

# Kluwer Patent Blog

## Guidance Note on Skeleton Arguments in English Patent Court Proceedings

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A recent decision from Joanna Smith J dealing with the costs of a withdrawn application in a case before the English Patents Court contains an important postscript and suggests that the rules in the Patents Court Guide regarding the lodging and filing of skeleton arguments need to be revisited.

All English patent litigators, and many practitioners outside of this jurisdiction know that it is customary for the parties' respective advocates to provide a skeleton argument to the Court, (and to exchange this document with the other side) shortly before any hearing. Skeleton arguments are intended to provide the Court with a succinct, factual and legal overview of the issues in dispute. They are also adversarial in nature, setting the tone for the oral submissions and seeking to persuade the Court that their client's position is correct.

The deadline for filing and exchanging skeleton arguments ahead of trials is typically contained in the Order for Directions, which is made fairly early on in the case and may be revisited at the Pre-Trial Review a few weeks before the trial. But skeleton arguments are not just for trial hearings. They are typically provided ahead of every contested Court application, including, but not limited to, disclosure, experiments, for a party to amend its case.

Like a traditional trifle, the rules of procedure in the English Patents Court are layered. As they are, at their heart, civil litigation proceedings, Patents Court matters are ultimately governed by the Civil Procedure Rules or "CPR". Within the CPR, Part 63 and its associated Practice Direction contain special provisions for all intellectual property proceedings including patent cases. The next layer in the trifle is the Chancery Guide which, briefly stated, is comprised of general procedural guidelines and which applies to cases in the Chancery Division within the Business and Property Courts, including all intellectual property proceedings. Finally, the Patents Court is blessed with its own set of procedural rules called the Patents Court Guide. Paragraph 1 of the Patents Court Guide confirms that the Chancery Guide applies to Patents Court proceedings, unless the guidance from the latter is different from the former, in which case the latter takes precedence.

Paragraph 14.7 of the Patents Court Guide provides that skeleton arguments should be lodged in time for the judge to read them before an application and that this should normally be 10:30 am on the working day before the hearing (or in the case of shorter applications, 3 pm). This is in contrast to the Chancery Court Guide which makes a distinction between "heavy" applications and other types of application. In relation to the former (defined in the Chancery Guide as hearings estimated to last more than 2½ hours and/or with a pre-reading estimate of more than 90 minutes), it requires

parties to lodge and exchange skeleton arguments at 12 noon two clear days before the date fixed for the hearing (or where there is a floating window, the beginning of that window).

A practical example of where this overlap was important was considered by the Patents Court recently. In entitlement proceedings commenced in April 2023 before the English Patents Court between Dr Vanessa Hill and Touchlight Genetics Limited, Dr Hill claims entitlement to three UK patents and two non-UK patent applications pursuant to Section 37 and 12 of the Patents Act 1977 respectively. In April 2024, Dr Hill applied to amend her claim to introduce several new causes of action relating to constructive trusts, breach of fiduciary duty and breach of implied contractual terms. Touchlight resisted this application, and a hearing was convened with a two-day estimate for the Court to assess whether the new allegations should be permitted into the case. The hearing was scheduled to commence before Joanna Smith J on Tuesday 25th June and so, in accordance with the Patents Court Guide, Touchlight lodged its skeleton at Court very shortly after 10 am on Monday 24th June. Touchlight's skeleton was 77 pages in length, Dr Hill's was 32 pages.

Shortly after the hearing, on Friday 28 June, Dr Hill withdrew her application and there followed, on 10 July, an application before the Judge on costs. Since Dr Hill had withdrawn her application, Touchlight was awarded its costs on the standard basis with a 65% interim payment on account. In a postscript to her judgment on costs, Joanna Smith J noted the disjunct between the provisions of the Chancery Court Guide and the Patents Court Guide in relation to the timing of filing of skeletons. She stated that she considered the provisions of paragraph 14.7(a) of the Patents Court Guide need to be revisited. She recommended that in future, in "heavy" applications before the Patents Court, notwithstanding the provisions of the Patents Court Guide, parties would be well advised to liaise over the exchange of skeleton arguments to ensure that each party's representatives, and the Court have time to digest the contents of the document in advance of the hearing.

This issue may be brought up before the Patent Court Users Committee in due course. Another matter that the authors wish to mention is that paragraph 14.58 of the Chancery Guide provides that skeleton arguments for heavy applications should not exceed 25 pages in length (and 50 pages for trial skeletons in the Chancery Division although other areas of the court also have similar restrictions on page count). Where, exceptionally, it is necessary to file a longer skeleton argument, the legal representatives whose names appear at the end of the document must file in good time a letter seeking permission from the Court and explaining why a longer document is appropriate. As there is no corresponding provision in the Patents Court Guide, this rule applies in Patents Court proceedings. However, in the authors' experience, this provision is more honoured in the breach than the observance, with parties to applications in patent cases serving lengthy skeletons without even informing the Court beforehand. It is possible that, in future, the Patents Court judges may crack down on this behaviour.

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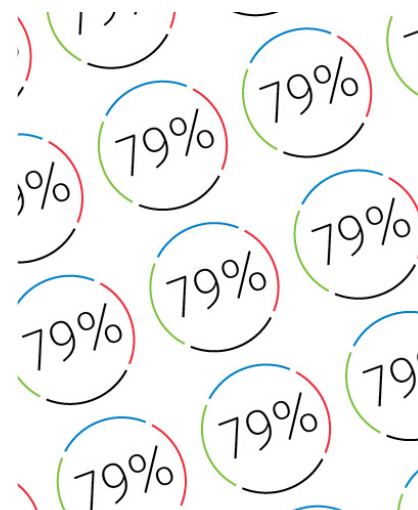
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