



# Intellectual Property (Unjustified Threats) Act 2017

## 2017 CHAPTER 14

### *Patents*

#### **1 Patents**

- (1) The Patents Act 1977 is amended as follows.
- (2) For section 70 (remedy for unjustified threats of infringement proceedings) substitute  
—

#### *“Unjustified threats*

#### **70 Threats of infringement proceedings**

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that—
  - (a) a patent exists, and
  - (b) a person intends to bring proceedings (whether in a court in the United Kingdom or elsewhere) against another person for infringement of the patent by—
    - (i) an act done in the United Kingdom, or
    - (ii) an act which, if done, would be done in the United Kingdom.
- (2) References in this section and in section 70C to a “recipient” include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

## 70A Actionable threats

- (1) Subject to subsections (2) to (5), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.
- (2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—
  - (a) where the invention is a product, making a product for disposal or importing a product for disposal, or
  - (b) where the invention is a process, using a process.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a) or (b).
- (4) A threat of infringement proceedings is not actionable if the threat—
  - (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to a product or process, and
  - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to that product or process.
- (5) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.
- (6) In sections 70C and 70D “an actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

## 70B Permitted communications

- (1) For the purposes of section 70A(5), a communication containing a threat of infringement proceedings is a “permitted communication” if—
  - (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
  - (b) all of the information that relates to the threat is information that—
    - (i) is necessary for that purpose (see subsection (5)(a) to (c) for some examples of necessary information), and
    - (ii) the person making the communication reasonably believes is true.
- (2) Each of the following is a “permitted purpose”—
  - (a) giving notice that a patent exists;
  - (b) discovering whether, or by whom, a patent has been infringed by an act mentioned in section 70A(2)(a) or (b);
  - (c) giving notice that a person has a right in or under a patent, where another person’s awareness of the right is relevant to any proceedings that may be brought in respect of the patent.
- (3) The court may, having regard to the nature of the purposes listed in subsection (2)(a) to (c), treat any other purpose as a “permitted purpose” if it considers that it is in the interests of justice to do so.
- (4) But the following may not be treated as a “permitted purpose”—

- (a) requesting a person to cease doing, for commercial purposes, anything in relation to a product or process,
  - (b) requesting a person to deliver up or destroy a product, or
  - (c) requesting a person to give an undertaking relating to a product or process.
- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” (see subsection (1)(b)(i))—
- (a) a statement that a patent exists and is in force or that an application for a patent has been made;
  - (b) details of the patent, or of a right in or under the patent, which—
    - (i) are accurate in all material respects, and
    - (ii) are not misleading in any material respect; and
  - (c) information enabling the identification of the products or processes in respect of which it is alleged that acts infringing the patent have been carried out.

#### **70C Remedies and defences**

- (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—
- (a) a declaration that the threat is unjustified;
  - (b) an injunction against the continuance of the threat;
  - (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.
- (2) In the application of subsection (1) to Scotland—
- (a) “declaration” means “declarator”, and
  - (b) “injunction” means “interdict”.
- (3) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the patent.
- (4) It is a defence for the person who made the threat to show—
- (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in section 70A(2) (a) or (b) in relation to the product or the use of a process which is the subject of the threat, and
  - (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

#### **70D Professional advisers**

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the conditions in subsection (3) are met.
- (2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—

- (a) is acting in a professional capacity in providing legal services or the services of a trade mark attorney or a patent attorney, and
  - (b) is regulated in the provision of legal services, or the services of a trade mark attorney or a patent attorney, by one or more regulatory bodies (whether through membership of a regulatory body, the issue of a licence to practise or any other means).
- (3) The conditions are that—
- (a) in making the communication the professional adviser is acting on the instructions of another person, and
  - (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.
- (4) This section does not affect any liability of the person on whose instructions the professional adviser is acting.
- (5) It is for a person asserting that subsection (1) applies to prove (if required) that at the material time—
- (a) the person concerned was acting as a professional adviser, and
  - (b) the conditions in subsection (3) were met.

**70E Supplementary: pending registration**

- (1) In sections 70 and 70B references to a patent include references to an application for a patent that has been published under section 16.
- (2) Where the threat of infringement proceedings is made after an application has been published (but before grant) the reference in section 70C(3) to “the patent” is to be treated as a reference to the patent as granted in pursuance of that application.

**70F Supplementary: proceedings for delivery up etc.**

In section 70(1)(b) the reference to proceedings for infringement of a patent includes a reference to proceedings for an order under section 61(1)(b) (order to deliver up or destroy patented products etc.).”

- (3) In section 70F (inserted by subsection (2)) at the end insert “and proceedings in the Unified Patent Court for an order for delivery up made in accordance with articles 32(1)(c) and 62(3) of the Agreement on a Unified Patent Court.
- (4) Before section 71 insert—

*“Declaration or declarator as to non-infringement”.*

- (5) In section 74 (proceedings in which validity of a patent may be put in issue) in subsection (1)(b), for “under section 70” substitute “in respect of an actionable threat under section 70A”.
- (6) In section 78 (effect of filing an application for a European patent (UK)), in subsection (2) at the appropriate place insert “sections 70 to 70F”.

- (7) In section 106 (costs and expenses in proceedings before the Court) in subsection (1A) (c), for “under section 70” substitute “in respect of an actionable threat under section 70A”.
- (8) In paragraph 2 of Schedule A3 (application of relevant statutory provisions to European patent with unitary effect) at the appropriate place insert “sections 70 to 70F (unjustified threats);”.