

SCHEDULES

SCHEDULE 5

PATENTS: MISCELLANEOUS AMENDMENTS

Application for restoration of lapsed patent

- 6 (1) Section 28 of the Patents Act 1977 (restoration of lapsed patents) is amended as follows.
- (2) For subsection (1) (application for restoration within period of one year) substitute—
- “ (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.”.
- (3) After subsection (2) insert—
- “(2A) Notice of the application shall be published by the comptroller in the prescribed manner.”.
- (4) In subsection (3), omit paragraph (b) (requirement that failure to renew is due to circumstances beyond proprietor’s control) and the word “and” preceding it.
- This amendment does not apply to a patent which has ceased to have effect in accordance with section 25(3) of the Patents Act 1977 (failure to renew within prescribed period) and in respect of which the period referred to in subsection (4) of that section (six months’ period of grace for renewal) has expired before commencement.
- (5) Omit subsections (5) to (9) (effect of order for restoration).
- 7 After that section insert—

“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.

Status: This is the original version (as it was originally enacted).

- (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.
- (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.”.

8

In consequence of the above amendments—

- (a) in section 60(6)(b) of the Patents Act 1977, for “section 28(6)” substitute “section 28A(4) or (5)”; and
- (b) in sections 77(5), 78(6) and 80(4) of that Act, for the words from “section 28(6)” to the end substitute “section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly.”.