



Patents Act 2004

2004 CHAPTER 16

Other amendments of the 1977 Act

12 Threats of infringement proceedings

(1) Section 70 of the 1977 Act (remedy for groundless threats of infringement proceedings) is amended as follows.

(2) For subsection (2) there is substituted—

“(2) In any such proceedings the claimant or pursuer shall, subject to subsection (2A) below, be entitled to the relief claimed if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them.

(2A) If 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—

- (a) the claimant or pursuer shall be entitled to the relief claimed only if he shows that the patent alleged to be infringed is invalid in a relevant respect;
- (b) even if the claimant or pursuer does show that the patent is invalid in a relevant respect, he shall not be entitled to the relief claimed if the defendant or defender proves that at the time of making the threats he did not know, and had no reason to suspect, that the patent was invalid in that respect.”

(3) For subsection (4) there is substituted—

“(4) Proceedings may not be brought under this section for—

- (a) a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process, or
- (b) a threat, made to a person who has made or imported a product for disposal or used a process, to bring proceedings for an infringement alleged to consist of doing anything else in relation to that product or process.”

Changes to legislation: There are currently no known outstanding effects for the Patents Act 2004, Section 12. (See end of Document for details)

(4) For subsection (5) there is substituted—

“(5) For the purposes of this section a person does not threaten another person with proceedings for infringement of a patent if he merely—

- (a) provides factual information about the patent,
- (b) makes enquiries of the other person for the sole purpose of discovering whether, or by whom, the patent has been infringed as mentioned in subsection (4)(a) above, or
- (c) makes an assertion about the patent for the purpose of any enquiries so made.”

(5) After subsection (5) there is inserted—

“(6) In proceedings under this section for threats made by one person (A) to another (B) in respect of an alleged infringement of a patent for an invention, it shall be a defence for A to prove that he used his best endeavours, without success, to discover—

- (a) where the invention is a product, the identity of the person (if any) who made or (in the case of an imported product) imported it for disposal;
- (b) where the invention is a process and the alleged infringement consists of offering it for use, the identity of a person who used the process;
- (c) where the invention is a process and the alleged infringement is an act falling within section 60(1)(c) above, the identity of the person who used the process to produce the product in question;

and that he notified B accordingly, before or at the time of making the threats, identifying the endeavours used.”

Commencement Information

II S. 12 in force at 1.1.2005 by S.I. 2004/3205, art. 2(d) (with art. 9)

Changes to legislation:

There are currently no known outstanding effects for the Patents Act 2004, Section 12.