

The Rules of the Supreme Court (Amendment No. 3) 1995

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1995 No. 3316 (L.20)

SUPREME COURT OF ENGLAND AND WALES

The Rules of the Supreme Court (Amendment No. 3) 1995

Made 20th December 1995

Laid before Parliament 21st December 1995

Coming into force 15th January 1996

We, the Supreme Court Rule Committee, having power under section 85 of the Supreme Court Act 1981 to make rules of court under section 84 of that Act for the purpose of regulating and prescribing the practice and procedure to be followed in the Supreme Court, hereby exercise those powers as follows—

Citation, commencement and interpretation ➔

1.—

1. These Rules may be cited as the Rules of the Supreme Court (Amendment No. 3) 1995 and shall come into force on 15th January 1996.
2. In these Rules, an Order referred to by number means the Order so numbered in the Rules of the Supreme Court 1965 and a reference to Appendix B is a reference to Appendix B to those Rules.

Trade Marks and patents ➔

2. The Arrangement of Orders at the beginning of the Rules of the Supreme Court 1965 shall be amended, by substituting for the title to Order 100, the following "The Trade Marks Act 1938, as amended by the Trade Marks (Amendment) Act 1984 and the Patents, Designs and Marks Act 1986; the Trade Marks Act 1994; and the Olympic Symbol etc. (Protection) Act 1995".

3. For Order 100, there shall be substituted the following—

"ORDER 100

THE TRADE MARKS ACT 1938, AS AMENDED BY THE TRADE MARKS (AMENDMENT) ACT 1984 AND THE PATENTS, DESIGNS AND MARKS ACT 1986; THE TRADE MARKS ACT 1994; AND THE OLYMPIC SYMBOL ETC. (PROTECTION) ACT 1995.

Definitions

1. In this Order—

"the 1938 Act" means the Trade Marks Act 1938 as amended by the Trade Marks (Amendment) Act 1984 and the Patents, Designs and Marks Act 1986;

"the 1994 Act" means the Trade Marks Act 1994;

"the Olympic Symbol Act" means the Olympic Symbol etc. (Protection) Act 1995;

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

"the register" means the register of trade marks maintained by the Registrar pursuant to section 63 of the 1994 Act;

"appointed person" means a person appointed by the Lord Chancellor to hear and decide appeals under the 1994 Act.

Assignment to the Chancery Division

2. Proceedings in the High Court under the 1938 Act, the 1994 Act or the Olympic Symbol Act shall be assigned to the Chancery Division.

Appeals and applications under the 1938 Act, the 1994 Act and the Olympic Symbol Act

3.—

1. Every appeal to the High Court under the 1938 Act or the 1994 Act shall be heard and determined by a single judge.
2. Subject to paragraph (7) below and to rule 4, every application to the High Court under the said Acts must be begun by originating motion.
3. Notice of the motion by which any such application is made under the 1938 Act or the 1994 Act must be served on the Registrar.
4. Where—
 - a. the Registrar refers to the High Court an application made to him under the 1938 Act or the 1994 Act;
 - b. the Board of Trade under the 1938 Act or an appointed person under section 76 of the 1994 Act refers to that Court an appeal,

then unless within one month after receiving notification of the decision to refer, the applicant or the appellant, as the case may be, makes to that Court the application or appeal referred, he shall be deemed to have abandoned it.

5. The period prescribed by Order 55, rule 4(2), in relation to an appeal to which paragraph (1) applies or the period prescribed by paragraph (4) in relation to an application or appeal to which that paragraph applies, may be extended by the Registrar on the application of any party interested and may be so extended although the application is not made until after the expiration of that period, but the foregoing provision shall not be taken to affect the power of the Court under Order 3, rule 5, to extend that period.
6. Where under subsection (6) of section 17 or subsection (9) of section 18 of the 1938 Act an appellant becomes entitled and intends to withdraw his application which is the subject-matter of the appeal, he must give notice of his intention to the Registrar and to any other party to the appeal within one month after the Court has given leave under the said subsection (6) or the said subsection (9) as the case may be, for further grounds of objection to be taken.
7. An application under section 16 or section 19 of the 1994 Act shall be made by originating summons or, if it is made in a pending action, by summons or motion in that action.
8. Where an application is made under section 19 of the 1994 Act the applicant shall serve notice of the application on all persons so far as reasonably ascertainable having an interest in the goods, material or articles which are the subject of the application, including any person in whose favour an order could be made in respect of the goods, material or articles under the said section of the 1994 Act or under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988.

Proceedings for infringement of registered trade mark; validity of registration disputed or revocation or rectification sought

4.—

1. Where in any proceedings a claim is made for relief for infringement of the rights conferred on the proprietor of a registered trade mark by section 9 of the 1994 Act, the party against whom the claim is made may in his defence put in issue the validity of the registration of that trade mark or may counterclaim for an order for revocation of the registration or for a declaration of invalidity of the registration or for rectification of the register, or may do any or all of those things.
2. A party to any such proceedings who in his pleading (whether a defence or counterclaim) disputes the validity of the registration of a registered trade mark or seeks a declaration of invalidity or an order for revocation of the registration, or rectification of the register, must serve with his pleading particulars of the objections to the validity of the registration or of any grounds for revocation or rectification, on which he relies.
3. A party to any such proceedings who counterclaims for an order for revocation of the registration or for a declaration of invalidity of the registration or for rectification of the register must serve on the Registrar a copy of the counterclaim together with a copy of the particulars mentioned in paragraph (2) and the Registrar shall be entitled to take

such part in the proceedings as he may think fit but need not serve a defence or other pleading unless ordered to do so by the Court.

Service of documents

5.—

1. This rule applies to the service of any document (including originating process) on a party until such time as that party has provided an address for service within the meaning of Order 6, rule 5(2) or Order 12, rule 3.
2. Subject to paragraph (3), for the purposes of any proceedings relating to a registered trade mark (including proceedings for revocation, declaration of invalidity or non-infringement or groundless threats of infringement proceedings or any other proceedings under the 1938 Act or the 1994 Act), where any document is served in the manner prescribed by Order 10 or Order 65 at an address for service given in the register kept under section 63 of the 1994 Act—
 - a. service shall be deemed to have been effected on the registered proprietor of the trade mark on the date on which the document was served at the said address;
 - b. the party on whom service is deemed to have been effected under sub-paragraph (a), shall be treated, for the purposes of any provision of these rules which specifies a time-limit for responding to the document so served (whether by acknowledging service, giving notice of intention to defend or otherwise), as having been served on the seventh day after the date on which the document was served at the said address.
3. Nothing in this rule shall prevent service being effected on the proprietor in accordance with the provisions of these rules.

Service of orders on the Registrar

6. Where an order is made by the Court in any case under the 1938 Act or the 1994 Act, the person in whose favour the order is made or, if there is more than one, such one of them as the Court shall direct, shall serve an office copy of the order on the Registrar.

4. For the definition of "patent" in Order 104, rule 1, there shall be substituted the following—

"patent" means an existing patent or a 1977 Act patent and includes any supplementary protection certificate granted pursuant to the Patents (Supplementary Protection Certificate for Medicinal Products) Rules 1992 and the Patents (Supplementary Protection Certificate for Medicinal Products) Regulations 1992." .

5. Order 104, rule 19 shall be amended—

1. by substituting in paragraph (6) for "5 days", "21 days";
- 2.

by substituting for paragraph (7) the following—

" (7) After receiving notice of appeal the comptroller shall lodge in Chancery Chambers all papers relating to the matter which is subject of the appeal." .

6. Order 104, rule 21(1)(a) shall be amended by inserting, after sub-paragraph (a)(iii), the following—

"(iv) section 251 of the Copyright, Designs and Patents Act 1988;" .

7. After Order 104, rule 23, there shall be inserted the following new rule—

"Service of documents

24.—

1. This rule applies to the service of any document (including originating process) on a party until such time as that party has provided an address for service within the meaning of Order 6, rule 5(2) or Order 12, rule 3.
2. Subject to paragraph (3), for the purposes of any proceedings relating to a patent or a registered design (including proceedings for revocation, declaration as to non-infringement or groundless threats of infringement proceedings or any other proceedings of a kind mentioned in this Order) where any document is served in the manner prescribed by Order 10 or Order 65 at an address for service given in the register kept under section 32 of the 1977 Act or, as the case may be, section 17 of the Registered Designs Act 1949—
 - a. service shall be deemed to have been effected on the registered proprietor of the patent or registered design on the date on which the document was served at the said address;
 - b. the party on whom service is deemed to have been effected under sub-paragraph (a) shall be treated, for the purposes of any provision of these rules which specifies a time-limit for responding to the document so served (whether by acknowledging service, giving notice of intention to defend or otherwise), as having been served on the seventh day after the date on which the document was served at the said address.
3. Nothing in paragraph (2) shall prevent service being effected on the proprietor in accordance with the provisions of these rules." .

Admiralty proceedings ➔

8. After Order 75, rule 14 there shall be inserted the following new rule—

"Filing of praecipe for caveat against release when Registry is closed

14A.—

1. When the Admiralty and Commercial Registry (in this rule referred to as "the Registry") is closed to the public, a praecipe for caveat against release may be filed in the Registry in accordance with the provisions of this rule.
 2. A praecipe under this rule must:
 - a. be signed by a solicitor acting on behalf of the intending caveator; and
 - b. be in Form 9 in Appendix B and addressed to the Registry.
 3. A solicitor causing a praecipe to be filed under this rule (in this rule referred to as "the filing solicitor") shall transmit a copy of the praecipe to the Registry by FAX for filing under this rule on the fax number designated for such purpose.
 4. Subject to paragraph (7) of this rule, the filing of a praecipe under this rule takes place when the FAX transmitted under paragraph (3) is recorded at the Registry as having been received and the praecipe so filed shall have the same effect for all purposes as a praecipe filed under rule 14 of this Order.
 5. When the Registry is next open to the public after the filing of a praecipe in accordance with this rule—
 1. the filing solicitor or his agent shall attend and deliver to the Registry—
 - i. the document which was transmitted by FAX;
 - ii. the transmission report.
 2. upon receipt of the document and transmission report under sub-paragraph (a) and upon satisfying himself that the document delivered fully accords with the document received by the Registry under paragraph (3), the proper officer shall stamp the document delivered with the time and date when the praecipe was received under paragraph (4), enter the same in the caveat book and retain the same with the faxed copy.
 6. Unless otherwise ordered by the Court, the stamped praecipe retained by the Court shall be conclusive proof that the praecipe was filed at the time and on the date stated.
 7. Notwithstanding Order 2, rule 1, if the filing solicitor does not comply with the provisions of paragraphs (2) and (5)(a), or if the document delivered under paragraph (5)(a)(i) is not stamped under paragraph (5)(b), the praecipe shall be deemed never to have been filed." .
9. For Order 75, rule 38, there shall be substituted the following rule—

"Summons for decree or directions in limitation action

38.—

1. The plaintiff must—
 - a. within 7 days after the acknowledgement of issue or service of the writ by one of the defendants identified by his name or,
 - b. if none of the defendants acknowledges issue or service, within 7 days after the time limited for acknowledging service,

and without serving a statement of claim, take out a summons returnable in chambers before the Admiralty registrar or district judge, as the case may be, asking for a decree limiting his liability or, in default of such a decree, for directions as to the future proceedings in the action.

2. The summons must be supported by affidavit verifying—
 - a. the plaintiff's case in the action and
 - b. if no defendant identified in the writ by his name has acknowledged service, service of the writ on at least one of the defendants so identified.
3. The affidavit referred to in paragraph (2) above shall state—
 - a. the names of all the persons who, to the knowledge of the plaintiff, have claims against him in respect of the casualty to which the action relates, not being defendants to the action who are identified in the writ by their names, and
 - b. the address of each of those persons if known to the plaintiff.
4. The summons and every affidavit in support thereof must be served on every defendant who has acknowledged issue or service of the writ at least 28 clear days before the hearing of the summons.
5. Any defendant who disputes the plaintiff's claim to limit his liability or alleges that he is unable to decide whether to dispute that claim shall, within 14 days of the service upon him of the summons and any affidavit in support, serve upon the plaintiff an affidavit stating the grounds upon which he relies to dispute the plaintiff's claim to limit his liability or such facts and matters as could justify the Court in giving a direction under paragraph (8) of this rule.
6. The plaintiff may, within 7 days of service upon him of any affidavit under paragraph (5), serve such further affidavit evidence as he may wish upon any defendant who has served an affidavit under paragraph (5) of this rule.
7. If on the hearing of the summons it appears to the Admiralty registrar or district judge that the plaintiff's claim to limit his liability is not disputed, he shall make a decree limiting the plaintiff's liability and declaring the amount thereof.
8. If on the hearing of the summons it appears to the Admiralty registrar or district judge that any defendant has not sufficient information to enable him to decide whether to

dispute the plaintiff's claim to limit his liability, he may, on such terms as seem just, give such directions as appear to him appropriate to enable the defendant to obtain such information and shall adjourn the hearing.

9. Any defendant who thereafter disputes the plaintiff's claim to limit his liability shall state on affidavit the grounds upon which he relies and such affidavit must be served on the plaintiff at least 10 clear days before the resumed hearing of the summons.
10. If on the hearing or the resumed hearing of the summons, the Admiralty registrar or district judge does not make a decree limiting the plaintiff's liability, he shall give such directions as to the further proceedings in the action as appear to him to be appropriate including, in particular, a direction requiring the taking out of a summons for directions under Order 25 and, if he gives no such direction, a direction fixing the period within which any notice under Order 38, rule 21, must be served.
11. Any defendant who, after the Admiralty registrar or district judge has given directions under paragraph (8) or (10), ceases to dispute the plaintiff's right to limit his liability must forthwith file a notice to that effect in the Registry or district registry and serve a copy on the plaintiff and on any other defendant who has acknowledged issue or service of the writ.
12. If every defendant who disputes the plaintiff's right to limit his liability serves a notice on the plaintiff under paragraph (11), the plaintiff may take out a summons returnable in chambers before the Admiralty registrar or district judge asking for a decree limiting his liability; and paragraphs (4) and (7) shall apply to a summons under this paragraph as they apply to a summons under paragraph (1)." .

Enforcement of Northern Ireland Confiscation Orders ➡

10. Order 115, rules 1(2) and 22(2) shall be amended, by inserting at the end of each paragraph, the words "and include any extended meaning given by the Criminal Justice (Confiscation) (Northern Ireland) Order 1990".

Proceeds of Crime Act 1995 ➡

11. Order 115, rule 23 shall be amended by inserting at the end the following:

- e. "rule 8 shall have effect as if the following paragraph were added at the end—

" (6) Where a receiver applies for the variation of a confiscation order, the application shall be made by summons, which shall be served, with any supporting evidence, on the defendant and any other person who may be affected by the making of an order under section 83 of the 1988 Act, not less than 7 days before the date fixed for the hearing of the summons." ;
- f. rule 11 shall apply with the necessary modifications where an application is made under section 93J of the 1988 Act for disclosure of information held by government departments." .

Mackay of Clashfern, C.

Bingham, M. R.,

Stephen Brown, P.,

Rattee, J.,

Bell, J.,

Colman, J.

Dated 20th December 1995

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the Rules of the Supreme Court so as—

- a. to substitute a new Order 100 (making provision for proceedings under the Trade Marks Act 1994, the Olympic Symbol etc. (Protection) Act 1995 and for the service of documents) and to make miscellaneous amendments to Order 104 (proceedings relating to patents) including provision for the service of documents (rules 2 to 7);
- b. in Admiralty proceedings to provide for a praecipe for caveat against release to be filed when the Admiralty Registry is closed and to make fresh provision for limitation actions (rules 8 and 9);
- c. to extend the provisions of Order 115 to apply to the enforcement of Northern Ireland confiscation orders and to make amendments to that Order which are consequential upon the provisions of the Proceeds of Crime Act 1995 (rules 10 and 11).