



THE HIGH COURT AMENDMENT RULES (NO. 2) 1990

THOMAS EICHELBAUM,
Administrator of the Government

ORDER IN COUNCIL

At Wellington this 6th day of August 1990

Present:

THE RIGHT HON. G. W. R. PALMER PRESIDING IN COUNCIL

PURSUANT to sections 51c and 51D of the Judicature Act 1908 and section 113 of the Patents Act 1953, His Excellency the Administrator of the Government, acting by and with the advice and consent of the Executive Council, and with the concurrence of the Right Honourable the Chief Justice and at least two of the other members of the Rules Committee (of whom at least one was a Judge of the High Court), hereby makes the following rules.

ANALYSIS

1. Title and commencement
2. Application of Part IVA
3. New Part XI_A inserted

PART XI_A

PATENTS

725A. Interpretation

Scientific Advisers

725B. Appointment of scientific advisers

725C. Nomination of scientific adviser and settlement of questions and instructions

725D. Reports of scientific adviser

725E. Cross-examination of scientific adviser

725F. Experiment or test

725G. Further or supplemental report

725H. Remuneration of scientific adviser

Extension of Term of Patent

725I. Application for extension of term of patent

- 725j. Application for directions
 725k. Copy of specifications and drawing
 725l. Affidavit concerning material facts
 725m. Grounds and facts
 725n. Advertisement
 725o. Service on Commissioner
 725p. Notice of opposition and notice of intention to appear
 725q. Obligation of applicant to supply copy of originating application, etc.
 725r. Obligation of applicant to comply with request of Commissioner
 725s. Notice of Commissioner's election to appear
 725t. Particulars of Commissioner's objection
 725u. Affidavit proving publication of advertisement
 725v. Costs
 725w. Reference to Court of application made to Commissioner
- Amendment of Specification with Leave of Court*
- 725x. Application for amendment of specification
 725y. Notice of intention to make application for amendment of specification
 725z. Advertisement
 725za. Right to be heard
 725zb. Time for making of application
 725zc. Service of notice of interlocutory application
 725zd. Duty of Court to give directions
 725ze. Procedure where amendment to specification allowed
- Revocation of Patents*
- 725zf. Application to Court for revocation of patent

- 725zg. Respondent in revocation proceedings to begin

Objections

- 725zh. Particulars of objections where validity of patent disputed
 725zi. Particulars where want of novelty alleged
 725zj. Service of notice on Solicitor-General

Particulars in Proceeding for Infringement of Patent

- 725zk. Particulars to be supplied by plaintiff
 725zl. Particulars to be supplied by defendant
 725zm. Evidence restricted to particulars delivered
 725zn. Amendment of particulars

Appeals

- 725zo. Mode of bringing appeal
 725zp. Time for appeal
 725zq. Contents of notice of appeal
 725zr. Grounds of appeal
 725zs. Service of notice of appeal
 725zt. Obligation of Commissioner to transmit papers to Court
 725zu. Contentions that may be raised by respondent
 725zv. Respondent's notice
 725zw. Appeal to be by way of rehearing
 725zx. Proceedings to be heard and determined in public
 725zy. Documentary evidence
 725zz. Cross-examination of witnesses
 725zza. Application of Part X

Costs

- 725zzb. Costs

4. Revocations
 5. Transitional provision
 6. Saving

RULES

1. Title and commencement—(1) These rules may be cited as the High Court Amendment Rules (No. 2) 1990, and shall be read together with and deemed part of the High Court Rules from time to time set out in the Second Schedule to the Judicature Act 1908 (hereinafter referred to as the High Court Rules).

(2) These rules shall come into force on the 1st day of October 1990.

2. Application of Part IVA—Rule 458D (as inserted by rule 12 of the High Court Amendment Rules (No. 2) 1987) is hereby amended by inserting, after subclause (1), the following subclause:

“(1A) Subject to Part XIA, this Part applies to any application to the Court under section 31 or section 32 or section 33 or section 41 of the Patents Act 1953.”

3. New Part XIA inserted—The High Court Rules are hereby amended by inserting, after Part XI, the following Part:

“PART XIA

“PATENTS

“725A. **Interpretation**—In this Part, unless the context otherwise requires,—

“‘Commissioner’ means the Commissioner of Patents:

“‘Journal’ means the *Patent Office Journal*:

“‘Report’ means a report by a scientific adviser:

“‘Respondent’s notice’ means a notice given under rule 725ZU:

“‘Scientific adviser’ includes—

“(a) A person with scientific qualifications; and

“(b) A medical practitioner; and

“(c) An engineer; and

“(d) An architect; and

“(e) A surveyor; and

“(f) An accountant; and

“(g) An actuary; and

“(h) Any other specially skilled person whose opinion in relation to any matter may be of assistance to the Court.

Cf. S.R. 1956/183, r. 2; S.R. 1976/116, r. 2

“*Scientific Advisers*

“725B. **Appointment of scientific advisers**—In any proceeding under the Patents Act 1953 or any proceeding for infringement of a patent, the Court 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 proceeding so request, the Court shall appoint a scientific adviser as aforesaid.

Cf. S.R. 1956/183, r. 5

“725C. **Nomination of scientific adviser and settlement of questions and instructions**—The Court shall nominate the scientific adviser and shall settle the questions or instructions to be submitted or given to the scientific adviser.

Cf. S.R. 1956/183, r. 6

“725D. **Reports of scientific adviser**—(1) Where, under rule 725B or rule 725C, the Court has appointed or nominated an independent scientific adviser, any report made by that scientific adviser, so far as it is not accepted by all parties to the proceeding,—

“(a) Shall be treated as information furnished to the Court; and

“(b) Shall be given such weight as the Court may think fit.

“(2) All reports by any such independent scientific adviser—

“(a) Shall be made in writing to the Court; and

“(b) Shall be accompanied by such copies thereof as the Court may require.

“(3) Copies of the report shall be forwarded by the Court to the parties to the proceeding.

Cf. S.R. 1956/183, r. 6A (1), (2); S.R. 1976/116, r. 3.

“725E. **Cross-examination of scientific adviser**—(1) Any party may, within 14 days of receiving a copy of the report, or within such other time as the Court may direct, apply for leave to cross-examine the scientific adviser on his or her report.

“(2) The Court may, on an application under subclause (1), make an order for the cross-examination of the scientific adviser at the hearing of the proceeding.

“(3) The Court shall, at the hearing, direct at what stage the scientific adviser is to be called.

Cf. S.R. 1953/183, r. 6A (3); S.R. 1976/116, r. 3

“725F. **Experiment or test**—(1) If the scientific adviser considers that an experiment or test (other than one of a trifling character) is necessary to enable the scientific adviser to report in a satisfactory manner, the scientific adviser—

“(a) Shall inform the parties; and

“(b) Shall endeavour to agree with the parties as to—

“(i) The expenses involved; and

“(ii) The persons to attend the experiment or test.

“(2) In default of agreement between the parties, all such matters shall be determined by the Court.

Cf. S.R. 1956/183, r. 6A (4); S.R. 1976/116, r. 3

“725G. **Further or supplemental report**—The Court may at any time direct the scientific adviser to make a further or supplemental report, and the provisions of rules 725D and 725E shall apply to any such report as they apply to an original report.

Cf. S.R. 1956/183, r. 6A (5); S.R. 1976/116, r. 3

“725H. **Remuneration of scientific adviser**—The remuneration of the scientific adviser shall be fixed by the Court, 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.

Cf. S.R. 1953/183, r. 7

“Extension of Term of Patent

“725I. **Application for extension of term of patent**—(1) Every application to the Court under section 31 or section 32 or section 33 of the Patents Act 1953 shall be made by way of an originating application.

“(2) The originating application shall be filed in the office of the Court at Wellington (unless the Court otherwise directs).

Cf. S.R. 1956/183, r. 8 (1)

“725J. **Application for directions**—The applicant shall file with the originating application an interlocutory application under rule 458i for directions regarding the proceeding commenced by the filing of the originating application.

Cf. S.R. 1956/183, r. 8 (1) (c)

“725K. Copy of specifications and drawing—The applicant shall file with the originating application a copy of the specifications and drawings of the patent.

Cf. S.R. 1956/183, r. 8 (2)

“725L. Affidavit concerning material facts—The applicant shall, when filing the originating application or not later than 21 days before the date appointed for the hearing of the interlocutory application for directions, file an affidavit stating all material facts on which the applicant relies.

Cf. S.R. 1956/183, r. 8 (2)

“725M. Grounds and facts—Nothing in rules 725I to 725L shall prevent the Court from making an order on grounds or facts other than those stated or referred to in the originating application and affidavit if the Court considers it expedient to do so.

Cf. S.R. 1956/183, r. 8 (3)

“725N. Advertisement—(1) As soon as possible after filing the originating application, the applicant shall cause an advertisement in accordance with subclause (2) 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 30 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 the applicant’s solicitor, if any, and the applicant’s address for service:

“(d) Contain a statement as to the effect of rule 725P.

Cf. S.R. 1956/183, r. 9

“725O. Service on Commissioner—Forthwith after filing any document (other than the specifications and drawings) the applicant shall serve on the Commissioner a copy of that document.

Cf. S.R. 1956/183, r. 10

“725P. Notice of opposition and notice of intention to appear—(1) Any person (other than the applicant) who intends to appear at the hearing to oppose or support the originating application or to claim the inclusion therein of any restrictions or conditions or provisions shall,—

“(a) Not later than 7 clear days before the date appointed for the hearing of the interlocutory application for directions,—

“(i) File a notice of opposition or a notice of intention to appear, as the case may require, in the office of the Court in which the originating application has been filed; and

“(ii) Serve a copy of the notice of opposition or notice of intention to appear on the applicant or the applicant’s solicitor and on the Commissioner:

“(b) If the person intends to oppose the application or to claim the inclusion therein of any restrictions or conditions or provisions, not later than 7 clear days before the date appointed for the hearing of the interlocutory application for directions,—

“(i) File in the office of the Court in which the originating application has been filed particulars of the applicant’s objection or claim; and

“(ii) Serve a copy thereof on the applicant or the applicant’s solicitor and on the Commissioner.

“(2) Every notice of opposition and 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.

“(3) Any person who fails to comply with subclause (1) shall be deemed to have abandoned that person’s 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 that person as aforesaid.

Cf. S.R. 156/183, r. 11

“725Q. Obligation of applicant to supply copy of originating application, etc.—The applicant shall, upon the request and at the expense of any person who has served a notice of opposition or a notice of intention to appear, supply that person with—

“(a) A copy of the originating application; and

“(b) A copy of the receipts and payments account; and

“(c) A copy of any affidavit filed in the Court.

Cf. S.R. 1956/183, r. 12 (1)

“725R. Obligation of applicant to comply with request of Commissioner—The applicant shall, upon request by the Commissioner, give the Commissioner or any person appointed by the Commissioner reasonable facilities for inspecting and taking extracts from the books of account by reference to which the Commissioner proposes to verify the receipts and payments account or from which the materials for making up that account have been derived.

Cf. S.R. 1956/183, r. 12 (2)

“725s. Notice of Commissioner’s election to appear—If the Commissioner elects to appear on the hearing of the originating application, the Commissioner shall, not later than 7 clear days before the day appointed for that hearing,—

“(a) Lodge notice of the Commissioner’s election in the Court; and

“(b) Serve a copy of the Commissioner’s notice of election—

“(i) On the applicant; and

“(ii) On any other person who has given notice of opposition or notice of intention to appear.

Cf. S.R. 1956/183, r. 13

“725T. Particulars of Commissioner’s objection—If the Commissioner elects or is directed to appear on the hearing of the originating application, the Commissioner shall, not later than 7 clear days before the day appointed for the main hearing, file particulars of any objection the Commissioner intends to make.

Cf. S.R. 1956/183, r. 14

“725U. Affidavit proving publication of advertisement—Before the date appointed for hearing the interlocutory 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 725N.

Cf. S.R. 1956/183, r. 15

“725v. Costs—If the Court refuses to grant an order extending the term of the patent, it shall not, except under special circumstances, award more than one set of costs among all the opponents.

Cf. S.R. 1956/183, r. 16

“725w. Reference to Court of application made to Commissioner—(1) Where the Commissioner decides to refer to the Court an application made to the Commissioner under section 31 or section 32 or section 33 of the Patents Act 1953, the Commissioner shall give notice of the decision in writing to the applicant and to any person who has supported the application and to any opponent.

“(2) The applicant shall, within 28 days after the date of the receipt of the notice,—

“(a) File an originating application setting out the relief which the applicant seeks; and

“(b) Serve a copy of the originating application—

“(i) On the Commissioner; and

“(ii) On any person who supported the application made to the Commissioner; and

“(iii) On any opponent to the application made to the Commissioner.

“(3) The Commissioner shall, within 14 days after the date of the service of the originating application upon the Commissioner, send the Commissioner’s file of proceedings to the Registrar of the Court.

“(4) If the person who made the application to the Commissioner fails to file an originating application or to withdraw the application to the Commissioner within the said 28 days, the Commissioner may, after giving 7 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 the applicant fails to proceed on the application.

Cf. S.R. 1956/183, r. 17

“Amendment of Specification with Leave of Court

“725x. Application for amendment of specification—Rules 725Y to 725ZE shall apply to every application made by a patentee under section 39 of the Patents Act 1953 for an order allowing the patentee to amend the patentee’s complete specification.

Cf. S.R. 1956/183, r. 18

“725y. Notice of intention to make application for amendment of specification—The patentee shall give notice to the Commissioner of the patentee’s intention to make an application under section 39 of the Patents Act 1953.

Cf. S.R. 1956/183, r. 18 (a)

“725z. Advertisement—(1) The notice under rule 725Y shall be accompanied by a copy of a suitable advertisement of the proposed amendment.

“(2) The Commissioner shall insert the advertisement once in the *Journal*.

“(3) The advertisement—

- “(a) Shall give particulars of the amendments sought and of the patentee’s address for service within New Zealand; and
 “(b) Shall state that any person desiring to oppose the amendment must, within 14 days after the date of the actual issue of the *Journal* in which the advertisement is published, give notice in writing of that person’s desire to the patentee at that address.

Cf. S.R. 1956/183, r. 18 (b)

“725ZA. **Right to be heard**—Any person giving any notice under rule 725z (3) (b) shall be entitled to be heard upon the application, subject to any direction of the Court as to costs.

Cf. S.R. 1956/183, r. 18 (c)

“725ZB. **Time for making of application**—The patentee shall, as soon as may be after the expiration of 21 days after the date of the actual issue of the *Journal* in which the advertisement is published, proceed by way of interlocutory application in the proceeding pending before the Court.

Cf. S.R. 1956/183, r. 18 (d)

“725ZC. **Service of notice of interlocutory application**—Notice of the interlocutory application, 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 by the patentee on—

“(a) The Commissioner; and

“(b) The parties to the proceedings; and

“(c) Such persons, if any, as have given notice of intention to oppose.

Cf. S.R. 1956/183, r. 18 (d)

“725ZD. **Duty of Court to give directions**—On the hearing of the interlocutory application, the Court—

“(a) Shall decide whether, and on what terms as to costs or otherwise, the application shall be allowed to proceed; and

“(b) 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.

Cf. S.R. 1956/183, r. 18 (e)

“725ZE. **Procedure where amendment to specification allowed**—

(1) Where the Court allows a specification to be amended,—

“(a) The patentee shall forthwith lodge with the Commissioner an office copy of the order allowing the amendment; and

“(b) The Commissioner shall advertise the order allowing the amendment once in the *Journal* and otherwise as the Court may direct.

“(2) The patentee 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.

Cf. S.R. 1956/183, r. 18 (f), (g)

“Revocation of Patents

“725ZF. **Application to Court for revocation of patent**—(1) Every application to the Court under section 41 of the Patents Act 1953 for the

revocation of a patent (not being an application made in the course of a proceeding) shall be made by way of an originating application.

“(2) The originating application shall be filed in the office of the Court at Wellington (unless the Court otherwise directs).

“725ZG. **Respondent in revocation proceedings to begin**—(1) The respondent to an application under section 41 of the Patents Act 1953 for the revocation of a patent—

“(a) Shall be entitled to begin and give evidence in support of the patent; and

“(b) If the applicant gives evidence impeaching the validity of the patent, shall be entitled to reply.

“(2) This rule has effect notwithstanding anything in rule 487.

Cf. S.R. 1956/183, r. 19

“Objections

“725ZH. **Particulars of objections where validity of patent disputed**—Particulars of objections as to the validity of a patent—

“(a) Shall be delivered—

“(i) With an application for revocation under section 41 of the Patents Act 1953; or

“(ii) With the defence in a proceeding for infringement of a patent; or

“(iii) With a counterclaim for revocation under section 70 of the Patents Act 1953; and

“(b) Shall state every ground upon which the validity of the patent is disputed; and

“(c) Shall include such particulars as will clearly define every issue which it is intended to raise.

Cf. S.R. 1956/183, r. 20

“725ZI. **Particulars where want of novelty alleged**—(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 that party's own possession) offered inspection of it, or (if it is not in that party's own possession) has used best endeavours to obtain the inspection of it for the other parties to the proceeding.

Cf. S.R. 1956/183, r. 21

“725ZJ. **Service of notice on Solicitor-General**—In any proceeding before the Court, any party who intends to dispute the validity of a patent—

- “(a) Shall give notice of that intention to the Solicitor-General at least 21 days before the hearing; and
- “(b) Shall supply the Solicitor-General with a copy of such papers filed in the proceeding by that party or by any other party as the Solicitor-General requires.

“Particulars in Proceeding for Infringement of Patent

“725ZK. **Particulars to be supplied by plaintiff**—In a proceeding for infringement of a patent, the plaintiff—

- “(a) Shall deliver with the plaintiff’s statement of claim particulars of the breaches relied upon; and
- “(b) Shall specify which of the claims in the specification of the patent sued upon are alleged to be infringed; and
- “(c) Shall give at least one instance of each type of infringement of which complaint is made.

Cf. S.R. 1956/183, r. 22

“725ZL. **Particulars to be supplied by defendant**—(1) If a defendant in a proceeding for infringement of a patent intends to rely, as a defence to the proceeding, on the insertion by the patentee in any contract or contracts of any condition which is void by virtue of section 66 of the Patents Act 1953, that defendant shall deliver with that defendant’s defence—

- “(a) Full particulars of the dates of, and parties to, all contracts on which that defendant intends to rely as containing any such condition; and
- “(b) Full particulars of the particular conditions on which that defendant intends to rely as being void by virtue of that section.

“(2) A defendant shall not be entitled to rely on a defence available to that defendant under section 66 (2) of the Patents Act 1953 of which particulars have not yet been delivered in accordance with the provisions of this rule.

Cf. S.R. 1956/183, r. 23

“725ZM. **Evidence restricted to particulars delivered**—Except by leave of the Court, which may be granted on such terms as the Court thinks 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 that person has delivered.

Cf. S.R. 1956/183, r. 24

“725ZN. **Amendment of particulars**—(1) Particulars filed in the Court under these rules may from time to time be amended by leave of the Court upon such terms as the Court thinks just.

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

“(3) This rule has effect notwithstanding anything in rule 187.

Cf. S.R. 1956/183, r. 25

“Appeals

“725ZO. **Mode of bringing appeal**—Any person who desires to appeal to the Court from any decision of the Commissioner in a case in which a

right of appeal is given by the Patents Act 1953 shall file a notice of appeal in the Court.

Cf. S.R. 1956/183, r. 26 (1); S.R. 1976/116, r. 4

“725zP. Time for appeal—(1) The notice of appeal shall be filed within 28 days after the date of the decision.

“(2) Except by leave of the Court, no appeal shall be entertained unless notice of appeal has been given within the period specified in subclause (1).

Cf. S.R. 1956/183, r. 26 (2), (7); S.R. 1976/116, r. 4

“725zQ. Contents of notice of appeal—The notice of appeal shall state—

“(a) The decision or the part of the decision appealed against; and

“(b) Any error of law alleged by the appellant; and

“(c) Any question of law to be resolved; and

“(d) The grounds of the appeal, which grounds shall be specified with such reasonable particularity as to give full advice to both the Court and the other parties of the issues involved; and

“(e) The relief sought.

Cf. S.R. 1956/183, r. 26 (3); S.R. 1976/116, r. 4

“725zR. Grounds of appeal—Except with the leave of the Court, which may be granted on such terms as the Court thinks just, no grounds other than those stated in the notice of appeal shall be allowed to be taken by the appellant at the hearing.

Cf. S.R. 1956/183, r. 26 (4); S.R. 1976/116, r. 4

“725zS. Service of notice of appeal—The appellant shall, within 7 days of filing the notice of appeal, serve a copy of the notice on—

“(a) The Commissioner; and

“(b) Any other party to the proceedings before the Commissioner.

Cf. S.R. 1956/183, r. 26 (5); S.R. 1976/116, r. 4

“725zT. Obligation of Commissioner to transmit papers to Court—On receiving the notice of appeal, the Commissioner shall forthwith transmit to the Court all the papers relating to the matter the subject of the appeal.

Cf. S.R. 1956/183, r. 26 (6); S.R. 1976/116, r. 4

“725zU. Contentions that may be raised by respondent—(1) A respondent who has not appealed from the decision of the Commissioner, but desires to contend on the appeal that the decision should be varied either in any event or in the event of the appeal being allowed in whole or in part, shall give notice to that effect, specifying the grounds of that contention and the relief which the respondent seeks from the Court. It shall not be necessary for any such respondent to file a further notice of appeal under rule 725zO.

“(2) A respondent who desires to contend on the appeal that the decision of the Commissioner should be affirmed on grounds other than those set out in the decision shall give notice to that effect specifying the grounds of that contention.

Cf. S.R. 1956/183, r. 26A (1), (2); S.R. 1976/116, r. 4

“725zV. Respondent’s notice—(1) A respondent’s notice shall be sent to the Commissioner and to the appellant and every other party to the

proceedings before the Commissioner within 28 days after the date of the receipt of the notice of appeal by the respondent or within such further time as the Court may direct.

“(2) A party by whom a respondent’s notice is given shall, within 7 days after the date of the service of the notice on the appellant, furnish 2 copies of the notice to the Court.

“(3) Where more than one party files a notice of appeal in accordance with these rules, any party to the proceedings, whether or not that party has filed a notice of appeal, may file a respondent’s notice in respect of any notice of appeal given by any other party.

Cf. S.R. 1956/183, r. 26A (3), (4), (5); S.R. 1976/116, r. 4

“725ZW **Appeal to be by way of rehearing**—An appeal to the Court shall be by way of rehearing, and the evidence used on appeal shall be the same as that used before the Commissioner, and no further evidence shall be given, except with the leave of the Court.

Cf. S.R. 1956/183, r. 26B; S.R. 1976/116, r. 4

“725ZX **Proceedings to be heard and determined in public**—(1) Subject to the provisions of this rule, all proceedings before the Court (being proceedings under the Patents Act 1953 or for infringement of a patent) shall be heard and determined in public unless in any particular case the Court directs that they shall be heard in private.

“(2) Proceedings before the Court relating to a decision of the Commissioner in any case in which the complete specification of the patent application has not been published shall be heard and determined in private unless the Court directs that they shall be heard in public.

“(3) A direction under this rule may be given by the Court either of its own motion or on the application of a party to the proceedings, and the direction may relate to all the proceedings or to any specified part of them.

Cf. S.R. 1956/183, r. 26C; S.R. 1976/116, r. 4

“725ZY. **Documentary evidence**—The rules applicable to the filing of documentary evidence on proceedings before the Commissioner shall apply to documentary evidence filed on an appeal to the Court.

Cf. S.R. 1956/183, r. 26D (1); S.R. 1976/116, r. 4

“725ZZ. **Cross-examination of witnesses**—(1) The Court may, at the request of any party, order the attendance at the hearing, for the purpose of cross examination, of any person who has made a statutory declaration or sworn an affidavit in the matter to which the appeal relates.

“(2) Any person requiring the attendance of a witness for cross examination shall tender to the witness whose attendance is required the appropriate fees, allowances, and travelling expenses payable to any witness in accordance with the appropriate scales specified in the Schedule to the Witnesses and Interpreters Fees Regulations 1974*.

Cf. S.R. 1956/183, r. 26D (2), (3); S.R. 1976/116, r. 4

“725ZZA. **Application of Part X**—Part X shall apply in relation to any appeal under the Patents Act 1953 except to the extent that provisions of that Part are modified by or are inconsistent with this Part or the Patents Act 1953.

*S.R. 1974/124

Amendment No. 1: (Revoked by S.R. 1984/268)

Amendment No. 2: (Revoked by S.R. 1987/193)

Amendment No. 3: (Revoked by S.R. 1987/193)

Amendment No. 4: (Revoked by S.R. 1988/147)

Amendment No. 5: S.R. 1988/147

“Costs

“725zzb. **Costs**—Where a proceeding for infringement of a patent goes 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.”

Cf. S.R. 1956/183, r. 27

4. Revocations—The Patents Rules 1956* and the Patents Rules 1956, Amendment No. 1† are hereby revoked.

5. Transitional provision—(1) Where, at the commencement of the 1st day of October 1990, proceedings in relation to any application made or proceeding instituted before the commencement of these rules under the Patents Act 1953 have not been completed, those proceedings may be continued and completed under the High Court Rules and the High Court Rules shall, so far as practicable, apply to those proceedings. So far as it is not practicable for any provision of the High Court Rules to be applied to any such proceedings, the rules revoked by these rules shall, to such extent as may be necessary, continue to apply to those proceedings.

(2) If in any proceedings to which subclause (1) of this rule applies any question arises as to the application of any provision of the High Court Rules or of the rules revoked by these rules, the Court may, either on the application of any party to those proceedings or of its own motion, determine the question and make such order thereon as it thinks fit.

(3) The Acts Interpretation Act 1924 shall apply subject to subclauses (1) and (2) of this rule and to rule 6 of these rules.

6. Saving—Subject to rule 5 of these rules, all appointments, records, advertisements, applications, notices, documents, judgments, orders, decisions, directions, appeals, and generally all acts of authority that originated under any of the provisions of the rules revoked by these rules and are subsisting or in force at the commencement of these rules shall enure for the purposes of the High Court Rules as if they had originated under the corresponding provisions of the High Court Rules, and accordingly shall, where necessary, be deemed to have so originated.

MARIE SHROFF,
Clerk of the Executive Council.

*S.R. 1956/183
†S.R. 1976/116

EXPLANATORY NOTE

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

These rules, which come into force on 1 October 1990, insert into the High Court Rules a new Part XIa relating to patents.

The new Part will apply in the place of the Patents Rules 1956 (which are revoked).

Issued under the authority of the Acts and Regulations Publication Act 1989.

Date of notification in *Gazette*: 9 August 1990.

These rules are administered in the Department of Justice.