

SCHEDULES

SCHEDULE 10

SPECIAL TRANSITIONAL PROVISIONS WITH RESPECT TO PATENTS FOR INVENTIONS AND REGISTERED DESIGNS

PART I

PATENTS FOR INVENTIONS

- 1 For the purposes of so much of section 32(1) of the Patents Act 1949 as provides that a patent may be revoked on the grounds that the invention, so far as claimed in any claim of the complete specification, was secretly used in the United Kingdom before the priority date of that claim, no account shall be taken of any use, on or after the appointed day, of the invention by the Post Office or a person authorised by it, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly.—
- (a) before the appointed day, to a government department or person authorised by a government department; or
 - (b) on or after the appointed day, in pursuance of an agreement in the case of which rights and liabilities thereunder vest in the Post Office by virtue of sections 16 to 18 of this Act, to the Post Office or a person authorised by it.
- 2 (1) Where an agreement in the case of which rights and liabilities thereunder vest in the Post Office by virtue of sections 16 to 18 of this Act contains provision—
- (a) conferring authority under section 46(1) of the Patents Act 1949 for the making, use or exercise of an invention for a purpose referable to the functions of the Postmaster General; or
 - (b) providing for the conferring by the Postmaster General on a person of such an authority under that section,
- then, on and after the appointed day.—
- (i) the authority conferred by the agreement, and any authority conferred before that day in pursuance of such a provision as is mentioned in head (b) above, shall continue in force and shall have effect so as to authorise the making, use and exercise of the invention for a purpose referable to the functions of the Post Office, being a purpose corresponding to that mentioned in head (a) above ; and
 - (ii) the provision described in head (b) above shall have effect as if it provided for the conferring by the Post Office of an authority having such effect as is mentioned in the last foregoing head.
- (2) For the purpose of fulfilling obligations imposed on it by virtue of this paragraph, the Post Office shall, on and after the appointed day, have power to confer such an authority as is mentioned in head (ii) of the foregoing sub-paragraph.

- (3) Nothing in the Patents Act 1949 shall be taken to prevent the use by the Post Office, for a purpose referable to its functions, of any articles made and supplied to it in the exercise of an authority continued in force by, or conferred by virtue of, this paragraph.
- 3 Where, by an agreement in force immediately before the appointed day and made in pursuance of subsection (3) of section 46 of the Patents Act 1949, terms are agreed upon which use of an invention may be made by virtue of that section for the manufacture of articles by the department of the Postmaster General, or the manufacture and supply to that department of articles by a person authorised by it.—
- (a) the agreement shall (so far as it relates to the use of the invention by, or with the authority of, that department) have effect as from the appointed day as if, for any reference to use by virtue of that section, whether or not it is expressed to be for any purpose referable to functions of the Postmaster General, there were substituted a reference to use by virtue of this paragraph for any purpose referable to functions of the Post Office corresponding to a purpose referable to functions of the Postmaster General, being a purpose in the case of which use of the invention therefor fell within the agreement, and the rights and liabilities of the Postmaster General subsisting immediately before the appointed day under the agreement shall, on that day, vest in the Post Office by virtue of this paragraph, and paragraph 2 of Schedule 9 to this Act shall apply as it does where rights and liabilities so vest by virtue of sections 16 to 18 of this Act;
- (b) the Post Office shall have power to use the invention for the manufacture of articles on the terms of the agreement as it has effect by virtue of this paragraph, and any person authorised by the Post Office in writing shall have power to use the invention for manufacture and supply to the Post Office on such terms, and the Post Office shall, accordingly, have power to use, for purposes referable to its functions, articles so manufactured by, or supplied to, it.
- 4 (1) If an obligation of the department of the Postmaster General incurred under section 46(5) of the Patents Act 1949 to give a notification or furnish information to a person has not been fulfilled before the appointed day, the Post Office shall, on that day, become under obligation to give the notification or furnish the information to that person ; and the Post Office shall, on and after that day, be under obligation to furnish to any person who requires it such other information as to the extent of use before that day of an invention as that department could have been required under the said section 46(5) to furnish to that person if this Act had not passed.
- (2) Subject to sub-paragraph (4) below, where, on or after the appointed day, use of an invention is begun under an authority continued in force by, or conferred by virtue of, paragraph 2 of this Schedule, the Post Office shall notify the patentee as soon as practicable after the use is begun.
- (3) Subject as aforesaid, the Post Office shall furnish the patentee with such information as he may from time to time require as to the extent of use, if any, of the invention after the beginning of the appointed day under such an authority as is mentioned in the last foregoing sub-paragraph or by virtue of paragraph 3 of this Schedule.
- (4) Nothing in the foregoing provisions of this paragraph shall impose on the Post Office an obligation to give notification or furnish information if the Minister notifies it that it is contrary to the public interest to do so.

- 5 Where, in the case of an invention, an authority for its use is continued in force by, or is conferred by virtue of, paragraph 2 of this Schedule, then—
- (a) if and so far as the invention has, before the priority date of the relevant claim of the complete specification, been duly recorded by or tried by or on behalf of a government department otherwise than in consequence of the communication thereof, directly or indirectly, by the patentee or a person from whom he derives title, any use of the invention by virtue of the said paragraph 2 may be made free of any royalty or other payment to the patentee;
 - (b) if and so far as the invention has not been so recorded or tried as aforesaid, any use of the invention by virtue of the said paragraph 2 at any time after the acceptance of the complete specification in respect of the patent or in consequence of any such communication as aforesaid, shall—
 - (i) except where an agreement as to terms for the use of the invention was made before the appointed day under section 46(3) of the Patents Act 1949 or a determination as to those terms was made by the court under section 48 of that Act, be made upon such terms as may be agreed upon, either before or after the use, between the Post Office and the patentee, or as may, in default of such an agreement, be determined by the court on a reference under paragraph 9 of this Schedule ;
 - (ii) in the said excepted case, be made upon the terms of the said agreement or determination.
- 6 The authority of the Post Office in respect of an invention may be given under paragraph 2 or 3 of this Schedule either before or after the patent is granted and either before or after the acts in respect of which the authority is given are done, but not so as to authorise the doing before the appointed day of any act; and such authority may be given to any person whether or not he is authorised, directly or indirectly, by the patentee to make, use, exercise or vend the invention.
- 7 (1) The Post Office shall have power to use, for a purpose referable to its functions, any article vested in it and made before the appointed day, in the exercise of the powers conferred by section 46 of the Patents Act 1949, by a government department, or a person authorised by a government department.
- (2) In the case of articles described in the foregoing sub-paragraph, and articles vested in the Post Office and made on or after the appointed day under an authority continued in force by, or conferred by virtue of, paragraph 2 of this Schedule, the Post Office, if the circumstances are such that their supply to the government of a country outside the United Kingdom is, by virtue of section 46(6) of the Patents Act 1949 included among the services of the Crown, shall have power to sell them to that government, and if the circumstances are such that their supply to the United Nations is, by virtue of that section, so included, shall have power to sell them to that organisation.
- (3) In the case of articles mentioned in the last foregoing sub-paragraph and articles vested in the Post Office and made on or after the appointed day by virtue of paragraph 3 of this Schedule, the Post Office shall have power to sell to any person such, if any, of them as are not required for a purpose referable to functions of the Post Office.
- (4) The purchaser of any articles sold in the exercise of powers conferred by this paragraph, and any person claiming through him, shall have power to deal with them in the same manner as if the patent were held by or on behalf of the Post Office.

- 8 (1) In relation to any use of a patented invention or an invention in respect of which an application for a patent is pending, being a use made on or after the appointed day for purposes referable to functions of the Post Office—
- (a) by the Post Office under any power conferred by, or by virtue of, the foregoing provisions of this Act, or by its using articles supplied to it by the patentee or applicant for the patent under an agreement in the case of which rights and liabilities thereunder vest in the Post Office by virtue of sections 16 to 18 of this Act;
 - (b) by a person authorised by an authority continued in force by paragraph 2 above or conferred by virtue of that paragraph or paragraph 3 above ;
 - (c) by the patentee or applicant for the patent, for the purpose of satisfying a liability under an agreement in the case of which rights and liabilities thereunder vest in the Post Office by virtue of sections 16 to 18 of this Act ;
- the provisions of any licence, assignment or agreement made—
- (i) before the appointed day, between the patentee or applicant for the patent or any person who derives title from him or from whom he derives title, and any person other than a government department; or
 - (ii) on or after the appointed day, between the patentee or applicant for the patent or any person who derives title from him or from whom he derives title, and any person other than the Post Office ;
- shall be of no effect so far as those provisions restrict or regulate the use of the invention, or any model, document or information relating thereto, or provide for the making of payments in respect of any such use, or calculated by reference thereto ; and the reproduction or publication of any model or document in connection with the said use shall not be deemed to be an infringement of any copyright subsisting in the model or document.
- (2) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the use of the invention is in force under the patent, then—
- (a) in relation to any use of the invention which, but for the provisions of this paragraph and paragraph 2 of this Schedule would constitute an infringement of the rights of the licensee, paragraph 5 of this Schedule shall have effect as if, for the reference in sub-paragraph (b) thereof to the patentee, there were substituted a reference to the licensee; and
 - (b) in relation to any use of the invention by the licensee by virtue of an authority continued in force by, or conferred by virtue of, paragraph 2 of this Schedule, paragraph 5 thereof shall have effect as if sub-paragraph (b) were omitted.
- (3) Subject to the provisions of the last foregoing sub-paragraph, where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention, then—
- (a) in relation to any use of the invention by virtue of paragraph 2 of this Schedule, paragraph 5 thereof shall have effect as if, in sub-paragraph (b), the reference to the patentee included a reference to the assignor, and any sum payable by virtue of that paragraph or an agreement referred to in paragraph 3 of this Schedule shall—
 - (i) except where an agreement was made before the appointed day between the patentee and the assignor as to the proportions in which any sum payable in relation to the use of the invention by or

under the authority of the department of the Postmaster General by virtue of section 46 of the Patents Act 1949 should be divided or a determination as to those proportions was made by the court under section 48 of that Act before the appointed day, be divided between the patentee and the assignor in such proportions as may be agreed between them or as may in default of agreement be determined by the court on a reference under paragraph 9 of this Schedule ;

- (ii) in the said excepted case, be divided in such proportions as may be provided for by the said agreement or determination ; and
 - (b) in relation to any use of the invention made after the beginning of the appointed day, being use referable to the functions of the Post Office and made by the patentee for the purpose mentioned in sub-paragraph (1)(c) above, paragraph 5(b) of this Schedule shall have effect as if that use were made by virtue of an authority continued in force by paragraph 2 of this Schedule.
- (4) Where, under paragraph 5 of this Schedule or such an agreement as is referred to in paragraph 3 thereof, payments are required to be made by the Post Office to a patentee in respect of any use of an invention, any person, being the holder of an exclusive licence under the patent (not being such a licence as is mentioned in sub-paragraph (2) of this paragraph) authorising him to make that use of the invention, shall—
- (a) except where an agreement as to the recovery from the patentee of a part of the payments made under section 46(3) of the Patents Act 1949 by the department of the Postmaster General in respect of the use of the invention was made before the appointed day under section 47(4) of that Act or a determination was made before that day under section 48 of that Act by the court as to such recovery, be entitled to recover from the patentee such part (if any) of those payments as may be agreed upon between that person and the patentee or as may, in default of agreement, be determined by the court on a reference under paragraph 9 of this Schedule to be just having regard to any expenditure incurred by that person—
 - (i) in developing the said invention, or
 - (ii) in making payments to the patentee, other than royalties or other payments determined by reference to the use of the invention, in consideration of the licence;
 - (b) in the said excepted case, be entitled to recover such part, if any, of the payments as may be provided for by the said agreement or determination ;
- and if that person, at any time before the amount of any such payment has been settled, gives to the Post Office notice in writing of his interest, any agreement as to the amount of that payment shall be of no effect unless it is made with his consent; and, for the purposes of this sub-paragraph, a notice given before the appointed day to the department of the Postmaster General in pursuance of section 47(4) of the Patents Act 1949 shall have effect as if it had been given to the Post Office.
- (5) Where any models, documents or information relating to an invention are used in connection with any such use of the invention as is described in sub-paragraph (1) above, paragraph 5 of this Schedule shall, whether or not it applies to the use of the invention, apply to the use of the models, documents or information as if, for the reference therein to the patentee, there were substituted a reference to the person entitled to the benefit of any provision of a licence, assignment or agreement which is rendered inoperative by the said sub-paragraph (1) in relation to that use.

- (6) Nothing in this paragraph shall be construed as authorising the disclosure to the Post Office or any other person of any model, document or information to the use of which this paragraph applies in contravention of any such licence, assignment or agreement as aforesaid.
- 9 (1) Any dispute as to the exercise by the Post Office or a person authorised by it of powers subsisting by virtue of the foregoing provisions of this Schedule, or as to terms for use thereunder of an invention or any models, documents or information relating to an invention, or as to the right of any person to receive any part of a payment made in pursuance of paragraph 5 of this Schedule or any such agreement as is referred to in paragraph 3 thereof may be referred to the court by either party to the dispute in such manner as is prescribed by the rules for the time being in force for the purposes of section 48(1) of the Patents Act 1949.
- (2) Subsections (2) to (5) of section 48 of the Patents Act 1949 shall have effect in relation to proceedings under the foregoing sub-paragraph and disputes that may be determined thereunder as they do in relation to proceedings and disputes that may be determined under subsection (1) of the said section 48, but subject to the modifications that—
- (a) in subsection (2), for references to a government department there shall be substituted references to the Post Office;
 - (b) in subsection (3), for the references to section 46 of that Act and to the opinion of the government department there shall be substituted respectively references to paragraph 5(a) of this Schedule and to the opinion of the Minister stated in a certificate signed by him ; and
 - (c) in subsection (4), for the first reference to a government department there shall be substituted a reference to the Post Office, for the second such reference there shall be substituted a reference to the department of the Postmaster General or the Post Office, and the reference to the services of the Crown shall include a reference to the purposes of the Post Office.
- (3) Any proceedings under the said section 48 which are in progress immediately before the appointed day, being proceedings to which the department of the Postmaster General is a party, may be continued with the substitution of the Post Office for that department; but in relation to such proceedings, subsection (3) of the said section 48 shall have effect with the substitution, for the reference to the opinion of a government department, of a reference to the opinion of the Minister stated in a certificate signed by him.
- 10 (1) Where, in pursuance of an agreement made before the appointed day in relation to an invention claimed under a complete specification, between the department of the Postmaster General and the applicant for the patent, or any person from whom he derives title, being an agreement to which the Post Office has become a party by virtue of this Act, communication of the invention is made to the Post Office or a person authorised by it to investigate the invention or its merits, the invention shall not be deemed to have been anticipated by reason only of that communication or of anything done in consequence thereof for the purposes of the investigation.
- (2) An authorisation to investigate an invention given under subsection (1) of section 51 of the Patents Act 1949 by the department of the Postmaster General and in force immediately before the appointed day shall remain in force on and after that day as if given by the Post Office and, in relation to that invention, the said subsection (1) shall have effect as if references to a government department included references to the Post Office.

- 11 Expressions to which meanings are assigned by the Patents Act 1949 for the purposes of that Act have those meanings also for the purposes of this Part of this Schedule.