



Patents Act 1977

1977 CHAPTER 37

PART III

MISCELLANEOUS AND GENERAL

Legal Proceedings

[^{F1}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 ^{M1}Supreme 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

F1 S. 96 repealed (E.W.) by [Supreme Court Act 1981 \(c. 54, SIF 37\)](#), s. 152(4), [Sch. 7](#)

Marginal Citations

M1 [1925 c. 49](#).

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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;
 - (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 [^{F2}the Lord Chief Justice of England and Wales after consulting the Lord Chancellor] ; [^{F3}and the Patents Court shall not be treated as a divisional court for the purposes of section 31(1) (f) of the ^{M2}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.
- [^{F4}(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

- F2** 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\(e\)](#)
- F3** S. 97(2): from “and” onwards repealed (E.W.) by [Supreme Court Act 1981 \(c. 54, SIF 37\)](#), [Sch. 7](#)
- F4** [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\(e\)](#)

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Marginal Citations

M2 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.
- (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 [^{F5}Treasury] and shall be defrayed out of moneys provided by Parliament.

Textual Amendments

F5 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.

[^{F6}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

F6 Ss. 99A, 99B inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 295, [Sch. 5 para. 26](#)

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[^{F7}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.]

Textual Amendments

F7 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.

[^{F8}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.

[For the purposes of subsection (2), as it has effect in relation to England and Wales,
^{F9}(2A) “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.]

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(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.

[^{F10}(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.]

Textual Amendments

- F8** S. 102, 102A substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 27](#)
- F9** 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)
- F10** 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)

^{F12}[^{F11}**102A** **Right of audience, &c. in proceedings on appeal from the comptroller.**

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Textual Amendments

- F11** S. 102, 102A substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 27](#)
- F12** 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

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“the relevant conventions” means the European Patent Convention,^{F13}...
and the Patent Co-operation Treaty.

(3) This section shall not extend to Scotland.

Extent Information

E1 S. 103 does not extend to Scotland, the Channel Islands nor the Colonies.

Textual Amendments

F13 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)

C1 S. 103 amended (E.W.) (1.1.1992) by S.I. 1991/2684, arts. 2, 4, 5, **Sch.1**.

C2 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.

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Textual Amendments

F14 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.

[^{F15}(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.]

[^{F16}(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,^{F17}...
and the Patent Co-operation Treaty.]

Textual Amendments

F15 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**

F16 S. 105(2) inserted by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), s. 303(1), **Sch. 7 para. 21**

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F17 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 ^{F18}

(1) In [^{F19}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 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.

[^{F20}(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 [^{F21}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 [^{F22}rules of court] .

Textual Amendments

F18 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)

F19 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)

F20 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)

F21 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)

F22 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 [^{F23}the county court] so orders, be recoverable [^{F24}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 [^{F25}a recorded decree arbitral][^{F25}an extract registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland.]

[^{F26}(4) The comptroller may make an order for security for costs or expenses against any party to proceedings before him under this Act if—

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- (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.

Textual Amendments

- F23** 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)
- F24** 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)
- F25** 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](#)
- F26** 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.

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Changes and effects yet to be applied to the whole Act associated Parts and Chapters:

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)