



# Patents Act 1977

## 1977 CHAPTER 37

An Act to establish a new law of patents applicable to future patents and applications for patents; to amend the law of patents applicable to existing patents and applications for patents; to give effect to certain international conventions on patents; and for connected purposes. [29th July 1977]

BE IT ENACTED by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

### PART I

#### NEW DOMESTIC LAW

##### *Patentability*

#### **1 Patentable inventions**

- (1) A patent may be granted only for an invention in Patentable respect of which the following conditions are satisfied, that is to inventions, say—
  - (a) the invention is new;
  - (b) it involves an inventive step ;
  - (c) it is capable of industrial application ;
  - (d) the grant of a patent for it is not excluded by subsections (2) and (3) below ;and references in this Act to a patentable invention shall be construed accordingly
- (2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of—
  - (a) a discovery, scientific theory or mathematical method ;

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- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
- (d) the presentation of information;

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

- (3) A patent shall not be granted—
  - (a) for an invention the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour ;
  - (b) for any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro-biological process or the product of such a process.
- (4) For the purposes of subsection (3) above behaviour shall not be regarded as offensive, immoral or anti-social only because it is prohibited by any law in force in the United Kingdom or any part of it.
- (5) The Secretary of State may by order vary the provisions of subsection (2) above for the purpose of maintaining them in conformity with developments in science and technology; and no such order shall be made unless a draft of the order has been laid before, and approved by resolution of, each House of Parliament.

## 2 Novelty

- (1) An invention shall be taken to be new if it does not form part of the state of the art.
- (2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.
- (3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following' conditions are satisfied, that is to say—
  - (a) that matter was contained in the application for that other patent both as filed and as published; and
  - (b) the priority date of that matter is earlier than that of the invention.
- (4) For the purposes of this section the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring later than the beginning of the period of six months immediately preceding the date of filing the application for the patent and either—
  - (a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person—
    - (i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or

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- (ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) above or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;
  - (b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor ; or
  - (c) the disclosure was due to, or made in consequence of the inventor displaying the invention at an international exhibition and the applicant states, on filing the application, that the invention has been so displayed and also, within the prescribed period, files written evidence in support of the statement complying with any prescribed conditions.
- (5) In this section references to the inventor include references to any proprietor of the invention for the time being.
- (6) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

### **3 Inventive step**

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

### **4 Industrial application**

- (1) Subject to subsection (2) below, an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture.
- (2) An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.
- (3) Subsection (2) above shall not prevent a product consisting of a substance or composition being treated as capable of industrial application merely because it is invented for use in any such method.

### **5 Priority date**

- (1) For the purposes of this Act the priority date of an invention to which an application for a patent relates and also of any matter (whether or not the same as the invention) contained in any such application is, except as provided by the following provisions of this Act, the date of filing the application.
- (2) If in or in connection with an application for a patent (the application in suit) a declaration is made, whether by the applicant or any predecessor in title of his, complying with the relevant requirements of rules and specifying one or more earlier

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relevant applications for the purposes of this section made by the applicant or a predecessor in title of his and each having a date of filing during the period of twelve months immediately preceding the date of filing the application in suit, then—

- (a) if an invention to which the application in suit relates is supported by matter disclosed in the earlier relevant application or applications, the priority date of that invention shall instead of being the date of filing the application in suit be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them;
  - (b) the priority date of any matter contained in the application in suit which was also disclosed in the earlier relevant application or applications shall be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.
- (3) Where an invention or other matter contained in the application in suit was also disclosed in two earlier relevant applications filed by the same applicant as in the case of the application in suit or a predecessor in title of his and the second of those relevant applications was specified in or in connection with the application in suit, the second of those relevant applications shall, so far as concerns that invention or matter, be disregarded unless—
- (a) it was filed in or in respect of the same country as the first; and
  - (b) not later than the date of filing the second, the first (whether or not so specified) was unconditionally withdrawn, or was abandoned or refused, without—
    - (i) having been made available to the public (whether in the United Kingdom or elsewhere);
    - (ii) leaving any rights outstanding; and
    - (iii) having served to establish a priority date in relation to another application, wherever made.
- (4) The foregoing provisions of this section shall apply for determining the priority date of an invention for which a patent has been granted as they apply for determining the priority date of an invention to which an application for that patent relates.
- (5) In this section " relevant application " means any of the following applications which has a date of filing, namely—
- (a) an application for a patent under this Act;
  - (b) an application in or for a convention country (specified under section 90 below) for protection in respect of an invention or an application which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to such an application.

## **6 Disclosure of matter, etc., between earlier and later applications**

(1) It is hereby declared for the avoidance of doubt that where an application (the application in suit) is made for a patent and a declaration is made in accordance with section 5(2) above in or in connection with that application specifying an earlier relevant application, the application in suit and any patent granted in pursuance of it shall not be invalidated by reason only of relevant intervening acts.

(2) In this section—

" relevant application " has the same meaning as in section 5 above; and

" relevant intervening acts " means acts done in relation to matter disclosed in an earlier relevant application between the dates of the earlier relevant application and the application in suit, as for example, filing another application for the invention for which the earlier relevant application was made, making information available to the public about that invention or that matter or working that invention, but disregarding any application, or the disclosure to the public of matter contained in any application, which is itself to be disregarded for the purposes of section 5(3) above.

*Right to apply for and obtain a patent and be mentioned as inventor*

## **7 Right to apply for and obtain a patent**

- (1) Any person may make an application for a patent either alone or jointly with another.
- (2) A patent for an invention may be granted—
  - (a) primarily to the inventor or joint inventors;
  - (b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;
  - (c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned;and to no other person.
- (3) In this Act " inventor " in relation to an invention means the actual deviser of the invention and " joint inventor " shall be construed accordingly.
- (4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

## **8 Determination before grant of questions about entitlement to patents, etc.**

- (1) At any time before a patent has been granted for an invention (whether or not an application has been made for it)—
  - (a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or
  - (b) any of two or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.
- (2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and

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before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below,—

- (a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;
  - (b) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly;
  - (c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred;
  - (d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.
- (3) Where a question is referred to the comptroller under subsection (1)(a) above and—
- (a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;
  - (b) any such application is refused under subsection 2(c) above before the comptroller has disposed of the reference (whether the reference was made before or after the publication of the application); or
  - (c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference, but after the publication of the application;

the comptroller may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 76 below, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.

- (4) Where a person refers a question under subsection (1)(b) above relating to an application, any order under subsection (1) above may contain directions to any person for transferring or granting any right in or under the application.
- (5) If any person to whom directions have been given under subsection (2)(d) or (4) above fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the comptroller may, on application made to him by any person in whose favour or on whose reference the directions were given, authorise him to do that thing on behalf of the person to whom the directions were given.
- (6) Where on a reference under this section it is alleged that, by virtue of any transaction, instrument or event relating to an invention or an application for a patent, any person other than the inventor or the applicant for the patent has become entitled to be granted (whether alone or with any other persons) a patent for the invention or has or would have any right in or under any patent so granted or any application for any such patent, an order shall not be made under subsection (2)(a), (b) or (d) above on the reference unless notice of the reference is given to the applicant and any such person, except any of them who is a party to the reference.
- (7) If it appears to the comptroller on a reference of a question under this section that the question involves matters which would more properly be determined by the court,

he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so.

- (8) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

## **9 Determination after grant of questions referred before grant**

If a question with respect to a patent or application is referred by any person to the comptroller under section 8 above, whether before or after the making of an application for the patent, and is not determined before the time when the application is first in order for a grant of a patent in pursuance of the application, that fact shall not prevent the grant of a patent, but on its grant that person shall be treated as having referred to the comptroller under section 37 below any question mentioned in that section which the comptroller thinks appropriate.

## **10 Handling of application by joint applicants**

If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the comptroller may, on a request made by any of the parties, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require.

## **11 Effect of transfer of application under s. 8 or 10**

- (1) Where an order is made or directions are given under section 8 or 10 above that an application for a patent shall proceed in the name of one or some of the original applicants (whether or not it is also to proceed in the name of some other person), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under either of those sections, continue in force and be treated as granted by the persons in whose name the application is to proceed.
- (2) Where an order is made or directions are given under section 8 above that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant (on the ground that the original applicant or applicants was or were not entitled to be granted the patent), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under that section and subject to subsection (3) below, lapse on the registration of that person or those persons as the applicant or applicants or, where the application has not been published, on the making of the order.
- (3) If before registration of a reference under section 8 above resulting in the making of any order mentioned in subsection (2) above—
- (a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in the United Kingdom or made effective and serious preparations to do so; or
  - (b) a licensee of the applicant, acting in good faith, worked the invention in the United Kingdom or made effective and serious preparations to do so ;

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that or those original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention.

- (4) Any such licence shall be granted for a reasonable period and on reasonable terms.
- (5) Where an order is made as mentioned in subsection (2) above, the person in whose name the application is to proceed or any person claiming that he is entitled to be granted any such licence may refer to the comptroller the question whether the latter is so entitled and whether any such period is or terms are reasonable, and the comptroller shall determine the question and may, if he considers it appropriate, order the grant of such a licence.

## **12 Determination of questions about entitlement to foreign and convention patents, etc.**

- (1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made)—
  - (a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or
  - (b) any of two or more co-proprietors of an application for such a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;
 and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.
- (2) If it appears to the comptroller on a reference of a question under this section that the question involves matters which would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so.
- (3) Subsection (1) above, in its application to a European patent and an application for any such patent, shall have effect subject to section 82 below.
- (4) Section 10 above, except so much of it as enables the comptroller to regulate the manner in which an application is to proceed, shall apply to disputes between joint applicants for any such patent as is mentioned in subsection (1) above as it applies to joint applicants for a patent under this Act.
- (5) Section 11 above shall apply in relation to—
  - (a) any orders made under subsection (1) above and any directions given under section 10 above by virtue of subsection (4) above ; and
  - (b) any orders made and directions given by the relevant convention court with respect to a question corresponding to any question which may be determined under subsection (1) above;
 as it applies to orders made and directions given apart from this section under section 8 or 10 above.
- (6) In the following cases, that is to say—



- (a) where an application for a European patent (UK) is refused or withdrawn, or the designation of the United Kingdom in the application is withdrawn, after publication the application but before a question relating to the right to the patent has been referred to the comptroller under subsection (1) above or before proceedings relating to that right have begun before the relevant convention court;
- (b) where an application has been made for a European patent (UK) and on a reference under subsection (1) above or any such proceedings as are mentioned in paragraph (a) above the comptroller, the court or the relevant convention court determines by a final decision (whether before or after publication of the application) that a person other than the applicant has the right to the patent, but that person requests the European Patent Office that the application for the patent should be refused; or
- (c) where an international application for a patent (UK) is withdrawn, or the designation of the United Kingdom in the application is withdrawn, whether before or after the making of any reference under subsection (1) above but after publication of the application ;

the comptroller may order that any person (other than the applicant) appearing to him to be entitled to be granted a patent under this Act may within the prescribed period make an application for such a patent for the whole or part of any matter comprised in the earlier application (subject, however, to section 76 below) and that if the application for a patent under this Act is filed, it shall be treated as having been filed on the date of filing the earlier application.

(7) In this section—

- (a) references to a patent and an application for a patent include respectively references to protection in respect of an invention and an application which, in accordance with the law of any country other than the United Kingdom or any treaty or international convention, is equivalent to an application for a patent or for such protection; and
- (b) a decision shall be taken to be final for the purposes of this section when the time for appealing from it has expired without an appeal being brought or, where an appeal is brought, when it is finally disposed of.

### **13 Mention of inventor**

- (1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.
- (2) Unless he has already given the Patent Office the information hereinafter mentioned, an applicant for a patent shall within the prescribed period file with the Patent Office a statement—
  - (a) identifying the person or persons whom he believes to be the inventor or inventors ; and
  - (b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent;and, if he fails to do so, the application shall be taken to be withdrawn.

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- (3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate ; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.

### *Applications*

## **14 Making of application**

- (1) Every application for a patent—
- (a) shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner ; and
  - (b) shall be accompanied by the fee prescribed for the purposes of this subsection (hereafter in this Act referred to as the filing fee).
- (2) Every application for a patent shall contain—
- (a) a request for the grant of a patent;
  - (b) a specification containing a description of the invention, a claim or claims and any drawing referred to in the description or any claim ; and
  - (c) an abstract;
- but the foregoing provision shall not prevent an application being initiated by documents complying with section 15(1) below.
- (3) The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.
- (4) Without prejudice to subsection (3) above, rules may prescribe the circumstances in which the specification of an application which requires for its performance the use of a micro-organism is to be treated for the purposes of this Act as complying with that subsection.
- (5) The claim or claims shall—
- (a) define the matter for which the applicant seeks protection ;
  - (b) be clear and concise ;
  - (c) be supported by the description ; and
  - (d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.
- (6) Without prejudice to the generality of subsection (5)(d) above, rules may provide for treating two or more inventions as being so linked as to form a single inventive concept for the purposes of this Act.
- (7) The purpose of the abstract is to give technical information and on publication it shall not form part of the state of the art by virtue of section 2(3) above, and the comptroller may determine whether the abstract adequately fulfils its purpose and, if it does not, may reframe it so that it does.
- (8) Rules may require a person who has made an application for a patent for an invention which requires for its performance the use of a micro-organism not to impose or

maintain in the prescribed circumstances any restrictions on the availability to the public of samples of the micro-organism and the uses to which they may be put, subject, however, to any prescribed exceptions, and rules may provide that in the event of a contravention of any provision included in the rules by virtue of this subsection the specification shall be treated for the purposes of this Act as not disclosing the invention in a manner required by subsection (3) above.

- (9) An application for a patent may be withdrawn at any time before the patent is granted and any withdrawal of such an application may not be revoked.

## **15 Date of filing application**

- (1) The date of filing an application for a patent shall, subject to the following provisions of this Act, be taken to be the earliest date on which the following conditions are satisfied in relation to the application, that is to say—
- (a) the documents filed at the Patent Office contain an indication that a patent is sought in pursuance of the application;
  - (b) those documents identify the applicant or applicants for the patent;
  - (c) those documents contain a description of the invention for which a patent is sought (whether or not the description complies with the other provisions of this Act and with any relevant rules); and
  - (d) the applicant pays the filing fee.
- (2) If any drawing referred to in any such application is filed later than the date which by virtue of subsection (1) above is to be treated as the date of filing the application, but before the beginning of the preliminary examination of the application under section 17 below, the comptroller shall give the applicant an opportunity of requesting within the prescribed period that the date on which the drawing is filed shall be treated for the purposes of this Act as the date of filing the application, and—
- (a) if the applicant makes any such request, the date of filing the drawing shall be so treated; but
  - (b) otherwise any reference to the drawing in the application shall be treated as omitted.
- (3) If on the preliminary examination of an application under section 17 below it is found that any drawing referred to in the application has not been filed, then—
- (a) if the drawing is subsequently filed within the prescribed period, the date on which it is filed shall be treated for the purposes of this Act as the date of filing the application; but
  - (b) otherwise any reference to the drawing in the application shall be treated as omitted.
- (4) Where, after an application for a patent has been filed and before the patent is granted, a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application and the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below) the new application shall be treated as having, as its date of filing, the date of filing the earlier application.
- (5) An application which has a date of filing by virtue of the foregoing provisions of this section shall be taken to be withdrawn at the end of the relevant prescribed period, unless before that end the applicant—

- (a) files at the Patent Office one or more claims for the purposes of the application and also the abstract; and
- (b) makes a request for a preliminary examination and search under the following provisions of this Act and pays the search fee.

## **16 Publication of application**

- (1) Subject to section 22 below, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the comptroller shall, unless the application is withdrawn or refused before preparations for its publication have been completed by the Patent Office, publish it as filed (including not only the original claims but also any amendments of those claims and new claims subsisting immediately before the completion of those preparations) and he may, if so requested by the applicant, publish it as aforesaid during that period, and in either event shall advertise the fact and date of its publication in the journal.
- (2) The comptroller may omit from the specification of a published application for a patent any matter—
  - (a) which in his opinion disparages any person in a way likely to damage him, or
  - (b) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

### *Examination and search*

## **17 Preliminary examination and search**

- (1) Where an application for a patent has a date of filing and is not withdrawn, and before the end of the prescribed period—
  - (a) a request is made by the applicant to the Patent Office in the prescribed form for a preliminary examination and a search; and
  - (b) the prescribed fee is paid for the examination and search (the search fee);the comptroller shall refer the application to an examiner for a preliminary examination and search, except that he shall not refer the application for a search until it includes one or more claims.
- (2) On a preliminary examination of an application the examiner shall determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act and shall report his determination to the comptroller.
- (3) If it is reported to the comptroller under subsection (2) above that not all the formal requirements are complied with, he shall give the applicant an opportunity to make observations on the report and to amend the application within a specified period (subject to section 15(5) above) so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to do so the comptroller may refuse the application.
- (4) Subject to subsections (5) and (6) below, on a search requested under this section, the examiner shall make such investigation as in his opinion is reasonably practicable and necessary for him to identify the documents which he thinks will be needed to decide, on a substantive examination under section 18 below, whether the invention for which a patent is sought is new and involves an inventive step.

- (5) On any such search the examiner shall determine whether or not the search would serve any useful purpose on the application as for the time being constituted and—
- (a) if he determines that it would serve such a purpose in relation to the whole or part of the application, he shall proceed to conduct the search so far as it would serve such a purpose and shall report on the results of the search to the comptroller ; and
  - (b) if he determines that the search would not serve such a purpose in relation to the whole or part of the application, he shall report accordingly to the comptroller;
- and in either event the applicant shall be informed of the examiner's report.
- (6) If it appears to the examiner, either before or on conducting a search under this section, that an application relates to two or more inventions, but that they are not so linked as to form a single inventive concept, he shall initially only conduct a search in relation to the first invention specified in the claims of the application, but may proceed to conduct a search in relation to another invention so specified if the applicant pays the search fee in respect of the application so far as it relates to that other invention.
- (7) After a search has been requested under this section for an application the comptroller may at any time refer the application to an examiner for a supplementary search, and subsection (4) above shall apply in relation to a supplementary search as it applies in relation to any other search under this section.

## **18 Substantive examination and grant or refusal of patent**

- (1) Where the conditions imposed by section 17(1) above for the comptroller to refer an application to an examiner for a preliminary examination and search are satisfied and at the time of the request under that subsection or within the prescribed period—
- (a) a request is made by the applicant to the Patent Office in the prescribed form for a substantive examination; and
  - (b) the prescribed fee is paid for the examination;
- the comptroller shall refer the application to an examiner for a substantive examination; and if no such request is made or the prescribed fee is not paid within that period, the application shall be treated as having been withdrawn at the end of that period.
- (2) On a substantive examination of an application the examiner shall investigate, to such extent as he considers necessary in view of any examination and search carried out under section 17 above, whether the application complies with the requirements of this Act and the rules and shall determine that question and report his determination to the comptroller.
- (3) If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.
- (4) If the examiner reports that the application, whether as originally filed or as amended in pursuance of section 17 above, this section or section 19 below, complies with those requirements at any time before the end of the prescribed period, the comptroller shall

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notify the applicant of that fact and, subject to subsection (5) and sections 19 and 22 below and on payment within the prescribed period of any fee prescribed for the grant, grant him a patent.

- (5) Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

## **19 General power to amend application before grant**

- (1) At any time before a patent is granted in pursuance of an application the applicant may, in accordance with the prescribed conditions and subject to section 76 below, amend the application of his own volition.
- (2) The comptroller may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a patent so as to acknowledge a registered trade mark.

## **20 Failure of application**

- (1) If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.
- (2) If at the end of that period an appeal to the court is pending in respect of the application or the time within which such an appeal could be brought has not expired, that period—
- (a) where such an appeal is pending, or is brought within the said time or before the expiration of any extension of that time granted (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, shall be extended until such date as the court may determine;
  - (b) where no such appeal is pending or is so brought, shall continue until the end of the said time or, if any extension of that time is so granted, until the expiration of the extension or last extension so granted.

## **21 Observations by third party on patentability**

- (1) Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations, and the comptroller shall consider the observations in accordance with rules.
- (2) It is hereby declared that a person does not become a party to any proceedings under this Act before the comptroller by reason only that he makes observations under this section.

*Security and safety*

**22 Information prejudicial to defence of realm or safety of public**

- (1) Where an application for a patent is filed in the Patent Office (whether under this Act or any treaty or international convention to which the United Kingdom is a party and whether before or after the appointed day) and it appears to the comptroller that the application contains information of a description notified to him by the Secretary of State as being information the publication of which might be prejudicial to the defence of the realm, the comptroller may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons.
- (2) If it appears to the comptroller that any application so filed contains information the publication of which might be prejudicial to the safety of the public, he may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons until the end of a period not exceeding three months from the end of the period prescribed for the purposes of section 16 above.
- (3) While directions are in force under this section with respect to an application—
  - (a) if the application is made under this Act, it may proceed to the stage where it is in order for the grant of a patent, but it shall not be published and that information shall not be so communicated and no patent shall be granted in pursuance of the application;
  - (b) if it is an application for a European patent, it shall not be sent to the European Patent Office; and
  - (c) if it is an international application for a patent, a copy of it shall not be sent to the International Bureau or any international searching authority appointed under the Patent Co-operation Treaty.
- (4) Subsection (3)(b) above shall not prevent the comptroller from sending the European Patent Office any information which it is his duty to send that office under the European Patent Convention.
- (5) Where the comptroller gives directions under this section with respect to any application, he shall give notice of the application and of the directions to the Secretary of State, and the following provisions shall then have effect:—
  - (a) the Secretary of State shall, on receipt of the notice, consider whether the publication of the application or the publication or communication of the information in question would be prejudicial to the defence of the realm or the safety of the public ;
  - (b) if the Secretary of State determines under paragraph (a) above that the publication of the application or the publication or communication of that information would be prejudicial to the safety of the public, he shall notify the comptroller who shall continue his directions under subsection (2) above until they are revoked under paragraph (e) below;
  - (c) if the Secretary of State determines under paragraph (a) above that the publication of the application or the publication or communication of that information would be prejudicial to the defence of the realm or the safety of the public, he shall (unless a notice under paragraph (d) below has previously been given by the Secretary of State to the comptroller) reconsider

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- that question during the period of nine months from the date of filing the application and at least once in every subsequent period of twelve months;
- (d) if on consideration of an application at any time it appears to the Secretary of State that the publication of the application or the publication or communication of the information contained in it would not, or would no longer, be prejudicial to the defence of the realm or the safety of the public, he shall give notice to the comptroller to that effect; and
  - (e) on receipt of such a notice the comptroller shall revoke the directions and may, subject to such conditions (if any) as he thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired.
- (6) The Secretary of State may do the following for the purpose of enabling him to decide the question referred to in subsection (5)(c) above—
- (a) where the application contains information relating to the production or use of atomic energy or research into matters connected with such production or use, he may at any time do one or both of the following, that is to say, inspect and authorise the United Kingdom Atomic Energy Authority to inspect the application and any documents sent to the comptroller in connection with it; and
  - (b) in any other case, he may at any time after (or, with the applicant's consent, before) the end of the period prescribed for the purposes of section 16 above inspect the application and any such documents ;
- and where that Authority are authorised under paragraph (a) above they shall as soon as practicable report on their inspection to the Secretary of State.
- (7) Where directions have been given under this section in respect of an application for a patent for an invention and, before the directions are revoked, that prescribed period expires and the application is brought in order for the grant of a patent, then—
- (a) if while the directions are in force the invention is worked by (or with the written authorisation of or to the order of) a government department, the provisions of sections 55 to 59 below shall apply as if—
    - (i) the working were use made by section 55 ;
    - (ii) the application had been published at the end of that period ; and
    - (iii) a patent had been granted for the invention at the time the application is brought in order for the grant of a patent (taking the terms of the patent to be those of the application as it stood at the time it was so brought in order); and
  - (b) if it appears to the Secretary of State that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Secretary of State may, with the consent of the Treasury, make such payment (if any) by way of compensation to the applicant as appears to the Secretary of State and the Treasury to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.
- (8) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions were in force.
- (9) A person who fails to comply with any direction under this section shall be liable—
- (a) on summary conviction, to a fine not exceeding £1,000 ; or



- (b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.

### **23 Restrictions on applications abroad by United Kingdom residents**

- (1) Subject to the following provisions of this section, no person resident in the United Kingdom shall, without written authority granted by the comptroller, file or cause to be filed outside the United Kingdom an application for a patent for an invention unless—
  - (a) an application for a patent for the same invention has been filed in the Patent Office (whether before, on or after the appointed day) not less than six weeks before the application outside the United Kingdom ; and
  - (b) either no directions have been given under section 22 above in relation to the application in the United Kingdom or all such directions have been revoked.
- (2) Subsection (1) above does not apply to an application for a patent for an invention for which an application for a patent has first been filed (whether before or after the appointed day) in a country outside the United Kingdom by a person resident outside the United Kingdom.
- (3) A person who files or causes to be filed an application for the grant of a patent in contravention of this section shall be liable—
  - (a) on summary conviction, to a fine not exceeding £1,000; or
  - (b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.
- (4) In this section—
  - (a) any reference to an application for a patent includes a reference to an application for other protection for an invention;
  - (b) any reference to either kind of application is a reference to an application under this Act, under the law of any country other than the United Kingdom or under any treaty or international convention to which the United Kingdom is a party.

#### *Provisions as to patents after grant*

### **24 Publication and certificate of grant**

- (1) As soon as practicable after a patent has been granted under this Act the comptroller shall publish in the journal a notice that it has been granted.
- (2) The comptroller shall, as soon as practicable after he publishes a notice under subsection (1) above, send the proprietor of the patent a certificate in the prescribed form that the patent has been granted to the proprietor.
- (3) The comptroller shall, at the same time as he publishes a notice under subsection (1) above in relation to a patent publish the specification of the patent, the names of the proprietor and (if different) the inventor and any other matters constituting or relating to the patent which in the comptroller's opinion it is desirable to publish.

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## **25 Term of patent**

- (1) A patent granted under this Act shall be treated for the purposes of the following provisions of this Act as having been granted, and shall take effect, on the date on which notice of its grant is published in the journal and, subject to subsection (3) below, shall continue in force until the end of the period of 20 years beginning with the date of filing the application for the patent or with such other date as may be prescribed.
- (2) A rule prescribing any such other date under this section shall not be made unless a draft of the rule has been laid before, and approved by resolution of, each House of Parliament.
- (3) A patent shall cease to have effect at the end of the period prescribed for the payment of any renewal fee if it is not paid within that period.
- (4) If during the period of six months immediately following the end of the prescribed period the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Act as if it had never expired, and accordingly—
  - (a) anything done under or in relation to it during that further period shall be valid ;
  - (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement ; and
  - (c) an act which would constitute the use of the patented invention for the services of the Crown if the patent had not expired shall constitute that use.
- (5) Rules shall include provision requiring the comptroller to notify the registered proprietor of a patent that a renewal fee has not been received from him in the Patent Office before the end of the prescribed period and before the framing of the notification.

## **26 Patent not to be impugned for lack of unity**

No person may in any proceeding object to a patent or to an amendment of a specification of a patent on the ground that the claims contained in the specification of the patent, as they stand or, as the case may be, as proposed to be amended, relate—

- (a) to more than one invention, or
- (b) to a group of inventions which are not so linked as to form a single inventive concept.

## **27 General power to amend specification after grant**

- (1) Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.
- (2) No such amendment shall be allowed under this section where there are pending before the court or the comptroller proceedings in which the validity of the patent may be put in issue.
- (3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

- (4) The comptroller may, without an application being made to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade-mark.
- (5) A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.

## **28 Restoration of lapsed patents**

- (1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period, an application for the restoration of the patent may be made to the comptroller under this section within one year from the date on which the patent ceased to have effect.
- (2) An application under this section may be made by the person who was the proprietor of the patent or by any other person who would have been entitled to the patent if it had not ceased to have effect; and where the patent was held by two or more persons jointly, the application may, with the leave of the comptroller, be made by one or more of them without joining the others.
- (3) If the comptroller is satisfied that—
  - (a) the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period, and
  - (b) those fees were not so paid because of circumstances beyond his control,the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.
- (4) An order under this section may be made subject to such conditions as the comptroller thinks fit (including a condition requiring compliance with any provisions of the rules relating to registration which have not been complied with), and if the proprietor of the patent does not comply with any condition of such an order the comptroller may revoke the order and give such directions consequential on the revocation as he thinks fit.
- (5) Where an order is made under this section and, between the end of the period of six months beginning with the date when the patent concerned ceased to have effect and the date of the application under this section,—
  - (a) a person continued to do or did again an act which would have constituted an infringement of the patent if it had not expired and which he first did before the end of that period, that act shall constitute such an infringement; or
  - (b) a person began in good faith to do an act which would constitute an infringement of the patent if it had been in force or made in good faith effective and serious preparations to do such an act, he shall, after the order comes into force, have the rights conferred by subsection (6) below.
- (6) Any such person shall have the right—
  - (a) to continue to do or, as the case may be, to do that act himself; and
  - (b) if it was done or preparations had been made to do it in the course of a business, to assign the right to do it or to transmit that right on his death or, in the case of a body corporate on its dissolution, to any person who acquires that part of the business in the course of which the act was done or preparations had

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been made to do it, or to authorise it to be done by any partners of his for the time being in that business;

and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

- (7) The rights mentioned in subsection (6) above shall not include the right to grant a licence to any person to do an act so mentioned.
- (8) Where a patented product is disposed of by any person to another in exercise of a right conferred by subsection (6) above, that other and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.
- (9) Subsections (5) to (7) above shall apply in relation to an act which would constitute the use of a patented invention for the services of the Crown if the patent had been in force as they apply in relation to an act which would constitute an infringement of the patent if it had been in force, and subsection (8) above shall apply accordingly to the disposal of a patented product in the exercise of a right conferred by subsection (6) above as applied by the foregoing provision.

## **29 Surrender of patents**

- (1) The proprietor of a patent may at any time by notice given to the comptroller offer to surrender his patent.
- (2) A person may give notice to the comptroller of his opposition to the surrender of a patent under this section, and if he does so the comptroller shall notify the proprietor of the patent and determine the question.
- (3) If the comptroller is satisfied that the patent may properly be surrendered, he may accept the offer and, as from the date when notice of his acceptance is published in the journal, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any use of the patented invention before that date for the services of the Crown.

*Property in patents and applications, and registration*

## **30 Nature of, and transactions in, patents and applications for patents**

- (1) Any patent or application for a patent is personal property (without being a thing in action), and any patent or any such application and rights in or under it may be transferred, created or granted in accordance with subsections (2) to (7) below.
- (2) Subject to section 36(3) below, any patent or any such application, or any right in it, may be assigned or mortgaged.
- (3) Any patent or any such application or right shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.
- (4) Subject to section 36(3) below, a licence may be granted under any patent or any such application for working the invention which is the subject of the patent or the application ; and—

- (a) to the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged; and
  - (b) any such licence or sub-licence shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.
- (5) Subsections (2) to (4) above shall have effect subject to the following provisions of this Act.
- (6) Any of the following transactions, that is to say—
- (a) any assignment or mortgage of a patent or any such application, or any right in a patent or any such application;
  - (b) any assent relating to any patent or any such application or right;
- shall be void unless it is in writing and is signed by or on behalf of the parties to the transaction (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative) or in the case of a body corporate is so signed or is under the seal of that body.
- (7) An assignment of a patent or any such application or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 61 or 69 below for a previous infringement or to bring proceedings under section 58 below for a previous act

### **31 Nature of, and transactions in, patents and applications for patents in Scotland**

- (1) Section 30 above shall not extend to Scotland, but instead the following provisions of this section shall apply there.
- (2) Any patent or application for a patent, and any right in or under any patent or any such application, is incorporeal moveable property, and the provisions of the following subsections and of section 36(3) below shall apply to any grant of licences, assignations and securities in relation to such property.
- (3) Any patent or any such application, or any right in it, may be assigned and security may be granted over a patent or any such application or right.
- (4) A licence may be granted, under any patent or any application for a patent, for working the invention which is the subject of the patent or the application.
- (5) To the extent that any licence granted under subsection (4) above so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned and security may be granted over it.
- (6) Any assignation or grant of security under this section may be carried out only by writing probative or holograph of the parties to the transaction.
- (7) An assignation of a patent or application for a patent or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 61 or 69 below for a previous infringement or to bring proceedings under section 58 below for a previous act.

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### **32 Register of patents, etc.**

- (1) There shall continue to be a register kept at the Patent Office and known as the register of patents which shall comply with rules made by virtue of this section and shall be kept in accordance with such rules; and in this Act, except so far as the context otherwise requires—
- " register ", as a noun, means the register of patents;
  - " register ", as a verb, means, in relation to any thing, to register or register particulars, or enter notice, of that thing in the register and, in relation to a person, means to enter his name in the register; and cognate expressions shall be construed accordingly.
- (2) Without prejudice to any other provision of this Act or rules, rules may make provision with respect to the following matters, including provision imposing requirements as to any of those matters, that is to say—
- (a) the registration of patents and of published applications for patents;
  - (b) the registration of transactions, instruments or events affecting rights in or under patents and applications ;
  - (c) the furnishing to the comptroller of any prescribed documents or description of documents in connection with any matter which is required to be registered;
  - (d) the correction of errors in the register and in any documents filed at the Patent Office in connection with registration;
  - (e) making the register or entries or reproductions of entries in it available for inspection by the public ;
  - (f) supplying certified copies of any such entries or reproductions to persons requiring them ; and
  - (g) the publication and advertisement of anything done under this Act or rules in relation to the register.
- (3) Notwithstanding anything in subsection (2)(b) above, no notice of any trust, whether express, implied or constructive, shall be entered in the register and the comptroller shall not be affected by any such notice.

### **33 Effect of registration, etc., on rights in patents**

- (1) Any person who claims to have acquired the property in a patent or application for a patent by virtue of any transaction, instrument or event to which this section applies shall be entitled as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event—
- (a) the earlier transaction, instrument or event was not registered, or
  - (b) in the case of any application which has not been published, notice of the earlier transaction, instrument or event had not been given to the comptroller, and
  - (c) in any case, the person claiming under the later transaction, instrument or event, did not know of the earlier transaction, instrument or event.
- (2) Subsection (1) above shall apply equally to the case where any person claims to have acquired any right in or under a patent or application for a patent, by virtue of a transaction, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.

- (3) This section applies to the following transactions, instruments and events:—
- (a) the assignment or assignation of a patent or application for a patent, or a right in it;
  - (b) the mortgage of a patent or application or the granting of security over it;
  - (c) the grant, assignment or assignation of a licence or sub-licence, or mortgage of a licence or sub-licence, under a patent or application ;
  - (d) the death of the proprietor or one of the proprietors of any such patent or application or any person having a right in or under a patent or application and the vesting by an assent of personal representatives of a patent, application or any such right; and
  - (e) any order or directions of a court or other competent authority—
    - (i) transferring a patent or application or any right in or under it to any person ; or
    - (ii) that an application should proceed in the name of any person;and in either case the event by virtue of which the court or authority had power to make any such order or give any such directions.
- (4) Where an application for the registration of a transaction, instrument or event has been made, but the transaction, instrument or event has not been registered, then, for the purposes of subsection (1)(a) above, registration of the application shall be treated as registration of the transaction, instrument or event.

#### **34 Rectification of register**

- (1) The court may, on the application of any person aggrieved, order the register to be rectified by the making, or the variation or deletion, of any entry in it.
- (2) In proceedings under this section the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.
- (3) Rules of court may provide for the notification of any application under this section to the comptroller and for his appearance on the application and for giving effect to any order of the court on the application.

#### **35 Evidence of register, documents, etc.**

- (1) The register shall be prima facie evidence of anything required or authorised by this Act or rules to be registered and in Scotland shall be admissible and sufficient evidence of any such thing.
- (2) A certificate purporting to be signed by the comptroller and certifying that any entry which he is authorised by this Act or rules to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence, and in Scotland shall be admissible and sufficient evidence, of the matters so certified.
- (3) Each of the following, that is to say—
  - (a) a copy of any entry in the register or of any document kept in the Patent Office, any specification of a patent or any application for a patent which has been published ;
  - (b) a document reproducing in legible form an entry made in the register otherwise than in legible form; or

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(c) an extract from the register or of any document mentioned in paragraph (a) or (b) above ;  
purporting to be certified by the comptroller and to be sealed with the seal of the Patent Office shall be admitted in evidence without further proof and without production of the original, and in Scotland such evidence shall be sufficient evidence.

### **36 Co-ownership of patents and applications for patents**

- (1) Where a patent is granted to two or more persons, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.
- (2) Where two or more persons are proprietors of a patent, then, subject to the provisions of this section and subject to any agreement to the contrary—
  - (a) each of them shall be entitled, by himself or his agents, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would apart from this subsection and section 55 below, amount to an infringement of the patent concerned; and
  - (b) any such act shall not amount to an infringement of the patent concerned.
- (3) Subject to the provisions of sections 8 and 12 above and section 37 below and to any agreement for the time being in force, where two or more persons are proprietors of a patent one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent or in Scotland cause or permit security to be granted over it.
- (4) Subject to the provisions of those sections, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.
- (5) Where a patented product is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.
- (6) Nothing in subsection (1) or (2) above shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.
- (7) The foregoing provisions of this section shall have effect in relation to an application for a patent which is filed as they have effect in relation to a patent and—
  - (a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed ; and
  - (b) the reference in subsection (5) above to a patented product shall be construed accordingly.

### **37 Determination of right to patent after grant**

- (1) After a patent has been granted for an invention—



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- (a) any person may refer to the comptroller the question whether he is the true proprietor of the patent or whether the patent should have been granted to him (in either case alone or jointly with any other persons) or whether the patent or any right in or under it should be transferred to him (alone or jointly with any other persons); and
- (b) any of two or more persons registered as joint proprietors of the patent may refer to the comptroller the question whether any right in or under the patent should be transferred or granted to any other person;

and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.

(2) Without prejudice to the generality of subsection (1) above, an order under that subsection may contain provision—

- (a) directing that the person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;
- (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;
- (c) granting any licence or other right in or under the patent;
- (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.

(3) If any person to whom directions have been given under subsection (2)(d) above fails to do anything necessary for carrying out any such directions within 14 days after the date of the order containing the directions, the comptroller may, on application made to him by any person in whose favour or on whose reference the order containing the directions was made, authorise him to do that thing on behalf of the person to whom the directions were given.

(4) Where the comptroller finds on a reference under subsection (1)(a) above that the patent was granted to a person not entitled to be granted that patent (whether alone or with other persons) and on an application made under section 72 below makes an order on that ground for the conditional or unconditional revocation of the patent, the comptroller may order that the person by whom the application was made or his successor in title may, subject to section 76 below, make a new application for a patent—

- (a) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent; and
- (b) in the case of conditional revocation, for the matter which in the opinion of the comptroller should be excluded from that specification by amendment under section 75 below;

and where such a new application is made, it shall be treated as having been filed on the date of filing the application for the patent to which the reference relates.

(5) On any such reference no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) above on that ground, if the reference was made after the end of the period of two years beginning with the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

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- (6) An order under this section shall not be so made as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.
- (7) Where a question is referred to the comptroller under subsection (1)(a) above an order shall not be made by virtue of subsection (2) or under subsection (4) above on the reference unless notice of the reference is given to all persons registered as proprietor of the patent or as having a right in or under the patent, except those who are parties to the reference.
- (8) If it appears to the comptroller on a reference under subsection (1) above that the question referred to him would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so.
- (9) The court shall not in the exercise of any such declaratory jurisdiction determine a question whether a patent was granted to a person not entitled to be granted the patent if the proceedings in which the jurisdiction is invoked were commenced after the end of the period of two years beginning with the date of the grant of the patent, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

### **38 Effect of transfer of patent under s. 37**

- (1) Where an order is made under section 37 above that a patent shall be transferred from any person or persons (the old proprietor or proprietors) to one or more persons (whether or not including an old proprietor), then, except in a case falling within subsection (2) below, any licences or other rights granted or created by the old proprietor or proprietors shall, subject to section 33 above and to the provisions of the order, continue in force and be treated as granted by the person or persons to whom the patent is ordered to be transferred (the new proprietor or proprietors).
- (2) Where an order is so made that a patent shall be transferred from the old proprietor or proprietors to one or more persons none of whom was an old proprietor (on the ground that the patent was granted to a person not entitled to be granted the patent), any licences or other rights in or under the patent shall, subject to the provisions of the order and subsection (3) below, lapse on the registration of that person or those persons as the new proprietor or proprietors of the patent.
- (3) Where an order is so made that a patent shall be transferred as mentioned in subsection (2) above or that a person other than an old proprietor may make a new application for a patent and before the reference of the question under that section resulting in the making of any such order is registered, the old proprietor or proprietors or a licensee of the patent, acting in good faith, worked the invention in question in the United Kingdom or made effective and serious preparations to do so, the old proprietor or proprietors or the licensee shall, on making a request to the new proprietor or proprietors within the prescribed period, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention, so far as it is the subject of the new application.
- (4) Any such licence shall be granted for a reasonable period and on reasonable terms.

- (5) The new proprietor or proprietors of the patent or any person claiming that he is entitled to be granted any such licence may refer to the comptroller the question whether that person is so entitled and whether any such period is or terms are reasonable, and the comptroller shall determine the question and may, if he considers it appropriate, order the grant of such a licence.

### *Employees' inventions*

## **39 Right to employees' inventions**

- (1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if—
- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties ; or
  - (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.
- (2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

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

- (1) Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that the employee has made an invention belonging to the employer for which a patent has been granted, that the patent is (having regard among other things to the size and nature of the employer's undertaking) of outstanding benefit to the employer and that by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer, the court or the comptroller may award him such compensation of an amount determined under section 41 below.
- (2) Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that—
- (a) a patent has been granted for an invention made by and belonging to the employee;
  - (b) his rights in the invention, or in any patent or application for a patent for the invention, have since the appointed day been assigned to the employer or an exclusive licence under the patent or application has since the appointed day been granted to the employer;
  - (c) the benefit derived by the employee from the contract of assignment, assignation or grant or any ancillary contract ("the relevant contract") is inadequate in relation to the benefit derived by the employer from the patent; and
  - (d) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract;

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the court or the comptroller may award him such compensation of an amount determined under section 41 below.

- (3) Subsections (1) and (2) above shall not apply to the invention of an employee where a relevant collective agreement provides for the payment of compensation in respect of inventions of the same description as that invention to employees of the same description as that employee.
- (4) Subsection (2) above shall have effect notwithstanding anything in the relevant contract or any agreement applicable to the invention (other than any such collective agreement).
- (5) If it appears to the comptroller on an application under this section that the application involves matters which would more properly be determined by the court, he may decline to deal with it.
- (6) In this section—
  - " the prescribed period ", in relation to proceedings before the court, means the period prescribed by rules of court, and
  - " relevant collective agreement " means a collective agreement within the meaning of the Trade Union and Labour Relations Act 1974, made by or on behalf of a trade union to which the employee belongs, and by the employer or an employers' association to which the employer belongs which is in force at the time of the making of the invention.
- (7) References in this section to an invention belonging to an employer or employee are references to it so belonging as between the employer and the employee.

#### **41 Amount of compensation**

- (1) An award of compensation to an employee under section 40(1) or (2) above in relation to a patent for an invention shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which the employer has derived, or may reasonably be expected to derive, from the patent or from the assignment, assignation or grant to a person connected with the employer of the property or any right in the invention or the property in, or any right in or under, an application for that patent.
- (2) For the purposes of subsection (1) above the amount of any benefit derived or expected to be derived by an employer from the assignment, assignation or grant of—
  - (a) the property in, or any right in or under, a patent for the invention or an application for such a patent ; or
  - (b) the property or any right in the invention ;
 to a person connected with him shall be taken to be the amount which could reasonably be expected to be so derived by the employer if that person had not been connected with him.
- (3) Where the Crown or a Research Council in its capacity as employer assigns or grants the property in, or any right in or under, an invention, patent or application for a patent to a body having among its functions that of developing or exploiting inventions resulting from public research and does so for no consideration or only a nominal consideration, any benefit derived from the invention, patent or application by that body shall be treated for the purposes of the foregoing provisions of this section as so derived by the Crown or, as the case may be, Research Council.

In this subsection " Research Council" means a body which is a Research Council for the purposes of the Science and Technology Act 1965.

- (4) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which has always belonged to an employer, the court or the comptroller shall, among other things, take the following matters into account, that is to say—
  - (a) the nature of the employee's duties, his remuneration and the other advantages he derives or has derived from his employment or has derived in relation to the invention under this Act;
  - (b) the effort and skill which the employee has devoted to making the invention;
  - (c) the effort and skill which any other person has devoted to making the invention jointly with the employee concerned, and the advice and other assistance contributed by any other employee who is not a joint inventor of the invention; and
  - (d) the contribution made by the employer to the making, developing and working of the invention by the provision of advice, facilities and other assistance, by the provision of opportunities and by his managerial and commercial skill and activities.
- (5) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which originally belonged to him, the court or the comptroller shall, among other things, take the following matters into account, that is to say—
  - (a) any conditions in a licence or licences granted under this Act or otherwise in respect of the invention or the patent;
  - (b) the extent to which the invention was made jointly by the employee with any other person ; and
  - (c) the contribution made by the employer to the making, developing and working of the invention as mentioned in subsection (4)(d) above.
- (6) Any order for the payment of compensation under section 40 above may be an order for the payment of a lump sum or for periodical payment, or both.
- (7) Without prejudice to section 32 of the Interpretation Act 1889 (which provides that a statutory power may in general be exercised from time to time), the refusal of the court or the comptroller to make any such order on an application made by an employee under section 40 above shall not prevent a further application being made under that section by him or any successor in title of his.
- (8) Where the court or the comptroller has made any such order, the court or he may on the application of either the employer or the employee vary or discharge it or suspend any provision of the order and revive any provision so suspended, and section 40(5) above shall apply to the application as it applies to an application under that section.
- (9) In England and Wales any sums awarded by the comptroller under section 40 above 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.
- (10) In Scotland an order made under section 40 above by the comptroller for the payment of any sums may be enforced in like manner as a recorded decree arbitral.
- (11) In Northern Ireland an order made under section 40 above by the comptroller for the payment of any sums may be enforced as if it were a money judgment.

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## **42 Enforceability of contracts relating to employees' inventions**

- (1) This section applies to any contract (whenever made) relating to inventions made by an employee, being a contract entered into by him—
  - (a) with the employer (alone or with another); or
  - (b) with some other person at the request of the employer or in pursuance of the employee's contract of employment.
- (2) Any term in a contract to which this section applies which diminishes the employee's rights in inventions of any description made by him after the appointed day and the date of the contract, or in or under patents for those inventions or applications for such patents, shall be unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent.
- (3) Subsection (2) above shall not be construed as derogating from any duty of confidentiality owed to his employer by an employee by virtue of any rule of law or otherwise.
- (4) This section applies to any arrangement made with a Crown employee by or on behalf of the Crown as his employer as it applies to any contract made between an employee and an employer other than the Crown, and for the purposes of this section " Crown employee " means a person employed under or for the purposes of a government department or any officer or body exercising on behalf of the Crown functions conferred by any enactment.

## **43 Supplementary**

- (1) Sections 39 to 42 above shall not apply to an invention made before the appointed day.
- (2) Sections 39 to 42 above shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say—
  - (a) he was mainly employed in the United Kingdom; or
  - (b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in the United Kingdom to which the employee was attached, whether or not he was also attached elsewhere.
- (3) In sections 39 to 42 above and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee.
- (4) Any references in sections 40 to 42 above to a patent and to a patent being granted are respectively references to a patent or other protection and to its being granted whether under the law of the United Kingdom or the law in force in any other country or under any treaty or international convention.
- (5) For the purposes of sections 40 and 41 above the benefit derived or expected to be derived by an employer from a patent shall, where he dies before any award is made under section 40 above in respect of the patent, include any benefit derived or expected to be derived from the patent by his personal representatives or by any person in whom it was vested by their assent.

- (6) Where an employee dies before an award is made under section 40 above in respect of a patented invention made by him, his personal representatives or their successors in title may exercise his right to make or proceed with an application for compensation under subsection (1) or (2) of that section.
- (7) In sections 40 and 41 above and this section "benefit" means benefit in money or money's worth.
- (8) Section 533 of the Income and Corporation Taxes Act 1970 (definition of connected persons) shall apply for determining for the purposes of section 41(2) above whether one person is connected with another as it applies for determining that question for the purposes of the Tax Acts.

*Contracts as to patented products, etc.*

#### **44 Avoidance of certain restrictive conditions**

- (1) Subject to the provisions of this section, any condition or term of a contract for the supply of a patented product or of a licence to work a patented invention, or of a contract relating to any such supply or licence, shall be void in so far it purports—
  - (a) in the case of a contract for supply, to require the person supplied to acquire from the supplier, or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the supplier or his nominee, anything other than the patented product;
  - (b) in the case of a licence to work a patented invention, to require the licensee to acquire from the licensor or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the licensor or his nominee, anything other than the product which is the patented invention or (if it is a process) other than any product obtained directly by means of the process or to which the process has been applied;
  - (c) in either case, to prohibit the person supplied or licensee from using articles (whether patented products or not) which are not supplied by, or any patented process which does not belong to, the supplier or licensor, or his nominee, or to restrict the right of the person supplied or licensee to use any such articles or process.
- (2) Subsection (1) above applies to contracts and licences whether made or granted before or after the appointed day, but not to those made or granted before 1st January 1950.
- (3) In proceedings against any person for infringement of a patent it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff or pursuer or a licence under the patent granted by him or with his consent and containing in either case a condition or term void by virtue of this section.
- (4) A condition or term of a contract or licence shall not be void by virtue of this section if—
  - (a) at the time of the making of the contract or granting of the licence the supplier or licensor was willing to supply the product, or grant a licence to work the invention, as the case may be, to the person supplied or licensee, on reasonable terms specified in the contract or licence and without any such condition or term as is mentioned in subsection (1) above; and

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- (b) the person supplied or licensee is entitled under the contract or licence to relieve himself of his liability to observe the condition or term on giving to the other party three months' notice in writing and subject to payment to that other party of such compensation (being, in the case of a contract to supply, a lump sum or rent for the residue of the term of the contract and, in the case of a licence, a royalty for the residue of the term of the licence) as may be determined by an arbitrator or arbiter appointed by the Secretary of State.
- (5) If in any proceeding it is alleged that any condition or term of a contract or licence is void by virtue of this section it shall be on the supplier or licensor to prove the matters set out in paragraph (a) of subsection (4) above.
- (6) A condition or term of a contract or licence shall not be void by virtue of this section by reason only that it prohibits any person from selling goods other than those supplied by a specific person or, in the case of a contract for the hiring of or licence to use a patented product, that it reserves to the bailor (or, in Scotland, hirer) or licensor, or his nominee, the right to supply such new parts of the patented product as may be required to put or keep it in repair.

#### **45 Determination of parts of certain contracts**

- (1) Any contract for the supply of a patented product or licence to work a patented invention, or contract relating to any such supply or licence, may at any time after the patent or all the patents by which the product or invention was protected at the time of the making of the contract or granting of the licence has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or licence or in any other contract, be determined, to the extent (and only to the extent) that the contract or licence relates to the product or invention, by either party on giving three months' notice in writing to the other party.
- (2) In subsection (1) above " patented product " and " patented invention" include respectively a product and an invention which is the subject of an application for a patent, and that subsection shall apply in relation to a patent by which any such product or invention was protected and which was granted after the time of the making of the contract or granting of the licence in question, on an application which had been filed before that time, as it applies to a patent in force at that time.
- (3) If, on an application under this subsection made by either party to a contract or licence falling within subsection (1) above, the court is satisfied that, in consequence of the patent or patents concerned ceasing to be in force, it would be unjust to require the applicant to continue to comply with all the terms and conditions of the contract or licence, it may make such order varying those terms or conditions as, having regard to all the circumstances of the case, it thinks just as between the parties.
- (4) Without prejudice to any other right of recovery, nothing in subsection (1) above shall be taken to entitle any person to recover property bailed under a hire-purchase agreement (within the meaning of the Consumer Credit Act 1974).
- (5) The foregoing provisions of this section apply to contracts and licences whether made before or after the appointed day.
- (6) The provisions of this section shall be without prejudice to any rule of law relating to the frustration of contracts and any right of determining a contract or licence exercisable apart from this section.



*Licences of right and compulsory licences*

**46 Patentee's application for entry in register that licences are available as of right**

- (1) At any time after the grant of a patent its proprietor may apply to the comptroller for an entry to be made in the register to the effect that licences under the patent are to be available as of right.
- (2) Where such an application is made, the comptroller shall give notice of the application to any person registered as having a right in or under the patent and, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, shall make that entry.
- (3) Where such an entry is made in respect of a patent—
  - (a) any person shall, at any time after the entry is made, be entitled as of right to a licence under the patent on such terms as may be settled by agreement or, in default of agreement, by the comptroller on the application of the proprietor of the patent or the person requiring the licence;
  - (b) the comptroller may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled ;
  - (c) if in proceedings for infringement of the patent (otherwise than by the importation of any article) the defendant or defender undertakes to take a licence on such terms, no injunction or interdict shall be granted against him and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence on those terms had been granted before the earliest infringement;
  - (d) the renewal fee payable in respect of the patent after the date of the entry shall be half the fee which would be payable if the entry had not been made.
- (4) The licensee under a licence of right may (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) request the proprietor of the patent to take proceedings to prevent any infringement of the patent; and if the proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were proprietor, making the proprietor a defendant or defender.
- (5) A proprietor so added as defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

**47 Cancellation of entry made under s. 46**

- (1) At any time after an entry has been made under section 46 above in respect of a patent, the proprietor of the patent may apply to the comptroller for cancellation of the entry.
- (2) Where such an application is made and the balance paid of all renewal fees which would have been payable if the entry had not been made, the comptroller may cancel the entry, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.
- (3) Within the prescribed period after an entry has been made under section 46 above in respect of a patent, any person who claims that the proprietor of the patent is, and was at the time of the entry, precluded by a contract in which the claimant is interested

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from granting licences under the patent may apply to the comptroller for cancellation of the entry.

- (4) Where the comptroller is satisfied, on an application under subsection (3) above, that the proprietor of the patent is and was so precluded, he shall cancel the entry; and the proprietor shall then be liable to pay, within a period specified by the comptroller, a sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and the patent shall cease to have effect at the expiration of that period if that sum is not so paid.
- (5) Where an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent shall afterwards be the same as if the entry had not been made.
- (6) Where an application has been made under this section, then—
  - (a) in the case of an application under subsection (1) above, any person, and
  - (b) in the case of an application under subsection (3) above, the proprietor of the patent,
 may within the prescribed period give notice to the comptroller of opposition to the cancellation; and the comptroller shall, in considering the application, determine whether the opposition is justified.

#### **48 Compulsory licences**

- (1) At any time after the expiration of three years, or of such other period as may be prescribed, from the date of the grant of a patent, any person may apply to the comptroller on one or more of the grounds specified in subsection (3) below—
  - (a) for a licence under the patent,
  - (b) for an entry to be made in the register to the effect that licences under the patent are to be available as of right, or
  - (c) where the applicant is a government department, for the grant to any person specified in the application of a licence under the patent.
- (2) A rule prescribing any such other period under subsection (1) above shall not be made unless a draft of the rule has been laid before, and approved by resolution of, each House of Parliament.
- (3) The grounds are:—
  - (a) where the patented invention is capable of being commercially worked in the United Kingdom, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable ;
  - (b) where the patented invention is a product, that a demand for the product in the United Kingdom—
    - (i) is not being met on reasonable terms, or
    - (ii) is being met to a substantial extent by importation;
  - (c) where the patented invention is capable of being commercially worked in the United Kingdom, that it is being prevented or hindered from being so worked—
    - (i) where the invention is a product, by the importation of the product,
    - (ii) where the invention is a process, by the importation of a product obtained directly by means of the process or to which the process has been applied ;

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- (d) that by reason of the refusal of the proprietor of the patent to grant a licence or licences on reasonable terms—
    - (i) a market for the export of any patented product made in the United Kingdom is not being supplied, or
    - (ii) the working or efficient working in the United Kingdom of any other patented invention which makes a substantial contribution to the art is prevented or hindered, or
    - (iii) the establishment or development of commercial or industrial activities in the United Kingdom is unfairly prejudiced ;
  - (e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the United Kingdom, is unfairly prejudiced.
- (4) Subject to the provisions of subsections (5) to (7) below, if he is satisfied that any of those grounds are established, the comptroller may—
- (a) where the application is under subsection (1)(a) above, order the grant of a licence to the applicant on such terms as the comptroller thinks ;
  - (b) where the application is under subsection (1)(b) above, make such an entry as is there mentioned ;
  - (c) where the application is under subsection (1)(c) above, order the grant of a licence to the person specified in the application on such terms as the comptroller thinks fit.
- (5) Where the application is made on the ground that the patented invention is not being commercially worked in the United Kingdom or is not being so worked to the fullest extent that is reasonably practicable, and it appears to the comptroller that the time which has elapsed since the publication in the journal of a notice of the grant of the patent has for any reason been insufficient to enable the invention to be so worked, he may by order adjourn the application for such period as will in his opinion give sufficient time for the invention to be so worked.
- (6) No entry shall be made in the register under this section on the ground mentioned in subsection (3)(d)(i) above, and any licence granted under this section on that ground shall contain such provisions as appear to the comptroller to be expedient for restricting the countries in which any product concerned may be disposed of or used by the licensee.
- (7) No order or entry shall be made under this section in respect of a patent (the patent concerned) on the ground mentioned in subsection (3)(d)(ii) above unless the comptroller is satisfied that the proprietor of the patent for the other invention is able and willing to grant to the proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms.
- (8) An application may be made under this section in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent; and no person shall be estopped or barred from alleging any of the matters specified in subsection (3) above by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted such a licence.

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#### **49 Provisions about licences under s. 48**

- (1) Where the comptroller is satisfied, on an application made under section 48 above in respect of a patent, that the manufacture, use or disposal of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or the use of the patented process, he may (subject to the provisions of that section) order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.
- (2) Where an application under section 48 above is made in respect of a patent by a person who holds a licence under the patent, the comptroller—
  - (a) may, if he orders the grant of a licence to the applicant, order the existing licence to be cancelled, or
  - (b) may, instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.
- (3) Where, on an application under section 48 above in respect of a patent, the comptroller orders the grant of a licence, he may direct that the licence shall operate—
  - (a) to deprive the proprietor of the patent of any right he has to work the invention concerned or grant licences under the patent;
  - (b) to revoke all existing licences granted under the patent.
- (4) Section 46(4) and (5) above shall apply to a licence granted in pursuance of an order under section 48 above and to a licence granted by virtue of an entry under that section as it applies to a licence granted by virtue of an entry under section 46 above.

#### **50 Exercise of powers on applications under s. 48**

- (1) The powers of the comptroller on an application under section 48 above in respect of a patent shall be exercised with a view to securing the following general purposes:—
  - (a) that inventions which can be worked on a commercial scale in the United Kingdom and which should in the public interest be so worked shall be worked there without undue delay and to the fullest extent that is reasonably practicable;
  - (b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention ;
  - (c) that the interests of any person for the time being working or developing an invention in the United Kingdom under the protection of a patent shall not be unfairly prejudiced.
- (2) Subject to subsection (1) above, the comptroller shall, in determining whether to make an order or entry in pursuance of such an application, take account of the following matters, that is to say—
  - (a) the nature of the invention, the time which has elapsed since the publication in the journal of a notice of the grant of the patent and the measures already taken by the proprietor of the patent or any licensee to make full use of the invention ;
  - (b) the ability of any person to whom a licence would be granted under the order concerned to work the invention to the public advantage ; and
  - (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted,

but shall not be required to take account of matters subsequent to the making of the application.

## **51 Application by Crown in cases of monopoly or merger**

(1) Where, on a reference under section 50 or 51 of the Fair Trading Act 1973 (the 1973 Act), a report of the Monopolies and Mergers Commission (the Commission), as laid before Parliament, contains conclusions to the effect—

- (a) that a monopoly situation (within the meaning of the 1973 Act) exists in relation to a description of goods which consist of or include patented products or in relation to a description of services in which a patented product or process is used, and
- (b) that facts found by the Commission in pursuance of their investigations under section 49 of the 1973 Act operate, or may be expected to operate, against the public interest,

the appropriate Minister or Ministers may, subject to subsection (3) below, apply to the comptroller for relief under subsection (4) below in respect of the patent.

(2) Where, on a reference under section 64 or 75 of the 1973 Act, a report of the Commission, as laid before Parliament, contains conclusions to the effect—

- (a) that a merger situation qualifying for investigation has been created ;
- (b) that one of the elements which constitute the creation of that situation is that the condition specified in section 64(2) or (3) of the 1973 Act prevails (or does so to a greater extent) in respect of a description of goods which consist of or include patented products or in respect of a description of services in which a patented product or process is used; and
- (c) that the creation of that situation, or particular elements in or consequences of it specified, in the report, operate, or may be expected to operate, against the public interest,

the Secretary of State may, subject to subsection (3) below, apply to the comptroller for relief under subsection (5) below in respect of the patent.

(3) Before making an application under subsection (1) or (2) above, the appropriate Minister or Ministers shall publish, in such manner as he or they think appropriate, a notice describing the nature of the proposed application, and shall consider any representations which, within the period of thirty days from the date of publication of the notice, may be made to him or them by persons whose interests appear to the appropriate Minister or Ministers to be likely to be affected by the proposed application.

(4) If on an application under subsection (1) above it appears to the comptroller that the facts specified in the Commission's report as being those which, in the Commission's opinion, operate or may be expected to operate against the public interest include—

- (a) any conditions in a licence or licences granted under the patent by its proprietor restricting the use of the invention concerned by the licensee or the right of the proprietor to grant other licences under the patent, or
- (b) a refusal by the proprietor to grant licences under the patent on reasonable terms,

the comptroller may by order cancel or modify any such condition or may, instead or in addition, make an entry in the register to the effect that licences under the patent are to be available as of right.

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- (5) If on an application under subsection (2) above it appears to the comptroller that the particular matters indicated in the Commission's report as being those which, in the Commission's opinion, operate or may be expected to operate against the public interest (whether those matters are so indicated in pursuance of a requirement imposed under section 69(4) or 75(3) of the 1973 Act or otherwise) include any such condition or refusal as is mentioned in paragraph (a) or (b) or subsection (4) above, the comptroller may by order cancel or modify any such condition or may, instead or in addition, make an entry in the register to the effect that licences under the patent are to be available as of right.
- (6) In this section " the appropriate Minister or Ministers ", in relation to a report of the Commission, means the Minister or Ministers to whom the report is made.

## **52 Opposition, appeal and arbitration**

- (1) The proprietor of the patent concerned or any other person wishing to oppose an application under sections 48 to 51 above may, in accordance with rules, give to the comptroller notice of opposition; and the comptroller shall consider the opposition in deciding whether to grant the application.
- (2) Where an appeal is brought from an order made by the comptroller in pursuance of an application under sections 48 to 51 above or from a decision of his to make an entry in the register in pursuance of such an application or from a refusal of his to make such an order or entry, the Attorney General, Lord Advocate or Attorney General for Northern Ireland, or such other counsel as any of them may appoint, shall be entitled to appear and be heard.
- (3) Where an application under sections 48 to 51 above is opposed under subsection (1) above, and either—
- (a) the parties consent, or
  - (b) the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the comptroller conveniently be made before him,
- the comptroller may at any time order the whole proceedings, or any question or issue of fact arising in them, to be referred to an arbitrator or arbiter agreed on by the parties or, in default of agreement, appointed by the comptroller.
- (4) Where the whole proceedings are so referred, section 21 of the Arbitration Act 1950 or, as the case may be, section 22 of the Arbitration Act (Northern Ireland) 1937 (statement of cases by arbitrators) shall not apply to the arbitration; but unless the parties otherwise agree before the award of the arbitrator or arbiter is made an appeal shall lie from the award to the court.
- (5) Where a question or issue of fact is so referred, the arbitrator or arbiter shall report his findings to the comptroller.

## **53 Compulsory licences; supplementary provisions**

- (1) Without prejudice to section 86 below (by virtue of which the Community Patent Convention has effect in the United Kingdom), sections 48 to 51 above shall have effect subject to any provision of that convention relating to the grant of compulsory licences for lack or insufficiency of exploitation as that provision applies by virtue of that section.

- (2) In any proceedings on an application made in relation to a patent under sections 48 to 51 above, any statement with respect to any activity in relation to the patented invention, or with respect to the grant or refusal of licences under the patent, contained in a report of the Monopolies and Mergers Commission laid before Parliament under Part VII of the Fair Trading Act 1973 shall be prima facie evidence of the matters stated, and in Scotland shall be sufficient evidence of those matters.
- (3) The comptroller may make an entry in the register under sections 48 to 51 above notwithstanding any contract which would have precluded the entry on the application of the proprietor of the patent under section 46 above.
- (4) An entry made in the register under sections 48 to 51 above shall for all purposes have the same effect as an entry made under section 46 above.
- (5) No order or entry shall be made in pursuance of an application under sections 48 to 51 above which would be at variance with any treaty or international convention to which the United Kingdom is a party.

#### **54 Special provisions where patented invention is being worked abroad**

- (1) Her Majesty may by Order in Council provide that the comptroller may not (otherwise than for purposes of the public interest) make an order or entry in respect of a patent in pursuance of an application under sections 48 to 51 above if the invention concerned is being commercially worked in any relevant country specified in the Order and demand in the United Kingdom for any patented product resulting from that working is being met by importation from that country.
- (2) In subsection (1) above "relevant country" means a country other than a member state whose law in the opinion of Her Majesty in Council incorporates or will incorporate provisions treating the working of an invention in, and importation from, the United Kingdom in a similar way to that in which the Order in Council would (if made) treat the working of an invention in, and importation from, that country.

#### *Use of patented inventions for services of the Crown*

#### **55 Use of patented inventions for services of the Crown**

- (1) Notwithstanding anything in this Act, any government department and any person authorised in writing by a government department may, for the services of the Crown and in accordance with this section, do any of the following acts in the United Kingdom in relation to a patented invention without the consent of the proprietor of the patent, that is to say—
  - (a) where the invention is a product, may—
    - (i) make, use, import or keep the product, or sell or offer to sell it where to do so would be incidental or ancillary to making, using, importing or keeping it; or
    - (ii) in any event, sell or offer to sell it for foreign defence purposes or for the production or supply of specified drugs and medicines, or dispose or offer to dispose of it (otherwise than by selling it) for any purpose whatever;

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- (b) where the invention is a process, may use it or do in relation to any product obtained directly by means of the process anything mentioned in paragraph (a) above;
- (c) without prejudice to the foregoing, where the invention or any product obtained directly by means of the invention is a specified drug or medicine, may sell or offer to sell the drug or medicine ;
- (d) may supply or offer to supply to any person any of the means, relating to an essential element of the invention, for putting the invention into effect;
- (e) may dispose or offer to dispose of anything which was made, used, imported or kept in the exercise of the powers conferred by this section and which is no longer required for the purpose for which it was made, used, imported or kept (as the case may be),

and anything done by virtue of this subsection shall not amount to an infringement of the patent concerned.

- (2) Any act done in relation to an invention by virtue of this section is in the following provisions of this section referred to as use of the invention ; and " use ", in relation to an invention, in sections 56 to 58 below shall be construed accordingly.
- (3) So far as the invention has before its priority date been duly recorded by or tried by or on behalf of a government department or the United Kingdom Atomic Energy Authority otherwise than in consequence of a relevant communication made in confidence, any use of the invention by virtue of this section may be made free of any royalty or other payment to the proprietor.
- (4) So far as the invention has not been so recorded or tried, any use of it made by virtue of this section at any time either—
  - (a) after the publication of the application for the patent for the invention; or
  - (b) without prejudice to paragraph (a) above, in consequence of a relevant communication made after the priority date of the invention otherwise than in confidence;

shall be made on such terms as may be agreed either before or after the use by the government department and the proprietor of the patent with the approval of the Treasury or as may in default of agreement be determined by the court on a reference under section 58 below.

- (5) Where an invention is used by virtue of this section at any time after publication of an application for a patent for the invention but before such a patent is granted, and the terms for its use agreed or determined as mentioned in subsection (4) above include terms as to payment for the use, then (notwithstanding anything in those terms) any such payment shall be recoverable only—
  - (a) after such a patent is granted ; and
  - (b) if (apart from this section) the use would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Patent Office.
- (6) The authority of a government department in respect of an invention may be given under this section either before or after the patent is granted and either before or after the use in respect of which the authority is given is made, and may be given to any



person whether or not he is authorised directly or indirectly by the proprietor of the patent to do anything in relation to the invention.

- (7) Where any use of an invention is made by or with the authority of a government department under this section, then, unless it appears to the department that it would be contrary to the public interest to do so, the department shall notify the proprietor of the patent as soon as practicable after the second of the following events, that is to say, the use is begun and the patent is granted, and furnish him with such information as to the extent of the use as he may from time to time require.
- (8) A person acquiring anything disposed of in the exercise of powers conferred by this section, and any person claiming through him, may deal with it in the same manner as if the patent were held on behalf of the Crown.
- (9) In this section " relevant communication ", in relation to an invention, means a communication of the invention directly or indirectly by the proprietor of the patent or any person from whom he derives title.
- (10) Subsection (4) above is without prejudice to any rule of law relating to the confidentiality of information.
- (11) In the application of this section to Northern Ireland, the reference in subsection (4) above to the Treasury shall, where the government department referred to in that subsection is a department of the Government of Northern Ireland, be construed as a reference to the Department of Finance for Northern Ireland.

## **56 Interpretation, etc., of provisions about Crown use**

- (1) Any reference in section 55 above to a patented invention, in relation to any time, is a reference to an invention for which a patent has before that time been, or is subsequently, granted.
- (2) In this Act, except so far as the context otherwise requires, " the services of the Crown " includes—
  - (a) the supply of anything for foreign defence purposes;
  - (b) the production or supply of specified drugs and medicines; and
  - (c) such purposes relating to the production or use of atomic energy or research into matters connected therewith as the Secretary of State thinks necessary or expedient;and " use for the services of the Crown " shall be construed accordingly.
- (3) In section 55(1)(a) above and subsection (2)(a) above, references to a sale or supply of anything for foreign defence purposes are references to a sale or supply of the thing—
  - (a) to the government of any country outside the United Kingdom, in pursuance of an agreement or arrangement between Her Majesty's Government in the United Kingdom and the government of that country, where the thing is required for the defence of that country or of any other country whose government is party to any agreement or arrangement with Her Majesty's Government in respect of defence matters ; or
  - (b) to the United Nations, or to the government of any country belonging to that organisation, in pursuance of an agreement or arrangement between Her Majesty's Government and that organisation or government, where the thing is required for any armed forces operating in pursuance of a resolution of that organisation or any organ of that organisation.

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- (4) For the purposes of section 55(1)(a) and (c) above and subsection (2)(b) above, specified drugs and medicines are drugs and medicines which are both—
- (a) required for the provision of pharmaceutical services, general medical services or general dental services, that is to say, services of those respective kinds under Part II of the National Health Service Act 1977, Part IV of the National Health Service (Scotland) Act 1947 or the corresponding provisions of the law in force in Northern Ireland or the Isle of Man, and
  - (b) specified for the purposes of this subsection in regulations made by the Secretary of State.

## 57 Rights of third parties in respect of Crown use

- (1) In relation to—
- (a) any use made for the services of the Crown of an invention by a government department, or a person authorised by a government department, by virtue of section 55 above, or
  - (b) anything done for the services of the Crown to the order of a government department by the proprietor of a patent in respect of a patented invention or by the proprietor of an application in respect of an invention for which an application for a patent has been filed and is still pending,
- the provisions of any licence, assignment, assignation or agreement to which this subsection applies shall be of no effect so far as those provisions restrict or regulate the working of the invention, or the use of any model, document or information relating to it, or provide for the making of payments in respect of, or calculated by reference to, such working or use; and the reproduction or publication of any model or document in connection with the said working or use shall not be deemed to be an infringement of any copyright subsisting in the model or document.
- (2) Subsection (1) above applies to a licence, assignment, assignation or agreement which is made, whether before or after the appointed day, between (on the one hand) any person who is a proprietor of or an applicant for the patent, or anyone who derives title from any such person or from whom such person derives title, and (on the other hand) any person whatever other than a government department.
- (3) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the working of the invention is in force under the patent or application concerned, then—
- (a) in relation to anything done in respect of the invention which, but for the provisions of this section and section 55 above, would constitute an infringement of the rights of the licensee, subsection (4) of that section shall have effect as if for the reference to the proprietor of the patent there were substituted a reference to the licensee; and
  - (b) in relation to anything done in respect of the invention by the licensee by virtue of an authority given under that section, that section shall have effect as if the said subsection (4) were omitted.
- (4) Subject to the provisions of subsection (3) above, where the patent, or the right to the grant of the patent, has been assigned to the proprietor of the patent or application in consideration of royalties or other benefits determined by reference to the working of the invention, then—
- (a) in relation to any use of the invention by virtue of section 55 above, subsection (4) of that section shall have effect as if the reference to the

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- proprietor of the patent included a reference to the assignor, and any sum payable by virtue of that subsection shall be divided between the proprietor of the patent or application and the assignor in such proportion as may be agreed on by them or as may in default of agreement be determined by the court on a reference under section 58 below ; and
- (b) in relation to any act done in respect of the invention for the services of the Crown by the proprietor of the patent or application to the order of a government department, section 55(4) above shall have effect as if that act were use made by virtue of an authority given under that section.
- (5) Where section 55(4) above applies to any use of an invention and a person holds an exclusive licence under the patent or application concerned (other than such a licence as is mentioned in subsection (3) above) authorising him to work the invention, then subsections (7) and (8) below shall apply.
- (6) In those subsections " the section 55(4)" payment means such payment (if any) as the proprietor of the patent or application and the department agree under section 55 above, or the court determines under section 58 below, should be made by the department to the proprietor in respect of the use of the invention.
- (7) The licensee shall be entitled to recover from the proprietor of the patent or application such part (if any) of the section 55(4) payment as may be agreed on by them or as may in default of agreement be determined by the court under section 58 below to be just having regard to any expenditure incurred by the licensee—
- (a) in developing the invention, or
- (b) in making payments to the proprietor in consideration of the licence, other than royalties or other payments determined by reference to the use of the invention.
- (8) Any agreement by the proprietor of the patent or application and the department under section 55(4) above as to the amount of the section 55(4) payment shall be of no effect unless the licensee consents to the agreement; and any determination by the court under section 55(4) above as to the amount of that payment shall be of no effect unless the licensee has been informed of the reference to the court and is given an opportunity to be heard.
- (9) Where any models, documents or information relating to an invention are used in connection with any use of the invention which falls within subsection (1)(a) above, or with anything done in respect of the invention which falls within subsection (1)(b) above, subsection (4) of section 55 above shall (whether or not it applies to any such use of the invention) apply to the use of the models, documents or information as if for the reference in it to the proprietor of the patent there were substituted a reference to the person entitled to the benefit of any provision of an agreement which is rendered inoperative by this section in relation to that use; and in section 58 below the references to terms for the use of an invention shall be construed accordingly.
- (10) Nothing in this section shall be construed as authorising the disclosure to a government department or any other person of any model, document or information to the use of which this section applies in contravention of any such licence, assignment, assignation or agreement as is mentioned in this section.

## 58 References of disputes as to Crown use

- (1) Any dispute as to the exercise by a government department or a person authorised by a government department of the powers conferred by section 55 above, or as to terms for the use of an invention for the services of the Crown thereunder, or as to the right of any person to receive any part of a payment made or agreed to be made in pursuance of subsection (4) of that section or determined by the court in pursuance of that subsection and this section, may be referred to the court by either party to the dispute after a patent has been granted for the invention.
- (2) If in such proceedings any question arises whether an invention has been recorded or tried as mentioned in section 55 above, and the disclosure of any document recording the invention, or of any evidence of the trial thereof, would in the opinion of the department be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed upon.
- (3) In determining under this section any dispute between a government department and any person as to the terms for the use of an invention for the services of the Crown, the court shall have regard—
  - (a) to any benefit or compensation which that person or any person from whom he derives title may have received or may be entitled to receive directly or indirectly from any government department in respect of the invention in question ;
  - (b) to whether that person or any person from whom he derives title has in the court's opinion without reasonable cause failed to comply with a request of the department to use the invention for the services of the Crown on reasonable terms.
- (4) In determining whether or not to grant any relief under this section and the nature and extent of the relief granted the court shall, subject to the following provisions of this section, apply the principles applied by the court immediately before the appointed day to the granting of relief under section 48 of the 1949 Act.
- (5) On a reference under this section the court may refuse to grant relief by way of compensation in respect of the use of an invention for the services of the Crown during any further period specified under section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that section.
- (6) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, the court shall not grant relief by way of compensation under this section in respect of any such use before the decision to allow the amendment unless the court is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.
- (7) If the validity of a patent is put in issue in proceedings under this section and it is found that the patent is only partially valid, the court may, subject to subsection (8) below, grant relief to the proprietor of the patent in respect of that part of the patent which is found to be valid and to have been used for the services of the Crown.
- (8) Where in any such proceedings it is found that a patent is only partially valid, the court shall not grant relief by way of compensation, costs or expenses except where the proprietor of the patent proves that the specification of the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and has been so used,

subject to the discretion of the court as to costs and expenses and as to the date from which compensation should be awarded.

- (9) As a condition of any such relief the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 75 below, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.
- (10) In considering the amount of any compensation for the use of an invention for the services of the Crown after publication of an application for a patent for the invention and before such a patent is granted, the court shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 16 above, that a patent would be granted conferring on the proprietor of the patent protection for an act of the same description as that found to constitute that use, and if the court finds that it would not have been reasonable, it shall reduce the compensation to such amount as it thinks just.
- (11) Where by virtue of a transaction, instrument or event to which section 33 above applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent (the new proprietor or licensee) and a government department or a person authorised by a government department subsequently makes use under section 55 above of the patented invention, the new proprietor or licensee shall not be entitled to any compensation under section 55(4) above (as it stands or as modified by section 57(3) above) in respect of a subsequent use of the invention before the transaction, instrument or event is registered unless—
  - (a) the transaction, instrument or event is registered within the period of six months beginning with its date; or
  - (b) the court is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.
- (12) In any proceedings under this section the court may at any time order the whole proceedings or any question or issue of fact arising in them to be referred, on such terms as the court may direct, to a Circuit judge discharging the functions of an official referee or an arbitrator in England and Wales or Northern Ireland, or to an arbiter in Scotland; and references to the court in the foregoing provisions of this section shall be construed accordingly.
- (13) One of two or more joint proprietors of a patent or application for a patent may without the concurrence of the others refer a dispute to the court under this section, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

## **59 Special provisions as to Crown use during emergency**

- (1) During any period of emergency within the meaning of this section the powers exercisable in relation to an invention by a government department or a person authorised by a government department under section 55 above shall include power to use the invention for any purpose which appears to the department necessary or expedient:—
  - (a) for the efficient prosecution of any war in which Her Majesty may be engaged;
  - (b) for the maintenance of supplies and services essential to the life of the community;

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- (c) for securing a sufficiency of supplies and services essential to the well-being of the community;
- (d) for promoting the productivity of industry, commerce and agriculture;
- (e) for fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade;
- (f) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or
- (g) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any country or territory outside the United Kingdom which is in grave distress as the result of war;

and any reference in this Act to the services of the Crown shall, as respects any period of emergency, include a reference to those purposes.

- (2) In this section the use of an invention includes, in addition to any act constituting such use by virtue of section 55 above, any act which would, apart from that section and this section, amount to an infringement of the patent concerned or, as the case may be, give rise to a right under section 69 below to bring proceedings in respect of the application concerned, and any reference in this Act to " use for the services of the Crown " shall, as respects any period of emergency, be construed accordingly.
- (3) In this section " period of emergency" means any period beginning with such date as may be declared by Order in Council to be the commencement, and ending with such date as may be so declared to be the termination, of a period of emergency for the purposes of this section.
- (4) A draft of an Order under this section shall not be submitted to Her Majesty unless it has been laid before, and approved by resolution of, each House of Parliament.

### *Infringement*

## **60 Meaning of infringement**

- (1) Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say—
  - (a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;
  - (b) where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;
  - (c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.
- (2) Subject to the following provisions of this section, a person (other than the proprietor of the patent) also infringes a patent for an invention if, while the patent is in force and without the consent of the proprietor, he supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting

the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.

- (3) Subsection (2) above shall not apply to the supply or offer of a staple commercial product unless the supply or the offer is made for the purpose of inducing the person supplied or, as the case may be, the person to whom the offer is made to do an act which constitutes an infringement of the patent by virtue of subsection (1) above.
- (4) Without prejudice to section 86 below, subsections (1) and (2) above shall not apply to any act which, under any provision of the Community Patent Convention relating to the exhaustion of the rights of the proprietor of a patent, as that provision applies by virtue of that section, cannot be prevented by the proprietor of the patent.
- (5) An act which, apart from this subsection, would constitute an infringement of a patent for an invention shall not do so if—
  - (a) it is done privately and for purposes which are not commercial;
  - (b) it is done for experimental purposes relating to the subject-matter of the invention ;
  - (c) it consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;
  - (d) it consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of such a ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the internal or territorial waters of the United Kingdom ;
  - (e) it consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing the United Kingdom (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft, hovercraft or vehicle;
  - (f) it consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing the United Kingdom as aforesaid or of the importation into the United Kingdom, or the use or storage there, of any part or accessory for such an aircraft.
- (6) For the purposes of subsection (2) above a person who does an act in relation to an invention which is prevented only by virtue of paragraph (a), (b) or (c) of subsection (5) above from constituting an infringement of a patent for the invention shall not be treated as a person entitled to work the invention, but—
  - (a) the reference in that subsection to a person entitled to work an invention includes a reference to a person so entitled by virtue of section 55 above, and
  - (b) a person who by virtue of section 28(6) above or section 64 below is entitled to do an act in relation to the invention without it constituting such an infringement shall, so far as concerns that act, be treated as a person entitled to work the invention.
- (7) In this section—

" relevant ship" and " relevant aircraft, hovercraft or vehicle" mean respectively a ship and an aircraft, hovercraft or vehicle registered in, or belonging to, any country, other than the United Kingdom, which is a party to the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 ; and

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" exempted aircraft " means an aircraft to which section 53 of the Civil Aviation Act 1949 (aircraft exempted from seizure in respect of patent claims) applies.

## **61 Proceedings for infringement of patent**

- (1) Subject to the following provisions of this Part of this Act, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made—
  - (a) for an injunction or interdict restraining the defendant or defender from any apprehended act of infringement;
  - (b) for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
  - (c) for damages in respect of the infringement;
  - (d) for an account of the profits derived by him from the infringement;
  - (e) for a declaration or declarator that the patent is valid and has been infringed by him.
- (2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.
- (3) The proprietor of a patent and any other person may by agreement with each other refer to the comptroller the question whether that other person has infringed the patent and on the reference the proprietor of the patent may make any claim mentioned in subsection (1)(c) or (e) above.
- (4) Except so far as the context requires, in the following provisions of this Act—
  - (a) any reference to proceedings for infringement and the bringing of such proceedings includes a reference to a reference under subsection (3) above and the making of such a reference ;
  - (b) any reference to a plaintiff or pursuer includes a reference to the proprietor of the patent; and
  - (c) any reference to a defendant or defender includes a reference to any other party to the reference.
- (5) If it appears to the comptroller on a reference under subsection (3) above that the question referred to him would more properly be determined by the court, he may decline to deal with it and the court shall have jurisdiction to determine the question as if the reference were proceedings brought in the court.
- (6) Subject to the following provisions of this Part of this Act, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted the court or the comptroller shall apply the principles applied by the court in relation to that kind of relief immediately before the appointed day.

## **62 Restrictions on recovery of damages for infringement**

- (1) In proceedings for infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant or defender who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed ; and a person shall not be taken to have



been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word " patent " or " patented ", or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words in question.

- (2) In proceedings for infringement of a patent the court or the comptroller may, if it or he thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during any further period specified under section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.
- (3) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, no damages shall be awarded in proceedings for an infringement of the patent committed before the decision to allow the amendment unless the court or the comptroller is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

### **63 Relief for infringement of partially valid patent**

- (1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the comptroller may, subject to subsection (2) below, grant relief in respect of that part of the patent which is found to be valid and infringed.
- (2) Where in any such proceedings it is found that a patent is only partially valid, the court or the comptroller shall not grant relief by way of damages, costs or expenses, except where the plaintiff or pursuer proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court or the comptroller may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court or the comptroller as to costs or expenses and as to the date from which damages should be reckoned.
- (3) As a condition of relief under this section the court or the comptroller may direct that the specification of the patent shall be amended to its or his satisfaction upon an application made for that purpose under section 75 below, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

### **64 Right to continue use begun before priority date**

- (1) Where a patent is granted for an invention, a person who in the United Kingdom before the priority date of the invention does in good faith an act which would constitute an infringement of the patent if it were in force, or makes in good faith effective and serious preparations to do such an act, shall have the rights conferred by subsection (2) below.
- (2) Any such person shall have the right—
  - (a) to continue to do or, as the case may be, to do that act himself; and
  - (b) if it was done or preparations had been made to do it in the course of a business, to assign the right to do it or to transmit that right on his death or, in the case of a body corporate on its dissolution, to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it, or to authorise it to be done by any partners of his for the time being in that business;

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and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

- (3) The rights mentioned in subsection (2) above shall not include the right to grant a licence to any person to do an act so mentioned.
- (4) Where a patented product is disposed of by any person to another in exercise of a right conferred by subsection (2) above, that other and any person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.

## **65 Certificate of contested validity of patent**

- (1) If in any proceedings before the court or the comptroller the validity of a patent to any extent is contested and that patent is found by the court or the comptroller to be wholly or partially valid, the court or the comptroller may certify the finding and the fact that the validity of the patent was so contested.
- (2) Where a certificate is granted under this section, then, if in any subsequent proceedings before the court or the comptroller for infringement of the patent concerned or for revocation of the patent a final order or judgment or interlocutor is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the court or the comptroller otherwise directs, be entitled to his costs or expenses as between solicitor and own client (other than the costs or expenses of any appeal in the subsequent proceedings).

## **66 Proceedings for infringement by a co-owner**

- (1) In the application of section 60 above to a patent of which there are two or more joint proprietors the reference to the proprietor shall be construed—
  - (a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 36 above or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and
  - (b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 36 above or any such agreement, is or are the proper person or persons to give the requisite consent.
- (2) One of two or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

## **67 Proceedings for infringement by exclusive licensee**

- (1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence ; and references to the proprietor of the patent in the provisions of this Act relating to infringement shall be construed accordingly.
- (2) In awarding damages or granting any other relief in any such proceedings the court or the comptroller shall take into consideration any loss suffered or likely to be suffered

by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

- (3) In any proceedings taken by an exclusive licensee by virtue of this section the proprietor of the patent shall be made a party to the proceedings, but if made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

## **68 Effect of non-registration on infringement proceedings**

Where by virtue of a transaction, instrument or event to which section 33 above applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent and the patent is subsequently infringed, the court or the comptroller shall not award him damages or order that he be given an account of the profits in respect of such a subsequent infringement occurring before the transaction, instrument or event is registered unless—

- (a) the transaction, instrument or event is registered within the period of six months beginning with its date ; or
- (b) the court or the comptroller is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.

## **69 Infringement of rights conferred by publication of application**

- (1) Where an application for a patent for an invention is published, then, subject to subsections (2) and (3) below, the applicant shall have, as from the publication and until the grant of the patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court or before the comptroller for damages in respect of any act which would have infringed the patent; and (subject to subsections (2) and (3) below) references in sections 60 to 62 and 66 to 68 above to a patent and the proprietor of a patent shall be respectively construed as including references to any such application and the applicant, and references to a patent being in force, being granted, being valid or existing shall be construed accordingly.
- (2) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only—
- (a) after the patent has been granted ; and
  - (b) if the act would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Patent Office.
- (3) Section 62(2) and (3) above shall not apply to an infringement of the rights conferred by this section, but in considering the amount of any damages for such an infringement, the court or the comptroller shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 16 above, that a patent would be granted conferring on the proprietor of the patent protection from an act of the same description as that found to infringe those

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rights, and if the court or the comptroller finds that it would not have been reasonable, it or he shall reduce the damages to such an amount as it or he thinks just.

## **70 Remedy for groundless threats of infringement proceedings**

- (1) Where a person (whether or not the proprietor of, or entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for any infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4) below, bring proceedings in the court against the person making the threats, claiming any relief mentioned in subsection (3) below.
- (2) In any such proceedings the plaintiff or pursuer shall, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them, be entitled to the relief claimed unless—
  - (a) the defendant or defender proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and
  - (b) the patent alleged to be infringed is not shown by the plaintiff or pursuer to be invalid in a relevant respect.
- (3) The said relief is—
  - (a) a declaration or declarator to the effect that the threats are unjustifiable;
  - (b) an injunction or interdict against the continuance of the threats; and
  - (c) damages in respect of any loss which the plaintiff or pursuer has sustained by the threats.
- (4) Proceedings may not be brought under this section for a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process.
- (5) It is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

## **71 Declaration or declarator as to non-infringement**

- (1) Without prejudice to the court's jurisdiction to make a declaration or declarator apart from this section, a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown—
  - (a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question ; and
  - (b) that the proprietor has refused or failed to give any such acknowledgment.
- (2) Subject to section 72(5) below, a declaration made by the comptroller under this section shall have the same effect as a declaration or declarator by the court.

## *Revocation of patents*

### **72 Power to revoke patents on application**

- (1) Subject to the following provisions of this Act, the court or the comptroller may on the application of any person by order revoke a patent for an invention on (but only on) any of the following grounds, that is to say—
  - (a) the invention is not a patentable invention ;
  - (b) the patent was granted to a person who was not the only person entitled under section 7(2) above to be granted that patent or to two or more persons who were not the only persons so entitled ;
  - (c) the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art;
  - (d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed, or, if the patent was granted on a new application filed under section 8(3), 12 or 37(4) above or as mentioned in section 15(4) above, in the earlier application, as filed ;
  - (e) the protection conferred by the patent has been extended by an amendment which should not have been allowed.
- (2) An application for the revocation of a patent on the ground mentioned in subsection (1) (b) above—
  - (a) may only be made by a person found by the court in an action for a declaration or declarator, or found by the court or the comptroller on a reference under section 37 above, to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked; and
  - (b) may not be made if that action was commenced or that reference was made after the end of the period of two years beginning with the date of the grant of the patent sought to be revoked, unless 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.
- (3) Rules under section 14(4) and (8) above shall, with any necessary modifications, apply for the purposes of subsection (1)(c) above as they apply for the purposes of section 14(3) above.
- (4) An order under this section may be an order for the unconditional revocation of the patent or, where the court or the comptroller determines that one of the grounds mentioned in subsection (1) above has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 75 below to the satisfaction of the court or the comptroller, as the case may be.
- (5) A decision of the comptroller or on appeal from the comptroller shall not estop any party to civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds referred to in subsection (1) above, whether or not any of the issues involved were decided in the said decision.
- (6) Where the comptroller refuses to grant an application made to him by any person under this section, no application (otherwise than by way of appeal or by way of putting validity in issue in proceedings for infringement) may be made to the court by that

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person under this section in relation to the patent concerned, without the leave of the court.

- (7) Where the comptroller has not disposed of an application made to him under this section, the applicant may not apply to the court under this section in respect of the patent concerned unless either—
- (a) the proprietor of the patent agrees that the applicant may so apply, or
  - (b) the comptroller certifies in writing that it appears to him that the question whether the patent should be revoked is one which would more properly be determined by the court.

### **73 Comptroller's power to revoke patents on his own initiative**

- (1) If it appears to the comptroller that an invention for which a patent has been granted formed part of the state of the art by virtue only of section 2(3) above, he may on his own initiative by order revoke the patent, but shall not do so without giving the proprietor of the patent an opportunity of making any observations and of amending the specification of the patent so as to exclude any matter which formed part of the state of the art as aforesaid without contravening section 76 below.
- (2) If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date and that the applications for both patents were filed by the same applicant or his successor in title, the comptroller may, on his own initiative but only after the relevant date, consider whether to revoke the patent granted under this Act and may, after giving the proprietor of the patent an opportunity of making any observations and of amending the specification of the patent, revoke the patent.
- (3) In this section " the relevant date " means whichever of the following dates is relevant, that is to say—
  - (a) the date on which the period for filing an opposition to the patent under the European Patent Convention expires without an opposition being filed ;
  - (b) the date when any opposition proceedings under that convention are finally disposed of by a decision to maintain the European patent;
  - (c) if later than either of the foregoing dates, the date when the patent under this Act is granted.

#### *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 under section 70 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—
- (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 before the end of the period of two years beginning with 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 section 37(1)(a) 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 the comptroller is considering its validity in order to decide whether to revoke it under section 73 above.

*General provisions as to amendment of patents and applications*

**75 Amendment of patent in infringement or revocation proceedings**

- (1) In any proceedings before the court or the comptroller in which the validity of a patent is put in issue the court or, as the case may be, the comptroller may, subject to section 76 below, allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the court or comptroller thinks fit.
- (2) A person may give notice to the court or the comptroller of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does

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so the court or the comptroller shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

- (3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.
- (4) Where an application for an order under this section is made to the court, the applicant shall notify the comptroller, who shall be entitled to appear and be heard and shall appear if so directed by the court.

## **76 Amendments of applications and patents not to include added matter**

- (1) An application for a patent (the later application) shall not be allowed to be filed under section 8(3), 12, or 37(4) above or as mentioned in section 15(4) above, in respect of any matter disclosed in an earlier application or the specification of a patent which has been granted, if the later application discloses matter which extends beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed.
- (2) No amendment of an application or the specification of a patent shall be allowed under any of the provisions of this Act to which this subsection applies if it—
  - (a) results in the application or specification disclosing any such matter, or
  - (b) (where a patent has been granted) extends the protection conferred by the patent.
- (3) Subsection (2) above applies to the following provisions of this Act, namely, sections 17(3), 18(3), 19(1), 27(1), 73 and 75.

## **PART II**

### PROVISIONS ABOUT INTERNATIONAL CONVENTIONS

#### *European patents and patent applications*

## **77 Effect of European patent (UK)**

- (1) Subject to the provisions of this Act, a European patent (UK) shall, as from the publication of the mention of its grant in the European Patent Bulletin, be treated for the purposes of Parts I and III of this Act as if it were a patent under this Act granted in pursuance of an application made under this Act and as if notice of the grant of the patent had, on the date of that publication, been published under section 24 above in the journal; and—
  - (a) the proprietor of a European patent (UK) shall accordingly as respects the United Kingdom have the same rights and remedies, subject to the same conditions, as the proprietor of a patent under this Act;
  - (b) references in Parts I and III of this Act to a patent shall be construed accordingly ; and
  - (c) any statement made and any certificate filed for the purposes of the provision of the convention corresponding to section 2(4)(c) above shall be respectively treated as a statement made and written evidence filed for the purposes of the said paragraph (c).



- (2) Subsection (1) above shall not affect the operation in relation to a European patent (UK) of any provisions of the European Patent Convention relating to the amendment or revocation of such a patent in proceedings before the European Patent Office.
- (3) Sections 58(7) to (9) and 63 above shall apply to the case where, after proceedings for the infringement of a European patent have been commenced before the court or the comptroller but have not been finally disposed of, it is established in proceedings before the European Patent Office that the patent is only partially valid as those provisions apply to proceedings in which the validity of a patent is put in issue and in which it is found that the patent is only partially valid.
- (4) Subject to subsection (6) below, where a European patent (UK) is amended or revoked in accordance with the European Patent Convention, the amendment shall be treated for the purposes of Parts I and III of this Act as if it had been made, or as the case may be the patent shall be treated for those purposes as having been revoked, under this Act.
- (5) Where—
  - (a) under the European Patent Convention a European patent (UK) is revoked for failure to observe a time limit and is subsequently restored ; and
  - (b) between the revocation and publication of the fact that it has been restored a person begins in good faith to do an act which would, apart from section 55 above, constitute an infringement of the patent or makes in good faith effective and serious preparations to do such an act;he shall have the rights conferred by section 28(6) above, and subsections (8) and (9) of that section shall apply accordingly.
- (6) While this subsection is in force—
  - (a) subsection (1) above shall not apply to a European patent (UK) the specification of which was published in French or German, unless a translation of the specification into English is filed at the Patent Office and the prescribed fee is paid before the end of the prescribed period;
  - (b) subsection (4) above shall not apply to an amendment made in French or German unless a translation of the amendment into English is filed at the Patent Office and the prescribed fee is paid before the end of the prescribed period.
- (7) Where a translation of a specification or amendment into English is not filed in accordance with subsection (6)(a) or (b) above, the patent shall be treated as always having been void.
- (8) The comptroller shall publish any translation filed at the Patent Office under subsection (6) above.
- (9) Subsection (6) above shall come into force on a day appointed for the purpose by rules and shall cease to have effect on a day so appointed, without prejudice, however, to the power to bring it into force again.

## **78 Effect of filing an application for a European patent (UK)**

- (1) Subject to the provisions of this Act, an application for a European patent (UK) having a date of filing under the European Patent Convention shall be treated for the purposes of the provisions of this Act to which this section applies as an application for a patent under this Act having that date as its date of filing and having the other incidents listed

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in subsection (3) below, but subject to the modifications mentioned in the following provisions of this section.

- (2) This section applies to the following provisions of this Act:—
- section 2(3) and so much of section 14(7) as relates to section 2(3);
  - section 5;
  - section 6;
  - so much of section 13(3) as relates to an application for and issue of a certificate under that subsection ;
  - sections 30 to 33 ;
  - section 36;
  - sections 55 to 69 ;
  - section 74, so far as relevant to any of the provisions mentioned above;
  - section 111; and
  - section 125.
- (3) The incidents referred to in subsection (1) above in relation to an application for a European patent (UK) are as follows:—
- (a) any declaration of priority made in connection with the application under the European Patent Convention shall be treated for the purposes of this Act as a declaration made under section 5(2) above;
  - (b) where a period of time relevant to priority is extended under that convention, the period of twelve months specified in section 5(2) above shall be so treated as altered correspondingly;
  - (c) where the date of filing an application is re-dated under that convention to a later date, that date shall be so treated as the date of filing the application;
  - (d) the application, if published in accordance with that convention, shall, subject to subsection (6) and section 79 below, be so treated as published under section 16 above;
  - (e) any designation of the inventor under that convention or any statement under it indicating the origin of the right to a European patent shall be treated for the purposes of section 13(3) above as a statement filed under section 13(2) above ;
  - (f) registration of the application in the register of European patents shall be treated as registration under this Act.
- (4) Rules under section 32 above may not impose any requirements as to the registration of applications for European patents (UK) but may provide for the registration of copies of entries relating to such applications in the European register of patents.
- (5) Subsections (1) to (3) above shall cease to apply to an application for a European patent (UK) when the application is refused or withdrawn or deemed to be withdrawn, or the designation of the United Kingdom in the application is withdrawn or deemed to be withdrawn, but if the rights of the applicant are re-established under the European Patent Convention, subsections (1) to (3) above shall as from the re-establishment of those rights again apply to the application.
- (6) Where between those subsections ceasing to apply to any such application and the re-establishment of the rights of the applicant a person begins in good faith to do an act which would, apart from section 55 above, constitute an infringement of the application if those subsections then applied, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by

section 28(6) above, and section 28(8) and (9) above shall apply to the exercise of any such right accordingly.

- (7) While this subsection is in force, an application for a European patent (UK) published by the European Patent Office under the European Patent Convention in French or German shall be treated for the purposes of sections 55 and 69 above as published under section 16 above when a translation into English of the claims of the specification of the application has been filed at and published by the Patent Office and the prescribed fee has been paid, but an applicant—
- (a) may recover a payment by virtue of section 55(5) above in respect of the use of the invention in question before publication of that translation ; or
  - (b) may bring proceedings by virtue of section 69 above in respect of an act mentioned in that section which is done before publication of that translation; if before that use or the doing of that act he has sent by post or delivered to the government department who made use or authorised the use of the invention, or, as the case may be, to the person alleged to have done the act, a translation into English of those claims.
- (8) Subsection (7) above shall come into force on a day appointed for the purpose by rules and shall cease to have effect on a day so appointed, without prejudice, however, to the power to bring it into force again.

## **79 Operation of s. 78 in relation to certain European patent applications**

- (1) Subject to the following provisions of this section, section 78 above, in its operation in relation to an international application for a patent (UK) which is treated by virtue of the European Patent Convention as an application for a European patent (UK), shall have effect as if any reference in that section to anything done in relation to the application under the European Patent Convention included a reference to the corresponding thing done under the Patent Co-operation Treaty.
- (2) Any such international application which is published under that treaty shall be treated for the purposes of section 2(3) above as published only when a copy of the application has been supplied to the European Patent Office in English, French or German and the relevant fee has been paid under that convention.
- (3) Any such international application which is published under that treaty in a language other than English, French or German shall, subject to section 78(7) above, be treated for the purposes of sections 55 and 69 above as published only when it is re-published in English, French or German by the European Patent Office under that convention.

## **80 Authentic text of European patents and patent applications**

- (1) Subject to subsection (2) below, the text of a European patent or application for such a patent in the language of the proceedings, that is to say, the language in which proceedings relating to the patent or the application are to be conducted before the European Patent Office, shall be the authentic text for the purposes of any domestic proceedings, that is to say, any proceedings relating to the patent or application before the comptroller or the court.
- (2) Where the language of the proceedings is French or German, a translation into English of the specification of the patent under section 77 above or of the claims of the application under section 78 above shall be treated as the authentic text for the purpose of any domestic proceedings, other than proceedings for the revocation of the patent,

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if the patent or application as translated into English confers protection which is narrower than that conferred by it in French or German.

- (3) If any such translation results in a European patent or application conferring the narrower protection, the proprietor of or applicant for the patent may file a corrected translation with the Patent Office and, if he pays the prescribed fee within the prescribed period, the Patent Office shall publish it, but—
- (a) any payment for any use of the invention which (apart from section 55 above) would have infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted, shall not be recoverable under that section,
  - (b) the proprietor or applicant shall not be entitled to bring proceedings in respect of an act which infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted,

unless before that use or the doing of the act the corrected translation has been published by the Patent Office or the proprietor or applicant has sent the corrected translation by post or delivered it to the government department who made use or authorised the use of the invention or, as the case may be, to the person alleged to have done that act.

- (4) Where a correction of a translation is published under subsection (3) above and before it is so published a person begins in good faith to do an act which would not constitute an infringement of the patent or application as originally translated but would (apart from section 55 above) constitute an infringement of it under the amended translation, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by section 28(6) above, and section 28(8) and (9) above shall apply to the exercise of any such right accordingly.

## **81 Conversion of European patent applications**

- (1) The comptroller may direct that on compliance with the relevant conditions mentioned in subsection (2) below an application for a European patent (UK) shall be treated as an application for a patent under this Act in the following cases :—
- (a) where the application is deemed to be withdrawn under the provisions of the European Patent Convention relating to the restriction of the processing of applications ;
  - (b) where under the convention the application is deemed to be withdrawn because it has not, within the period required by the convention, been received by the European Patent Office.
- (2) The relevant conditions referred to above are that—
- (a) in the case of an application falling within subsection (1)(a) above, the European Patent Office transmits a request of the applicant to the Patent Office that his application should be converted into an application under this Act, together with a copy of the files relating to the application;
  - (b) in the case of an application falling within subsection (1)(b) above,—
    - (i) the applicant requests the comptroller within the relevant prescribed period (where the application was filed with the Patent Office) to give a direction under this section, or
    - (ii) the central industrial property office of a country which is party to the convention, other than the United Kingdom, with which the

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- application was filed transmits within the relevant prescribed period a request that the application should be converted into an application under this Act, together with a copy of the application ; and
- (c) in either case the applicant within the relevant prescribed period pays the filing fee and if the application is in a language other than English, files a translation into English of the application and of any amendments previously made in accordance with the convention.
- (3) Where an application for a European patent falls to be treated as an application for a patent under this Act by virtue of a direction under this section—
- (a) the date which is the date of filing the application under the European Patent Convention shall be treated as its date of filing for the purposes of this Act, but if that date is re-dated under the convention to a later date, that later date shall be treated for those purposes as the date of filing the application;
  - (b) if the application satisfies a requirement of the convention corresponding to any of the requirements of this Act or rules designated as formal requirements, it shall be treated as satisfying that formal requirement;
  - (c) any document filed with the European Patent Office under any provision of the convention corresponding to any of the following provisions of this Act, that is to say, sections 2(4)(c), 5, 13(2) and 14, or any rule made for the purposes of any of those provisions, shall be treated as filed with the Patent Office under that provision or rule; and
  - (d) the comptroller shall refer the application for only so much of the examination and search required by sections 17 and 18 above as he considers appropriate in view of any examination and search carried out under the convention, and those sections shall apply with any necessary modifications accordingly.

## **82 Jurisdiction to determine questions as to right to a patent**

- (1) The court shall not have jurisdiction to determine a question to which this section applies except in accordance with the following provisions of this section.
- (2) Section 12 above shall not confer jurisdiction on the comptroller to determine a question to which this section applies except in accordance with the following provisions of this section.
- (3) This section applies to a question arising before the grant of a European patent whether a person has a right to be granted a European patent, or a share in any such patent, and in this section " employer-employee question " means any such question between an employer and an employee, or their successors in title, arising out of an application for a European patent for an invention made by the employee.
- (4) The court and the comptroller shall have jurisdiction to determine any question to which this section applies, other than an employer-employee question, if either of the following conditions is satisfied, that is to say—
  - (a) the applicant has his residence or principal place of business in the United Kingdom ; or
  - (b) the other party claims that the patent should be granted to him and he has his residence or principal place of business in the United Kingdom and the applicant does not have his residence or principal place of business in any of the relevant contracting states ;

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and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom.

- (5) The court and the comptroller shall have jurisdiction to determine an employer-employee question if either of the following conditions is satisfied, that is to say—
- (a) the employee is mainly employed in the United Kingdom; or
  - (b) the employee is not mainly employed anywhere or his place of main employment cannot be determined, but the employer has a place of business in the United Kingdom to which the employee is attached (whether or not he is also attached elsewhere);

and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom or, where there is such evidence of such an agreement, if the proper law of the contract of employment does not recognise the validity of the agreement.

- (6) Without prejudice to subsections (2) to (5) above, the court and the comptroller shall have jurisdiction to determine any question to which this section applies if there is written evidence that the parties have agreed to submit to the jurisdiction of the court or the comptroller, as the case may be, and, in the case of an employer-employee question, the proper law of the contract of employment recognises the validity of the agreement.
- (7) If, after proceedings to determine a question to which this section applies have been brought before the competent authority of a relevant contracting state other than the United Kingdom, proceedings are begun before the court or a reference is made to the comptroller under section 12 above to determine that question, the court or the comptroller, as the case may be, shall stay or sist the proceedings before the court or the comptroller unless or until the competent authority of that other state either—
- (a) determines to decline jurisdiction and no appeal lies from the determination or the time for appealing expires, or
  - (b) makes a determination which the court or the comptroller refuses to recognise under section 83 below.
- (8) References in this section to the determination of a question include respectively references to—
- (a) the making of a declaration or the grant of a declarator with respect to that question (in the case of the court); and
  - (b) the making of an order under section 12 above in relation to that question (in the case of the court or the comptroller).
- (9) In this section and section 83 below " relevant contracting state " means a country which is a party to the European Patent Convention and has not exercised its right under the convention to exclude the application of the protocol to the convention known as the Protocol on Recognition.

### **83 Effect of patent decisions of competent authorities of other states**

- (1) A determination of a question to which section 82 above applies by the competent authority of a relevant contracting state other than the United Kingdom shall, if no appeal lies from the determination or the time for appealing has expired, be recognised

in the United Kingdom as if it had been made by the court or the comptroller unless the court or he refuses to recognise it under subsection (2) below.

- (2) The court or the comptroller may refuse to recognise any such determination that the applicant for a European patent had no right to be granted the patent, or any share in it, if either—
  - (a) the applicant did not contest the proceedings in question because he was not notified of them at all or in the proper manner or was not notified of them in time for him to contest the proceedings ; or
  - (b) the determination in the proceedings in question conflicts with the determination of the competent authority of any relevant contracting state in proceedings instituted earlier between the same parties as in the proceedings in question.

#### **84 Patent agents and other representatives**

- (1) No individual shall carry on for gain in the United Kingdom, alone or in partnership with any other person, the business of acting as agent or other representative of other persons for the purpose of applying for or obtaining European patents or for the purpose of conducting proceedings in connection with such patents before the European Patent Office or the comptroller, or hold himself out or permit himself to be held out as so carrying on such a business, unless he satisfies the condition that his name and that of each of his partners appears on the European list.
- (2) Subsection (1) above shall not prohibit a barrister, advocate or solicitor of any part of the United Kingdom from conducting or otherwise taking part in any proceedings in connection with European patents before the European Patent Office or the comptroller to the same extent as he is entitled to take part in the corresponding proceedings in connection with patents under this Act before the Patent Office or the comptroller.
- (3) A body corporate shall not for gain act or describe itself or hold itself out as entitled to act as agent or other representative of other persons for any purpose mentioned in subsection (1) above unless permitted to do so under the European Patent Convention.
- (4) Any person who contravenes subsection (1) or (3) above shall be liable on summary conviction to a fine not exceeding £1,000.
- (5) Proceedings for an offence under this section may be begun at any time within twelve months from the date of the offence.
- (6) A person who does any act mentioned in subsection (1) above, but satisfies the condition mentioned in that subsection, shall not be treated as contravening section 114 below so long as he does not describe himself as a patent agent without qualification and does not hold himself out or permit himself to be held out as carrying on any business other than one mentioned in that subsection.
- (7) In this section " the European list" means the list of professional representatives maintained by the European Patent Office in pursuance of the European Patent Convention.

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## **85 European patent attorneys**

- (1) For the avoidance of doubt, it is hereby declared that any person whose name appears on the European list shall not be guilty of an offence under section 21 of the Solicitors Act 1974 or Article 22 of the Solicitors (Northern Ireland) Order 1976 by reason only of his describing himself as a European patent attorney.
- (2) A person whose name appears on the European list shall not be guilty of an offence under any of the enactments mentioned in subsection (3) below by reason only of the preparation by him of any document (other than a deed) for use in proceedings before the comptroller under this Act, in relation to a European patent or application for such a patent.
- (3) The enactments referred to in subsection (2) above (which prohibit the preparation for reward of certain instruments or writs by persons not legally qualified) are—
  - (a) section 22 of the Solicitors Act 1974 ;
  - (b) section 39 of the Solicitors (Scotland) Act 1933 ; and
  - (c) Article 23 of the Solicitors (Northern Ireland) Order 1976
- (4) In this section "the European list" means the list of professional representatives maintained by the European Patent Office in pursuance of the European Patent Convention.

### *Community patents*

## **86 Implementation of Community Patent Convention**

- (1) All rights, powers, liabilities, obligations and restrictions from time to time created or arising by or under the Community Patent Convention and all remedies and procedures from time to time provided for by or under that convention shall by virtue of this section have legal effect in the United Kingdom and shall be used there, be recognised and available in law and be enforced, allowed and followed accordingly.
- (2) The Secretary of State may by regulations make provision—
  - (a) for implementing any obligation imposed by that convention on a domestic institution or enabling any such obligation to be implemented or enabling any rights or powers conferred on any such institution to be exercised; and
  - (b) otherwise for giving effect to subsection (1) above and dealing with matters arising out of its commencement or operation.
- (3) Regulations under this section may include any incidental, consequential, transitional or supplementary provision appearing to the Secretary of State to be necessary or expedient, including provision amending any enactment, whenever passed, other than an enactment contained in this Part of this Act, and provision for the application of any provision of the regulations outside the United Kingdom.
- (4) Sections 12, 73(2), 77 to 80, 82 and 83 above shall not apply to any application for a European patent which under the Community Patent Convention is treated as an application for a Community patent, or to a Community patent (since any such application or patent falls within the foregoing provisions of this section).
- (5) In this section " domestic institution " means the court, the comptroller or the Patent Office, as the case may require.



## **87 Decisions on Community Patent Convention**

- (1) For the purposes of all legal proceedings, including proceedings before the comptroller, any question as to the meaning or effect of the Community Patent Convention, or as to the validity, meaning and effect of any instrument made under or in implementation of that convention by any relevant convention institution shall be treated as a question of law (and if not referred to the relevant convention court, be for determination as such in accordance with the principles laid down by and any relevant decision of that court).
- (2) In this section—
  - " relevant convention institution " means any institution established by or having functions under the Community Patent Convention, not being an institution of the United Kingdom or any other member state, and
  - " relevant convention court " does not include—
    - (a) the European Patent Office or any of its departments ; or
    - (b) a court of the United Kingdom or of any other member state.

## **88 Jurisdiction in legal proceedings in connection with Community Patent Convention**

- (1) For the purposes of the application in the United Kingdom of Article 69 of the Community Patent Convention (residence of a party as founding jurisdiction in actions for infringement, etc.) the residence of a party shall be determined in accordance with the following provisions of this section until such date as the Secretary of State may by order appoint for the repeal of those provisions.
- (2) For the purpose of determining whether a person is resident in any part of the United Kingdom the court shall apply the law of that part of the United Kingdom.
- (3) A company within the meaning of the Companies Act 1948 shall be treated for the purposes of subsection (2) above as resident in that part of the United Kingdom where its registered office is situated or where it has a principal place of business.
- (4) Any other body corporate or any unincorporated body of persons shall be so treated as resident in that part of the United Kingdom where it has a principal place of business.
- (5) Where any body has a principal place of business in two or more parts of the United Kingdom it shall be so treated as resident in all those parts.
- (6) If the court determines that a person is not resident in the United Kingdom, then, in order to determine whether he is resident in a country which is a party to the Community Patent Convention the court shall, except in a case falling within subsection (7) below, apply the law which would be applied by the courts of that country in order to found jurisdiction under that convention.
- (7) The question whether a person is to be taken for the purposes of this section as resident in the United Kingdom or any other country shall be determined in accordance with the law of that country of which he is a citizen if by that law his residence depends on that of another person or on the location of an authority.

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*International applications for patents*

**89 Effect of filing international application for a patent**

- (1) Subject to the provisions of this Act, an international application for a patent (UK) for which a date of filing has been accorded (whether by the Patent Office or by any other body) under the Patent Co-operation Treaty (in this section referred to as the Treaty) shall, until this subsection ceases to apply to the application, be treated for the purposes of Parts I and III of this Act as an application for a patent under this Act having that date as its date of filing and—
  - (a) the application, if published in accordance with the Treaty and if it satisfies relevant conditions, shall be so treated as published under section 16 above, subject, however, to subsection (7) below ;
  - (b) where the date of filing an application is re-dated under the Treaty to a later date, that date shall be so treated as the date of filing the application;
  - (c) any declaration of priority made under the Treaty shall be so treated as a declaration made under section 5(2) above;
  - (d) where a period of time relevant to priority is extended under the Treaty, the period of twelve months specified in section 5(2) above shall be treated as altered correspondingly;
  - (e) any statement of the name of the inventor under the Treaty shall be so treated as a statement filed under section 13(2) above ; and
  - (f) an amendment of the application made in accordance with the Treaty shall, if it satisfies the relevant conditions, be so treated as made under this Act.
- (2) Accordingly, until subsection (1) above ceases to apply to an application filed or published in accordance with the Treaty, the applicant shall, subject to subsection (7) below, have the same rights and remedies in relation to the application as an applicant for a patent under this Act has in relation to a filed or, as the case may be, a published application for such a patent.
- (3) Notwithstanding anything in subsection (1) above, the provisions of the Treaty and not those of this Act relating to publication, search, examination and amendment shall apply to any such application until all the relevant conditions are satisfied and, if those conditions are not satisfied before the end of the prescribed period, the application shall be taken to be withdrawn.
- (4) The relevant conditions—
  - (a) in the case of an application, are that a copy of the application and, if it is not in English, a translation into English have been filed at the Patent Office and the filing fee has been paid to the Patent Office by the applicant; and
  - (b) in the case of an amendment, are that a copy of the amendment and, if it is not in English, a translation into English have been filed at the Patent Office.
- (5) The comptroller shall on payment of the prescribed fee publish any translation filed at the Patent Office under subsection (4) above.
- (6) Before the relevant conditions are satisfied, subsection (1) above shall not operate so as to secure that an international application for a patent (UK) is to be treated for the purposes of section 8 above as an application for a patent under this Act and shall not affect the application of section 12 above to an invention for which an international application of a patent is made or proposed to be made, but when the

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relevant conditions are satisfied the international application shall be so treated and accordingly section 12 above shall not apply to it.

(7) For the purposes of sections 55 and 69 above an international application for a patent (UK) published in accordance with the Treaty—

- (a) shall, if published in English, be treated as published under section 16 above on its publication in accordance with the Treaty;
- (b) shall, if published in any other language and if the relevant conditions are satisfied, be treated as published under section 16 above on the publication of a translation of the application under subsection (5) above;

but, if the application is published in a language other than English, the applicant may recover a payment by virtue of section 55 above in respect of the use of the invention in question before publication of that translation, or may bring proceedings by virtue of section 69 above in respect of an act mentioned in that section which is done before publication of that translation, if before that use or the doing of that act he has sent by post or delivered to the government department who made use or authorised the use of the invention, or, as the case may be, to the person alleged to have done the act, a translation into English of the specification of the application.

(8) Subsection (1) above shall cease to apply to an international application for a patent (UK) if—

- (a) the application is withdrawn or deemed to be withdrawn ; or
- (b) the designation of the United Kingdom in the application is withdrawn or deemed to be withdrawn;

except where the application or the designation of the United Kingdom in the application is deemed to be withdrawn under the Treaty because of an error or omission in the Patent Office or any other institution having functions under the Treaty or of an application not being received by the International Bureau, owing to circumstances outside the applicant's control, before the end of the time limited for that purpose by the Treaty.

(9) Where the relevant conditions are satisfied before the end of the prescribed period, the comptroller shall refer the application for so much of the examination and search as is required by sections 17 and 18 above as he considers appropriate in view of any examination and search carried out under the Treaty, and those sections shall apply with any necessary modifications accordingly.

(10) The foregoing provisions of this section shall not apply to an international application for a patent (UK) which is treated by virtue of the European Patent Convention as an application for a European patent (UK) or which contains an indication that the applicant wishes to obtain a European patent (UK).

(11) If an international application for a patent which purports to designate the United Kingdom is refused a filing date under the Treaty and the comptroller determines that the refusal was caused by an error or omission in the Patent Office or any other institution having functions under the Treaty, he may direct that the application shall be treated as an application under this Act.

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### *Convention countries*

#### **90 Orders in Council as to convention countries**

- (1) Her Majesty may with a view to the fulfilment of a treaty or international convention, arrangement or engagement, by Order in Council declare that any country specified in the Order is a convention country for the purposes of section 5 above.
- (2) Her Majesty may by Order in Council direct that any of the Channel Islands, any colony or any British protectorate or protected state shall be taken to be a convention country for those purposes.
- (3) For the purposes of subsection (1) above every colony, protectorate, and territory subject to the authority or under the suzerainty of another country, and every territory administered by another country under the trusteeship system of the United Nations shall be taken to be a country in the case of which a declaration may be made under that subsection.

### *Miscellaneous*

#### **91 Evidence of conventions and instruments under conventions**

- (1) Judicial notice shall be taken of the following, that is to say—
  - (a) the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty (each of which is hereafter in this section referred to as the relevant convention);
  - (b) any bulletin, journal or gazette published under the relevant convention and the register of European or Community patents kept under it; and
  - (c) any decision of, or expression of opinion by, the relevant convention court on any question arising under or in connection with the relevant convention.
- (2) Any document mentioned in subsection (1)(b) above shall be admissible as evidence of any instrument or other act thereby communicated of any convention institution.
- (3) Evidence of any instrument issued under the relevant convention by any such institution, including any judgment or order of the relevant convention court, or of any document in the custody of any such institution or reproducing in legible form any information in such custody otherwise than in legible form, or any entry in or extract from such a document, may be given in any legal proceedings by production of a copy certified as a true copy by an official of that institution; and any document purporting to be such a copy shall be received in evidence without proof of the official position or handwriting of the person signing the certificate.
- (4) Evidence of any such instrument may also be given in any legal proceedings—
  - (a) by production of a copy purporting to be printed by the Queen's Printer;
  - (b) where the instrument is in the custody of a government department, by production of a copy certified on behalf of the department to be a true copy by an officer of the department generally or specially authorised to do so ;and any document purporting to be such a copy as is mentioned in paragraph (b) above of an instrument in the custody of a department shall be received in evidence without proof of the official position or handwriting of the person signing the certificate, or of his authority to do so, or of the document being in the custody of the department.

- (5) In any legal proceedings in Scotland evidence of any matter given in a manner authorised by this section shall be sufficient evidence of it.
- (6) In this section—
- " convention institution " means an institution established by or having functions under the relevant convention;
  - " relevant convention court " does not include a court of the United Kingdom or of any other country which is a party to the relevant convention; and
  - " legal proceedings ", in relation to the United Kingdom, includes proceedings before the comptroller.

## **92 Obtaining evidence for proceedings under the European Patent Convention**

- (1) Sections 1 to 3 of the Evidence (Proceedings in Other Jurisdictions) Act 1975 (provisions enabling United Kingdom courts to assist in obtaining evidence for foreign courts) shall apply for the purpose of proceedings before a relevant convention court under the European Patent Convention as they apply for the purpose of civil proceedings in a court exercising jurisdiction in a country outside the United Kingdom
- (2) In the application of those sections by virtue of this section any reference to the High Court, the Court of Session or the High Court of Justice in Northern Ireland shall include a reference to the comptroller.
- (3) Rules under this Act may include provision—
- (a) as to the manner in which an application under section 1 of the said Act of 1975 is to be made to the comptroller for the purpose of proceedings before a relevant convention court under the European Patent Convention ; and
  - (b) subject to the provisions of that Act, as to the circumstances in which an order can be made under section 2 of that Act on any such application.
- (4) Rules of court and rules under this Act may provide for an officer of the European Patent Office to attend the hearing of an application under section 1 of that Act before the court or the comptroller, as the case may be, and examine the witnesses or request the court or comptroller to put specified questions to the witnesses.
- (5) Section 1(4) of the Perjury Act 1911 and section 1(4) of the Perjury Act (Northern Ireland) 1946 (statements made for the purposes, among others, of judicial proceedings in a tribunal of a foreign state) shall apply in relation to proceedings before a relevant convention court under the European Patent Convention as they apply to a judicial proceeding in a tribunal of a foreign state.

## **93 Enforcement of orders for costs**

If the European Patent Office orders the payment of costs in any proceedings before it—

- (a) in England and Wales the costs 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;
- (b) in Scotland the order may be enforced in like manner as a recorded decree arbitral.
- (c) in Northern Ireland the order may be enforced as if it were a money judgment.

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**94 Communication of information to the European Patent Office, etc.**

It shall not be unlawful by virtue of any enactment to communicate the following information in pursuance of the European Patent Convention to the European Patent Office or the competent authority of any country which is party to the Convention, that is to say—

- (a) information in the files of the court which, in accordance with rules of court, the court authorises to be so communicated;
- (b) information in the files of the Patent Office which, in accordance with rules under this Act, the comptroller authorises to be so communicated.

**95 Financial provisions**

- (1) There shall be paid out of moneys provided by Parliament any sums required by any Minister of the Crown or government department to meet any financial obligation of the United Kingdom under the European Patent Convention, the Community Patent Convention or the Patent Co-operation Treaty.
- (2) Any sums received by any Minister of the Crown or government department in pursuance of either of those conventions or that treaty shall be paid into the Consolidated Fund.

**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 ;
  - (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.

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## **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

" 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.

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(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.

### *Offences*

## **109 Falsification of register, etc.**

If a person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy or reproduction of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be liable—

- (a) on summary conviction, to a fine not exceeding £1,000;
- (b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.

## **110 Unauthorised claim of patent rights**

- (1) If a person falsely represents that anything disposed of by him for value is a patented product he shall, subject to the following provisions of this section, be liable on summary conviction to a fine not exceeding £200.
- (2) For the purposes of subsection (1) above a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word "patent" or "patented" or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.
- (3) Subsection (1) above does not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).
- (4) In proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of the offence.

## **111 Unauthorised claim that patent has been applied for**

- (1) If a person represents that a patent has been applied for in respect of any article disposed of for value by him and—
  - (a) no such application has been made, or
  - (b) any such application has been refused or withdrawn,he shall, subject to the following provisions of this section, be liable on summary conviction to a fine not exceeding £200.
- (2) Subsection (1)(b) above does not apply where the representation is made (or continues to be made) before the expiry of a period which commences with the refusal or withdrawal and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

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- (3) For the purposes of subsection (1) above a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words " patent applied for " or " patent pending ", or anything expressing or implying that a patent has been applied for in respect of the article, shall be taken to represent that a patent has been applied for in respect of it.
- (4) In any proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of such an offence.

## **112 Misuse of title " Patent Office "**

If any person uses on his place of business, or on any document issued by him, or otherwise, the words " Patent Office " or any other words suggesting that his place of business is, or is officially connected with, the Patent Office, he shall be liable on summary conviction to a fine not exceeding £500.

## **113 Offences by corporations**

- (1) Where an offence under this Act which has been committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body corporate, or any person who was purporting to act in any such capacity, he, as well as the body corporate, shall be guilty of that offence and shall be liable to be proceeded against and punished accordingly.
- (2) Where the affairs of a body corporate are managed by its members, subsection (1) above shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

### *Patent agents*

## **114 Restrictions on practice as patent agent**

- (1) An individual shall not, either alone or in partnership with any other person, practise, describe himself or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent in the register of patent agents or (as the case may be) unless he and all his partners are so registered.
- (2) A body corporate shall not practise, describe itself or hold itself out or permit itself to be described or held out as mentioned in subsection (1) above unless—
  - (a) in the case of a company within the meaning of the Companies Act 1948 which began to carry on business as a patent agent before 17th November 1917, a director or the manager of the company is registered as a patent agent in the register of patent agents and the name of that director or manager is mentioned as being so registered in all professional advertisements, circulars or letters issued by or with the consent of the company in which the name of the company appears;
  - (b) in any other case, every director or, where the body's affairs are managed by its members, every member of the body and in any event, if it has a manager who is not a director or member, that manager, is so registered.

- (3) Any person who contravenes the provisions of this section shall be liable on summary conviction to a fine not exceeding £1,000.
- (4) Proceedings for an offence under this section may be begun at any time within twelve months from the date of the offence.
- (5) This section shall not be construed as prohibiting solicitors from taking such part in proceedings relating to patents and applications for patents as has heretofore been taken by solicitors and, in particular, shall not derogate from the provisions of section 102 above as it applies to solicitors.
- (6) A patent agent shall not be guilty of an offence under section 22 of the Solicitors Act 1974 or section 39 of the Solicitors (Scotland) Act 1933 (which prohibit the preparation for reward of certain instruments or writs by persons not legally qualified) by reason only of the preparation by him for use in proceedings under this Act before the comptroller or on appeal under this Act to the Patents Court from the comptroller of any document other than a deed.
- (7) For Article 23(2)(d) of the Solicitors (Northern Ireland) Order 1976 there shall be substituted the following paragraph—
  - “(d) a patent agent within the meaning of the Patents Act 1977 preparing, for use in proceedings under that Act or the Patents Act 1949 before the comptroller (as defined in the former Act) or on appeal under either of those Acts to the Patents Court from the comptroller, any document other than a deed ;”.

## **115 Power of comptroller to refuse to deal with certain agents**

- (1) Rules may authorise the controller to refuse to recognise as agent in respect of any business under this Act—
  - (a) any individual whose name has been erased from, and not restored to, the register of patent agents, or who is for the time being suspended from acting as a patent agent;
  - (b) any person who has been convicted of an offence under section 114 above or section 88 of the 1949 Act (which is replaced by section 114);
  - (c) any person who is found by the Secretary of State to have been convicted of any offence or to have been guilty of any such misconduct as, in the case of an individual registered in the register of patent agents, would render him liable to have his name erased from it;
  - (d) any person, not being registered as a patent agent, who in the opinion of the comptroller is engaged wholly or mainly in acting as agent in applying for patents in the United Kingdom or elsewhere in the name or for the benefit of a person by whom he is employed;
  - (e) any company or firm, if any person whom the comptroller could refuse to recognise as agent in respect of any business under this Act is acting as a director or manager of the company or is a partner in the firm.
- (2) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom.
- (3) Rules may authorise the comptroller to refuse to recognise as agent or other representative for the purpose of applying for European patents any person who does

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not satisfy the condition mentioned in section 84(1) above and does not fall within the exemption in subsection (2) of that section.

*Immunity of department*

**116 Immunity of department as regards official acts**

Neither the Secretary of State nor any officer of his—

- (a) shall be taken to warrant the validity of any patent granted under this Act or any treaty or international convention to which the United Kingdom is a party; or
- (b) shall incur any liability by reason of or in connection with any examination or investigation required or authorised by this Act or any such treaty or convention, or any report or other proceedings consequent on any such examination or investigation.

*Administrative provisions*

**117 Correction of errors in patents and applications**

- (1) The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.
- (2) Where the comptroller is requested to correct such an error or mistake, any person may in accordance with rules give the comptroller notice of opposition to the request and the comptroller shall determine the matter.

**118 Information about patent applications and patents, and inspection of documents**

- (1) After publication of an application for a patent in accordance with section 16 above the comptroller shall on a request being made to him in the prescribed manner and on payment of the prescribed fee (if any) give the person making the request such information, and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application as may be specified in the request, subject, however, to any prescribed restrictions.
- (2) Subject to the following provisions of this section, until an application for a patent is so published documents or information constituting or relating to the application shall not, without the consent of the applicant, be published or communicated to any person by the comptroller.
- (3) Subsection (2) above shall not prevent the comptroller from—
  - (a) sending the European Patent Office information which it is his duty to send that office in accordance with any provision of the European Patent Convention; or
  - (b) publishing or communicating to others any prescribed bibliographic information about an unpublished application for a patent;

nor shall that subsection prevent the Secretary of State from inspecting or authorising the inspection of an application for a patent or any connected documents under section 22(6)(a) above.

- (4) Where a person is notified that an application for a patent has been made, but not published in accordance with section 16 above, and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification after the application is so published, that person may make a request under subsection (1) above, notwithstanding that the application has not been published, and that subsection shall apply accordingly.
- (5) Where an application for a patent is filed, but not published, and a new application is filed in respect of any part of the subject-matter of the earlier application (either in accordance with rules or in pursuance of an order under section 8 above) and is published, any person may make a request under subsection (1) above relating to the earlier application and on payment of the prescribed fee the comptroller shall give him such information and permit him to inspect such documents as could have been given or inspected if the earlier application had been published.

#### **119 Service by post**

Any notice required or authorised to be given by this Act or rules, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

#### **120 Hours of business and excluded days**

- (1) Rules may specify the hour at which the Patent Office shall be taken to be closed on any day for purposes of the transaction by the public of business under this Act or of any class of such business, and may specify days as excluded days for any such purposes.
- (2) Any business done under this Act on any day after the hour so specified in relation to business of that class, or on a day which is an excluded day in relation to business of that class, shall be taken to have been done on the next following day not being an excluded day; and where the time for doing anything under this Act expires on an excluded day that time shall be extended to the next following day not being an excluded day.

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

Before 1st June in every year the comptroller shall cause to be laid before both Houses of Parliament a report with respect to the execution of this Act and the discharge of his functions under the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty, and every such report shall include an account of all fees, salaries and allowances, and other money received and paid by him under this Act, those conventions and that treaty during the previous year.

### *Supplemental*

#### **122 Crown's right to sell forfeited articles**

Nothing in this Act affects the right of the Crown or any person deriving title directly or indirectly from the Crown to dispose of or use articles forfeited under the laws relating to customs or excise.

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## 123 Rules

- (1) The Secretary of State may make such rules as he thinks expedient for regulating the business of the Patent Office in relation to patents and applications for patents (including European patents, applications for European patents and international applications for patents) and for regulating all matters placed by this Act under the direction or control of the comptroller ; and in this Act, except so far as the context otherwise requires, " prescribed " means prescribed by rules and " rules " means rules made under this section.
- (2) Without prejudice to the generality of subsection (1) above, rules may make provision—
  - (a) prescribing the form and contents of applications for patents and other documents which may be filed at the Patent Office and requiring copies to be furnished of any such documents ;
  - (b) regulating the procedure to be followed in connection with any proceeding or other matter before the comptroller or the Patent Office and authorising the rectification of irregularities of procedure;
  - (c) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the Patent Office and providing for the remission of fees in the prescribed circumstances ;
  - (d) regulating the mode of giving evidence in any such proceeding and empowering the comptroller to compel the attendance of witnesses and the discovery of and production of documents;
  - (e) requiring the comptroller to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding;
  - (f) requiring the comptroller to hold proceedings in Scotland in such circumstances as may be specified in the rules where there is more than one party to proceedings under section 8, 12, 37, 40(1) or (2), 41(8), 61(3), 71 or 72 above ;
  - (g) providing for the appointment of advisers to assist the comptroller in any proceeding before him ;
  - (h) prescribing time limits for doing anything required to be done in connection with any such proceeding by this Act or the rules and providing for the alteration of any period of time specified in this Act or the rules;
  - (i) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;
  - (j) without prejudice to any other provision of this Act, requiring and regulating the translation of documents in connection with an application for a patent or a European patent or an international application for a patent and the filing and authentication of any such translations;
  - (k) requiring the keeping of a register of patent agents and regulating the registration of patent agents and authorising in prescribed cases the erasure from the register of patent agents of the name of any person registered therein or the suspension of the right of any such person to act as a patent agent;
  - (l) providing for the publication and sale of documents in the Patent Office and of information about such documents.
- (3) Rules may make different provision for different cases.
- (4) Rules prescribing fees shall not be made except with the consent of the Treasury.



- (5) The remuneration of any adviser appointed under rules to assist the comptroller in any proceeding shall be determined by the Secretary of State with the consent of the Minister for the Civil Service and shall be defrayed out of moneys provided by Parliament.
- (6) Rules shall provide for the publication by the comptroller of a journal (in this Act referred to as "the journal") containing particulars of applications for and grants of patents, and of other proceedings under this Act.
- (7) Rules shall require or authorise the comptroller to make arrangements for the publication of reports of cases relating to patents, trade marks and registered designs decided by him and of cases relating to patents (whether under this Act or otherwise) trade marks, registered designs and copyright decided by any court or body (whether in the United Kingdom or elsewhere).

#### **124 Rules, regulations and orders; supplementary**

- (1) Any power conferred on the Secretary of State by this Act to make rules, regulations or orders shall be exercisable by statutory instrument.
- (2) Any Order in Council and any statutory instrument containing an order, rules or regulations under this Act, other than an order or rule required to be laid before Parliament in draft or an order under section 132(5) below, shall be subject to annulment in pursuance of a resolution of either House of Parliament.
- (3) Any Order in Council or order under any provision of this Act may be varied or revoked by a subsequent order.

#### **125 Extent of invention**

- (1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.
- (2) It is hereby declared for the avoidance of doubt that where more than one invention is specified in any such claim, each invention may have a different priority date under section 5 above.
- (3) The Protocol on the Interpretation of Article 69 of the European Patent Convention (which Article contains a provision corresponding to subsection (1) above) shall, as for the time being in force, apply for the purposes of subsection (1) above as it applies for the purposes of that Article.

#### **126 Stamp duty**

- (1) An instrument relating to a Community patent or to an application for a European patent shall not be chargeable with stamp duty by reason only of all or any of the provisions of the Community Patent Convention mentioned in subsection (2) below.
- (2) The said provisions are—

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- (a) Article 2.2 (Community patent and application for European patent in which the contracting states are designated to have effect throughout the territories to which the Convention applies);
- (b) Article 39.1(c) (Community patent treated as national patent of contracting state in which applicant's representative has place of business);
- (c) Article 39.1(c) as applied by Article 45 to an application for a European patent in which the contracting states are designated.

## **127 Existing patents and applications**

- (1) No application for a patent may be made under the 1949 Act on or after the appointed day.
- (2) Schedule 1 to this Act shall have effect for securing that certain provisions of the 1949 Act shall continue to apply on and after the appointed day to—
  - (a) a patent granted before that day ;
  - (b) an application for a patent which is filed before that day, and which is accompanied by a complete specification or in respect of which a complete specification is filed before that day;
  - (c) a patent granted in pursuance of such an application.
- (3) Schedule 2 to this Act shall have effect for securing that (subject to the provisions of that Schedule) certain provisions of this Act shall apply on and after the appointed day to any patent and application to which subsection (2) above relates, but, except as provided by the following provisions of this Act, this Act shall not apply to any such patent or application.
- (4) An application for a patent which is made before the appointed day, but which does not comply with subsection (2)(b) above, shall be taken to have been abandoned immediately before that day, but, notwithstanding anything in section 5(3) above, the application may nevertheless serve to establish a priority date in relation to a later application for a patent under this Act if the date of filing the abandoned application falls within the period of fifteen months immediately preceding the filing of the later application.
- (5) Schedule 3 to this Act shall have effect for repealing certain provisions of the 1949 Act.
- (6) The transitional provisions and savings in Schedule 4 to this Act shall have effect.
- (7) In Schedules 1 to 4 to this Act " existing patent " means a patent mentioned in subsection (2)(a) and (c) above, " existing application" means an application mentioned in subsection (2)(b) above, and expressions used in the 1949 Act and those Schedules have the same meanings in those Schedules as in that Act.

## **128 Priorities between patents and applications under 1949 Act and this Act**

- (1) The following provisions of this section shall have effect for the purpose of resolving questions of priority arising between patents and applications for patents under the 1949 Act and patents and applications for patents under this Act.
- (2) A complete specification under the 1949 Act shall be treated for the purposes of sections 2(3) and 5(2) above—
  - (a) if published under that Act, as a published application for a patent under this Act;

- (b) if it has a date of filing under that Act, as an application for a patent under this Act which has a date of filing under this Act;
- and in the said section 2(3), as it applies by virtue of this subsection in relation to any such specification, the words " both as filed and " shall be omitted.
- (3) In section 8(1), (2) and (4) of the 1949 Act (search for anticipation by prior claim) the references to any claim of a complete specification, other than the applicant's, published and filed as mentioned in section 8(1) shall include references to any claim contained in an application made and published under this Act or in the specification of a patent granted under this Act, being a claim in respect of an invention having a priority date earlier than the date of filing the complete specification under the 1949 Act.
- (4) In section 32(1)(a) of the 1949 Act (which specifies, as one of the grounds of revoking a patent, that the invention was claimed in a valid claim of earlier priority date contained in the complete specification of another patent), the reference to such a claim shall include a reference to a claim contained in the specification of a patent granted under this Act (a new claim) which satisfies the following conditions:—
- (a) the new claim must be in respect of an invention having an earlier priority date than that of the relevant claim of the complete specification of the patent sought to be revoked; and
- (b) the patent containing the new claim must be wholly valid or be valid in those respects which have a bearing on that relevant claim.
- (5) For the purposes of this section and the provisions of the 1949 Act mentioned in this section the date of filing an application for a patent under that Act and the priority date of a claim of a complete specification under that Act shall be determined in accordance with the provisions of that Act, and the priority date of an invention which is the subject of a patent or application for a patent under this Act shall be determined in accordance with the provisions of this Act.

## **129 Application of Act to Crown**

—This Act does not affect Her Majesty in her private capacity but, subject to that, it binds the Crown.

## **130 Interpretation**

- (1) In this Act, except so far as the context otherwise requires—
- " application for a European patent (UK) " and " international application for a patent (UK) " each mean an application of the relevant description which, on its date of filing, designates the United Kingdom;
- " appointed day ", in any provision of this Act, means the day appointed under section 132 below for the coming into operation of that provision ;
- " Community Patent Convention " means the Convention for the European Patent for the Common Market and " Community patent " means a patent granted under that convention;
- " comptroller " means the Comptroller-General of Patents, Designs and Trade Marks ;
- " Convention on International Exhibitions " means the Convention relating to International Exhibitions signed in Paris on 22nd November 1928, as

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amended or supplemented by any protocol to that convention which is for the time being in force ;

" court " means

- (a) as respects England and Wales, the High Court;
- (b) as respects Scotland, the Court of Session ;
- (c) as respects Northern Ireland, the High Court in Northern Ireland;

" date of filing " means—

- (a) in relation to an application for a patent made under this Act, the date which is the date of filing that application by virtue of section 15 above; and
- (b) in relation to any other application, the date which, under the law of the country where the application was made or in accordance with the terms of a treaty or convention to which that country is a party, is to be treated as the date of filing that application or is equivalent to the date of filing an application in that country (whatever the outcome of the application);

" designate " in relation to an application or a patent, means designate the country or countries (in pursuance of the European Patent Convention or the Patent Co-operation Treaty) in which protection is sought for the invention which is the subject of the application or patent;

" employee " means a person who works or (where the employment has ceased) worked under a contract of employment or in employment under or for the purposes of a government department;

" employer ", in relation to an employee, means the person by whom the employee is or was employed;

" European Patent Convention " means the Convention on the Grant of European Patents, "European patent" means a patent granted under that convention, " European patent (UK) " means a European patent designating the United Kingdom, "European Patent Bulletin " means the bulletin of that name published under that convention, and " European Patent Office " means the office of that name established by that convention ;

" exclusive licence " means a licence from the proprietor of or applicant for a patent conferring on the licensee, or on him and persons authorised by him, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application relates, and " exclusive licensee " and " non-exclusive licence " shall be construed accordingly;

" filing fee " means the fee prescribed for the purposes of section 14 above;

" formal requirements " means those requirements designated as such by rules made for the purposes of section 17 above;

" international application for a patent " means an application made under the Patent Co-operation Treaty;

" International Bureau " means the secretariat of the World Intellectual Property Organization established by a convention signed at Stockholm on 14th July 1967 ;

" international exhibition " means an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions or falling within the terms of any subsequent treaty or convention replacing that convention ;

" inventor " has the meaning assigned to it by section 7 above;

" journal " has the meaning assigned to it by section 123 (6) above;

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" mortgage ", when used as a noun, includes a charge for securing money or money's worth and, when used as a verb, shall be construed accordingly;

" 1949 Act " means the Patents Act 1949 ;

" patent " means a patent under this Act;

" patent agent " means a person carrying on for gain in the United Kingdom the business of acting as agent for other persons for the purpose of applying for or obtaining patents (other than European patents) in the United Kingdom or elsewhere or for the purpose of conducting proceedings in connection with such patents before the comptroller;

" Patent Co-operation Treaty " means the treaty of that name signed at Washington on 19th June 1970;

" patented invention " means an invention for which a patent is granted and " patented process " shall be construed accordingly;

" patented product " means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied ;

" prescribed " and " rules " have the meanings assigned to them by section 123 above ;

" priority date " means the date determined as such under section 5 above;

" published " means made available to the public (whether in the United Kingdom or elsewhere) and a document shall be taken to be published under any provision of this Act if it can be inspected as of right at any place in the United Kingdom by members of the public, whether on payment of a fee or not; and " republished " shall be construed accordingly ;

" register " and cognate expressions have the meanings assigned to them by section 32 above ;

" relevant convention court ", in relation to any proceedings under the European Patent Convention, the Community Patent Convention or the Patent Co-operation Treaty, means that court or other body which under that convention or treaty has jurisdiction over those proceedings, including (where it has such jurisdiction) any department of the European Patent Office ;

" right ", in relation to any patent or application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;

" search fee " means the fee prescribed for the purposes of section 17 above;

" services of the Crown " and " use for the services of the Crown " have the meanings assigned to them by section 56(2) above, including, as respects any period of emergency within the meaning of section 59 above, the meanings assigned to them by the said section 59.

- (2) Rules may provide for stating in the journal that an exhibition falls within the definition of international exhibition in subsection (1) above and any such statement shall be conclusive evidence that the exhibition falls within that definition.
- (3) For the purposes of this Act matter shall be taken to have been disclosed in any relevant application within the meaning of section 5 above or in the specification of a patent if it was either claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or specification.
- (4) References in this Act to an application for a patent, as filed, are references to such an application in the state it was on the date of filing.

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- (5) References in this Act to an application for a patent being published are references to its being published under section 16 above.
- (6) References in this Act to any of the following conventions, that is to say—
- (a) The European Patent Convention ;
  - (b) The Community Patent Convention ;
  - (c) The Patent Co-operation Treaty;
- are references to that convention or any other international convention or agreement replacing it, as amended or supplemented by any convention or international agreement (including in either case any protocol or annex), or in accordance with the terms of any such convention or agreement, and include references to any instrument made under any such convention or agreement.
- (7) Whereas by a resolution made on the signature of the Community Patent Convention the governments of the member states of the European Economic Community resolved to adjust their laws relating to patents so as (among other things) to bring those laws into conformity with the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty, it is hereby declared that the following provisions of this Act, that is to say, sections 1(1) to (4), 2 to 6, 14(3), (5) and (6), 37(5), 54, 60, 69, 72(1) and (2), 74(4), 82, 83, 88(6) and (7), 100 and 125, are so framed as to have, as nearly as practicable, the same effects in the United Kingdom as the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty have in the territories to which those Conventions apply.
- (8) The Arbitration Act 1950 shall not apply to any proceedings before the comptroller under this Act.
- (9) Except so far as the context otherwise requires, any reference in this Act to any enactment shall be construed as a reference to that enactment as amended or extended by or under any other enactment, including this Act.

### **131 Northern Ireland**

In the application of this Act to Northern Ireland—

- (a) "enactment" includes an enactment of the Parliament of Northern Ireland and a Measure of the Northern Ireland Assembly;
- (b) any reference to a government department includes a reference to a Department of the Government of Northern Ireland;
- (c) any reference to the Crown includes a reference to the Crown in right of Her Majesty's Government in Northern Ireland;
- (d) any reference to the Companies Act 1948 includes a reference to the corresponding enactments in force in Northern Ireland; and
- (e) the Arbitration Act (Northern Ireland) 1937 shall apply in relation to an arbitration in pursuance of this Act as if this Act related to a matter in respect of which the Parliament of Northern Ireland had power to make laws.

### **132 Short title, extent, commencement, consequential amendments and repeals**

- (1) This Act may be cited as the Patents Act 1977.

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- (2) This Act shall extend to the Isle of Man, subject to any modifications contained in an Order made by Her Majesty in Council, and accordingly, subject to any such order, references in this Act to the United Kingdom shall be construed as including references to the Isle of Man.
- (3) For the purposes of this Act the territorial waters of the United Kingdom shall be treated as part of the United Kingdom.
- (4) This Act applies to acts done in an area designated by order under section 1(7) of the Continental Shelf Act 1964, in connection with the exploration of the sea bed or subsoil or exploitation of their natural resources, as it applies to acts done in the United Kingdom.
- (5) This Act (except sections 77(6), (7) and (9), 78(7) and (8), this subsection and the repeal of section 41 of the 1949 Act) shall come into operation on such day as may be appointed by the Secretary of State by order, and different days may be appointed under this subsection for different purposes.
- (6) The consequential amendments in Schedule 5 shall have effect.
- (7) Subject to the provisions of Schedule 4 to this Act, the enactments specified in Schedule 6 to this Act (which include certain enactments which were spent before the passing of this Act) are hereby repealed to the extent specified in column 3 of that Schedule.

## SCHEDULES

### SCHEDULE 1

Section 127.

#### APPLICATION OF 1949 ACT TO EXISTING PATENTS AND APPLICATIONS

- 1 (1) The provisions of the 1949 Act referred to in sub-paragraph (2) below shall continue to apply on and after the appointed day in relation to existing patents and applications (but not in relation to patents and applications for patents under this Act).
- (2) The provisions are sections 1 to 10, 11(1) and (2), 12, 13, 15 to 17, 19 to 21, 22(1) to (3), 23 to 26, 28 to 33, 46 to 53, 55, 56, 59 to 67, 69, 76, 80, 87(2), 92(1), 96, 101, 102(1) and 103 to 107.
- (3) Sub-paragraph (1) above shall have effect subject to the following provisions of this Schedule, paragraph 2(b) of Schedule 3 below and the provisions of Schedule 4 below.
- 2 (1) In section 6 of the 1949 Act, at the end of the proviso to subsection (3) (post-dating of application) there shall be inserted “and—
- (c) no application shall, on or after the appointed day, be post-dated under this subsection to a date which is that of the appointed day or which falls after it”,
- and there shall be inserted at the end of subsection (4) “; but no application shall on or after the appointed day be post-dated under this subsection to a date which is that of the appointed day or which falls after it”.
- (2) At the end of subsection (5) of that section (ante-dating) there shall be inserted “; but a fresh application or specification may not be filed on or after the appointed day in accordance with this subsection and those rules unless the comptroller agrees that he will direct that the application or specification shall be ante-dated to a date which falls before the appointed day”.
- 3 (1) This paragraph and paragraph 4 below shall have effect with respect to the duration of existing patents after the appointed day, and in those paragraphs—
- (a) “old existing patent” means an existing patent the date of which fell eleven years or more before the appointed day and also any patent of addition where the patent for the main invention is, or was at any time, an old existing patent by virtue of the foregoing provision;
- (b) “new existing patent” means any existing patent not falling within paragraph (a) above; and
- (c) any reference to the date of a patent shall, in relation to a patent of addition, be construed as a reference to the date of the patent for the main invention.
- (2) Sections 23 to 25 of the 1949 Act (extension of patents on grounds of inadequate remuneration and war loss) shall not apply to a new existing patent.
- (3) The period for which the term of an old existing patent may be extended under section 23 or 24 of that Act shall not exceed in the aggregate four years, except



where an application, for an order under the relevant section has been made before the appointed day and has not been disposed of before that day.

- 4 (1) The term of every new existing patent under section 22(3) of the 1949 Act shall be twenty instead of sixteen years from the date of the patent, but—
- (a) the foregoing provision shall have effect subject to section 25(3) to (5) above ; and
  - (b) on and after the end of the sixteenth year from that date a patent shall not be renewed under section 25(3) to (5) above except by or with the consent of the proprietor of the patent.
- (2) Where the term of a new existing patent is extended by this paragraph,—
- (a) any licence in force under the patent from immediately before the appointed day until the end of the sixteenth year from the date of the patent shall, together with any contract relating to the licence, continue in force so long as the patent remains in force (unless determined otherwise than in accordance with this sub-paragraph), but, if it is an exclusive licence, it shall after the end of that year be treated as a non-exclusive licence ;
  - (b) notwithstanding the terms of the licence, the licensee shall not be required to make any payment to the proprietor for working the invention in question after the end of that year;
  - (c) every such patent shall after the end of that year be treated as endorsed under section 35 of the 1949 Act (licences of right).
- (3) Where the term of a new existing patent is extended by this paragraph and any government department or any person authorised by a government department—
- (a) has before the appointed day, used the invention in question for the services of the Crown ; and
  - (b) continues to so use it until the end of the sixteenth year from the date of the patent,
- any such use of the invention by any government department or person so authorised, after the end of that year, may be made free of any payment to the proprietor of the patent.
- (4) Without prejudice to any rule of law about the frustration of contracts, where any person suffers loss or is subjected to liability by reason of the extension of the term of a patent by this paragraph, the court may on the application of that person determine how and by whom the loss or liability is to be borne and make such order as it thinks fit to give effect to the determination.
- (5) No order shall be made on an application under sub-paragraph (4) above which has the effect of imposing a liability on any person other than the applicant unless notification of the application is given to that person.
- 5 In section 26(3) of the 1949 Act (no patent of addition unless date of filing of complete specification was the same as or later than the date of filing of complete specification in respect of main invention) after " main invention" there shall be inserted " and was earlier than the date of the appointed day " .
- 6 Notwithstanding anything in section 32(1)(j) of the 1949 Act (ground for revocation that patent was obtained on a false suggestion or representation), it shall not be a ground of revoking a patent under that subsection that the patent was obtained on a false suggestion or representation that a claim of the complete specification of

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the patent had a priority date earlier than the date of filing the application for the patent, but if it is shown—

- (a) on a petition under that section or an application under section 33 of that Act; or
  - (b) by way of defence or on a counterclaim on an action for infringement;
- that such a suggestion or representation was falsely made, the priority date of the claim shall be taken to be the date of filing the application for that patent.

- 7 (1) In section 33 of the 1949 Act (revocation of patent by comptroller), in subsection (1) for the words preceding the proviso there shall be substituted—

“(1) Subject to the provisions of this Act, a patent may, on the application of any person interested, be revoked by the comptroller on any of the grounds set out in section 32(1) of this Act.”.

- (2) At the end of the said section 33 there shall be added the following subsection:—

“(5) A decision of the comptroller or on appeal from the comptroller shall not estop any party to civil proceedings in which infringement of a patent is in issue from alleging that any claim of the specification is invalid on any of the grounds set out in section 32(1) of this Act, whether or not any of the issues involved were decided in that decision.”.

- 8 In section 101(1) of the 1949 Act (interpretation) there shall be inserted in the appropriate place—

““ appointed day ” means the day appointed under section 132 of the Patents Act 1977 for the coming into operation of Schedule 1 to that Act;”.

## SCHEDULE 2

Section 127.

### APPLICATION OF THIS ACT TO EXISTING PATENTS AND APPLICATIONS

- 1 (1) Without prejudice to those provisions of Schedule 4 below which apply (in certain circumstances) provisions of this Act in relation to existing patents and applications, the provisions of this Act referred to in sub-paragraph (2) below shall apply in relation to existing patents and applications on and after the appointed day subject to the following provisions of this Schedule and the provisions of Schedule 4 below.

- (2) The provisions are sections 22, 23, 25(3) to (5), 28 to 36, 44 to 54, 86, 96, 98, 99, 101 to 105, 107 to 111, 113 to 116, 118(1) to (3), 119 to 124, 130 and 132(2), (3) and (4).

- 2 In those provisions as they apply by virtue of this Schedule—

- (a) a reference to this Act includes a reference to the 1949 Act;
- (b) a reference to a specified provision of this Act other than one of those provisions shall be construed as a reference to the corresponding provision of the 1949 Act (any provision of that Act being treated as corresponding to a provision of this Act if it was enacted for purposes which are the same as or similar to that provision of this Act) ;
- (c) a reference to rules includes a reference to rules under the 1949 Act;
- (d) references to a patent under this Act and to an application for such a patent include respectively a reference to an existing patent and application ;
- (e) references to the grant of a patent under this Act includes a reference to the sealing and grant of an existing patent;

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- (f) a reference to a patented product and to a patented invention include respectively a reference to a product and invention patented under an existing patent;
- (g) references to a published application for a patent under this Act, and to publication of such an application, include respectively references to a complete specification which has been published under the 1949 Act and to publication of such a specification (and a reference to an application for a patent under this Act which has not been published shall be construed accordingly);
- (h) a reference to the publication in the journal of a notice of the grant of a patent includes a reference to the date of an existing patent;
- (i) a reference to the priority date of an invention includes a reference to the priority date of the relevant claim of the complete specification.

### SCHEDULE 3

Section 127.

#### REPEALS OF PROVISIONS OF 1949 ACT

- 1 Subject to the provisions of Schedule 4 below, the provisions of the 1949 Act referred to in paragraph 2 below (which have no counterpart in the new law of patents established by this Act in relation to future patents and applications) shall cease to have effect.
- 2 The provisions are:—
- (a) section 14 (opposition to grant of patent);
  - (b) section 32(3) (revocation for refusal to comply with Crown request to use invention);
  - (c) section 41 (inventions relating to food or medicine, etc.);
  - (d) section 42 (comptroller's power to revoke patent after expiry of two years from grant of compulsory licence);
  - (e) section 71 (extension of time for certain convention applications) ;
  - (f) section 72 (protection of inventions communicated under international agreements).

### SCHEDULE 4

Section 127.

#### TRANSITIONAL PROVISIONS

##### *General*

- 1 In so far as any instrument made or other thing done under any provision of the 1949 Act which is repealed by virtue of this Act could have been made or done under a corresponding provision of this Act, it shall not be invalidated by the repeals made by virtue of this Act but shall have effect as if made or done under that corresponding provision.

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*Use of patented invention for services of the Crown*

- 2 (1) Any question whether—
- (a) an act done before the appointed day by a government department or a person authorised in writing by a government department amounts to the use of an invention for the services of the Crown ; or
  - (b) any payment falls to be made in respect of any such use (whether to a person entitled to apply for a patent for the invention, to the patentee or to an exclusive licensee) ;
- shall be determined under sections 46 to 49 of that Act and those sections shall apply accordingly.
- (2) Sections 55 to 59 above shall apply to an act so done on or after the appointed day in relation to an invention—
- (a) for which an existing patent has been granted or an existing application for a patent has been made ; or
  - (b) which was communicated before that day to a government department or any person authorised in writing by a government department by the proprietor of the patent or any person from whom he derives title ;
- and shall so apply subject to sub-paragraph (3) below, the modifications contained in paragraph 2 of Schedule 2 above and the further modification that sections 55(5) (b) and 58(10) above shall not apply in relation to an existing application.
- (3) Where an act is commenced before the appointed day and continues to be done on or after that day, then, if it would not amount to the use of an invention for the services of the Crown under the 1949 Act, its continuance on or after that day shall not amount to such use under this Act.

*Infringement*

- 3 (1) Any question whether an act done before the appointed day infringes an existing patent or the privileges or rights arising under a complete specification which has been published shall be determined in accordance with the law relating to infringement in force immediately before that day and, in addition to those provisions of the 1949 Act which continue to apply by virtue of Schedule 1 above, section 70 of that Act shall apply accordingly.
- (2) Sections 60 to 71 above shall apply to an act done on or after the appointed day which infringes an existing patent or the privileges or rights arising under a complete specification which has been published (whether before, on or after the appointed day) as they apply to infringements of a patent under this Act or the rights conferred by an application for such a patent, and shall so apply subject to sub-paragraph (3) below, the modifications contained in paragraph 2 of Schedule 2 above and the further modification that section 69(2) and (3) above shall not apply in relation to an existing application.
- (3) Where an act is commenced before the appointed day and continues to be done on or after that day, then, if it would not, under the law in force immediately before that day, amount to an infringement of an existing patent or the privileges or rights arising under a complete specification, its continuance on or after that day shall not amount to the infringement of that patent or those privileges or rights.

*Notice of opposition*

- 4 (1) Where notice of opposition to the grant of a patent has been given under section 14 of the 1949 Act before the appointed day, the following provisions shall apply:—
- (a) if issue has been joined on the notice before the appointed day, the opposition, any appeal from the comptroller's decision on it and any further appeal shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court;
  - (b) in any other case, the notice shall be taken to have abated immediately before the appointed day.
- (2) Sub-paragraph (1)(a) above shall have effect subject to paragraph 12(2) below.

*Secrecy*

- 5 (1) Where directions given under section 18 of the 1949 Act in respect of an existing application (directions restricting publication of information about inventions) are in force immediately before the appointed day, they shall continue in force on and after that day and that section shall continue to apply accordingly.
- (2) Where sub-paragraph (1) above does not apply in the case of an existing application section 18 of the 1949 Act shall not apply to the application but section 22 of this Act shall.
- (3) Where the comptroller has before the appointed day served a notice under section 12 of the Atomic Energy Act 1946 (restrictions on publication of information about atomic energy etc.) in respect of an existing application that section shall continue to apply to the application on and after that day; but where no such notice has been so served that section shall not apply to the application on and after that day.

*Revocation*

- 6 (1) Where before the appointed day an application has been made under section 33 of the 1949 Act for the revocation of a patent (the original application), the following provisions shall apply:—
- (a) if issue has been joined on the application before the appointed day, the application, any appeal from the comptroller's decision on it and any further appeal shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court;
  - (b) if issue has not been so joined, the original application shall be taken to be an application under section 33 of the 1949 Act for the revocation of the patent on whichever of the grounds referred to in section 32(1) of that Act corresponds (in the comptroller's opinion) to the ground on which the original application was made, or, if there is no ground which so corresponds, shall be taken to have abated immediately before the appointed day.
- (2) Sub-paragraph (1)(a) above shall have effect subject to paragraph 11(3) below.
- 7 (1) This paragraph applies where an application has been made before the appointed day under section 42 of the 1949 Act for the revocation of a patent.

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- (2) Where the comptroller has made no order before that day for the revocation of the patent under that section, the application shall be taken to have abated immediately before that day.
- (3) Where the comptroller has made such an order before that day, then, without prejudice to section 38 of the Interpretation Act 1889, section 42 shall continue to apply to the patent concerned on and after that day as if this Act had not been enacted.

*Licences of right and compulsory licences*

- 8 (1) Sections 35 to 41 and 43 to 45 of the 1949 Act shall continue to apply on and after the relevant day—
  - (a) to any endorsement or order made or licence granted under sections 35 to 41 which is in force immediately before that day; and
  - (b) to any application made before that day under sections 35 to 41.
- (2) Any appeal from a decision or order of the comptroller instituted under sections 35 to 41 or 43 to 45 on or after the relevant day (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.
- (3) In this paragraph " the relevant day " means, in relation to section 41, the date of the passing of this Act and, in relation to sections 35 to 40 and 43 to 45, the appointed day.

*Convention countries*

- 9 (1) Without prejudice to paragraph 1 above, an Order in Council declaring any country to be a convention country for all purposes of the 1949 Act or for the purposes of section 1(2) of that Act and in force immediately before the appointed day shall be treated as an Order in Council under section 90 above declaring that country to be a convention country for the purposes of section 5 above.
- (2) Where an Order in Council declaring any country to be a convention country for all purposes of the 1949 Act or for the purposes of section 70 of that Act is in force immediately before the appointed day, a vessel registered in that country (whether before, on or after that day) shall be treated for the purposes of section 60 above, as it applies by virtue of paragraph 3(2) above to an existing patent or existing application, as a relevant ship and an aircraft so registered and a land vehicle owned by a person ordinarily resident in that country shall be so treated respectively as a relevant aircraft and a relevant vehicle.

*Appeals from court on certain petitions for revocation*

- 10 Where the court has given judgment on a petition under section 32(1)(j) of the 1949 Act before the appointed day, any appeal from the judgment (whether instituted before, on or after that day) shall be continued or instituted and be disposed of under the old law.

*Appeals from comptroller under continuing provisions of 1949 Act*

- 11 (1) In this paragraph "the continuing 1949 Act provisions " means the provisions of the 1949 Act which continue to apply on and after the appointed day as mentioned in paragraph 1 of Schedule 1 above.

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- (2) This paragraph applies where—
  - (a) the comptroller gives a decision or direction (whether before or on or after the appointed day) under any of the continuing 1949 Act provisions, and
  - (b) an appeal lies under those provisions from the decision or direction;but this paragraph applies subject to the foregoing provisions of this Schedule.
- (3) Where such an appeal has been instituted before the Appeal Tribunal before the appointed day, and the hearing of the appeal has begun but has not been completed before that day, the appeal (and any further appeal) shall be continued and disposed of under the old law.
- (4) Where such an appeal has been so instituted, but the hearing of it has not begun before the appointed day, it shall be transferred by virtue of this sub-paragraph to the Patents Court on that day and the appeal (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.
- (5) Any such appeal instituted on or after the appointed day shall lie to the Patents Court or, where the proceedings appealed against were held in Scotland, the Court of Session; and accordingly, the reference to the Appeal Tribunal in section 31(2) of the 1949 Act shall be taken to include a reference to the Patents Court or (as the case may be) the Court of Session.
- (6) Section 97(3) of this Act shall apply to any decision of the Patents Court on an appeal instituted on or after the appointed day from a decision or direction of the comptroller under any of the continuing 1949 Act provisions as it applies to a decision of that Court referred to in that subsection, except that for references to the sections mentioned in paragraph (a) of that subsection there shall be substituted references to sections 33, 55 and 56 of the 1949 Act.

*Appeals from comptroller under repealed provisions of 1949 Act*

- 12 (1) This paragraph applies where an appeal to the Appeal Tribunal has been instituted before the appointed day under any provision of the 1949 Act repealed by this Act.
- (2) Where the hearing of such an appeal has begun but has not been completed before that day, the appeal (and any further appeal) shall be continued and disposed of under the old law.
- (3) Where the hearing of such an appeal has not begun before that day, it shall be transferred by virtue of this sub-paragraph to the Patents Court on that day and the appeal (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.

*Appeals from Appeal Tribunal to Court of Appeal*

- 13 Section 87(1) of the 1949 Act shall continue to apply on and after the appointed day to any decision of the Appeal Tribunal given before that day, and any appeal by virtue of this paragraph (and any further appeal) shall be prosecuted under the old law.

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

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*Rules*

- 14 The power to make rules under section 123 of this Act shall include power to make rules for any purpose mentioned in section 94 of the 1949 Act.

*Supplementary*

- 15 Section 97(2) of this Act applies to—
- (a) any appeal to the Patents Court by virtue of paragraph 4(1)(a), 6(1)(a), 8(2) or 11(5) above, and
  - (b) any appeal which is transferred to that Court by virtue of paragraph 11(4) or 12(3) above,
- as it applies to an appeal under that section ; and section 97 of this Act shall apply for the purposes of any such appeal instead of section 85 of the 1949 Act.
- 16 In this Schedule " the old law " means the 1949 Act, any rules made under it and any relevant rule of law as it was or they were immediately before the appointed day.
- 17 For the purposes of this Schedule—
- (a) issue is joined on a notice of opposition to the grant of a patent under section 14 of the 1949 Act when the applicant for the patent files a counter-statement fully setting out the grounds on which the opposition is contested ;
  - (b) issue is joined on an application for the revocation of a patent under section 33 of that Act when the patentee files a counter-statement fully setting out the grounds on which the application is contested.
- 18 (1) Nothing in the repeals made by this Act in sections 23 and 24 of the 1949 Act shall have effect as respects any such application as is mentioned in paragraph 3(3) of Schedule 1 above.
- (2) Nothing in the repeal by this Act of the Patents Act 1957 shall have effect as respects existing applications.
- (3) Section 69 of the 1949 Act (which is not repealed by this Act) and section 70 of that Act (which continues to have effect for certain purposes by virtue of paragraph 3 above) shall apply as if section 68 of that Act has not been repealed by this Act and as if paragraph 9 above had not been enacted.

SCHEDULE 5

Section 132.

CONSEQUENTIAL AMENDMENTS

*Crown Proceedings Act 1947 (c. 44)*

- 1 In section 3 of the Crown Proceedings Act 1947, for subsection (2) there shall be substituted:—
- “(2) Nothing in the preceding subsection or in any other provision of this Act shall affect the rights of any Government department under Schedule 1 to the Registered Designs Act 1949 or section 55 of the Patents Act 1977, or the rights of the Secretary of State under section 22 of the said Act of 1977.”



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

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*Registered Designs Act 1949 (c. 88)*

- 2 In section 32(1) of the Registered Designs Act 1949—
- (a) in paragraph (a), for " the Patents Act 1949 " there shall be substituted " the Patents Act 1977 "; and
  - (b) in paragraph (c), after " 1949 " there shall be inserted " or section 114 of the Patents Act 1977 ".
- 3 In sections 42 and 44(1) of the Registered Designs Act 1949, for " the Patents Act 1949 " there shall be substituted, in each case, " the Patents Act 1977 ".

*Defence Contracts Act 1958 (c. 38)*

- 4 In subsection (4) of section 4 of the Defence Contracts Act 1958, for the words from " Patents Act 1949 " to the end there shall be substituted " Patents Act 1977 ".

*Administration of Justice Act 1970 (c. 31)*

- 5 (1) In subsections (2) and (3) of section 10 of the Administration of Justice Act 1970 for "either" there shall be substituted, in each case, " the ".
- (2) In subsection (4) of the said section 10, for " (as so amended)" there shall be substituted " (as amended by section 24 of the Administration of Justice Act 1969) ".
- (3) For subsection (5) of the said section 10, there shall be substituted:—
- “(5) In subsection (8) of the said section 28 (which confers power on the Tribunal to make rules about procedure etc.), there shall be inserted at end of the subsection the words " including right of audience”.

*Atomic Energy Authority (Weapons Group) Act 1973 (c. 4)*

- 6 In section 5(2) of the Atomic Energy Authority (Weapons Group) Act 1973—
- (a) after the first " Patents Act 1949 " there shall be inserted " , the Patents Act 1977 " ; and
  - (b) after the second " Patents Act 1949 " there shall be inserted " section 55(4) of the Patents Act 1977 ".

*Fair Trading Act 1973 (c. 41)*

- 7 (1) In paragraph 10 of Schedule 4 to the Fair Trading Act 1973 for "Patents Act 1949" there shall be substituted " Patents Act 1977 ".
- (2) After the said paragraph 10 there shall be inserted:—
- “10A The services of persons carrying on for gain in the United Kingdom the business of acting as agents or other representatives of other persons for the purpose of applying for or obtaining European patents or for the purpose of conducting proceedings in connection with such patents before the European Patent Office or the comptroller and whose names appear on the European list (within the meaning of section 84(7) of the Patents Act 1977) in their capacity as such persons.”

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

*Restrictive Trade Practices Act 1976 (c. 34)*

8 (1) In paragraph 10 of Schedule 1 to the Restrictive Trade Practices Act 1976, for " the Patents Act 1949 " there shall be substituted " the Patents Act 1977 ".

(2) After the said paragraph 10 there shall be inserted:—

“10A The services of persons carrying on for gain in the United Kingdom the business of acting as agents or other representatives of other persons for the purpose of applying for or obtaining European patents or for the purpose of conducting proceedings in connection with such patents before the European Patent Office or the comptroller and whose names appear on the European list (within the meaning of section 84(7) of the Patents Act 1977), in their capacity as such persons.”

SCHEDULE 6

Section 132.

ENACTMENTS REPEALED

Chapter	Short Title	Extent of Repeal
7 Edw. 7. c. 29.	The Patents and Designs Act 1907.	Section 47(2).
9 & 10 Geo. 6. c. 80.	The Atomic Energy Act 1946.	In section 12, subsections (1) to (7).
12, 13 & 14 Geo. 6. c. 87.	The Patents Act 1949.	Section 11(3). Section 14. Section 16(6). Section 18. Section 22(4) and (5). In section 23(1), the words from "(not exceeding" to "ten years)". In section 24, in subsection (1), the words "(not exceeding ten years)" and, in subsection (7), the words from "but" to the end. Section 27. In section 32, subsection (3). In section 33(3), the proviso. Sections 34 to 45. Sections 54, 57 and 58. Section 68. Sections 70 to 75.

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Chapter	Short Title	Extent of Repeal
		Sections 77 to 79. Sections 81 to 86. Section 87(1) and (3). Sections 88 to 91. Sections 93 to 95. Sections 97 to 100. Section 102(2). Schedule 1. Schedule 3, except paragraphs 1 and 26.
5 & 6 Eliz. 2. c. 13.	The Patents Act 1957.	The whole Act, except in relation to existing applications.
9 & 10 Eliz. 2. c. 25.	The Patents and Designs (Renewals, Extensions and Fees) Act 1961.	In section 1(1), the words from " subsection (5) " to " and in ". Section 2.
10 & 11 Eliz. 2. c. 30.	The Northern Ireland Act 1962.	In Schedule 1, the entry relating to section 84 of the Patents Act 1949.
1967 c. 80.	The Criminal Justice Act 1967.	In Schedule 3, in Parts I and IV, the entries relating to the Patents Act 1949.
1968. c. 64.	The Civil Evidence Act 1968.	Section 15.
1969 c. 58.	The Administration of Justice Act 1969.	In section 24, in subsection (1), the words " 85 of the Patents Act 1949 and section " and " each of ", in subsections (2), (3) and (4) the words " of each of those sections " and in subsection (4) the words from "as subsection (11)" to "and" and the words "in the case of the said section 28 ".
1970 c. 31.	The Administration of Justice Act 1970.	In section 10, in subsection (1), the words " Patents Appeal Tribunal or the " and in subsection (4), the words from " the Patents Appeal" to " and ".
1971 c. 23.	The Courts Act 1971.	Section 46.

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

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Chapter	Short Title	Extent of Repeal
1971 c. 36 (N.I.)	The Civil Evidence Act (Northern Ireland) 1971.	Section 11.
1973 c. 41.	The Fair Trading Act 1973.	Section 126. In Schedule 3, in paragraph 16(2), the words from " of section 40" to "Commission)", where first occurring. In Schedule 12, the entry relating to the Patents Act 1949.
1974 c. 47	The Solicitors Act 1974.	In Schedule 3, paragraph 3.