

IPEC Small Claims Checklist



Jane Lambert¹

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1. Have you read the Guide to the Intellectual Property Enterprise Court Small Claims Track (“the Guide”), CPR Parts 27 and 63 and the Parts 27 and 63 Practice Directions?

These are very important because they set out and explain the rules that the Court will apply to your case. They can be downloaded from the Ministry of Justice website.²

2. Can your case be brought in the IPEC Small Claims Track?

Although para 4.3 of the Guide says that the Small Claims Track is only suitable for copyright, trade mark, passing off, unregistered design right and registered Community design cases, CPR 63.27 says that a claim may be started in, or transferred to, the Small Claims Track if CPR 63.13 applies but not CPR 62.2 and the value of the claim is not more than £10,000. CPR 63.13 refers to a much longer list in para 16.1 of the Part 63 Practice Direction and includes technical trade secrets, database rights and rights in performances as well as those listed in para 4.3 of the Guide. As para 1 of the Guide says:

“Where there is any conflict or confusion between the provisions of this Guide and the CPR, you must follow the rules and practices as set out in the CPR” It would appear that the Guide is too restrictive. However, just because a case can be brought before the Small Claims track, it doesn’t mean it must be. You have to ask for the case to be

¹ Barrister, 4-5 Gray’s Inn Square, London, WC1R 5AH, Tel 020 7404 5252, Email jlambert@4-5.co.uk, <http://nipclaw.blogspot.co.uk/p/profile.html>

² The Guide can be downloaded from https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/426129/patents-court-small-claims.pdf and CPR Parts 27 and 63 and the Parts 27 and 63 Practice Directions from <http://www.justice.gov.uk/courts/procedure-rules/civil/rules>

allocated to the Small Claims Track in your Particulars of Claim and the other side may object to your request. If he or she does object, the Court will decide whether the case is suitable for the Small Claims Track (see paragraph 9 below).

3. Have you sent the other side a letter before claim that complies with CPR 63.20 (2)?

There are two traps here and you may need to consult a lawyer specializing in intellectual property law³ or a patent or trade mark attorney with the right to conduct litigation to avoid them. The first of those traps is that the Practice Direction referred to by CPR 63.20 (2) no longer exists but CPR 63.20 (2) still requires compliance with it. The former Practice Direction gave detailed instructions as to what should be in a letter before claim and the evidence that should be contained in it. The second trap is that threatening certain types of intellectual property actions without justification can be actionable. In other words, the other side can sue you merely for threatening IP infringement proceedings in some circumstances. The laws on groundless threats are complex and not all lawyers understand them because there are no similar laws outside IP. That is why you may need specialist advice on that point.

4. Have you considered any Response by the Other Side?

The other side may have spotted a flaw in your argument, produced evidence which is incompatible with your case or suggested talks or mediation to resolve the dispute. If they have done any of those things you have to consider their response and formulate an answer. Again, you have to be careful. If the Court thinks you have acted unreasonably by pressing on with a flawed claim in the face of a valid objection or squandering the opportunity for a fair settlement, it could penalize in several ways.

5. Have you drafted Particulars of Claim?

Read paragraph 7.6 of the Guide very carefully. This is an important document and one for which you may need specialist counsel or a solicitor or a patent or trade mark attorney advocate. Your particulars of claim should identify the intellectual property right that you believe to have been infringed, state how it arises, explain how it has been infringed and set out the remedies you require and why you are entitled to them. If you claim

³ These would include barristers who are members of the Intellectual Property Bar Association or solicitors whose firms are members of the Intellectual Property Lawyers Association.

money from the other side you must show how you have worked out your claim. You must limit your money claim to £10,000 in your Particulars of Claim. That is very important because the Small Claims Track cannot hear claims for more than that amount. You must also state whether you have complied with CPR 63.20 (2) which is mentioned in paragraph 2 above and ask for the case to be allocated to the Small Claims Track.

6. Have you issued your Claim Form properly?

You need to download a claim form (Form N1) and the Notes for claimant on completing a claim form (Leaflet N1A) from HM Courts and Tribunals Service website⁴ or obtain them from a law stationer or any County Court Office. You should read the leaflet and paragraph 7.2 of the Guide carefully and fill in the form as prescribed. You then post your claim form and particulars of claim with the correct fee to the Intellectual Property Enterprise Court at:

The Rolls Building,
7 Rolls Building,
Fetter Lane,
London,
EC4A 1NL.

Alternatively, you can take those documents by hand to the public counter of the Rolls Building (nearest underground stations Chancery Lane and Temple).

7. Have you served the Claim Form and Particulars of Claim correctly?

It is your job to serve the claim form and particulars of claim on the other side⁵ and not the Court's. Read CPR Part 6 and the Part 6 Practice Direction and paragraphs 7.3, 7.4 and 7.5 of the Guide very carefully. You must make sure that you include a response pack with sealed copies of the claim form and particulars of claim. If you do not do that the claim will not be served properly and the defendant can apply to set aside any orders or judgments that you may have obtained against him or her.

8. Has the Defendant responded in Time?

Read paragraphs 7.5 and 7.7 of the Guide very carefully for the time limits and applying for judgment in default. If the 48 or, as the case may be, the 70-day time limit has expired and you have

not yet received his or her defence, check with the Court office as to whether they have received a defence. Sometimes, a defendant files a defence with the Court but does not serve it on the claimant. If the defendant has not filed and served a defence in time you can consider an application for a default judgment.

9. Does the Defendant object to the Case in the Small Claims Track?

If the defendant objects to the Small Claims Track he or she can say so in the defence. There may be all sorts of good reasons why he or she objects. The case may involve a new or difficult point of law which should be decided by a Circuit or even a High Court judge. Or the defendant may believe that the claimant will have to drop the case if he or she risks costs on the Multitrack or High Court scale. Where one side wants the case to proceed in the Small Claims Track and the other side does not, the Court sends both sides a directions questionnaire and considers the parties' responses. Sometimes the Court orders a hearing at this point. Transferring a case to the Multitrack leaves the Claimant with a difficult choice. Does he or she discontinue before the costs have mounted or is he or she sufficiently confident of the strengths of the claim to risk an adverse costs order? That is another issue upon which the Claimant may need to take specialist legal advice.

10. Have you complied with the Court's Directions

If the Defendant does not object to the Small Claims Track or the Court dismisses the Defendant's objections, it will give directions for the further conduct of the case. Usually, it will give those directions without a hearing. These will include a timetable for the exchange of evidence and a date for the final hearing of the claim, unless the parties agree that the claim can be decided by without a hearing. Evidence will usually take the form of witness statements exhibiting the documents relied upon. Sometimes the parties are directed to exchange skeleton arguments. It is your job to comply with those directions punctually.

11. Are you and your Witnesses ready for the Final Hearing?

Most hearings take place at the Royal Courts of Justice in the Strand. You should make sure that you arrive at the courtroom in good time with your witnesses and documents.

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<http://hmctsformfinder.justice.gov.uk/HMCTS/FormFinder.do>

⁵ We should now call him, her or it "the defendant".