

Most patent and trade mark attorneys will provide the name and address of their firm as the agent for service during the process of obtaining registered intellectual property rights for their clients. As the application for the registered right then proceeds through the application process and hopefully through to grant, then the office which has received the application – whether it be the United Kingdom Intellectual Property Office (UKIPO) for national registered rights or the Office of Harmonisation for the Internal Market (OHIM) for community trade marks and community registered designs or the European Patent Office for applications for national patents in Europe via the European Patent Convention – will use that address for official communications with the applicant during prosecution¹, be they part of an ex parte or inter partes proceeding. After grant, such addresses continue to be used for communications from the relevant IP office relating to renewals, entitlement disputes or revocation proceedings proceeding in such office.

Court Proceedings

The position in relation to proceedings started in either the Patents Court, the Chancery Division or the Intellectual Property & Enterprise Court is different. Service of the claim form in such proceedings is generally governed by the Civil Procedure Rules, what lawyers generally call “the White Book” – but which is in fact not one book but two. In particular CPR Part 6 contains a detailed set of rules about how the claim form (the document which is used to start off the litigation process, formerly called a writ) is to be served. Of particular interest to patent attorneys and trade mark attorneys is the fact that the general rules about service set out in CPR Part 6 are subject² to certain special rules for IP cases, which are set out in CPR part 63 (the part of the civil procedure rules that deals with IP).

Specifically CPR 63.14(2) provides that:

A claim form, relating to a registered right, may be served

- (a) on the party who has registered the right (i.e., the applicant or proprietor) at its address for service for that right given in the UKIPO register, provided the address is within the United Kingdom; or
- (b) in accordance with rule 6.32(1), 6.33(1) or 6.33(2) on a party who has registered the right at the address for service given for that right in the appropriate register at
 - (i) the United Kingdom Patent Office; or
 - (ii) the Office for Harmonisation in the Internal Market.

Effect of CPR 63.14(2)(b)

The precise effect of CPR 63.14(2)(b) was recently considered by Mr. Justice Birss in the case of *Bullitt Mobile Limited v Sonim Technologies [2013] EWHC 3367 (IPEC)*. In that case Bullitt served its claim form in a threats action on Sonim’s patent attorney in Leeds (Hepworth Browne), whose address for service had been recorded in OHIM’s register of Community registered designs. Sonim contested jurisdiction and successfully argued that:

1. CPR 63.14(2)(a) did not apply as the registers kept by OHIM were not the same as the UKIPO registers.
2. Service on Hepworth Browne in reliance on CPR 63.14(2)(b) was defective as CPR Rule 6.32(1) only related to service of proceedings in Northern Ireland and Scotland and CPR Rule 6.33 only related to service of proceedings outside the UK.
3. The net effect was that CPR 63.14(2) only authorised service on either an address (i) in the UK for service given in one of the UKIPO registers or (ii) in a register kept by OHIM (community trademarks or community registered designs) where that address was not in England or Wales.

Birss J had no option other than to accept this reasoning as there was no ambiguity in the language. He did, however, ultimately ratify the service on the Leeds patent attorney under CPR rule 6.15, which provides that a court can ratify a method of service, which is not in strict accordance with the Civil Procedure Rules, where it appears to the court that there is good reason to do so. Birss J found that there was good reason to do so in this case – the reason being principally that the threats complained of had allegedly been made within the jurisdiction of the English courts and the relief sought – including a declaration of non-infringement – was within the exclusive jurisdiction of the Community Design Courts, such as IPEC. Birss J also thought that it was relevant to the exercise of his discretion under CPR 6.15 that there seemed no logical basis for CPR 63.14 allowing service of process in Edinburgh, Belfast or Paris but not in England (or Wales).

In a case which did not involve threats – for example proceedings for the revocation of a US company’s UK patent and for a declaration of non-infringement of that patent – then CPR 6.15 may well not rescue service on a patent attorney in England and Wales. Service under the Hague Convention may be required – which in many cases is not particularly onerous as it can be effected by post, providing that service in such state has been endorsed by the local circuit for the state in which the defendant is based.

¹ Patent Rules 2007 rule 103, Registered Designs Rules 2006 rule 42, Trade Mark Rules 2008 rule 11, Implementing Regulations to the Convention on the Grant of European Patents Rule 41(d), Commission Regulation (EC) No 2245/2002 implementing Council Regulation (EC) No 6/2002 on Community designs article 1(e), Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark article 1(e).

² By virtue of CPR 6.1(a).

And the Lesson

It is clear that CPR 63.14(2) does have a material hole within it: service on a defendant via his patent attorney, whose address in England or Wales has been stated in OHIM's registers of Community registered designs or Community trade marks, can be successfully challenged.

This hole is only likely to be relevant, however, where the defendant does not have a seat, branch office or establishment in the UK or in the European Community³, where he could be personally served under other provisions of CPR part 6. It may therefore be highly relevant for clients based in Asia or the Americas, who file in Europe but do not actually have a physical or legal presence here themselves.

Birss J has in short provided yet another good reason for using a patent attorney based in England or Wales. Whether our professional friends north of the border or in Northern Ireland are likely to see things quite this way must of course be open to some considerable doubt. Their remedy, if they want one, may be to politely point out that that the current rules may well violate Article 12⁴ of the EC Treaty, which provides that any discrimination on grounds of nationality shall be prohibited. In accordance with case law under Article 12, CPR 63.14(2) (a) should not mandate an address for service only in the UK but rather in the UK or another EEA state and CPR 63.14(2)(b) should not distinguish between an address for service on the one hand in England and Wales and on the other in the rest of the EEA.

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Andrew acted for Sonim in this case as both solicitor and advocate.

³ Service on the latter often being made easier by Council Regulation EC 44/2001.

⁴ Formerly Article 7 of the Treaty of Rome. See for example *De Bry v. Fitzgerald and Another* [1990] 1 WLR 552; *Fitzgerald v. Williams* [1996] QB 657 in the context of orders for security for costs, which were held to discriminate on the basis of nationality as they only applied to claimants ordinarily resident outside the jurisdiction of the English Courts, which would amount to in effect discrimination on the basis of nationality.