at The Rolls Building, 7 Rolls Buildings, Fetter Lane, London EC4A 7NL. The documents should be contained in a bundle which is clearly marked for the attention of the IPEC Small Claims Track sitting in the Thomas More Building. The relevant documents are:

- the enforcement application;
- any evidence in support of the application;
- the sealed judgment or order of which enforcement is sought;
- any appeal notice or appeal order; and
- any order staying the proceedings.

5.11 Appeals

An order of an IPEC judge may be appealed. This applies equally to orders made following a trial and those made in response to an application to the court. All appeals go the Court of Appeal, see PD52A, Section 3, Table 1. No party has an absolute right to appeal, permission must be obtained. Permission to appeal may and generally should be sought from the judge who made the order. If the judge refuses to give permission, the party may instead seek permission from the Court of Appeal.

NOTE THAT this does not apply to appeals from decisions in the IPEC Small Claims Track. All

appeals from the IPEC Small Claims Track go to an Enterprise Judge, i.e. a judge of the IPEC multi-track, see CPR 63.19(3).

Costs in the Court of Appeal

There is no automatic capping of costs in the Court of Appeal. However, the Court of Appeal has a discretion to make an order limiting the costs which a successful party may recover from the unsuccessful party on appeal. See CPR Part 59 rule 19. The discretion will be exercised with regard to (a) the means of both parties, (b) all the circumstances of the case and (c) the need to facilitate access to justice. Exceptionally, an order limiting costs may not be made if the appeal raises an issue of principle or practice upon which substantial sums may turn.

An appellant who wishes to have the appeal costs capped should apply to the Court of Appeal as soon as is practicable.

5.12 Information available on the Internet

A link to 'Intellectual Property Enterprise Court' (and links to other courts) can be found at: www.gov.uk/courts-tribunals. It contains links to copies of this Guide and the Guide to the Intellectual Property Enterprise Court Small Claims Track.

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

Statutes and other legislation are at: www.legislation.gov.uk

www.justice.gov.uk/courts/court-lists provides links to two useful sites. The first is 'Intellectual Property Enterprise Court Diary' which provides the diary for trials (but not applications) to be heard in IPEC and a record of past trials. The second is 'Business and Property Courts Rolls Building Cause List'. The link there to 'Intellectual Property List (ChD)' provides a list of all IP court hearings, including those heard in IPEC. After about 2pm the website shows the hearings for the following day.

IPEC judgments are available at the National Archive website and may searched for by name at www.caselaw.nationalarchives.gov.uk.

Annex A – Contact details

The Intellectual Property Enterprise Court

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

The Rolls Building
7 Rolls Building
Fetter Lane
London
EC4A 1NL

DX160040 Strand 4

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

The judge's clerk and clerk to the Intellectual Property Enterprise Court is at present Francine Kouassi. Her contact details are:

Francine.Kouassi1@justice.gov.uk

Tel: 020 7947 6265

Filing documents online

Documents may be filed at the court online. A guide as to how this may be done is at www.gov.uk/guidance/ce-file-system-information-and-support-advice.

This does not apply to bundles of documents to be used at the hearing of an application or at the trial. These must be taken or sent in hard copy to the court (see above).

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

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

Please note that the court cannot give legal advice.

IP Pro Bono

A person with limited financial resources (including firms and companies if they qualify) may be entitled to free professional advice regarding any IP matter, whether concerning IPEC or not. The IP Pro Bono scheme is designed to help such persons. It may be contacted at:

www.ipprobono.org.uk

Intellectual Property Enterprise Court Users Committee

IPEC has a Users' Committee which considers the problems and concerns of intellectual property litigators in IPEC. Membership of the committee includes the judges of the Intellectual Property Enterprise Court and of the Patents Court, representatives of each of the Intellectual Property Office, European Patent Office, Intellectual Property Bar Association, IP Chambers Clerks, the Intellectual Property Lawyers Association, the Chartered Institute of Patent Attorneys, the Institute of Trade Mark Attorneys, the IP Federation, the British Copyright Council, the Pro Bono Committees and IP Academics.

Anyone having views concerning the improvement of intellectual property litigation in the Intellectual Property Enterprise Court is invited to make his or her views known to the committee, preferably through the relevant professional representative on the committee or its secretary.

The current secretary is:

Luke Maunder,
Bristows,
100 Victoria Embankment,
London
EC4Y 0DH

Tel: 020 7400 8000

Fax: 020 7400 8050

Email: luke.maunder@bristows.com

Annex B – Example CMC Order

UPON HEARING the Case Management Conference on [date]

UPON the issues to be determined at trial being identified in the Schedule to this order (“the Issues”)

AND UPON the parties’ legal advisors having informed their clients of alternative dispute resolution as a possible means of resolving these proceedings

IT IS ORDERED THAT:

Split trial

1. The trial shall determine only issues of liability, namely those set out in the schedule to this order. All issues of quantum, should they arise, will be resolved at a second trial.

Disclosure

2. Disclosure in accordance with the following paragraphs shall be given by 4pm on [date].
3. The claimant shall make and serve on the defendant a list in accordance with form N265 of documents in their control which relate to [Issues identified by number].
4. The defendant shall make and serve on the claimant a list in accordance with form N265 of the documents in their control which relate to [Issues identified by number].
5. Each party’s list of documents shall also include all known adverse documents within the meaning of paragraph 2 of Practice Direction 51U.
6. 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 7 days of the request, upon the undertaking of the party requesting the copies to pay the reasonable copying charges.

Evidence

7. The statements of case shall stand as evidence in chief.
8. The claimant may file [number] witness statements dealing with [Issues identified by number].
9. The defendant may file [number] witness statements dealing with [Issues identified by number].
10. The witness statements shall be filed and exchanged on or before 4pm on [date].
11. The parties may apply to serve witness statements in reply on or before 4pm on [date]. An application must identify the matters in the opposing party’s evidence of fact to be addressed.
12. The parties may each serve an expert’s report dealing with [Issues identified by number] on or before 4pm on [date].
13. The parties may apply to serve an expert’s report in reply on or before 4pm on [date]. An application must identify the matters in the opposing party’s expert evidence to be addressed.
14. The witnesses may be cross-examined at trial.
15. Any party intending to rely on a cross-examination bundle shall give the relevant witness

adequate notice of the bundle and must at the same time inform the court and the other parties (unless the court gives permission not to notify the other parties) of the exceptional reasons which are said to justify the late introduction of new documents into the case.

Trial

16. 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.
17. 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.
18. 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.
19. Time estimates for the cross-examination and speeches of the parties, a reading guide for the judge shall be filed by 4pm on [date].
20. The parties shall file and exchange skeleton arguments, on or before 4pm on [date].
21. The time allocated for the trial is [] day(s).
22. The trial of the Claim shall take place on [date].
23. Judgment in the action shall be handed down on [date]. The parties shall make themselves available for a hearing on that date to determine any matters consequential on the judgment, should it not be possible to agree a final order.

Costs

24. Costs are reserved to the trial.

Schedule – List of Issues

The following list adopts the abbreviations used in the Statements of Case.

Trade Mark

1. Whether, because the Trade Mark is similar to the Earlier Trade Mark and is registered for goods identical with or similar to those for which the Earlier Trade Mark is registered, there exists a likelihood of confusion on the part of the public.
2. Whether the Sign has been used in the course of trade.
3. Whether the Sign is similar to the Trade Mark.
4. Whether the Trade Mark has a reputation in the United Kingdom.
5. Whether use of the Sign has taken unfair advantage of the distinctive character or the repute of the Trade Mark.
6. Whether such use was without due cause.

Passing Off

7. Whether the claimant owns goodwill in its business associated in the mind of the public with the Trade Mark.

8. Whether the defendant has misrepresented that its goods are connected in the course of trade with the claimant's business.
9. If so, whether such misrepresentation has caused the claimant damage.

Annex C – Guidelines on bundles

General

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 in the case of a trial bundle and the applicant in the case of other hearings 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 contents 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 may 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. Alternatively, each file may be paginated continuously from the first to the last page. One or other of these modes of pagination must be used for the trial bundle. It is not necessary for other hearings.
8. These page numbers should be inserted in a form, such as a colour or bold format, 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.