



Patents Act 1949

1949 CHAPTER 87

Miscellaneous provisions as to rights in inventions

54 Co-ownership of patents

- (1) Where after the commencement of this Act a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent
- (2) Subject to the provisions of this and the next following section, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to make, use, exercise and vend the patented invention for his own benefit without accounting to the other or others.
- (3) Subject to the provisions of the next following section, and to any agreement for the time being in force, a licence under a patent shall not be granted, and a share in a patent shall not be assigned, except with the consent of all persons, other than the licensor or assignor, who are registered as grantee or proprietor of the patent.
- (4) Where an article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with it in the same manner as if the article had been sold by a sole patentee.
- (5) Subject to the provisions of this section, the rules of law applicable to the ownership and devolution of personal property generally shall apply in relation to patents as they apply in relation to other choses in action ; and nothing in subsection (1) or subsection (2) of this section 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.

55 Power of comptroller to give directions to co-owners

- (1) Where two or more persons are registered as grantee or proprietor of a patent, the comptroller may, upon application made to him in the prescribed manner by any of

those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent, or the exercise of any right under the last foregoing section in relation thereto, as he thinks fit.

- (2) If any person registered as grantee or proprietor of the patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered the comptroller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.
- (3) Before giving directions in pursuance of an application under this section, the comptroller shall give an opportunity to be heard—
 - (a) in the case of an application under subsection (1) of this section, to the other person or persons registered as grantee or proprietor of the patent;
 - (b) in the case of an application under subsection (2) of this section, to the person in default.
- (4) An appeal shall lie from any decision or direction of the comptroller under this section.
- (5) 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 a deceased person, or their rights or obligations as such.

56 Disputed as to inventions made by employees

- (1) Where a dispute arises between an employer and a person who is or was at the material time his employee as to the rights of the parties in respect of an invention made by the employee either alone or jointly with other employees or in respect of any patent granted or to be granted in respect thereof, the comptroller may, upon application made to him in the prescribed manner by either of the parties, and after giving to each of them an opportunity to be heard, determine the matter in dispute, and may make such orders for giving effect to his decision as he considers expedient :

Provided that if it appears to the comptroller upon any application under 'this section that the matter in dispute involves questions which would more properly be determined by the court, he may decline to deal therewith.

- (2) In proceedings before the court between an employer and a person who is or was at the material time his employee, or upon an application made to the comptroller under subsection (1) of this section, the court or comptroller may, unless satisfied that one or other of the parties is entitled, to the exclusion of the other to the benefit of an invention made by the employee, by order provide for the apportionment between them of the benefit of the invention, and of any patent granted or to be granted in respect thereof, in such manner as the court or comptroller considers just.
- (3) A decision of the comptroller under this section shall have the same effect as between the parties and persons claiming under them as a decision of the court.
- (4) An appeal shall lie from any decision of the comptroller under this section.

57 Avoidance of certain restrictive conditions

- (1) Subject to the provisions of this section, any condition of a contract for the sale or lease of a patented article or of an article made by a patented process or for licence to use or work a patented article or process, or relating to any such sale, lease or licence, shall be void in so far as it purports—
 - (a) to require the purchaser, lessee or licensee to acquire from the vendor, lessor or licensor, or his nominees, or prohibit him from acquiring from any specified person, or from acquiring except from the vendor, lessor or licensor, or his nominees, any articles other than the patented article or an article made by the patented process;
 - (b) to prohibit the purchaser, lessee or licensee from using articles (whether patented or not) which are not supplied by, or any patented process which does not belong to, the vendor, lessor or licensor, or his nominees, or to restrict the right of the purchaser, lessee or licensee to use any such articles or process.
- (2) 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 and containing a condition void by virtue of this section.
- (3) A condition of a contract shall not be void by virtue of this section if—
 - (a) at the time of the making of the contract the vendor, lessor or licensor was willing to sell or lease the article, or grant a licence to use or work the article or process, as the case may be, to 'the purchaser, lessee or licensee, on reasonable terms specified in the contract and without any such condition as is mentioned in subsection (1) of this section; and
 - (b) the purchaser, lessee or licensee is entitled under the contract to relieve himself of his liability to observe the condition upon giving to the other party three months' notice in writing, and subject to payment to him of such compensation (being, in the case of a purchase a lump sum, and in the case of a lease or licence a rent or royalty for the residue of the term of the contract) as may be determined by an arbitrator appointed by the Board of Trade.
- (4) If in any proceeding it is alleged that any condition of a contract is void by virtue of this section, it shall be on the vendor, lessor or licensor to prove the matters set out in paragraph (a) of the last foregoing subsection.
- (5) A condition of a contract 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 specified person, or, in the case of a contract for the lease of or licence to use a patented article, that it reserves to the lessor or licensor or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

58 Determination of certain contracts

- (1) Any contract for the sale or lease of a patented article or for licence to manufacture, use or work a patented article or process, or relating to any such sale, lease or licence, whether made before or after the commencement of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or in any other contract, be determined by either party on giving three months notice in writing to the other party.

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

- (2) Where notice is given under this section to determine a contract made before the twenty-eighth day of August, nineteen hundred and seven, the party by whom the notice is given shall be liable to pay to the other party such compensation as may, in default of agreement, be determined by an arbitrator appointed by the Board of Trade.
- (3) The provisions of this section shall be without prejudice to any right of determining a contract exercisable apart from this section.