



# Patents Act 1977

## 1977 CHAPTER 37

### PART I

#### NEW DOMESTIC LAW

##### *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—

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(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, assignments 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 assignment 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 assignment 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.

### **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

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- (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
  - (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—
  - (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.

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- (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.
- (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 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.