Patents Act 1977

1977 CHAPTER 37

An Act to establish a new law of patents applicable to future patents and applications for patents; to amend the law of patents applicable to existing patents and applications for patents; to give effect to certain international conventions on patents; and for connected purposes. [29th July 1977]

Extent Information

E1 This Act does not extend to the Channel Islands or the Colonies for extent provision see s. 132(2)

Modifications etc. (not altering text)

C1 Act extended (with modifications) (2.1.1993) by S.I. 1992/3091, **reg.5**
Act extended (8.2.1997) by S.I. 1996/3120, **reg. 5**
Act applied (8.2.1997) by S.I. 1997/64, **rule 9**
Act extended (1.3.2002) by The Patents and Plant Variety Rights (Compulsory Licensing) Regulations 2002 (S.I. 2002/247), **reg. 26(1)** (subject to reg. 26(2)(3))

C2 Act modified (10.6.2003) by Patents Act 1977 (Isle of Man) Order 2003 (S.I. 2003/1249), arts. 2, 3, **Sch.**

C3 Act modified (Isle of Man) (11.11.2013) by The Patents (Isle of Man) Order 2013 (S.I. 2013/2602), art. 2, **Sch.** (as amended (1.6.2016) by The Patents (Isle of Man) (Amendment) Order 2016 (S.I. 2016/559), **Sch.** and as further amended (15.2.2017) by The Patents (Isle of Man) (Amendment) Order 2017 (S.I. 2017/162), arts. 1(2), 2, **Sch.** (with art. 3))

PART I

NEW DOMESTIC LAW

Patentability

1 Patentable inventions.

(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say—

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(a) the invention is new;
(b) it involves an inventive step;
(c) it is capable of industrial application;
(d) the grant of a patent for it is not excluded by subsections (2) and (3) **[**[F1] or section 4A**]** below;

and references in this Act to a patentable invention shall be construed accordingly.

(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of—
(a) a discovery, scientific theory or mathematical method;
(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
(c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
(d) the presentation of information;

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

[[F2](3) A patent shall not be granted for an invention the commercial exploitation of which would be contrary to public policy or morality.

(4) For the purposes of subsection (3) above exploitation shall not be regarded as contrary to public policy or morality only because it is prohibited by any law in force in the United Kingdom or any part of it.**]**

(5) The Secretary of State may by order vary the provisions of subsection (2) above for the purpose of maintaining them in conformity with developments in science and technology; and no such order shall be made unless a draft of the order has been laid before, and approved by resolution of, each House of Parliament.

Textual Amendments

F1 Words in s. 1(1)(d) inserted (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 2**; S.I. 2007/3396, art. 2(l)

F2 S. 1(3)(4) substituted (28.7.2000) by S.I. 2000/2037, **reg. 3**

2 Novelty.

(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say—

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(a) that matter was contained in the application for that other patent both as filed and as published; and

(b) the priority date of that matter is earlier than that of the invention.

(4) For the purposes of this section the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring later than the beginning of the period of six months immediately preceding the date of filing the application for the patent and either—

(a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person—

(i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or

(ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) above or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;

(b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor; or

(c) the disclosure was due to, or made in consequence of the inventor displaying the invention at an international exhibition and the applicant states, on filing the application, that the invention has been so displayed and also, within the prescribed period, files written evidence in support of the statement complying with any prescribed conditions.

(5) In this section references to the inventor include references to any proprietor of the invention for the time being.

[F3](6) . . . . . .

Textual Amendments

F3 S. 2(6) repealed (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 3, **Sch. 3**; S.I. 2007/3396, art. 2(i)(l)

3 Inventive step.

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

4 Industrial application.

(1) [F4]..., an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture.

[F5](2) . . . . . .

[F6](3) . . . . . .

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Textual Amendments

F4 Words in s. 4(1) repealed (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 4(a), **Sch. 3**; S.I. 2007/3396, art. 2(i)(l)

F5 S. 4(2) repealed (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 4(b), **Sch. 3**; S.I. 2007/3396, art. 2(i)(l)

F6 S. 4(3) repealed (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 4(b), **Sch. 3**; S.I. 2007/3396, art. 2(i)(l)

[[F7]4A Methods of treatment or diagnosis

(1) A patent shall not be granted for the invention of—

(a) a method of treatment of the human or animal body by surgery or therapy, or

(b) a method of diagnosis practised on the human or animal body.

(2) Subsection (1) above does not apply to an invention consisting of a substance or composition for use in any such method.

(3) In the case of an invention consisting of a substance or composition for use in any such method, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

(4) In the case of an invention consisting of a substance or composition for a specific use in any such method, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if that specific use does not form part of the state of the art.**]**

Textual Amendments

F7 S. 4A inserted (13.12.2007) by Patents Act 2004 (c. 16), **ss. 1**, 17(1); S.I. 2007/3396, art. 2(a)

5 Priority date.

(1) For the purposes of this Act the priority date of an invention to which an application for a patent relates and also of any matter (whether or not the same as the invention) contained in any such application is, except as provided by the following provisions of this Act, the date of filing the application.

(2) If in or in connection with an application for a patent (the application in suit) a declaration is made, whether by the applicant or any predecessor in title of his, complying with the relevant requirements of rules and specifying one or more earlier relevant applications for the purposes of this section made by the applicant or a predecessor in title of his and **[**[F8]the application in suit has a date of filing during the period allowed under subsection (2A)(a) or (b) below**]**, then—

(a) if an invention to which the application in suit relates is supported by matter disclosed in the earlier relevant application or applications, the priority date of that invention shall instead of being the date of filing the application in suit be the date of filing the relevant application in which that matter was disclosed, or, if it was disclosed in more than one relevant application, the earliest of them;

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(b) the priority date of any matter contained in the application in suit which was also disclosed in the earlier relevant application or applications shall be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.

[[F9](2A) The periods are—

(a) the period of twelve months immediately following the date of filing of the earlier specified relevant application, or if there is more than one, of the earliest of them; and

(b) where the comptroller has given permission under subsection (2B) below for a late declaration to be made under subsection (2) above, the period commencing immediately after the end of the period allowed under paragraph (a) above and ending at the end of the prescribed period.

(2B) The applicant may make a request to the comptroller for permission to make a late declaration under subsection (2) above.

(2C) The comptroller shall grant a request made under subsection (2B) above if, and only if—

(a) the request complies with the relevant requirements of rules; and

(b) the comptroller is satisfied that the applicant's failure to file the application in suit within the period allowed under subsection (2A)(a) above was unintentional.**]**

(3) Where an invention or other matter contained in the application in suit was also disclosed in two earlier relevant applications filed by the same applicant as in the case of the application in suit or a predecessor in title of his and the second of those relevant applications was specified in or in connection with the application in suit, the second of those relevant applications shall, so far as concerns that invention or matter, be disregarded unless—

(a) it was filed in or in respect of the same country as the first; and

(b) not later than the date of filing the second, the first (whether or not so specified) was unconditionally withdrawn, or was abandoned or refused, without—

(i) having been made available to the public (whether in the United Kingdom or elsewhere);

(ii) leaving any rights outstanding; and

(iii) having served to establish a priority date in relation to another application, wherever made.

(4) The foregoing provisions of this section shall apply for determining the priority date of an invention for which a patent has been granted as they apply for determining the priority date of an invention to which an application for that patent relates.

(5) In this section "relevant application" means any of the following applications which has a date of filing, namely—

(a) an application for a patent under this Act;

[[F10](aa) an application in or for a country (other than the United Kingdom) which is a member of the World Trade Organisation for protection in respect of an invention which, in accordance with the law of that country or a treaty or international obligation to which it is a party, is equivalent to an application for a patent under this Act;**]**

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(b) an application in or for a convention country (specified under section 90 below) for protection in respect of an invention or an application which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to **[**[F11]an application for a patent under this Act**]**.

[F12](6) . . . . . .

Textual Amendments

F8 Words in s. 5(2) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **3** (with arts. 20-23)

F9 S. 5(2A)-(2C) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **3** (with arts. 20-23)

F10 S. 5(5)(aa) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 1(1)**; S.I. 2014/2330, art. 3, Sch.

F11 Words in s. 5(5)(b) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 1(2)**; S.I. 2014/2330, art. 3, Sch.

F12 S. 5(6) omitted (1.10.2014) by virtue of Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 1(3)**; S.I. 2014/2330, art. 3, Sch.

Modifications etc. (not altering text)

C4 S. 5 extended (24.5.2000) by S.I. 2000/1114, **art. 2**

6 Disclosure of matter, etc., between earlier and later applications.

(1) It is hereby declared for the avoidance of doubt that where an application (the application in suit) is made for a patent and a declaration is made in accordance with section 5(2) above in or in connection with that application specifying an earlier relevant application, the application in suit and any patent granted in pursuance of it shall not be invalidated by reason only of relevant intervening acts.

(2) In this section—

"relevant application" has the same meaning as in section 5 above; and

"relevant intervening acts" means acts done in relation to matter disclosed in an earlier relevant application between the dates of the earlier relevant application and the application in suit, as for example, filing another application for the invention for which the earlier relevant application was made, making information available to the public about that invention or that matter or working that invention, but disregarding any application, or the disclosure to the public of matter contained in any application, which is itself to be disregarded for the purposes of section 5(3) above.

Right to apply for and obtain a patent and be mentioned as inventor

7 Right to apply for and obtain a patent.

(1) Any person may make an application for a patent either alone or jointly with another.

(2) A patent for an invention may be granted—

(a) primarily to the inventor or joint inventors;

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(b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;

(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned;

and to no other person.

(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.

(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

8 Determination before grant of questions about entitlement to patents, etc.

(1) At any time before a patent has been granted for an invention (whether or not an application has been made for it)—

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or

(b) any of two or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;

and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.

(2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below.—

(a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;

(b) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly;

(c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred;

(d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.

(3) Where a question is referred to the comptroller under subsection (1)(a) above and—

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(a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;

(b) any such application is refused under subsection 2(c) above before the comptroller has disposed of the reference (whether the reference was made before or after the publication of the application); or

(c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference **[**[F13](whether the application is refused or withdrawn before or after its publication) **]** ;

the comptroller may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 76 below, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.

(4) Where a person refers a question under subsection (1)(b) above relating to an application, any order under subsection (1) above may contain directions to any person for transferring or granting any right in or under the application.

(5) If any person to whom directions have been given under subsection (2)(d) or (4) above fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the comptroller may, on application made to him by any person in whose favour or on whose reference the directions were given, authorise him to do that thing on behalf of the person to whom the directions were given.

(6) Where on a reference under this section it is alleged that, by virtue of any transaction, instrument or event relating to an invention or an application for a patent, any person other than the inventor or the applicant for the patent has become entitled to be granted (whether alone or with any other persons) a patent for the invention or has or would have any right in or under any patent so granted or any application for any such patent, an order shall not be made under subsection (2)(a), (b) or (d) above on the reference unless notice of the reference is given to the applicant and any such person, except any of them who is a party to the reference.

(7) If it appears to the comptroller on a reference of a question under this section that the question involves matters which 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.

(8) 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 deceased persons, or their right or obligations as such.

Textual Amendments

F13 Words in s. 8(3)(c) substituted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 6(1)**, 17(1); S.I. 2004/3205, art. 2(b) (with art. 9)

9 Determination after grant of questions referred before grant.

If a question with respect to a patent or application is referred by any person to the comptroller under section 8 above, whether before or after the making of an application

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for the patent, and is not determined before the time when the application is first in order for a grant of a patent in pursuance of the application, that fact shall not prevent the grant of a patent, but on its grant that person shall be treated as having referred to the comptroller under section 37 below any question mentioned in that section which the comptroller thinks appropriate.

10 Handling of application by joint applicants.

If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the comptroller may, on a request made by any of the parties, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require.

11 Effect of transfer of application under s. 8 or 10.

(1) Where an order is made or directions are given under section 8 or 10 above that an application for a patent shall proceed in the name of one or some of the original applicants (whether or not it is also to proceed in the name of some other person), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under either of those sections, continue in force and be treated as granted by the persons in whose name the application is to proceed.

(2) Where an order is made or directions are given under section 8 above that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant (on the ground that the original applicant or applicants was or were not entitled to be granted the patent), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under that section and subject to subsection (3) below, lapse on the registration of that person or those persons as the applicant or applicants or, where the application has not been published, on the making of the order.

(3) If before registration of a reference under section 8 above resulting in the making of any order mentioned in subsection (2) above—

(a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in the United Kingdom or made effective and serious preparations to do so; or

(b) a licensee of the applicant, acting in good faith, worked the invention in the United Kingdom or made effective and serious preparations to do so;

that or those original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, 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.

[[F14](3A) If, before registration of a reference under section 8 above resulting in the making of an order under subsection (3) of that section, the condition in subsection (3)(a) or (b) above is met, the original applicant or any of the applicants or the licensee shall, on making a request within the prescribed period to the new applicant, 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.**]**

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(4) **[**[F15]A licence under subsection (3) or (3A) above **]** shall be granted for a reasonable period and on reasonable terms.

(5) Where an order is made as mentioned in subsection (2) **[**[F16]or (3A)**]** above, the person in whose name the application is to proceed **[**[F17]or, as the case may be, who makes the new application **]** or any person claiming that he is entitled to be granted any such licence may refer to the comptroller the question whether the latter is so entitled and whether any such period is 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.

Textual Amendments

F14 S. 11(3A) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 6(2)**, 17(1); S.I. 2004/3205, art. 2(b) (with art. 9)

F15 Words in s. 11(4) substituted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 6(3)**, 17(1); S.I. 2004/3205, art. 2(b) (with art. 9)

F16 Words in s. 11(5) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 6(4)(a)**, 17(1); S.I. 2004/3205, art. 2(b) (with art. 9)

F17 Words in s. 11(5) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 6(4)(b)**, 17(1); S.I. 2004/3205, art. 2(b) (with art. 9)

12 Determination of questions about entitlement to foreign and convention patents, etc.

(1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made)—

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) any of two or more co-proprietors of an application for such a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

(2) If it appears to the comptroller on a reference of a question under this section that the question involves matters which 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.

(3) Subsection (1) above, in its application to a European patent and an application for any such patent, shall have effect subject to section 82 below.

(4) Section 10 above, except so much of it as enables the comptroller to regulate the manner in which an application is to proceed, shall apply to disputes between joint applicants for any such patent as is mentioned in subsection (1) above as it applies to joint applicants for a patent under this Act.

(5) Section 11 above shall apply in relation to—

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(a) any orders made under subsection (1) above and any directions given under section 10 above by virtue of subsection (4) above; and

(b) any orders made and directions given by the relevant convention court with respect to a question corresponding to any question which may be determined under subsection (1) above;

as it applies to orders made and directions given apart from this section under section 8 or 10 above.

(6) In the following cases, that is to say—

(a) where an application for a European patent (UK) is refused or withdrawn, or the designation of the United Kingdom in the application is withdrawn **[**[F18]whether before or **]** , after publication of the application but before a question relating to the right to the patent has been referred to the comptroller under subsection (1) above or before proceedings relating to that right have begun before the relevant convention court;

(b) where an application has been made for a European patent (UK) and on a reference under subsection (1) above or any such proceedings as are mentioned in paragraph (a) above the comptroller, the court or the relevant convention court determines by a final decision (whether before or after publication of the application) that a person other than the applicant has the right to the patent, but that person requests the European Patent Office that the application for the patent should be refused; or

(c) where an international application for a patent (UK) is withdrawn, or the designation of the United Kingdom in the application is withdrawn, whether before or after the making of any reference under subsection (1) above **[**[F19]or the**]** publication of the application;

the comptroller may order that any person (other than the applicant) appearing to him to be entitled to be granted a patent under this Act may within the prescribed period make an application for such a patent for the whole or part of any matter comprised in the earlier application (subject, however, to section 76 below) and that if the application for a patent under this Act is filed, it shall be treated as having been filed on the date of filing the earlier application.

(7) In this section—

(a) references to a patent and an application for a patent include respectively references to protection in respect of an invention and an application which, in accordance with the law of any country other than the United Kingdom or any treaty or international convention, is equivalent to an application for a patent or for such protection; and

(b) a decision shall be taken to be final for the purposes of this section when the time for appealing from it has expired without an appeal being brought or, where an appeal is brought, when it is finally disposed of.

Textual Amendments

F18 Words in s. 12(6)(a) inserted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 5(a)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F19 Words in s. 12(6)(c) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 5(b)**; S.I. 2004/3205, art. 2(k) (with art. 9)

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13 Mention of inventor.

(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.

(2) Unless he has already given the Patent Office the information hereinafter mentioned, an applicant for a patent shall within the prescribed period file with the Patent Office a statement—

(a) identifying the person or persons whom he believes to be the inventor or inventors; and

(b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent;

and, if he fails to do so, the application shall be taken to be withdrawn.

(3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.

Applications

14 Making of application.

(1) Every application for a patent—

(a) shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner; **[**[F20]and**]**

(b) **[**[F20]shall be accompanied by the fee prescribed for the purposes of this subsection (hereafter in this Act referred to as the filing fee).**]**

[[F21](1A) Where an application for a patent is made, the fee prescribed for the purposes of this subsection ("the application fee") shall be paid not later than the end of the period prescribed for the purposes of section 15(10)(c) below.**]**

(2) Every application for a patent shall contain—

(a) a request for the grant of a patent;

(b) a specification containing a description of the invention, a claim or claims and any drawing referred to in the description or any claim; and

(c) an abstract;

but the foregoing provision shall not prevent an application being initiated by documents complying with section 15(1) below.

(3) The specification of an application shall disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(4) . . . . . [F22]

(5) The claim or claims shall—

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(a) define the matter for which the applicant seeks protection;
(b) be clear and concise;
(c) be supported by the description; and
(d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.

(6) Without prejudice to the generality of subsection (5)(d) above, rules may provide for treating two or more inventions as being so linked as to form a single inventive concept for the purposes of this Act.

(7) The purpose of the abstract is to give technical information and on publication it shall not form part of the state of the art by virtue of section 2(3) above, and the comptroller may determine whether the abstract adequately fulfils its purpose and, if it does not, may reframe it so that it does.

(8) . . . . . [F22]

(9) An application for a patent may be withdrawn at any time before the patent is granted and any withdrawal of such an application may not be revoked.

[[F23](10) Subsection (9) above does not affect the power of the comptroller under section 117(1) below to correct an error or mistake in a withdrawal of an application for a patent.**]**

Textual Amendments

F20 S. 14(1)(b) and preceding word ceased to have effect (1.1.2005) by virtue of The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **4(2)** (with arts. 20-23)

F21 S. 14(1A) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **4(3)** (with arts. 20-23)

F22 S. 14(4)(8) repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

F23 S. 14(10) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **4(4)** (with arts. 20-23)

[[F24]**15 Date of filing application.**

(1) Subject to the following provisions of this Act, the date of filing an application for a patent shall be taken to be the earliest date on which documents filed at the Patent Office to initiate the application satisfy the following conditions—
(a) the documents indicate that a patent is sought;
(b) the documents identify the person applying for a patent or contain information sufficient to enable that person to be contacted by the Patent Office; and
(c) the documents contain either—
(i) something which is or appears to be a description of the invention for which a patent is sought; or
(ii) a reference, complying with the relevant requirements of rules, to an earlier relevant application made by the applicant or a predecessor in title of his.

(2) It is immaterial for the purposes of subsection (1)(c)(i) above—
(a) whether the thing is in, or is accompanied by a translation into, a language accepted by the Patent Office in accordance with rules;

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(b) whether the thing otherwise complies with the other provisions of this Act and with any relevant rules.

(3) Where documents filed at the Patent Office to initiate an application for a patent satisfy one or more of the conditions specified in subsection (1) above, but do not satisfy all those conditions, the comptroller shall as soon as practicable after the filing of those documents notify the applicant of what else must be filed in order for the application to have a date of filing.

(4) Where documents filed at the Patent Office to initiate an application for a patent satisfy all the conditions specified in subsection (1) above, the comptroller shall as soon as practicable after the filing of the last of those documents notify the applicant of—

(a) the date of filing the application, and

(b) the requirements that must be complied with, and the periods within which they are required by this Act or rules to be complied with, if the application is not to be treated as having been withdrawn.

(5) Subsection (6) below applies where—

(a) an application has a date of filing by virtue of subsection (1) above;

(b) within the prescribed period the applicant files at the Patent Office—

(i) a drawing, or

(ii) part of the description of the invention for which a patent is sought, and

(c) that drawing or that part of the description was missing from the application at the date of filing.

(6) Unless the applicant withdraws the drawing or the part of the description filed under subsection (5)(b) above ("the missing part") before the end of the prescribed period—

(a) the missing part shall be treated as included in the application; and

(b) the date of filing the application shall be the date on which the missing part is filed at the Patent Office.

(7) Subsection (6)(b) above does not apply if—

(a) on or before the date which is the date of filing the application by virtue of subsection (1) above a declaration is made under section 5(2) above in or in connection with the application;

(b) the applicant makes a request for subsection (6)(b) above not to apply; and

(c) the request complies with the relevant requirements of rules and is made within the prescribed period.

(8) Subsections (6) and (7) above do not affect the power of the comptroller under section 117(1) below to correct an error or mistake.

(9) Where, after an application for a patent has been filed and before the patent is granted—

(a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and

(b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below),

the new application shall be treated as having, as its date of filing, the date of filing the earlier application.

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(10) Where an application has a date of filing by virtue of this section, the application shall be treated as having been withdrawn if any of the following applies—

(a) the applicant fails to file at the Patent Office, before the end of the prescribed period, one or more claims and the abstract;

(b) where a reference to an earlier relevant application has been filed as mentioned in subsection (1)(c)(ii) above—

(i) the applicant fails to file at the Patent Office, before the end of the prescribed period, a description of the invention for which the patent is sought;

(ii) the applicant fails to file at the Patent Office, before the end of the prescribed period, a copy of the application referred to, complying with the relevant requirements of rules;

(c) the applicant fails to pay the application fee before the end of the prescribed period;

(d) the applicant fails, before the end of the prescribed period, to make a request for a search under section 17 below and pay the search fee.

(11) In this section "relevant application" has the meaning given by section 5(5) above.

Textual Amendments

F24 Ss. 15, 15A substituted for s. 15 (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **5** (with arts. 20-23)

15A Preliminary examination

(1) The comptroller shall refer an application for a patent to an examiner for a preliminary examination if—

(a) the application has a date of filing;

(b) the application has not been withdrawn or treated as withdrawn; and

(c) the application fee has been paid.

(2) On a preliminary examination of an application the examiner shall—

(a) determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act; and

(b) determine whether any requirements under section 13(2) or 15(10) above remain to be complied with.

(3) The examiner shall report to the comptroller his determinations under subsection (2) above.

(4) If on the preliminary examination of an application it is found that—

(a) any drawing referred to in the application, or

(b) part of the description of the invention for which the patent is sought,

is missing from the application, then the examiner shall include this finding in his report under subsection (3) above .

(5) Subsections (6) to (8) below apply if a report is made to the comptroller under subsection (3) above that not all the formal requirements have been complied with.

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(6) The comptroller shall specify a period during which the applicant shall have the opportunity—

(a) to make observations on the report, and

(b) to amend the application so as to comply with those requirements (subject to section 76 below).

(7) The comptroller may refuse the application if the applicant fails to amend the application as mentioned in subsection (6)(b) above before the end of the period specified by the comptroller under that subsection.

(8) Subsection (7) above does not apply if—

(a) the applicant makes observations as mentioned in subsection (6)(a) above before the end of the period specified by the comptroller under that subsection, and

(b) as a result of the observations, the comptroller is satisfied that the formal requirements have been complied with.

(9) If a report is made to the comptroller under subsection (3) above—

(a) that any requirement of section 13(2) or 15(10) above has not been complied with; or

(b) that a drawing or part of the description of the invention has been found to be missing,

then the comptroller shall notify the applicant accordingly.**]**

Textual Amendments

F24 Ss. 15, 15A substituted for s. 15 (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **5** (with arts. 20-23)

16 Publication of application.

(1) Subject to section 22 below **[**[F25]and to any prescribed restrictions**]**, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the comptroller shall, unless the application is withdrawn or refused before preparations for its publication have been completed by the Patent Office, publish it as filed (including not only the original claims but also any amendments of those claims and new claims subsisting immediately before the completion of those preparations) and he may, if so requested by the applicant, publish it as aforesaid during that period, and in either event shall advertise the fact and date of its publication in the journal.

(2) The comptroller may omit from the specification of a published application for a patent any matter—

(a) which in his opinion disparages any person in a way likely to damage him, or

(b) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

Textual Amendments

F25 Words in s. 16(1) inserted (1.10.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 6**; S.I. 2005/2471, art. 2(g)

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Examination and search

17 [F26Search.]

[F27(1) The comptroller shall refer an application for a patent to an examiner for a search if, and only if—

(a) the comptroller has referred the application to an examiner for a preliminary examination under section 15A(1) above;

(b) the application has not been withdrawn or treated as withdrawn;

(c) before the end of the prescribed period—

(i) the applicant makes a request to the Patent Office in the prescribed form for a search; and

(ii) the fee prescribed for the search ("the search fee") is paid;

(d) the application includes—

(i) a description of the invention for which a patent is sought; and

(ii) one or more claims; and

(e) the description and each of the claims comply with the requirements of rules as to language.]

(2) [F28On a preliminary examination of an application the examiner shall determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act and shall report his determination to the comptroller.]

(3) [F28If it is reported to the comptroller under subsection (2) above that not all the formal requirements are complied with, he shall give the applicant an opportunity to make observations on the report and to amend the application within a specified period (subject to section 15(5) above) so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to do so the comptroller may refuse the application.]

(4) Subject to subsections (5) and (6) below, on a search requested under this section, the examiner shall make such investigation as in his opinion is reasonably practicable and necessary for him to identify the documents which he thinks will be needed to decide, on a substantive examination under section 18 below, whether the invention for which a patent is sought is new and involves an inventive step.

(5) On any such search the examiner shall determine whether or not the search would serve any useful purpose on the application as for the time being constituted and—

(a) if he determines that it would serve such a purpose in relation to the whole or part of the application, he shall proceed to conduct the search so far as it would serve such a purpose and shall report on the results of the search to the comptroller; and

(b) if he determines that the search would not serve such a purpose in relation to the whole or part of the application, he shall report accordingly to the comptroller;

and in either event the applicant shall be informed of the examiner's report.

(6) If it appears to the examiner, either before or on conducting a search under this section, that an application relates to two or more inventions, but that they are not so linked as to form a single inventive concept, he shall initially only conduct a search in relation to the first invention specified in the claims of the application, but may proceed to

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conduct a search in relation to another invention so specified if the applicant pays the search fee in respect of the application so far as it relates to that other invention.

(7) After a search has been requested under this section for an application the comptroller may at any time refer the application to an examiner for a supplementary search, and **[**[F29]subsections (4) and (5) above**]** shall apply in relation to a supplementary search as **[**[F29]they apply**]** in relation to any other search under this section.

[[F30](8) A reference for a supplementary search in consequence of—

(a) an amendment of the application made by the applicant under section 18(3) or 19(1) below, or

(b) a correction of the application, or of a document filed in connection with the application, under section 117 below,

shall be made only on payment of the prescribed fee, unless the comptroller directs otherwise.**]**

Textual Amendments

F26 S. 17 heading substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **6(2)** (with arts. 20-23)

F27 S. 17(1) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **6(3)** (with arts. 20-23)

F28 S. 17(2)(3) ceased to have effect (1.1.2005) by virtue of The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **6(4)** (with arts. 20-23)

F29 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 3(2)**

F30 S. 17(8) added by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 3(3)**

18 Substantive examination and grant or refusal of patent.

(1) Where the conditions imposed by section 17(1) above for the comptroller to refer an application to an examiner for a [F31]... search are satisfied and at the time of the request under that subsection or within the prescribed period—

(a) a request is made by the applicant to the Patent Office in the prescribed form for a substantive examination; and

(b) the prescribed fee is paid for the examination;

the comptroller shall refer the application to an examiner for a substantive examination; and if no such request is made or the prescribed fee is not paid within that period, the application shall be treated as having been withdrawn at the end of that period.

[[F32](1A) If the examiner forms the view that a supplementary search under section 17 above is required for which a fee is payable, he shall inform the comptroller, who may decide that the substantive examination should not proceed until the fee is paid; and if he so decides, then unless within such period as he may allow—

(a) the fee is paid, or

(b) the application is amended so as to render the supplementary search unnecessary,

he may refuse the application.**]**

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(2) On a substantive examination of an application the examiner shall investigate, to such extent as he considers necessary in view of any examination **[**[F33]carried out under section 15A above**]** and search carried out under section 17 above, whether the application complies with the requirements of this Act and the rules and shall determine that question and report his determination to the comptroller.

(3) If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.

(4) If the examiner reports that the application, whether as originally filed or as amended in pursuance of **[**[F34]section 15A**]** above, this section or section 19 below, complies with those requirements at any time before the end of the prescribed period, the comptroller shall notify the applicant of that fact and, subject to subsection (5) and sections 19 and 22 below and on payment within the prescribed period of any fee prescribed for the grant, grant him a patent.

(5) Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

Textual Amendments

F31 Words in s. 18(1) omitted (1.1.2005) by virtue of The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **7(2)** (with arts. 20-23)

F32 S. 18(1A) inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 4**

F33 Words in s. 18(2) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **7(3)** (with arts. 20-23)

F34 Words in s. 18(4) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **7(4)** (with arts. 20-23)

19 General power to amend application before grant.

(1) At any time before a patent is granted in pursuance of an application the applicant may, in accordance with the prescribed conditions and subject to section 76 below, amend the application of his own volition.

(2) The comptroller may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a patent so as to acknowledge a registered trade mark.

Modifications etc. (not altering text)

C5 S. 19(2) extended by Patents, Designs and Marks Act 1986 (c. 39, SIF 67A) s. 2(3), Sch. 2 Pt. I para. 1(2)(*e*)(i)
S. 19(2) amended (31.10.1994) by 1994 c. 26, s. 106(1), **Sch. 4 para. 1(2)**; S.I. 1994/2550, **art. 2**

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20 Failure of application.

(1) If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.

(2) If at the end of that period an appeal to the court is pending in respect of the application or the time within which such an appeal could be brought has not expired, that period—

(a) where such an appeal is pending, or is brought within the said time or before the expiration of any extension of that time granted (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, shall be extended until such date as the court may determine;

(b) where no such appeal is pending or is so brought, shall continue until the end of the said time or, if any extension of that time is so granted, until the expiration of the extension or last extension so granted.

[F35 20A Reinstatement of applications

(1) Subsection (2) below applies where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is—

(a) set out in this Act or rules, or

(b) specified by the comptroller.

(2) Subject to subsection (3) below, the comptroller shall reinstate the application if, and only if—

(a) the applicant requests him to do so;

(b) the request complies with the relevant requirements of rules; and

(c) he is satisfied that the failure to comply referred to in subsection (1) above was unintentional.

(3) The comptroller shall not reinstate the application if—

(a) an extension remains available under this Act or rules for the period referred to in subsection (1) above; or

(b) the period referred to in subsection (1) above is set out or specified—

(i) in relation to any proceedings before the comptroller;

(ii) for the purposes of section 5(2A)(b) above; or

(iii) for the purposes of a request under this section or section 117B below.

(4) Where the application was made by two or more persons jointly, a request under subsection (2) above may, with the leave of the comptroller, be made by one or more of those persons without joining the others.

(5) If the application has been published under section 16 above, then the comptroller shall publish notice of a request under subsection (2) above in the prescribed manner.

(6) The reinstatement of an application under this section shall be by order.

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(7) If an application is reinstated under this section the applicant shall comply with the requirement referred to in subsection (1) above within the further period specified by the comptroller in the order reinstating the application.

(8) The further period specified under subsection (7) above shall not be less than two months.

(9) If the applicant fails to comply with subsection (7) above the application shall be treated as having been withdrawn on the expiry of the period specified under that subsection.

Textual Amendments

F35 Ss. 20A, 20B inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **8** (with arts. 20-23)

20B Effect of reinstatement under section 20A

(1) The effect of reinstatement under section 20A of an application for a patent is as follows.

(2) Anything done under or in relation to the application during the period between termination and reinstatement shall be treated as valid.

(3) If the application has been published under section 16 above before its termination anything done during that period which would have constituted an infringement of the rights conferred by publication of the application if the termination had not occurred shall be treated as an infringement of those rights—

(a) if done at a time when it was possible for the period referred to in section 20A(1) above to be extended, or

(b) if it was a continuation or repetition of an earlier act infringing those rights.

(4) If the application has been published under section 16 above before its termination and, after the termination and before publication of notice of the request for its reinstatement, a person—

(a) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place, or

(b) made in good faith effective and serious preparations to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the reinstatement of the application and the grant of the patent; but this right does not extend to granting a licence to another person to do the act.

F36 **[** (4A) The right conferred by subsection (4) does not become exercisable until the end of the period during which a request may be made under this Act, or under the rules, for an extension of the period referred to in section 20A(1).**]**

(5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (4) above may—

(a) authorise the doing of that act by any partners of his for the time being in that business, and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(6) Where a product is disposed of to another in exercise of a right conferred by subsection (4) or (5) above, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant.

[F37](6A) **[** The above provisions apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to infringement of the rights conferred by publication of the application for a patent (or, as the case may be, infringement of the patent).**]**

(7) In this section "termination", in relation to an application, means—

(a) the refusal of the application, or

(b) the application being treated as having been refused or withdrawn.**]**

Textual Amendments

F35 Ss. 20A, 20B inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **8** (with arts. 20-23)

F36 S. 20B(4A) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 2**; S.I. 2014/2330, art. 3, Sch.

F37 S. 20B(6A) inserted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(2), **Sch. 2 para. 7** (see S.I. 2004/2357, art. 1(2))

21 Observations by third party on patentability.

(1) Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations, and the comptroller shall consider the observations in accordance with rules.

(2) It is hereby declared that a person does not become a party to any proceedings under this Act before the comptroller by reason only that he makes observations under this section.

Security and safety

22 Information prejudicial to [F38national security] or safety of public.

(1) Where an application for a patent is filed in the Patent Office (whether under this Act or any treaty or international convention to which the United Kingdom is a party and whether before or after the appointed day) and it appears to the comptroller that the application contains information of a description notified to him by the Secretary of State as being information the publication of which might be prejudicial to **[**F39national security**]** , the comptroller may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(2) If it appears to the comptroller that any application so filed contains information the publication of which might be prejudicial to the safety of the public, he may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons until the end of a period not exceeding three months from the end of the period prescribed for the purposes of section 16 above.

(3) While directions are in force under this section with respect to an application—

(a) if the application is made under this Act, it may proceed to the stage where it is in order for the grant of a patent, but it shall not be published and that information shall not be so communicated and no patent shall be granted in pursuance of the application;

(b) if it is an application for a European patent, it shall not be sent to the European Patent Office; and

(c) if it is an international application for a patent, a copy of it shall not be sent to the International Bureau or any international searching authority appointed under the Patent Co-operation Treaty.

(4) Subsection (3)(b) above shall not prevent the comptroller from sending the European Patent Office any information which it is his duty to send that office under the European Patent Convention.

(5) Where the comptroller gives directions under this section with respect to any application, he shall give notice of the application and of the directions to the Secretary of State, and the following provisions shall then have effect:—

(a) the Secretary of State shall, on receipt of the notice, consider whether the publication of the application or the publication or communication of the information in question would be prejudicial to **[**[F40]national security**]** or the safety of the public;

(b) if the Secretary of State determines under paragraph (a) above that the publication of the application or the publication or communication of that information would be prejudicial to the safety of the public, he shall notify the comptroller who shall continue his directions under subsection (2) above until they are revoked under paragraph (e) below;

(c) if the Secretary of State determines under paragraph (a) above that the publication of the application or the publication or communication of that information would be prejudicial to **[**[F41]national security **]** or the safety of the public, he shall (unless a notice under paragraph (d) below has previously been given by the Secretary of State to the comptroller) reconsider that question during the period of nine months from the date of filing the application and at least once in every subsequent period of twelve months;

(d) if on consideration of an application at any time it appears to the Secretary of State that the publication of the application or the publication or communication of the information contained in it would not, or would no longer, be prejudicial to **[**[F42]national security**]** or the safety of the public, he shall give notice to the comptroller to that effect; and

(e) on receipt of such a notice the comptroller shall revoke the directions and may, subject to such conditions (if any) as he thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired.

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(6) The Secretary of State may do the following for the purpose of enabling him to decide the question referred to in subsection (5)(c) above—

(a) where the application contains information relating to the production or use of atomic energy or research into matters connected with such production or use, he may at any time do one or both of the following, that is to say,

[[F43](i) inspect the application and any documents sent to the comptroller in connection with it;

(ii) authorise a government body with responsibility for the production of atomic energy or for research into matters connected with its production or use, or a person appointed by such a government body, to inspect the application and any documents sent to the comptroller in connection with it**]**; and

(b) in any other case, he may at any time after (or, with the applicant's consent, before) the end of the period prescribed for the purposes of section 16 above inspect the application and any such documents;

and where **[**[F44] a government body or a person appointed by a government body carries out an inspection which the body or person is authorised to carry out under paragraph (a) above, the body or (as the case may be) the person shall report on the inspection to the Secretary of State as soon as practicable.**]**

(7) Where directions have been given under this section in respect of an application for a patent for an invention and, before the directions are revoked, that prescribed period expires and the application is brought in order for the grant of a patent, then—

(a) if while the directions are in force the invention is worked by (or with the written authorisation of or to the order of) a government department, the provisions of sections 55 to 59 below shall apply as if—

(i) the working were use made by section 55;

(ii) the application had been published at the end of that period; and

(iii) a patent had been granted for the invention at the time the application is brought in order for the grant of a patent (taking the terms of the patent to be those of the application as it stood at the time it was so brought in order); and

(b) if it appears to the Secretary of State that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Secretary of State may, with the consent of the Treasury, make such payment (if any) by way of compensation to the applicant as appears to the Secretary of State and the Treasury to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.

(8) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions were in force.

(9) A person who fails to comply with any direction under this section shall be liable—

(a) on summary conviction, to a fine not exceeding £1,000; or

(b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.

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Textual Amendments

F38 Words in s. 22 heading substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 8(2)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F39 Words in s. 22(1) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 8(3)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F40 Words in s. 22(5)(a) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 8(3)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F41 Words in s. 22(5)(c) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 8(3)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F42 Words in s. 22(5)(d) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 8(3)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F43 Words in s. 22(6)(a) substituted (1.1.2005) by Patents Act 2004 (c. 16), **Sch. 8 para. 4(a)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F44 Words in s. 22(6) substituted (1.1.2005) by Patents Act 2004 (c. 16), **Sch. 8 para. 4(b)**; S.I. 2004/3205, art. 2(k) (with art. 9)

23 Restrictions on applications abroad by United Kingdom residents.

(1) Subject to the following provisions of this section, no person resident in the United Kingdom shall, without written authority granted by the comptroller, file or cause to be filed outside the United Kingdom an application for a patent for an invention **[**[F45]if subsection (1A) below applies to that application,**]** unless—

(a) an application for a patent for the same invention has been filed in the Patent Office (whether before, on or after the appointed day) not less than six weeks before the application outside the United Kingdom; and

(b) either no directions have been given under section 22 above in relation to the application in the United Kingdom or all such directions have been revoked.

[[F46](1A) This subsection applies to an application if—

(a) the application contains information which relates to military technology or for any other reason publication of the information might be prejudicial to national security; or

(b) the application contains information the publication of which might be prejudicial to the safety of the public.**]**

(2) Subsection (1) above does not apply to an application for a patent for an invention for which an application for a patent has first been filed (whether before or after the appointed day) in a country outside the United Kingdom by a person resident outside the United Kingdom.

(3) A person who files or causes to be filed an application for the grant of a patent in contravention of this section shall be liable—

(a) on summary conviction, to a fine not exceeding £1,000; or

(b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.

[[F47](3A) A person is liable under subsection (3) above only if—

(a) he knows that filing the application, or causing it to be filed, would contravene this section; or

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(b) he is reckless as to whether filing the application, or causing it to be filed, would contravene this section.**]**

(4) In this section—

(a) any reference to an application for a patent includes a reference to an application for other protection for an invention;

(b) any reference to either kind of application is a reference to an application under this Act, under the law of any country other than the United Kingdom or under any treaty or international convention to which the United Kingdom is a party.

Textual Amendments

F45 Words in s. 23(1) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 7(1)**, 17(1); S.I. 2004/3205, art. 2(c) (with art. 9)

F46 S. 23(1A) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 7(2)**, 17(1); S.I. 2004/3205, art. 2(c) (with art. 9)

F47 S. 23(3A) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 7(3)**, 17(1); S.I. 2004/3205, art. 2(c) (with art. 9)

Provisions as to patents after grant

24 Publication and certificate of grant.

(1) As soon as practicable after a patent has been granted under this Act the comptroller shall publish in the journal a notice that it has been granted.

(2) The comptroller shall, as soon as practicable after he publishes a notice under subsection (1) above, send the proprietor of the patent a certificate in the prescribed form that the patent has been granted to the proprietor.

(3) The comptroller shall, at the same time as he publishes a notice under subsection (1) above in relation to a patent publish the specification of the patent, the names of the proprietor and (if different) the inventor and any other matters constituting or relating to the patent which in the comptroller's opinion it is desirable to publish.

[[F48](4) Subsection (3) above shall not require the comptroller to identify as inventor a person who has waived his right to be mentioned as inventor in any patent granted for the invention.**]**

Textual Amendments

F48 S. 24(4) inserted (1.10.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 9**; S.I. 2005/2471, art. 2(g)

25 Term of patent.

(1) A patent granted under this Act shall be treated for the purposes of the following provisions of this Act as having been granted, and shall take effect, on the date on which notice of its grant is published in the journal and, subject to subsection (3) below,

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shall continue in force until the end of the period of 20 years beginning with the date of filing the application for the patent or with such other date as may be prescribed.

(2) A rule prescribing any such other date under this section shall not be made unless a draft of the rule has been laid before, and approved by resolution of, each House of Parliament.

[[F49](3) Where any renewal fee in respect of a patent is not paid by the end of the period prescribed for payment (the "prescribed period") the patent shall cease to have effect at the end of such day, in the final month of that period, as may be prescribed.**]**

(4) If during **[**[F50]the period ending with the sixth month after the month in which the prescribed period ends**]** the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Act as if it had never expired, and accordingly—

(a) anything done under or in relation to it during that further period shall be valid;

(b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and

(c) an act which would constitute the use of the patented invention for the services of the Crown if the patent had not expired shall constitute that use.

(5) Rules shall include provision requiring the comptroller to notify the registered proprietor of a patent that a renewal fee has not been received from him in the Patent Office before the end of the prescribed period and before the framing of the notification.

Textual Amendments

F49 S. 25(3) substituted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 8(1)**, 17(1); S.I. 2005/2471, art. 2(a) (with art. 3)

F50 Words in s. 25(4) substituted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 8(2)**, 17(1); S.I. 2005/2471, art. 2(a) (with art. 3)

26 Patent not to be impugned for lack of unity.

No person may in any proceeding object to a patent or to an amendment of a specification of a patent on the ground that the claims contained in the specification of the patent, as they stand or, as the case may be, as proposed to be amended, relate—

(a) to more than one invention, or

(b) to a group of inventions which are not so linked as to form a single inventive concept.

27 General power to amend specification after grant.

(1) Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.

(2) No such amendment shall be allowed under this section where there are pending before the court or the comptroller proceedings in which the validity of the patent may be put in issue.

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(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) The comptroller may, without an application being made to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade-mark.

(5) A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.

[[F51](6) In considering whether or not to allow an application under this section, the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.**]**

Textual Amendments

F51 S. 27(6) inserted (13.12.2007) by Patents Act 2004 (c. 16), **ss. 2(1)**, 17(1); S.I. 2007/3396, art. 2(b)

Modifications etc. (not altering text)

C6 S. 27(4) extended by Patents, Designs and Marks Act 1986 (c. 39, SIF 67A), s. 2(3), **Sch. 2 Pt. I para. 1(2)**(*e*)(ii)
S. 27(4) amended (31.10.1994) by 1994 c. 26, s. 106(1), **Sch. 4 para. 1(2)**; S.I. 1994/2550 art. 2

28 Restoration of lapsed patents.

[[F52](1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the comptroller within the prescribed period.

(1A) Rules prescribing that period may contain such transitional provisions and savings as appear to the Secretary of State to be necessary or expedient.**]**

(2) An application under this section may be made by the person who was the proprietor of the patent or by any other person who would have been entitled to the patent if it had not ceased to have effect; and where the patent was held by two or more persons jointly, the application may, with the leave of the comptroller, be made by one or more of them without joining the others.

[[F53](2A) Notice of the application shall be published by the comptroller in the prescribed manner.**]**

[[F54](3) If the comptroller is satisfied that the failure of the proprietor of the patent—

(a) to pay the renewal fee within the prescribed period; or

(b) to pay that fee and any prescribed additional fee **[**[F55]within the period ending with the sixth month after the month in which the prescribed period ended**]**,

was unintentional, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.**]**

(4) An order under this section may be made subject to such conditions as the comptroller thinks fit (including a condition requiring compliance with any provisions of the rules relating to registration which have not been complied with), and if the proprietor of the patent does not comply with any condition of such an order the comptroller may

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revoke the order and give such directions consequential on the revocation as he thinks fit.

(5) . . . . . [F56]

Textual Amendments

F52 S. 28(1)(1A) substituted and inserted respectively by Copyright, Designs and Patents Act 1988 (c.48, SIF 67A), s. 295, **Sch. 5 para. 6(2)**

F53 S. 28(2A) inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 6(3)**

F54 S. 28(3) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **9** (with arts. 20-23)

F55 Words in s. 28(3) substituted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 8(3)**, 17(1); S.I. 2005/2471, art. 2(a) (with art. 3)

F56 S. 28(5)–(9) repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), ss. 295, 303(2), Sch. 5 para. 6(5), **Sch. 8**

[[F57]28A Effect of order for restoration of patent.

(1) The effect of an order for the restoration of a patent is as follows.

(2) Anything done under or in relation to the patent during the period between expiry and restoration shall be treated as valid.

(3) Anything done during that period which would have constituted an infringement if the patent had not expired shall be treated as an infringement—

(a) if done at a time when it was possible for the patent to be renewed under section 25(4), or

(b) if it was a continuation or repetition of an earlier infringing act.

(4) If after it was no longer possible for the patent to be so renewed, and before publication of notice of the application for restoration, a person—

(a) began in good faith to do an act which would have constituted an infringement of the patent if it had not expired, or

(b) made in good faith effective and serious preparations to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the patent; but this right does not extend to granting a licence to another person to do the act.

(5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (4) may—

(a) authorise the doing of that act by any partners of his for the time being in that business, and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(6) Where a product is disposed of to another in exercise of the rights conferred by subsection (4) or (5), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

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(7) The above provisions apply in relation to the use of a patent for the services of the Crown as they apply in relation to infringement of the patent.**]**

Textual Amendments

F57 S. 28A inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 7**

29 Surrender of patents.

(1) The proprietor of a patent may at any time by notice given to the comptroller offer to surrender his patent.

(2) A person may give notice to the comptroller of his opposition to the surrender of a patent under this section, and if he does so the comptroller shall notify the proprietor of the patent and determine the question.

(3) If the comptroller is satisfied that the patent may properly be surrendered, he may accept the offer and, as from the date when notice of his acceptance is published in the journal, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any use of the patented invention before that date for the services of the Crown.

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 **[**[F58]the assignor or mortgagor**]** (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative) [F59]....

[[F60](6A) If a transaction mentioned in subsection (6) above is by a body corporate, references in that subsection to such a transaction being signed by or on behalf of the assignor or mortgagor shall be taken to include references to its being under the seal of the body corporate.**]**

(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.

Textual Amendments

F58 Words in s. 30(6) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **10(2)(a)** (with arts. 20-23)

F59 Words in s. 30(6) omitted (1.1.2005) by virtue of The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **10(2)(b)** (with arts. 20-23)

F60 S. 30(6A) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **10(3)** (with arts. 20-23)

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 sub-sections and of section 36(3) below shall apply to any grant of licences, assignations 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 assignation or grant of security under this section may be carried out only by writing **[**[F61]subscribed in accordance with the Requirements of Writing (Scotland) Act 1995.**]**

(7) An assignation 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

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or 69 below for a previous infringement or to bring proceedings under section 58 below for a previous act.

Textual Amendments

F61 Words in s. 31(6) substituted (1.8.1995) by 1995 c. 7, ss. 14(1), 15(2), **Sch. 4 para. 49** (with ss. 9(3)(5)(7), 13, 14(3))

[F62 32 Register of patents etc.

(1) The comptroller shall maintain the register of patents, which shall comply with rules made by virtue of this section and shall be kept in accordance with such rules.

(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—

(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;

[F63(ba) the entering on the register of notices concerning opinions issued, or to be issued, under section 74A below;**]**

(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; and

(e) 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.

(4) The register need not be kept in documentary form.

(5) Subject to rules, the public shall have a right to inspect the register at the Patent Office at all convenient times.

(6) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and rules may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.

(7) Applications under subsection (6) above or rules made by virtue of that subsection shall be made in such manner as may be prescribed.

(8) In relation to any portion of the register kept otherwise than in documentary form—

(a) the right of inspection conferred by subsection (5) above is a right to inspect the material on the register; and

(b) the right to a copy or extract conferred by subsection (6) above or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(9) [F64]... 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 sufficient evidence of any such thing.

(10) 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 sufficient evidence, of the matters so certified.

(11) Each of the following, that is to say—

(a) a copy of an entry in the register or an extract from the register which is supplied under subsection (6) above;

(b) a copy of any document kept in the Patent Office or an extract from any such document, any specification of a patent or any application for a patent which has been published,

which purports to be a certified copy or a certified extract shall, [F65]... be admitted in evidence without further proof and without production of any original; and in Scotland such evidence shall be sufficient evidence.

[F66](12) . . . . . .

(13) In this section "certified copy" and "certified extract" mean a copy and extract certified by the comptroller and sealed with the seal of the Patent Office.

(14) 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.**]**

Textual Amendments

F62 S. 32 substituted by Patents, Designs and Marks Act 1986 (c. 39, SIF 67A), s. 1, **Sch. 1 para. 4**

F63 S. 32(2)(ba) inserted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 13(3)**, 17(1); S.I. 2005/2471, art. 2(c)

F64 Words in s. 32(9) repealed (4.4.2005) by Criminal Justice Act 2003 (c. 44), s. 336(3)(4), **Sch. 37 Pt. 6**; S.I. 2005/950, art. 2(1), Sch. 1 para. 44(3) (with Sch. 2) (as explained (29.7.2005) by S.I. 2005/2122, art. 2; and as amended: (14.7.2008) by 2008 c. 4, Sch. 26 para. 78, Sch. 28 Pt. 2; S.I. 2008/1586, Sch. 1 paras. 48(s), 50(2)(d); (30.11.2009) by S.I. 2009/3111, art. 2; (3.12.2012) by S.I. 2012/2905, art. 4; (3.12.2012) by 2012 c. 10, Sch. 14 para. 17; S.I. 2012/2906, art. 2(l))

F65 Words in s. 32(11) repealed (4.4.2005) by Criminal Justice Act 2003 (c. 44), s. 336(3)(4), **Sch. 37 Pt. 6**; S.I. 2005/950, art. 2(1), Sch. 1 para. 44(3) (with Sch. 2) (as explained (29.7.2005) by S.I. 2005/2122, art. 2; and as amended: (14.7.2008) by 2008 c. 4, Sch. 26 para. 78, Sch. 28 Pt. 2; S.I. 2008/1586, Sch. 1 paras. 48(s), 50(2)(d); (30.11.2009) by S.I. 2009/3111, art. 2; (3.12.2012) by S.I. 2012/2905, art. 4; (3.12.2012) by 2012 c. 10, Sch. 14 para. 17; S.I. 2012/2906, art. 2(l))

F66 S. 32(12) repealed (14.4.2000) by 1999 c. 23, s. 67, **Sch. 6** (with Sch. 7 paras. 3(2)(3), 5(2)); S.I. 2000/1034, art. 2, **Sch.**

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

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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

(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 . . . . . F67

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Textual Amendments

F67 S. 35 repealed by Patents, Designs and Marks Act 1986 (c. 39, SIF 67A), s. 3(1), **Sch. 3 Pt. I**

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

[[F68](a) amend the specification of the patent or apply for such an amendment to be allowed or for the patent to be revoked, or amend the specification of the patent or apply for such an amendment to be allowed or for the patent to be revoked, or

(b)**]** 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.

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Textual Amendments

F68 Words in s. 36(3)(a)(b) inserted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 9**, 17(1); S.I. 2005/2471, art. 2(b)

37 Determination of right to patent after grant.

[[F69](1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question—

(a) who is or are the true proprietor or proprietors of the patent,

(b) whether the patent should have been granted to the person or persons to whom it was granted, or

(c) whether any right in or under the patent should be transferred or granted to any other person or persons;

and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.**]**

(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 **[**[F70]this section**]** 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.

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(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 **[**[F71]the second anniversary of**]** 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 **[**[F70]this section**]** 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 **[**[F72]this section**]** 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 **[**[F73]the second anniversary of**]** 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.

Textual Amendments

F69 S. 37(1) substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 9(2)**

F70 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 9(3)(a)**

F71 Words in s. 37(5) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 3(1)(a)**; S.I. 2014/2330, art. 3, Sch.

F72 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 9(3)(b)**

F73 Words in s. 37(9) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 3(1)(a)**; S.I. 2014/2330, art. 3, Sch.

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

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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 **[**[F74]or, as the case may be, the new applicant **]** 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 **[**[F75]or, as the case may be, the new applicant **]** 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 is 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.

Textual Amendments

F74 Words in s. 38(3) inserted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 10(2)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F75 Words in s. 38(5) inserted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 10(3)**; S.I. 2004/3205, art. 2(k) (with art. 9)

Employees' inventions

39 Right to employees' inventions.

(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if—

(a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

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(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

[[F76](3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

(a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or

(b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.**]**

Textual Amendments

F76 S. 39(3) added by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 11(1)**

40 Compensation of employees for certain inventions.

[[F77](1) Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that—

(a) the employee has made an invention belonging to the employer for which a patent has been granted,

(b) having regard among other things to the size and nature of the employer's undertaking, the invention or the patent for it (or the combination of both) is of outstanding benefit to the employer, and

(c) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer,

the court or the comptroller may award him such compensation of an amount determined under section 41 below.**]**

(2) Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that—

(a) a patent has been granted for an invention made by and belonging to the employee;

(b) his rights in the invention, or in any patent or application for a patent for the invention, have since the appointed day been assigned to the employer or an exclusive licence under the patent or application has since the appointed day been granted to the employer;

(c) the benefit derived by the employee from the contract of assignment, assignation or grant or any ancillary contract ("the relevant contract") is inadequate in relation to the benefit derived by the employer from **[**[F78]the invention or the patent for it (or both)**]** ; and

(d) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract;

the court or the comptroller may award him such compensation of an amount determined under section 41 below.

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(3) Subsections (1) and (2) above shall not apply to the invention of an employee where a relevant collective agreement provides for the payment of compensation in respect of inventions of the same description as that invention to employees of the same description as that employee.

(4) Subsection (2) above shall have effect notwithstanding anything in the relevant contract or any agreement applicable to the invention (other than any such collective agreement).

(5) If it appears to the comptroller on an application under this section that the application involves matters which would more properly be determined by the court, he may decline to deal with it.

(6) In this section—

"the prescribed period", in relation to proceedings before the court, means the period prescribed by rules of court, and

"relevant collective agreement" means a collective agreement within the meaning of **[**[F79]the Trade Union and Labour Relations (Consolidation) Act 1992**]**, made by or on behalf of a trade union to which the employee belongs, and by the employer or an employers' association to which the employer belongs which is in force at the time of the making of the invention.

(7) References in this section to an invention belonging to an employer or employee are references to it so belonging as between the employer and the employee.

Textual Amendments

F77 S. 40(1) substituted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 10(1)**, 17(1) (with s. 10(8)); S.I. 2004/3205, art. 2(d) (with art. 9)

F78 Words in s. 40(2)(c) substituted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 10(2)**, 17(1) (with s. 10(8)); S.I. 2004/3205, art. 2(d) (with art. 9)

F79 Words in s. 40(6) substituted (16.10.1992) by Trade Union and Labour Relations (Consolidation) Act 1992 (c. 52), ss. 300(2), 302, **Sch. 2 para. 9**

41 Amount of compensation.

[[F80](1) An award of compensation to an employee under section 40(1) or (2) above shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which the employer has derived, or may reasonably be expected to derive, from any of the following—

(a) the invention in question;

(b) the patent for the invention;

(c) the assignment, assignation or grant of—

(i) the property or any right in the invention, or

(ii) the property in, or any right in or under, an application for the patent,

to a person connected with the employer.**]**

(2) For the purposes of subsection (1) above the amount of any benefit derived or expected to be derived by an employer from the assignment, assignation or grant of—

(a) the property in, or any right in or under, a patent for the invention or an application for such a patent; or

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(b) the property or any right in the invention;

to a person connected with him shall be taken to be the amount which could reasonably be expected to be so derived by the employer if that person had not been connected with him.

(3) Where the Crown**[**[F81], United Kingdom Research and Innovation**]** or a Research Council in its capacity as employer assigns or grants the property in, or any right in or under, an invention, patent or application for a patent to a body having among its functions that of developing or exploiting inventions resulting from public research and does so for no consideration or only a nominal consideration, any benefit derived from the invention, patent or application by that body shall be treated for the purposes of the foregoing provisions of this section as so derived by the Crown**[**[F82], United Kingdom Research and Innovation or the Research Council (as the case may be)**]**.

In this subsection "Research Council" means a body which is a Research Council for the purposes of the [M1]Science and Technology Act 1965 [F83]...

(4) In determining the fair share of the benefit to be secured for an employee in respect of [F84]... an invention which has always belonged to an employer, the court or the comptroller shall, among other things, take the following matters into account, that is to say—

(a) the nature of the employee's duties, his remuneration and the other advantages he derives or has derived from his employment or has derived in relation to the invention under this Act;

(b) the effort and skill which the employee has devoted to making the invention;

(c) the effort and skill which any other person has devoted to making the invention jointly with the employee concerned, and the advice and other assistance contributed by any other employee who is not a joint inventor of the invention; and

(d) the contribution made by the employer to the making, developing and working of the invention by the provision of advice, facilities and other assistance, by the provision of opportunities and by his managerial and commercial skill and activities.

(5) In determining the fair share of the benefit to be secured for an employee in respect of [F85]... an invention which originally belonged to him, the court or the comptroller shall, among other things, take the following matters into account, that is to say—

(a) any conditions in a licence or licences granted under this Act or otherwise in respect of the invention or the patent **[**[F86]for it**]**;

(b) the extent to which the invention was made jointly by the employee with any other person; and

(c) the contribution made by the employer to the making, developing and working of the invention as mentioned in subsection (4)(d) above.

(6) Any order for the payment of compensation under section 40 above may be an order for the payment of a lump sum or for periodical payment, or both.

(7) Without prejudice to **[**[F87]section 12 or section 14 of the [M2]Interpretation Act 1978**]**, the refusal of the court or the comptroller to make any such order on an application made by an employee under section 40 above shall not prevent a further application being made under that section by him or any successor in title of his.

(8) Where the court or the comptroller has made any such order, the court or he may on the application of either the employer or the employee vary or discharge it or suspend

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any provision of the order and revive any provision so suspended, and section 40(5) above shall apply to the application as it applies to an application under that section.

(9) In England and Wales any sums awarded by the comptroller under section 40 above shall, if **[**[F88]the county court**]** so orders, be recoverable **[**[F89] under section 85 of the County Courts Act 1984**]** or otherwise as if they were payable under an order of that court.

(10) In Scotland an order made under section 40 above by the comptroller for the payment of any sums may be enforced in like manner as **[**[F90]an extract registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland.**]**.

(11) In Northern Ireland an order made under section 40 above by the comptroller for the payment of any sums may be enforced as if it were a money judgment.

Textual Amendments

F80 S. 41(1) substituted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 10(3)**, 17(1) (with s. 10(8)); S.I. 2004/3205, art. 2(d) (with art. 9)

F81 Words in s. 41(3) inserted (1.4.2018) by Higher Education and Research Act 2017 (c. 29), s. 124(5), **Sch. 12 para. 13(a)**; S.I. 2018/241, reg. 2(t)

F82 Words in s. 41(3) substituted (1.4.2018) by Higher Education and Research Act 2017 (c. 29), s. 124(5), **Sch. 12 para. 13(b)**; S.I. 2018/241, reg. 2(t)

F83 Words in s. 41(3) omitted (1.4.2018) by virtue of Higher Education and Research Act 2017 (c. 29), s. 124(5), **Sch. 12 para. 13(c)**; S.I. 2018/241, reg. 2(t)

F84 Words in s. 41(4) repealed (1.1.2005) by Patents Act 2004 (c. 16), ss. 10(4), 17(1), **Sch. 3** (with s. 10(8)); S.I. 2004/3205, art. 2(d)(g) (with art. 9)

F85 Words in s. 41(5) repealed (1.1.2005) by Patents Act 2004 (c. 16), ss. 10(4), 17(1), **Sch. 3** (with s. 10(8)); S.I. 2004/3205, art. 2(d)(g) (with art. 9)

F86 Words in s. 41(5)(a) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 10(5)**, 17(1) (with s. 10(8)); S.I. 2004/3205, art. 2(d) (with art. 9)

F87 Words substituted by virtue of Interpretation Act 1978 (c. 30), **s. 25(2)**

F88 Words in s. 41(9) substituted (E.W.S.) (22.4.2014) by Crime and Courts Act 2013 (c. 22), s. 61(3), **Sch. 9 para. 52**; S.I. 2014/954, art. 2(c) (with art. 3) (with transitional provisions and savings in S.I. 2014/956, arts. 3-11)

F89 Words in s. 41(9) substituted (6.4.2014) by Tribunals, Courts and Enforcement Act 2007 (c. 15), s. 148, **Sch. 13 para. 40** (with s. 89); S.I. 2014/768, art. 2(1)(b)

F90 Words in s. 41(10) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 11**; S.I. 2004/3205, art. 2(k) (with art. 9)

Marginal Citations

M1 1965 c. 4.

M2 1978 c. 30.

42 Enforceability of contracts relating to employees' inventions.

(1) This section applies to any contract (whenever made) relating to inventions made by an employee, being a contract entered into by him—

(a) with the employer (alone or with another); or

(b) with some other person at the request of the employer or in pursuance of the employee's contract of employment.

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(2) Any term in a contract to which this section applies which diminishes the employee's rights in inventions of any description made by him after the appointed day and the date of the contract, or in or under patents for those inventions or applications for such patents, shall be unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent.

(3) Subsection (2) above shall not be construed as derogating from any duty of confidentiality owed to his employer by an employee by virtue of any rule of law or otherwise.

(4) This section applies to any arrangement made with a Crown employee by or on behalf of the Crown as his employer as it applies to any contract made between an employee and an employer other than the Crown, and for the purposes of this section "Crown employee" means a person employed under or for the purposes of a government department or any officer or body exercising on behalf of the Crown functions conferred by any enactment **[**[F91]or a person serving in the naval, military or air forces of the Crown.**]**

Textual Amendments

F91 Words added (retrospectively) by Armed Forces Act 1981 (c. 55, SIF 7:1), **s. 22(1)(2)**

43 Supplementary.

(1) Sections 39 to 42 above shall not apply to an invention made before the appointed day.

(2) Sections 39 to 42 above shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say—

(a) he was mainly employed in the United Kingdom; or

(b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in the United Kingdom to which the employee was attached, whether or not he was also attached elsewhere.

(3) In sections 39 to 42 above and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee.

(4) Any references **[**[F92]in sections 39 to 42**]** above to a patent and to a patent being granted are respectively references to a patent or other protection and to its being granted whether under the law of the United Kingdom or the law in force in any other country or under any treaty or international convention.

(5) For the purposes of sections 40 and 41 above the benefit derived or expected to be derived by an employer from **[**[F93]an invention or patent**]** shall, where he dies before any award is made under section 40 above in respect of **[**[F94]it**]** , include any benefit derived or expected to be derived from **[**[F94]it**]** by his personal representatives or by any person in whom it was vested by their assent.

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[[F95](5A) For the purposes of sections 40 and 41 above the benefit derived or expected to be derived by an employer from an invention shall not include any benefit derived or expected to be derived from the invention after the patent for it has expired or has been surrendered or revoked.**]**

(6) Where an employee dies before an award is made under section 40 above in respect of a patented invention made by him, his personal representatives or their successors in title may exercise his right to make or proceed with an application for compensation under subsection (1) or (2) of that section.

(7) In sections 40 and 41 above and this section "benefit" means benefit in money or money's worth.

(8) Section 533 of the [M3]Income and Corporation Taxes Act 1970 (definition of connected persons) shall apply for determining for the purposes of section 41(2) above whether one person is connected with another as it applies for determining that question for the purposes of the Tax Acts.

Textual Amendments

F92 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 11(2)**

F93 Words in s. 43(5) substituted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 10(6)(a)**, 17(1) (with s. 10(8)); S.I. 2004/3205, art. 2(d) (with art. 9)

F94 Word in s. 43(5) substituted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 10(6)(b)**, 17(1) (with s. 10(8)); S.I. 2004/3205, art. 2(d) (with art. 9)

F95 S. 43(5A) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 10(7)**, 17(1) (with s. 10(8)); S.I. 2004/3205, art. 2(d) (with art. 9)

Marginal Citations

M3 1970 c. 10.

Contracts as to patented products, etc.

[F96]**44** . . . . . .

Textual Amendments

F96 S. 44 repealed (1.3.2000) by 1998 c. 41, s. 70, 74(3), **Sch. 14 Pt. I** (with s. 73); S.I. 2000/344, art. 2, **Sch.**

[F97]**45 Determination of parts of certain contracts.**

. . . . . .

Textual Amendments

F97 S. 45 repealed (1.3.2000) by 1998 c. 41, s. 70, 74(3), **Sch. 14 Pt. I** (with s. 73); S.I. 2000/344, art. 2, **Sch.**

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Licences of right and compulsory licences

46 Patentee's application for entry in register that licences are available as of right.

(1) At any time after the grant of a patent its proprietor may apply to the comptroller for an entry to be made in the register to the effect that licences under the patent are to be available as of right.

(2) Where such an application is made, the comptroller shall give notice of the application to any person registered as having a right in or under the patent and, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, shall make that entry.

(3) Where such an entry is made in respect of a patent—

(a) any person shall, at any time after the entry is made, be entitled as of right to a licence under the patent on such terms as may be settled by agreement or, in default of agreement, by the comptroller on the application of the proprietor of the patent or the person requiring the licence;

(b) the comptroller may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled;

(c) if in proceedings for infringement of the patent (otherwise than by the importation of any article **[**[F98]from a country which is not a member State of the European Economic Community**]**) the defendant or defender undertakes to take a licence on such terms, no injunction or interdict shall be granted against him and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence on those terms had been granted before the earliest infringement;

[[F99](d) if the expiry date in relation to a renewal fee falls after the date of the entry, that fee shall be half the fee which would be payable had the entry not been made.**]**

[[F100](3A) An undertaking under subsection (3)(c) above may be given at any time before final order in the proceedings, without any admission of liability.**]**

[[F101](3B) For the purposes of subsection (3)(d) above the expiry date in relation to a renewal fee is the day at the end of which, by virtue of section 25(3) above, the patent in question ceases to have effect if that fee is not paid.**]**

(4) The licensee under a licence of right may (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) request the proprietor of the patent to take proceedings to prevent any infringement of the patent; and if the proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were proprietor, making the proprietor a defendant or defender.

(5) A proprietor so added as defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Textual Amendments

F98 Words inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 12(2)**

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F99 S. 46(3)(d) substituted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 8(4)(a)**, 17(1); S.I. 2005/2471, art. 2(a)

F100 S. 46(3A) inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 12(3)**

F101 S. 46(3B) inserted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 8(4)(b)**, 17(1); S.I. 2005/2471, art. 2(a)

47 Cancellation of entry made under s. 46.

(1) At any time after an entry has been made under section 46 above in respect of a patent, the proprietor of the patent may apply to the comptroller for cancellation of the entry.

(2) Where such an application is made and the balance paid of all renewal fees which would have been payable if the entry had not been made, the comptroller may cancel the entry, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.

(3) Within the prescribed period after an entry has been made under section 46 above in respect of a patent, any person who claims that the proprietor of the patent is, and was at the time of the entry, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the comptroller for cancellation of the entry.

(4) Where the comptroller is satisfied, on an application under subsection (3) above, that the proprietor of the patent is and was so precluded, he shall cancel the entry; and the proprietor shall then be liable to pay, within a period specified by the comptroller, a sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and the patent shall cease to have effect at the expiration of that period if that sum is not so paid.

(5) Where an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent shall afterwards be the same as if the entry had not been made.

(6) Where an application has been made under this section, then—

(a) in the case of an application under subsection (1) above, any person, and

(b) in the case of an application under subsection (3) above, the proprietor of the patent,

may within the prescribed period give notice to the comptroller of opposition to the cancellation; and the comptroller shall, in considering the application, determine whether the opposition is justified.

[48 [F102]Compulsory licences: general.

(1) At any time after the expiration of three years, or of such other period as may be prescribed, from the date of the grant of a patent, any person may apply to the comptroller on one or more of the relevant grounds–

(a) for a licence under the patent;

(b) for an entry to be made in the register to the effect that licences under the patent are to be available as of right; or

(c) where the applicant is a government department, for the grant to any person specified in the application of a licence under the patent.

(2) Subject to sections 48A and 48B below, if he is satisfied that any of the relevant grounds are established, the comptroller may–

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(a) where the application is under subsection (1)(a) above, order the grant of a licence to the applicant on such terms as the comptroller thinks fit;

(b) where the application is under subsection (1)(b) above, make such an entry as is there mentioned;

(c) where the application is under subsection (1)(c) above, order the grant of a licence to the person specified in the application on such terms as the comptroller thinks fit.

(3) An application may be made under this section in respect of a patent even though the applicant is already the holder of a licence under the patent; and no person shall be estopped or barred from alleging any of the matters specified in the relevant grounds by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted a licence.

(4) In this section "the relevant grounds" means–

(a) in the case of an application made in respect of a patent whose proprietor is a WTO proprietor, the grounds set out in section 48A(1) below;

(b) in any other case, the grounds set out in section 48B(1) below.

(5) A proprietor is a WTO proprietor for the purposes of this section and sections 48A, 48B, 50 and 52 below if–

(a) he is a national of, or is domiciled in, a country which is a member of the World Trade Organisation; or

(b) he has a real and effective industrial or commercial establishment in such a country.

(6) A rule prescribing any such other period under subsection (1) above shall not be made unless a draft of the rule has been laid before, and approved by resolution of, each House of Parliament.**]**

Textual Amendments

F102 S. 48 substituted (29.7.1999) by S.I. 1999/1899, **reg. 3**

[48A [F103]Compulsory licences: WTO proprietors.

(1) In the case of an application made under section 48 above in respect of a patent whose proprietor is a WTO proprietor, the relevant grounds are–

(a) where the patented invention is a product, that a demand in the United Kingdom for that product is not being met on reasonable terms;

(b) that by reason of the refusal of the proprietor of the patent concerned to grant a licence or licences on reasonable terms–

(i) the exploitation in the United Kingdom of any other patented invention which involves an important technical advance of considerable economic significance in relation to the invention for which the patent concerned was granted is prevented or hindered, or

(ii) the establishment or development of commercial or industrial activities in the United Kingdom is unfairly prejudiced;

(c) that by reason of conditions imposed by the proprietor of the patent concerned on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use

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or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the United Kingdom, is unfairly prejudiced.

(2) No order or entry shall be made under section 48 above in respect of a patent whose proprietor is a WTO proprietor unless–

(a) the applicant has made efforts to obtain a licence from the proprietor on reasonable commercial terms and conditions; and

(b) his efforts have not been successful within a reasonable period.

(3) No order or entry shall be so made if the patented invention is in the field of semi-conductor technology.

(4) No order or entry shall be made under section 48 above in respect of a patent on the ground mentioned in subsection (1)(b)(i) above unless the comptroller is satisfied that the proprietor of the patent for the other invention is able and willing to grant the proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms.

(5) A licence granted in pursuance of an order or entry so made shall not be assigned except to a person to whom the patent for the other invention is also assigned.

(6) A licence granted in pursuance of an order or entry made under section 48 above in respect of a patent whose proprietor is a WTO proprietor–

(a) shall not be exclusive;

(b) shall not be assigned except to a person to whom there is also assigned the part of the enterprise that enjoys the use of the patented invention, or the part of the goodwill that belongs to that part;

(c) shall be predominantly for the supply of the market in the United Kingdom;

(d) shall include conditions entitling the proprietor of the patent concerned to remuneration adequate in the circumstances of the case, taking into account the economic value of the licence; and

(e) shall be limited in scope and in duration to the purpose for which the licence was granted.**]**

Textual Amendments

F103 S. 48A inserted (29.7.1999) by S.I. 1999/1899, **reg. 4**

[48B [F104]Compulsory licences: other cases.

(1) In the case of an application made under section 48 above in respect of a patent whose proprietor is not a WTO proprietor, the relevant grounds are–

(a) where the patented invention is capable of being commercially worked in the United Kingdom, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable;

(b) where the patented invention is a product, that a demand for the product in the United Kingdom–

(i) is not being met on reasonable terms, or

(ii) is being met to a substantial extent by importation from a country which is not a member State;

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(c) where the patented invention is capable of being commercially worked in the United Kingdom, that it is being prevented or hindered from being so worked–
  (i) where the invention is a product, by the importation of the product from a country which is not a member State,
  (ii) where the invention is a process, by the importation from such a country of a product obtained directly by means of the process or to which the process has been applied;

(d) that by reason of the refusal of the proprietor of the patent to grant a licence or licences on reasonable terms–
  (i) a market for the export of any patented product made in the United Kingdom is not being supplied, or
  (ii) the working or efficient working in the United Kingdom of any other patented invention which makes a substantial contribution to the art is prevented or hindered, or
  (iii) the establishment or development of commercial or industrial activities in the United Kingdom is unfairly prejudiced;

(e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the United Kingdom, is unfairly prejudiced.

(2) Where–
  (a) an application is made on the ground that the patented invention is not being commercially worked in the United Kingdom or is not being so worked to the fullest extent that is reasonably practicable; and
  (b) it appears to the comptroller that the time which has elapsed since the publication in the journal of a notice of the grant of the patent has for any reason been insufficient to enable the invention to be so worked,

he may by order adjourn the application for such period as will in his opinion give sufficient time for the invention to be so worked.

(3) No order or entry shall be made under section 48 above in respect of a patent on the ground mentioned in subsection (1)(a) above if–
  (a) the patented invention is being commercially worked in a country which is a member State; and
  (b) demand in the United Kingdom is being met by importation from that country.

(4) No entry shall be made in the register under section 48 above on the ground mentioned in subsection (1)(d)(i) above, and any licence granted under section 48 above on that ground shall contain such provisions as appear to the comptroller to be expedient for restricting the countries in which any product concerned may be disposed of or used by the licensee.

(5) No order or entry shall be made under section 48 above in respect of a patent on the ground mentioned in subsection (1)(d)(ii) above unless the comptroller is satisfied that the proprietor of the patent for the other invention is able and willing to grant to the proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms.**]**

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Textual Amendments

F104 S. 48B inserted (29.7.1999) by S.I. 1999/1899, **reg. 5**

49 Provisions about licences under s. 48.

(1) Where the comptroller is satisfied, on an application made under section 48 above in respect of a patent, that the manufacture, use or disposal of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or the use of the patented process, he may (subject to the provisions of that section) order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 48 above is made in respect of a patent by a person who holds a licence under the patent, the comptroller—

(a) may, if he orders the grant of a licence to the applicant, order the existing licence to be cancelled, or

(b) may, instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.

(3) . . . . . [F105]

(4) Section 46(4) and (5) above shall apply to a licence granted in pursuance of an order under section 48 above and to a licence granted by virtue of an entry under that section as it applies to a licence granted by virtue of an entry under section 46 above.

Textual Amendments

F105 S. 49(3) repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), ss. 295, 303(2), Sch. 5 para. 13, **Sch. 8**

50 Exercise of powers on applications under s. 48.

(1) The powers of the comptroller on an application under section 48 above in respect of a patent **[**[F106]whose proprietor is not a WTO proprietor**]** shall be exercised with a view to securing the following general purposes:—

(a) that inventions which can be worked on a commercial scale in the United Kingdom and which should in the public interest be so worked shall be worked there without undue delay and to the fullest extent that is reasonably practicable;

(b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention;

(c) that the interests of any person for the time being working or developing an invention in the United Kingdom under the protection of a patent shall not be unfairly prejudiced.

(2) Subject to subsection (1) above, the comptroller shall, in determining whether to make an order or entry in pursuance of **[**[F107]any application under section 48 above**]**, take account of the following matters, that is to say—

(a) the nature of the invention, the time which has elapsed since the publication in the journal of a notice of the grant of the patent and the measures already taken by the proprietor of the patent or any licensee to make full use of the invention;

(b) the ability of any person to whom a licence would be granted under the order concerned to work the invention to the public advantage; and

(c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted,

but shall not be required to take account of matters subsequent to the making of the application.

Textual Amendments

F106 Words in s. 50(1) inserted (29.7.1999) by S.I. 1999/1899, **reg. 7(2)**

F107 Words in s. 50(2) substituted (29.7.1999) by S.I. 1999/1899, **reg. 7(3)**

[F108 50A Powers exercisable following merger and market investigations

(1) Subsection (2) below applies where—

(a) section 41(2), 55(2), 66(6), 75(2), 83(2), 138(2), 147(2) [F109, 147A(2)] or 160(2) of, or paragraph 5(2) or 10(2) of Schedule 7 to, the Enterprise Act 2002 (powers to take remedial action following merger or market investigations) applies;

(b) the [F110 Competition and Markets Authority] or (as the case may be) the Secretary of State considers that it would be appropriate to make an application under this section for the purpose of remedying, mitigating or preventing a matter which cannot be dealt with under the enactment concerned; and

(c) the matter concerned involves—

(i) conditions in licences granted under a patent by its proprietor restricting the use of the invention by the licensee or the right of the proprietor to grant other licences; or

(ii) a refusal by the proprietor of a patent to grant licences on reasonable terms.

(2) The [F111 Competition and Markets Authority] or (as the case may be) the Secretary of State may apply to the comptroller to take action under this section.

(3) Before making an application the [F111 Competition and Markets Authority] or (as the case may be) the Secretary of State shall publish, in such manner as it or he thinks appropriate, a notice describing the nature of the proposed application and shall consider any representations which may be made within 30 days of such publication by persons whose interests appear to it or him to be affected.

(4) The comptroller may, if it appears to him on an application under this section that the application is made in accordance with this section, by order cancel or modify any condition concerned of the kind mentioned in subsection (1)(c)(i) above or may, instead or in addition, make an entry in the register to the effect that licences under the patent are to be available as of right.

[F112 (5) References in this section to the Competition and Markets Authority are references to a CMA group except where—

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(a) section 75(2) of the Enterprise Act 2002 applies; or

(b) any other enactment mentioned in subsection (1)(a) above applies and the functions of the Competition and Markets Authority under that enactment are being performed by the CMA Board by virtue of section 34C(3) or 133A(2) of the Enterprise Act 2002.**]**

(6) References in section 35, 36, 47, 63, 134 **[**[F113], 141 or 141A**]** of the Enterprise Act 2002 (questions to be decided by the **[**[F114]Competition and Markets Authority**]** in its reports) to taking action under section 41(2), 55, 66, 138 **[**[F115], 147 or 147A**]** shall include references to taking action under subsection (2) above.

(7) Action taken by virtue of subsection (4) above in consequence of an application under subsection (2) above where an enactment mentioned in subsection (1)(a) above applies shall be treated, for the purposes of sections 91(3), 92(1)(a), 162(1) and 166(3) of the Enterprise Act 2002 (duties to register and keep under review enforcement orders etc.), as if it were the making of an enforcement order (within the meaning of the Part concerned) under the relevant power in Part 3 or (as the case may be) 4 of that Act.

[In subsection (5) "CMA Board" and "CMA group" have the same meaning as in [F116](8) Schedule 4 to the Enterprise and Regulatory Reform Act 2013.**]]**

Textual Amendments

F108 S. 50A inserted (20.6.2003) by Enterprise Act 2002 (c. 40), ss. 278, 279, **Sch. 25 para. 8(2)**; S.I. 2003/1397, art. 2(1), Sch. (with arts. 8, 12)

F109 Word in s. 50A(1)(a) inserted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 32(2)** (with art. 3)

F110 Words in s. 50A(1)(b) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 32(3)** (with art. 3)

F111 Words in s. 50A(2)(3) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 32(3)** (with art. 3)

F112 S. 50A(5) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 32(4)** (with art. 3)

F113 Words in s. 50A(6) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 32(5)(a)** (with art. 3)

F114 Words in s. 50A(6) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 32(5)(b)** (with art. 3)

F115 Words in s. 50A(6) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 32(5)(c)** (with art. 3)

F116 S. 50A(8) inserted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 32(6)** (with art. 3)

Modifications etc. (not altering text)

C7 S. 50A(1)(a) amended (20.6.2003) by The Enterprise Act 2002 (Protection of Legitimate Interests) Order 2003 (S.I. 2003/1592), art. 1(1), **Sch. 4 para. 3(1)(a)**

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C8 S. 50A(1)(a) amended (20.6.2003) by The Enterprise Act 2002 (Protection of Legitimate Interests) Order 2003 (S.I. 2003/1592), art. 1(1), **Sch. 4 para. 3(1)(b)**

C9 S. 50A(6) amended (20.6.2003) by The Enterprise Act 2002 (Protection of Legitimate Interests) Order 2003 (S.I. 2003/1592), art. 1(1), **Sch. 4 para. 3(1)(c)**

C10 S. 50A(6) amended (20.6.2003) by The Enterprise Act 2002 (Protection of Legitimate Interests) Order 2003 (S.I. 2003/1592), art. 1(1), **Sch. 4 para. 3(1)(d)**

C11 S. 50A(7) amended (20.6.2003) by The Enterprise Act 2002 (Protection of Legitimate Interests) Order 2003 (S.I. 2003/1592), art. 1(1), **Sch. 4 para. 3(1)(e)**

[F117 51 Powers exercisable in consequence of report of [F118 Competition and Markets Authority].

(1) Where a report of the **[**F119 Competition and Markets Authority**]** has been laid before Parliament containing conclusions to the effect—

F120 (a) . . . . . .

F120 (b) . . . . . .

(c) on a competition reference, that a person was engaged in an anti-competitive practice which operated or may be expected to operate against the public interest, or

(d) on a reference under section 11 of the Competition Act 1980 (reference of public bodies and certain other persons), that a person is pursuing a course of conduct which operates against the public interest,

the appropriate Minister or Ministers may apply to the comptroller to take action under this section.

(2) Before making an application the appropriate Minister or Ministers shall publish, in such manner as he or they think appropriate, a notice describing the nature of the proposed application and shall consider any representations which may be made within 30 days of such publication by persons whose interests appear to him or them to be affected.

(3) If on an application under this section it appears to the comptroller that the matters specified in the **[**F121 Competition and Markets Authority's report as being those which in the opinion of the Competition and Markets Authority**]** operate, or operated or may be expected to operate, against the public interest include—

(a) conditions in licences granted under a patent by its proprietor restricting the use of the invention by the licensee or the right of the proprietor to grant other licences, or

(b) a refusal by the proprietor of a patent to grant licences on reasonable terms

he may by order cancel or modify any such condition or may, instead or in addition, make an entry in the register to the effect that licences under the patent are to be available as of right.

(4) In this section "the appropriate Minister or Ministers"means the Minister or Ministers to whom the report of the **[**F122 Competition and Markets Authority**]** was made.**]**

Textual Amendments

F117 S. 51 substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 14**

F118 Words in s. 51 heading substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 33(5)** (with art. 3)

F119 Words in s. 51(1) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 33(2)** (with art. 3)

F120 S. 51(1)(a)(b) repealed (20.6.2003 for specified purposes and 29.12.2004 in so far as not already in force) by Enterprise Act 2002 (c. 40), s. 279, Sch. 25 para. 8(3), **Sch. 26**; S.I. 2003/1397, art. 2(1), Sch. (with arts. 3(1), 8, 12); S.I. 2004/3233, art. 2, Sch. (with arts. 3-5)

F121 Words in s. 51(3) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 33(3)** (with art. 3)

F122 Words in s. 51(4) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 33(4)** (with art. 3)

[52 F123 Opposition, appeal and arbitration.

(1) The proprietor of the patent concerned or any other person wishing to oppose an application under sections 48 to 51 above may, in accordance with rules, give to the comptroller notice of opposition; and the comptroller shall consider any opposition in deciding whether to grant the application.

(2) Where an order or entry has been made under section 48 above in respect of a patent whose proprietor is a WTO proprietor–

(a) the proprietor or any other person may, in accordance with rules, apply to the comptroller to have the order revoked or the entry cancelled on the grounds that the circumstances which led to the making of the order or entry have ceased to exist and are unlikely to recur;

(b) any person wishing to oppose an application under paragraph (a) above may, in accordance with rules, give to the comptroller notice of opposition; and

(c) the comptroller shall consider any opposition in deciding whether to grant the application.

(3) If it appears to the comptroller on an application under subsection (2)(a) above that the circumstances which led to the making of the order or entry have ceased to exist and are unlikely to recur, he may–

(a) revoke the order or cancel the entry; and

(b) terminate any licence granted to a person in pursuance of the order or entry subject to such terms and conditions as he thinks necessary for the protection of the legitimate interests of that person.

(4) Where an appeal is brought–

(a) from an order made by the comptroller in pursuance of an application under sections 48 to 51 above;

(b) from a decision of his to make an entry in the register in pursuance of such an application;

(c) from a revocation or cancellation made by him under subsection (3) above; or

(d) from a refusal of his to make such an order, entry, revocation or cancellation,

the Attorney General, the appropriate Law Officer within the meaning of section 4A of the Crown Suits (Scotland) Act 1857 F124 or the Attorney General for Northern Ireland,

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or **[**[F125]such other person who has a right of audience**]** as any of them may appoint, shall be entitled to appear and be heard.

(5) Where an application under sections 48 to 51 above or subsection (2) above is opposed, and either–

(a) the parties consent, or

(b) the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the comptroller conveniently be made before him,

the comptroller may at any time order the whole proceedings, or any question or issue of fact arising in them, to be referred to an arbitrator or arbiter agreed on by the parties or, in default of agreement, appointed by the comptroller.

(6) Where the whole proceedings are so referred, unless the parties otherwise agree before the award of the arbitrator or arbiter is made, an appeal shall lie from the award to the court.

(7) Where a question or issue of fact is so referred, the arbitrator or arbiter shall report his findings to the comptroller.**]**

Textual Amendments

F123 S. 52 substituted (29.7.1999) by S.I. 1999/1899, **reg. 6** (with transitional provisions in reg. 8(4))

F124 1857 c. 44.

F125 Words in s. 52(4) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 4(1)**; S.I. 2014/2330, art. 3, Sch.

53 Compulsory licences; supplementary provisions.

[F126](1) . . . . . .

(2) In any proceedings on an **[**[F127]application made under section 48 above in respect of a patent**]**, any statement with respect to any activity in relation to the patented invention, or with respect to the grant or refusal of licences under the patent, contained in a report of the **[**[F128]Competition and Markets Authority**]** laid before Parliament under Part VII of the [M4]Fair Trading Act 1973 **[**[F129]or section 17 of the Competition Act 1980**]**[F130] or published under Part 3 or 4 of the Enterprise Act 2002**]** shall be prima facie evidence of the matters stated, and in Scotland shall be sufficient evidence of those matters.

(3) The comptroller may make an entry in the register under sections 48 to 51 above notwithstanding any contract which would have precluded the entry on the application of the proprietor of the patent under section 46 above.

(4) An entry made in the register under sections 48 to 51 above shall for all purposes have the same effect as an entry made under section 46 above.

(5) No order or entry shall be made in pursuance of an application under sections 48 to 51 above which would be at variance with any treaty or international convention to which the United Kingdom is a party.

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Textual Amendments

F126 S. 53(1) repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 12, **Sch. 3**; S.I. 2004/3205, art. 2(g)(k) (with art. 9)

F127 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 15(a)**

F128 Words in s. 53(2) substituted (1.4.2014) by The Enterprise and Regulatory Reform Act 2013 (Competition) (Consequential, Transitional and Saving Provisions) Order 2014 (S.I. 2014/892), art. 1(1), **Sch. 1 para. 34** (with art. 3)

F129 Words inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 15(b)**

F130 Words in s. 53(2) inserted (20.6.2003) by Enterprise Act 2002 (c. 40), s. 279, **Sch. 25 para. 8(4)**; S.I. 2003/1397, art. 2(1), Sch. (with arts. 812)

Modifications etc. (not altering text)

C12 S. 53(2) modified (20.6.2003) by The Enterprise Act 2002 (Protection of Legitimate Interests) Order 2003 (S.I. 2003/1592), art. 1(1), **Sch. 4 para. 3(2)** (as amended (1.4.2014) by S.I. 2014/891, arts. 1, 19(2) (with arts. 20-23))

Marginal Citations

M4 1973 c. 41.

54 Special provisions where patented invention is being worked abroad.

(1) Her Majesty may by Order in Council provide that the comptroller may not (otherwise than for purposes of the public interest) make an order or entry in respect of a patent in pursuance of an application under sections 48 to 51 above if the invention concerned is being commercially worked in any relevant country specified in the Order and demand in the United Kingdom for any patented product resulting from that working is being met by importation from that country.

(2) In subsection (1) above "relevant country" means a country other than a member state **[**[F131]or a member of the World Trade Organisation**]** whose law in the opinion of Her Majesty in Council incorporates or will incorporate provisions treating the working of an invention in, and importation from, the United Kingdom in a similar way to that in which the Order in Council would (if made) treat the working of an invention in, and and importation from, that country.

Textual Amendments

F131 Words in s. 54(2) inserted (29.7.1999) by S.I. 1999/1899, **reg. 7(4)**

Use of patented inventions for services of the Crown

55 Use of patented inventions for services of the Crown.

(1) Notwithstanding anything in this Act, any government department and any person authorised in writing by a government department may, for the services of the Crown and in accordance with this section, do any of the following acts in the United

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Kingdom in relation to a patented invention without the consent of the proprietor of the patent, that is to say—

(a) where the invention is a product, may—

(i) make, use, import or keep the product, or sell or offer to sell it where to do so would be incidental or ancillary to making, using, importing or keeping it; or

(ii) in any event, sell or offer to sell it for foreign defence purposes or for the production or supply of specified drugs and medicines, or dispose or offer to dispose of it (otherwise than by selling it) for any purpose whatever;

(b) where the invention is a process, may use it or do in relation to any product obtained directly by means of the process anything mentioned in paragraph (a) above;

(c) without prejudice to the foregoing, where the invention or any product obtained directly by means of the invention is a specified drug or medicine, may sell or offer to sell the drug or medicine;

(d) may supply or offer to supply to any person any of the means, relating to an essential element of the invention, for putting the invention into effect;

(e) may dispose or offer to dispose of anything which was made, used, imported or kept in the exercise of the powers conferred by this section and which is no longer required for the purpose for which it was made, used, imported or kept (as the case may be),

and anything done by virtue of this subsection shall not amount to an infringement of the patent concerned.

(2) Any act done in relation to an invention by virtue of this section is in the following provisions of this section referred to as use of the invention; and "use", in relation to an invention, in sections 56 to 58 below shall be construed accordingly.

(3) So far as the invention has before its priority date been duly recorded by or tried by or on behalf of a government department or the United Kingdom Atomic Energy Authority otherwise than in consequence of a relevant communication made in confidence, any use of the invention by virtue of this section may be made free of any royalty or other payment to the proprietor.

(4) So far as the invention has not been so recorded or tried, any use of it made by virtue of this section at any time either—

(a) after the publication of the application for the patent for the invention; or

(b) without prejudice to paragraph (a) above, in consequence of a relevant communication made after the priority date of the invention otherwise than in confidence;

shall be made on such terms as may be agreed either before or after the use by the government department and the proprietor of the patent with the approval of the Treasury or as may in default of agreement be determined by the court on a reference under section 58 below.

(5) Where an invention is used by virtue of this section at any time after publication of an application for a patent for the invention but before such a patent is granted, and the terms for its use agreed or determined as mentioned in subsection (4) above include terms as to payment for the use, then (notwithstanding anything in those terms) any such payment shall be recoverable only—

(a) after such a patent is granted; and

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(b) if (apart from this section) the use would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Patent Office.

(6) The authority of a government department in respect of an invention may be given under this section either before or after the patent is granted and either before or after the use in respect of which the authority is given is made, and may be given to any person whether or not he is authorised directly or indirectly by the proprietor of the patent to do anything in relation to the invention.

(7) Where any use of an invention is made by or with the authority of a government department under this section, then, unless it appears to the department that it would be contrary to the public interest to do so, the department shall notify the proprietor of the patent as soon as practicable after the second of the following events, that is to say, the use is begun and the patent is granted, and furnish him with such information as to the extent of the use as he may from time to time require.

(8) A person acquiring anything disposed of in the exercise of powers conferred by this section, and any person claiming through him, may deal with it in the same manner as if the patent were held on behalf of the Crown.

(9) In this section "relevant communication", in relation to an invention, means a communication of the invention directly or indirectly by the proprietor of the patent or any person from whom he derives title.

(10) Subsection (4) above is without prejudice to any rule of law relating to the confidentiality of information.

(11) In the application of this section to Northern Ireland, the reference in subsection (4) above to the Treasury shall, where the government department referred to in that subsection is a department of the Government of Northern Ireland, be construed as a reference to the Department of Finance for Northern Ireland.

Modifications etc. (not altering text)

C13 S. 55(4) modified by Atomic Energy (Weapons Group) Act 1973 (c. 4, SIF 8), **s. 5(2)** (as amended by Patents Act 1977 (c.37 SIF 91), s. 132(5), Sch. 5 para. 6)

56 Interpretation, etc., of provisions about Crown use.

(1) Any reference in section 55 above to a patented invention, in relation to any time, is a reference to an invention for which a patent has before that time been, or is subsequently, granted.

(2) In this Act, except so far as the context otherwise requires, "the services of the Crown" includes—

(a) the supply of anything for foreign defence purposes;

(b) the production or supply of specified drugs and medicines; and

(c) such purposes relating to the production or use of atomic energy or research into matters connected therewith as the Secretary of State thinks necessary or expedient;

and "use for the services of the Crown" shall be construed accordingly.

(3) In section 55(1)(a) above and subsection (2)(a) above, references to a sale or supply of anything for foreign defence purposes are references to a sale or supply of the thing—

(a) to the government of any country outside the United Kingdom, in pursuance of an agreement or arrangement between Her Majesty's Government in the United Kingdom and the government of that country, where the thing is required for the defence of that country or of any other country whose government is party to any agreement or arrangement with Her Majesty's Government in respect of defence matters; or

(b) to the United Nations, or to the government of any country belonging to that organisation, in pursuance of an agreement or arrangement between Her Majesty's Government and that organisation or government, where the thing is required for any armed forces operating in pursuance of a resolution of that organisation or any organ of that organisation.

(4) For the purposes of section 55(1)(a) and (c) above and subsection (2)(b) above, specified drugs and medicines are drugs and medicines which are both—

(a) required for the **[**[F132]provision of—

[F133]**[** primary medical services [F134]**[**under **[**[F135]the National Health Service

(ai) Act 2006, the National Health Service (Wales) Act 2006**]**, Part 1 of the National Health Service (Scotland) Act 1978 or any corresponding provisions of the law in force in Northern Ireland or the Isle of Man**]** or primary dental services under **[**[F135]the National Health Service Act 2006, the National Health Service (Wales) Act 2006**]** , or any corresponding provisions of the law in force in Northern Ireland or the Isle of Man, or**]**

(i) pharmaceutical services, general medical services or general dental services under **[**[F136]Chapter 1 of Part 7 of the National Health Service Act 2006 or Chapter 1 of Part 7 of the National Health Service (Wales) Act 2006**][**[F137] (in the case of pharmaceutical services) **]**, Part II of the National Health Service (Scotland) Act 1978 **[**[F138](in the case of pharmaceutical services or general dental services)**]**, or the corresponding provisions of the law in force in Northern Ireland or the Isle of Man, or

(ii) personal medical services or personal dental services provided in accordance with arrangements made under [F139]... section 17C of the 1978 Act **[**[F140](in the case of personal dental services)**]** , or the corresponding provisions of the law in force in Northern Ireland or the Isle of Man**][**[F141], or

(iii) local pharmaceutical services provided under a pilot scheme established under **[**[F142]section 134 of the National Health Service Act 2006, or section 92 of the National Health Service (Wales) Act 2006,**]** or an LPS scheme established under **[**[F143]Schedule 12 to the National Health Service Act 2006, or Schedule 7 to the National Health Service (Wales) Act 2006**]**, or under any corresponding provision of the law in force in the Isle of Man**]**

and,

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(b) specified for the purposes of this subsection in regulations made by the Secretary of State.

Textual Amendments

F132 Words in s. 56(4)(a) substituted for s. 56(4)(a)(i)(ii) and words immediately preceding them (1.4.1998) by 1997 c. 46, s. 41(10), **Sch. 2 Pt. I para. 2**; S.I. 1998/631, art. 2(1)(b), **Sch. 2** (subject to art. 3, 4, 5)

F133 S. 56(4)(a)(ai) inserted (1.4.2004) by Health and Social Care (Community Health and Standards) Act 2003 (c. 43), s. 199(1)(4), **Sch. 11 para. 6(2)**; S.I. 2004/288, **art. 5(2)(d)** (with art. 7) (as amended by S.I. 2004/866 and S.I. 2005/2925); S.I. 2004/480, **art. 4(2)(d)** (with art. 6) (as amended by S.I. 2004/1019 and S.I. 2006/345))

F134 Words in s. 56(4)(a)(ai) inserted (1.4.2004) by Primary Medical Services (Scotland) Act 2004 (Consequential Modifications) Order 2004 (S.I. 2004/957), art. 1, **Sch. para. 2(a)**

F135 Words in s. 56(4)(a)(ai) substituted (1.3.2007) by National Health Service (Consequential Provisions) Act 2006 (c. 43), s. 8(2), **Sch. 1 para. 58(a)** (with Sch. 3 Pt. 1)

F136 Words in s. 56(4)(a)(i) substituted (1.3.2007) by virtue of National Health Service (Consequential Provisions) Act 2006 (c. 43), s. 8(2), **Sch. 1 para. 58(b)** (with Sch. 3 Pt. 1)

F137 Words in s. 56(4)(a)(i) inserted (1.4.2004) by Health and Social Care (Community Health and Standards) Act 2003 (c. 43), s. 199(1)(4), **Sch. 11 para. 6(3)**; S.I. 2004/288, art. 5(2)(d) (with art. 7) (as amended by S.I. 2004/866 and S.I. 2005/2925); S.I. 2004/480, art. 4(2)(d) (with art. 6) (as amended by S.I. 2004/1019 and S.I. 2006/345)

F138 Words in s. 56(4)(a)(i) inserted (1.4.2004) by Primary Medical Services (Scotland) Act 2004 (Consequential Modifications) Order 2004 (S.I. 2004/957), art. 1, **Sch. para. 2(b)**

F139 Words in s. 56(4)(a)(ii) repealed (1.4.2004) by Health and Social Care (Community Health and Standards) Act 2003 (c. 43), s. 199(1)(4), Sch. 11 para. 6(4), **Sch. 14 Pt. 4**; S.I. 2004/288, arts. 5(2)(d), 6(2)(c) (with art. 7) (as amended by S.I. 2004/866 and S.I. 2005/2925); S.I. 2004/480, arts. 4(2)(d), 5(2)(c) (with art. 6) (as amended by S.I. 2004/1019 and S.I. 2006/345)

F140 Words in s. 56(4)(a)(ii) inserted (1.4.2004) by Primary Medical Services (Scotland) Act 2004 (Consequential Modifications) Order 2004 (S.I. 2004/957), art. 1, **Sch. para. 2(c)**

F141 S. 56(4)(a)(iii) and preceding word inserted (1.7.2002 for W. and 1.1.2003 for E.) by 2001 c. 15, ss. 67, 70, Sch. 5 para. 4; S.I. 2002/1475, **art. 2(1)**, Sch. Pt. 1; S.I. 2003/53, art. 2(a)

F142 Words in s. 56(4)(a)(iii) substituted (1.3.2007) by National Health Service (Consequential Provisions) Act 2006 (c. 43), s. 8(2), **Sch. 1 para. 58(c)(i)** (with Sch. 3 Pt. 1)

F143 Words in s. 56(4)(a)(iii) substituted (1.3.2007) by virtue of National Health Service (Consequential Provisions) Act 2006 (c. 43), s. 8(2), **Sch. 1 para. 58(c)(ii)** (with Sch. 3 Pt. 1)

57 Rights of third parties in respect of Crown use.

(1) In relation to—

(a) any use made for the services of the Crown of an invention by a government department, or a person authorised by a government department, by virtue of section 55 above, or

(b) anything done for the services of the Crown to the order of a government department by the proprietor of a patent in respect of a patented invention or by the proprietor of an application in respect of an invention for which an application for a patent has been filed and is still pending,

the provisions of any licence, assignment, assignation or agreement to which this subsection applies shall be of no effect so far as those provisions restrict or regulate the working of the invention, or the use of any model, document or information relating to it, or provide for the making of payments in respect of, or calculated by reference to, such working or use; and the reproduction or publication of any model or document

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in connection with the said working or use shall not be deemed to be an infringement of any copyright **[**[F144]or design right**]** subsisting in the model or document.

(2) Subsection (1) above applies to a licence, assignment, assignation or agreement which is made, whether before or after the appointed day, between (on the one hand) any person who is a proprietor of or an applicant for the patent, or anyone who derives title from any such person or from whom such person derives title, and (on the other hand) any person whatever other than a government department.

(3) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the working of the invention is in force under the patent or application concerned, then—

(a) in relation to anything done in respect of the invention which, but for the provisions of this section and section 55 above, would constitute an infringement of the rights of the licensee, subsection (4) of that section shall have effect as if for the reference to the proprietor of the patent there were substituted a reference to the licensee; and

(b) in relation to anything done in respect of the invention by the licensee by virtue of an authority given under that section, that section shall have effect as if the said subsection (4) were omitted.

(4) Subject to the provisions of subsection (3) above, where the patent, or the right to the grant of the patent, has been assigned to the proprietor of the patent or application in consideration of royalties or other benefits determined by reference to the working of the invention, then—

(a) in relation to any use of the invention by virtue of section 55 above, subsection (4) of that section shall have effect as if the reference to the proprietor of the patent included a reference to the assignor, and any sum payable by virtue of that subsection shall be divided between the proprietor of the patent or application and the assignor in such proportion as may be agreed on by them or as may in default of agreement be determined by the court on a reference under section 58 below; and

(b) in relation to any act done in respect of the invention for the services of the Crown by the proprietor of the patent or application to the order of a government department, section 55(4) above shall have effect as if that act were use made by virtue of an authority given under that section.

(5) Where section 55(4) above applies to any use of an invention and a person holds an exclusive licence under the patent or application concerned (other than such a licence as is mentioned in subsection (3) above) authorising him to work the invention, then subsections (7) and (8) below shall apply.

(6) In those subsections "the section 55(4)" payment means such payment (if any) as the proprietor of the patent or application and the department agree under section 55 above, or the court determines under section 58 below, should be made by the department to the proprietor in respect of the use of the invention.

(7) The licensee shall be entitled to recover from the proprietor of the patent or application such part (if any) of the section 55(4) payment as may be agreed on by them or as may in default of agreement be determined by the court under section 58 below to be just having regard to any expenditure incurred by the licensee—

(a) in developing the invention, or

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(b) in making payments to the proprietor in consideration of the licence, other than royalties or other payments determined by reference to the use of the invention.

(8) Any agreement by the proprietor of the patent or application and the department under section 55(4) above as to the amount of the section 55(4) payment shall be of no effect unless the licensee consents to the agreement; and any determination by the court under section 55(4) above as to the amount of that payment shall be of no effect unless the licensee has been informed of the reference to the court and is given an opportunity to be heard.

(9) Where any models, documents or information relating to an invention are used in connection with any use of the invention which falls within subsection (1)(a) above, or with anything done in respect of the invention which falls within subsection (1)(b) above, subsection (4) of section 55 above shall (whether or not it applies to any such use of the invention) apply to the use of the models, documents or information as if for the reference in it to the proprietor of the patent there were substituted a reference to the person entitled to the benefit of any provision of an agreement which is rendered inoperative by this section in relation to that use; and in section 58 below the references to terms for the use of an invention shall be construed accordingly.

(10) Nothing in this section shall be construed as authorising the disclosure to a government department or any other person of any model, document or information to the use of which this section applies in contravention of any such licence, assignment, assignation or agreement as is mentioned in this section.

Textual Amendments

F144 Words inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(1), **Sch. 7 para. 20**

Modifications etc. (not altering text)

C14 By S.I. 1987/1497, **reg. 9(2) para. 2** Table B it is provided that s. 57(1) shall apply as if there were inserted at the end thereof the words, "or of any topography right"

[[F145]57A Compensation for loss of profit.

(1) Where use is made of an invention for the services of the Crown, the government department concerned shall pay—

(a) to the proprietor of the patent, or

(b) if there is an exclusive licence in force in respect of the patent, to the exclusive licensee,compensation for any loss resulting from his not being awarded a contract to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process.

(2) Compensation is payable only to the extent that such a contract could have been fulfilled from his existing manufacturing or other capacity; but is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract.

(3) In determining the loss, regard shall be had to the profit which would have been made on such a contract and to the extent to which any manufacturing or other capacity was under-used.

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(4) No compensation is payable in respect of any failure to secure contracts to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process, otherwise than for the services of the Crown.

(5) The amount payable shall, if not agreed between the proprietor or licensee and the government department concerned with the approval of the Treasury, be determined by the court on a reference under section 58, and is in addition to any amount payable under section 55 or 57.

(6) In this section "the government department concerned", in relation to any use of an invention for the services of the Crown, means the government department by whom or on whose authority the use was made.

(7) In the application of this section to Northern Ireland, the reference in subsection (5) above to the Treasury shall, where the government department concerned is a department of the Government of Northern Ireland, be construed as a reference to the Department of Finance and Personnel.**]**

Textual Amendments

F145 S. 57A inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 16(1)(4)**

58 References of disputes as to Crown use.

[[F146](1) Any dispute as to—

(a) the exercise by a government department, or a person authorised by a government department, of the powers conferred by section 55 above,

(b) terms for the use of an invention for the services of the Crown under that section,

(c) the right of any person to receive any part of a payment made in pursuance of subsection (4) of that section, or

(d) the right of any person to receive a payment under section 57A,

may be referred to the court by either party to the dispute after a patent has been granted for the invention.**]**

(2) If in such proceedings any question arises whether an invention has been recorded or tried as mentioned in section 55 above, and the disclosure of any document recording the invention, or of any evidence of the trial thereof, would in the opinion of the department be prejudicial to the public interest, the disclosure may be made confidentially to **[**[F147]the other party's legal representative**]** or to an independent expert mutually agreed upon.

(3) In determining under this section any dispute between a government department and any person as to the terms for the use of an invention for the services of the Crown, the court shall have regard—

(a) to any benefit or compensation which that person or any person from whom he derives title may have received or may be entitled to receive directly or indirectly from any government department in respect of the invention in question;

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(b) to whether that person or any person from whom he derives title has in the court's opinion without reasonable cause failed to comply with a request of the department to use the invention for the services of the Crown on reasonable terms.

(4) In determining whether or not to grant any relief **[**[F148]under subsection (1)(a), (b) or (c) above**]** and the nature and extent of the relief granted the court shall, subject to the following provisions of this section, apply the principles applied by the court immediately before the appointed day to the granting of relief under section 48 of the 1949 Act.

(5) On a reference under this section the court may refuse to grant relief by way of compensation in respect of the use of an invention for the services of the Crown during any further period specified under section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that section.

(6) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, **[**[F149]or, in the case of a European patent (UK), has been allowed under any of the provisions in the Agreement on a Unified Patent Court,**]** the court shall not grant relief by way of compensation under this section in respect of any such use before the decision to allow the amendment unless the court is satisfied that

[[F150](a)**]** the specification of the patent as published was framed in good faith and with reasonable skill and knowledge **[**[F151]and.

(b) the relief is sought in good faith**]**

(7) If the validity of a patent is put in issue in proceedings under this section and it is found that the patent is only partially valid, the court may, subject to subsection (8) below, grant relief to the proprietor of the patent in respect of that part of the patent which is found to be valid and to have been used for the services of the Crown.

(8) Where in any such proceedings it is found that a patent is only partially valid, the court shall not grant relief by way of compensation, costs or expenses except where the proprietor of the patent proves that

[[F152](a)**]** the specification of the patent was framed in good faith and with reasonable skill and knowledge, and

[[F153](b) the relief is sought in good faith,

and**]** in that event the court may grant relief in respect of that part of the patent which is valid and has been so used, subject to the discretion of the court as to costs and expenses and as to the date from which compensation should be awarded.

(9) As a condition of any such relief the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 75 below, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

[[F154](9A) The court may also grant such relief in the case of a European patent (UK) on condition that the claims of the patent are limited to its satisfaction by the European Patent Office at the request of the proprietor.**]**

(10) In considering the amount of any compensation for the use of an invention for the services of the Crown after publication of an application for a patent for the invention and before such a patent is granted, the court shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 16 above, that a patent would be granted conferring on the proprietor of

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the patent protection for an act of the same description as that found to constitute that use, and if the court finds that it would not have been reasonable, it shall reduce the compensation to such amount as it thinks just.

(11) Where by virtue of a transaction, instrument or event to which section 33 above applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent (the new proprietor or licensee) and a government department or a person authorised by a government department subsequently makes use under section 55 above of the patented invention, the new proprietor or licensee shall not be entitled to any compensation under section 55(4) above (as it stands or as modified by section 57(3) above) **[**[F155], or to any compensation under section 57A above,**]** in respect of a subsequent use of the invention before the transaction, instrument or event is registered unless—

(a) the transaction, instrument or event is registered within the period of six months beginning with its date; or

(b) the court is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.

(12) In any proceedings under this section the court may at any time order the whole proceedings or any question or issue of fact arising in them to be referred, on such terms as the court may direct, to a Circuit judge discharging the functions of an official referee or an arbitrator in England and Wales or Northern Ireland, or to an arbiter in Scotland; and references to the court in the foregoing provisions of this section shall be construed accordingly.

(13) One of two or more joint proprietors of a patent or application for a patent may without the concurrence of the others refer a dispute to the court under this section, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Textual Amendments

F146 S. 58(1) substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 16(2)(4)**

F147 Words in s. 58(2) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 4(2)**; S.I. 2014/2330, art. 3, Sch.

F148 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 16(2)(4)**

F149 Words in s. 58(6) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(2)** (with art. 3)

F150 Words in s. 58(6) renumbered as s. 58(6)(a) (13.12.2007) by Patents Act 2004 (c. 16), **ss. 2(2)(a)**, 17(1); S.I. 2007/3396, art. 2(c)

F151 S. 58(6)(b) and word inserted (13.12.2007) by Patents Act 2004 (c. 16), **ss. 2(2)(a)**, 17(1); S.I. 2007/3396, art. 2(c)

F152 Words in s. 58(8) renumbered as s. 58(8)(a) (13.12.2007) by Patents Act 2004 (c. 16), **ss. 2(2)(b)**, 17(1); S.I. 2007/3396, art. 2(c)

F153 S. 58(8)(b) and word inserted (13.12.2007) by Patents Act 2004 (c. 16), **ss. 2(2)(b)**, 17(1); S.I. 2007/3396, art. 2(c)

F154 S. 58(9A) inserted (13.12.2007) by Patents Act 2004 (c. 16), **ss. 3(2)**, 17(1); S.I. 2007/3396, art. 2(e)

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F155 Words inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 16(3)(4)**

59 Special provisions as to Crown use during emergency.

(1) During any period of emergency within the meaning of this section the powers exercisable in relation to an invention by a government department or a person authorised by a government department under section 55 above shall include power to use the invention for any purpose which appears to the department necessary or expedient—

(a) for the efficient prosecution of any war in which Her Majesty may be engaged;

(b) for the maintenance of supplies and services essential to the life of the community;

(c) for securing a sufficiency of supplies and services essential to the well-being of the community;

(d) for promoting the productivity of industry, commerce and agriculture;

(e) for fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade;

(f) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or

(g) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any country or territory outside the United Kingdom which is in grave distress as the result of war;

and any reference in this Act to the services of the Crown shall, as respects any period of emergency, include a reference to those purposes.

(2) In this section the use of an invention includes, in addition to any act constituting such use by virtue of section 55 above, any act which would, apart from that section and this section, amount to an infringement of the patent concerned or, as the case may be, give rise to a right under section 69 below to bring proceedings in respect of the application concerned, and any reference in this Act to "use for the services of the Crown" shall, as respects any period of emergency, be construed accordingly.

(3) In this section "period of emergency" means any period beginning with such date as may be declared by Order in Council to be the commencement, and ending with such date as may be so declared to be the termination, of a period of emergency for the purposes of this section.

(4) A draft of an Order under this section shall not be submitted to Her Majesty unless it has been laid before, and approved by resolution of, each House of Parliament.

Infringement

60 Meaning of infringement.

(1) Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say—

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(a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;

(b) where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;

(c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

(2) Subject to the following provisions of this section, a person (other than the proprietor of the patent) also infringes a patent for an invention if, while the patent is in force and without the consent of the proprietor, he supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.

(3) Subsection (2) above shall not apply to the supply or offer of a staple commercial product unless the supply or the offer is made for the purpose of inducing the person supplied or, as the case may be, the person to whom the offer is made to do an act which constitutes an infringement of the patent by virtue of subsection (1) above.

[F156](4) . . . . . .

(5) An act which, apart from this subsection, would constitute an infringement of a patent for an invention shall not do so if—

(a) it is done privately and for purposes which are not commercial;

(b) it is done for experimental purposes relating to the subject-matter of the invention;

(c) it consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;

(d) it consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of such a ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the internal or territorial waters of the United Kingdom;

(e) it consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing the United Kingdom (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft, hovercraft or vehicle;

(f) it consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing the United Kingdom as aforesaid or of the importation into the United Kingdom, or the use or storage there, of any part or accessory for such an aircraft.

[[F157](g) it consists of the use by a farmer of the product of his harvest for propagation or multiplication by him on his own holding, where there has been a sale of plant propagating material to the farmer by the proprietor of the patent or with his consent for agricultural use;

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(h) it consists of the use of an animal or animal reproductive material by a farmer for an agricultural purpose following a sale to the farmer, by the proprietor of the patent or with his consent, of breeding stock or other animal reproductive material which constitutes or contains the patented invention.**]**

[[F158](i) it consists of—

(i) an act done in conducting a study, test or trial which is necessary for and is conducted with a view to the application of paragraphs 1 to 5 of article 13 of Directive 2001/82/EC or paragraphs 1 to 4 of article 10 of Directive 2001/83/EC, or

(ii) any other act which is required for the purpose of the application of those paragraphs.**]**

[[F159](j) it consists of a use referred to in Article 27(c) of the Agreement on a Unified Patent Court;

(k) subject to subsection (6H), it consists of an act or use referred to in Article 27(k) of the Agreement on a Unified Patent Court.**]**

(6) For the purposes of subsection (2) above a person who does an act in relation to an invention which is prevented only by virtue of paragraph (a), (b) or (c) of subsection (5) above from constituting an infringement of a patent for the invention shall not be treated as a person entitled to work the invention, but—

(a) the reference in that subsection to a person entitled to work an invention includes a reference to a person so entitled by virtue of section 55 above, and

(b) a person who by virtue of **[**[F160]section 20B(4) or (5) above or**]**[[F161]section 28A(4) or (5)**]** above or section 64 below **[**[F162]or section 117A(4) or (5) below**]** is entitled to do an act in relation to the invention without it constituting such an infringement shall, so far as concerns that act, be treated as a person entitled to work the invention.

[[F163](6A) Schedule A1 contains—

(a) provisions restricting the circumstances in which subsection (5)(g) applies; and

(b) provisions which apply where an act would constitute an infringement of a patent but for subsection (5)(g).

(6B) For the purposes of subsection (5)(h), use for an agricultural purpose—

(a) includes making an animal or animal reproductive material available for the purposes of pursuing the farmer's agricultural activity; but

(b) does not include sale within the framework, or for the purposes, of a commercial reproduction activity.

(6C) In paragraphs (g) and (h) of subsection (5) "sale" includes any other form of commercialisation.**]**

[[F164](6D) For the purposes of subsection (5)(b), anything done in or for the purposes of a medicinal product assessment which would otherwise constitute an infringement of a patent for an invention is to be regarded as done for experimental purposes relating to the subject-matter of the invention.

(6E) In subsection (6D), "medicinal product assessment" means any testing, course of testing or other activity undertaken with a view to providing data for any of the following purposes—

(a) obtaining or varying an authorisation to sell or supply, or offer to sell or supply, a medicinal product (whether in the United Kingdom or elsewhere);

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(b) complying with any regulatory requirement imposed (whether in the United Kingdom or elsewhere) in relation to such an authorisation;

(c) enabling a government or public authority (whether in the United Kingdom or elsewhere), or a person (whether in the United Kingdom or elsewhere) with functions of—

(i) providing health care on behalf of such a government or public authority, or

(ii) providing advice to, or on behalf of, such a government or public authority about the provision of health care,

to carry out an assessment of suitability of a medicinal product for human use for the purpose of determining whether to use it, or recommend its use, in the provision of health care.

(6F) In subsection (6E) and this subsection—

"medicinal product" means a medicinal product for human use or a veterinary medicinal product;

"medicinal product for human use" has the meaning given by article 1 of Directive 2001/83/EC;

"veterinary medicinal product" has the meaning given by article 1 of Directive 2001/82/EC.

(6G) Nothing in subsections (6D) to (6F) is to be read as affecting the application of subsection (5)(b) in relation to any act of a kind not falling within subsection (6D).**]**

[[F165](6H) Subsection 5(k) applies to an act or use in relation to a European patent (UK) or a European patent with unitary effect, but does not apply to an act or use in relation to a patent granted by the comptroller.**]**

(7) In this section—

"relevant ship" and "relevant aircraft, hovercraft or vehicle" mean respectively a ship and an aircraft, hovercraft or vehicle registered in, or belonging to, any country, other than the United Kingdom, which is a party to the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 **[**[F166]or which is a member of the World Trade Organisation**]**; and

"exempted aircraft" means an aircraft to which **[**[F167]section 89 of the Civil Aviation Act 1982**]** section 53 of the [M5]Civil Aviation Act 1949 (aircraft exempted from seizure in respect of patent claims) applies.

[[F168]"Directive 2001/82/EC" means Directive 2001/82/EC of the European Parliament and of the Council on the Community code relating to veterinary medicinal products as amended by **[**[F169] Directive 2004/28/EC**]** of the European Parliament and of the Council;

"Directive 2001/83/EC" means Directive 2001/83/EC of the European Parliament and of the Council on the Community code relating to medicinal products for human use, as amended by Directive 2002/98/EC of the European Parliament and of the Council, by Commission Directive 2003/63/EC and by Directives 2004/24/EC and 2004/27/EC of the European Parliament and of the Council**]**

Textual Amendments

F156 S. 60(4) repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 13, **Sch. 3**; S.I. 2004/3205, art. 2(g)(k) (with art. 9)

F157 S. 60(5)(g)(h) inserted (28.7.2000) by S.I. 2000/2037, **reg. 4(a)**
F158 S. 60(5)(i) inserted (30.10.2005) by Medicines (Marketing Authorisations Etc.) Amendment Regulations 2005 (S.I. 2005/2759), regs. 1(a), **3(a)**
F159 S. 60(5)(j)(k) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(3)** (with art. 3)
F160 Words in s. 60(6)(b) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **11(a)** (with arts. 20-23)
F161 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 8(a)**
F162 Words in s. 60(6)(b) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **11(b)** (with arts. 20-23)
F163 S. 60(6A)(6B)(6C) inserted (28.7.2000) by S.I. 2000/2037, **reg. 4(b)**
F164 S. 60(6D)-(6G) inserted (1.10.2014) by The Legislative Reform (Patents) Order 2014 (S.I. 2014/1997), arts. 1(2), 2
F165 S. 60(6H) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(4)** (with art. 3)
F166 Words in s. 60(7) in the definition of "relevant ship" and "relevant aircraft, hovercraft or vehicle" inserted (29.7.1999) by virtue of S.I. 1999/1899, **reg. 7**
F167 Words substituted by Civil Aviation Act 1982 (c. 16, SIF 9), s. 109, **Sch. 15 para. 19**
F168 Words in s. 60(7) inserted (30.10.2005) by Medicines (Marketing Authorisations Etc.) Amendment Regulations 2005 (S.I. 2005/2759), regs. 1(a), **3(b)**
F169 Words in s. 60(7) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 5**; S.I. 2014/2330, art. 3, Sch.

Marginal Citations
M5 1949 c. 67.

61 Proceedings for infringement of patent.

(1) Subject to the following provisions of this Part of this Act, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made—
  (a) for an injunction or interdict restraining the defendant or defender from any apprehended act of infringement;
  (b) for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
  (c) for damages in respect of the infringement;
  (d) for an account of the profits derived by him from the infringement;
  (e) for a declaration or declarator that the patent is valid and has been infringed by him.

(2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.

(3) The proprietor of a patent and any other person may by agreement with each other refer to the comptroller the question whether that other person has infringed the patent and on the reference the proprietor of the patent may make any claim mentioned in subsection (1)(c) or (e) above.

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(4) Except so far as the context requires, in the following provisions of this Act—

(a) any reference to proceedings for infringement and the bringing of such proceedings includes a reference to a reference under subsection (3) above and the making of such a reference;

(b) any reference to a **[**[F170]claimant**]** or pursuer includes a reference to the proprietor of the patent; and

(c) any reference to a defendant or defender includes a reference to any other party to the reference.

(5) If it appears to the comptroller on a reference under subsection (3) above that the question referred to him would more properly be determined by the court, he may decline to deal with it and the court shall have jurisdiction to determine the question as if the reference were proceedings brought in the court.

(6) Subject to the following provisions of this Part of this Act, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted the court or the comptroller shall apply the principles applied by the court in relation to that kind of relief immediately before the appointed day.

[[F171](7) If the comptroller awards any sum by way of damages on a reference under subsection (3) above, then—

(a) in England and Wales, the sum shall be recoverable, if **[**[F172]the county court**]** so orders, **[**[F173] under section 85 of the County Courts Act 1984**]** or otherwise as if it were payable under an order of that court;

(b) in Scotland, payment of the sum may be enforced in like manner as an extract registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland;

(c) in Northern Ireland, payment of the sum may be enforced as if it were a money judgment.**]**

Textual Amendments

F170 Word in s. 61(4)(b) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 14**; S.I. 2004/3205, art. 2(k) (with art. 9)

F171 S. 61(7) inserted (1.1.2005) by Patents Act 2004 (c. 16), **ss. 11**, 17(1); S.I. 2004/3205, art. 2(d) (with art. 9)

F172 Words in s. 61(7)(a) substituted (E.W.S.) (22.4.2014) by Crime and Courts Act 2013 (c. 22), s. 61(3), **Sch. 9 para. 52**; S.I. 2014/954, art. 2(c) (with art. 3) (with transitional provisions and savings in S.I. 2014/956, arts. 3-11)

F173 Words in s. 61(7)(a) substituted (6.4.2014) by Tribunals, Courts and Enforcement Act 2007 (c. 15), s. 148, **Sch. 13 para. 41** (with s. 89); S.I. 2014/768, art. 2(1)(b)

62 Restrictions on recovery of damages for infringement.

(1) In proceedings for infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant or defender who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed; and a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word "patent" or "patented", or any word or words expressing or implying that a patent has been obtained for the product, unless the

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number of the patent **[**[F174]or a relevant internet link**]** accompanied the word or words in question.

[[F175](1A) The reference in subsection (1) to a relevant internet link is a reference to an address of a posting on the internet—

(a) which is accessible to the public free of charge, and

(b) which clearly associates the product with the number of the patent.**]**

(2) In proceedings for infringement of a patent the court or the comptroller may, if it or he thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during **[**[F176]the further period specified in**]** section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.

(3) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, **[**[F177]the court or the comptroller shall, when awarding damages or making an order for an account of profits in proceedings for an infringement of the patent committed before the decision to allow the amendment, take into account the following—

(a) whether at the date of infringement the defendant or defender knew, or had reasonable grounds to know, that he was infringing the patent;

(b) whether the specification of the patent as published was framed in good faith and with reasonable skill and knowledge;

(c) whether the proceedings are brought in good faith.**]**

Textual Amendments

F174 Words in s. 62(1) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 15(1)**, 24(1); S.I. 2014/2330, art. 3, Sch. (with art. 5)

F175 S. 62(1A) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 15(2)**, 24(1); S.I. 2014/2330, art. 3, Sch.

F176 Words in s. 62(2) substituted (1.10.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 15**; S.I. 2005/2471, art. 2(g)

F177 Words in s. 62(3) substituted (29.4.2006) by Intellectual Property (Enforcement, etc) Regulations 2006 (S.I. 2006/1028), art. 1, **Sch. 2 para. 2**

63 Relief for infringement of partially valid patent.

(1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the comptroller may, subject to subsection (2) below, grant relief in respect of that part of the patent which is found to be valid and infringed.

(2) Where in any such proceedings it is found that a patent is only partially valid, the court or the comptroller shall **[**[F178], when awarding damages, costs or expenses or making an order for an account of profits, take into account the following—

(a) whether at the date of the infringement the defendant or defender knew, or had reasonable grounds to know, that he was infringing the patent;

(b) whether the specification of the patent was framed in good faith and with reasonable skill and knowledge;

(c) whether the proceedings are brought in good faith;

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and any relief granted shall be subject to the discretion of the court or the comptroller as to costs or expenses and as to the date from which damages or an account should be reckoned.**]**

(3) As a condition of relief under this section the court or the comptroller may direct that the specification of the patent shall be amended to its or his satisfaction upon an application made for that purpose under section 75 below, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

[[F179](4) The court or the comptroller may also grant relief under this section in the case of a European patent (UK) on condition that the claims of the patent are limited to its or his satisfaction by the European Patent Office at the request of the proprietor.**]**

Textual Amendments

F178 Words in s. 63(2) substituted (29.4.2006) by Intellectual Property (Enforcement, etc) Regulations 2006 (S.I. 2006/1028), art. 1, **Sch. 2 para. 3**

F179 S. 63(4) inserted (13.12.2007) by Patents Act 2004 (c. 16), **ss. 3(1)**, 17(1); S.I. 2007/3396, art. 2(e)

[[F180]**64 Right to continue use begun before priority date.**

(1) Where a patent is granted for an invention, a person who in the United Kingdom before the priority date of the invention—

(a) does in good faith an act which would constitute an infringement of the patent if it were in force, or

(b) makes in good faith effective and serious preparations to do such an act,

has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent; but this right does not extend to granting a licence to another person to do the act.

(2) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (1) may—

(a) authorise the doing of that act by any partners of his for the time being in that business, and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(3) Where a product is disposed of to another in exercise of the rights conferred by subsection (1) or (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.**]**

Textual Amendments

F180 S. 64 substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 17**

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65 Certificate of contested validity of patent.

(1) If in any proceedings before the court or the comptroller the validity of a patent to any extent is contested and that patent is found by the court or the comptroller to be wholly or partially valid, the court or the comptroller may certify the finding and the fact that the validity of the patent was so contested.

(2) Where a certificate is granted under this section, then, if in any subsequent proceedings before the court or the comptroller for infringement of the patent concerned or for revocation of the patent a final order or judgment or interlocutor is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the court or the comptroller otherwise directs, be entitled to his costs or expenses as between solicitor and own client (other than the costs or expenses of any appeal in the subsequent proceedings).

66 Proceedings for infringement by a co-owner.

(1) In the application of section 60 above to a patent of which there are two or more joint proprietors the reference to the proprietor shall be construed—
  (a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 36 above or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and
  (b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 36 above or any such agreement, is or are the proper person or persons to give the requisite consent.

(2) One of two or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

67 Proceedings for infringement by exclusive licensee.

(1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the proprietor of the patent in the provisions of this Act relating to infringement shall be construed accordingly.

(2) In awarding damages or granting any other relief in any such proceedings the court or the comptroller shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(3) In any proceedings taken by an exclusive licensee by virtue of this section the proprietor of the patent shall be made a party to the proceedings, but if made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

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68 Effect of non-registration on infringement proceedings.

Where by virtue of a transaction, instrument or event to which section 33 above applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent and the patent is subsequently infringed[F181]... before the transaction, instrument or event is registered **[**[F182], in proceedings for such an infringement, the court or comptroller shall not award him costs or expenses**]** unless—

(a) the transaction, instrument or event is registered within the period of six months beginning with its date; or

(b) the court or the comptroller is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.

Textual Amendments

F181 Words in s. 68 repealed (29.4.2006) by virtue of Intellectual Property (Enforcement, etc) Regulations 2006 (S.I. 2006/1028), art. 1, **Sch. 2 para. 4(a)**, Sch. 4

F182 Words in s. 68 inserted (29.4.2006) by Intellectual Property (Enforcement, etc) Regulations 2006 (S.I. 2006/1028), art. 1, **Sch. 2 para. 4(b)**

69 Infringement of rights conferred by publication of application.

(1) Where an application for a patent for an invention is published, then, subject to subsections (2) and (3) below, the applicant shall have, as from the publication and until the grant of the patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court or before the comptroller for damages in respect of any act which would have infringed the patent; and (subject to subsections (2) and (3) below) references in sections 60 to 62 and 66 to 68 above to a patent and the proprietor of a patent shall be respectively construed as including references to any such application and the applicant, and references to a patent being in force, being granted, being valid or existing shall be construed accordingly.

(2) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only—

(a) after the patent has been granted; and

(b) if the act would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Patent Office.

(3) Section 62(2) and (3) above shall not apply to an infringement of the rights conferred by this section, but in considering the amount of any damages for such an infringement, the court or the comptroller shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 16 above, that a patent would be granted conferring on the proprietor of the patent protection from an act of the same description as that found to infringe those rights, and if the court or the comptroller finds that it would not have been reasonable, it or he shall reduce the damages to such an amount as it or he thinks just.

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[F183 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.

Textual Amendments

F183 Ss. 70-70F substituted for s. 70 (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

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.

Textual Amendments

F183 Ss. 70-70F substituted for s. 70 (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

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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.

Textual Amendments

F183 Ss. 70-70F substituted for s. 70 (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

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;

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(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.

Textual Amendments

F183 Ss. 70-70F substituted for s. 70 (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

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.

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Textual Amendments

F183 Ss. 70-70F substituted for s. 70 (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

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.

Textual Amendments

F183 Ss. 70-70F substituted for s. 70 (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

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.) **[**[F184]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.**]]**

Textual Amendments

F183 Ss. 70-70F substituted for s. 70 (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

F184 Words in s. 70F inserted (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(3)**, 8; S.I. 2017/771, reg. 2(2) (with reg. 3)

[[F185]*Declaration or declarator as to non-infringement]*

Textual Amendments

F185 S. 71 crossheading inserted (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(4)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

71 Declaration or declarator as to non-infringement

(1) Without prejudice to the court's jurisdiction to make a declaration or declarator apart from this section, a declaration or declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the comptroller in proceedings between the person doing or proposing to do the act and

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the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown—

(a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and

(b) that the proprietor has refused or failed to give any such acknowledgment.

(2) Subject to section 72(5) below, a declaration made by the comptroller under this section shall have the same effect as a declaration or declarator by the court.

Revocation of patents

72 Power to revoke patents on application.

(1) Subject to the following provisions of this Act, the court or the comptroller may [F186]... by order revoke a patent for an invention **[**[F187]on the application of any person (including the proprietor of the patent)**]** on (but only on) any of the following grounds, that is to say—

(a) the invention is not a patentable invention;

[[F188](b) that the patent was granted to a person who was not entitled to be granted that patent;**]**

(c) the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art;

(d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed, or, if the patent was granted on a new application filed under section 8(3), 12 or 37(4) above or as mentioned in **[**[F189]section 15(9)**]** above, in the earlier application, as filed;

(e) the protection conferred by the patent has been extended by an amendment which should not have been allowed.

(2) An application for the revocation of a patent on the ground mentioned in subsection (1)(b) above—

(a) may only be made by a person found by the court in an action for a declaration or declarator, or found by the court or the comptroller on a reference under section 37 above, to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked; and

(b) may not be made if that action was commenced or that reference was made after **[**[F190]the second anniversary of**]** the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(3) . . . . . [F191]

(4) An order under this section may be an order for the unconditional revocation of the patent or, where the court or the comptroller determines that one of the grounds mentioned in subsection (1) above has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended [F192]... to the satisfaction of the court or the comptroller, as the case may be.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

[[F193](4A) The reference in subsection (4) above to the specification being amended is to its being amended under section 75 below and also, in the case of a European patent (UK), to its being amended under any provision of the European Patent Convention under which the claims of the patent may be limited by amendment at the request of the proprietor.**]**

(5) A decision of the comptroller or on appeal from the comptroller shall not estop any party to civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds referred to in subsection (1) above, whether or not any of the issues involved were decided in the said decision.

(6) Where the comptroller refuses to grant an application made to him by any person under this section, no application (otherwise than by way of appeal or by way of putting validity in issue in proceedings for infringement) may be made to the court by that person under this section in relation to the patent concerned, without the leave of the court.

(7) Where the comptroller has not disposed of an application made to him under this section, the applicant may not apply to the court under this section in respect of the patent concerned unless either—

(a) the proprietor of the patent agrees that the applicant may so apply, or

(b) the comptroller certifies in writing that it appears to him that the question whether the patent should be revoked is one which would more properly be determined by the court.

Textual Amendments

F186 Words in s. 72(1) repealed (1.10.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 18, **Sch. 3**; S.I. 2005/2471, art. 2(f)(g)

F187 Words in s. 72(1) inserted (1.10.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 18**; S.I. 2005/2471, art. 2(g)

F188 S. 72(1)(*b*) substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 18**

F189 Words in s. 72(1)(d) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **12** (with arts. 20-23)

F190 Words in s. 72(2)(b) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 3(1)(b)**; S.I. 2014/2330, art. 3, Sch.

F191 S. 72(3) repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

F192 Words in s. 72(4) repealed (13.12.2007) by Patents Act 2004 (c. 16), ss. 4, 17(1), **Sch. 3**; S.I. 2007/3396, art. 2(f)(i)

F193 S. 72(4A) inserted (13.12.2007) by Patents Act 2004 (c. 16), **ss. 4**, 17(1); S.I. 2007/3396, art. 2(f)

73 Comptroller's power to revoke patents on his own initiative.

(1) If it appears to the comptroller that an invention for which a patent has been granted formed part of the state of the art by virtue only of section 2(3) above, he may on his own initiative by order revoke the patent, but shall not do so without giving the proprietor of the patent an opportunity of making any observations and of amending the specification of the patent so as to exclude any matter which formed part of the state of the art as aforesaid without contravening section 76 below.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

[[F194](1A) Where the comptroller issues an opinion under section 74A that section 1(1)(a) or (b) is not satisfied in relation to an invention for which there is a patent, the comptroller may revoke the patent.

(1B) The power under subsection (1A) may not be exercised before—

(a) the end of the period in which the proprietor of the patent may apply under the rules (by virtue of section 74B) for a review of the opinion, or

(b) if the proprietor applies for a review, the decision on the review is made (or, if there is an appeal against that decision, the appeal is determined).

(1C) The comptroller shall not exercise the power under subsection (1A) without giving the proprietor of the patent an opportunity to make any observations and to amend the specification of the patent without contravening section 76.**]**

[[F195](2) If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent.

(3) The comptroller shall not take action under subsection (2) above before—

(a) the end of the period for filing an opposition to the European patent (UK) under the European Patent Convention, or

(b) if later, the date on which opposition proceedings are finally disposed of;

and he shall not then take any action if the decision is not to maintain the European patent or if it is amended so that there are not two patents in respect of the same invention.

(4) The comptroller shall not take action under subsection (2) above if the European patent (UK) has been surrendered under section 29(1) above before the date on which by virtue of section 25(1) above the patent under this Act is to be treated as having been granted or, if proceedings for the surrender of the European patent (UK) have been begun before that date, until those proceedings are finally disposed of; and he shall not then take any action if the decision is to accept the surrender of the European patent.**]**

Textual Amendments

F194 S. 73(1A)-(1C) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 16(4)**, 24(1); S.I. 2014/2330, art. 3, Sch. (with art. 6)

F195 S. 73(2)(3)(4) substituted for subsections (2) and (3) by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 19**

Putting validity in issue

74 Proceedings in which validity of patent may be put in issue.

(1) Subject to the following provisions of this section, the validity of a patent may be put in issue—

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(a) by way of defence, in proceedings for infringement of the patent under section 61 above or proceedings under section 69 above for infringement of rights conferred by the publication of an application;

(b) in proceedings **[**[F196]in respect of an actionable threat under section 70A**]** above;

(c) in proceedings in which a declaration in relation to the patent is sought under section 71 above;

(d) in proceedings before the court or the comptroller under section 72 above for the revocation of the patent;

(e) in proceedings under section 58 above.

(2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent.

(3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 72 above or otherwise) are the grounds on which the patent may be revoked under that section.

(4) No determination shall be made in any proceedings mentioned in subsection (1) above on the validity of a patent which any person puts in issue on the ground mentioned in section 72(1)(b) above unless—

(a) it has been determined in entitlement proceedings commenced by that person or in the proceedings in which the validity of the patent is in issue that the patent should have been granted to him and not some other person; and

(b) except where it has been so determined in entitlement proceedings, the proceedings in which the validity of the patent is in issue are commenced **[**[F197]on or before the second anniversary of**]** the date of the grant of the patent or it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(5) Where the validity of a patent is put in issue by way of defence or counterclaim the court or the comptroller shall, if it or he thinks it just to do so, give the defendant an opportunity to comply with the condition in subsection (4)(a) above.

(6) In subsection (4) above "entitlement proceedings", in relation to a patent, means a reference under **[**[F198]section 37(1) above**]** on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration or declarator that it was so granted.

(7) Where proceedings with respect to a patent are pending in the court under any provision of this Act mentioned in subsection (1) above, no proceedings may be instituted without the leave of the court before the comptroller with respect to that patent under section 61(3), 69, 71 or 72 above.

(8) It is hereby declared that for the purposes of this Act the validity of a patent is not put in issue merely because

[[F199](a)**]** the comptroller is considering its validity in order to decide whether to revoke it under section 73 above, **[**[F200]or

(b) its validity is being considered in connection with an opinion under section 74A below or a review of such an opinion.**]**

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Textual Amendments

F196 Words in s. 74(1)(b) substituted (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(5)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

F197 Words in s. 74(4)(b) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 3(2)**; S.I. 2014/2330, art. 3, Sch.

F198 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 10**

F199 Words in s. 74(8) renumbered (1.10.2005) as s. 74(8)(a) by Patents Act 2004 (c. 16), **ss. 13(2)**, 17(1); S.I. 2005/2471, art. 2(c)

F200 S. 74(8)(b) and preceding word inserted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 13(2)**, 17(1); S.I. 2005/2471, art. 2(c)

[[F201]*Opinions by Patent Office*

Textual Amendments

F201 Ss. 74A, 74B and cross-heading inserted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 13(1)**, 17(1); S.I. 2005/2471, art. 2(c)

74A [[F202]Opinions on matters prescribed in the rules]

(1) The proprietor of a patent or any other person may request the comptroller to issue [[F203]an opinion on a prescribed matter in relation to the patent].

(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—

(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.

Textual Amendments

F202 S. 74A title substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 16(1)**, 24(1); S.I. 2014/2330, art. 3, Sch.

F203 Words in s. 74A(1) substituted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 16(1)**, 24(1); S.I. 2014/2330, art. 3, Sch.

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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;

[F204](c) . . . . . .

(d) provide for there to be a right of appeal against a decision made on a review only in prescribed cases.**]**

Textual Amendments

F204 S. 74B(2)(c) omitted (1.10.2014) by virtue of Intellectual Property Act 2014 (c. 18), **ss. 16(2)**, 24(1); S.I. 2014/2330, art. 3, Sch.

General provisions as to amendment of patents and applications

75 Amendment of patent in infringement or revocation proceedings.

(1) In any proceedings before the court or the comptroller in which the validity of a patent **[**[F205]may be **]** put in issue the court or, as the case may be, the comptroller may, subject to section 76 below, allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the court or comptroller thinks fit.

(2) A person may give notice to the court or the comptroller of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the court or the comptroller shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) Where an application for an order under this section is made to the court, the applicant shall notify the comptroller, who shall be entitled to appear and be heard and shall appear if so directed by the court.

[[F206](5) In considering whether or not to allow an amendment proposed under this section, the court or the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.**]**

Textual Amendments

F205 Words in s. 75(1) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 19**; S.I. 2004/3205, art. 2(k) (with art. 9)

F206 S. 75(5) inserted (13.12.2007) by Patents Act 2004 (c. 16), **ss. 2(5)**, 17(1); S.I. 2007/3396, art. 2(d)

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

[F207 76 Amendments of applications and patents not to include added matter.

(1) An application for a patent which—

(a) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted, and

(b) discloses additional matter, that is, matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed,

may be filed under section 8(3), 12 or 37(4) above, or as mentioned in **[**F208 section 15(9)**]** above, but shall not be allowed to proceed unless it is amended so as to exclude the additional matter.

F209 (1A) **[** Where, in relation to an application for a patent—

(a) a reference to an earlier relevant application has been filed as mentioned in section 15(1)(c)(ii) above; and

(b) the description filed under section 15(10)(b)(i) above discloses additional matter, that is, matter extending beyond that disclosed in the earlier relevant application,

the application shall not be allowed to proceed unless it is amended so as to exclude the additional matter.**]**

(2) No amendment of an application for a patent shall be allowed under **[**F210 section 15A(6)**]** , 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

(3) No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it—

(a) results in the specification disclosing additional matter, or

(b) extends the protection conferred by the patent.**]**

[F211 (4) In subsection (1A) above "relevant application" has the meaning given by section 5(5) above.**]**

Textual Amendments

F207 S. 76 substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 20**

F208 Words in s. 76(1) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **13(2)** (with arts. 20-23)

F209 S. 76(1A) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **13(3)** (with arts. 20-23)

F210 Words in s. 76(2) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **13(4)** (with arts. 20-23)

F211 S. 76(4) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **13(5)** (with arts. 20-23)

[F212 76A *Biotechnological inventions*

(1) Any provision of, or made under, this Act is to have effect in relation to a patent or an application for a patent which concerns a biotechnological invention, subject to the provisions of Schedule A2.

(2) Nothing in this section or Schedule A2 is to be read as affecting the application of any provision in relation to any other kind of patent or application for a patent.**]**

Status: *This version of this Act contains provisions that are prospective.*
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Textual Amendments

F212 S. 76A inserted (28.7.2000) by S.I. 2000/2037, **reg. 5**

PART II

PROVISIONS ABOUT INTERNATIONAL CONVENTIONS

European patents and patent applications

77 Effect of European patent (UK).

(1) Subject to the provisions of this Act, a European patent (UK) shall, as from the publication of the mention of its grant in the European Patent Bulletin, be treated for the purposes of Parts I and III of this Act as if it were a patent under this Act granted in pursuance of an application made under this Act and as if notice of the grant of the patent had, on the date of that publication, been published under section 24 above in the journal; and—

(a) the proprietor of a European patent (UK) shall accordingly as respects the United Kingdom have the same rights and remedies, subject to the same conditions, as the proprietor of a patent under this Act;

(b) references in Parts I and III of this Act to a patent shall be construed accordingly; and

(c) any statement made and any certificate filed for the purposes of the provision of the convention corresponding to section 2(4)(c) above shall be respectively treated as a statement made and written evidence filed for the purposes of the said paragraph (c).

(2) Subsection (1) above shall not affect the operation in relation to a European patent (UK) of any provisions of the European Patent Convention relating to the amendment or revocation of such a patent in proceedings before the European Patent Office.

[[F213](3) Where in the case of a European patent (UK)—

(a) proceedings for infringement, or proceedings under section 58 above, have been commenced before the court or the comptroller and have not been finally disposed of, and

(b) it is established in proceedings before the European Patent Office that the patent is only partially valid,

the provisions of section 63 or, as the case may be, of subsections (7) to (9) of section 58 apply as they apply to proceedings in which the validity of a patent is put in issue and in which it is found that the patent is only partially valid.**]**

[[F214](4) Where a European patent (UK) is amended in accordance with the European Patent Convention **[**[F215]or the Agreement on a Unified Patent Court**]**, the amendment shall have effect for the purposes of Parts I and III of this Act as if the specification of the patent had been amended under this Act; but subject to subsection (6)(b) below.

(4A) Where a European patent (UK) is revoked in accordance with the European Patent Convention **[**[F216]or the Agreement on a Unified Patent Court**]**, the patent shall be

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treated for the purposes of Parts I and III of this Act.**]**

(5) Where—

(a) under the European Patent Convention **[**[F217]or the Agreement on a Unified Patent Court**]** a European patent (UK) is revoked for failure to observe a time limit and is subsequently restored **[**[F218] or is revoked by the Board of Appeal and is subsequently restored by the Enlarged Board of Appeal**][**[F219]or is revoked and subsequently restored by the Unified Patent Court**]**; and

(b) between the revocation and publication of the fact that it has been restored a person begins in good faith to do an act which would, apart from section 55 above, constitute an infringement of the patent or makes in good faith effective and serious preparations to do such an act;

he shall have the rights conferred by **[**[F220]section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly.**]**

[[F221](5A) Where, under the European Patent Convention **[**[F222]or the Agreement on a Unified Patent Court**]**, a European patent (UK) is revoked and subsequently restored (including where it is revoked by the Board of Appeal and subsequently restored by the Enlarged Board of Appeal), any fee that would have been imposed in relation to the patent after the revocation but before the restoration is payable within the prescribed period following the restoration.**]**

(6) **[**[F223]While this subsection is in force—

(a) subsection (1) above shall not apply to a European patent (UK) the specification of which was published in French or German, unless a translation of the specification into English is filed at the Patent Office and the prescribed fee is paid before the end of the prescribed period;

(b) subsection (4) above shall not apply to an amendment made in French or German unless **[**[F224]a translation into English of the specification as amended**]** is filed at the Patent Office and the prescribed fee is paid before the end of the prescribed period.**]**

(7) Where **[**[F225]such a translation is not filed**]**, the patent shall be treated as always having been void.

(8) The comptroller shall publish any translation filed at the Patent Office under subsection (6) above.

(9) Subsection (6) above shall come into force on a day appointed for the purpose by rules and shall cease to have effect on a day so appointed, without prejudice, however, to the power to bring it into force again.

[[F226](10) Subsection (1) does not apply and is to be treated as never having applied in respect of a European patent (UK) whose unitary effect is registered by the European Patent Office in the Register for unitary patent protection (see, in particular, the Unitary Patent Regulation).**]**

Textual Amendments

F213 S. 77(3) substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 21(2)**

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

F214 S. 77(4)(4A) substituted for subsection (4) by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 21(3)**

F215 Words in s. 77(4) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(5)(a)** (with art. 3)

F216 Words in s. 77(4A) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(5)(a)** (with art. 3)

F217 Words in s. 77(5)(a) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(5)(b)(i)** (with art. 3)

F218 Words in s. 77(5)(a) inserted (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 2**; S.I. 2007/3396, art. 2(j)

F219 Words in s. 77(5)(a) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(5)(b)(ii)** (with art. 3)

F220 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 8(b)**

F221 S. 77(5A) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), s. 24(1), **Sch. para. 6**; S.I. 2014/2330, art. 3, Sch. (with art. 8)

F222 Words in s. 77(5A) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(5)(a)** (with art. 3)

F223 S. 77(6) ceased to have effect (6.4.2005) by virtue of The Patents (Translations) Rules 2005 (S.I. 2005/687), art. 1**rule 2**3

F224 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 21(4)**

F225 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 21(5)**

F226 S. 77(10) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(5)(c)** (with art. 3)

Modifications etc. (not altering text)

C15 S. 77(9): 1.9.1987 appointed by S.I. 1987/288, **rule 4(1)** (subject to a saving in rule 4(2))

78 Effect of filing an application for a European patent (UK).

(1) Subject to the provisions of this Act, an application for a European patent (UK) having a date of filing under the European Patent Convention shall be treated for the purposes of the provisions of this Act to which this section applies as an application for a patent under this Act having that date as its date of filing and having the other incidents listed in subsection (3) below, but subject to the modifications mentioned in the following provisions of this section.

(2) This section applies to the following provisions of this Act:—

section 2(3) and so much of section 14(7) as relates to section 2(3);

section 5;

section 6;

so much of section 13(3) as relates to an application for and issue of a certificate under that subsection;

sections 30 to 33;

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section 36;
sections 55 to 69;
[[F227]sections 70 to 70F **]**
section 74, so far as relevant to any of the provisions mentioned above;
section 111; and
section 125.

(3) The incidents referred to in subsection (1) above in relation to an application for a European patent (UK) are as follows:—

(a) any declaration of priority made in connection with the application under the European Patent Convention shall be treated for the purposes of this Act as a declaration made under section 5(2) above;

(b) where a period of time relevant to priority is extended under that convention, the period of twelve months **[**[F228]allowed under section 5(2A)(a)**]** above shall be so treated as altered correspondingly;

(c) where the date of filing an application is re-dated under that convention to a later date, that date shall be so treated as the date of filing the application;

(d) the application, if published in accordance with that convention, shall, subject to subsection (7) and section 79 below, be so treated as published under section 16 above;

(e) any designation of the inventor under that convention or any statement under it indicating the origin of the right to a European patent shall be treated for the purposes of section 13(3) above as a statement filed under section 13(2) above;

(f) registration of the application in the register of European patents shall be treated as registration under this Act.

(4) Rules under section 32 above may not impose any requirements as to the registration of applications for European patents (UK) but may provide for the registration of copies of entries relating to such applications in the European register of patents.

[[F229](5) Subsections (1) to (3) above shall cease to apply to an application for a European patent (UK), except as mentioned in subsection (5A) below, if—

(a) the application is refused or withdrawn or deemed to be withdrawn, or

(b) the designation of the United Kingdom in the application is withdrawn or deemed to be withdrawn,

but shall apply again if the rights of the applicant are re-established under the European Patent Convention, as from their re-establishment.

(5A) The occurrence of any of the events mentioned in subsection (5)(a) or (b) shall not affect the continued operation of section 2(3) above in relation to matter contained in an application for a European patent (UK) which by virtue of that provision has become part of the state of the art as regards other inventions.**][**[F230]; and the occurrence of any event mentioned in subsection (5)(b) shall not prevent matter contained in an application for a European patent (UK) becoming part of the state of the art by virtue of section 2(3) above as regards other inventions where the event occurs before the publication of that application.**]**

[[F231](6) Where, between subsections (1) to (3) above ceasing to apply to an application for a European patent (UK) and the re-establishment of the rights of the applicant, a person—

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(a) begins in good faith to do an act which would constitute an infringement of the rights conferred by publication of the application if those subsections then applied, or

(b) makes in good faith effective and serious preparations to do such an act,

he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding subsections (1) to (3) applying again and notwithstanding the grant of the patent.

(6A) Subsections (5) and (6) of section 20B above have effect for the purposes of subsection (6) above as they have effect for the purposes of that section and as if the references to subsection (4) of that section were references to subsection (6) above.

(6B) Subject to subsection (6A) above, the right conferred by subsection (6) above does not extend to granting a licence to another person to do the act in question.

(6C) Subsections (6) to (6B) above apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to an infringement of the rights conferred by publication of the application (or, as the case may be, infringement of the patent).

"Patented invention" has the same meaning as in section 55 above.**]**

(7) While this subsection is in force, an application for a European patent (UK) published by the European Patent Office under the European Patent Convention in French or German shall be treated for the purposes of sections 55 and 69 above as published under section 16 above when a translation into English of the claims of the specification of the application has been filed at and published by the Patent Office and the prescribed fee has been paid, but an applicant—

(a) may recover a payment by virtue of section 55(5) above in respect of the use of the invention in question before publication of that translation; or

(b) may bring proceedings by virtue of section 69 above in respect of an act mentioned in that section which is done before publication of that translation;

if before that use or the doing of that act he has sent by post or delivered to the government department who made use or authorised the use of the invention, or, as the case may be, to the person alleged to have done the act, a translation into English of those claims.

(8) Subsection (7) above shall come into force on a day appointed for the purpose by rules and shall cease to have effect on a day so appointed, without prejudice, however, to the power to bring it into force again.

Textual Amendments

F227 Words in s. 78(2) inserted (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(6)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

F228 Words in s. 78(3)(b) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **14** (with arts. 20-23)

F229 S. 78(5)(5A) substituted for subsection (5) by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 22**

F230 Words in s. 78(5A) inserted (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 3(2)**; S.I. 2007/3396, art. 2(j) (with art. 3)

F231 S. 78(6)-(6C) substituted for s. 78(6) (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 3(3)**; S.I. 2007/3396, art. 2(j)

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

Modifications etc. (not altering text)

C16 S. 78(8): 1.9.1986 appointed by S.I. 1987/288, **rule 4(1)** (subject to saving in rule 4(2))

79 Operation of s. 78 in relation to certain European patent applications.

(1) Subject to the following provisions of this section, section 78 above, in its operation in relation to an international application for a patent (UK) which is treated by virtue of the European Patent Convention as an application for a European patent (UK), shall have effect as if any reference in that section to anything done in relation to the application under the European Patent Convention included a reference to the corresponding thing done under the Patent Co-operation Treaty.

(2) Any such international application which is published under that treaty shall be treated for the purposes of section 2(3) above as published only when a copy of the application has been supplied to the European Patent Office in English, French or German and the relevant fee has been paid under that convention.

(3) Any such international application which is published under that treaty in a language other than English, French or German shall, subject to section 78(7) above, be treated for the purposes of sections 55 and 69 above as published only when it is re-published in English, French or German by the European Patent Office under that convention.

80 Authentic text of European patents and patent applications.

(1) Subject to subsection (2) below, the text of a European patent or application for such a patent in the language of the proceedings, that is to say, the language in which proceedings relating to the patent or the application are to be conducted before the European Patent Office, shall be the authentic text for the purposes of any domestic proceedings, that is to say, any proceedings relating to the patent or application before the comptroller or the court.

(2) Where the language of the proceedings is French or German, a translation into English of the specification of the patent under section 77 above or of the claims of the application under section 78 above shall be treated as the authentic text for the purpose of any domestic proceedings, other than proceedings for the revocation of the patent, if the patent or application as translated into English confers protection which is narrower than that conferred by it in French or German.

(3) If any such translation results in a European patent or application conferring the narrower protection, the proprietor of or applicant for the patent may file a corrected translation with the Patent Office and, if he pays the prescribed fee within the prescribed period, the Patent Office shall publish it, but—

(a) any payment for any use of the invention which (apart from section 55 above) would have infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted, shall not be recoverable under that section,

(b) the proprietor or applicant shall not be entitled to bring proceedings in respect of an act which infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted,

unless before that use or the doing of the act the corrected translation has been published by the Patent Office or the proprietor or applicant has sent the corrected

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translation by post or delivered it to the government department who made use or authorised the use of the invention or, as the case may be, to the person alleged to have done that act.

[[F232](4) Where a correction of a translation is published under subsection (3) above and before it is so published a person—

(a) begins in good faith to do an act which would not constitute an infringement of the patent as originally translated, or of the rights conferred by publication of the application as originally translated, but would do so under the amended translation, or

(b) makes in good faith effective and serious preparations to do such an act,

he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding the publication of the corrected translation and notwithstanding the grant of the patent.

(5) Subsections (5) and (6) of section 28A above have effect for the purposes of subsection (4) above as they have effect for the purposes of that section and as if—

(a) the references to subsection (4) of that section were references to subsection (4) above;

(b) the reference to the registered proprietor of the patent included a reference to the applicant.

(6) Subject to subsection (5) above, the right conferred by subsection (4) above does not extend to granting a licence to another person to do the act in question.

(7) Subsections (4) to (6) above apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to an infringement of the patent or of the rights conferred by the publication of the application.

"Patented invention" has the same meaning as in section 55 above.**]**

Textual Amendments

F232 S. 80(4)-(7) substituted for s. 80(4) (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 4**; S.I. 2007/3396, art. 2(j)

81 Conversion of European patent applications.

(1) The comptroller may direct that on compliance with the relevant conditions mentioned in subsection (2) below an application for a European patent (UK) shall be treated as an application for a patent under this Act **[**[F233]where the application is deemed to be withdrawn under the provisions of the European Patent Convention relating to the time for forwarding applications to the European Patent Office**]**

(2) The relevant conditions referred to above are [F234]...—

(a) [F234]. . . . . .

(b) **[**[F235]that**]** ,—

(i) the applicant requests the comptroller within the relevant prescribed period (where the application was filed with the Patent Office) to give a direction under this section, or

(ii) the central industrial property office of a country which is party to the convention, other than the United Kingdom, with which the

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application was filed transmits within the relevant prescribed period a request that the application should be converted into an application under this Act, together with a copy of the application; and

(c) **[**[F236]that**]** the applicant within the relevant prescribed period pays the **[**[F237]application fee**]** and if the application is in a language other than English, files a translation into English of the application and of any amendments previously made in accordance with the convention.

(3) Where an application for a European patent falls to be treated as an application for a patent under this Act by virtue of a direction under this section—

(a) the date which is the date of filing the application under the European Patent Convention shall be treated as its date of filing for the purposes of this Act, but if that date is re-dated under the convention to a later date, that later date shall be treated for those purposes as the date of filing the application;

(b) if the application satisfies a requirement of the convention corresponding to any of the requirements of this Act or rules designated as formal requirements, it shall be treated as satisfying that formal requirement;

(c) any document filed with the European Patent Office under any provision of the convention corresponding to any of the following provisions of this Act, that is to say, sections 2(4)(c), 5, 13(2) and 14, or any rule made for the purposes of any of those provisions, shall be treated as filed with the Patent Office under that provision or rule; and

(d) the comptroller shall refer the application for only so much of the examination and search required by sections **[**[F238]15A,**]** 17 and 18 above as he considers appropriate in view of any examination and search carried out under the convention, and those sections shall apply with any necessary modifications accordingly.

Textual Amendments

F233 Words in s. 81(1) substituted (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 5(2)**; S.I. 2007/3396, art. 2(j)

F234 S. 81(2)(a) and word repealed (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), Sch. 1 para. 5(3)(a), **Sch. 3**; S.I. 2007/3396, art. 2(i)(j)

F235 Word in s. 81(2)(b) substituted (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 5(3)(b)**; S.I. 2007/3396, art. 2(j)

F236 Word in s. 81(2)(c) substituted (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 5(3)(c)**; S.I. 2007/3396, art. 2(j)

F237 Words in s. 81(2)(c) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **15(2)** (with arts. 20-23)

F238 Word in s. 81(3)(d) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **15(3)** (with arts. 20-23)

82 Jurisdiction to determine questions as to right to a patent.

(1) The court shall not have jurisdiction to determine a question to which this section applies except in accordance with the following provisions of this section.

(2) Section 12 above shall not confer jurisdiction on the comptroller to determine a question to which this section applies except in accordance with the following provisions of this section.

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(3) This section applies to a question arising before the grant of a European patent whether a person has a right to be granted a European patent, or a share in any such patent, and in this section "employer-employee question" means any such question between an employer and an employee, or their successors in title, arising out of an application for a European patent for an invention made by the employee.

(4) The court and the comptroller shall have jurisdiction to determine any question to which this section applies, other than an employer-employee question, if either of the following conditions is satisfied, that is to say—

(a) the applicant has his residence or principal place of business in the United Kingdom; or

(b) the other party claims that the patent should be granted to him and he has his residence or principal place of business in the United Kingdom and the applicant does not have his residence or principal place of business in any of the relevant contracting states;

and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom.

(5) The court and the comptroller shall have jurisdiction to determine an employer-employee question if either of the following conditions is satisfied, that is to say—

(a) the employee is mainly employed in the United Kingdom; or

(b) the employee is not mainly employed anywhere or his place of main employment cannot be determined, but the employer has a place of business in the United Kingdom to which the employee is attached (whether or not he is also attached elsewhere);

and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom or, where there is such evidence of such an agreement, if the **[**[F239]law applicable to**]** the contract of employment does not recognise the validity of the agreement.

(6) Without prejudice to subsections (2) to (5) above, the court and the comptroller shall have jurisdiction to determine any question to which this section applies if there is written evidence that the parties have agreed to submit to the jurisdiction of the court or the comptroller, as the case may be, and, in the case of an employer-employee question, the **[**[F239]law applicable to**]** the contract of employment recognises the validity of the agreement.

(7) If, after proceedings to determine a question to which this section applies have been brought before the competent authority of a relevant contracting state other than the United Kingdom, proceedings are begun before the court or a reference is made to the comptroller under section 12 above to determine that question, the court or the comptroller, as the case may be, shall stay or sist the proceedings before the court or the comptroller unless or until the competent authority of that other state either—

(a) determines to decline jurisdiction and no appeal lies from the determination or the time for appealing expires, or

(b) makes a determination which the court or the comptroller refuses to recognise under section 83 below.

(8) References in this section to the determination of a question include respectively references to—

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(a) the making of a declaration or the grant of a declarator with respect to that question (in the case of the court); and

(b) the making of an order under section 12 above in relation to that question (in the case of the court or the comptroller).

(9) In this section and section 83 below "relevant contracting state" means a country which is a party to the European Patent Convention and has not exercised its right under the convention to exclude the application of the protocol to the convention known as the Protocol on Recognition.

Textual Amendments

F239 Words in s. 82(5)(6) substituted (1.4.1991) by Contracts (Applicable Law) Act 1990 (c. 36, SIF 30), s. 5, **Sch. 4 para. 3**; S.I. 1991/707, **art. 2**

83 Effect of patent decisions of competent authorities of other states.

(1) A determination of a question to which section 82 above applies by the competent authority of a relevant contracting state other than the United Kingdom shall, if no appeal lies from the determination or the time for appealing has expired, be recognised in the United Kingdom as if it had been made by the court or the comptroller unless the court or he refuses to recognise it under subsection (2) below.

(2) The court or the comptroller may refuse to recognise any such determination that the applicant for a European patent had no right to be granted the patent, or any share in it, if either—

(a) the applicant did not contest the proceedings in question because he was not notified of them at all or in the proper manner or was not notified of them in time for him to contest the proceedings; or

(b) the determination in the proceedings in question conflicts with the determination of the competent authority of any relevant contracting state in proceedings instituted earlier between the same parties as in the proceedings in question.

[F240 83A European patent with unitary effect and Unified Patent Court

(1) Schedule A3 contains provision about the application of this Act in relation to the European patent with unitary effect.

(2) Schedule A4 contains provision about the jurisdiction of the Unified Patent Court in relation to the European patent (UK) and the European patent with unitary effect.**]**

Textual Amendments

F240 S. 83A inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(6)** (with art. 3)

84 . . . . . F241

Status: *This version of this Act contains provisions that are prospective.*
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Textual Amendments

F241 S. 84 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

85 . . . . . [F242]

Textual Amendments

F242 S. 85 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

Community patents

PROSPECTIVE

[F243]86 Implementation of Community Patent Convention.

. . . . . .

Textual Amendments

F243 S. 86 repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 1 para. 6, **Sch. 3**; S.I. 2004/3205, art. 2(g)(i) (with art. 9)

PROSPECTIVE

[F244]87 Decisions on Community Patent Convention.

. . . . . .

Textual Amendments

F244 S. 87 repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 1 para. 6, **Sch. 3**; S.I. 2004/3205, art. 2(g)(i) (with art. 9)

88 . . . . . [F245]

Textual Amendments

F245 S. 88 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), ss. 295, 305(3), Sch. 5 para. 23, **Sch. 8**

Status: *This version of this Act contains provisions that are prospective.*
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[F246 Unified Patent Court

Textual Amendments

F246 Ss. 88A, 88B and cross-heading inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 17**, 24(1); S.I. 2014/2330, art. 3, Sch.

88A Implementation of Agreement on a Unified Patent Court

(1) The Secretary of State may by order make provision for giving effect in the United Kingdom to the provisions of the Agreement on a Unified Patent Court made in Brussels on 19 February 2013.

(2) An order under this section may, in particular, make provision—
  (a) to confer jurisdiction on a court, remove jurisdiction from a court or vary the jurisdiction of a court;
  (b) to require the payment of fees.

(3) An order under this section may also make provision for varying the application of specified provisions of this Act so that they correspond to provision made by the Agreement.

(4) An order under this section may—
  (a) make provision which applies generally or in relation only to specified cases;
  (b) make different provision for different cases.

(5) An order under this section may amend this Act or any other enactment.

(6) An order under this section may not be made unless a draft of the order has been laid before, and approved by resolution of, each House of Parliament.

(7) The meaning of "court" in this section is not limited by the definition of that expression in section 130(1).

88B Designation as international organisation of which UK is member

The Unified Patent Court is to be treated for the purposes of section 1 of the International Organisations Act 1968 (organisations of which the United Kingdom is a member) as an organisation to which that section applies.**]**

International applications for patents

[F247 89 Effect of international application for patent.

(1) An international application for a patent (UK) for which a date of filing has been accorded under the Patent Co-operation Treaty shall, subject to—
  section 89A (international and national phases of application), and
  section 89B (adaptation of provisions in relation to international application),
be treated for the purposes of Parts I and III of this Act as an application for a patent under this Act.

Status: *This version of this Act contains provisions that are prospective.*
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(2) If the application, or the designation of the United Kingdom in it, is withdrawn or (except as mentioned in subsection (3)) deemed to be withdrawn under the Treaty, it shall be treated as withdrawn under this Act.

(3) An application shall not be treated as withdrawn under this Act if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Treaty—

(a) because of an error or omission in an institution having functions under the Treaty, or

(b) because, owing to circumstances outside the applicant's control, a copy of the application was not received by the International Bureau before the end of the time limited for that purpose under the Treaty,

or in such other circumstances as may be prescribed.

[F248](4) . . . . . .

(5) If an international application for a patent which designates the United Kingdom is refused a filing date under the Treaty and the comptroller determines that the refusal was caused by an error or omission in an institution having functions under the Treaty, he may direct that the application shall be treated as an application under this Act, having such date of filing as he may direct.**]**

Textual Amendments

F247 Ss. 89-89B substituted for s. 89 by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 25**

F248 S. 89(4) repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 1 para. 7, **Sch. 3**; S.I. 2004/3205, art. 2(g)(i) (with art. 9)

[[F249]89A International and national phases of application.

(1) The provisions of the Patent Co-operation Treaty relating to publication, search, examination and amendment, and not those of this Act, apply to an international application for a patent (UK) during the international phase of the application.

(2) The international phase of the application means the period from the filing of the application in accordance with the Treaty until the national phase of the application begins.

(3) The national phase of the application begins—

(a) when the prescribed period expires, provided any necessary translation of the application into English has been filed at the Patent Office and the prescribed fee has been paid by the applicant; or

(b) on the applicant expressly requesting the comptroller to proceed earlier with the national phase of the application, filing at the Patent Office—

(i) a copy of the application, if none has yet been sent to the Patent Office in accordance with the Treaty, and

(ii) any necessary translation of the application into English,

and paying the prescribed fee.

For this purpose a "copy of the application" includes a copy published in accordance with the Treaty in a language other than that in which it was originally filed.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(4) If the prescribed period expires without the conditions mentioned in subsection (3)(a) being satisfied, the application shall be taken to be withdrawn.

(5) Where during the international phase the application is amended in accordance with the Treaty, the amendment shall be treated as made under this Act if—

(a) when the prescribed period expires, any necessary translation of the amendment into English has been filed at the Patent Office, or

(b) where the applicant expressly requests the comptroller to proceed earlier with the national phase of the application, there is then filed at the Patent Office—

(i) a copy of the amendment, if none has yet been sent to the Patent Office in accordance with the Treaty, and

(ii) any necessary translation of the amendment into English;

otherwise the amendment shall be disregarded.

(6) The comptroller shall on payment of the prescribed fee publish any translation filed at the Patent Office under subsection (3) or (5) above.**]**

Textual Amendments

F249 Ss. 89-89B substituted for s. 89 by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 25**

[F250 89B Adaptation of provisions in relation to international application.

(1) Where an international application for a patent (UK) is accorded a filing date under the Patent Co-operation Treaty—

(a) that date, or if the application is re-dated under the Treaty to a later date that later date, shall be treated as the date of filing the application under this Act,

(b) any declaration of priority made under the Treaty shall be treated as made under section 5(2) above, and where in accordance with the Treaty any extra days are allowed, the period of 12 months **[F251** allowed under section 5(2A)(a) above**]** shall be treated as altered accordingly, and

(c) any statement of the name of the inventor under the Treaty shall be treated as a statement filed under section 13(2) above.

(2) If the application, not having been published under this Act, is published in accordance with the Treaty it shall be treated, for purposes other than those mentioned in subsection (3), as published under section 16 above when the **[F252** national phase of the application begins or, if later, when published in accordance with the Treaty**]** .

(3) For the purposes of section 55 (use of invention for service of the Crown) and section 69 (infringement of rights conferred by publication) the application, not having been published under this Act, shall be treated as published under section 16 above-—

(a) if it is published in accordance with the Treaty in English, on its being so published; and

(b) if it is so published in a language other than English—

(i) on the publication of a translation of the application in accordance with section 89A(6) above, or

(ii) on the service by the applicant of a translation into English of the specification of the application of the government department

Status: *This version of this Act contains provisions that are prospective.*
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concerned or, as the case may be, on the person committing the infringing act.

The reference in paragraph (b)(ii) to the service of a translation on a government department or other person is to its being sent by post or delivered to that department or person.

(4) During the international phase of the application, section 8 above does not apply (determination of questions of entitlement in relation to application under this Act) and section 12 above (determination of entitlement in relation to foreign and convention patents) applies notwithstanding the application; but after the end of the international phase, section 8 applies and section 12 does not.

(5) When the national phase begins the comptroller shall refer the application for so much of the examination and search **[**[F253]under sections 15A,**]** 17 and 18 above as he considers appropriate in view of any examination or search carried out under the Treaty.**]**

Textual Amendments

F250 Ss. 89-89B substituted for s. 89 by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 25**

F251 Words in s. 89B(1)(b) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **16(2)** (with arts. 20-23)

F252 Words in s. 89B(2) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 8**; S.I. 2004/3205, art. 2(i) (with art. 9)

F253 Words in s. 89B(5) substituted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **16(3)** (with arts. 20-23)

Convention countries

90 Orders in Council as to convention countries.

(1) Her Majesty may with a view to the fulfilment of a treaty or international convention, arrangement or engagement, by Order in Council declare that any country specified in the Order is a convention country for the purposes of section 5 above.

(2) Her Majesty may by Order in Council direct that any of the Channel Islands, any colony . . . [F254] shall be taken to be a convention country for those purposes.

(3) For the purposes of subsection (1) above every colony, protectorate, and territory subject to the authority or under the suzerainty of another country, and every territory administered by another country under the trusteeship system of the United Nations shall be taken to be a country in the case of which a declaration may be made under that subsection.

Textual Amendments

F254 Words repealed by Statute Law (Repeals) Act 1986 (c. 12), s. 1(1), **Sch. 1 Pt. VI**

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Miscellaneous

91 Evidence of conventions and instruments under conventions.

(1) Judicial notice shall be taken of the following, that is to say—

(a) the European Patent Convention, the Community Patent Convention **[**[F255], the Agreement on a Unified Patent Court**]** and the Patent Co-operation Treaty (each of which is hereafter in this section referred to as the relevant convention);

(b) any bulletin, journal or gazette published under the relevant convention and the register of European **[**[F256]patents kept under the European Patent Convention**]**; and

(c) any decision of, or expression of opinion by, the relevant convention court on any question arising under or in connection with the relevant convention.

(2) Any document mentioned in subsection (1)(b) above shall be admissible as evidence of any instrument or other act thereby communicated of any convention institution.

(3) Evidence of any instrument issued under the relevant convention by any such institution, including any judgment or order of the relevant convention court, or of any document in the custody of any such institution or reproducing in legible form any information in such custody otherwise than in legible form, or any entry in or extract from such a document, may be given in any legal proceedings by production of a copy certified as a true copy by an official of that institution; and any document purporting to be such a copy shall be received in evidence without proof of the official position or handwriting of the person signing the certificate.

(4) Evidence of any such instrument may also be given in any legal proceedings—

(a) by production of a copy purporting to be printed by the Queen's Printer;

(b) where the instrument is in the custody of a government department, by production of a copy certified on behalf of the department to be a true copy by an officer of the department generally or specially authorised to do so;

and any document purporting to be such a copy as is mentioned in paragraph (b) above of an instrument in the custody of a department shall be received in evidence without proof of the official position or handwriting of the person singing the certificate, or of his authority to do so, or of the document being in the custody of the department.

(5) In any legal proceedings in Scotland evidence of any matter given in a manner authorised by this section shall be sufficient evidence of it.

(6) In this section—

"convention institution" means an institution established by or having functions under the relevant convention;

"relevant convention court" does not include a court of the United Kingdom or of any other country which is a party to the relevant convention **[**[F257]but does include the Unified Patent Court**]**; and

"legal proceedings", in relation to the United Kingdom, includes proceedings before the comptroller.

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Textual Amendments

F255 Words in s. 91(1)(a) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(7)(a)** (with art. 3)

F256 Words in s. 91(1) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 20**; S.I. 2004/3205, art. 2(k) (with art. 9)

F257 Words in s. 91(6) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(7)(b)** (with art. 3)

92 Obtaining evidence for proceedings under the European Patent Convention.

(1) Sections 1 to 3 of the [M6]Evidence (Proceedings in Other Jurisdictions) Act 1975 (provisions enabling United Kingdom courts to assist in obtaining evidence for foreign courts) shall apply for the purpose of proceedings before a relevant convention court under the European Patent Convention **[**[F258]or proceedings before the Unified Patent Court**]** as they apply for the purpose of civil proceedings in a court exercising jurisdiction in a country outside the United Kingdom.

(2) In the application of those sections by virtue of this section any reference to the High Court, the Court of Session or the High Court of Justice in Northern Ireland shall include a reference to the comptroller.

(3) Rules under this Act may include provision—

(a) as to the manner in which an application under section 1 of the said Act of 1975 is to be made to the comptroller for the purpose of proceedings before a relevant convention court under the European Patent Convention; and

(b) subject to the provisions of that Act, as to the circumstances in which an order can be made under section 2 of that Act on any such application.

(4) Rules of court and rules under this Act may provide for an officer of the European Patent Office to attend the hearing of an application under section 1 of that Act before the court or the comptroller, as the case may be, and examine the witnesses or request the court or comptroller to put specified questions to the witnesses.

(5) Section 1(4) of the [M7]Perjury Act 1911 and **[**[F259]Article 3(4) of the Perjury (Northern Ireland) Order 1979**]** (statements made for the purposes, among others, of judicial proceedings in a tribunal of a foreign state) shall apply in relation to proceedings before a relevant convention court under the European Patent Convention **[**[F260]or proceedings before the Unified Patent Court**]** as they apply to a judicial proceeding in a tribunal of a foreign state.

Textual Amendments

F258 Words in s. 92(1) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(8)** (with art. 3)

F259 Words substituted by S.I. 1979/1714 (N.I. 19), **Sch. 1 para. 28**

F260 Words in s. 92(5) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(8)** (with art. 3)

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Marginal Citations

M6 1975 c. 34.

M7 1911 c. 6.

93 Enforcement of orders for costs.

If the European Patent Office orders the payment of costs in any proceedings before it—

(a) in England and Wales the costs shall, if **[**[F261]the county court**]** so orders, be recoverable **[**[F262] under section 85 of the County Courts Act 1984**]** or otherwise as if they were payable under an order of that court;

(b) in Scotland the order may be enforced in like manner as **[**[F263]a recorded decree arbitral**][**[F263]an extract registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland.**]**

(c) in Northern Ireland the order may be enforced as if it were a money judgment.

Textual Amendments

F261 Words in s. 93(a) substituted (E.W.S.) (22.4.2014) by Crime and Courts Act 2013 (c. 22), s. 61(3), **Sch. 9 para. 52**; S.I. 2014/954, art. 2(c) (with art. 3) (with transitional provisions and savings in S.I. 2014/956, arts. 3-11)

F262 Words in s. 93(a) substituted (6.4.2014) by Tribunals, Courts and Enforcement Act 2007 (c. 15), s. 148, **Sch. 13 para. 42** (with s. 89); S.I. 2014/768, art. 2(1)(b)

F263 Words commencing "an extract registered" substituted (S.) for the words "a recorded decree arbitral" by Debtors (Scotland) Act 1987 (c. 18, SIF 45:2), s. 108(1), Sch. 6 paras. 1, **20**

94 Communication of information to the European Patent Office, etc.

It shall not be unlawful by virtue of any enactment to communicate the following information in pursuance of the European Patent Convention to the European Patent Office or the competent authority of any country which is party to the Convention, that is to say—

(a) information in the files of the court which, in accordance with rules of court, the court authorises to be so communicated;

(b) information in the files of the Patent Office which, in accordance with rules under this Act, the comptroller authorises to be so communicated.

95 Financial provisions.

(1) There shall be paid out of moneys provided by Parliament any sums required by any Minister of the Crown or government department to meet any financial obligation of the United Kingdom under the European Patent Convention, [F264]... or the Patent Co-operation Treaty.

(2) Any sums received by any Minister of the Crown or government department in pursuance of **[**[F265]that convention **]** or that treaty shall be paid into the Consolidated Fund.

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Textual Amendments

F264 Words in s. 95(1) repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 21(a), **Sch. 3**; S.I. 2004/3205, art. 2(g)(k) (with art. 9)

F265 Words in s. 95(2) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 21(b)**; S.I. 2004/3205, art. 2(k) (with art. 9)

PART III

MISCELLANEOUS AND GENERAL

Legal Proceedings

[F266 96 The Patents Court.

(1) There shall be constituted, as part of the Chancery Division of the High Court, a Patents Court to take such proceedings relating to patents and other matters as may be prescribed by rules of court.

(2) The judges of the Patents Court shall be such of the puisne judges of the High Court as the Lord Chancellor may from time to time nominate.

(3) The foregoing provisions of this section shall not be taken as prejudicing the provisions of the M8Supreme Court of Judicature (Consolidation) Act 1925 which enable the whole jurisdiction of the High Court to be exercised by any judge of that court.

(4) Rules of court shall make provision for the appointment of scientific advisers to assist the Patents Court in proceedings under this Act and for regulating the functions of such advisers.

(5) The remuneration of any such adviser shall be determined by the Lord Chancellor with the consent of the Minister for the Civil Service and shall be defrayed out of moneys provided by Parliament.]

Textual Amendments

F266 S. 96 repealed (E.W.) by Supreme Court Act 1981 (c. 54, SIF 37), s. 152(4), **Sch. 7**

Marginal Citations

M8 1925 c. 49.

97 Appeals from the comptroller.

(1) Except as provided by subsection (4) below, an appeal shall lie to the Patents Court from any decision of the comptroller under this Act or rules except any of the following decisions, that is to say—

(a) a decision falling within section 14(7) above;

(b) a decision under section 16(2) above to omit matter from a specification;

(c) a decision to give directions under subsection (1) or (2) of section 22 above;

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(d) a decision under rules which is excepted by rules from the right of appeal conferred by this section.

(2) For the purpose of hearing appeals under this section the Patents Court may consist of one or more judges of that court in accordance with directions given by **[**[F267]the Lord Chief Justice of England and Wales after consulting the Lord Chancellor**]** ; **[**[F268]and the Patents Court shall not be treated as a divisional court for the purposes of section 31(1)(f) of the [M9]Supreme Court of Judicature (Consolidation) Act 1925 (appeals from divisional courts).**]**

(3) An appeal shall not lie to the Court of Appeal from a decision of the Patents Court on appeal from a decision of the comptroller under this Act or rules—

(a) except where the comptroller's decision was given under section 8, 12, 18, 20, 27, 37, 40, 61, 72, 73 or 75 above; or

(b) except where the ground of appeal is that the decision of the Patents Court is wrong in law;

but an appeal shall only lie to the Court of Appeal under this section if leave to appeal is given by the Patents Court or the Court of Appeal.

[[F269](4) The Lord Chief Justice may nominate a judicial office holder (as defined in section 109(4) of the Constitutional Reform Act 2005) to exercise his functions under subsection (2).**]**

(4) An appeal shall lie to the Court of Session from any decision of the comptroller in proceedings which under rules are held in Scotland, except any decision mentioned in paragraphs (a) to (d) of subsection (1) above.

(5) An appeal shall not lie to the Inner House of the Court of Session from a decision of an Outer House judge on appeal from a decision of the comptroller under this Act or rules—

(a) except where the comptroller's decision was given under section 8, 12, 18, 20, 27, 37, 40, 61, 72, 73 or 75 above; or

(b) except where the ground of appeal is that the decision of the Outer House judge is wrong in law.

Textual Amendments

F267 Words in s. 97(2) substituted (3.4.2006) by Constitutional Reform Act 2005 (c. 4), s. 148(1), **Sch. 4 para. 91(2)**; S.I. 2006/1014, art. 2(a), Sch. 1 para. 11(e)

F268 S. 97(2): from "and" onwards repealed (E.W.) by Supreme Court Act 1981 (c. 54, SIF 37), **Sch. 7**

F269 S. 97(4) inserted (3.4.2006) by Constitutional Reform Act 2005 (c. 4), s. 148(1), **Sch. 4 para. 91(3)**; S.I. 2006/1014, art. 2(a), Sch. 1 para. 11(e)

Marginal Citations

M9 1925 c. 49.

98 Proceedings in Scotland.

(1) In Scotland proceedings relating primarily to patents (other than proceedings before the comptroller) shall be competent in the Court of Session only, and any jurisdiction of the sheriff court relating to patents is hereby abolished except in relation to questions which are incidental to the issue in proceedings which are otherwise competent there.

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(2) The remuneration of any assessor appointed to assist the court in proceedings under this Act in the Court of Session shall be determined by the Lord President of the Court of Session with the consent of the **[**[F270]Treasury**]** and shall be defrayed out of moneys provided by Parliament.

Textual Amendments

F270 Words substituted by virtue of S.I. 1981/1670 arts. 2(2), 3(5)

99 General powers of the court.

The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Act or any treaty or international convention to which the United Kingdom is a party, make any order or exercise any other power which the comptroller could have made or exercised for the purpose of determining that question.

[[F271]99A Power of Patents Court to order report.

(1) Rules of court shall make provision empowering the Patents Court in any proceedings before it under this Act, on or without the application of any party, to order the Patent Office to inquire into and report on any question of fact or opinion.

(2) Where the court makes such an order on the application of a party, the fee payable to the Patent Office shall be at such rate as may be determined in accordance with rules of court and shall be costs of the proceedings unless otherwise ordered by the court.

(3) Where the court makes such an order of its own motion, the fee payable to the Patent Office shall be at such rate as may be determined by the Lord Chancellor with the approval of the Treasury and shall be paid out of money provided by Parliament.**]**

Textual Amendments

F271 Ss. 99A, 99B inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 26**

[[F272]99B Power of Court of Session to order report.

(1) In any proceedings before the Court of Session under this Act the court may, either of its own volition or on the application of any party, order the Patent Office to inquire into and report on any question of fact or opinion.

(2) Where the court makes an order under subsection (1) above of its own volition the fee payable to the Patent Office shall be at such rate as may be determined by the Lord President of the Court of Session with the consent of the Treasury and shall be defrayed out of moneys provided by Parliament.

(3) Where the court makes an order under subsection (1) above on the application of a party, the fee payable to the Patent Office shall be at such rate as may be provided for in rules of court and shall be treated as expenses in the cause.**]**

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Textual Amendments

F272 Ss. 99A, 99B inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 26**

100 Burden of proof in certain cases.

(1) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the proprietor of the patent or a licensee of his shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process.

(2) In considering whether a party has discharged the burden imposed upon him by this section, the court shall not require him to disclose any manufacturing or commercial secrets if it appears to the court that it would be unreasonable to do so.

101 Exercise of comptroller's discretionary powers.

Without prejudice to any rule of law, the comptroller shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretion vested in the comptroller by this Act or rules.

[F273 102 Right of audience, &c. in proceedings before comptroller.

(1) A party to proceedings before the comptroller under this Act, or under any treaty or international convention to which the United Kingdom is a party, may appear before the comptroller in person or be represented by any person whom he desires to represent him.

(2) No offence is committed under the enactments relating to the preparation of documents by persons not legally qualified by reason only of the preparation by any person of a document, other than a deed, for use in such proceedings.

[F274(2A) For the purposes of subsection (2), as it has effect in relation to England and Wales, "the enactment relating to the preparation of documents by persons not qualified" means section 14 of the Legal Services Act 2007 (offence to carry on a reserved legal activity if not entitled) as it applies in relation to an activity which amounts to the carrying on of reserved instrument activities within the meaning of that Act.**]**

(3) Subsection (1) has effect subject to rules made under section 281 of the Copyright, Designs and Patents Act 1988 (power of comptroller to refuse to recognise certain agents).

(4) In its application to proceedings in relation to applications for, or otherwise in connection with, European patents, this section has effect subject to any restrictions imposed by or under the European Patent Convention.

[F275(5) Nothing in this section is to be taken to limit any entitlement to prepare deeds conferred on a registered patent attorney by virtue of the Legal Services Act 2007.**]]**

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Textual Amendments

F273 S. 102, 102A substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 27**

F274 S. 102(2A) inserted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 40(a)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)

F275 S. 102(5) substituted (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 21 para. 40(b)** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(h)

[F277[F276]102A Right of audience, &c. in proceedings on appeal from the comptroller.

. . . . . .

Textual Amendments

F276 S. 102, 102A substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 27**

F277 S. 102A repealed (1.1.2010) by Legal Services Act 2007 (c. 29), s. 211(2), **Sch. 23** (with ss. 29, 192, 193); S.I. 2009/3250, art. 2(i)(iii)

103 Extension of privilege for communications with solicitors relating to patent proceedings.

(1) It is hereby declared that the rule of law which confers privilege from disclosure in legal proceedings in respect of communications made with a solicitor or a person acting on his behalf, or in relation to information obtained or supplied for submission to a solicitor or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before a court in the United Kingdom extends to such communications so made for the purpose of any pending or contemplated—

(a) proceedings before the comptroller under this Act or any of the relevant conventions, or

(b) proceedings before the relevant convention court under any of those conventions.

(2) In this section—

"legal proceedings" includes proceedings before the comptroller;

the references to legal proceedings and pending or contemplated proceedings include references to applications for a patent or a European patent and to international applications for a patent; and

"the relevant conventions" means the European Patent Convention, [F278]... and the Patent Co-operation Treaty.

(3) This section shall not extend to Scotland.

Extent Information

E2 S. 103 does not extend to Scotland, the Channel Islands nor the Colonies.

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Textual Amendments

F278 Words in s. 103(2) repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 22, **Sch. 3**; S.I. 2004/3205, art. 2(g)(k) (with art. 9)

Modifications etc. (not altering text)

C17 S. 103 amended (E.W.) (1.1.1992) by S.I. 1991/2684, arts. 2, 4, 5, **Sch.1**.

C18 S. 103 applied (with modifications) (E.W.S.) (23.12.2011) by The Legal Services Act 2007 (Designation as a Licensing Authority) (No. 2) Order 2011 (S.I. 2011/2866), art. 1(2), **Sch. 2**

104 Privilege for communications with patent agents relating to patent proceedings.

. . . . . [F279]

Textual Amendments

F279 S. 104 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), ss. 303(2), **Sch. 8**

105 Extension of privilege in Scotland for communications relating to patent proceedings.

[[F280](1) It is hereby declared that in Scotland the rules of law which confer privilege from disclosure in legal proceedings in respect of communications, reports or other documents (by whomsoever made) made for the purpose of any pending or contemplated proceedings in a court in the United Kingdom extend to communications, reports or other documents made for the purpose of patent proceedings.**]**

[[F281](2) In this section—

"patent proceedings" means proceedings under this Act or any of the relevant conventions, before the court, the comptroller or the relevant convention court, whether contested or uncontested and including an application for a patent; and

"the relevant conventions" means the European Patent Convention, [F282]... and the Patent Co-operation Treaty.**]**

Textual Amendments

F280 S. 105: the existing text is renumbered as s. 105(1) and the words "within the meaning of section 104 above" are repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), ss. 303(1), 303(2), Sch. 7 para. 21, **Sch. 8**

F281 S. 105(2) inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(1), **Sch. 7 para. 21**

F282 Words in s. 105(2) repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 22, **Sch. 3**; S.I. 2004/3205, art. 2(g)(k) (with art. 9)

106 Costs and expenses in proceedings before the Court [F283]....

(1) In **[**[F284]proceedings to which this section applies**]** under section 40 above (whether on an application or on appeal to the court), the court, in determining whether to award

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costs or expenses to any party and what costs or expenses to award, shall have regard to all the relevant circumstances, including the financial position of the parties.

[[F285](1A) This section applies to proceedings before the court (including proceedings on an appeal to the court) which are—

(a) proceedings under section 40;

(b) proceedings for infringement;

(c) proceedings **[**[F286]in respect of an actionable threat under section 70A**]** ; or

(d) proceedings on an application for a declaration or declarator under section 71.**]**

(2) If in any such proceedings the Patents Court directs that any costs of one party shall be paid by another party, the court may settle the amount of the costs by fixing a lump sum or may direct that the costs shall be taxed on a scale specified by the court, being a scale of costs prescribed by **[**[F287]rules of court**]** .

Textual Amendments

F283 Words in s. 106 heading repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 3**; S.I. 2004/3205, art. 2(g) (with art. 9)

F284 Words in s. 106(1) substituted (1.1.2005) by Patents Act 2004 (c. 16), **s. 14(2)**(4), 17(1); S.I. 2004/3205, art. 2(e) (with art. 9)

F285 S. 106(1A) inserted (1.1.2005) by Patents Act 2004 (c. 16), **s. 14(3)**(4), 17(1); S.I. 2004/3205, art. 2(e) (with art. 9)

F286 Words in s. 106(1A)(c) substituted (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(7)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

F287 Words in s. 106(2) substituted (1.10.2009) by Constitutional Reform Act 2005 (c. 4), s. 148(1), **Sch. 11 para. 23(4)**; S.I. 2009/1604, art. 2(d)

107 Costs and expenses in proceedings before the comptroller.

(1) The comptroller may, in proceedings before him under this Act, by order award to any party such costs or, in Scotland, such expenses as he may consider reasonable and direct how and by what parties they are to be paid.

(2) In England and Wales any costs awarded under this section shall, if **[**[F288]the county court**]** so orders, be recoverable **[**[F289] under section 85 of the County Courts Act 1984**]** or otherwise as if they were payable under an order of that court.

(3) In Scotland any order under this section for the payment of expenses may be enforced in like manner as **[**[F290]a recorded decree arbitral**][**[F290]an extract registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland.**]**

[[F291](4) The comptroller may make an order for security for costs or expenses against any party to proceedings before him under this Act if—

(a) the prescribed conditions are met, and

(b) he is satisfied that it is just to make the order, having regard to all the circumstances of the case;

and in default of the required security being given the comptroller may treat the reference, application or notice in question as abandoned.**]**

(5) In Northern Ireland any order under this section for the payment of costs may be enforced as if it were a money judgment.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

Textual Amendments

F288 Words in s. 107(2) substituted (E.W.S.) (22.4.2014) by Crime and Courts Act 2013 (c. 22), s. 61(3), **Sch. 9 para. 52**; S.I. 2014/954, art. 2(c) (with art. 3) (with transitional provisions and savings in S.I. 2014/956, arts. 3-11)

F289 Words in s. 107(2) substituted (6.4.2014) by Tribunals, Courts and Enforcement Act 2007 (c. 15), s. 148, **Sch. 13 para. 43** (with s. 89); S.I. 2014/768, art. 2(1)(b)

F290 Words commencing "an extract registered" substituted (S.) for the words "a recorded decree arbitral" by Debtors (Scotland) Act 1987 (c. 18, SIF 45:2), s. 108(1), Sch. 6 paras. 1, **20**

F291 S. 107(4) substituted (1.10.2005) by Patents Act 2004 (c. 16), **ss. 15**, 17(1); S.I. 2005/2471, art. 2(d) (with art. 4)

108 Licences granted by order of comptroller.

Any order for the grant of a licence under section 11, 38, 48 or 49 above shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order.

Offences

109 Falsification of register etc.

If a person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy or reproduction of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be liable—

(a) on summary conviction, to a fine not exceeding £1,000,

(b) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both.

110 Unauthorised claim of patent rights.

(1) If a person falsely represents that anything disposed of by him for value is a patented product he shall, subject to the following provisions of this section, be liable on summary conviction to a fine not exceeding **[**[F292]level 3 on the standard scale**]**

(2) For the purposes of subsection (1) above a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word "patent" or "patented" or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

(3) Subsection (1) above does not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(4) In proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of the offence.

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Textual Amendments

F292 Words substituted by virtue of (E.W.) Criminal Justice Act 1982 (c. 48, SIF 39:1), **s. 46** and (S.) Criminal Procedure (Scotland) Act 1975 (c. 21, SIF 39:1), **s. 289G** and (N.I.) S.I. 1984/703 (N.I. 3), **art. 5**

111 Unauthorised claim that patent has been applied for.

(1) If a person represents that a patent has been applied for in respect of any article disposed of for value by him and—

(a) no such application has been made, or

(b) any such application has been refused or withdrawn,

he shall, subject to the following provisions of this section, be liable on summary conviction to a fine not exceeding **[**[F293]level 3 on the standard scale**]**

(2) Subsection (1)(b) above does not apply where the representation is made (or continues to be made) before the expiry of a period which commences with the refusal or withdrawal and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(3) For the purposes of subsection (1) above a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words "patent applied for" or "patent pending", or anything expressing or implying that a patent has been applied for in respect of the article, shall be taken to represent that a patent has been applied for in respect of it.

(4) In any proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of such an offence.

Textual Amendments

F293 Words substituted by virtue of (E.W.) Criminal Justice Act 1982 (c. 48, SIF 39:1), **s. 46** and (S.) Criminal Procedure (Scotland) Act 1975 (c. 21, SIF 39:1), **s. 289G** and (N.I.) S.I. 1984/703 (N.I. 3), **art. 5**

112 Misuse of title "Patent Office".

If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office" or any other words suggesting that his place of business is, or is officially connected with, the Patent Office, he shall be liable on summary conviction to a fine not exceeding **[**[F294]level 4 on the standard scale**]**

Textual Amendments

F294 Words substituted by virtue of (E.W.) Criminal Justice Act 1982 (c. 48, SIF 39:1), **s. 46** and (S.) Criminal Procedure (Scotland) Act 1975 (c. 21, SIF 39:1), **s. 289G** and (N.I.) S.I. 1984/703 (N.I. 3), **art. 5**

Modifications etc. (not altering text)

C19 S. 112 amended (3.1.1995) by 1994 c. 40, ss. 76, 82(2)(f), **Sch. 16 para. 4**

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

113 Offences by corporations.

(1) Where an offence under this Act which has been committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body corporate, or any person who was purporting to act in any such capacity, he, as well as the body corporate, shall be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

(2) Where the affairs of a body corporate are managed by its members, subsection (1) above shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

114 . . . . . F295

Textual Amendments

F295 S. 114 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

115 . . . . . F296

Textual Amendments

F296 S. 115 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

Immunity of department

116 Immunity of department as regards official acts.

Neither the Secretary of State nor any officer of his—

(a) shall be taken to warrant the validity of any patent granted under this Act or any treaty or international convention to which the United Kingdom is a party; or

(b) shall incur any liability by reason of or in connection with any examination or investigation required or authorised by this Act or any such treaty or convention, or any report or other proceedings consequent on any such examination or investigation.

Administrative provisions

117 Correction of errors in patents and applications.

(1) The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.

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(2) Where the comptroller is requested to correct such an error or mistake, any person may in accordance with rules give the comptroller notice of opposition to the request and the comptroller shall determine the matter.

[[F297](3) Where the comptroller is requested to correct an error or mistake in a withdrawal of an application for a patent, and—

(a) the application was published under section 16 above; and

(b) details of the withdrawal were published by the comptroller;

the comptroller shall publish notice of such a request in the prescribed manner.

(4) Where the comptroller publishes a notice under subsection (3) above, the comptroller may only correct an error or mistake under subsection (1) above by order.**]**

Textual Amendments

F297 S. 117(3)(4) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **17** (with arts. 20-23)

[[F298]

117A Effect of resuscitating a withdrawn application under section 117

(1) Where—

(a) the comptroller is requested to correct an error or mistake in a withdrawal of an application for a patent; and

(b) an application has been resuscitated in accordance with that request,

the effect of that resuscitation is as follows.

(2) Anything done under or in relation to the application during the period between the application being withdrawn and its resuscitation shall be treated as valid.

(3) If the comptroller has published notice of the request as mentioned in section 117(3) above, anything done during that period which would have constituted an infringement of the rights conferred by publication of the application if the application had not been withdrawn shall be treated as an infringement of those rights if it was a continuation or repetition of an earlier act infringing those rights.

(4) If the comptroller has published notice of the request as mentioned in section 117(3) above and, after the withdrawal of the application and before publication of the notice, a person—

(a) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the withdrawal had not taken place, or

(b) made in good faith effective and serious preparations to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the resuscitation of the application and the grant of the patent; but this right does not extend to granting a licence to another person to do the act.

(5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (4) above may—

(a) authorise the doing of that act by any partners of his for the time being in that business, and

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(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(6) Where a product is disposed of to another in exercise of a right conferred by subsection (4) or (5) above, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant.**]**

[[F299](7) The above provisions apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to infringement of the rights conferred by publication of the application for a patent (or, as the case may be, infringement of the patent).

"Patented invention" has the same meaning as in section 55 above.**]**

Textual Amendments

F298 Ss. 117A, 117B inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **18** (with arts. 20-23)

F299 S. 117A(7) inserted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(2), **Sch. 2 para. 23** (see S.I. 2004/2357, art. 1(2))

[[F298]**117B Extension of time limits specified by comptroller**

(1) Subsection (2) below applies in relation to a period if it is specified by the comptroller in connection with an application for a patent, or a patent.

(2) Subject to subsections (4) and (5) below, the comptroller shall extend a period to which this subsection applies if—

(a) the applicant or the proprietor of the patent requests him to do so; and

(b) the request complies with the relevant requirements of rules.

(3) An extension of a period under subsection (2) above expires—

(a) at the end of the period prescribed for the purposes of this subsection, or

(b) if sooner, at the end of the period prescribed for the purposes of section 20 above.

(4) If a period has already been extended under subsection (2) above—

(a) that subsection does not apply in relation to it again;

(b) the comptroller may further extend the period subject to such conditions as he thinks fit.

(5) Subsection (2) above does not apply to a period specified in relation to proceedings before the comptroller.**]**

Textual Amendments

F298 Ss. 117A, 117B inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **18** (with arts. 20-23)

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118 Information about patent applications and patents, and inspection of documents.

(1) After publication of an application for a patent in accordance with section 16 above the comptroller shall on a request being made to him in the prescribed manner and on payment of the prescribed fee (if any) give the person making the request such information, and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application as may be specified in the request, subject, however, to any prescribed restrictions.

(2) Subject to the following provisions of this section, until an application for a patent is so published documents or information constituting or relating to the application shall not, without the consent of the applicant, be published or communicated to any person by the comptroller.

(3) Subsection (2) above shall not prevent the comptroller from—

(a) sending the European Patent Office information which it is his duty to send that office in accordance with any provision of the European Patent Convention;

[[F300](aa) sending any patent office outside the United Kingdom such information about unpublished applications for patents as that office requests;**]** or

(b) publishing or communicating to others any prescribed bibliographic information about an unpublished application for a patent;

nor shall that subsection prevent the Secretary of State from inspecting or authorising the inspection of an application for a patent or any connected documents under **[**[F301]section 22(6) above**]**.

[[F302](3A) Information may not be sent to a patent office in reliance on subsection (3)(aa) otherwise than in accordance with the working arrangements that the comptroller has made for that purpose with that office.

(3B) Those arrangements must include provision for ensuring that the confidentiality of information of the kind referred to in subsection (3)(aa) sent by the comptroller to the patent office in question is protected.**]**

[[F303](3C) The reference in subsection (3)(aa) to a patent office is to an organisation which carries out, in relation to patents, functions of the kind carried out at the Patent Office.**]**

(4) Where a person is notified that an application for a patent has been made, but not published in accordance with section 16 above, and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification after the application is so published, that person may make a request under subsection (1) above, notwithstanding that the application has not been published, and that subsection shall apply accordingly.

(5) Where an application for a patent is filed, but not published, and a new application is filed in respect of any part of the subject-matter of the earlier application (either in accordance with rules or in pursuance of an order under section 8 above) and is published, any person may make a request under subsection (1) above relating to the earlier application and on payment of the prescribed fee the comptroller shall give him such information and permit him to inspect such documents as could have been given or inspected if the earlier application had been published.

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Textual Amendments

F300 S. 118(3)(aa) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 18(1)**, 24(1); S.I. 2014/2330, art. 3, Sch. (with art. 7)

F301 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 28**

F302 S. 118(3A)(3B) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 18(2)**, 24(1); S.I. 2014/2330, art. 3, Sch. (with art. 7)

F303 S. 118(3C) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 18(3)**, 24(1); S.I. 2014/2330, art. 3, Sch. (with art. 7)

[F304]118A Copyright in documents made available electronically for inspection under section 118(1)

. . . . . .

Textual Amendments

F304 S. 118A repealed (1.6.2014) by The Copyright (Public Administration) Regulations 2014 (S.I. 2014/1385), regs. 1, **3(1)**

119 Service by post.

Any notice required or authorised to be given by this Act or rules, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

120 Hours of business and excluded days.

(1) **[**[F305] The comptroller may give directions specifying **]** the hour at which the Patent Office shall be taken to be closed on any day for purposes of the transaction by the public of business under this Act or of any class of such business, **[**[F306] and the directions may specify **]** days as excluded days for any such purposes.

(2) Any business done under this Act on any day after the hour so specified in relation to business of that class, or on a day which is an excluded day in relation to business of that class, shall be taken to have been done on the next following day not being an excluded day; and where the time for doing anything under this Act expires on an excluded day that time shall be extended to the next following day not being an excluded day.

[[F307](3) Directions under this section shall be published in the prescribed manner.**]**

Textual Amendments

F305 Words in s. 120(1) substituted (22.9.2004) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 24(2)(a)**; S.I. 2004/2177, art. 2 (with arts. 6, 8)

F306 Words in s. 120(1) substituted (22.9.2004) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 24(2)(b)**; S.I. 2004/2177, art. 2 (with arts. 6, 8)

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F307 S. 120(3) inserted (22.9.2004) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 24(3)**; S.I. 2004/2177, art. 2 (with arts. 6, 8)

121 Comptroller's annual report.

Before **[**[F308]1st December**]** in every **[**[F309]financial year **]** the comptroller shall cause to be laid before both Houses of Parliament a report with respect to the execution of this Act and the discharge of his functions under the European Patent Convention, [F310]... and the Patent Co-operation Treaty, and every such report shall include an account of all fees, salaries and allowances, and other money received and paid by him under this Act, **[**[F311]that convention**]** and that treaty during the previous **[**[F309]financial year**]** .

Textual Amendments

F308 Words in s. 121 substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 25(a)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F309 Words in s. 121 substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 25(b)**; S.I. 2004/3205, art. 2(k) (with art. 9)

F310 Words in s. 121 repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 25(c), **Sch. 3**; S.I. 2004/3205, art. 2(g)(k) (with art. 9)

F311 Words in s. 121 substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 25(d)**; S.I. 2004/3205, art. 2(k) (with art. 9)

Modifications etc. (not altering text)

C20 S. 121 amended (31.10.1994) by 1994 c. 26, **s. 71(1)**; S.I. 1994/2550, **art. 2**

Supplemental

122 Crown's right to sell forfeited articles.

Nothing in this Act affects the right of the Crown or any person deriving title directly or indirectly from the Crown to dispose of or use articles forfeited under the laws relating to customs or excise.

123 Rules.

(1) The Secretary of State may make such rules as he thinks expedient for regulating the business of the Patent Office in relation to patents and applications for patents (including European patents, applications for European patents and international applications for patents) and for regulating all matters placed by this Act under the direction or control of the comptroller; and in this Act, except so far as the context otherwise requires, "prescribed" means prescribed by rules and "rules" means rules made under this section.

(2) Without prejudice to the generality of subsection (1) above, rules may make provision—

(a) prescribing the form and contents of applications for patents and other documents which may be filed at the Patent Office and requiring copies to be furnished of any such documents;

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(b) regulating the procedure to be followed in connection with any proceeding or other matter before the comptroller or the Patent Office and authorising the rectification of irregularities of procedure;

(c) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the Patent Office and providing for the remission of fees in the prescribed circumstances;

(d) regulating the mode of giving evidence in any such proceeding and empowering the comptroller to compel the attendance of witnesses and the discovery of and production of documents;

(e) requiring the comptroller to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding;

(f) requiring the comptroller to hold proceedings in Scotland in such circumstances as may be specified in the rules where there is more than one party to proceedings under section 8, 12, 37, 40(1) or (2), 41(8), 61(3), 71 or 72 above;

(g) providing for the appointment of advisers to assist the comptroller in any proceeding before him;

(h) prescribing time limits for doing anything required to be done in connection with any such proceeding by this Act or the rules and providing for the alteration of any period of time specified in this Act or the rules;

[[F312](i) giving effect to an inventor's rights to be mentioned conferred by section 13, and providing for an inventor's waiver of any such right to be subject to acceptance by the comptroller;**]**

(j) without prejudice to any other provision of this Act, requiring and regulating the translation of documents in connection with an application for a patent or a European patent or an international application for a patent and the filing and authentication of any such translations;

(k) . . . . . [F313]

(l) providing for the publication and sale of documents in the Patent Office and of information about such documents.

[[F314](2A) The comptroller may set out in directions any forms the use of which is required by rules; and any such directions shall be published in the prescribed manner.**]**

(3) Rules may make different provision for different cases.

[[F315](3A) It is hereby declared that rules—

(a) authorising the rectification of irregularities of procedure, or

(b) providing for the alteration of any period of time,

may authorise the comptroller to extend or further extend any period notwithstanding that the period has already expired.**]**

[F316](4) . . . . . .

[F317](5) . . . . . .

(6) Rules shall provide for the publication by the comptroller of a journal (in this Act referred to as "the journal") containing particulars of applications for and grants of patents, and of other proceedings under this Act.

(7) Rules shall require or authorise the comptroller to make arrangements for the publication of reports of cases relating to patents, trade marks **[**[F318]registered designs

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or design right**]** decided by him and of cases relating to patents (whether under this Act or otherwise) trade marks, registered designs **[**[F319], copyright and design right**]** decided by any court or body (whether in the United Kingdom or elsewhere).

Textual Amendments

F312 S. 123(2)(i) substituted (1.10.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 26(2)**; S.I. 2005/2471, art. 2(g)

F313 S. 123(2)(k) repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

F314 S. 123(2A) inserted (22.9.2004) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 26(3)**; S.I. 2004/2177, art. 2 (with arts. 7, 8)

F315 Words substituted by virtue of S.I. 1981/1670 arts. 2, 3(5)

F316 S. 123(4) repealed (22.9.2004) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 26(4), **Sch. 3**; S.I. 2004/2177, art. 2 (with arts. 7, 8)

F317 S. 123(5) repealed (22.9.2004) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 26(4), **Sch. 3**; S.I. 2004/2177, art. 2 (with arts. 7, 8)

F318 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(1), **Sch. 7 para. 22(a)**

F319 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(1), **Sch. 7 para. 22(b)**

Modifications etc. (not altering text)

C21 S. 123 extended (10.12.1992) by S.I. 1992/3091, **reg. 4(2)**
S. 123 extended (1.3.2002) by The Patents and Plant Variety Rights (Compulsory Licensing) Regulations 2002 (S.I. 2002/247), **reg. 20**

C22 S. 123(1) amended (2.1.1993) by S.I. 1992/3091, **reg. 4(1)**

C23 S. 123(2)-(7) applied (10.12.1992) by S.I 1992/3091, reg. 4(2)

C24 S. 123(7) extended by Patents, Designs and Marks Act 1986 (c. 39, SIF 67A), s. 2(3), **Sch. 2 Pt. I para. 1(2)**(*e*)(iii)
S. 123(7) amended (31.10.1994) by 1994 c. 26, s. 106(1), **Sch. 4 para. 1(2)**; S.I. 1994/2550, **art. 2**

124 Rules, regulations and orders; supplementary.

(1) Any power conferred on the Secretary of State by this Act to make rules, regulations or orders shall be exercisable by statutory instrument.

(2) Any Order in Council and any statutory instrument containing an order, rules or regulations under this Act, other than an order or rule required to be laid before Parliament in draft or an order under section 132(5) below, shall be subject to annulment in pursuance of a resolution of either House of Parliament.

(3) Any Order in Council or order under any provision of this Act may be varied or revoked by a subsequent order.

Modifications etc. (not altering text)

C25 S. 124 applied (10.12.1992) by S.I. 1992/3091, **reg. 4(2)**

C26 S. 124 applied (1.3.2002) by The Patents and Plant Variety Rights (Compulsory Licensing) Regulations 2002 (S.I. 2002/247), **reg. 20**

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

[F320 124A Use of electronic communications

(1) The comptroller may [F321 give] directions as to the form and manner in which documents to be delivered to the comptroller—

(a) in electronic form; or

(b) using electronic communications,

are to be delivered to him.

(2) A direction under subsection (1) may provide that in order for a document to be delivered in compliance with the direction it shall be accompanied by one or more additional documents specified in the direction.

(3) [F322 Subject to subsections (14) and (15), if a document to which a direction under subsection (1) or (2)] applies is delivered to the comptroller in a form or manner which does not comply with the direction the comptroller may treat the document as not having been delivered.

(4) Subsection (5) applies in relation to a case where—

(a) a document is delivered using electronic communications, and

(b) there is a requirement for a fee to accompany the document.

(5) The comptroller may [F323 give] directions specifying—

(a) how the fee shall be paid; [F324 and]

(b) when the fee shall be deemed to have been paid.

(6) The comptroller may [F325 give] directions specifying that a person who delivers a document to the comptroller in electronic form or using electronic communications cannot treat the document as having been delivered unless its delivery has been acknowledged.

(7) The comptroller may [F326 give] directions specifying how a time of delivery is to be accorded to a document delivered to him in electronic form or using electronic communications.

(8) A direction under this section may be given—

(a) generally;

(b) in relation to a description of cases specified in the direction;

(c) in relation to a particular person or persons.

F327 (9) . . . . . .

F327 (10) . . . . . .

(11) A direction under this section may be varied or revoked by a subsequent direction under this section.

F328 (12) . . . . . .

[F329 (13) The delivery using electronic communications to any person by the comptroller of any document is deemed to be effected, unless the comptroller has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the comptroller by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(14) A requirement of this Act that something must be done in the prescribed manner is satisfied in the case of something that is done—

(a) using a document in electronic form, or

(b) using electronic communications,

only if the directions under this section that apply to the manner in which it is done are complied with.

(15) In the case of an application made as mentioned in subsection (14)(a) or (b) above, a reference in this Act to the application not having been made in compliance with rules or requirements of this Act includes a reference to its not having been made in compliance with any applicable directions under this section.

(16) This section applies—

(a) to delivery at, in, with or to the Patent Office as it applies to delivery to the comptroller; and

(b) to delivery by the Patent Office as it applies to delivery by the comptroller.**]]**

Textual Amendments

F320 S. 124A inserted (1.4.2003) by Patents Act 1977 (Electronic Communications) Order 2003 (S.I. 2003/512), arts. 1, **2**

F321 Word in s. 124A(1) substituted (1.10.2006) by Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(2)**

F322 Words in s. 124A(3) substituted (1.10.2006) by Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(3)**

F323 Word in s. 124A(5) substituted (1.10.2006) by Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(4)(a)**

F324 Word in s. 124A(5) inserted (1.10.2006) by Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(4)(b)**

F325 Word in s. 124A(6) substituted (1.10.2006) by Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(5)**

F326 Word in s. 124A(7) substituted (1.10.2006) by Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(6)**

F327 S. 124A(9)(10) omitted (1.10.2006) by virtue of Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(7)**

F328 S. 124A(12) omitted (1.10.2006) by virtue of Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(7)**

F329 S. 124A(13)-(16) substituted for s. 124A(13)-(15) (1.10.2006) by Registered Designs Act 1949 and Patents Act 1977 (Electronic Communications) Order 2006 (S.I. 2006/1229), arts. 1, **4(8)**

125 Extent of invention.

(1) For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(2) It is hereby declared for the avoidance of doubt that where more than one invention is specified in any such claim, each invention may have a different priority date under section 5 above.

(3) The Protocol on the Interpretation of Article 69 of the European Patent Convention (which Article contains a provision corresponding to subsection (1) above) shall, as for the time being in force, apply for the purposes of subsection (1) above as it applies for the purposes of that Article.

[F330 125A Disclosure of invention by specification: availablity of samples of [F331 biological material].

(1) Provision may be made by rules prescribing the circumstances in which the specification of an application for a patent, or of a patent, for an invention which **[**F332 involves the use of or concerns biological material**]** is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(2) The rules may in particular require the applicant or patentee—

(a) to take such steps as may be prescribed for the purposes of making available to the public samples of the **[**F332 biological material**]**, and

(b) not to impose or maintain restrictions on the uses to which such samples may be put, except as may be prescribed.

(3) The rules may provide that, in such cases as may be prescribed, samples need only be made available to such persons or descriptions of persons as may be prescribed; and the rules may identify a description of persons by reference to whether the comptroller has given his certificate as to any matter.

(4) An application for revocation of the patent under section 72(1)(c) above may be made if any of the requirements of the rules cease to be complied with.**]**

Textual Amendments

F330 S. 125A inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 30**

F331 Words in sidenote to s. 125A substituted (28.7.2000) by S.I. 2000/2037, **reg. 6(2)**

F332 Words in s. 125A(1)(2)(a) substituted (28.7.2000) by S.I. 2000/2037, **reg. 6(3)(4)**

F333 126 . . . . . .

Textual Amendments

F333 S. 126 repealed (28.7.2000 with effect as mentioned in Sch. 40 Pt. III Note 1 of the amending Act) by 2000 c. 17, s. 156, **Sch. 40 Pt. III**

127 Existing patents and applications.

(1) No application for a patent may be made under the 1949 Act on or after the appointed day.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(2) Schedule 1 to this Act shall have effect for securing that certain provisions of the 1949 Act shall continue to apply on and after the appointed day to—
  (a) a patent granted before that day;
  (b) an application for a patent which is filed before that day, and which is accompanied by a complete specification or in respect of which a complete specification is filed before that day;
  (c) a patent granted in pursuance of such an application.

(3) Schedule 2 to this Act shall have effect for securing that (subject to the provisions of that Schedule) certain provisions of this Act shall apply on and after the appointed day to any patent and application to which subsection (2) above relates, but, except as provided by the following provisions of this Act, this Act shall not apply to any such patent or application.

(4) An application for a patent which is made before the appointed day, but which does not comply with subsection (2)(b) above, shall be taken to have been abandoned immediately before that day, but, notwithstanding anything in section 5(3) above, the application may nevertheless serve to establish a priority date in relation to a later application for a patent under this Act if the date of filing the abandoned application falls within the period of fifteen months immediately preceding the filing of the later application.

(5) Schedule 3 to this Act shall have effect for repealing certain provisions of the 1949 Act.

(6) The transitional provisions and savings in Schedule 4 to this Act shall have effect.

(7) In Schedules 1 to 4 to this Act "existing patent" means a patent mentioned in subsection (2)(a) and (c) above, "existing application" means an application mentioned in subsection (2)(b) above, and expressions used in the 1949 Act and those Schedules have the same meanings in those Schedules as in that Act.

Modifications etc. (not altering text)

C27 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

128 Priorities between patents and applications under 1949 Act and this Act.

(1) The following provisions of this section shall have effect for the purpose of resolving questions of priority arising between patents and applications for patents under the 1949 Act and patents and applications for patents under this Act.

(2) A complete specification under the 1949 Act shall be treated for the purposes of sections 2(3) and 5(2) above—
  (a) if published under that Act, as a published application for a patent under this Act;
  (b) if it has a date of filing under that Act, as an application for a patent under this Act which has a date of filing under this Act;

  and in the said section 2(3), as it applies by virtue of this subsection in relation to any such specification, the words "both as filed and" shall be omitted.

Status: *This version of this Act contains provisions that are prospective.*
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(3) In section 8(1), (2) and (4) of the 1949 Act (search for anticipation by prior claim) the references to any claim of a complete specification, other than the applicant's, published and filed as mentioned in section 8(1) shall include references to any claim contained in an application made and published under this Act or in the specification of a patent granted under this Act, being a claim in respect of an invention having a priority date earlier than the date of filing the complete specification under the 1949 Act.

(4) In section 32(1)(a) of the 1949 Act (which specifies, as one of the grounds of revoking a patent, that the invention was claimed in a valid claim of earlier priority date contained in the complete specification of another patent), the reference to such a claim shall include a reference to a claim contained in the specification of a patent granted under this Act (a new claim) which satisfies the following conditions:—

(a) the new claim must be in respect of an invention having an earlier priority date than that of the relevant claim of the complete specification of the patent sought to be revoked; and

(b) the patent containing the new claim must be wholly valid or be valid in those respects which have a bearing on that relevant claim.

(5) For the purposes of this section and the provisions of the 1949 Act mentioned in this section the date of filing an application for a patent under that Act and the priority date of a claim of a complete specification under that Act shall be determined in accordance with the provisions of that Act, and the priority date of an invention which is the subject of a patent or application for a patent under this Act shall be determined in accordance with the provisions of this Act.

[F334 128A EU compulsory licences

(1) In this Act an "EU compulsory licence" means a compulsory licence granted under Regulation (EC) No 816/2006 of the European Parliament and of the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (referred to in this Act as "the Compulsory Licensing Regulation").

(2) In the application to EU compulsory licences of the provisions of this Act listed in subsection (3)—

(a) references to a licence under a patent,

(b) references to a right under a patent, and

(c) references to a proprietary interest under a patent,

include an EU compulsory licence.

(3) The provisions referred to in subsection (2) are—

sections 32 and 33 (registration of patents etc);

section 37 (determination of right to patent after grant);

section 38 (effect of transfer etc of patent under section 37), apart from subsection (2) and subsections (3) to (5) so far as relating to subsection (2);

section 41 (amount of compensation);

section 46(2) (notice of application for entry that licences are available as of right);

section 57(1) and (2) (rights of third parties in respect of Crown use).

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(4) In the following provisions references to this Act include the Compulsory Licensing Regulation—

sections 97 to 99B, 101 to 103, 105 and 107 (legal proceedings);
section 119 (service by post);
section 120 (hours of business and excluded days);
section 121 (comptroller's annual report);
section 123 (rules);
section 124A (use of electronic communications);
section 130(8) (disapplication of Part 1 of Arbitration Act 1996).

(5) In section 108 (licences granted by order of comptroller) the reference to a licence under section 11, 38, 48 or 49 includes an EU compulsory licence.

(6) References in this Act to the Compulsory Licensing Regulation are to that Regulation as amended from time to time.

Textual Amendments

F334 Ss. 128A, 128B inserted (17.12.2007) by The Patents (Compulsory Licensing and Supplementary Protection Certificates) Regulations 2007 (S.I. 2007/3293), regs. 1(2), **2(2)**

128B. Supplementary protection certificates

(1) Schedule 4A contains provision about the application of this Act in relation to supplementary protection certificates and other provision about such certificates.

(2) In this Act a "supplementary protection certificate" means a certificate issued under—

(a) **[**[F335]Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6th May 2009 concerning the supplementary protection certificate for medicinal products**]**, or

(b) Regulation (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products.**]**

Textual Amendments

F334 Ss. 128A, 128B inserted (17.12.2007) by The Patents (Compulsory Licensing and Supplementary Protection Certificates) Regulations 2007 (S.I. 2007/3293), regs. 1(2), **2(2)**

F335 Words in s. 128B(2)(a) substituted (1.10.2014) by The Patents (Supplementary Protection Certificates) Regulations 2014 (S.I. 2014/2411), regs. 1(2), **2(2)**

129 Application of Act to Crown.

—This Act does not affect Her Majesty in her private capacity but, subject to that, it binds the Crown.

130 Interpretation.

(1) In this Act, except so far as the context otherwise requires—

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[[F336]"Agreement on a Unified Patent Court" means the Agreement on a Unified Patent Court signed at Brussels on 19th February 2013;**]**

[[F337]"application fee" means the fee prescribed for the purposes of section 14(1A) above;**]**

"application for a European patent (UK)" and **[**[F338](subject to subsection (4A) below)**]** "international application for a patent (UK)" each mean an application of the relevant description which, on its date of filing, designates the United Kingdom;

"appointed day", in any provision of this Act, means the day appointed under section 132 below for the coming into operation of that provision;

[[F339]"biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system;

[F339]"biotechnological invention" means an invention which concerns a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used;

[F340]…

"comptroller" means the Comptroller-General of Patents, Designs and Trade Marks;

"Convention on International Exhibitions" means the Convention relating to International Exhibitions signed in Paris on 22nd November 1928, as amended or supplemented by any protocol to that convention which is for the time being in force;

"court" means

(a) **[**[F341]as respects England and Wales, the High **[**[F342]Court;**]]**
(b) as respects Scotland, the Court of Session;
(c) as respects Northern Ireland, the High Court in Northern Ireland;

[[F343]or the Unified Patent Court, as respects the jurisdiction which it has by virtue of Schedule A4;**]**

"date of filing" means—

(a) in relation to an application for a patent made under this Act, the date which is the date of filing that application by virtue of section 15 above; and
(b) in relation to any other application, the date which, under the law of the country where the application was made or in accordance with the terms of a treaty or convention to which that country is a party, is to be treated as the date of filing that application or is equivalent to the date of filing an application in that country (whatever the outcome of the application);

"designate" in relation to an application or a patent, means designate the country or countries (in pursuance of the European Patent Convention or the Patent Co-operation Treaty) in which protection is sought for the invention which is the subject of the application or patent **[**[F344]and includes a reference to a country being treated as designated in pursuance of the convention or treaty**]**;

[[F345]"electronic communication" has the same meaning as in the Electronic Communications Act 2000;**]**

"employee" means a person who works or (where the employment has ceased) worked under a contract of employment or in employment under or for the purposes of a government department **[**[F346]or a person who serves (or served) in the naval, military or air forces of the Crown**]**;

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"employer", in relation to an employee, means the person by whom the employee is or was employed;

"European Patent Convention" means the Convention on the Grant of European Patents, "European patent" means a patent granted under that convention, "European patent (UK)" means a European patent designating the United Kingdom, "European Patent Bulletin" means the bulletin of that name published under that convention, and "European Patent Office" means the office of that name established by that convention;

[[F336]"European patent with unitary effect" has the same meaning as in Article 2 of the Unitary Patent Regulation;**]**

"exclusive licence" means a licence from the proprietor of or applicant for a patent conferring on the licensee, or on him and persons authorised by him, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application relates, and "exclusive licensee" and "non-exclusive licence" shall be construed accordingly;

[F337]…

"formal requirements" means those requirements designated as such by rules made for the purposes of **[**[F347]section 15A**]** above;

"international application for a patent" means an application made under the Patent Co-operation Treaty;

"International Bureau" means the secretariat of the World Intellectual Property Organization established by a convention signed at Stockholm on 14th July 1967;

"international exhibition" means an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions or falling within the terms of any subsequent treaty or convention replacing that convention;

"inventor" has the meaning assigned to it by section 7 above;

"journal" has the meaning assigned to it by section 123(6) above;

"mortgage", when used as a noun, includes a charge for securing money or money's worth and, when used as a verb, shall be construed accordingly;

[M10]"1949 Act" means the Patents Act 1949;

"patent" means a patent under this Act;

[F348]. . . . . ;

"Patent Co-operation Treaty" means the treaty of that name signed at Washington on 19th June 1970;

"patented invention" means an invention for which a patent is granted and "patented process" shall be construed accordingly;

"patented product" means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied;

"prescribed" and "rules" have the meanings assigned to them by section 123 above;

"priority date" means the date determined as such under section 5 above;

"published" means made available to the public (whether in the United Kingdom or elsewhere) and a document shall be taken to be published under any provision of this Act if it can be inspected as of right at any place in the

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United Kingdom by members of the public, whether on payment of a fee or not; and "republished" shall be construed accordingly;

"register" and cognate expressions have the meanings assigned to them by section 32 above;

[F349]"relevant convention court", in relation to any proceedings under the European Patent Convention, ... or the Patent Co-operation Treaty, means that court or other body which under that convention or treaty has jurisdiction over those proceedings, including (where it has such jurisdiction) any department of the European Patent Office;

"right", in relation to any patent or application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;

"search fee" means the fee prescribed for the purposes of **[**[F350]section 17(1) above**]**;

"services of the Crown" and "use for the services of the Crown" have the meanings assigned to them by section 56(2) above, including, as respects any period of emergency within the meaning of section 59 above, the meanings assigned to them by the said section 59.

[[F336]"Unified Patent Court" means the court established under the Agreement on a Unified Patent Court;**]**

[[F336]"Unitary Patent Regulation" means Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection.**]**

(2) Rules may provide for stating in the journal that an exhibition falls within the definition of international exhibition in subsection (1) above and any such statement shall be conclusive evidence that the exhibition falls within that definition.

(3) For the purposes of this Act matter shall be taken to have been disclosed in any relevant application within the meaning of section 5 above or in the specification of a patent if it was either claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or specification.

(4) References in this Act to an application for a patent, as filed, are references to such an application in the state it was on the date of filing.

[F351]**[** (4A) An international application for a patent is not, by reason of being treated by virtue of the European Patent Convention as an application for a European patent (UK), to be treated also as an international application for a patent (UK).**]**

(5) References in this Act to an application for a patent being published are references to its being published under section 16 above.

[F352]**[** (5A) References in this Act to the amendment of a patent or its specification (whether under this Act or by the European Patent Office) include, in particular, limitation of the claims (as interpreted by the description and any drawings referred to in the description or claims).**]**

(6) References in this Act to any of the following conventions, that is to say—

(a) The European Patent Convention;

(b) The Community Patent Convention;

(c) The Patent Co-operation Treaty;

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

[F353](d) **[** The Agreement on a Unified Patent Court;**]**

are references to that convention or any other international convention or agreement replacing it, as amended or supplemented by any convention or international agreement (including in either case any protocol or annex), or in accordance with the terms of any such convention or agreement, and include references to any instrument made under any such convention or agreement.

(7) Whereas by a resolution made on the signature of the Community Patent Convention the governments of the member states of the European Economic Community resolved to adjust their laws relating to patents so as (among other things) to bring those laws into conformity with the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty, it is hereby declared that the following provisions of this Act, that is to say, sections 1(1) to (4), 2 to 6, 14(3), (5) and (6), 37(5), 54, 60, 69, 72(1) and (2), 74(4), 82, 83, . . . [F354] 100 and 125, are so framed as to have, as nearly as practicable, the same effects in the United Kingdom as the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty have in the territories to which those Conventions apply.

(8) **[**[F355]Nothing in any of sections 1 to 15 of and schedule 1 to the Arbitration (Scotland) Act 2010 or**][**[F356]Part I of the Arbitration Act 1996**][**[F357]applies**]** to any proceedings before the comptroller under this Act.

(9) Except so far as the context otherwise requires, any reference in this Act to any enactment shall be construed as a reference to that enactment as amended or extended by or under any other enactment, including this Act.**]**

Textual Amendments

F336 Words in s. 130(1) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(9)(a)** (with art. 3)

F337 Words in s. 130(1) inserted (1.1.2005) by The Regulatory Reform (Patents) Order 2004 (S.I. 2004/2357), arts. 1(2), **19** (with arts. 20-23)

F338 Words in s. 130(1) inserted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 9(2)(a)**; S.I. 2004/3205, art. 2(i) (with art. 9)

F339 S. 130: definitions of "biological material" and "biotechnological invention" inserted (28.7.2000) by S.I. 2000/2037, **reg. 7**

F340 Words in s. 130(1) repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 27(a), **Sch. 3**; S.I. 2004/3205, art. 2(g)(k) (with art. 9)

F341 Definition substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(1), **Sch. 7 para. 23**

F342 Word in s. 130(1) substituted (1.10.2013) by Crime and Courts Act 2013 (c. 22), s. 61(3), **Sch. 9 para. 27**; S.I. 2013/1725, art. 3(c)

F343 Words in s. 130(1) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(9)(b)** (with art. 3)

F344 Words in s. 130(1) inserted (1.1.2005 for specified purposes, 13.12.2007 for specified purposes) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 9(2)(b)**; S.I. 2004/3205, art. 2(j) (with art. 9); S.I. 2007/3396, art. 2(k) (with art. 3)

F345 Words in s. 130(1) inserted (1.4.2003) by Patents Act 1977 (Electronic Communications) Order 2003 (S.I. 2003/512), arts. 1, **3**

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

F346 Words added (retrospectively) by Armed Forces Act 1981 (c. 55, SIF 7:1), **s. 22(1)(3)**
F347 Words in s. 130(1) substituted (29.4.2006) by Intellectual Property (Enforcement, etc) Regulations 2006 (S.I. 2006/1028), art. 1, **Sch. 2 para. 5(1)** (with reg. 5(2))
F348 Definition of "patent agent" repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**
F349 Words in s. 130(1) repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 2 para. 27(b), **Sch. 3**; S.I. 2004/3205, art. 2(g)(k) (with art. 9)
F350 Words substituted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, **Sch. 5 para. 5**
F351 S. 130(4A) inserted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 9(3)**; S.I. 2004/3205, art. 2(i) (with art. 9)
F352 S. 130(5A) inserted (13.12.2007) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 1 para. 9(4)**; S.I. 2007/3396, art. 2(j)
F353 S. 130(6)(d) inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(9)(c)** (with art. 3)
F354 Words repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**
F355 Words in s. 130(8) inserted (S.) (5.6.2010) by The Arbitration (Scotland) Act 2010 (Consequential Amendments) Order 2010 (S.S.I. 2010/220), art. 1, **sch. para. 5(a)**
F356 Words in s. 130(8) substituted (31.1.1997) by 1996 c. 23, s. 107(1), **Sch. 3 para. 33** (with Pt. I); S.I. 1996/3146, **art. 3**
F357 Word in s. 130(8) substituted (S.) (5.6.2010) by The Arbitration (Scotland) Act 2010 (Consequential Amendments) Order 2010 (S.S.I. 2010/220), art. 1, **sch. para. 5(b)**

Marginal Citations
M10 1949 c. 87.

131 Northern Ireland.

In the application of this Act to Northern Ireland—

(a) "enactment" includes an enactment of the Parliament of Northern Ireland and a Measure of the Northern Ireland Assembly;

(b) any reference to a government department includes a reference to a Department of the Government of Northern Ireland;

(c) any reference to the Crown includes a reference to the Crown in right of Her Majesty's Government in Northern Ireland;

(d) any reference to the **[**[F358]Companies Act 1985**]** includes a reference to the corresponding enactments in force in Northern Ireland; and

[F359](e) . . . . . .

[[F360](f) any reference to a claimant includes a reference to a plaintiff.**]**

Textual Amendments
F358 Words substituted by Companies Consolidation (Consequential Provisions) Act 1985 (c. 9, SIF 27), s. 30, **Sch. 2**
F359 S. 131(e) repealed (31.1.1997) by 1996 c. 23, s. 107(2), **Sch. 4** (with Pt. I); S.I. 1996/3146, **art. 3**
F360 S. 131(f) inserted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 28**; S.I. 2004/3205, art. 2(k) (with art. 9)

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

[131A [F361]Scotland

In the application of this Act to Scotland–

(a) "enactment" includes an enactment comprised in, or in an instrument made under, an Act of the Scottish Parliament;

(b) any reference to a government department includes a reference to any part of the Scottish Administration; and

(c) any reference to the Crown includes a reference to the Crown in right of the Scottish Administration.**]**

Textual Amendments

F361 S. 131A inserted (1.7.1999) by S.I. 1999/1820, arts. 1(2)(3), 4, **Sch. 2 Pt. I para. 58** (with saving in art. 5)

132 Short title, extent, commencement, consequential amendments and repeals.

(1) This Act may be cited as the Patents Act 1977.

(2) This Act shall extend to the Isle of Man, subject to any modifications contained in an Order made by Her Majesty in Council, and accordingly, subject to any such order, references in this Act to the United Kingdom shall be construed as including references to the Isle of Man.

(3) For the purposes of this Act the territorial waters of the United Kingdom shall be treated as part of the United Kingdom.

(4) This Act applies to acts done in an area designated by order under section 1(7) of the [M11]Continental Shelf Act 1964, **[**[F362]or specified by Order under **[**[F363]section 10(8) of the Petroleum Act 1998**]** in connection with any activity falling within section 23(2) of that Act**]**, as it applies to acts done in the United Kingdom.

(5) This Act (except sections 77(6), (7) and (9), 78(7) and (8), this subsection and the repeal of section 41 of the 1949 Act) shall come into operation on such day as may be appointed by the Secretary of State by order, and different days may be appointed under this subsection for different purposes.

(6) The consequential amendments in Schedule 5 shall have effect.

(7) Subject to the provisions of Schedule 4 to this Act, the enactments specified in Schedule 6 to this Act (which include certain enactments which were spent before the passing of this Act) are hereby repealed to the extent specified in column 3 of that Schedule.

Textual Amendments

F362 Words substituted by Oil and Gas (Enterprise) Act 1982 (c. 23, SIF 86), **Sch. 3 para. 39**

F363 Words in s. 132(4) substituted (15.2.1999) by 1998 c. 17, s. 50, **Sch. 4 para. 14** (with Sch. 3 para. 5(1)): S.I. 1999/161, **art. 2**

Modifications etc. (not altering text)

C28 Power of appointment conferred by s. 132(5) partly exercised by S.I. 1977/2090, 1978/586

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

C29 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

Marginal Citations

M11 1964 c. 29.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

SCHEDULES

[F364SCHEDULE A1

Section 60(5)(g)

DEROGATION FROM PATENT PROTECTION IN RESPECT OF BIOTECHNOLOGICAL INVENTIONS

Textual Amendments

F364 Sch. A1 inserted (28.7.2000) by S.I. 2000/2037, reg. 8(1), **Sch. 1**

Interpretation

1 In this Schedule—

"Council Regulation" means Council Regulation (EC) No. 2100/94 of 27th July 1994 on Community plant variety rights;

"farmer's own holding" means any land which a farmer actually exploits for plant growing, whether as his property or otherwise managed under his own responsibility and on his own account;

"the gazette" means the gazette published under section 34 of the Plant Variety and Seeds Act 1964 [F365];

"protected material" means plant propagating material which incorporates material subject to a patent;

"relevant activity" means the use by a farmer of the product of his harvest for propagation or multiplication by him on his own holding, where the product of the harvest constitutes or contains protected material;

"relevant rights holder" means the proprietor of a patent to which protected material is subject;

"seed" includes seed potatoes;

"seed year" means the period from 1st July in one year to 30th June in the following year, both dates inclusive.

Textual Amendments

F365 1964 c. 14.

Specified species

2 Section 60(5)(g) applies only to varieties of the following plant species and groups:

Name	***Common Name***
Fodder plants	
Cicer arietinum L.	Chickpea milkvetch

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

Lupinus luteus L.	Yellow lupin
Medicago sativa L.	Lucerne
Pisum sativum L. (partim)	Field pea
Trifolium alexandrinum L.	Berseem/Egyptian clover
Trifolium resupinatum L.	Persian clover
Vicia faba	Field bean
Vicia sativa L.	Common vetch
Cereals	
Avena sativa	Oats
Hordeum vulgare L.	Barley
Oryza sativa L.	Rice
Phalaris canariensis L.	Canary grass
Secale cereale L.	Rye
X Triticosecale Wittm.	Triticale
Triticum aestivum L. emend. Fiori et Paol.	Wheat
Triticum durum Desf.	Durum wheat
Triticum spelta L.	Spelt wheat
Potatoes	
Solanum tuberosum	Potatoes
Oil and fibre plants	
Brassica napus L. (partim)	Swede rape
Brassica rapa L. (partim)	Turnip rape
Linum usitatissimum	Linseed with the exclusion of flax

Liability to pay equitable remuneration

3 (1) If a farmer's use of protected material is authorised by section 60(5)(g), he shall, at the time of the use, become liable to pay the relevant rights holder equitable remuneration.

(2) That remuneration must be sensibly lower than the amount charged for the production of protected material of the same variety in the same area with the holder's authority.

(3) Remuneration is to be taken to be sensibly lower if it would be taken to be sensibly lower within the meaning of Article 14(3) fourth indent of the Council Regulation.

Exemption for small farmers

4 (1) Paragraph 3 does not apply to a farmer who is considered to be a small farmer for the purposes of Article 14(3) third indent of the Council Regulation.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(2) It is for a farmer who claims to be a small farmer to prove that he is such a farmer.

Information to be supplied by farmer

5 (1) At the request of a relevant rights holder ("H"), a farmer must tell H—
- (a) his name and address;
- (b) whether he has performed a relevant activity; and
- (c) if he has performed such an activity, the address of the holding on which he performed it.

(2) If the farmer has performed such an activity, he must tell H whether he is—
- (a) liable to pay remuneration as a result of paragraph 3; or
- (b) not liable because he is a small farmer.

(3) If the farmer has told H that he is liable to pay remuneration as a result of paragraph 3, he must tell H—
- (a) the amount of the protected material used;
- (b) whether the protected material has been processed for planting; and
- (c) if it has, the name and address of the person who processed it.

(4) The farmer must comply with sub-paragraphs (2) and (3) when complying with sub-paragraph (1).

(5) If the farmer has told H that he is liable to pay remuneration as a result of paragraph 3, he must (if H asks him to do so) tell H—
- (a) whether he used any protected material with the authority of H within the same seed year; and
- (b) if he did, the amount used and the name and address of the person who supplied it.

Information to be supplied by seed processor

6 (1) On the request of a relevant rights holder, a seed processor shall supply the following information—
- (a) the name and address of the seed processor;
- (b) the address of the seed processor's principal place of business; and
- (c) whether the seed processor has processed seed of a species specified in paragraph 2 above.

(2) If the seed processor has processed seed of a species specified in paragraph 2 above he shall also supply the following information with the information referred to in sub-paragraph (1)—
- (a) the name and address of the person for whom the processing was carried out;
- (b) the amount of seed resulting from the processing;
- (c) the date processing commenced;
- (d) the date processing was completed;
- (e) the place where processing was carried out.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

Information to be supplied by relevant rights holder

7 On the request of a farmer or a seed processor a relevant rights holder shall supply the following information—

(a) his name and address; and

(b) the amount of royalty charged for certified seed of the lowest certification category for seed containing that protected material.

Period in respect of which inquiry may be made

8 A request may be made under paragraphs 5, 6 and 7 in respect of the current seed year and the three preceding seed years.

Restriction on movement for processing from the holding

9 No person shall remove or cause to be removed from a holding protected material in order to process it unless—

(a) he has the permission of the relevant rights holder in respect of that protected material;

(b) he has taken measures to ensure that the same protected material is returned from processing as is sent for processing and the processor has undertaken to him that the processor has taken measures to ensure that the same protected material is returned from processing as is sent for processing; or

(c) he has the protected material processed by a seed processor on the list of processors referred to in the gazette as being permitted to process seed away from a holding.

Confidentiality

10 (1) A person who obtains information pursuant to this Schedule shall owe an obligation of confidence in respect of the information to the person who supplied it.

(2) Sub-paragraph (1) shall not have effect to restrict disclosure of information—

(a) for the purposes of, or in connection with, establishing the amount to be paid to the holder of rights pursuant to paragraph 3 and obtaining payment of that amount,

(b) for the purposes of, or in connection with, establishing whether a patent has been infringed, or

(c) for the purposes of, or in connection with, any proceedings for the infringement of a patent.

Formalities

11 (1) A request for information under this Schedule, and any information given in response to such a request, must be in writing.

(2) Information requested under this Schedule must be given—

(a) within 28 days; or

(b) if the request specifies a longer period, within the specified period.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

Remedies

12 (1) If, in response to a request under this Schedule, a person—

(a) knowingly fails to provide information which he is required by this Schedule to give, or

(b) refuses to provide any such information,

the court may order him to provide it.

(2) Sub-paragraph (1) does not affect any of the court's other powers to make orders.

(3) A person who knowingly provides false information in response to a request under this Schedule is liable in damages to the person who made the request.

(4) In any action for damages under sub-paragraph (3) the court must have regard, in particular to—

(a) how flagrant the defendant was in providing the false information, and

(b) any benefit which accrued to him as a result of his providing false information,

and shall award such additional damages as the justice of the case may require.**]**

[[F366]SCHEDULE A2

Section 76A

BIOTECHNOLOGICAL INVENTIONS

Textual Amendments

F366 Sch. A2 inserted (28.7.2000) by 2000/2037, reg. 8(2), Sch. 2

1 An invention shall not be considered unpatentable solely on the ground that it concerns—

(a) a product consisting of or containing biological material; or

(b) a process by which biological material is produced, processed or used.

2 Biological material which is isolated from its natural environment or produced by means of a technical process may be the subject of an invention even if it previously occurred in nature.

3 The following are not patentable inventions—

(a) the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene;

(b) processes for cloning human beings;

(c) processes for modifying the germ line genetic identity of human beings;

(d) uses of human embyos for industrial or commercial purposes;

(e) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes;

(f) any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro-biological or other technical process or the product of such a process.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

4 Inventions which concern plants or animals may be patentable if the technical feasibility of the invention is not confined to a particular plant or animal variety.

5 An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

6 The industrial application of a sequence or partial sequence of a gene must be disclosed in the patent application as filed.

7 The protection conferred by a patent on a biological material possessing specific characteristics as a result of the invention shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

8 The protection conferred by a patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the invention shall extend to biological material directly obtained through that process and to any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

9 The protection conferred by a patent on a product containing or consisting of genetic information shall extend to all material, save as provided for in paragraph 3(a) above, in which the product is incorporated and in which the genetic information is contained and performs its function.

10 The protection referred to in paragraphs 7, 8 and 9 above shall not extend to biological material obtained from the propagation or multiplication of biological material placed on the market by the proprietor of the patent or with his consent, where the multiplication or propagation necessarily results from the application for which the biological material was marketed, provided that the material obtained is not subsequently used for other propagation or multiplication.

11 In this Schedule:

"essentially biological process" means a process for the production of animals and plants which consists entirely of natural phenomena such as crossing and selection;

"microbiological process" means any process involving or performed upon or resulting in microbiological material;

"plant variety" means a plant grouping within a single botanical taxon of the lowest known rank, which grouping can be:

(a) defined by the expression of the characteristics that results from a given genotype or combination of genotypes; and

(b) distinguished from any other plant grouping by the expression of at least one of the said characteristics; and

(c) considered as a unit with regard to its suitability for being propagated unchanged.**]**

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

[F367SCHEDULE A3

EUROPEAN PATENT WITH UNITARY EFFECT

Textual Amendments

F367 Schs. A3, A4 inserted (coming into force in accordance with art. 1(2)) by The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (S.I. 2016/388), arts. 1(2), **2(10)** (with art. 3)

Meaning of "relevant statutory provisions"

1. In this Schedule "relevant statutory provisions" means—
   (a) the provisions of this Act which, by virtue of paragraph 2, apply in relation to the European patent with unitary effect, and
   (b) the other provisions of this Act which, by virtue of the Unitary Patent Regulation, are to be treated as applying in relation to the European patent with unitary effect (see, in particular, Article 7 of that Regulation).

Provisions applied by this Schedule to the European patent with unitary effect

2. The following provisions of this Act apply in relation to a European patent with unitary effect, subject to paragraphs 3 and 4—

   section 48 (compulsory licences: general);

   section 48A (compulsory licences: WTO proprietors);

   section 48B (compulsory licences: other cases);

   section 49 (provisions about licences under section 48);

   section 50 (exercise of powers on applications under section 48);

   section 50A (powers exercisable following merger and market investigations);

   section 51 (powers exercisable in consequence of report of Competition and Markets Authority);

   section 52 (opposition, appeal and arbitration);

   section 53 (compulsory licences; supplementary provisions);

   section 54 (special provisions where patented invention is being worked abroad);

   section 55 (use of patented inventions for services of the Crown);

   section 56 (interpretation, etc., of provisions about Crown use);

   section 57 (rights of third parties in respect of Crown use);

   section 57A (compensation for loss of profit);

   section 58(1) to (6) and (9A) to (13) (references of disputes as to Crown use);

   section 59 (special provisions as to Crown use during emergency);

   section 60 (meaning of infringement);

   section 64 (right to continue use begun before priority date);

   [F368sections 70 to 70F (unjustified threats);]

   section 73(2) to (4) (Comptroller's power to revoke patents on his own initiative);

   section 74A (opinions on matters prescribed in the rules);

   section 74B (reviews of opinions under section 74A);

   section 76A (biotechnological inventions);

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

section 77(4) to (5A) (effect of European patent (UK));

section 80(1) (authentic text of European patents and patent applications);

sections 97 to 100 (legal proceedings) so far as they relate to proceedings which do not fall within the exclusive jurisdiction of the Unified Patent Court as set out in paragraph 1 of Schedule A4;

section 101 (exercise of comptroller's discretionary powers);

section 102 (right of audience, &c in proceedings before comptroller);

sections 103 (extension of privilege for communications with solicitors relating to patent proceedings) and 105 (extension of privilege in Scotland for communications relating to patent proceedings) so far as they relate to proceedings before the comptroller;

section 107 (costs and expenses in proceedings before the comptroller);

section 108 (licences granted by order of comptroller);

section 110 (unauthorised claim of patent rights);

section 116 (immunity of department as regards official acts);

section 118 (information about patent applications and patents, and inspection of documents);

section 123 (rules);

section 124 (rules, regulations and orders; supplementary);

section 125 (extent of invention);

section 128A (EU compulsory licences);

section 128B (supplementary protection certificates).

Textual Amendments

F368 Words in Sch. A3 para. 2 inserted (1.10.2017) by Intellectual Property (Unjustified Threats) Act 2017 (c. 14), **ss. 1(8)**, 8; S.I. 2017/771, reg. 2(2) (with reg. 3)

Manner of application of relevant statutory provisions

3. The relevant statutory provisions apply in relation to a European patent with unitary effect in the same way as they apply in relation to a European patent (UK).

Modifications of relevant statutory provisions

4. (1) In their application in relation to the European patent with unitary effect, the relevant statutory provisions which are referred to in this paragraph have effect subject to the modifications set out in this paragraph.

(2) In section 7(2)(b), the reference to the United Kingdom is a reference to any of the Participating Member States.

(3) In sections 30(7) and 31(7), references to proceedings by virtue of section 61 or 69 are references to equivalent proceedings in the Unified Patent Court.

(4) In sections 33(1)(a), 33(4), 37(2), 37(7), 38(2) and 38(3), the reference to registration is a reference to registration in the Register for unitary patent protection.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(5) In sections 48(1)(b), 48B(4), 50A(4), 51(3), 53(3), and 53(4), the reference to the register is a reference to the Register for unitary patent protection.

(6) In sections 48(2)(b), 50A(4), 51(3), 53(3), 53(4) and 53(5), the reference to making an entry is a reference to directing the making of an entry.

(7) In sections 48B(2)(b) and 50(2)(a), the reference to the journal is a reference to the European Patent Bulletin.

(8) In section 55(5)(b), the reference to the Patent Office is a reference to the European Patent Office.

(9) In section 59(2), the reference to section 69 includes a reference to Article 67 of the European Patent Convention.

(10) In section 60—

(a) in subsections (1), (2), and (5)(d), (e) and (f), the references to the United Kingdom are references to the territory of a Contracting Member State in which the European patent with unitary effect has effect;

(b) in subsection (7)—

(i) in the definition of "relevant ship" and "relevant aircraft, hovercraft or vehicle", the reference to the United Kingdom is a reference to a Contracting Member State in which the European patent with unitary effect has effect; and

(ii) in the definition of "exempted aircraft", the reference to an aircraft to which section 89 of the Civil Aviation Act 1982 applies is a reference to an aircraft other than an aircraft of a Contracting Member State in which the European patent with unitary effect has effect.

Interpretation

5. In this Schedule—

(a) "Contracting Member State" has the same meaning as in Article 2(c) of the Agreement on a Unified Patent Court; and

(b) the following expressions have the same meanings as in Article 2 of the Unitary Patent Regulation—

Participating Member State;

Register for unitary patent protection.

SCHEDULE A4

THE UNIFIED PATENT COURT

Jurisdiction

1. The Unified Patent Court has exclusive jurisdiction in respect of an Article 32(1) action which relates to—

(a) a European patent with unitary effect, or

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(b) a supplementary protection certificate for which the basic patent is a European patent with unitary effect,

(c) subject to paragraph 2—

(i) a European patent (UK), or

(ii) a supplementary protection certificate for which the basic patent is a European patent (UK).

Transitional provisions

2. (1) The transitional provisions in Article 83 apply in relation to an action referred to in Article 83(1).

(2) An opt out referred to in Article 83(3) may be exercised in accordance with that provision and any relevant Rules of Procedure.

(3) Such opt out may be withdrawn in accordance with Article 83(4) and any relevant Rules of Procedure.

(4) For the purposes of this paragraph, a reference to Article 83 is a reference to Article 83 of the Agreement on a Unified Patent Court.

Modifications of law applicable where UPC has jurisdiction

3. (1) In the case of an Article 32(1) action relating to—

(a) a European patent with unitary effect, or

(b) a European patent (UK),

the provisions of this Act listed in sub-paragraph (2) do not apply in relation to the action where the Unified Patent Court has jurisdiction in accordance with paragraph 1.

(2) The provisions referred to in sub-paragraph (1) are—

section 58(7) to (9) (references of disputes as to Crown use);

section 61 (proceedings for infringement of patent);

section 62 (restrictions on recovery of damages for infringement);

section 63 (relief for infringement of partially valid patent);

section 65 (certificate of contested validity of patent);

section 66 (proceedings for infringement by a co-owner);

section 67 (proceedings for infringement by exclusive licensee);

section 68 (effect of non-registration on infringement proceedings);

section 69 (infringement of rights conferred by publication of application);

section 71 (declaration or declarator as to non-infringement);

section 72 (power to revoke patents on application);

section 73(1) to (1C) (comptroller's power to revoke patents on his own initiative);

section 74 (proceedings in which validity of patent may be put in issue);

section 75 (amendment of patent in infringement or revocation proceedings);

section 77(3) (effect of European patent (UK)).

(3) In the case of an Article 32(1) action relating to a supplementary protection certificate for which the basic patent is—

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(a) a European patent with unitary effect, or
(b) a European patent (UK),

the provisions of this Act listed in sub-paragraph (4) do not apply in relation to the action where the Unified Patent Court has jurisdiction in accordance with paragraph 1.

(4) The provisions referred to in sub-paragraph (3) are—

section 58(7) to (9) (references of disputes as to Crown use);
section 61 (proceedings for infringement of patent);
section 62 (restrictions on recovery of damages for infringement);
section 63 (relief for infringement of partially valid patent);
section 65 (certificate of contested validity of patent);
section 66 (proceedings for infringement by a co-owner);
section 67 (proceedings for infringement by exclusive licensee);
section 68 (effect of non-registration on infringement proceedings);
section 69 (infringement of rights conferred by publication of application);
section 71 (declaration or declarator as to non-infringement);
section 74 (proceedings in which validity of patent may be put in issue);
section 75 (amendment of a patent in infringement or revocation proceedings).

Enforcement

4. (1) For the purposes of enforcement of a decision or order of the Unified Patent Court—
(a) the decision or order has the same force and effect,
(b) proceedings for or with respect to enforcement of the decision or order may be taken, and
(c) the enforcing court, or in a relevant Northern Ireland case the Enforcement of Judgments Office, has the same powers in relation to the enforcement of the decision or order,

as if the decision or order had originally been made by the enforcing court.

(2) The enforcing court, or in a relevant Northern Ireland case the Enforcement of Judgments Office, may enforce a mediation settlement in the same manner as a judgment or order of the enforcing court.

(3) In this paragraph—

"enforcing court" means—
(a) as respects England and Wales, the High Court,
(b) as respects Scotland, the Court of Session, and
(c) as respects Northern Ireland, the High Court in Northern Ireland;

"mediation settlement" means a settlement reached through mediation using the facilities of the patent mediation and arbitration centre established under Article 35 of the Agreement on a Unified Patent Court;

"relevant Northern Ireland case" means a case where—
(a) the decision or order of the Unified Patent Court would, if it had been given by the High Court in Northern Ireland, or
(b) the mediation settlement would, if enforced in the same manner as a judgment or order of the High Court in Northern Ireland,

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be enforced by the Enforcement of Judgments Office under the Judgments Enforcement (Northern Ireland) Order 1981.

Interpretation

5. In this Schedule—
   (a) "Article 32(1) action" means an action listed in Article 32(1) of the Agreement on a Unified Patent Court;
   (b) "basic patent" has the same meaning as in Article 1(c) of Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6th May 2009 concerning the supplementary protection certificate for medicinal products; and
   (c) "Rules of Procedure" has the same meaning as in the Agreement on a Unified Patent Court.**]**

SCHEDULE 1

Section 127.

Application of 1949 Act to existing patents and applications

1 (1) The provisions of the 1949 Act referred to in sub-paragraph (2) below shall continue to apply on and after the appointed day in relation to existing patents and applications (but not in relation to patents and applications for patents under this Act).

(2) The provisions are sections 1 to 10, 11(1) and (2), 12, 13, 15 to 17, 19 to 21, 22(1) to (3), 23 to 26, 28 to 33, 46 to 53, 55, 56, 59 to 67, 69, 76, 80, 87(2), 92(1), 96, 101, 102(1) and 103 to 107.

(3) Sub-paragraph (1) above shall have effect subject to the following provisions of this Schedule, paragraph 2(b) of Schedule 3 below and the provisions of Schedule 4 below.

2 (1) In section 6 of the 1949 Act, at the end of the proviso to subsection (3) (post-dating of application) there shall be inserted

"and—
(c) no application shall, on or after the appointed day, be postdated under this subsection to a date which is that of the appointed day or which falls after it ""

and there shall be inserted at the end of subsection (4) " ; but no application shall on or after the appointed day be post-dated under this subsection to a date which is that of the appointed day or which falls after it".

(2) At the end of subsection (5) of that section (ante-dating) there shall be inserted " ; but a fresh application or specification may not be filed on or after the appointed day in accordance with this subsection and those rules unless the comptroller agrees that he will direct that the application or specification shall be ante-dated to a date which falls before the appointed day".

Status: *This version of this Act contains provisions that are prospective.*
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Modifications etc. (not altering text)

C30 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

3 (1) This paragraph and paragraph 4 below shall have effect with respect to the duration of existing patents after the appointed day, and in those paragraphs—

(a) "old existing patent" means an existing patent the date of which fell eleven years or more before the appointed day and also any patent of addition where the patent for the main invention is, or was at any time, an old existing patent by virtue of the foregoing provision;

(b) "new existing patent" means any existing patent not falling within paragraph (a) above; and

(c) any reference to the date of a patent shall, in relation to a patent of addition, be construed as a reference to the date of the patent for the main invention.

(2) Sections 23 to 25 of the 1949 Act (extension of patents on grounds of inadequate remuneration and war loss) shall not apply to a new existing patent.

(3) The period for which the term of an old existing patent may be extended under section 23 or 24 of that Act shall not exceed in the aggregate four years, except where an application for an order under the relevant section has been made before the appointed day and has not been disposed of before that day.

4 (1) The term of every new existing patent under section 22(3) of the 1949 Act shall be twenty instead of sixteen years from the date of the patent, but—

(a) the foregoing provision shall have effect subject to section 25(3) to (5) above; and

(b) on and after the end of the sixteenth year from that date a patent shall not be renewed under section 25(3) to (5) above except by or with the consent of the proprietor of the patent.

(2) Where the term of a new existing patent is extended by this paragraph,—

(a) any licence in force under the patent from immediately before the appointed day until the end of the sixteenth year from the date of the patent shall, together with any contract relating to the licence, continue in force so long as the patent remains in force (unless determined otherwise than in accordance with this sub-paragraph), but, if it is an exclusive licence, it shall after the end of that year be treated as a non-exclusive licence;

(b) notwithstanding the terms of the licence, the licensee shall not be required to make any payment to the proprietor for working the invention in question after the end of that year;

(c) every such patent shall after the end of that year be treated as endorsed under section 35 of the 1949 Act (licences of right) **[**[F369], but subject to paragraph 4A below**]**.

(3) Where the term of a new existing patent is extended by this paragraph and any government department or any person authorised by a government department—

(a) has before the appointed day, used the invention in question for the services of the Crown; and

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(b) continues to so use it until the end of the sixteenth year from the date of the patent,

any such use of the invention by any government department or person so authorised, after the end of that year, may be made free of any payment to the proprietor of the patent.

(4) Without prejudice to any rule of law about the frustration of contracts, where any person suffers loss or is subjected to liability by reason of the extension of the term of a patent by this paragraph, the court may on the application of that person determine how and by whom the loss or liability is to be borne and make such order as it thinks fit to give effect to the determination.

Textual Amendments

F369 Words inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), **s. 293**

[F370 4A(1) If the proprietor of a patent for an invention which is a product files a declaration with the Patent Office in accordance with this paragraph, the licences to which persons are entitled by virtue of paragraph 4(2)(c) above shall not extend to a use of the product which is excepted by or under this paragraph.

(2) Pharmaceutical use is excepted, that is—

(a) use as a medicinal product within the meaning of the Medicines Act 1968, and

(b) the doing of any other act mentioned in section 60(1)(a) above with a view to such use.

(3) The Secretary of State may by order except such other uses as he thinks fit; and an order may—

(a) specify as an excepted use any act mentioned in section 60(1)(a) above, and

(b) make different provision with respect to acts done in different circumstances or for different purposes.

(4) For the purposes of this paragraph the question what uses are excepted, so far as that depends on—

(a) orders under section 130 of the Medicines Act 1968 (meaning of "medicinal product"), or

(b) orders under sub-paragraph (3) above,

shall be determined in relation to a patent at the beginning of the sixteenth year of the patent.

(5) A declaration under this paragraph shall be in the prescribed form and shall be filed in the prescribed manner and within the prescribed time limits.

(6) A declaration may not be filed—

(a) in respect of a patent which has at the commencement of section 293 of the Copyright, Designs and Patents Act 1988 passed the end of its fifteenth year; or

(b) if at the date of filing there is—

(i) an existing licence for any description of excepted use of the product, or

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(ii) an outstanding application under section 46(3)(a) or (b) above for the settlement by the comptroller of the terms of a licence for any description of excepted use of the product,

and, in either case, the licence took or is to take effect at or after the end of the sixteenth year of the patent.

(7) Where a declaration has been filed under this paragraph in respect of a patent—

(a) section 46(3)(c) above (restriction of remedies for infringement where licences available as of right) does not apply to an infringement of the patent in so far as it consists of the excepted use of the product after the filing of the declaration; and

(b) section 46(3)(d) above (abatement of renewal fee if licences available as of right) does not apply to the patent.**]**

Textual Amendments

F370 Sch. 1 para. 4A inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), **s. 293**

[[F371]4B(1) An application under section 46(3)(a) or (b) above for the settlement by the comptroller of the terms on which a person is entitled to a licence by virtue of paragraph 4(2)(c) above is ineffective if made before the beginning of the sixteenth year of the patent.

(2) This paragraph applies to applications made after the commencement of section 294 of the Copyright, Designs and Patents Act 1988 and to any application made before the commencement of that section in respect of a patent which has not at the commencement of that section passed the end of its fifteenth year.**]**

(5) No order shall be made on an application under sub-paragraph (4) above which has the effect of imposing a liability on any person other than the applicant unless notification of the application is given to that person.

Textual Amendments

F371 Sch. 1 para. 4B inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), **s. 294**

5 In section 26(3) of the 1949 Act (no patent of addition unless date of filing of complete specification was the same as or later than the date of filing of complete specification in respect of main invention) after "main invention" there shall be inserted "and was earlier than the date of the appointed day".

Modifications etc. (not altering text)

C31 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

6 Notwithstanding anything in section 32(1)(j) of the 1949 Act (ground for revocation that patent was obtained on a false suggestion or representation), it shall not be a ground of revoking a patent under that subsection that the patent was obtained on a false suggestion or representation that a claim of the complete specification of

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the patent had a priority date earlier than the date of filing the application for the patent, but if it is shown—

(a) on a petition under that section or an application under section 33 of that Act; or

(b) by way of defence or on a counterclaim on an action for infringement;

that such a suggestion or representation was falsely made, the priority date of the claim shall be taken to be the date of filing the application for that patent.

7 (1) In section 33 of the 1949 Act (revocation of patent by comptroller), in subsection (1) for the words preceding the proviso there shall be substituted—

"(1) Subject to the provisions of this Act, a patent may, on the application of any person interested, be revoked by the comptroller on any of the grounds set out in section 32(1) of this Act:"

(2) At the end of the said section 33 there shall be added the following subsection:—

"(5) A decision of the comptroller or on appeal from the comptroller shall not estop any party to civil proceedings in which infringement of a patent is in issue from alleging that any claim of the specification is invalid on any of the grounds set out in section 32(1) of this Act, whether or not any of the issues involved were decided in that decision."

Modifications etc. (not altering text)

C32 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

8 In section 101(1) of the 1949 Act (interpretation) there shall be inserted in the appropriate place—

""appointed day"means the day appointed under section 132 of the Patents Act 1977 for the coming into operation of Schedule 1 to that Act;"

Modifications etc. (not altering text)

C33 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

SCHEDULE 2

Section 127.

Application of this Act to Existing Patents and Applications

1 (1) Without prejudice to those provisions of Schedule 4 below which apply (in certain circumstances) provisions of this Act in relation to existing patents and applications, the provisions of this Act referred to in sub-paragraph (2) below shall apply in relation to existing patents and applications on and after the appointed day subject to the following provisions of this Schedule and the provisions of Schedule 4 below.

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

(2) The provisions are sections 22, 23, 25(3) to (5), 28 to 36, 44 to 54, 86, **[**[F372]96**]**, 98, 99, 101 to 105, 107 to 111, 113 to 116, 118(1) to (3), 119 to 124, 130 and 132(2), (3) and (4).

Textual Amendments

F372 The reference to section 96 is repealed (E.W.) by Supreme Court Act 1981 (c. 54, SIF 37), s. 152(4), **Sch. 7**

2 In those provisions as they apply by virtue of this Schedule—

(a) a reference to this Act includes a reference to the 1949 Act;

(b) a reference to a specified provision of this Act other than one of those provisions shall be construed as a reference to the corresponding provision of the 1949 Act (any provision of that Act being treated as corresponding to a provision of this Act if it was enacted for purposes which are the same as or similar to that provision of this Act);

(c) a reference to rules includes a reference to rules under the 1949 Act;

(d) references to a patent under this Act and to an application for such a patent include respectively a reference to an existing patent and application;

(e) references to the grant of a patent under this Act includes a reference to the sealing and grant of an existing patent;

(f) a reference to a patented product and to a patented invention include respectively a reference to a product and invention patented under an existing patent;

(g) references to a published application for a patent under this Act, and to publication of such an application, include respectively references to a complete specification which has been published under the 1949 Act and to publication of such a specification (and a reference to an application for a patent under this Act which has not been published shall be construed accordingly);

(h) a reference to the publication in the journal of a notice of the grant of a patent includes a reference to the date of an existing patent;

(i) a reference to the priority date of an invention includes a reference to the priority date of the relevant claim of the complete specification.

SCHEDULE 3

Section 127.

REPEALS OF PROVISIONS OF 1949 ACT

Modifications etc. (not altering text)

C34 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

1 Subject to the provisions of Schedule 4 below, the provisions of the 1949 Act referred to in paragraph 2 below (which have no counterpart in the new law of

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patents established by this Act in relation to future patents and applications) shall cease to have effect.

2 The provisions are:—

(a) section 14 (opposition to grant of patent) ;

(b) section 32(3) (revocation for refusal to comply with Crown request to use invention) ;

(c) section 41 (inventions relating to food or medicine, etc.) ;

(d) section 42 (comptroller's power to revoke patent after expiry of two years from grant of compulsory licence);

(e) section 71 (extension of time for certain convention applications) ;

(f) section 72 (protection of inventions communicated under international agreements).

SCHEDULE 4

Section 127.

TRANSITIONAL PROVISIONS

General

1 In so far as any instrument made or other thing done under any provision of the 1949 Act which is repealed by virtue of this Act could have been made or done under a corresponding provision of this Act, it shall not be invalidated by the repeals made by virtue of this Act but shall have effect as if made or done under that corresponding provision.

Use of patented invention for services of the Crown

2 (1) Any question whether—

(a) an act done before the appointed day by a government department or a person authorised in writing by a government department amounts to the use of an invention for the services of the Crown; or

(b) any payment falls to be made in respect of any such use (whether to a person entitled to apply for a patent for the invention, to the patentee or to an exclusive licensee);

shall be determined under sections 46 to 49 of that Act and those sections shall apply accordingly.

(2) Sections 55 to 59 above shall apply to an act so done on or after the appointed day in relation to an invention—

(a) for which an existing patent has been granted or an existing application for a patent has been made; or

(b) which was communicated before that day to a government department or any person authorised in writing by a government department by the proprietor of the patent or any person from whom he derives title;

and shall so apply subject to sub-paragraph (3) below, the modifications contained in paragraph 2 of Schedule 2 above and the further modification that sections 55(5)(b) and 58(10) above shall not apply in relation to an existing application.

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(3) Where an act is commenced before the appointed day and continues to be done on or after that day, then, if it would not amount to the use of an invention for the services of the Crown under the 1949 Act, its continuance on or after that day shall not amount to such use under this Act.

Infringement

3 (1) Any question whether an act done before the appointed day infringes an existing patent or the privileges or rights arising under a complete specification which has been published shall be determined in accordance with the law relating to infringement in force immediately before that day and, in addition to those provisions of the 1949 Act which continue to apply by virtue of Schedule 1 above, section 70 of that Act shall apply accordingly.

(2) Sections 60 to 71 above shall apply to an act done on or after the appointed day which infringes an existing patent or the privileges or rights arising under a complete specification which has been published (whether before, on or after the appointed day) as they apply to infringements of a patent under this Act or the rights conferred by an application for such a patent, and shall so apply subject to sub-paragraph (3) below, the modifications contained in paragraph 2 of Schedule 2 above and the further modification that section 69(2) and (3) above shall not apply in relation to an existing application.

(3) Where an act is commenced before the appointed day and continues to be done on or after that day, then, if it would not, under the law in force immediately before that day, amount to an infringement of an existing patent or the privileges or rights arising under a complete specification, its continuance on or after that day shall not amount to the infringement of that patent or those privileges or rights.

Notice of opposition

4 (1) Where notice of opposition to the grant of a patent has been given under section 14 of the 1949 Act before the appointed day, the following provisions shall apply:—

(a) if issue has been joined on the notice before the appointed day, the opposition, any appeal from the comptroller's decision on it and any further appeal shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court;

(b) in any other case, the notice shall be taken to have abated immediately before the appointed day.

(2) Sub-paragraph (1)(a) above shall have effect subject to paragraph 12(2) below.

Secrecy

5 (1) Where directions given under section 18 of the 1949 Act in respect of an existing application (directions restricting publication of information about inventions) are in force immediately before the appointed day, they shall continue in force on and after that day and that section shall continue to apply accordingly.

(2) Where sub-paragraph (1) above does not apply in the case of an existing application section 18 of the 1949 Act shall not apply to the application but section 22 of this Act shall.

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(3) Where the comptroller has before the appointed day served a notice under section 12 of the [M12]Atomic Energy Act 1946 (restrictions on publication of information about atomic energy etc.) in respect of an existing application that section shall continue to apply to the application on and after that day; but where no such notice has been so served that section shall not apply to the application on and after that day.

Marginal Citations

M12 1946 c. 80.

Revocation

6 (1) Where before the appointed day an application has been made under section 33 of the 1949 Act for the revocation of a patent (the original application), the following provisions shall apply:—

(a) if issue has been joined on the application before the appointed day, the application, any appeal from the comptroller's decision on it and any further appeal shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court;

(b) if issue has not been so joined, the original application shall be taken to be an application under section 33 of the 1949 Act for the revocation of the patent on whichever of the grounds referred to in section 32(1) of that Act corresponds (in the comptroller's opinion) to the ground on which the original application was made, or, if there is no ground which so corresponds, shall be taken to have abated immediately before the appointed day.

(2) Sub-paragraph (1)(a) above shall have effect subject to paragraph 11(3) below.

7 (1) This paragraph applies where an application has been made before the appointed day under section 42 of the 1949 Act for the revocation of a patent.

(2) Where the comptroller has made no order before that day for the revocation of the patent under that section, the application shall be taken to have abated immediately before that day.

(3) Where the comptroller has made such an order before that day, then, without prejudice to **[**[F373]section 16(1) or section 17(2)(a) of the [M13]Interpretation Act 1978**]**, section 42 shall continue to apply to the patent concerned on and after that day as if this Act had not been enacted.

Textual Amendments

F373 Words substituted by virtue of Interpretation Act 1978 (c. 30), **s. 25(2)**

Marginal Citations

M13 1978 c. 30.

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Licences of right and compulsory licences

8 (1) Sections 35 to 41 and 43 to 45 of the 1949 Act shall continue to apply on and after the relevant day—

(a) to any endorsement or order made or licence granted under sections 35 to 41 which is in force immediately before that day; and

(b) to any application made before that day under sections 35 to 41.

(2) Any appeal from a decision or order of the comptroller instituted under sections 35 to 41 or 43 to 45 on or after the relevant day (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.

(3) In this paragraph "the relevant day" means, in relation to section 41, the date of the passing of this Act and, in relation to sections 35 to 40 and 43 to 45, the appointed day.

Convention countries

9 (1) Without prejudice to paragraph 1 above, an Order in Council declaring any country to be a convention country for all purposes of the 1949 Act or for the purposes of section 1(2) of that Act and in force immediately before the appointed day shall be treated as an Order in Council under section 90 above declaring that country to be a convention country for the purposes of section 5 above.

(2) Where an Order in Council declaring any country to be a convention country for all purposes of the 1949 Act or for the purposes of section 70 of that Act is in force immediately before the appointed day, a vessel registered in that country (whether before, on or after that day) shall be treated for the purposes of section 60 above, as it applies by virtue of paragraph 3(2) above to an existing patent or existing application, as a relevant ship and an aircraft so registered and a land vehicle owned by a person ordinarily resident in that country shall be so treated respectively as a relevant aircraft and a relevant vehicle.

Appeals from court on certain petitions for revocation

10 Where the court has given judgment on a petition under section 32(1)(j) of the 1949 Act before the appointed day, any appeal from the judgment (whether instituted before, on or after that day) shall be continued or instituted and be disposed of under the old law.

Appeals from comptroller under continuing provisions of 1949 Act

11 (1) In this paragraph "the continuing 1949 Act provisions" means the provisions of the 1949 Act which continue to apply on and after the appointed day as mentioned in paragraph 1 of Schedule 1 above.

(2) This paragraph applies where—

(a) the comptroller gives a decision or direction (whether before or on or after the appointed day) under any of the continuing 1949 Act provisions, and

(b) an appeal lies under those provisions from the decision or direction;

but this paragraph applies subject to the foregoing provisions of this Schedule.

(3) Where such an appeal has been instituted before the Appeal Tribunal before the appointed day, and the hearing of the appeal has begun but has not been completed

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before that day, the appeal (and any further appeal) shall be continued and disposed of under the old law.

(4) Where such an appeal has been so instituted, but the hearing of it has not begun before the appointed day, it shall be transferred by virtue of this sub-paragraph to the Patents Court on that day and the appeal (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.

(5) Any such appeal instituted on or after the appointed day shall lie to the Patents Court or, where the proceedings appealed against were held in Scotland, the Court of Session; and accordingly, the reference to the Appeal Tribunal in section 31(2) of the 1949 Act shall be taken to include a reference to the Patents Court or (as the case may be) the Court of Session.

(6) Section 97(3) of this Act shall apply to any decision of the Patents Court on an appeal instituted on or after the appointed day from a decision or direction of the comptroller under any of the continuing 1949 Act provisions as it applies to a decision of that Court referred to in that subsection, except that for references to the sections mentioned in paragraph (a) of that subsection there shall be substituted references to sections 33, 55 and 56 of the 1949 Act.

Appeals from comptroller under repealed provisions of 1949 Act

12 (1) This paragraph applies where an appeal to the Appeal Tribunal has been instituted before the appointed day under any provision of the 1949 Act repealed by this Act.

(2) Where the hearing of such an appeal has begun but has not been completed before that day,the appeal (and any further appeal) shall be continued and disposed of under the old law.

(3) Where the hearing of such an appeal has not begun before that day, it shall be transferred by virtue of this sub-paragraph to the Patents Court on that day and the appeal (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.

Appeals from Appeal Tribunal to Court of Appeal

13 Section 87(1) of the 1949 Act shall continue to apply on and after the appointed day to any decision of the Appeal Tribunal given before that day, and any appeal by virtue of this paragraph (and any further appeal) shall be prosecuted under the old law.

Rules

14 The power to make rules under section 123 of this Act shall include power to make rules for any purpose mentioned in section 94 of the 1949 Act.

Supplementary

15 Section 97(2) of this Act applies to—

(a) any appeal to the Patents Court by virtue of paragraph 4(1)(a), 6(1)(a), 8(2) or 11(5) above, and

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(b) any appeal which is transferred to that Court by virtue of paragraph 11(4) or 12(3) above,

as it applies to an appeal under that section; and section 97 of this Act shall apply for the purposes of any such appeal instead of section 85 of the 1949 Act.

16 In this Schedule "the old law" means the 1949 Act, any rules made under it and any relevant rule of law as it was or they were immediately before the appointed day.

17 For the purposes of this Schedule—

(a) issue is joined on a notice of opposition to the grant of a patent under section 14 of the 1949 Act when the applicant for the patent files a counter-statement fully setting out the grounds on which the opposition is contested;

(b) issue is joined on an application for the revocation of a patent under section 33 of that Act when the patentee files a counter-statement fully setting out the grounds on which the application is contested.

18 (1) Nothing in the repeals made by this Act in sections 23 and 24 of the 1949 Act shall have effect as respects any such application as is mentioned in paragraph 3(3) of Schedule 1 above.

(2) Nothing in the repeal by this Act of the [M14]Patents Act 1957 shall have effect as respects existing applications.

(3) Section 69 of the 1949 Act (which is not repealed by this Act) and section 70 of that Act (which continues to have effect for certain purposes by virtue of paragraph 3 above) shall apply as if section 68 of that Act has not been repealed by this Act and as if paragraph 9 above had not been enacted.

Marginal Citations

M14 1957 c. 13.

[[F374]SCHEDULE 4A

SUPPLEMENTARY PROTECTION CERTIFICATES

Textual Amendments

F374 Sch. 4A inserted (17.12.2007) by The Patents (Compulsory Licensing and Supplementary Protection Certificates) Regulations 2007 (S.I. 2007/3293), regs. 1(2), **2(3)**

References to patents etc

1. (1) In the application to supplementary protection certificates of the provisions of this Act listed in sub-paragraph (2)—

(a) references to a patent are to a supplementary protection certificate;

(b) references to an application or the applicant for a patent are to an application or the applicant—

(i) for a supplementary protection certificate, or

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(ii) for an extension of the duration of a supplementary protection certificate;

(c) references to the proprietor of a patent are to the holder of a supplementary protection certificate;

(d) references to the specification of a patent are to the text of a supplementary protection certificate;

(e) references to a patented product or an invention (including a patented invention) are to a product for which a supplementary protection certificate has effect;

(f) references to a patent having expired or having been revoked are to a supplementary protection certificate having lapsed or having been declared invalid;

(g) references to proceedings for the revocation of a patent are to proceedings—

(i) for a decision that a supplementary protection certificate has lapsed, or

(ii) for a declaration that a supplementary protection certificate is invalid;

(h) references to the issue of the validity of a patent include the issue of whether a supplementary protection certificate has lapsed or is invalid.

(2) The provisions referred to in sub-paragraph (1) are—

section 14(1), (9) and (10) (making of application);

section 19(1) (general power to amend application before grant);

sections 20A and 20B (reinstatement of applications);

section 21 (observations by third party on patentability);

section 27 (general power to amend specification after grant);

section 29 (surrender of patents);

sections 30 to 36, 37(1) to (3) and (5) to (9) and 38 (property in patents and applications, and registration);

sections 39 to 59 (employees' inventions, licences of right and compulsory licences and use of patented inventions for services of the Crown);

sections 60 to 71 (infringement);

section 74(1) and (7) (proceedings in which validity of patent may be put in issue);

[[F375] sections 74A and 74B (opinions by the Patent Office);**]**

section 75 (amendment of patent in infringement or revocation proceedings);

sections 103 and 105 (privilege for communications relating to patent proceedings);

section 108 (licences granted by order of comptroller);

sections 110 and 111 (unauthorised claim of patent rights or that patent has been applied for);

section 116 (immunity of department as regards official acts);

sections 117 to 118 (administrative provisions);

section 123 (rules);

section 130 (interpretation).

2. (1) In the case of the provisions of this Act listed in sub-paragraph (2), paragraph 1 applies in relation to an application for a supplementary protection certificate only if the basic patent expires before the certificate is granted.

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(2) The provisions referred to in sub-paragraph (1) are—

section 20B(3) to (6A) (effect of reinstatement under section 20A);

section 55(5) and (7) (use of patented inventions for services of the Crown);

section 58(10) (disputes as to Crown use);

section 69 (infringement of rights conferred by publication of application);

section 117A(3) to (7) (effect of resuscitating a withdrawn application under section 117).

Textual Amendments

F375 Words in Sch. 4A para. 1(2) inserted (1.10.2014) by Intellectual Property Act 2014 (c. 18), **ss. 16(3)**, 24(1); S.I. 2014/2330, art. 3, Sch.

References to this Act etc

3. (1) In the provisions of this Act listed in sub-paragraph (2)—

(a) references to this Act include the Medicinal Products Regulation and the Plant Protection Products Regulation, and

(b) references to a provision of this Act include any equivalent provision of the Medicinal Products Regulation and the Plant Protection Products Regulation.

(2) The provisions referred to in sub-paragraph (1) are—

sections 20A and 20B (reinstatement of applications);

section 21 (observations by third party on patentability);

section 69 (infringement of rights conferred by publication of application);

section 74(1) and (7) (proceedings in which validity of patent may be put in issue);

sections 97 to 99B, 101 to 103, 105 and 107 (legal proceedings);

section 116 (immunity of department as regards official acts);

sections 117 and 118 to 121 (administrative provisions);

section 122 (Crown's right to sell forfeited articles);

section 123 (rules);

section 124A (use of electronic communications);

section 130 (interpretation).

Other references

4. (1) In the application of section 21(1) (observations by third party on patentability) to supplementary protection certificates, the reference to the question whether the invention is a patentable invention is to the question whether the product is one for which a supplementary protection certificate may have effect.

(2) In the application of section 69(2) (conditions for infringement of rights conferred by publication of application) to supplementary protection certificates, the condition in paragraph (b) is that the act would, if the certificate had been granted on the date of the publication of the application, have infringed not only the certificate as granted but also the certificate for which the application was made.

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Fees

5. A supplementary protection certificate does not take effect unless—
   (a) the prescribed fee is paid before the end of the prescribed period, or
   (b) the prescribed fee and any prescribed additional fee are paid before the end of the period of six months beginning immediately after the prescribed period.

Interpretation

6. (1) Expressions used in this Act that are defined in the Medicinal Products Regulation or the Plant Protection Products Regulation have the same meaning as in that Regulation.

   (2) References in this Act to, or to a provision of, the Medicinal Products Regulation or the Plant Protection Products Regulation are to that Regulation or that provision as amended from time to time.

7. In this Act—
   (a) "the Medicinal Products Regulation" means **[**[F376]Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6th May 2009 concerning the supplementary protection certificate for medicinal products**]**, and
   (b) "the Plant Protection Products Regulation" means Regulation (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products.

Textual Amendments

F376 Words in Sch. 4A para. 7(a) substituted (1.10.2014) by The Patents (Supplementary Protection Certificates) Regulations 2014 (S.I. 2014/2411), regs. 1(2), **2(3)(a)**

Transitional provision

[[F377]8. (1) A reference (express or implied) in this Act to the Medicinal Products Regulation, or a provision of it, is to be read as being or (subject to context) including a reference to the old Regulation, or the corresponding provision of the old Regulation, in relation to times, circumstances or purposes in relation to which the old Regulation, or that provision, had effect.

   (2) Other than in relation to times, circumstances or purposes referred to in subparagraph (1), anything done, or having effect as if done, under (or for the purposes of or in reliance on) the old Regulation or a provision of the old Regulation and in force or effective immediately before 1st October 2014 (the day on which the Patents (Supplementary Protection Certificates) Regulations 2014 came into force) has effect on or after that date for the purposes of this Act as if done under (or for the purpose of or in reliance on) the Medicinal Products Regulation or the corresponding provision of it.

   (3) In this paragraph "the old Regulation" means Council Regulation (EEC) No 1768/92 of 18th June 1992 concerning the creation of a supplementary protection certificate for medicinal products.**]]**

Status: *This version of this Act contains provisions that are prospective.*
Changes to legislation: *Patents Act 1977 is up to date with all changes known to be in force on or before 21 October 2020. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes*

Textual Amendments

F377 Sch. 4A para. 8 and cross-heading inserted (1.10.2014) by The Patents (Supplementary Protection Certificates) Regulations 2014 (S.I. 2014/2411), regs. 1(2), **2(3)(b)**

SCHEDULE 5

Section 132.

CONSEQUENTIAL AMENDMENTS

1, 2. . . . . **F378**

Textual Amendments

F378 Sch. 5 paras 1, 2 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

[**F379**3 In sections 42 and 44(1) of the Registered Designs Act 1949, for "the Patents Act 1949" there shall be substituted, in each case, "the Patents Act 1977".]

Textual Amendments

F379 Sch. 5 para. 3 repealed in part by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(2), **Sch. 8**

Defence Contracts Act 1958 (c. 38)

4 In subsection (4) of section 4 of the Defence Contracts Act 1958, for the words from "Patents Act 1949" to the end there shall be substituted "Patents Act 1977".

Modifications etc. (not altering text)

C35 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

Administration of Justice Act 1970 (c. 31)

5 (1) In subsections (2) and (3) of section 10 of the Administration of Justice Act 1970 for "either" there shall be substituted in each case, "the".

(2) In subsection (4) of the said section 10, for "(as so amended)" there shall be substituted "(as amended by section 24 of the Administration of Justice Act 1969)".

(3) For subsection (5) of the said section 10, there shall be substituted :—

"(5) In subsection (8) of the said section 28 (which confers power on the Tribunal to make rules about procedure etc.), there shall be inserted at end of the subsection the words "including right of audience"."

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Modifications etc. (not altering text)

C36 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

Atomic Energy Authority (Weapons Group) Act 1973 (c. 4)

6 In section 5(2) of the Atomic Energy Authority (Weapons Group) Act 1973—

(a) after the first "Patents Act 1949"there shall be inserted ", the Patents Act 1977" ; and

(b) after the second "Patents Act 1949" there shall be inserted "section 55(4) of the Patents Act 1977".

Modifications etc. (not altering text)

C37 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

7, 8. . . . . **F380**

Textual Amendments

F380 Sch. 5 paras. 7, 8 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), and Sch. 5 para. 7 expressed to be repealed (prosp.) by Enterprise Act 2002 (c. 40), ss. 278, 279, **Sch. 26**

SCHEDULE 6

Section 132.

ENACTMENTS REPEALED

Modifications etc. (not altering text)

C38 The text of ss. 127(5), 132(6),(7); Sch. 1 para. 2(1),(2), 5, 7(1)(2), 8; Sch. 3; Sch. 5 paras 4, 5(1), (2), (3), 6; Sch. 6 is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

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Chapter	Short Title	Extent of Repeal
7 Edw. 7. c. 29.	The Patents and Designs Act 1907.	Section 47(2).
9 & 10 Geo. 6. c. 80.	The Atomic Energy Act 1946.	In section 12, subsections (1) to (7).
12, 13 & 14 Geo. 6. c. 87.	The Patents Act 1949.	Section 11(3). Section 14. Section 16(6). Section 18. Section 22(4) and (5). In section 23(1), the words from "(not exceeding" to "ten years)". In section 24, in subsection (1), the words "(not exceeding ten years)" and, in subsection (7), the words from "but" to the end. Section 27. In section 32, subsection (3). In section 33(3), the proviso. Sections 34 to 45. Sections 54, 57 and 58. Section 68. Sections 70 to 75. Sections 77 to 79. Sections 81 to 86. Section 87(1) and (3). Sections 88 to 91. Sections 93 to 95. Sections 97 to 100. Section 102(2). Schedule 1. Schedule 3, except paragraphs 1 and 26.
5 & 6 Eliz. 2. c. 13.	The Patents Act 1957.	The whole Act, except in relation to existing applications.

Chapter	Short Title	Extent of Repeal
9 & 10 Eliz. 2. c. 25.	The Patents and Designs (Renewals, Extensions and Fees) Act 1961.	In section 1(1), the words from "subsection (5)" to "and in". Section 2.
10 & 11 Eliz. 2. c. 30.	The Northern Ireland Act 1962.	In Schedule 1, the entry relating to section 84 of the Patents Act 1949.
1967 c. 80.	The Criminal Justice Act 1967.	In Schedule 3, in Parts I and IV, the entries relating to the Patents Act 1949.
1968. c. 64.	The Civil Evidence Act 1968.	Section 15.
1969 c. 58.	The Administration of Justice Act 1969.	In section 24, in subsection (1), the words "85 of the Patents Act 1949 and section" and "each of", in subsections (2), (3) and (4) the words "of each of those sections" and in subsection (4) the words from "as subsection (11)" to "and" and the words "in the case of the said section 28".
1970 c. 31.	The Administration of Justice Act 1970.	In section 10, in subsection (1), the words "Patents Appeal Tribunal or the" and in subsection (4), the words from "the Patents Appeal" to "and".
1971 c. 23.	The Courts Act 1971.	Section 46.
1971 c. 36 (N.I.)	The Civil Evidence Act (Northern Ireland) 1971.	Section 11.
1973 c. 41.	The Fair Trading Act 1973.	Section 126. In Schedule 3, in paragraph 16(2), the words from "of section 40" to "Commission)", where first occurring. In Schedule 12, the entry relating to the Patents Act 1949.
1974 c. 47.	The Solicitors Act 1974.	In Schedule 3, paragraph 3.

Status:
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Changes to legislation:
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View outstanding changes

Changes and effects yet to be applied to :

- s. 50A heading words inserted by S.I. 2019/93, Sch. 1 para. B1(5) (as inserted) by S.I. 2019/1245 reg. 16 (This amendment not applied to legislation.gov.uk. The affecting statutory instrument has no legal effect. It was made under a procedure which meant that it ceased to have effect 28 days after signing unless it was debated and approved in Parliament within that time. It was not debated and approved within 28 days, so it has expired with no effect.)
- s. 128A heading words substituted by S.I. 2019/801 reg. 3(a) (This amendment not applied to legislation.gov.uk. Reg. 3(a)(b) substituted immediately before IP completion day by S.I. 2020/1050, regs. 1(2), 27)
- s. 128A heading words substituted by S.I. 2019/801, reg. 3(a) (as substituted) by S.I. 2020/1050 reg. 27
- s. 50A(1) word inserted by S.I. 2019/93, Sch. 1 para. B1(2)(a) (as inserted) by S.I. 2019/1245 reg. 16 (This amendment not applied to legislation.gov.uk. The affecting statutory instrument has no legal effect. It was made under a procedure which meant that it ceased to have effect 28 days after signing unless it was debated and approved in Parliament within that time. It was not debated and approved within 28 days, so it has expired with no effect.)
- s. 50A(1) words inserted by S.I. 2019/93, Sch. 1 para. B1(2)(b) (as inserted) by S.I. 2019/1245 reg. 16 (This amendment not applied to legislation.gov.uk. The affecting statutory instrument has no legal effect. It was made under a procedure which meant that it ceased to have effect 28 days after signing unless it was debated and approved in Parliament within that time. It was not debated and approved within 28 days, so it has expired with no effect.)
- s. 50A(5)(a) words inserted by S.I. 2019/93, Sch. 1 para. B1(3) (as inserted) by S.I. 2019/1245 reg. 16 (This amendment not applied to legislation.gov.uk. The affecting statutory instrument has no legal effect. It was made under a procedure which meant that it ceased to have effect 28 days after signing unless it was debated and approved in Parliament within that time. It was not debated and approved within 28 days, so it has expired with no effect.)
- s. 50A(7) word inserted by S.I. 2019/93, Sch. 1 para. B1(4) (as inserted) by S.I. 2019/1245 reg. 16 (This amendment not applied to legislation.gov.uk. The affecting statutory instrument has no legal effect. It was made under a procedure which meant that it ceased to have effect 28 days after signing unless it was debated and approved in Parliament within that time. It was not debated and approved within 28 days, so it has expired with no effect.)
- s. 56(4)(a)(i) words omitted by S.I. 2006/1056 Sch. para. 2(a) (This amendment comes into force on the day on which 2005 asp 13, s. 20 comes into force, see art. 1(2)(b))
- s. 62(3)(a) words in s. 62(3) renumbered as s. 62(3)(a) by 2004 c. 16 s. 2(3) (Amendment not applied to legislation.gov.uk. S. 2(3) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)
- s. 62(3)(b) and word inserted by 2004 c. 16 s. 2(3) (Amendment not applied to legislation.gov.uk. S. 2(3) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)

- s. 128A(1) words substituted by S.I. 2019/801 reg. 3(b) (This amendment not applied to legislation.gov.uk. Reg. 3(a)(b) substituted immediately before IP completion day by S.I. 2020/1050, regs. 1(2), 27)
- s. 128A(1) words substituted by S.I. 2019/801, reg. 3(b) (as substituted) by S.I. 2020/1050 reg. 27
- s. 128A(2) words substituted by S.I. 2019/801 reg. 3(c)(i)
- s. 128A(2) words substituted by S.I. 2019/801 reg. 3(c)(ii)
- s. 128A(5) words substituted by S.I. 2019/801 reg. 3(d)
- Sch. A1 para. 1 words inserted by S.I. 2019/801 reg. 4 (This amendment not applied to legislation.gov.uk. Reg. 4 omitted immediately before IP completion day by virtue S.I. 2020/1050, regs. 1(2), 28)
- Sch. A1 para. 1 words omitted by S.I. 2020/1050 reg. 39(a)
- Sch. A1 para. 3(3) words substituted by S.I. 2020/1050 reg. 39(b)
- Sch. A1 para. 4 words substituted by S.I. 2020/1050 reg. 39(c)
- Sch. 5 para. 7 repealed by 2002 c. 40 Sch. 26 (This amendment not applied to legislation.gov.uk. Sch. 5 para. 7 already repealed by by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), Sch. 8; S.I. 1990/2168, art. 2 (with art. 3))
- Sch. 5 para. 5 repealed by 2007 c. 15 Sch. 23 Pt. 6

Changes and effects yet to be applied to the whole Act associated Parts and Chapters:

- Act amendment to earlier affecting provision S.I. 2013/2602, art. 2, Sch. by S.I. 2019/1327 art. 2

Whole provisions yet to be inserted into this Act (including any effects on those provisions):

- s. 56(4)(a)(iiia) and word added by S.I. 2006/1056 Sch. para. 2(b) (This amendment comes into force on the day on which 2005 asp 13, s. 20 comes into force, see art. 1(2)(b))
- s. 63(3)(a) words in s. 63(3) renumbered as s. 63(3)(a) by 2004 c. 16 s. 2(4) (Amendment not applied to legislation.gov.uk. S. 2(4) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)
- s. 63(3)(b) and word inserted by 2004 c. 16 s. 2(4) (Amendment not applied to legislation.gov.uk. S. 2(4) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)