

PATENTS ACT 2004

EXPLANATORY NOTES

COMMENTARY ON SECTIONS

Section 2 – Amendment of patents after grant

24. Sections 27(1) and 75(1) confer on the comptroller and the court a discretion to allow or refuse an amendment to a patent. Article 138(3) EPC 2000 requires contracting states to enable a patent proprietor to amend his patent by limiting the claims in national proceedings for revocation of the patent. Article 105a(1) EPC 2000 confers on the EPO a discretion to allow or refuse an amendment of a European patent by limitation of the claims. The comptroller and the court continue to have a discretion to allow or refuse an amendment, but in exercising that discretion, *subsection (5)* requires the comptroller or court to have regard to any relevant principles which are applicable in amendment or limitation proceedings under the EPC. These may include relevant regulations made under the EPC, any relevant guidelines produced by the EPO, and decisions of the Opposition Division and Boards of Appeal. This should ensure that, as far as possible, there is consistency in approach as regards post-grant amendment in national proceedings and before the EPO.
25. *Subsection (5)* therefore applies to all types of amendment made during any proceedings in which validity may be put in issue (note also the change to section 75 made by *Schedule 2 paragraph 19*). Furthermore, *subsection (1)* makes clear that the new regime applies equally to voluntary amendments under section 27 – that is, amendments proposed by the patent proprietor when no proceedings are under way. This is also intended to ensure closer conformity of approach between amendment under section 27 and the new procedure under EPC 2000 for limitation at the EPO.
26. *Subsections (3) and (4)* amend sections 62 and 63 in order to protect third parties from patent proprietors who act covetously. Under section 62(3) as amended, where a patent proprietor has amended his patent and sues for a pre-amendment infringement, the courts or comptroller may not award damages for that infringement unless they are satisfied that the proprietor is acting in good faith in bringing the infringement proceedings. Therefore, damages may not be awarded if it were shown that the proprietor knew that the infringed claim, before amendment, was invalid. However, damages would be available for infringing acts committed after the amendment was allowed. Similarly, under section 63(2) as amended, damages will only be available for a partially valid patent if the court or comptroller is satisfied that the proprietor has acted in good faith in bringing the infringement proceedings. Therefore damages will not be available if it can be shown that the proprietor knew that the infringed claim was only partially valid.
27. *Subsection (2)* makes the corresponding changes to section 58(6) and (8). These provisions are equivalent to sections 62(3) and 63(2), but apply to Crown use instead of infringement.