



# Patents Act 1977

## 1977 CHAPTER 37

### PART I

#### NEW DOMESTIC LAW

##### *Putting validity in issue*

#### **74 Proceedings in which validity of patent may be put in issue.**

- (1) Subject to the following provisions of this section, the validity of a patent may be put in issue—
  - (a) by way of defence, in proceedings for infringement of the patent under section 61 above or proceedings under section 69 above for infringement of rights conferred by the publication of an application;
  - (b) in proceedings [<sup>F1</sup>in respect of an actionable threat under section 70A] above;
  - (c) in proceedings in which a declaration in relation to the patent is sought under section 71 above;
  - (d) in proceedings before the court or the comptroller under section 72 above for the revocation of the patent;
  - (e) in proceedings under section 58 above.
- (2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent.
- (3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 72 above or otherwise) are the grounds on which the patent may be revoked under that section.
- (4) No determination shall be made in any proceedings mentioned in subsection (1) above on the validity of a patent which any person puts in issue on the ground mentioned in section 72(1)(b) above unless—

**Changes to legislation:** Patents Act 1977, Cross Heading: Putting validity in issue is up to date with all changes known to be in force on or before 26 January 2024. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes

- (a) it has been determined in entitlement proceedings commenced by that person or in the proceedings in which the validity of the patent is in issue that the patent should have been granted to him and not some other person; and
- (b) except where it has been so determined in entitlement proceedings, the proceedings in which the validity of the patent is in issue are commenced [<sup>F2</sup>on or before the second anniversary of] the date of the grant of the patent or it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.
- (5) Where the validity of a patent is put in issue by way of defence or counterclaim the court or the comptroller shall, if it or he thinks it just to do so, give the defendant an opportunity to comply with the condition in subsection (4)(a) above.
- (6) In subsection (4) above “entitlement proceedings”, in relation to a patent, means a reference under [<sup>F3</sup>section 37(1) above] on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration or declarator that it was so granted.
- (7) Where proceedings with respect to a patent are pending in the court under any provision of this Act mentioned in subsection (1) above, no proceedings may be instituted without the leave of the court before the comptroller with respect to that patent under section 61(3), 69, 71 or 72 above.
- (8) It is hereby declared that for the purposes of this Act the validity of a patent is not put in issue merely because
- [<sup>F4</sup>(a)] the comptroller is considering its validity in order to decide whether to revoke it under section 73 above, [<sup>F5</sup>or
- (b) its validity is being considered in connection with an opinion under section 74A below or a review of such an opinion.]

#### Textual Amendments

- F1** Words in s. 74(1)(b) substituted (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017 \(c. 14\), ss. 1\(5\), 8; S.I. 2017/771, reg. 2\(1\)\(a\) \(with reg. 3\)](#)
- F2** Words in s. 74(4)(b) substituted (1.10.2014) by [Intellectual Property Act 2014 \(c. 18\), s. 24\(1\), Sch. para. 3\(2\); S.I. 2014/2330, art. 3, Sch.](#)
- F3** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\), s. 295, Sch. 5 para. 10](#)
- F4** Words in s. 74(8) renumbered (1.10.2005) as s. 74(8)(a) by [Patents Act 2004 \(c. 16\), ss. 13\(2\), 17\(1\); S.I. 2005/2471, art. 2\(c\)](#)
- F5** S. 74(8)(b) and preceding word inserted (1.10.2005) by [Patents Act 2004 \(c. 16\), ss. 13\(2\), 17\(1\); S.I. 2005/2471, art. 2\(c\)](#)

**Changes to legislation:**

Patents Act 1977, Cross Heading: Putting validity in issue is up to date with all changes known to be in force on or before 26 January 2024. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations.

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**Changes and effects yet to be applied to the whole Act associated Parts and Chapters:**

Whole provisions yet to be inserted into this Act (including any effects on those provisions):

- s. 56(4)(a)(iiia) and word added by [S.I. 2006/1056 Sch. para. 2\(b\)](#) (This amendment comes into force on the day on which 2005 asp 13, s. 20 comes into force, see art. 1(2)(b))
- s. 63(3)(a) words in s. 63(3) renumbered as s. 63(3)(a) by [2004 c. 16 s. 2\(4\)](#) (Amendment not applied to legislation.gov.uk. S. 2(4) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)
- s. 63(3)(b) and word inserted by [2004 c. 16 s. 2\(4\)](#) (Amendment not applied to legislation.gov.uk. S. 2(4) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)