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STATUTORY INSTRUMENTS

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**2004 No. 3205 (C. 140)**

**PATENTS**

**The Patents Act 2004 (Commencement No. 2 and Consequential, etc. and Transitional Provisions) Order 2004**

*Made* - - - - - *29th November 2004*  
*Laid before Parliament* *7th December 2004*  
*Coming into force* - - - *1st January 2005*

The Secretary of State, in exercise of the powers conferred upon her by section 17 of the Patents Act 2004<sup>(1)</sup>, and after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992<sup>(2)</sup>, makes the following Order:

**Citation, commencement and interpretation of this Order**

1.—(1) This Order may be cited as the Patents Act 2004 (Commencement No. 2 and Consequential, etc. and Transitional Provisions) Order 2004, and shall come into force on 1st January 2005.

(2) In this Order—

“the 1977 Act” means the Patents Act 1977<sup>(3)</sup>;

“the 2004 Act” means the Patents Act 2004;

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(1) 2004 c. 16.

(2) 1992 c. 53.

(3) 1977 c. 37. Sections 8, 11, 12, 22, 23, 38, 40, 41, 43, 53, 60, 61, 63, 70, 75, 89, 89B, 91, 95, 103, 105, 106, 121, 130 and 131 are amended, and sections 86 and 87 repealed, by the provisions of the Patents Act 2004 which are brought into force by article 2 of this Order. Section 40 was previously amended by paragraph 9 of Schedule 2 to the Trade Union and Labour Relations (Consolidation) Act 1992 (c. 52); section 43 by paragraph 11(2) of Schedule 5 to the Copyright, Designs and Patents Act 1988 (c. 48); section 53 by paragraph 15 of Schedule 5 to that Act, by paragraph 8(1) and (4) of Schedule 25 to the Enterprise Act 2002 (c. 22) and by SI 1999/506; section 60 by paragraph 8(a) of Schedule 5 to the Copyright, Designs and Patents Act 1988, Schedule 15 to the Civil Aviation Act 1982 and by SI 1999/1899 and 2000/2037; section 105 by paragraph 21 of Schedule 7, and Schedule 8, to the Copyright, Designs and Patents Act 1988; section 130 (definition of “court”) by paragraph 23 of Schedule 7 to that Act, and (definition of “employee”) by section 22 of the Armed Forces Act 1981 (c. 55); and section 131 by Schedule 2 to the Companies Consolidation (Consequential Provisions) Act 1985 (c. 9) and by Schedule 4 to the Arbitration Act 1996 (c. 23). Sections 89 and 89B were substituted by paragraph 25 of Schedule 5 to the Copyright, Designs and Patents Act 1988. Sections 22 and 23 were modified in their effect by section 32(2) of the Magistrates’ Courts Act 1980 (c. 43); section 103 by SI 1991/2684; and section 121 by article 6 of SI 1991/1796 (revoked by section 16(3) of the Patents Act 2004, which is brought into force by article 2(h) of this Order). References to the Interpretation Act 1889 in section 41(7) and to the Income and Corporation Taxes Act 1970 in section 43(8) are now to be construed as references, respectively, to the corresponding provisions of the Interpretation Act 1978 (c. 30) and the Income and Corporation Taxes Act 1988 (c. 1).

“the appointed day” means the day appointed by article 2;

“the Rules” means the Patents Rules 1995(4).

### **Commencement of the 2004 Act**

2. 1st January 2005 is the day appointed for the coming into force of the following provisions of the 2004 Act—

- (a) section 5 (for the purposes of the provisions mentioned in sub-paragraphs (i) and (j) below);
- (b) section 6;
- (c) section 7;
- (d) sections 10 to 12;
- (e) section 14;
- (f) section 16(1) (for the purposes of the provisions mentioned in sub-paragraph (k) below);
- (g) section 16(2) (for the purposes of the entries in Schedule 3 relating to provisions brought into force by this article and to the amendment of section 106 of the 1977 Act);
- (h) section 16(3);
- (i) paragraphs 1, 6, 7 and 8, and paragraph 9(1), (2)(a) and (3), of Schedule 1;
- (j) paragraph 9(2)(b) of Schedule 1 (for the purposes of the Patent Co-operation Treaty);
- (k) paragraphs 1, 5, 8, 10 to 14, 16, 17, 19, 20 to 22, 25, 27 and 28 of Schedule 2.

### **Consequential, incidental and supplementary provisions**

3. The Rules are amended as follows.

4. For rule 9 there is substituted—

#### **“Orders under section 8 or 12**

9.—(1) Where an order is made under section 8 or 12—

- (a) that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant; or
- (b) that a new application for a patent may be made,

the comptroller shall give notice of the making of the order to the original applicant or applicants, and to any of their licensees of whom he is aware.

(2) A person who makes a request under section 11(3) or (3A) must do so before the end of the relevant period.

(3) The relevant period is—

- (a) where the request is made by an original applicant, the period of two months starting on the date the notice is sent to him;
- (b) where the request is made by a licensee, the period of four months starting on the date the notice is sent to him.

(4) In this rule, a reference to section 11 includes a reference to that section as applied by section 12(5).”

5. For rule 13 there is substituted—

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(4) [SI 1995/2093](#), to which amendments relevant to this Order have been made by [SI 1999/3197](#).

**“Reference to the comptroller under section 11(5)**

**13.**—(1) A reference under section 11(5) shall be made on Patents Form 2/77 and shall be accompanied by a copy and by a statement in duplicate setting out fully—

- (a) the question referred;
- (b) the facts upon which the person making the reference relies; and
- (c) the period or terms of the licence which he is prepared to accept or grant.

(2) The comptroller shall send, except to the person who made the reference, a copy of the reference and statement to—

- (a) every person in whose name the application is to proceed or, as the case may be, who makes the new application; and
- (b) every person claiming to be entitled to be granted a licence,

and any such person who receives a copy of the reference and statement may, before the end of the period of six weeks starting on the date the copies were sent to him, file a counter-statement (which must be in duplicate) setting out fully his grounds of objection.

(3) The comptroller shall send a copy of the counter-statement to the person who made the reference.

(4) The comptroller may give such directions as he thinks fit with regard to the subsequent procedure.

(5) In this rule, a reference to section 11 includes a reference to that section as applied by section 12(5).”.

6. For rule 57 there is substituted—

**“Orders under section 37**

**57.**—(1) Where an order is made under section 37—

- (a) that a patent shall be transferred to one or more persons none of whom was an old proprietor; or
- (b) that a person other than an old proprietor may make a new application for a patent,

the comptroller shall give notice of the making of the order to the old proprietor or proprietors, and to any of their licensees of whom he is aware; and a person who makes a request under section 38(3) must do so before the end of the relevant period.

(2) The relevant period is—

- (a) where the request is made by an old proprietor, the period of two months starting on the date the notice is sent to him;
- (b) where the request is made by a licensee, the period of four months starting on the date the notice is sent to him.”.

7. For rule 58 there is substituted—

**“Reference to the comptroller under section 38(5)**

**58.**—(1) A reference under section 38(5) shall be made on Patents Form 2/77 and shall be accompanied by a copy and by a statement in duplicate setting out fully—

- (a) the question referred;
- (b) the facts upon which the person making the reference relies; and
- (c) the period or terms of the licence which he is prepared to accept or grant.

(2) The comptroller shall send, except to the person who made the reference, a copy of the reference and statement to—

- (a) the new proprietor or proprietors or, as the case may be, the new applicant; and
- (b) every person claiming to be entitled to be granted a licence,

and any such person who receives a copy of the reference and statement may, before the end of the period of six weeks starting on the date the copies were sent to him, file a counter-statement (which must be in duplicate) setting out fully his grounds of objection.

(3) The comptroller shall send a copy of the counter-statement to the person who made the reference.

(4) The comptroller may give such directions as he thinks fit with regard to the subsequent procedure.”.

8. In rules 72 and 73, for “plaintiff” (wherever it occurs) there is substituted “claimant”.

### **Transitional provisions**

9.—(1) The following transitional provisions have effect notwithstanding the amendments to the 1977 Act made by the provisions brought into force by article 2, or the amendments to the Rules made by articles 4 and 5.

(2) If before the appointed day a question is referred to the comptroller under section 8 or 12 of the 1977 Act, sections 8, 11 and 12 of that Act and rules 9 and 13 have effect in relation to that reference as if the amendments to those sections and rules had not been made.

(3) Where proceedings are brought under section 70 of the 1977 Act in respect of an alleged threat made before the appointed day, that section has effect in relation to that alleged threat as if the amendments to that section had not been made.

(4) Where proceedings are brought before the appointed day, section 75(1) of the 1977 Act has effect in relation to those proceedings as if the amendment to that subsection had not been made.

(5) Where the national phase (as defined by section 89A(3) of the 1977 Act) of an international application for a patent (UK) begins before the appointed day, section 89B(2) of that Act has effect in relation to that application as if the amendment to that subsection had not been made.

*Sainsbury of Turville,*  
Parliamentary Under-Secretary of State for  
Science and Innovation  
Department of Trade and Industry

29th November 2004

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## EXPLANATORY NOTE

*(This note is not part of the Order)*

Article 2 of this Order brings into force, on 1st January 2005, a number of provisions of the Patents Act 2004, all but one of which make amendments to the Patents Act 1977 (“the 1977 Act”). The Order also makes a number of consequential, incidental or supplementary amendments to the Patents Rules 1995, and makes appropriate transitional provision.

### **Remedies in entitlement proceedings**

Section 6 is brought into force, together with paragraphs 5 and 10 of Schedule 2.

Articles 4 to 7 make consequential amendments to rules 9 and 13, and also restate those rules (and the corresponding rules 57 and 58) in a clearer form.

Article 9(2) contains a transitional provision related to the amendments to sections 8, 11 and 12 of the 1977 Act and to rules 9 and 13. Thus as regards “pre-grant” entitlement questions, the changes will have effect only for questions referred to the comptroller on or after 1st January 2005. No transitional provision is necessary as regards the amendments to section 38 of the 1977 Act or rules 57 and 58, which concern “post-grant” entitlement, as these merely clarify the existing law.

### **Restrictions on applications abroad**

Section 7 is brought into force, together with paragraph 8 of Schedule 2. No transitional provision is necessary.

### **Compensation of employees for certain inventions**

Section 10 is brought into force, together with paragraph 11 of Schedule 2.

A transitional provision is already contained in section 10(8), with the result that the section will apply only to an invention the patent for which is applied for on or after 1st January 2005.

### **Enforcement of damages**

Section 11 is brought into force. No transitional provision is necessary.

### **Threats of infringement proceedings**

Section 12 is brought into force, together with paragraphs 14, 16, 17 and 28 of Schedule 2 (which make consequential terminological amendments).

Article 8 makes consequential terminological amendments to rules 72 and 73.

Article 9(3) contains a transitional provision relating to the amendments to section 70 of the 1977 Act made by section 12. Thus the changes will have effect only in relation to communications alleged to be threats which are made on or after 1st January 2005.

### **Costs and expenses in court proceedings**

Section 14 is brought into force.

A transitional provision is already contained in section 14(4), with the result that the section will apply only to proceedings commenced on or after 1st January 2005.

### **Removal of references to the Community Patent Convention.**

Paragraph 6 of Schedule 1, and paragraphs 12, 13, 20 to 22, 25(c), 25(d) and 27 of Schedule 2, are brought into force. No transitional provision is necessary.

### **Jurisdiction over post-grant amendment**

*Status: This is the original version (as it was originally made). This item of legislation is currently only available in its original format.*

Paragraph 19 of Schedule 2 is brought into force.

*Article 9(4)* contains a transitional provision relating to the amendment of section 75(1). Thus the amended section 75(1) will apply only to proceedings commenced on or after 1st January 2005.

#### **Patent Co-operation Treaty**

Paragraphs 7, 8, 9(2) and 9(3) of Schedule 1 are brought into force, but paragraph 9(2)(b) is brought into force only for the purposes of the Patent Co-operation Treaty. It is not brought into force for the purposes of the European Patent Convention.

*Article 9(5)* contains a transitional provision relating to the amendment of section 89B(2) of the 1977 Act made by paragraph 8 of Schedule 1. Thus the amended section 89B(2) will apply only to international applications which enter the UK national phase on or after 1st January 2005.

#### **Comptroller's annual report**

Section 16(3) and paragraph 25(a) and (b) of Schedule 2 are brought into force. No transitional provision is necessary.

### **NOTE AS TO EARLIER COMMENCEMENT ORDERS**

*(This note is not part of the Order)*

The provisions of the Patents Act 2004 which are set out in the table below have been brought into force before the date of this Order by the Patents Act 2004 (Commencement No. 1 and Consequential and Transitional Provisions) Order 2004 ([SI 2004/2177 \(C. 94\)](#)).

| <i>Provision</i>   | <i>Date of Commencement</i> | <i>S.I. No.</i>           |
|--|-----------------------------|---------------------------|
| Section 16(1) (for the purposes of the provisions of Schedule 2 mentioned below).                | 22nd September 2004         | <a href="#">2004/2177</a> |
| Section 16(2) (for the purposes of the repeals in Schedule 3 corresponding to those provisions). | 22nd September 2004         | <a href="#">2004/2177</a> |
| Paragraph 24 and paragraph 26 of Schedule 2 (except for paragraph 26(2)).                        | 22nd September 2004         | <a href="#">2004/2177</a> |

In addition, paragraphs 7 and 23 of Schedule 2 come into force (pursuant to section 17(2) of the Patents Act 2004) with the commencement of the Regulatory Reform (Patents) Order 2004 ([SI 2004/2357](#)), which like this Order comes into force on 1st January 2005.

A regulatory impact assessment has not been prepared for this instrument, as it has no impact on the costs of business distinct from that of the Patents Act 2004 itself. A regulatory impact assessment for the Patents Bill was placed in the libraries of both Houses of Parliament, and is also available from the Patent Office, Intellectual Property and Innovation Directorate, Concept House, Newport, South Wales, NP10 8QQ.