



# Patents Act 2004

## 2004 CHAPTER 16

### *Other amendments of the 1977 Act*

#### **13 Opinions by Patent Office as to validity or infringement**

(1) After section 74 of the 1977 Act there is inserted—

#### *“Opinions by Patent Office*

##### **74A Opinions as to validity or infringement**

- (1) The proprietor of a patent or any other person may request the comptroller to issue an opinion—
  - (a) as to whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;
  - (b) as to whether, or to what extent, the invention in question is not patentable because the condition in section 1(1)(a) or (b) above is not satisfied.
- (2) Subsection (1) above applies even if the patent has expired or has been surrendered.
- (3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so—
  - (a) in such circumstances as may be prescribed, or
  - (b) if for any reason he considers it inappropriate in all the circumstances to do so.
- (4) An opinion under this section shall not be binding for any purposes.
- (5) An opinion under this section shall be prepared by an examiner.
- (6) In relation to a decision of the comptroller whether to issue an opinion under this section—

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*Status: This is the original version (as it was originally enacted).*

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- (a) for the purposes of section 101 below, only the person making the request under subsection (1) above shall be regarded as a party to a proceeding before the comptroller; and
- (b) no appeal shall lie at the instance of any other person.

#### **74B Reviews of opinions under section 74A**

- (1) Rules may make provision for a review before the comptroller, on an application by the proprietor or an exclusive licensee of the patent in question, of an opinion under section 74A above.
- (2) The rules may, in particular—
  - (a) prescribe the circumstances in which, and the period within which, an application may be made;
  - (b) provide that, in prescribed circumstances, proceedings for a review may not be brought or continued where other proceedings have been brought;
  - (c) make provision under which, in prescribed circumstances, proceedings on a review are to be treated for prescribed purposes as if they were proceedings under section 61(1)(c) or (e), 71(1) or 72(1) (a) above;
  - (d) provide for there to be a right of appeal against a decision made on a review only in prescribed cases.”
- (2) In section 74 of that Act (proceedings in which validity of patent may be put in issue), in subsection (8), after “the validity of a patent is not put in issue merely because” there is inserted “(a)” and at the end there is inserted “or
  - (b) its validity is being considered in connection with an opinion under section 74A below or a review of such an opinion.”
- (3) In section 32(2) of that Act (rules about the register of patents), after paragraph (b) there is inserted—
  - “(ba) the entering on the register of notices concerning opinions issued, or to be issued, under section 74A below;”.