

1956/183

THE PATENTS RULES 1956

C. W. M. NORRIE, Governor-General

ORDER IN COUNCIL

At the Government Buildings at Wellington this 29th day of October 1956

Present:

THE RIGHT HON. S. G. HOLLAND PRESIDING IN COUNCIL

PURSUANT to the Patents Act 1953, His Excellency the Governor-General, acting by and with the advice and consent of the Executive Council, and with the concurrence of the Right Honourable the Chief Justice and six other members of the Rules Committee constituted under the Judicature Amendment Act 1930 (two of such other members being Judges of the Supreme Court), hereby makes the following rules.

RULES

1. (1) These rules may be cited as the Patents Rules 1956.
 (2) These rules shall come into force on the fourteenth day after the date of their notification in the *Gazette*.
2. In these rules, unless the context otherwise requires,—
 - “The Act” means the Patents Act 1953;
 - “Commissioner” means the Commissioner of Patents;
 - “Court” means the Supreme Court;
 - “Journal” means the *Patent Office Journal*.

Application of Rules of Supreme Court

3. The rules of the Supreme Court for the time being in force shall apply to all proceedings before the Court or a Judge under the Act, except as otherwise provided by these rules.
4. Unless otherwise expressly provided, all proceedings before the Court or a Judge under the Act shall be by way of motion.

Appointment of Scientific Advisers

5. In any proceedings under the Act or any proceedings for infringement of a patent the Court or a Judge may at any time, and whether or not an application has been made by any party for that purpose,

appoint an independent scientific adviser to assist the Court or to inquire and report upon any questions of fact or opinion not involving questions of law or construction:

Provided that, if all the parties to the proceedings so request, the Court or a Judge shall appoint a scientific adviser as aforesaid.

6. The Court or the Judge shall nominate the scientific adviser and shall settle the questions or instructions to be submitted or given to him.

7. The remuneration of the scientific adviser shall be fixed by the Court or a Judge, and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may be required to attend before the Court.

Application for Extension of Term of Patent

8. (1) A person applying to the Court for an extension of the term of a patent under section 31, section 32, or section 33 of the Act shall file in the office of the Court at Wellington (unless the Court or a Judge otherwise directs), a motion—

- (a) Specifying the substantive relief which he seeks:
- (b) Stating precisely the grounds on which the relief is sought or referring to the grounds appearing in an affidavit sworn by a person whose name is stated in the motion:
- (c) Applying to the Court or a Judge for—
 - (i) Directions as to the earliest date on which the motion so far as it relates to substantive relief may be set down for its main hearing; and
 - (ii) Any special directions which may be sought as to the mode in which evidence may be given and other matters.

(2) The applicant shall file with the motion a copy of the specification and drawings of the patent and shall also, when filing the motion or not later than twenty-one days before the date appointed for the hearing of the motion for directions, file—

- (a) An affidavit stating all material facts on which the applicant relies:
- (b) A copy of the receipts and payments account relating to the patent, which copy shall be verified by either the last mentioned affidavit or a separate affidavit.

(3) Nothing in this rule shall prevent the Court or a Judge from making an order on grounds or facts other than those stated or referred to in the motion and affidavits if it seems expedient to do so.

9. (1) As soon as possible after filing the motion, the applicant shall cause an advertisement in accordance with subclause (2) of this rule to be published once in the *Journal* and once in a daily newspaper published at each of the following cities—namely, Auckland, Wellington, Christchurch, and Dunedin.

- (2) The advertisement shall—
 - (a) State the nature of the application:
 - (b) State that the application for directions will be heard on a day and at a time to be appointed, which day shall not be earlier than thirty clear days after the date of the last publication of the advertisement:
 - (c) Have at the foot thereof the name of the applicant and of his solicitor, if any, and the applicant's address for service:
 - (d) Contain a statement as to the effect of rule 11 hereof.

10. Forthwith after filing any document (other than the specifications and drawings) the applicant shall serve on the Commissioner a copy of that document.

11. (1) Any person (other than the applicant) who intends to appear at the hearing to oppose or support the application or to claim the inclusion therein of any restrictions or conditions or provisions shall,—

- (a) Not later than seven clear days before the date appointed for the hearing of the application for directions, file notice of his intention to do so in the office of the Court in which the motion has been filed and serve a copy thereof on the applicant or his solicitor and on the Commissioner:
- (b) If he intends to oppose the application or to claim the inclusion therein of any restrictions or conditions or provisions, not later than seven clear days before the date appointed for hearing the application for directions, file in the office of the Court in which the motion has been filed particulars of his objection or claim, and serve a copy thereof on the applicant or his solicitor and on the Commissioner.

(2) Every notice of intention to appear filed by any person under this rule shall have at the foot thereof the person's address for service within New Zealand.

(3) Any person who fails to comply with the provisions of subclause (1) of this rule shall be deemed to have abandoned his opposition, support, or claim.

(4) Except by leave of the Court, which may be granted on such terms as may be just, no person shall be heard or adduce evidence in support of any objection or claim as regards any matters not specified in the particulars filed by him as aforesaid.

12. (1) The applicant shall, upon the request and at the expense of any person who has served notice of intention to appear, supply that person with a copy of the motion and receipts and payments account, and of any affidavit, filed in the Court as aforesaid.

(2) The applicant shall, upon request by the Commissioner, give him or any person appointed by him reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the receipts and payments account or from which the materials for making up that account have been derived.

13. If the Commissioner elects to appear on the hearing he shall, not later than seven clear days before the date appointed for the main hearing, lodge notice of his election in the Court, and serve a copy on the applicant and on any other person who has given notice of his intention to appear at the hearing.

14. If the Commissioner elects or is directed to appear on the hearing of the application he shall, not later than seven clear days before the day appointed for the main hearing, file particulars of any objection he intends to make.

15. Before the date appointed for hearing the application for directions, the applicant shall file in the Court an affidavit to prove that a sufficient advertisement has been published in accordance with rule 9 hereof.

16. If the Court refuses the application for substantive relief it shall not, except under special circumstances, award more than one set of costs among all the opponents.

17. (1) Where the Commissioner decides to refer to the Court an application made to him under section 31, section 32, or section 33 of the Act, he shall give notice of his decision in writing to the applicant and to any person who has supported the application and to any opponent.

(2) The applicant shall, within twenty-eight days after the date of the receipt of the notice, file a motion setting out the relief which he seeks, and shall serve a copy of the motion on the Commissioner and on any person who has supported the application and on any opponent.

(3) The Commissioner shall, within fourteen days after the date of the service of the motion upon him, send his file of proceedings to the Registrar of the Court.

(4) If the applicant fails to file a motion or to withdraw the application within the said twenty-eight days, the Commissioner may, after giving seven clear days' further notice to the parties, prepare and file a statement of case referring the application for decision by the Court, which may award costs against the applicant if he fails to proceed on the application.

Application for Amendment of Specification

18. Where application is made by a patentee for leave to amend his specification under section 39 of the Act, the following provisions shall apply:

- (a) The applicant shall give notice of his intention to the Commissioner accompanied by a copy of a suitable advertisement of the proposed amendment, and the Commissioner shall insert the advertisement once in the *Journal*:
- (b) The advertisement shall give particulars of the amendments sought and of the applicant's address for service within New Zealand, and shall state that any person desiring to oppose the amendment must, within fourteen days after the date of the actual issue of the *Journal* in which the advertisement is published, give notice in writing of his desire to the applicant at that address:
- (c) Any person giving any such notice shall be entitled to be heard upon the application, subject to any direction of the Court as to costs:
- (d) The applicant shall, as soon as may be after the expiration of twenty-one days after the date of the actual issue of the *Journal* in which the advertisement is published, proceed by way of motion in the proceedings pending before the Court; and notice of the motion, together with a copy of the specification certified by the Commissioner showing in a distinguishing ink or type the amendment proposed to be made, shall be served on the Commissioner, the parties to the proceedings, and such persons, if any, as shall have given notice of intention to oppose:
- (e) On the hearing of the motion the Court shall decide whether, and on what terms as to costs or otherwise, the application shall be allowed to proceed, and shall direct whether the application shall be heard on oral or affidavit evidence, and, if on affidavit evidence, shall fix the times within which affidavits shall be filed by the parties and by any other person entitled to be heard under the Act or these rules:

- (f) Where the Court allows a specification to be amended, the applicant shall forthwith lodge with the Commissioner an office copy of the order allowing the amendment, and the Commissioner shall advertise the same once in the *Journal* and otherwise as the Court may direct:
- (g) The applicant shall also, if so required by the Court or by the Commissioner, leave at the Patent Office a new specification and drawings as amended which shall be prepared as far as may be in accordance with the Patents Regulations 1954.

Respondent in Revocation Proceedings to Begin

19. The respondent to an application for the revocation of a patent under section 41 of the Act shall be entitled to begin and give evidence in support of the patent, and if the applicant gives evidence impeaching the validity of the patent, the respondent shall be entitled to the reply.

Particulars of Objections Where Validity of Patent Disputed

20. Particulars of objections as to the validity of a patent shall be delivered with an application for revocation under section 41 of the Act, or with the defence in an action for infringement of a patent, or with a counterclaim for revocation under section 70 of the Act, and shall state every ground upon which the validity of the patent is disputed, and shall include such particulars as will clearly define every issue which it is intended to raise.

Particulars Where Want of Novelty Alleged

21. (1) If one of the objections taken in the particulars of objections as to the validity of a patent is want of novelty, the particulars shall state the time and place of the previous knowledge, publication, or user alleged.

(2) If it is alleged that the invention has been used prior to the date of the patent, the particulars shall also—

- (a) Specify the name and address of the person who is alleged to have made the prior user and the place of the prior user; and
- (b) Specify whether the prior user is alleged to have continued down to the date of the patent, and, if not, the earliest and latest dates on which the prior user is alleged to have taken place; and
- (c) Contain a description (accompanied by drawings, if necessary) sufficient to identify the alleged prior user; and
- (d) If the user relates to any machinery or apparatus, specify whether it is in existence and where it can be inspected.

(3) No evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent and which is in existence at the date of the delivery of the particulars shall be receivable unless it is proved that the party relying on the prior user has (if the machinery or apparatus is in his own possession) offered inspection of it, or (if it is not in his own possession) has used his best endeavours to obtain the inspection of it for the other parties to the proceedings.

Particulars in Infringement Actions

22. In an action for infringement of a patent the plaintiff shall deliver with his statement of claim particulars of the breaches relied upon, and shall specify which of the claims in the specification of the patent sued upon are alleged to be infringed, and shall give at least one instance of each type of infringement of which complaint is made.

23. If a defendant in an action for infringement of a patent intends to rely, as a defence to the action, on the insertion by the patentee in any contract or contracts of any condition which is void by virtue of section 66 of the Act, he shall deliver with his defence full particulars of the dates of, and parties to, all contracts on which he intends to rely as containing any such condition, and of the particular conditions on which he intends to rely as being void by virtue of that section. A defendant shall not be entitled to rely on a defence available to him under subsection (2) of the said section 66 of which particulars have not yet been delivered in accordance with the provisions of this rule.

Evidence Restricted to Particulars Delivered

24. Except by leave of the Court, which may be granted on such terms as may seem just, no person shall be heard or adduce evidence in support of any alleged infringement or objection or defence as regards any matters which are not specified in or are at variance with the particulars he has delivered.

Amendment of Particulars

25. (1) Particulars filed in the Court under these rules may from time to time be amended by leave of the Court or a Judge upon such terms as may be just.

(2) Further and better particulars may at any time be ordered by the Court or a Judge.

Appeals

26. (1) Notice of any appeal to the Court from any decision of the Commissioner shall, within twenty-eight days after the day on which the decision appealed against was given, be filed in the Court and served by the appellant on the Commissioner and on every other party to the proceedings before the Commissioner.

(2) The notice shall state the nature of the decision appealed against, and whether the appeal is from the whole or part only, and, if so, what part of the decision. It shall also state concisely the grounds of the appeal.

(3) Except with the leave of the Court, which may be granted on such terms as may be just, no grounds other than those so stated shall be allowed to be taken by the appellant at the hearing.

Costs

27. The costs as between party and party in proceedings in the Court relating to patents, including in such cases the costs of prior proceedings before the Commissioner, shall be governed by the scale of costs in force with regard to actions, but in fixing the sum to which the scale is to be

applied regard may be had not merely to the sum or value at issue, but also to the complexity of the matters and the nature of the work involved in the trial and in preparing for the trial:

Provided that where the proceedings go to trial no costs shall be allowed to the parties delivering any particulars of breaches or particulars of objection in respect of any issues raised in those particulars and relating to that patent except so far as the issues or particulars are certified by the Court to have been proved or to have been reasonable and proper.

Non-compliance with Rules

28. Non-compliance with any of these rules shall not render the proceedings in which the non-compliance has occurred void; but the proceedings may be set aside, either wholly or in part, as irregular, or amended or otherwise dealt with in such manner and on such terms as the Court, on any motion taken out with reference to the non-compliance, may deem just.

Revocations

29. The Rules of the Supreme Court (Patents and Designs)* are hereby revoked.

T. J. SHERRARD,
Clerk of the Executive Council.

**Gazette*, 1923, Vol. II, p. 2241

EXPLANATORY NOTE

This note is not part of the rules, but is intended to indicate their general effect.

These rules replace the existing rules relating to patent actions in the Supreme Court. The revision of the rules is consequential on the passing of the Patents Act 1953.

Issued under the authority of the Regulations Act 1936.

Date of notification in *Gazette*: 1 November 1956.

These regulations are administered in the Department of Justice.