



Patents Act 1977

1977 CHAPTER 37

PART III

MISCELLANEOUS AND GENERAL

Legal Proceedings

96 The Patents Court

- (1) There shall be constituted, as part of the Chancery Division of the High Court, a Patents Court to take such proceedings relating to patents and other matters as may be prescribed by rules of court.
- (2) The judges of the Patents Court shall be such of the puisne judges of the High Court as the Lord Chancellor may from time to time nominate.
- (3) The foregoing provisions of this section shall not be taken as prejudicing the provisions of the Supreme Court of Judicature (Consolidation) Act 1925 which enable the whole jurisdiction of the High Court to be exercised by any judge of that court.
- (4) Rules of court shall make provision for the appointment of scientific advisers to assist the Patents Court in proceedings under this Act and for regulating the functions of such advisers.
- (5) The remuneration of any such adviser shall be determined by the Lord Chancellor with the consent of the Minister for the Civil Service and shall be defrayed out of moneys provided by Parliament.

97 Appeals from the comptroller

- (1) Except as provided by subsection (4) below, an appeal shall lie to the Patents Court from any decision of the comptroller under this Act or rules except any of the following decisions, that is to say—
 - (a) a decision falling within section 14(7) above ;

Status: This is the original version (as it was originally enacted).

- (b) a decision under section 16(2) above to omit matter from a specification;
 - (c) a decision to give directions under subsection (1) or (2) of section 22 above ;
 - (d) a decision under rules which is excepted by rules from the right of appeal conferred by this section.
- (2) For the purpose of hearing appeals under this section the Patents Court may consist of one or more judges of that court in accordance with directions given by or on behalf of the Lord Chancellor; and the Patents Court shall not be treated as a divisional court for the purposes of section 31(1)(f) of the Supreme Court of Judicature (Consolidation) Act 1925 (appeals from divisional courts).
- (3) An appeal shall not lie to the Court of Appeal from a decision of the Patents Court on appeal from a decision of the comptroller under this Act or rules—
- (a) except where the comptroller's decision was given under section 8, 12, 18, 20, 27, 37, 40, 61, 72, 73 or 75 above; or
 - (b) except where the ground of appeal is that the decision of the Patents Court is wrong in law;
- but an appeal shall only lie to the Court of Appeal under this section if leave to appeal is given by the Patents Court or the Court of Appeal.
- (4) An appeal shall lie to the Court of Session from any decision of the comptroller in proceedings which under rules are held in Scotland, except any decision mentioned in paragraphs (a) to (d) of subsection (1) above.
- (5) An appeal shall not lie to the Inner House of the Court of Session from a decision of an Outer House judge on appeal from a decision of the comptroller under this Act or rules—
- (a) except where the comptroller's decision was given under section 8, 12, 18, 20, 27, 37, 40, 61, 72, 73 or 75 above; or
 - (b) except where the ground of appeal is that the decision of the Outer House judge is wrong in law.

98 Proceedings in Scotland

- (1) In Scotland proceedings relating primarily to patents (other than proceedings before the comptroller) shall be competent in the Court of Session only, and any jurisdiction of the sheriff court relating to patents is hereby abolished except in relation to questions which are incidental to the issue in proceedings which are otherwise competent there.
- (2) The remuneration of any assessor appointed to assist the court in proceedings under this Act in the Court of Session shall be determined by the Lord President of the Court of Session with the consent of the Minister for the Civil Service and shall be defrayed out of moneys provided by Parliament.

99 General powers of the court

The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Act or any treaty or international convention to which the United Kingdom is a party, make any order or exercise any other power which the comptroller could have made or exercised for the purpose of determining that question.

100 Burden of proof in certain cases

- (1) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the proprietor of the patent or a licensee of his shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process.
- (2) In considering whether a party has discharged the burden imposed upon him by this section, the court shall not require him to disclose any manufacturing or commercial secrets if it appears to the court that it would be unreasonable to do so.

101 Exercise of comptroller's discretionary powers

Without prejudice to any rule of law, the comptroller shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretion vested in the comptroller by this Act or rules.

102 Right of audience in patent proceedings

- (1) Any party to any proceedings before the comptroller under this Act or any treaty or international convention to which the United Kingdom is a party may appear before the comptroller in person or be represented by counsel or a solicitor (of any part of the United Kingdom) or a patent agent or, subject to rules under section 115 below, by any other person whom he desires to represent him.
- (2) Subsection (1) above, in its application to proceedings under any such treaty or convention, shall have effect subject to section 84(1) or (3) above.
- (3) Without prejudice to the right of counsel to appear before the High Court, a member of the Bar of England and Wales who is not in actual practice, a solicitor of the Supreme Court and a patent agent shall each have the right to appear and be heard on behalf of any party to an appeal under this Act from the comptroller to the Patents Court.

103 Extension of privilege for communications with solicitors relating to patent proceedings

- (1) It is hereby declared that the rule of law which confers privilege from disclosure in legal proceedings in respect of communications made with a solicitor or a person acting on his behalf, or in relation to information obtained or supplied for submission to a solicitor or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before a court in the United Kingdom extends to such communications so made for the purpose of any pending or contemplated—
 - (a) proceedings before the comptroller under this Act or any of the relevant conventions, or
 - (b) proceedings before the relevant convention court under any of those conventions.
- (2) In this section—

" legal proceedings " includes proceedings before the comptroller ;
the references to legal proceedings and pending or contemplated proceedings include references to applications for a patent or a European patent and to international applications for a patent; and

Status: This is the original version (as it was originally enacted).

" the relevant conventions " means the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty.

(3) This section shall not extend to Scotland.

104 Privilege for communications with patent agents relating to patent proceedings

(1) This section applies to any communication made for the purpose of any pending or contemplated patent proceedings, being either—

- (a) a communication between the patent agent of a party to those proceedings and that party or any other person ; or
- (b) a communication between a party to those proceedings and a person other than his patent agent made for the purpose of obtaining, or in response to a request for, information which that party is seeking for the purpose of submitting it to his patent agent.

(2) For the purposes of subsection (1) above a communication made by or to a person acting—

- (i) on behalf of a patent agent; or
- (ii) on behalf of a party to any pending or contemplated proceedings,

shall be treated as made by or to that patent agent or party, as the case may be.

(3) In any legal proceedings other than criminal proceedings a communication to which this section applies shall be privileged from disclosure in like manner as if any proceedings before the comptroller or the relevant convention court for the purpose of which the communication was made were proceedings before the court (within the meaning of this Act) and the patent agent in question had been the solicitor of the party concerned

(4) In this section—

" legal proceedings " includes proceedings before the comptroller ;

" patent agent " means an individual registered as a patent agent in the register of patent agents, a company lawfully practising as a patent agent in the United Kingdom or a person who satisfies the condition mentioned in section 84(1) or (3) above;

" patent proceedings " means proceedings under this Act or any of the relevant conventions before the court, the comptroller or the relevant convention court, whether contested or uncontested and including an application for a patent;

" party ", in relation to any contemplated proceedings, means a prospective party to the proceedings; and

" the relevant conventions " means the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty.

(5) This section shall not extend to Scotland.

105 Extension of privilege in Scotland for communications relating to patent proceedings

It is hereby declared that in Scotland the rules of law which confer privilege from disclosure in legal proceedings in respect of communications, reports or other documents (by whomsoever made) made for the purpose of any pending

or contemplated proceedings in a court in the United Kingdom extend to communications, reports or other documents made for the purpose of patent proceedings within the meaning of section 104 above.

106 Costs and expenses in proceedings before the Court under s. 40

- (1) In proceedings before the court under section 40 above (whether on an application or on appeal to the court), the court, in determining whether to award costs or expenses to any party and what costs or expenses to award, shall have regard to all the relevant circumstances, including the financial position of the parties.
- (2) If in any such proceedings the Patents Court directs that any costs of one party shall be paid by another party, the court may settle the amount of the costs by fixing a lump sum or may direct that the costs shall be taxed on a scale specified by the court, being a scale of costs prescribed by the Rules of the Supreme Court or by the County Court Rules.

107 Costs and expenses in proceedings before the comptroller

- (1) The comptroller may, in proceedings before him under this Act, by order award to any party such costs or, in Scotland, such expenses as he may consider reasonable and direct how and by what parties they are to be paid.
- (2) In England and Wales any costs awarded under this section shall, if a county court so orders, be recoverable by execution issued from the county court or otherwise as if they were payable under an order of that court.
- (3) In Scotland any order under this section for the payment of expenses may be enforced in like manner as a recorded decree arbitral.
- (4) If any of the following persons, that is to say—
 - (a) any person by whom a reference is made to the comptroller under section 8, 12 or 37 above;
 - (b) any person by whom an application is made to the comptroller for the revocation of a patent;
 - (c) any person by whom notice of opposition is given to the comptroller under section 27(5), 29(2), 47(6) or 52(1) above, or section 117(2) below ;neither resides nor carries on business in the United Kingdom, the comptroller may require him to give security for the costs or expenses of the proceedings and in default of such security being given may treat the reference, application or notice as abandoned.
- (5) In Northern Ireland any order under this section for the payment of costs may be enforced as if it were a money judgment.

108 Licences granted by order of comptroller

Any order for the grant of a licence under section 11, 38, 48 or 49 above shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order.