



RESEARCH PAPER 04/41

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# *The Patents Bill* [HL]

[Bill 90 of 2003-04]

The Patents Bill was introduced to the House of Lords on 15 January 2004. It would amend the *Patents Act 1977* and implement, in UK law, changes to the 1973 European Patent Convention agreed in 2000.

The Bill would also make other changes to the *Patents Act 1977* that have been indicated as necessary or recommended through consultation by the Patent Office.

The Bill has been considered in the House of Lords. It was passed to the House of Commons on 6 April 2004 and is due to have its Second Reading on 7 June 2004.

The provisions of the Bill would have the same extent as the *Patents Act 1977*, that is, the United Kingdom (including the Isle of Man). It would apply to acts done in an area designated by order under section 1(7) of the *Continental Shelf Act 1964* or specified by order under section 10(8) of the *Petroleum Act 1998*.

Stephen McGinness

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## Summary of main points

The primary legislation in the UK dictating the use of patents is the *Patents Act 1977*. This legislation reflects not only UK policy but those areas required, through international agreements, to co-ordinate with foreign patent legislation.

The European Patent Convention (EPC) was amended in Munich in 2000 and the 1977 Act needs to be amended to reflect changes made to that Convention. The Bill would make the necessary amendments to the Act.

The changes proposed would:

- disallow the patenting of methods of treatment or diagnosis in a clearer way;
- ensure that, when considering amendments to patents after grant, the comptroller or court would have regard to any relevant principles which are applicable in amendment or limitation proceedings under the EPC;
- allow relief to be granted for infringement, or Crown use, of a partially valid patent on condition that the proprietor of a European patent (UK) limits the patent satisfactorily at the European Patent Office; and
- allow a court or the comptroller to order revocation of a European patent found to be partially invalid unless the proprietor limits his patent at the European Patent Office.

The Patent Office has consulted about various aspects of the *Patents Act 1977* and the Bill would resolve some of the issues raised in those consultations. These changes include:

- relaxing restrictions on applications abroad by United Kingdom residents;
- improving provision for the compensation of employees whose inventions confer outstanding benefits to their company;
- allowing the Patent Office to issue opinions with regard to the validity or infringement of patents.

The Bill and the Explanatory Notes are available at:

<http://www.publications.parliament.uk/pa/cm200304/cmbills/090/2004090.htm>



## CONTENTS

<b>I</b>	<b>Intellectual Property</b>	<b>7</b>
<b>II</b>	<b>Patents</b>	<b>8</b>
	<b>A. Patents Legislation</b>	<b>11</b>
	<b>B. Costs of Patenting</b>	<b>13</b>
	<b>C. International Patents</b>	<b>14</b>
	<b>D. European Patent Convention</b>	<b>17</b>
<b>III</b>	<b>The <i>Patents Bill 2003-04</i> in the House of Lords</b>	<b>20</b>
	<b>A. Second Reading</b>	<b>20</b>
	<b>B. Committee Stage</b>	<b>23</b>
	<b>C. Report and Third Reading</b>	<b>25</b>
	<b>D. Other Comment</b>	<b>27</b>
<b>IV</b>	<b><i>Regulatory Reform (Patents) Order 2004</i></b>	<b>29</b>
<b>V</b>	<b>How the Bill would amend the Patents Act 1977</b>	<b>31</b>



# I Intellectual Property

For any company, ideas (or intellectual property) are an important part of their success. In the absence of protective legislation, the best way to protect those ideas is to keep them secret. Nation states have a vested interest in making sure that technology is widely dispersed to promote their development and competitive interests. Patents have developed as a contract between nation states and innovators. The patent provides a time-limited monopoly (otherwise seen to be a bad thing) to the innovator in return for making the knowledge public.

The importance of intellectual property was highlighted by a statement from Ian Harvey, chief executive of the British Technology Group (BTG):

Intellectual property is one of the few ways that you can differentiate a product and enforce its uniqueness. Competing on price or first-mover advantage are ephemeral in comparison.<sup>1</sup>

The Times article goes on to explain how one of the organisations (the National Research Development Corporation, NRDC) that was to become BTG was created, in 1949, to patent and commercialise inventions springing from government research and universities.<sup>2</sup> The company was privatised in 1992 and currently its portfolio includes 330 products protected by over 5000 patents. BTG makes money by licensing the rights to those patents.

The problem of protecting intellectual property has become very important as far as scientific research is concerned. The Medical Research Council (MRC) failed to protect its intellectual property with respect to monoclonal antibodies.<sup>3</sup> In response, the MRC has generated a new company that will exploit further breakthroughs made by research programmes it has funded.<sup>4</sup> It is now rare to find a university that does not have a policy in place for the exploitation of intellectual property of such research.

The DTI hosts a website on the subject of intellectual property (IP) which introduces the subject:

**Intellectual property**, often known as IP, allows people to own their creativity and innovation in the same way that they can own physical property. The owner

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<sup>1</sup> “Little-understood BTG aims to harness profit power of ideas”, *The Times*, 23 October 2000

<sup>2</sup> A driving force in establishing the NRDC was recognition of the loss of revenue to the UK caused by the Medical Research Council declining Professor Howard Florey's proposal to patent penicillin. The Government set up the NRDC to provide a mechanism for the licensing of intellectual property.

<sup>3</sup> A biotechnological breakthrough that is now widely used in medicines and testing kits and would have provided substantial royalties to the MRC.

<sup>4</sup> “MRC pulls it all together”, *Financial Times*, 8 February 2000

of IP can control and be rewarded for its use and this encourages further innovation and creativity to the benefit of us all.

In some cases, IP gives rise to protection for ideas but in other areas, there will have to be more elaboration of an idea before protection can arise. It will often not be possible to protect IP and gain IP rights (or IPRs) unless they have been applied for and granted, but some IP protection such as copyright arises automatically, without any registration, as soon as there is a record in some form of what has been created.

The four main types of IP are:

- ***patents for inventions*** - new and improved products and processes that are capable of industrial application
- ***trade marks for brand identity*** - of goods and services allowing distinctions to be made between different traders
- ***designs for shape and appearance*** - either functional or aesthetically pleasing articles or surface decoration, pattern or ornament
- ***copyright for material*** - literary and artistic material, music, films, sound recordings and broadcasts, including software and multimedia

However, IP is much broader than this extending to trade secrets, plant varieties, geographical indications, performers rights and so on. To understand exactly what can be protected by IP, you will need to check the four main areas of copyright, designs, patents and trade marks as well as other IP. Often, more than one type of IP may apply to the same creation.<sup>5</sup>

## II Patents

### **What is a patent?**

A patent gives an inventor the right for a limited period to stop others from making, using or selling an invention without the permission of the inventor.

Patents are generally interested in functional and technical aspects of products and processes, and must fulfil specific conditions to be granted.

Most patents are for incremental improvements in known technology - evolution rather than revolution. The technology does not have to be complex.

Patent rights are territorial; a UK patent does not give rights outside of the UK. Patent rights last for up to 20 years in the UK.<sup>6</sup>

The subject of patents, while easily summarised, contains many difficulties in the detail of administering the process. The Patent Office<sup>7</sup> provides detailed guidance on various

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<sup>5</sup> <http://www.intellectual-property.gov.uk/std/faq/question1.htm>

<sup>6</sup> <http://www.intellectual-property.gov.uk/std/faq/patents/what.htm>



aspects of intellectual property, on trade marks,<sup>8</sup> copyright<sup>9</sup> and design<sup>10</sup> as well as comprehensive detail on patents.<sup>11</sup>

The use of patents to protect intellectual property has been rising, applications in the UK rose by over 2% between 2000 and 2001.<sup>12</sup> It has, however, been indicated that UK small to medium size enterprises (SMEs) are using patents less than similar companies in other countries:<sup>13</sup>

Bottom of the pile for patent enthusiasm was the UK, where only 23 per cent had used the system. In contrast, more than half the Spanish SMEs were using patents.<sup>14</sup>

There was a lack of patent use spread across the European countries surveyed compared with their US and Japanese counterparts. While the reasons for this could vary (one disadvantage is that the details of patented technology have to be made public) there was concern about negative effects on EU businesses.

If we want to improve European innovation and competitiveness, many more SMEs should be using patents and patent information than currently do,” said Charles Oppenheim, Professor of Information Science at Loughborough University.<sup>15</sup>

Patent counts are not necessarily a reliable indicator of competitiveness or innovation. Moreover, increasing patent numbers could indicate that beneficial competition is being undermined by companies acquiring rafts of patent rights which they use in a defensive and anti-innovative manner against their competitors to block off whole areas of technology.

The use to which patents have been put has changed over time. An example of how things could develop was the topic of a New Scientist article reporting on concerns about patents being granted on common-sense ways of working.<sup>16</sup>

Since a court case in July 1998 ruled in favour of patenting business methods, the US has been allowed such filings - but the move has left the US Patents and Trademarks Office mired in controversy. It now allows patents on anything tangible and useful. Among the controversial patents it has granted is one that

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<sup>7</sup> <http://www.patent.gov.uk/>

<sup>8</sup> <http://www.patent.gov.uk/tm/index.htm>

<sup>9</sup> <http://www.patent.gov.uk/copy/index.htm>

<sup>10</sup> <http://www.patent.gov.uk/design/index.htm>

<sup>11</sup> <http://www.patent.gov.uk/patent/index.htm>

<sup>12</sup> <http://www.patent.gov.uk/media/keyfacts/filingstats.htm>

<sup>13</sup> EU Publication Office, *Enforcing small firms' patent rights*, 2001

<sup>14</sup> [ftp://ftp.cordis.lu/pub/innovation-policy/studies/studies\\_enforcing\\_firms\\_patent\\_rights.pdf](ftp://ftp.cordis.lu/pub/innovation-policy/studies/studies_enforcing_firms_patent_rights.pdf)

<sup>15</sup> “Smaller companies are patently missing out”, *Financial Times*, 11 September 2001

<sup>16</sup> “Smaller companies are patently missing out”, *Financial Times*, 11 September 2001

<sup>16</sup> “Foul play”, *New Scientist*, 25 November 2000

embodies the idea of undercutting a competitor by checking their prices on the Internet.

[...]

The outlook remains worrying. In San Francisco, Greg Aharonian searches out old documents not found by the USPTO examiners, and uses them to invalidate new patents. But he has now been sued for alleged infringement of a patent on remotely querying a database - a patent he has been trying to bust.<sup>17</sup>

The Financial Times reported that

...US companies accounted for 52 per cent of business method applications to the EPO last year, compared with fewer than 20 per cent for companies from the UK, Germany and France. While US companies are taking half the business method cake, over the same period they accounted for fewer than a third - 28 per cent - of all EPO applications.<sup>18</sup>

Companies may feel that they have to document their current business methods and so prevent those methods from being patented. Such documentation, if it predates a patent application, could invalidate the patent. However, a 2001 press release from the European Patent Office stated:

The EPO also wishes to remind applicants that methods of doing business per se are excluded from patentability pursuant to Article 52(2)(c) & (3) EPC. Claims to such methods and their commonplace technological implementation in European patent applications will not be searched because it would not serve any useful purpose to do so.<sup>19</sup>

This statement supported the Government's response to a consultation held to investigate whether software and business methods should be patentable:

The Government's conclusion is that those who favour some form of patentability for business methods have not provided the necessary evidence that it would be likely to increase innovation. Unless and until that evidence is available, ways of doing business should remain unpatentable.<sup>20</sup>

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<sup>17</sup> "Foul play", *New Scientist*, 25 November 2000

<sup>18</sup> "Using monopolies to protect methodologies", *Financial Times*, 26 October 2000

<sup>19</sup> European Patent Office Press Release, "Business Methods", 13 August 2001

<sup>20</sup> *Should Patents be granted for Computer Software or Ways of Doing Business? - The Government's Conclusions* <http://www.patent.gov.uk/about/consultations/conclusions.htm>

## A. Patents Legislation

Protection of inventions to encourage the development of technology, and thus stimulate the national economy, has been in place since Elizabethan times. At this time monopolies were granted to exploit the technology but the award was ‘a matter of the Sovereign’s grace, and was made by the issue of Letters Patent’.<sup>21</sup>

The earliest known English patent for invention was granted by Henry VI to Flemish-born John of Utynam in 1449. The patent gave John a 20-year monopoly for a method of making stained glass, required for the windows of Eton College, that had not been previously known in England.<sup>22</sup> The granting of monopolies became abused and the Statute of Monopolies was passed in 1623 to regularise the awarding of such benefits. The Statute stated that monopolies were bad unless they existed to protect the inventors of new manufacturing processes. This recognised the importance of providing some incentive to inventors though such monopoly privileges were time-limited to fourteen years.

Britain's patent system served the country well during the dramatic technological changes of the industrial revolution. However, by the mid-19th century it had become extremely inefficient. The Great Exhibition of 1851 accelerated demands for patent reform.

Up to that time, any prospective patentee had to present a petition to no less than seven offices, and at each stage to pay certain fees. The procedure was described in exaggerated form, somewhat derisively, by Charles Dickens in his spoof, "A Poor Man's Tale of a Patent", published in the 19th-century popular journal "Household Words"; Dickens' inventor visits 34 offices (including some abolished years before). To meet public concerns over this state of affairs, the Patent Office was established by the Patent Law Amendment Act of 1852, which completely overhauled the British patent system and laid down a simplified procedure for obtaining patents of invention. Legal fees were substantially reduced and the issuing of separate patents for each nation of the Union was replaced by the publication of a single UK patent. The office of Comptroller General of Patents and a staff of patent examiners were brought into being by a subsequent Act in 1883 to carry out a limited form of examination; mainly to ensure that the specification described the invention properly, but without any investigation into novelty.<sup>23</sup>

Four further pieces of legislation usefully punctuate the history of patent legislation:

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<sup>21</sup> “Patents and Designs”, *Halsbury’s Statutes*, Volume 33, p1, Fourth Edition, 2001

<sup>22</sup> <http://www.patent.gov.uk/patent/history/fivehundred/origins.htm>

<sup>23</sup> <http://www.patent.gov.uk/patent/history/fivehundred/eighteenth.htm>

- i. The *Patent and Designs Act 1907* consolidated legislation with respect to patents, registration of designs and trade marks and set out the first requirements to establish that patents were granted only where novelty could be established.
- ii. The *Patents Act 1949* further refined patents legislation, detailing procedures for the application, investigation and opposition of patents, granting patents, the effect and terms of patents including extensions due to war loss and inadequate remuneration and a variety of other provisions. No Patents may now be granted under this, or earlier, legislation as it was reformed through the *Patents Act 1977* under which all patents are now granted.
- iii. The *Patents Act 1977* gave effect to proposals in the White Paper on Patent Law Reform<sup>24</sup> which in turn drew upon the Report of the Banks Committee.<sup>25</sup>

It repealed the 1949 Act and established a new law on patents and gave effect to a number of international patents agreements. The Act gave effect to the Patent Co-operation Treaty<sup>26</sup> which provided for the establishment of an International Patent Co-operation Union; the European Patent Convention,<sup>27</sup> which led to the establishment of the European Patent Office and European Patents, and the Community Patent Convention<sup>28</sup> (which has never come into effect).

A Patents Court was established as part of the High Court and the law with regard to ownership of employees inventions was put on a statutory basis. The Act provided for the making of awards to such employees in certain cases.

- iv. Most recently the *Copyright, Designs and Patents Act 1988* provided legislation that made

...provision with respect to patent agents and trade mark agents; to confer patents and designs jurisdiction on certain county courts; to amend the law of patents...<sup>29</sup>

Essentially the Act established a register of patent agents and detailed how the designations of patent agent and patent attorney were to be given.

Prior to bringing forward this Bill, the Department of Trade and Industry and the Patent Office conducted a consultation exercise which set out proposals

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<sup>24</sup> *Patent Law Reform*, Cmnd 6000, 1975

<sup>25</sup> *The British Patent System: report of the committee to examine the patent system and patent law* [Banks Report], Cmnd 4407, 1970

<sup>26</sup> *Patent Co-operation Treaty*, Cmnd 4530, 1970

<sup>27</sup> *Convention on the grant of European Patents*, Cmnd 5656, 1974

<sup>28</sup> *Convention for the European Patent for the Common Market*, Cmnd 6553, 1976

<sup>29</sup> Long title, *Copyright, Designs and Patents Act 1988*

...regarding the effect of the European Patent Convention revisions of 2000 on the Patents Act 1977 and certain other changes and improvements to the Act, including proposed changes relating to enforcement and post-grant issues, and modernisation of the Act.<sup>30</sup>

The consultation paper is available from the Patent Office website.<sup>31</sup> The consultation exercise did not consider changes of the kind proposed by Mr Liddell-Grainger's *Patents Act 1977 (Amendment) Bill 2001-02* that would have introduced exemplary damages against people who wilfully infringed patents.

Patent issues in the UK are dealt with by the Patent Office. The Comptroller-General, currently Ron Marchant, has the authority to make decisions on patent disputes. In many ways the Comptroller's powers are like those of a judge in the courts. The most common disputes on which the Comptroller decides are in the areas of ownership, licences and technical issues.<sup>32</sup>

## B. Costs of Patenting

One of the problems with patents most often highlighted with the patent process is that the procedures are difficult and costly. Applicants often require professionals to help them through the process and this adds to the costs. A *New Scientist* article pointed out that:

“Some people almost set themselves up to have their ideas stolen by writing their own patents.”

[...]

“It's very hard to be detached enough to write a wide enough patent on your own invention. For example, you might describe the particular materials you used to make it; that means it would not cover the same device made with different materials.”

Another danger for inventors writing their own patents, he says, is that it is not written in “patent-lawyerese”. According to Weaver, this “shows you're a bit hard-up, and probably don't have the money to sue, so any firm might rip the idea off after its published.” For example, what most people call a square, a patent agent would define as a “rectilinear construction of variable side length”.<sup>33</sup>

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<sup>30</sup> <http://www.patent.gov.uk/about/consultations/patact/summary.htm>

<sup>31</sup> <http://www.patent.gov.uk/about/consultations/future/index.htm>

<sup>32</sup> <http://www.patent.gov.uk/patent/info/deciding.pdf>

<sup>33</sup> “Winners and losers in the invention game”, *New Scientist*, 5 October 1991

Below, is a table reproduced from the EU website<sup>34</sup> comparing the costs of obtaining a patent in the EU, the US and Japan:

<b>Cost of Obtaining a Patent (€)</b>							
	<i>Filing and Search fees</i>	<i>Examination fees</i>	<i>Grant fees</i>	<i>Renewal Fees</i>	<i>Translation costs</i>	<i>Agents Fees</i>	<i>Total</i>
<b>EPC*</b>	810 + 532	1,431	715	16,790	12,600	17,000	49,900
<b>US</b>	690	-	1,210	2,730	n.a.	5,700	10,330
<b>Japan</b>	210	1,100	850	5,840	n.a.	8,450	16,450

*Source: The First Mover Monopoly, Oswang and Oxford University, October 2000*

\* *European Patent Convention*

The higher costs of the European patent reflect the cost of translation. A European patent must be translated into the language of each European country in which the applicant desires patent protection. There has been pressure to reform the system to enable the EU members of the European Patent Convention to work in one language and to have a single court in which patents might be defended. Although this could improve efficiency, natural political pressures (much of it independent of patent law) have so far acted against such a resolution: despite support from many businesses and countries for such a system.<sup>35</sup>

The costs involved in patents do not end once the patent has been granted. There are renewal fees necessary to maintain the patent and the potential costs of defending it against those who wish to exploit the technology without recognising the existence of a patent. It is possible that an inventor may not wish to risk the court costs in defending a patent, despite having spent a considerable amount of money in registering the patent. The potential problem is that this may be an incentive not to participate in the patent process, relying instead on secrecy to maintain the commercial advantage your technology might provide.

### **C. International Patents**

National patents are not adequate to protect intellectual property within a global marketplace as there may be conflicts where similar patents are placed in two different national patent offices. There have been efforts made to establish procedures to allow for intellectual property to cross national borders. A UK patent would provide a monopoly for the patent holder within the UK, but to extend that to other countries would also require patents to be registered that cover those countries. One way would be to individually submit patents in each jurisdiction but it would be simpler if one patent submission could be arranged to cover many countries at once. As yet, there is no single patent that would cover all countries, ore even just Europe, but there have been multi-

<sup>34</sup> [http://europa.eu.int/comm/internal\\_market/en/indprop/patent/2k-714.htm](http://europa.eu.int/comm/internal_market/en/indprop/patent/2k-714.htm)

<sup>35</sup> "The politics of plagiarism", *Financial Times*, 17 November 2000

lateral negotiations under the aegis of organisations such as the World Intellectual Property Organisation (WIPO) towards the provision of such patents. Currently, the European Patent Convention, Patent Cooperation Treaty and the Patent Law Treaty aim to provide mechanisms such that patent law amongst signatories can be harmonised as far as possible to facilitate extension of intellectual property beyond national boundaries.

One reflection of the supposed ideal of European integration and harmonisation would be a single European patent that would provide patent protection throughout the EU. There are factors however that have stalled the implementation of an EU-patent.

*Language* - much of the present cost in obtaining a European patent is in the translation required. If it was possible to agree on a single language the costs could be drastically reduced.

*Justice systems* - the most obvious system is to have a central court that enforced patents, but this might increase present costs which would deter smaller patent holders from contesting infringements. An alternative might be a delegated regional system answerable to a central authority.

*Existing national patent systems* - an EU patent system would compete with national patent systems and potentially threaten nationally based patent offices. This is important as these offices provide advice and support on patent issues for both Government and innovators.<sup>36</sup>

Currently the European Patent is a product of a centralised patent grant system administered by the European Patent Office (EPO) on behalf of all contracting states. Rather than granting one single European patent, it essentially organises for a series of national patents to be granted - a “one stop shop” rather than a single shop. Obviously, as detailed above, this leads to increased costs. The EPO, which is not an EU institution, was established under the European Patent Convention in 1973 and the Convention aids in co-ordinating patenting activity among the signatories to the Convention. This is dealt with in detail in the following section.

Already several international conventions exist that should provide some kind of harmonisation among the variety of national patent systems. The World Trade Organisation (WTO) mediated an agreement on intellectual property rights called the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).<sup>37</sup> The WTO provides the following brief overview of TRIPS:

The agreement covers five broad issues:

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<sup>36</sup> “How many boffins does it take?”, *Financial Times*, 8 October 2001

<sup>37</sup> [http://www.wto.org/english/docs\\_e/legal\\_e/final\\_e.htm#TRIPS](http://www.wto.org/english/docs_e/legal_e/final_e.htm#TRIPS)

- how basic principles of the trading system and other international intellectual property agreements should be applied
- how to give adequate protection to intellectual property rights
- how countries should enforce those rights adequately in their own territories
- how to settle disputes on intellectual property between members of the WTO
- special transitional arrangements during the period when the new system is being introduced.

The WTO website<sup>38</sup> contains information on the details of the TRIPS agreement.

The Patent Cooperation Treaty (PCT), as well as other international treaties concerning issues of intellectual property, is administered by the World Intellectual Property Organisation (WIPO):<sup>39</sup> an agency of the United Nations. WIPO provides the following information on the PCT:

The PCT was concluded in 1970, amended in 1979 and modified in 1984. It is open to States party to the Paris Convention for the Protection of Industrial Property. Instruments of ratification or accession must be deposited with the Director General of WIPO. The PCT created a Union. The Union has an Assembly. Every State party to the PCT is a member of the Assembly.<sup>40</sup>

The PCT may provide the eventual basis for a truly worldwide international patent system:

By filing one international patent application under the PCT you can simultaneously seek protection for an invention in each of a large number of countries (now more than one hundred) throughout the world. If you are a national or resident of a PCT Contracting State, you may file such an application and thereby benefit from:

- extra time (at least 8 months more, but frequently 18 months more, compared with not using the PCT) to investigate the commercial possibilities of your invention;
- the option of obtaining, in addition to an international search report, an international preliminary examination report, providing information about the patentability of your invention, before you incur any costs associated with the patent granting procedure in any of the countries in which you still wish to obtain patents;
- the possibility of complying with a number of formalities in a centralized manner when you prepare your application in accordance with the international standards effective under the PCT; and

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<sup>38</sup> [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/agrm6\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm6_e.htm)

<sup>39</sup> <http://www.wipo.org/>

<sup>40</sup> <http://www.wipo.org/pct/en/index.html>



- significant fee reductions throughout the international and national phases of the procedure.

Currently the system is useful only if an inventor believes worldwide protection is required. It works in a somewhat similar manner to the European Patent whereby you get a one-stop shop – at least for the first stages of the patent application process. However, unlike for a European Patent, there is no centralised office which can grant patents under the PCT, so for the later stages of the patent application process, the application must be pursued separately at each national patent office where a granted patent is required.

The most recent WIPO initiative, the Patent Law Treaty is discussed in an article in IPMatters:

Adopted in Geneva, on 2nd June 2000, the Patent Law Treaty (PLT) comes as the result of a World Intellectual Property Organisation (WIPO) initiative. Its aim is to harmonise the formal requirements set by patent offices for granting patents, and to streamline the procedures for obtaining and maintaining a patent.

Initially, PLT will apply to all EU countries, the US, Canada, Japan and Australia. Eventually it will include virtually all countries in the world.

While the PLT is only concerned with patent formalities, many of the provisions will prove extremely useful when the PLT comes into force for a large number of states, providing speedier and less costly procedures.

Specifically, PLT signatories have agreed to a single internationally standardised set of formal requirements for national and regional offices, standardised forms to be accepted by all offices, filing date requirements, and procedures to avoid a loss of the filing date because of a failure to comply with formalities, simplified procedures before the patent office, basic principles for the implementation of electronic filing, and mechanisms to avoid unintentional loss of rights as a result of failure to comply with time limits.<sup>41</sup>

## **D. European Patent Convention**

The European Patent Convention (EPC) was signed in Munich in 1973. All the Member States of the enlarged European Community are signatories, except Latvia, Lithuania and Malta, as are six non-member countries: Bulgaria, Romania, Turkey, Switzerland, Liechtenstein and the Principality of Monaco. This comprises a total of 28 EPC Contracting States. The European Patent Convention (EPC) established the European Patent Office (EPO) but that office does not grant European Patents in the way that the UK Patent Office grants UK Patents.

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<sup>41</sup> <http://thomsonderwent.com/ipmatters/iplr/8204362/>

Instead the EPO provides a mechanism for granting a ‘bundle’ of patents which are valid in Contracting States and so can provide the applicant with protection in as many of those states as desired – through a single patent application made to the EPO. Although this system has the advantage of being extremely flexible it is more complex and costly than a single EU Patent would be and there is no provision in the system for a court with powers to settle patent disputes at European level. This leaves the possibility that the competent courts in the Member States will hand down contradictory judgments.

The EU *Green Paper on the Community patent and the patent system in Europe* recognises the strengths and weaknesses of the EPC system:

The Munich Convention ushered in major improvements in the patent system, such as a centralized procedure for the grant of patents based on uniform patent law and conducted in a single language, a reduction in the costs of protection where it is sought in more than one Member State, a high quality protection right and de facto harmonization of the provisions of national patent law governing patentability, validity and the extent of protection.

But, because it is not supplemented by the unitary Community patent, the system also has its limitations:

- once a European patent has been granted, its entry into the national phase gives rise to considerable costs and complicates the management of rights, since translations of the specification have to be filed with the national patent office of each designated country and renewal fees have to be paid for each of those countries;
- the management of proceedings for infringement or revocation is complex, since actions have to be brought before the national courts of each country for which the European patent has been granted;
- in the absence of a common court, the emergence of different interpretations of European patent law by national courts is liable to undermine the value of the European patent;
- the sum total of the national fees payable for renewal of a European patent constitutes a heavy burden for patentees, especially since only part of the proceeds (currently 50%) is used to defray the costs incurred by the European Patent Office in managing the procedure for granting patents;
- the additional costs of protection for each designated country are prompting businesses to be selective in their choice of countries, with effects that run counter to the aims of the single market. The fact that requests for protection are concentrated on the larger Member States disadvantages the smaller ones in terms of both technology transfer and their attractiveness to investors. And the limitation of protection to only part of the single market reduces its commercial value.<sup>42</sup>

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<sup>42</sup> [http://europa.eu.int/comm/internal\\_market/en/indprop/patent/paten.pdf](http://europa.eu.int/comm/internal_market/en/indprop/patent/paten.pdf)

The Green Paper, while focussed on the introduction of a single Community Patent, identified areas where harmonisation of Member States' patent legislation would be desirable. Computer programmes, employees' inventions, the use of agents, the recognition of professional qualifications and the scope of the rights conferred by patents in certain sectors were all highlighted as areas of concern. The Green Paper also identified measures to make the patent system more attractive to small businesses such as reducing the costs of a European Patent, providing a system of insurance against the costs of defending patents in court and whether a period of grace might be introduced whereby a patent could be obtained for an invention that had already been disclosed to the public. It is currently not allowed to patent an invention if there is any public knowledge of it.<sup>43</sup>

These findings along with other events in intellectual property law meant that the EPC was ripe for amending. The head of the EPO indicated that:

The EPC needs to be brought into line with the TRIPs Agreement, the future Community patent and the provisions of the forthcoming Patent Law Treaty (PLT), eg regarding the requirements for according a filing date, electronic filing of applications or re-establishment of rights in respect of the priority period.<sup>44</sup>

In November 2000, there was a Diplomatic Conference to revise the European Patent Convention. This meeting in Munich, among other administrative changes, agreed that

- There should be a meeting of patent ministers every five years to review the Convention
- That methods for treatment and diagnosis of the human or animal body by surgery or therapy would continue to not be patentable though 'products, in particular substances or compositions, for use in any of these methods' would still be patentable, and this result should be delivered in a less complex way
- That computer programmes would remain non-patentable
- That regulations with regard to filing for a European Patent should be eased

Many of the provisions within the Convention were moved to that Convention's Implementing Regulations. The details of all the changes agreed are highlighted in a document produced at the end of the conference.<sup>45</sup>

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<sup>43</sup> COM (1999) 42, Communication from the Commission to the Council, the European Parliament and the Economic and Social Committee - *Promoting innovation through patents - The follow-up to the Green Paper on the Community Patent and the Patent System in Europe*  
[http://europa.eu.int/comm/internal\\_market/en/indprop/patent/8682en.pdf](http://europa.eu.int/comm/internal_market/en/indprop/patent/8682en.pdf)

<sup>44</sup> Notice from the President of the European Patent Office dated 24 March 2000 concerning revision of the European Patent Convention.  
[http://www.european-patent-office.org/epo/dipl\\_conf/overview.htm](http://www.european-patent-office.org/epo/dipl_conf/overview.htm)

<sup>45</sup> [http://www.european-patent-office.org/epo/dipl\\_conf/pdf/em00002.pdf](http://www.european-patent-office.org/epo/dipl_conf/pdf/em00002.pdf)

The European Patent Convention has been reasonably successful in providing a broader patent for Europe but it has proved extremely difficult to introduce a single European patent. One of the major problems has been wrangling over the language to be used. It would make sense that a single patent should use a single language and the favoured language would currently be English. French, and to a lesser extent German, sensibilities require that their languages be made compulsory but if that happens then other countries would also lobby for their languages to be included too as there would be some advantage to being able to lodge a patent in your mother tongue. Another barrier to a single patent would be the regulation of it. There have been difficulties in agreeing on a single European Patent Court where patent disputes might be settled.<sup>46</sup>

### **III The *Patents Bill 2003-04* in the House of Lords**

The Patents Bill had its first reading in the Lords on 15 January 2004. The technical nature of the Bill might be indicated by the fact that debate on all stages of the Bill in the Lords was completed in just over four hours.

#### **A. Second Reading**

The Bill was introduced by Lord Sainsbury (Parliamentary Under-Secretary of State for Science and Innovation):

UK businesses operate in national, regional and global markets and thus will want to ensure that they can protect their valuable intellectual property assets in all types of markets. The Patents Act 1977 has served us well in this respect. It had two key objectives: first, to reform and modernise UK domestic patent law and, secondly, to permit the UK to ratify a number of international patent agreements and thus ensure that UK businesses could obtain similar patent protection for their inventions regionally, in other countries in Europe, and globally.

The most important of these international patent agreements was the European Patent Convention of 1973 which allows a UK applicant to obtain, using a single application and granting procedure, a patent which will be effective in any of up to 27 European countries, including the UK as well as all our EU partners. This European patent is in effect a bundle of national patents that all become effective in the country in question upon payment of a fee and filing a translation of the patent in the official language of that country.

In November 2000, at an intergovernmental meeting in Munich, a large number of changes to the 1973 European Patent Convention were discussed and agreed by representatives from all the contracting states which had ratified this

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<sup>46</sup> <http://www.oiprc.ox.ac.uk/EJWP1099.pdf>

convention. All the states which attended this conference undertook to implement the agreed changes as soon as possible.

The first objective of the Bill is therefore to amend the Patents Act 1977 to implement, in UK law, the changes to the 1973 European Patent Convention that were agreed in 2000. Failure to ratify the revised version of the European Patent Convention would result in the UK having to leave the European Patent Organisation, the body set up under the convention to carry out all the tasks involved in the granting of European patents.

[...]

This brings me to the second part of the Bill which is concerned with other amendments to the Patents Act 1977—which will make improvements to the current arrangements for handling disputes over patents, including the creation of a new opinion procedure to provide an early and rapid assessment of issues relevant to validity or infringement of a patent; and make the UK patent system more responsive to the needs of customers.

[...]

The Government have therefore taken the opportunity presented by the Bill to make a number of improvements relating to the handling of disputes and utilising the expertise in the Patent Office. In an effort to help patent holders and others determine as early as possible what is the likelihood of success when considering or facing possible litigation, Clause 12 of the Bill would provide a new procedure under which the Patent Office would issue, on request, an opinion on certain matters that might be relevant to a patent dispute.

Lord Lyell, a former Attorney General, had some reservations about the Bill. He wondered whether certain changes being made to the *Patents Act 1977* were due to specific problems that had become apparent with relief and damages being sought due to patent infringement disputes not being claimed in good faith. He also wondered whether the *outstanding benefit* referred in regard to a patented invention would have any limit when deciding on a contributing employee's reward or whether there might be a definition of *best endeavour* in relation to "Remedy for groundless threats of infringement proceedings". He was concerned that the wording of clause 12 (as it then was) indicated that opinions by the Patent Office with regard to validity or infringement of patents "shall not be binding for any purposes".<sup>47</sup>

Lord Sainsbury did not believe that the courts should be restrained by legal definitions of 'outstanding' when considering cases and that they should be able to recognise when a patent made an outstanding contribution to the company rather than one that was simply

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<sup>47</sup> HL Deb 26 January 2004 c38-9

substantial or good. As regards patent disputes, he indicated that there had been ways to ensure good faith in the past, although different from those proposed in the Bill:

There is an issue concerning whether a patent-holder who knowingly maintains an invalid patent claim can later amend his patent. When a court or the comptroller is deciding whether to allow or refuse an amendment of a patent, Clause 2 would retain their discretion to take account of such covetous behaviour, but only if it is consistent with the relevant principles under the European Patent Convention. If it is considered that the principles under the EPC clearly rule out covetous behaviour from being taken into account, the comptroller or the court would not be able to take such behaviour into account either. However, Clause 2 would prevent a covetous patent-holder from winning damages for any infringement committed when the patent claim was restricted by amendment to its proper scope. The provision would therefore protect the public from the action of covetous patent-holders, but differently from the past.<sup>48</sup>

While Lord Razzall welcomed the Bill he was concerned about a number of things that were not in it. He wanted to know where the right of an inventor to remain confidential was, why the jurisdiction of the Patents County Court was not to be widened to cover trademark matters, why no change had been made to Section 40 of the Act when that part of the legislation had never been used, why the concession “that no injunction and only limited damages will be available as remedies in infringement proceedings, provided the defendant agrees to take a licence of right” was not extended, why the consent of both parties would still be required to take infringement proceedings before the comptroller and why the Government had not done more to address the issue of threats. This Bill was an opportunity to address concerns raised in consultation about patents legislation and it would be a pity to miss that opportunity.<sup>49</sup>

Lord Sainsbury confirmed that the Government were intending to change the Patent Rules such that an inventor, who is not the patent holder, could have his address kept confidential, but not his name. He believed that the Bill amended the threats issue in a positive way:

Genuine attempts at pre-litigation settlement of a patent infringement may have been hampered in the past by the existing provisions on threats in Section 70 of the 1977 Act.

[...]

Under current provisions, a patent holder who, for example, has failed to find the manufacturer of an allegedly infringing product cannot risk contacting the retailer of the product to resolve the dispute for fear of a threats action against him.

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<sup>48</sup> HL Deb 26 January 2004 c44

<sup>49</sup> HL Deb 26 January 2004 c39-42

Clause 11 would, therefore, allow the patent holder freely to approach an alleged secondary infringer, but only in the limited circumstances where he has unsuccessfully used his best endeavours to locate the alleged primary infringer first. Furthermore, it clarifies the way in which a patent-holder may contact an alleged secondary infringer as part of his best endeavours. I believe that it is therefore a modest adjustment to the balance between the rights of a patent holder to chase infringers and the need to provide alleged secondary infringers with protection from unjustified threats. It is an adjustment that should address concerns about the inability of patent holders to make genuine attempts to settle disputes.<sup>50</sup>

Earl Attlee raised the issue of exemplary damages against those that flagrantly breach patents. He believed that the current situation might not sufficiently deter larger companies from breaching patents and using their economic might to ignore the patents of small companies and inventors. He recognised that there would have to be tight drafting of a definition of how flagrant a breach would have to be before damages would be awarded as otherwise every claim for infringement could seek exemplary damages and that is not desirable.<sup>51</sup>

Lord Sainsbury acknowledged that he had not dealt with all of the points raised but was sure that they would be raised and debated during Committee.

## **B. Committee Stage**

The committee stage in the House of Lords was taken place on 8 March 2004. The debate occurred in Grand Committee, where by agreement the House would not divide.

Subsection 2 (1) of the Bill would require the comptroller, when judging whether to allow patent holders to amend their patent, to have regard to the relevant principles of the European Patent Convention. Earl Attlee was concerned that this amendment was vague when it should be more precise and therefore proposed that Subsection 2 (1) should be omitted from the Bill. Lord Sainsbury persuaded the amendment to be dropped, as it would have resulted in the consideration of voluntary patent amendments being subject to different considerations from patent amendments made during proceedings in the courts.<sup>52</sup>

Lord Triesman proposed an amendment that would relax the requirement on British residents applying for patents overseas to first submit the patent application to the UK Patent Office. The amendment made allowance for patents that would relate to military technology or other matters that would affect national security to continue to be scrutinised by the UK Patent Office in advance of submitting the patent application abroad.

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<sup>50</sup> HL Deb 26 January 2004 cc45-6

<sup>51</sup> HL Deb 26 January 2004 c43

<sup>52</sup> HL Deb 8 March 2004 c345-7

We understand that there may be concern about how to identify applications that contain sensitive subject matter. However, anyone in doubt can continue first to file at the UK Patent Office or to seek the comptroller's permission. Moreover, further protection is provided by limiting the application of the criminal offence presently found in Section 23(3). The offence would apply only to those people who have filed abroad knowing that they are contravening the section as amended or who do so recklessly.<sup>53</sup>

Concerns that the provisions might unduly disadvantage foreign patentees using British patent agents were answered by Lord Triesman and the amendment was accepted.

Lord Razzall sought to introduce a new clause to introduce the right of inventors to remain anonymous. One of his major concerns was that inventors could be targeted by protestors and that public availability of inventors' names and addresses only made that more possible. Lord Lyell pointed out that the Minister supported the principle of keeping an address confidential in Second Reading debate though would like more detail on how this was to be achieved.

Lord Sainsbury pointed out that under the European Patent Convention an inventor, who was not also a patent applicant, could request that his details remain confidential and that the Government had consulted on this point. The consultation had shown that there were concerns about names being made confidential but significantly less concern about addresses and other details. Availability of names made the searching of patents, a crucial part of the patenting process, easier and enabled professionals to put the patent into context and possibly to link it to academic research. He also pointed out that inventors would be able to use employers' addresses if they were concerned about using their own address on the patent.

As the debate occurred in Grand Committee, Lord Razzall withdrew the amendment though he was not convinced by the Minister's arguments.<sup>54</sup>

Lord Razzall and Earl Attlee moved amendments that would expand the role of the comptroller in settling patent disputes by introducing a system of binding arbitration that could be instigated by only one party in the dispute. Lord Triesman pointed out that consultation on this kind of change had drawn negative responses and that, given only one party had to agree and the decision could be appealed in the courts, this would seem to be a way to waste both time and money. Lord Razzall and Earl Attlee moved amendments that would further modify the provisions which concerned patent holders who make unjustified threats of suing for patent infringement. Lord Triesman promised to consider introducing a more limited amendment protecting legal advisers from an

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<sup>53</sup> HL Deb 8 March 2004 c350

<sup>54</sup> HL Deb 8 March 2004 cc354-6



action for unjustified threats later in proceedings and the amendments on this were withdrawn.<sup>55</sup>

Earl Attlee moved a number of amendments that would prevent the Patent Office from being able to give opinions on infringements of patents while allowing them to give opinions on validity. He reported that various organisations did not believe the Patent Office was competent to give an opinion on infringement and the fact that such opinions on infringement would not be binding would not deter infringers. Lord Sainsbury however defended the competence of the Patent Office to give an opinion on infringement and the value of having such opinions to those potentially involved in patent disputes. He refused to expand on the cost of such opinions beyond the ‘few hundred pounds’ expressed during Second Reading. He said that matters such as this would be subject to more consultation before the secondary legislation is made setting out the details of the procedure. The amendment was withdrawn.<sup>56</sup>

Earl Attlee moved an amendment to introduce a patent levy to provide the Secretary of State with a fund to aid selected patent cases so that there could be some relief for patent holders who believed they were being bullied out of their rights due to inadequate financial power to defend those rights. Lord Sainsbury indicated that such a change should be consulted upon before being implemented and that there could be problems, with regard to international agreements, in who would be able to call on this financial resource. He accepted that there was a problem in enforcing patents and stated that the Government were taking steps to address those difficulties but the issues would need more considered steps than those in the amendment. The amendment was withdrawn.<sup>57</sup>

The Government made a number of minor amendments to Clauses 14 and 15 and Schedule 2 that were agreed to without debate. A further amendment to Clause 15 that would allow statutory instruments containing only ‘transitory, transitional or saving provision’ to follow the negative procedure was also agreed to on a short recommendation by Lord Triesman.<sup>58</sup>

### **C. Report and Third Reading**

Report Stage in the House of Lords took place on 23 March 2004.

Lord Razzall returned to the issue of inventor confidentiality. He did not believe that the hindrance to patent searching outweighed the safety risk to inventors nor that similar protection being available in other jurisdictions should prevent the UK from implementing it. He did not think that, even if only the name was made available,

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<sup>55</sup> HL Deb 8 March 2004 c368-73

<sup>56</sup> HL Deb 8 March 2004 cc374-7GC

<sup>57</sup> HL Deb 8 March 2004 cc379-83GC

<sup>58</sup> HL Deb 8 March 2004 cc383-6GC

addresses would not be deduced by capable people using modern technology. Lord Sainsbury agreed that an amendment would be put forward at Third Reading to allow inventors to have their name (as well as their address, as already proposed) kept confidential under appropriate circumstances.<sup>59</sup>

Earl Attlee revisited the issue of restriction on applications abroad by United Kingdom residents. He sought to remove a subsection that related to the safety of the public as he believed that it would be completely subsumed into the previous subsection that covered national security and was thus redundant. He also thought that the legislation as drafted would mean that the applicant, rather than the comptroller, would have to make a judgement as to whether the application had implications for public safety, a task they might not be competent to judge. Lord Triesman indicated that he had taken advice from the security advisers at the Ministry of Defence<sup>60</sup> who believed both subsections would be necessary to cover every eventuality. Earl Attlee was not convinced:

He said that the two phrases would cover every eventuality. That is what worries me. Applicants will play safe, and my fear is that the deregulation will not work as well as the Minister intends.<sup>61</sup>

Despite that, he withdrew the amendment.

Earl Attlee then moved an amendment that would provide an additional way in which a patent holder might defend himself if someone accused him of making unjustified threats of patent infringement. The amendment specifically targeted the situation where a claim of patent infringement was made and, though the patent was indeed infringed, the courts found the patent to be invalid. In that case, as the law currently stood, the patent holder could be charged with unjustified threats. Lord Sainsbury indicated that he believed the current situation to be unfair but the amendment to be badly drafted and offered to table amendments on Third Reading of the Bill. The amendment was withdrawn.<sup>62</sup>

The issue of opinions from the Patent Office was also revisited. Earl Attlee sought to ensure that, if the Patent Office were to give an opinion on infringement, they would have to seek comment from interested third parties if they were to issue an opinion ‘adverse to that party’. Lord Sainsbury tried to reassure Earl Attlee that the intention was for the opinion process to be widely notified so that any third parties should be able to become aware of the process in good time, but that they did not wish to introduce processes that would compromise the key advantages of the procedure: ‘its low cost and its speed’. He believed that adequate procedure would be put in place to ensure notification should be

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<sup>59</sup> HL Deb 23 March 2004 c663-6

<sup>60</sup> In the debate Lord Triesman referred to ‘security services’ but explained in a letter, dated 29 March 2004, to Lord Attlee that he meant security advisors from the Ministry of Defence.

<sup>61</sup> HL Deb 23 March 2004 c668

<sup>62</sup> HL Deb 23 March 2004 cc668-70

sufficient to raise awareness among interested third parties. The amendment was withdrawn.<sup>63</sup>

The Bill returned to the House of Lords for Third Reading on 6 April 2004.

Lord Sainsbury tabled, as promised, amendments to give limited additional defence to a patent holder being sued for making unjustified threats of patent infringement and to allow an inventor to request that his name and address be kept confidential. He indicated that he had, as promised, considered provisions exempting legal advisors from threats but:

...decided that any action in this respect would not be appropriate, not least because of the different nature and extent of the UK and Australian threats provisions.<sup>64</sup>

All of the amendments were agreed to without debate or division and the Bill was passed.<sup>65</sup>

## D. Other Comment

The passage of the Bill has not caused a great amount of political controversy or press comment. The *Financial Times* indicated that the Bill, as presented in the House of Lords, was less radical than it might have been:

But Ministers have backed away from proposals that would have allowed employees to enjoy a greater share of the profits that their lucrative inventions generate for employers. The suggestions to help inventors share in the fruits of their research perhaps with a percentage of royalty payments were dropped after businesses objected.<sup>66</sup>

It also reported on a group, the Patent Reform Group, which would like to have seen more radical changes to patent law:

Ron Marchant, chief executive of the Patent Office, told *The Daily Telegraph* last week that it would help provide a new framework for innovation and benefit small companies but critics argue that the legislation does not go far enough in enforcing protection or redress for inventors.

They maintain that the introduction of arbitration will do nothing to encourage small inventors to seek an independent opinion from the Patent Office because it will not be binding on either side and does nothing to increase protection for them.

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<sup>63</sup> HL Deb 23 March 2004 c cc672-5

<sup>64</sup> HL Deb 6 April 2004 c1724

<sup>65</sup> HL Deb 6 April 2004 cc1723-7

<sup>66</sup> "Big shake-up in patent laws", *Financial Times*, 17 January 2004

John Mitchell, managing director of AllVoice Computing, based in Newton Abbot, Devon and chairman of the Patent Reform Group, says the Government has "shied away" from making any changes to enforce copyright protection. He adds: "This is plainly absurd. Major changes are required."

He maintains that Britain is losing "billions of pounds" because companies cannot afford to mount costly action for breaches of copyright, or "theft". He says it is no longer worthwhile seeking redress in British courts and he concentrates any action in America, where judges can award triple damages.

Mr Mitchell says there was no support for the arbitration idea when it was canvassed by the Government in a consultation document before publication of the Bill, citing the submission from the South West SMART Club, a 100-strong organisation of small companies benefiting from Government innovation awards, to support his claim.

The Patent Office disputes his assertion and says there was considerable backing for the idea. The Chartered Institute of Patent Agents has also given the proposal a "cautious welcome".

John Collins, of Marks & Clark, a leading firm of patent lawyers, and a member of the Reform Group, says the cost of starting legal action and the likely damages remain considerable deterrents.

Legal bills of between pounds 800,000 and pounds 1m are not uncommon but the institute says Michael Fysh, the new Patent County Court judge, is making greater efforts to peg costs.<sup>67</sup>

The Institute of International Licensing Practitioners provided some comment by fellows of that Institute on the Bill. The measures in the Bill were generally welcome and of practical value. The plans on introducing a facility for the Patent Office to issue opinions could, in the view of one Fellow,

...contribute towards mitigating the potentially very considerable financial and administrative implications of instigating formal proceedings, and facilitating a settlement without involving expensive litigation...<sup>68</sup>

There was also a technical question from a Fellow of the Institute relating to Clause 10 of the Bill:

He has simply questioned whether proceedings for infringement would, in England and Wales, always be conducted in a county court, as the text of the proposed amendment implies. If proceedings are not always to be confined to a

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<sup>67</sup> "Inventors up in arms", *Daily Telegraph*, 19 February 2004

<sup>68</sup> Personal communication, *Institute of International Licensing Practitioners*, 27 May 2004

county court then the phrase "if a county court so orders" could, for example, instead read "if a court [of appropriate jurisdiction] so orders" and the word "county" deleted from the phrase "county court" later in that sentence.<sup>69</sup>

The Chartered Institute of Patent Agents also broadly welcomed the legislation:

The Patents Bill is vital to innovative industry in the UK. Without it, the UK will be unable to ratify the revised European Patent Convention.

[...]

The Bill also makes several other improvements to UK patent law.

The Institute approves of the great majority of the provisions, and believes they are generally well drafted.<sup>70</sup>

There are, however, some areas where the Institute believe the Bill could be further improved. The Bill addresses the issue of threats issued by a patent holder against someone they claim has infringed their patent and the Institute does not believe that a person who issues a threat in good faith, believing his patent to be valid and infringed, should be treated in the same way as someone who issues threats knowingly or having reasonable grounds to suspect that he does not have a valid infringed patent. While supporting the change to Clause 11(4) introduced in the House of Lords the Institute suggest a further change:

In Clause 11(4), for insertion after Section 70(5), we suggest that it should be sufficient for A to prove that he used "reasonable endeavours to discover..." The phrase "best endeavours" has been judicially interpreted as requiring a very high level of activity. If the standard is set too high, the provision will have no effect.<sup>71</sup>

CIPA was also supportive of introducing opinions from the Patent Office as a method to 'allow small and medium-sized enterprises an impartial view of their position at low cost' and, as the opinions would be 'much less thorough and authoritative than a Court decision' they would also have to be non-binding.

#### **IV *Regulatory Reform (Patents) Order 2004***

As the Bill progresses through its Parliamentary stages it will be paralleled by the passage of secondary legislation that also amends the *Patents Act 1977*. The most interesting aspect of the dual progress is that some of the amendments to the Bill rely on amendments that are yet to be made by this secondary legislation. The commencement

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<sup>69</sup> *Ibid*

<sup>70</sup> Personal communication, *Chartered Institute of Patent Agents*, 1 June 2005

<sup>71</sup> *Ibid*

provisions within the Bill ensure that, if the Regulatory Reform Order does not come into force, then those provisions within the Bill that are dependent on it will not come into force either. Discussion between officials at the Patent Office with the Parliamentary Counsel indicates that it is possible to refer to legislation that does not yet exist within a Bill.

Information on the progress of deregulation provisions are provided on the Patent Office website:

8. It was proposed in *A Consultation Document on the Deregulation of Patents Legislation*, that patent legislation should be amended by means of an Order under the Regulatory Reform Act 2001. The consultation document was published on this web site on 25 February 2003, and is still available.

9. The consultation closed on 30 May 2003, and responses were received both from private individuals and from organisations representing virtually all those who would be affected by the proposals.

10. Having taken into account those responses, a proposed draft of the Regulatory Reform (Patents) Order 2004<sup>72</sup> (together with an explanatory document, which includes a full signed Regulatory Impact Assessment)<sup>73</sup> was laid before Parliament for initial scrutiny on Monday 10 November 2003. The Delegated Powers and Regulatory Reform Committee of the House of Lords<sup>74</sup> issued their report on 30 January 2004, and the report of the Regulatory Reform Committee of the House of Commons<sup>75</sup> was issued on 17 February 2004.<sup>76</sup>

Discussion with Patent Office officials has revealed that, since the proposals were laid before Parliament, the amendments to sections 22 and 23 and the prospective new section 23A of the *Patents Act 1977* have been withdrawn and changes to section 23 of that Act have been transferred to the Patents Bill.

It is expected that an amended proposed draft Order will be laid for the second stage of Parliamentary scrutiny in the near future, that the House of Lords debate will take place shortly before the summer recess, and that the Order will come into force very early next year.

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<sup>72</sup> <http://www.patent.gov.uk/patent/notices/misc/order.pdf>

<sup>73</sup> <http://www.patent.gov.uk/patent/notices/misc/explanation.pdf>  
and <http://www.patent.gov.uk/patent/notices/misc/corrections.pdf>

<sup>74</sup> <http://www.publications.parliament.uk/pa/ld200304/ldselect/lddelreg/32/3201.htm>

<sup>75</sup> <http://www.publications.parliament.uk/pa/cm/cmdereg.htm>

<sup>76</sup> <http://www.patent.gov.uk/patent/notices/misc/deregulation.htm>

## V How the Bill would amend the Patents Act 1977

The Patents Bill has been brought before Parliament to amend UK patent law such that it complies with international obligations and to make some practical changes to the patent process. The changes proposed in the Bill with regard to international obligations would:

- disallow the patenting of methods of treatment or diagnosis in a clearer way;
- ensure that, when considering amendments to patents after grant, the comptroller or court would have regard to any relevant principles which are applicable in amendment or limitation proceedings under the EPC;
- allow relief to be granted for infringement, or Crown use, of a partially valid patent on condition that the proprietor of a European patent (UK) limits the patent satisfactorily at the European Patent Office; and
- allow a court or the comptroller to order revocation of a European patent found to be partially invalid unless the proprietor limits his patent at the European Patent Office.

The Patent Office has consulted about various aspects of the *Patents Act 1977* and the Bill would resolve some of the issues raised in those consultations. These changes include:

- relaxing restrictions on applications abroad by United Kingdom residents;
- improving provision for the compensation of employees whose inventions confer outstanding benefits to their company;
- allowing the Patent Office to issue opinions with regard to the validity or infringement of patents.

The following tables show how the Bill would amend the current 1977 Act if the Bill were to be enacted in its current form. The existing text is presented in the left hand columns (text excised from the Bill is indicated by *italics*) and the proposed amended text in the right hand columns (text added is indicated by **bold** formatting), unchanged sections of the 1977 Act are not separately listed and [...] indicates no change. Each amendment is footnoted as to which clause in the Bill makes that amendment. Plain text that appears in both sides of the table has been inserted to provide context.

1977 Act, Section 2, Novelty	Text as amended by the Bill
(1) An invention shall be taken to be new if it does not form part of the state of the art.	(1) An invention shall be taken to be new if it does not form part of the state of the art.
(2) [...]	(2) [...]
(3) [...]	(3) [...]

<p>(4) [...]</p> <p>(5) [...]</p> <p>(6) <i>In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, 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.</i><sup>77</sup></p>	<p>(4) [...]</p> <p>(5) [...]</p>
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<b>1977 Act, Section 4, Industrial application</b>	Text as amended by the Bill
<p>(1) <i>Subject to subsection (2) below,</i><sup>78</sup> 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.</p> <p>(2) <i>An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.</i></p> <p>(3) <i>Subsection (2) above shall not prevent a product consisting of a substance or composition being treated as capable of industrial application merely because it is invented for use in any such method.</i><sup>79</sup></p>	<p>(1) 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.</p>

<b>1977 Act, Section 8, Determination before grant of questions about entitlement to patents, etc</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) Where a question is referred to the comptroller under subsection (1)(a) above and—</p> <p>(a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;</p> <p>(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</p>	<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) Where a question is referred to the comptroller under subsection (1)(a) above and—</p> <p>(a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;</p> <p>(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</p>

<sup>77</sup> Amended by Part 2 of Schedule 2 of the Bill

<sup>78</sup> Amended by Part 3 of Schedule 2 of the Bill

<sup>79</sup> Amended by Part 3 of Schedule 2 of the Bill



<p>(c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference, <i>but after the publication of the application</i>,<sup>80</sup></p> <p>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.</p>	<p>(c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference, <b>(whether the application is refused or withdrawn before or after its publication)</b>,<sup>81</sup></p> <p>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.</p>
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<b>1977 Act, Section 11, Effect of transfer of application under s 8 or 10</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) <i>Any such licence</i><sup>82</sup> shall be granted for a reasonable period and on reasonable terms.</p> <p>(5) Where an order is made as mentioned in subsection (2) above, the person in whose name the application is to proceed 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</p>	<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p><b>(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.</b><sup>83</sup></p> <p>(4) <b>A licence under subsection (3) or (3A) above</b><sup>84</sup> shall be granted for a reasonable period and on reasonable terms.</p> <p>(5) Where an order is made as mentioned in subsection (2) <b>or (3A)</b><sup>85</sup> above, the person in whose name the application is to proceed <b>or, as the case may be, who makes the new application</b><sup>86</sup> 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</p>

<sup>80</sup> Amended by Clause 6 (1) of the Bill

<sup>81</sup> Amended by Clause 6 (1) of the Bill

<sup>82</sup> Amended by Clause 6 (3) of the Bill

<sup>83</sup> Amended by Clause 6 (2) of the Bill

<sup>84</sup> Amended by Clause 6 (3) of the Bill

<sup>85</sup> Amended by Clause 6 (4) (a) of the Bill

<sup>86</sup> Amended by Clause 6 (4) (b) of the Bill

the grant of such a licence.	the question and may, if he considers it appropriate, order the grant of such a licence.
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<b>1977 Act, Section 12, Determination of questions about entitlement to foreign and convention patents, etc</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(5) [...]</p> <p>(6) In the following cases, that is to say—</p> <p>(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, 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;</p> <p>(b) [...]</p> <p>(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 <i>but after</i><sup>87</sup> publication of the application;</p> <p>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.</p>	<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(5) [...]</p> <p>(6) In the following cases, that is to say—</p> <p>(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, <b>whether before or</b><sup>88</sup> 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;</p> <p>(b) [...]</p> <p>(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 <b>or the</b><sup>89</sup> publication of the application;</p> <p>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.</p>

<b>1977 Act, Section 16, Publication of application</b>	Text as amended by the Bill
<p>(1) Subject to section 22 below, 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</p>	<p>(1) Subject to section 22 below <b>and to any prescribed restrictions</b>,<sup>90</sup> 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</p>

<sup>87</sup> Amended by Schedule 2, Part 4 (b) of the Bill

<sup>88</sup> Amended by Schedule 2, Part 4 (a) of the Bill

<sup>89</sup> Amended by Schedule 2, Part 4 (b) of the Bill

<sup>90</sup> Amended by Schedule 2, Part 5 of the Bill

<p>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.</p>	<p>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.</p>
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1977 Act	Text as amended by the Bill
<p><b>22 Information prejudicial to <i>defence of realm</i><sup>91</sup> or safety of public</b></p> <p>(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 the <i>defence of the realm</i>,<sup>92</sup> the comptroller may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(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:—</p> <p>(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 the <i>defence of the realm</i><sup>93</sup> or the safety of the public;</p> <p>(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</p>	<p><b>22 Information prejudicial to national security<sup>98</sup> or safety of public</b></p> <p>(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 the <b>national security</b>,<sup>99</sup> the comptroller may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(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:—</p> <p>(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 the <b>national security</b><sup>100</sup> or the safety of the public;</p> <p>(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</p>

<sup>91</sup> Amended by Schedule 2, Part 7 (2) of the Bill

<sup>92</sup> Amended by Schedule 2, Part 7 (3) of the Bill

<sup>93</sup> Amended by Schedule 2, Part 7 (3) of the Bill

<p>who shall continue his directions under subsection (2) above until they are revoked under paragraph (e) below;</p> <p>(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 the <i>defence of the realm</i><sup>94</sup> 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;</p> <p>(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 the <i>defence of the realm</i><sup>95</sup> or the safety of the public, he shall give notice to the comptroller to that effect; and</p> <p>(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.</p> <p>(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—</p> <p>(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, <i>inspect and authorise the United Kingdom Atomic Energy Authority to inspect the application and any documents sent to the comptroller in connection with it</i>;<sup>96</sup> and</p>	<p>who shall continue his directions under subsection (2) above until they are revoked under paragraph (e) below;</p> <p>(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 the <b>national security</b><sup>101</sup> 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;</p> <p>(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 the <b>national security</b><sup>102</sup> or the safety of the public, he shall give notice to the comptroller to that effect; and</p> <p>(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.</p> <p>(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—</p> <p>(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,</p> <p>(i) <b>inspect the application and any documents sent to the comptroller in connection with it;</b></p> <p>(ii) <b>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</b></p>
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<sup>94</sup> Amended by Schedule 2, Part 7 (3) of the Bill

<sup>95</sup> Amended by Schedule 2, Part 7 (3) of the Bill

<sup>96</sup> Amended by Schedule 2, Part 7 (4) (a) of the Bill

<sup>97</sup> Amended by Schedule 2, Part 7 (4) (b) of the Bill

<sup>98</sup> Amended by Schedule 2, Part 7 (2) of the Bill

<sup>99</sup> Amended by Schedule 2, Part 7 (3) of the Bill

<sup>100</sup> Amended by Schedule 2, Part 7 (3) of the Bill

<sup>101</sup> Amended by Schedule 2, Part 7 (3) of the Bill

<sup>102</sup> Amended by Schedule 2, Part 7 (3) of the Bill

<sup>103</sup> Amended by Schedule 2, Part 7 (4) (a) of the Bill

<sup>104</sup> Amended by Schedule 2, Part 7 (4) (b) of the Bill

<p>(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;</p> <p>and where <i>that Authority are authorised under paragraph (a) above they shall as soon as practicable report on their inspection to the Secretary of State.</i><sup>97</sup></p>	<p><b>application and any documents sent to the comptroller in connection with it,</b><sup>103</sup> and</p> <p>(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;</p> <p>and where <b>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.</b><sup>104</sup></p>
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1977 Act, Section 23, Restrictions on applications abroad by United Kingdom residents	Text as amended by the Bill
<p>(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 invention unless—</p> <p>(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</p> <p>(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.</p> <p>(2) [...]</p> <p>(3) [...]</p>	<p>(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 invention <b>if subsection (1A) below applies to that application,</b><sup>105</sup> unless—</p> <p>(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</p> <p>(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.</p> <p><b>(1A) This subsection applies to an application if—</b></p> <p>(a) <b>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></p> <p>(b) <b>the application contains information the publication of which might be prejudicial to the safety of the public.</b><sup>106</sup></p> <p>(2) [...]</p> <p>(3) [...]</p> <p><b>(4) A person is liable under subsection (3) above only if—</b></p> <p>(a) <b>he knows that filing the application, or causing it to be filed, would contravene this section; or</b></p>

<sup>105</sup> Amended by Clause 7 (1) of the Bill

<sup>106</sup> Amended by Clause 7 (2) of the Bill

	<b>(b) he is reckless as to whether filing the application, or causing it to be filed, would contravene this section.<sup>107</sup></b>
<b>1977 Act, Section 24, Publication and certificate of grant</b>	Text as amended by the Bill
<p>(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.</p> <p>(2) [...]</p> <p>(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.</p>	<p>(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.</p> <p>(2) [...]</p> <p>(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.</p> <p><b>(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.<sup>108</sup></b></p>

<b>1977 Act, Section 25, Term of patent</b>	Text as amended by the Bill
<p>[...]</p> <p>(1) [...]</p> <p>(3) <i>A patent shall cease to have effect at the end of the period prescribed for the payment of any renewal fee if it is not paid within that period.</i></p> <p>(4) <i>If during the period of six months immediately following the end of the prescribed period<sup>109</sup> 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—</i></p> <p>(a) anything done under or in relation to it during that further period shall be valid;</p> <p>(b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and</p> <p>(c) an act which would constitute the use of the patented invention for the services of the Crown if</p>	<p>(1) [...]</p> <p>(2) [...]</p> <p><b>(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.<sup>110</sup></b></p> <p>(4) <b>If during the period ending with the sixth month after the month in which the prescribed period ends<sup>111</sup> 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—</b></p> <p>(a) anything done under or in relation to it during that further period shall be valid;</p> <p>(b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and</p> <p>(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.</p>

<sup>107</sup> Amended by Clause 7 (3) of the Bill

<sup>108</sup> Amended by Schedule 2, Part 8 of the Bill

<sup>109</sup> Amended by Clause 8 (2) of the Bill

<sup>110</sup> Amended by Clause 8 (1) of the Bill

<sup>111</sup> Amended by Clause 8 (2) of the Bill

the patent had not expired shall constitute that use.	
<b>1977 Act, Section 27, General power to amend specification after grant</b>	Text as amended by the Bill
<p>(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.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(3) [...]</p>	<p>(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.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(5) [...]</p> <p><b>(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.<sup>112</sup></b></p>

<b>1977 Act, Section 28, Restoration of lapsed patents</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(1A) [...]</p> <p>(2) [...]</p> <p>(2A) [...]</p> <p>(3) If the comptroller is satisfied that—</p> <p style="padding-left: 2em;">(a) the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period, ...</p> <p style="padding-left: 2em;">(b) ...</p> <p>the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.</p>	<p>(1) [...]</p> <p>(1A) [...]</p> <p>(2) [...]</p> <p>(2A) [...]</p> <p>(3) If the comptroller is satisfied that—</p> <p style="padding-left: 2em;">(a) the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within <b>the period ending with the sixth month after the month in which the prescribed period ended,</b><sup>113</sup></p> <p style="padding-left: 4em;">...</p> <p style="padding-left: 2em;">(b) ...</p> <p>the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.</p>

<sup>112</sup> Amended by Clause 2 (1) of the Bill

<sup>113</sup> Amended by Clause 8 (3) of the Bill

1977 Act, Section 32, Register of patents etc	Text as amended by the Bill
<p>(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.</p> <p>(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—</p> <p>(a) the registration of patents and of published applications for patents;</p> <p>(b) the registration of transactions, instruments or events affecting rights in or under patents and applications;</p> <p>(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;</p> <p>(d) the correction of errors in the register and in any documents filed at the Patent Office in connection with registration; and</p> <p>(e) the publication and advertisement of anything done under this Act or rules in relation to the register.</p>	<p>(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.</p> <p>(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—</p> <p>(a) the registration of patents and of published applications for patents;</p> <p>(b) the registration of transactions, instruments or events affecting rights in or under patents and applications;</p> <p><b>(ba) the entering on the register of notices concerning opinions issued, or to be issued, under section 74A below;<sup>114</sup></b></p> <p>(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;</p> <p>(d) the correction of errors in the register and in any documents filed at the Patent Office in connection with registration; and</p> <p>(e) the publication and advertisement of anything done under this Act or rules in relation to the register.</p>

1977 Act, Section 36, Co-ownership of patents and applications for patents	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) [...]</p> <p>(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 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.</p>	<p>(1) [...]</p> <p>(2) [...]</p> <p>(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</p> <p><b>(a) amend the specification of the patent or apply for such an amendment to be allowed or for the patent to be revoked, or</b></p> <p><b>(b)</b> <sup>115</sup> 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.</p>

<sup>114</sup> Amended by Clause 13 (3) of the Bill

<sup>115</sup> Amended by Clause 9 of the Bill



<b>1977 Act, Section 38, Effect of transfer of patent under s 37</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) [...]</p> <p>(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 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.</p> <p>(4) [...]</p> <p>(5) The new proprietor or proprietors of the patent 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.</p>	<p>(1) [...]</p> <p>(2) [...]</p> <p>(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 <b>or, as the case may be, the new applicant</b><sup>116</sup> 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.</p> <p>(4) [...]</p> <p>(5) The new proprietor or proprietors <b>or, as the case may be, the new applicant</b><sup>117</sup> of the patent 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.</p>

<b>1977 Act, Section 40, Compensation of employees for certain inventions</b>	Text as amended by the Bill
<p>(1) <i>Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that the employee has made an invention belonging to the employer for which a patent has been granted, that the patent is (having regard among other things to the size and nature of the employer's undertaking) of outstanding benefit to the employer and that by reason of those facts it is just that the employee should be awarded compensation to</i></p>	<p>(1) <b>Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that—</b></p> <p><b>(a) the employee has made an invention belonging to the employer for which a patent has been granted,</b></p> <p><b>(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</b></p>

<sup>116</sup> Amended by Schedule 2, Part 9 (2) of the Bill

<sup>117</sup> Amended by Schedule 2, Part 9 (3) of the Bill

<p><i>be paid by the employer, the court or the comptroller may award him such compensation of an amount determined under section 41 below.</i></p> <p>(2) Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that—</p> <p>(a) a patent has been granted for an invention made by and belonging to the employee;</p> <p>(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;</p> <p>(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 <i>the patent</i>; and</p> <p>(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;</p> <p>the court or the comptroller may award him such compensation of an amount determined under section 41 below.</p>	<p><b>combination of both) is of outstanding benefit to the employer, and</b></p> <p>(c) <b>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.</b><sup>118</sup></p> <p>(2) Where it appears to the court or the comptroller on an application made by an employee within the prescribed period that—</p> <p>(a) a patent has been granted for an invention made by and belonging to the employee;</p> <p>(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;</p> <p>(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 <b>the invention or the patent for it (or both)</b>;<sup>119</sup> and</p> <p>(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;</p> <p>the court or the comptroller may award him such compensation of an amount determined under section 41 below.</p>
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<b>1977 Act, Section 41, Amount of compensation</b>	Text as amended by the Bill
<p>(1) <i>An award of compensation to an employee under section 40(1) or (2) above in relation to a patent for an invention 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 the patent or from the assignment, assignation or grant to a person connected with the employer of the property or any right in the invention or the property in, or any right in or under, an application for that patent.</i></p>	<p><b>(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—</b></p> <p><b>(d) the invention in question;</b></p> <p><b>(e) the patent for the invention;</b></p> <p><b>(f) the assignment, assignation or grant of—</b></p> <p><b>(i) the property or any right in the invention, or</b></p> <p><b>(ii) the property in, or any right in or under, an application for the patent, to</b></p>

<sup>118</sup> Amended by Clause 10 (1) of the Bill

<sup>119</sup> Amended by Clause 10 (2) of the Bill

<sup>120</sup> Amended by Clause 10 (4) of the Bill

<sup>121</sup> Amended by Clause 10 (4) of the Bill

<sup>122</sup> Amended by Schedule 2, Part 10 of the Bill

<p>(2) [...]</p> <p>(3) [...]</p> <p>(4) In determining the fair share of the benefit to be secured for an employee in respect of <i>a patent for</i><sup>120</sup> 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—</p> <p>(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;</p> <p>(b) the effort and skill which the employee has devoted to making the invention;</p> <p>(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</p> <p>(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.</p> <p>(5) In determining the fair share of the benefit to be secured for an employee in respect of <i>a patent for</i><sup>121</sup> 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—</p> <p>(a) any conditions in a licence or licences granted under this Act or otherwise in respect of the invention or the patent;</p> <p>(b) the extent to which the invention was made jointly by the employee with any other person; and</p> <p>(c) the contribution made by the employer to the making, developing and working of the invention as mentioned in subsection (4)(d) above.</p> <p>(6) [...]</p> <p>(7) [...]</p> <p>(8) [...]</p> <p>(9) [...]</p> <p>(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 a <i>recorded decree</i></p>	<p style="text-align: center;"><b>a person connected with the employer.</b><sup>123</sup></p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) In determining the fair share of the benefit to be secured for an employee in respect of 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—</p> <p>(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;</p> <p>(b) the effort and skill which the employee has devoted to making the invention;</p> <p>(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</p> <p>(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.</p> <p>(5) In determining the fair share of the benefit to be secured for an employee in respect of 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—</p> <p>(a) any conditions in a licence or licences granted under this Act or otherwise in respect of the invention or the patent <b>for it</b>;<sup>124</sup></p> <p>(b) the extent to which the invention was made jointly by the employee with any other person; and</p> <p>(c) the contribution made by the employer to the making, developing and working of the invention as mentioned in subsection (4)(d) above.</p> <p>(6) [...]</p> <p>(7) [...]</p> <p>(8) [...]</p> <p>(9) [...]</p> <p>(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 a <b>an extract</b></p>
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<sup>123</sup> Amended by Clause 10 (3) of the Bill

<sup>124</sup> Amended by Clause 10 (5) of the Bill

<sup>125</sup> Amended by Schedule 2, Part 10 of the Bill

<i>arbitral</i> . <sup>122</sup>	<b>registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland.</b> <sup>125</sup>
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1977 Act, Section 43, Supplementary	Text as amended by the Bill
(1) [...]	(1) [...]
(2) [...]	(2) [...]
(3) [...]	(3) [...]
(4) [...]	(4) [...]
(5) For the purposes of sections 40 and 41 above the benefit derived or expected to be derived by an employer from <i>a patent</i> <sup>126</sup> shall, where he dies before any award is made under section 40 above in respect of <i>the patent</i> , <sup>127</sup> include any benefit derived or expected to be derived from <i>the patent</i> <sup>128</sup> by his personal representatives or by any person in whom it was vested by their assent.	(5) For the purposes of sections 40 and 41 above the benefit derived or expected to be derived by an employer from <b>an invention or patent</b> <sup>129</sup> shall, where he dies before any award is made under section 40 above in respect of <b>it</b> , <sup>130</sup> include any benefit derived or expected to be derived from <b>it</b> <sup>131</sup> by his personal representatives or by any person in whom it was vested by their assent.
	<b>(6) 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.</b> <sup>132</sup>

1977 Act, Section 46, Patentee's application for entry in register that licences are available as of right	Text as amended by the Bill
(1) [...]	(1) [...]
(2) [...]	(2) [...]
(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	(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

<sup>126</sup> Amended by Clause 10 (6) (a) of the Bill

<sup>127</sup> Amended by Clause 10 (6) (b) of the Bill

<sup>128</sup> Amended by Clause 10 (6) (b) of the Bill

<sup>129</sup> Amended by Clause 10 (6) (a) of the Bill

<sup>130</sup> Amended by Clause 10 (6) (b) of the Bill

<sup>131</sup> Amended by Clause 10 (6) (b) of the Bill

<sup>132</sup> Amended by Clause 10 (7) of the Bill

<p>before the entry was made, order the licence to be exchanged for a licence of right on terms so settled;</p> <p>(c) if in proceedings for infringement of the patent (otherwise than by the importation of any article [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;</p> <p>(d) <i>the renewal fee payable in respect of the patent after the date of the entry shall be half the fee which would be payable if the entry had not been made.</i></p> <p>(3A) [...]</p>	<p>before the entry was made, order the licence to be exchanged for a licence of right on terms so settled;</p> <p>(c) if in proceedings for infringement of the patent (otherwise than by the importation of any article [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;</p> <p><b>(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.<sup>133</sup></b></p> <p>(3A) [...]</p> <p><b>(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.<sup>134</sup></b></p>
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<b>1977 Act, Section 53, Compulsory licences; supplementary provisions</b>	Text as amended by the Bill
<i>(1) Without prejudice to section 86 below (by virtue of which the Community Patent Convention has effect in the United Kingdom), sections 48 to 51 above shall have effect subject to any provision of that convention relating to the grant of compulsory licences for lack or insufficiency of exploitation as that provision applies by virtue of that section.</i>	(1) <b>[subsection omitted]</b>

<b>1977 Act, Section 58, References of disputes as to Crown use</b>	Text as amended by the Bill
<p>(1) Any dispute as to—</p> <p>(a) the exercise by a government department, or a person authorised by a government department, of the powers conferred by section 55 above,</p> <p>(b) terms for the use of an invention for the services of the Crown under that section,</p> <p>(c) the right of any person to receive any part of a payment made in pursuance of subsection (4) of that section, or</p> <p>(d) the right of any person to receive a payment under section 57A,</p>	<p>(1) Any dispute as to—</p> <p>(a) the exercise by a government department, or a person authorised by a government department, of the powers conferred by section 55 above,</p> <p>(b) terms for the use of an invention for the services of the Crown under that section,</p> <p>(c) the right of any person to receive any part of a payment made in pursuance of subsection (4) of that section, or</p> <p>(d) the right of any person to receive a payment under section 57A,</p>

<sup>133</sup> Amended by Clause 8 (4) (a) of the Bill

<sup>134</sup> Amended by Clause 8 (4) (b) of the Bill

<p>may be referred to the court by either party to the dispute after a patent has been granted for the invention.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(5) [...]</p> <p>(6) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, 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 the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.</p> <p>(7) [...]</p> <p>(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 the specification of the patent was framed in good faith and with reasonable skill and knowledge, 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.</p> <p>(9) [...]</p>	<p>may be referred to the court by either party to the dispute after a patent has been granted for the invention.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(5) [...]</p> <p>(6) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, 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</p> <p>(a) the specification of the patent as published was framed in good faith and with reasonable skill and knowledge and</p> <p><b>(b) the relief is sought in good faith<sup>135</sup></b></p> <p>(7) [...]</p> <p>(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</p> <p>(a) the specification of the patent was framed in good faith and with reasonable skill and knowledge, and</p> <p><b>(b) the relief is sought in good faith, and<sup>136</sup></b> 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.</p> <p>(9) [...]</p> <p><b>(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.<sup>137</sup></b></p>
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1977 Act, Section 60, Meaning of infringement	Text as amended by the Bill
(1) [...]	(1) [...]
(2) [...]	(2) [...]
(3) [...]	(3) [...]
(4) <i>Without prejudice to section 86 below, subsections (1) and (2) above shall not apply to any act which, under any provision of the Community Patent Convention relating to the exhaustion of the rights of the</i>	(4) <b>[subsection omitted]</b>

<sup>135</sup> Amended by Clause 2 (2) (a) of the Bill

<sup>136</sup> Amended by Clause 2 (2) (b) of the Bill

<sup>137</sup> Amended by Clause 3 (2) of the Bill

<i>proprietor of a patent, as that provision applies by virtue of that section, cannot be prevented by the proprietor of the patent.</i>	
<b>1977 Act, Section 61, Proceedings for infringement of patent</b>	Text as amended by the Bill
<p>(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—</p> <p>(a) for an injunction or interdict restraining the defendant or defender from any apprehended act of infringement;</p> <p>(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;</p> <p>(c) for damages in respect of the infringement;</p> <p>(d) for an account of the profits derived by him from the infringement;</p> <p>(e) for a declaration or declarator that the patent is valid and has been infringed by him.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) Except so far as the context requires, in the following provisions of this Act—</p> <p>(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;</p> <p>(b) any reference to a <i>plaintiff</i><sup>138</sup> or pursuer includes a reference to the proprietor of the patent; and</p> <p>(c) any reference to a defendant or defender includes a reference to any other party to the reference.</p> <p>(5) [...]</p> <p>(6) [...]</p>	<p>(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—</p> <p>(a) for an injunction or interdict restraining the defendant or defender from any apprehended act of infringement;</p> <p>(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;</p> <p>(c) for damages in respect of the infringement;</p> <p>(d) for an account of the profits derived by him from the infringement;</p> <p>(e) for a declaration or declarator that the patent is valid and has been infringed by him.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) Except so far as the context requires, in the following provisions of this Act—</p> <p>(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;</p> <p>(b) any reference to a <b>claimant</b><sup>139</sup> or pursuer includes a reference to the proprietor of the patent; and</p> <p>(c) any reference to a defendant or defender includes a reference to any other party to the reference.</p> <p>(5) [...]</p> <p>(6) [...]</p> <p><b>(7) If the comptroller awards any sum by way of damages on a reference under subsection (3) above, then—</b></p> <p><b>(a) in England and Wales, the sum shall be recoverable, if a county court so orders, by execution issued from the county court or otherwise as if it were payable under an order of that court;</b></p> <p><b>(b) in Scotland, payment of the sum may be enforced in like manner as an extract registered decree arbitral bearing a warrant</b></p>

<sup>138</sup> Amended by Schedule 2, Part 13 of the Bill

<sup>139</sup> Amended by Schedule 2, Part 13 of the Bill

	<p><b>for execution issued by the sheriff court of any sheriffdom in Scotland;</b></p> <p><b>(c) in Northern Ireland, payment of the sum may be enforced as if it were a money judgment.<sup>140</sup></b></p>
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1977 Act, Section 62, Restrictions on recovery of damages for infringement	Text as amended by the Bill
<p>(1) [...]</p> <p>(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 <i>any further period specified under</i> section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.</p> <p>(3) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, no damages shall be awarded in proceedings for an infringement of the patent committed before the decision to allow the amendment unless the court or the comptroller is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.</p>	<p>(1) [...]</p> <p>(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 <b>the further period specified in<sup>141</sup></b> section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.</p> <p>(3) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, no damages shall be awarded in proceedings for an infringement of the patent committed before the decision to allow the amendment unless the court or the comptroller is satisfied that</p> <p>(a) the specification of the patent as published was framed in good faith and with reasonable skill and knowledge <b>and</b></p> <p>(b) <b>the proceedings are brought in good faith.<sup>142</sup></b></p>

1977 Act, Section 63, Relief for infringement of partially valid patent	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) Where in any such proceedings it is found that a patent is only partially valid, the court or the comptroller shall not grant relief by way of damages, costs or expenses, except where the <i>plaintiff<sup>143</sup></i> or pursuer proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court or the comptroller may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court or the comptroller as to costs or expenses and as to the date from which damages should be reckoned.</p> <p>(3) [...]</p>	<p>(1) [...]</p> <p>(2) Where in any such proceedings it is found that a patent is only partially valid, the court or the comptroller shall not grant relief by way of damages, costs or expenses, except where the <b>claimant<sup>144</sup></b> or pursuer proves that</p> <p>(a) the specification for the patent was framed in good faith and with reasonable skill and knowledge, and</p> <p>(b) <b>the proceedings are brought in good faith and<sup>145</sup></b> in that event the court or the comptroller may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court or the comptroller as to costs or expenses and as to the date from which damages should be reckoned.</p> <p>(3) [...]</p>

<sup>140</sup> Amended by Clause 11 of the Bill

<sup>141</sup> Amended by Schedule 2, Part 14 of the Bill

<sup>142</sup> Amended by Clause 2 (3) of the Bill

<sup>143</sup> Amended by Schedule 2, Part 15 of the Bill

<sup>144</sup> Amended by Schedule 2, Part 15 of the Bill

<sup>145</sup> Amended by Clause 2 (4) of the Bill



	(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. <sup>146</sup>
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1977 Act, Section 70, Remedy for groundless threats of infringement proceedings	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) <i>In any such proceedings the plaintiff or pursuer shall, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them, be entitled to the relief claimed unless—</i></p> <p>(a) <i>the defendant or defender proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and</i></p> <p>(b) <i>the patent alleged to be infringed is not shown by the plaintiff or pursuer to be invalid in a relevant respect.</i></p> <p>(3) The said relief is—</p> <p>(a) a declaration or declarator to the effect that the threats are unjustifiable;</p> <p>(b) an injunction or interdict against the continuance of the threats; and</p> <p>(c) damages in respect of any loss which the <i>plaintiff</i><sup>147</sup> or pursuer has sustained by the threats.</p> <p>(4) <i>Proceedings may not be brought under this section for a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process.</i></p>	<p>(1) [...]</p> <p>(2) <b>In any such proceedings the claimant or pursuer shall, subject to subsection (2A) below, be entitled to the relief claimed if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them.</b></p> <p><b>(2A) If the defendant or defender proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent—</b></p> <p>(a) <b>the claimant or pursuer shall be entitled to the relief claimed only if he shows that the patent alleged to be infringed is invalid in a relevant respect;</b></p> <p>(b) <b>even if the claimant or pursuer does show that the patent is invalid in a relevant respect, he shall not be entitled to the relief claimed if the defendant or defender proves that at the time of making the threats he did not know, and had no reason to suspect, that the patent was invalid in that respect.</b><sup>148</sup></p> <p>(3) The said relief is—</p> <p>(a) a declaration or declarator to the effect that the threats are unjustifiable;</p> <p>(b) an injunction or interdict against the continuance of the threats; and</p> <p>(c) damages in respect of any loss which the <b>claimant</b><sup>149</sup> or pursuer has sustained by the threats.</p> <p>(4) <b>Proceedings may not be brought under this section for—</b></p> <p>(a) <b>a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process, or</b></p> <p>(b) <b>a threat, made to a person who has made or imported a product for disposal or used a process, to bring proceedings for an infringement alleged to consist of doing</b></p>

<sup>146</sup> Amended by Clause 3 (1) of the Bill

<sup>147</sup> Amended by Schedule 2, Part 16 of the Bill

<sup>148</sup> Amended by Clause 12 (2) of the Bill

<sup>149</sup> Amended by Schedule 2, Part 16 of the Bill

<p>(5) <i>It is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.</i></p>	<p>anything else in relation to that product or process.<sup>150</sup></p> <p>(5) <b>For the purposes of this section a person does not threaten another person with proceedings for infringement of a patent if he merely—</b></p> <p>(a) <b>provides factual information about the patent,</b></p> <p>(b) <b>makes enquiries of the other person for the sole purpose of discovering whether, or by whom, the patent has been infringed as mentioned in subsection (4)(a) above, or</b></p> <p>(c) <b>makes an assertion about the patent for the purpose of any enquiries so made.</b><sup>151</sup></p> <p>(6) <b>In proceedings under this section for threats made by one person (A) to another (B) in respect of an alleged infringement of a patent for an invention, it shall be a defence for A to prove that he used his best endeavours, without success, to discover—</b></p> <p>(a) <b>where the invention is a product, the identity of the person (if any) who made or (in the case of an imported product) imported it for disposal;</b></p> <p>(b) <b>where the invention is a process and the alleged infringement consists of offering it for use, the identity of a person who used the process;</b></p> <p>(c) <b>where the invention is a process and the alleged infringement is an act falling within section 60(1)(c) above, the identity of the person who used the process to produce the product in question;</b></p> <p><b>and that he notified B accordingly, before or at the time of making the threats, identifying the endeavours used.</b><sup>152</sup></p>
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<b>1977 Act, Section 72, Power to revoke patents on application</b>	Text as amended by the Bill
<p>(1) Subject to the following provisions of this Act, the court or the comptroller may <i>on the application of any person</i><sup>153</sup> by order revoke a patent for an invention on (but only on) any of the following grounds, that is to say—</p> <p>(a) the invention is not a patentable invention;</p> <p>(b) that the patent was granted to a person who was not entitled to be granted that patent;]</p> <p>(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;</p>	<p>(1) Subject to the following provisions of this Act, the court or the comptroller may on the application of any person by order revoke a patent for an invention <b>on the application of any person (including the proprietor of the patent)</b><sup>155</sup> on (but only on) any of the following grounds, that is to say—</p> <p>(a) the invention is not a patentable invention;</p> <p>(b) that the patent was granted to a person who was not entitled to be granted that patent;]</p> <p>(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;</p>

<sup>150</sup> Amended by Clause 12 (3) of the Bill

<sup>151</sup> Amended by Clause 12 (4) of the Bill

<sup>152</sup> Amended by Clause 12 (5) of the Bill

<sup>153</sup> Amended by Schedule 2, Part 17 of the Bill

<sup>154</sup> Amended by Clause 4 of the Bill

<sup>155</sup> Amended by Schedule 2, Part 17 of the Bill

<p>(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 section 15(4) above, in the earlier application, as filed;</p> <p>(e) the protection conferred by the patent has been extended by an amendment which should not have been allowed.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(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 <i>under section 75 below</i><sup>154</sup> to the satisfaction of the court or the comptroller, as the case may be.</p>	<p>(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 section 15(4) above, in the earlier application, as filed;</p> <p>(e) the protection conferred by the patent has been extended by an amendment which should not have been allowed.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(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 below to the satisfaction of the court or the comptroller, as the case may be.</p> <p><b>(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.<sup>156</sup></b></p>
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<b>1977 Act, Section 74, Proceedings in which validity of patent may be put in issue</b>	Text as amended by the Bill
(1) [...]	(1) [...]
(2) [...]	(2) [...]
(3) [...]	(3) [...]
(4) [...]	(4) [...]
(5) [...]	(5) [...]
(6) [...]	(6) [...]
(7) [...]	(7) [...]
(8) It is hereby declared that for the purposes of this Act the validity of a patent is not put in issue merely	(8) It is hereby declared that for the purposes of this Act the validity of a patent is not put in issue merely

<sup>156</sup> Amended by Clause 4 of the Bill

<p>because the comptroller is considering its validity in order to decide whether to revoke it under section 73 above.</p>	<p>because                  (a) <sup>157</sup> the comptroller is considering its validity in order to decide whether to revoke it under section 73 above or                  (b) <b>its validity is being considered in connection with an opinion under section 74A below or a review of such an opinion.</b><sup>158</sup></p>
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	Text as amended by the Bill
<p>[clauses added]</p>	<p><i>“Opinions by Patent Office</i></p> <p><b>74A Opinions as to validity or infringement</b></p> <p>(1) The proprietor of a patent or any other person may request the comptroller to issue an opinion—</p> <p>(a) as to whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;</p> <p>(b) as to whether, or to what extent, the invention in question is not patentable because the condition in section 1(1)(a) or (b) above is not satisfied.</p> <p>(2) Subsection (1) above applies even if the patent has expired or has been surrendered.</p> <p>(3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so—</p> <p>(a) in such circumstances as may be prescribed, or</p> <p>(b) if for any reason he considers it inappropriate in all the circumstances to do so.</p> <p>(4) An opinion under this section shall not be binding for any purposes.</p> <p>(5) An opinion under this section shall be prepared by an examiner.</p> <p>(6) For the purposes of section 101 below, only the person making a request under subsection (1) above shall be regarded as a party to a proceeding before the comptroller in relation to that request.</p> <p><b>74B Reviews of opinions under section 74A</b></p> <p>(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.</p> <p>(2) The rules may, in particular—</p> <p>(a) prescribe the circumstances in which, and the period within which, an application may be</p>

<sup>157</sup> Amended by clause 13 (2) of the Bill

<sup>158</sup> Amended by clause 13 (2) of the Bill

	<p>made;</p> <p>(b) provide that, in prescribed circumstances, proceedings for a review may not be brought or continued where other proceedings have been brought;</p> <p>(c) make provision under which, in prescribed circumstances, proceedings on a review are to be treated for prescribed purposes as if they were proceedings under section 61(1)(c) or (e), 71(1) or 72(1)(a) above;</p> <p>(d) provide for there to be a right of appeal against a decision made on a review only in prescribed cases.<sup>159</sup></p>
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1977 Act, Section 75, Amendment of patent in infringement or revocation proceedings	Text as amended by the Bill
<p>(1) In any proceedings before the court or the comptroller in which the validity of a patent <i>is</i><sup>160</sup> 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.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p>	<p>(1) In any proceedings before the court or the comptroller in which the validity of a patent <b>may be</b><sup>161</sup> 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.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(5) <b>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.</b><sup>162</sup></p>

1977 Act, Section 78, Effect of filing an application for a European patent (UK)	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(5) [...]</p>	<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) [...]</p> <p>(5) [...]</p>

<sup>159</sup> Amended by Clause 13 (1) of the Bill

<sup>160</sup> Amended by Schedule 2, Part 18 of the Bill

<sup>161</sup> Amended by Schedule 2, Part 18 of the Bill

<sup>162</sup> Amended by Clause 1 (5) of the Bill

<sup>163</sup> Amended by Schedule 1, Part 3 (3) of the Bill

<p>(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.</p> <p>(6) <i>Where between those subsections ceasing to apply to any such application and the re-establishment of the rights of the applicant a person begins in good faith to do an act which would, apart from section 55 above, constitute an infringement of the application if those subsections then applied, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by [section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly].</i><sup>163</sup></p>	<p>(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; <b>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.</b><sup>164</sup></p> <p>(6) <b>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—</b></p> <p><b>(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></p> <p><b>(b) makes in good faith effective and serious preparations to do such an act,</b></p> <p><b>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.</b></p> <p>(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.</p> <p>(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.</p> <p>(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).</p> <p><b>“Patented invention” has the same meaning as in section 55 above.”</b><sup>165</sup></p>
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<sup>164</sup> Amended by Schedule 1, Part 3 (2) of the Bill

<sup>165</sup> Amended by Schedule 1, Part 3 (3) of the Bill

1977 Act, Section 80, Authentic text of European patents and patent applications	Text as amended by the Bill
<p>(1) [...].</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) <i>Where a correction of a translation is published under subsection (3) above and before it is so published a person begins in good faith to do an act which would not constitute an infringement of the patent or application as originally translated but would (apart from section 55 above) constitute an infringement of it under the amended translation, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by [section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly].</i></p>	<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p><b>(4) Where a correction of a translation is published under subsection (3) above and before it is so published a person—</b></p> <p><b>(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></p> <p><b>(b) makes in good faith effective and serious preparations to do such an act,</b></p> <p><b>(5) 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.</b></p> <p><b>(6) 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—</b></p> <p><b>(a) the references to subsection (4) of that section were references to subsection (4) above;</b></p> <p><b>(b) the reference to the registered proprietor of the patent included a reference to the applicant.</b></p> <p><b>(7) 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.</b></p> <p><b>(8) 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.</b></p> <p><b>“Patented invention” has the same meaning as in section 55 above.”</b><sup>166</sup></p>

<sup>166</sup> Amended by Schedule 1, Part 4 of the Bill

1977 Act, Section 81, Conversion of European patent applications	Text as amended by the Bill
<p>(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 <i>in the following cases</i>:—</p> <p>(a) <i>where the application is deemed to be withdrawn under the provisions of the European Patent Convention relating to the restriction of the processing of applications;</i></p> <p>(b) <i>where under the convention the application is deemed to be withdrawn because it has not, within the period required by the convention, been received by the European Patent Office.</i><sup>167</sup></p> <p>(2) The relevant conditions referred to above are that—</p> <p>(a) <i>in the case of an application falling within subsection (1)(a) above, the European Patent Office transmits a request of the applicant to the Patent Office that his application should be converted into an application under this Act, together with a copy of the files relating to the application,</i><sup>168</sup></p> <p>(b) <i>in the case of an application falling within subsection (1)(b) above,—</i><sup>169</sup></p> <p>(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</p> <p>(ii) the central industrial property office of a country which is party to the convention, other than the United Kingdom, with which the 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</p> <p>(c) <i>in either case</i><sup>170</sup> the applicant within the relevant prescribed period pays the filing 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.</p>	<p>(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 <i>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.</i><sup>171</sup></p> <p>(2) The relevant conditions referred to above are that—</p> <p>(a)<sup>172</sup></p> <p>(b) <b>that</b><sup>173</sup> —</p> <p>(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</p> <p>(ii) the central industrial property office of a country which is party to the convention, other than the United Kingdom, with which the 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</p> <p>(c) <b>that</b><sup>174</sup> the applicant within the relevant prescribed period pays the filing 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.</p>

<sup>167</sup> Amended by Schedule 1, Part 5 (2) of the Bill

<sup>168</sup> Amended by Schedule 1, Part 5 (3) (a) of the Bill

<sup>169</sup> Amended by Schedule 1, Part 5 (3) (b) of the Bill

<sup>170</sup> Amended by Schedule 1, Part 5 (3) (c) of the Bill

<sup>171</sup> Amended by Schedule 1, Part 5 (2) of the Bill

<sup>172</sup> Amended by Schedule 1, Part 5 (3) (a) of the Bill

<sup>173</sup> Amended by Schedule 1, Part 5 (3) (b) of the Bill

<sup>174</sup> Amended by Schedule 1, Part 5 (3) (c) of the Bill



<b>1977 Act, Section 86, Implementation of Community Patent Convention</b>	Text as amended by the Bill
<p>(1) <i>All rights, powers, liabilities, obligations and restrictions from time to time created or arising by or under the Community Patent Convention and all remedies and procedures from time to time provided for by or under that convention shall by virtue of this section have legal effect in the United Kingdom and shall be used there, be recognised and available in law and be enforced, allowed and followed accordingly.</i></p> <p>(2) <i>The Secretary of State may by regulations make provision—</i></p> <p style="padding-left: 2em;">(a) <i>for implementing any obligation imposed by that convention on a domestic institution or enabling any such obligation to be implemented or enabling any rights or powers conferred on any such institution to be exercised; and</i></p> <p style="padding-left: 2em;">(b) <i>otherwise for giving effect to subsection (1) above and dealing with matters arising out of its commencement or operation.</i></p> <p>(3) <i>Regulations under this section may include any incidental, consequential, transitional or supplementary provision appearing to the Secretary of State to be necessary or expedient, including provision amending any enactment, whenever passed, other than an enactment contained in this Part of this Act, and provision for the application of any provision of the regulations outside the United Kingdom.</i></p> <p>(4) <i>Sections 12, 73(2), 77 to 80, 82 and 83 above shall not apply to any application for a European patent which under the Community Patent Convention is treated as an application for a Community patent, or to a Community patent (since any such application or patent falls within the foregoing provisions of this section).</i></p> <p>(5) <i>In this section “domestic institution” means the court, the comptroller or the Patent Office, as the case may require.</i></p>	<p>[Section omitted]<sup>175</sup></p>

<b>1977 Act, Section 87, Decisions on Community Patent Convention</b>	Text as amended by the Bill
<p><i>For the purposes of all legal proceedings, including proceedings before the comptroller, any question as to the meaning or effect of the Community Patent Convention, or as to the validity, meaning and effect of any instrument made under or in implementation of that convention by any relevant convention institution shall be treated as a</i></p>	<p>[Section omitted]<sup>176</sup></p>

<sup>175</sup> Amended by Schedule 1, Part 6 of the Bill

<sup>176</sup> Amended by Schedule 1, Part 6 of the Bill

<p><i>question of law (and if not referred to the relevant convention court, be for determination as such in accordance with the principles laid down by and any relevant decision of that court).</i></p> <p><i>(1) In this section—</i></p> <p><i>“relevant convention institution” means any institution established by or having functions under the Community Patent Convention, not being an institution of the United Kingdom or any other member state, and</i></p> <p><i>“relevant convention court” does not include—</i></p> <p><i>(a) the European Patent Office or any of its departments; or</i></p> <p><i>(b) a court of the United Kingdom or of any other member state.</i></p>	
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<b>1977 Act, Section 89, Effect of international application for patent</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) <i>For the purposes of the above provisions an application shall not be treated as an international application for a patent (UK) by reason only of its containing an indication that the applicant wishes to obtain a European patent (UK), but an application shall be so treated if it also separately designates the United Kingdom.</i></p>	<p>(1) [...]</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) <b>[subsection omitted]</b><sup>177</sup></p>

<b>1977 Act, Section 89B, Adaptation of provisions in relation to international application</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) <i>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 conditions mentioned in section 89A(3)(a) are complied with.</i><sup>178</sup></p>	<p>(1) [...]</p> <p>(2) <i>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 <b>national phase of the application begins or, if later, when published in accordance with the Treaty.</b></i><sup>179</sup></p>

<sup>177</sup> Amended by Schedule 1, Part 7 of the Bill

<sup>178</sup> Amended by Schedule 1, Part 8 of the Bill

<sup>179</sup> Amended by Schedule 1, Part 8 of the Bill

1977 Act, Section 91, Evidence of conventions and instruments under conventions	Text as amended by the Bill
<p>(1) Judicial notice shall be taken of the following, that is to say—</p> <p>(a) the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty (each of which is hereafter in this section referred to as the relevant convention);</p> <p>(b) any bulletin, journal or gazette published under the relevant convention and the register of European or Community patents kept under it; and</p> <p>(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.</p>	<p>(1) Judicial notice shall be taken of the following, that is to say—</p> <p>(a) the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty (each of which is hereafter in this section referred to as the relevant convention);</p> <p>(b) any bulletin, journal or gazette published under the relevant convention and the register of European <b>patents kept under the European Patent Convention</b>,<sup>180</sup> and</p> <p>(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.</p>

1977 Act, Section 95, Financial provisions	Text as amended by the Bill
<p>(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, <i>the Community Patent Convention</i><sup>181</sup> or the Patent Co-operation Treaty.</p> <p>(2) Any sums received by any Minister of the Crown or government department in pursuance of <i>either of those conventions</i><sup>182</sup> or that treaty shall be paid into the Consolidated Fund.</p>	<p>(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, or the Patent Co-operation Treaty.</p> <p>(2) Any sums received by any Minister of the Crown or government department in pursuance of <b>that convention</b><sup>183</sup> or that treaty shall be paid into the Consolidated Fund.</p>

1977 Act, Section 103, Extension of privilege for communications with solicitors relating to patent proceedings	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) In this section—</p> <p>“legal proceedings” includes proceedings before the comptroller;</p> <p>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</p> <p>“the relevant conventions” means the European Patent Convention, <i>the Community Patent Convention</i><sup>184</sup> and the Patent Co-operation Treaty.</p>	<p>(1) [...]</p> <p>(2) In this section—</p> <p>“legal proceedings” includes proceedings before the comptroller;</p> <p>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</p> <p>“the relevant conventions” means the European Patent Convention, and the Patent Co-operation Treaty.</p>

<sup>180</sup> Amended by Schedule 2, Part 19 of the Bill

<sup>181</sup> Amended by Schedule 2, Part 20 of the Bill

<sup>182</sup> Amended by Schedule 2, Part 20 of the Bill

<sup>183</sup> Amended by Schedule 2, Part 20 of the Bill

<sup>184</sup> Amended by Schedule 2, Part 21 of the Bill

<b>1977 Act, Section 105 Extension of privilege in Scotland for communications relating to patent proceedings</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) In this section—</p> <p>“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</p> <p>“the relevant conventions” means the European Patent Convention, <i>the Community Patent Convention</i><sup>185</sup> and the Patent Co-operation Treaty.</p>	<p>(1) [...]</p> <p>(2) In this section—</p> <p>“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</p> <p>“the relevant conventions” means the European Patent Convention, and the Patent Co-operation Treaty.</p>

<b>1977 Act, Section 107, Costs and expenses in proceedings before the comptroller</b>	Text as amended by the Bill
<p>(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.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p>(4) <i>If any of the following persons, that is to say—</i></p> <ul style="list-style-type: none"> <li>(a) <i>any person by whom a reference is made to the comptroller under section 8, 12 or 37 above;</i></li> <li>(b) <i>any person by whom an application is made to the comptroller for the revocation of a patent;</i></li> <li>(c) <i>any person by whom notice of opposition is given to the comptroller under section 27(5), 29(2), 47(6) or 52(1) above, or section 117(2) below;</i></li> </ul> <p><i>neither resides nor carries on business in the United Kingdom, the comptroller may require him to give security for the costs or expenses of the proceedings and in default of such security being given may treat the reference, application or notice as abandoned.</i><sup>186</sup></p> <p>(5) [...]</p>	<p>(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.</p> <p>(2) [...]</p> <p>(3) [...]</p> <p><b>(4) The comptroller may make an order for security for costs or expenses against any party to proceedings before him under this Act if—</b></p> <ul style="list-style-type: none"> <li><b>(a) the prescribed conditions are met, and</b></li> <li><b>(b) he is satisfied that it is just to make the order, having regard to all the circumstances of the case;</b></li> </ul> <p><b>and in default of the required security being given the comptroller may treat the reference, application or notice in question as abandoned.</b><sup>187</sup></p> <p>(5) [...]</p>

<sup>185</sup> Amended by Schedule 2, Part 21 of the Bill

<sup>186</sup> Amended by Clause 14 of the Bill

<sup>187</sup> Amended by Clause 14 of the Bill

<b>1977 Act, Section 120, Hours of business and excluded days</b>	Text as amended by the Bill
<p>(1) <i>Rules may specify</i><sup>188</sup> 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, <i>and may specify</i><sup>189</sup> days as excluded days for any such purposes.</p> <p>(2) [...]</p>	<p>(1) <b>The comptroller may give directions specifying</b><sup>190</sup> 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, <b>and the directions may specify</b><sup>191</sup> days as excluded days for any such purposes.</p> <p>(2) [...]</p> <p>(3) <b>Directions under this section shall be published in the prescribed manner.</b><sup>192</sup></p>

<b>1977 Act, Section 121, Comptroller's annual report</b>	Text as amended by the Bill
<p>Before <i>1st June</i><sup>193</sup> in every 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, <i>the Community Patent Convention</i><sup>194</sup> 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, <i>those conventions</i><sup>195</sup> and that treaty during the previous year.</p>	<p>Before <b>1st December</b><sup>196</sup> in every <b>financial</b><sup>197</sup> 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, 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, <b>that convention</b><sup>198</sup> and that treaty during the previous <b>financial</b><sup>199</sup> year.</p>

<b>1977 Act, Section 123, Rules</b>	Text as amended by the Bill
<p>(1) [...]</p> <p>(2) Without prejudice to the generality of subsection (1) above, rules may make provision—</p> <p>(a) prescribing the form and contents of applications for patents and other documents which may be</p>	<p>(1) [...]</p> <p>(2) Without prejudice to the generality of subsection (1) above, rules may make provision—</p> <p>(a) prescribing the form and contents of applications for patents and other documents which may be</p>

<sup>188</sup> Amended by Schedule 2, Part 23 (2) (a) of the Bill

<sup>189</sup> Amended by Schedule 2, Part 23 (2) (b) of the Bill

<sup>190</sup> Amended by Schedule 2, Part 23 (2) (a) of the Bill

<sup>191</sup> Amended by Schedule 2, Part 23 (2) (b) of the Bill

<sup>192</sup> Amended by Schedule 2, Part 23 (3) of the Bill

<sup>193</sup> Amended by Schedule 2, Part 24 (a) of the Bill

<sup>194</sup> Amended by Schedule 2, Part 24 (c) of the Bill

<sup>195</sup> Amended by Schedule 2, Part 24 (d) of the Bill

<sup>196</sup> Amended by Schedule 2, Part 24 (a) of the Bill

<sup>197</sup> Amended by Schedule 2, Part 24 (b) of the Bill

<sup>198</sup> Amended by Schedule 2, Part 24 (d) of the Bill

<sup>199</sup> Amended by Schedule 2, Part 24 (b) of the Bill

<sup>200</sup> Amended by Schedule 2, Part 25 (2) of the Bill

<sup>201</sup> Amended by Schedule 2, Part 25 (4) of the Bill

<p>filed at the Patent Office and requiring copies to be furnished of any such documents;</p> <p>(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;</p> <p>(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;</p> <p>(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;</p> <p>(e) requiring the comptroller to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding;</p> <p>(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;</p> <p>(g) providing for the appointment of advisers to assist the comptroller in any proceeding before him;</p> <p>(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;</p> <p>(i) <i>giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;</i><sup>200</sup></p> <p>(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;</p> <p>(k) . . . ;</p> <p>(l) providing for the publication and sale of documents in the Patent Office and of information about such documents.</p> <p>(3) [...]</p> <p>(3A) [...]</p>	<p>filed at the Patent Office and requiring copies to be furnished of any such documents;</p> <p>(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;</p> <p>(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;</p> <p>(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;</p> <p>(e) requiring the comptroller to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding;</p> <p>(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;</p> <p>(g) providing for the appointment of advisers to assist the comptroller in any proceeding before him;</p> <p>(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;</p> <p>(i) <b>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;</b><sup>202</sup></p> <p>(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;</p> <p>(k) . . . ;</p> <p>(l) providing for the publication and sale of documents in the Patent Office and of information about such documents.</p> <p><b>(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.</b><sup>203</sup></p> <p>(3) [...]</p> <p>(3A) [...]</p>
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<sup>202</sup> Amended by Schedule 2, Part 25 (2) of the Bill

<sup>203</sup> Amended by Schedule 2, Part 25 (3) of the Bill

<p>(4) <i>Rules prescribing fees shall not be made except with the consent of the Treasury.</i></p> <p>(5) <i>The remuneration of any adviser appointed under rules to assist the comptroller in any proceeding shall be determined by the Secretary of State with the consent of the Minister for the Civil Service and shall be defrayed out of moneys provided by Parliament.</i><sup>201</sup></p>	
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1977 Act, Section 130, Interpretation	Text as amended by the Bill
<p>(1) In this Act, except so far as the context otherwise requires—</p> <p>“application for a European patent (UK)” and “international application for a patent (UK)” each mean an application of the relevant description which, on its date of filing, designates the United Kingdom;</p> <p>[...]</p> <p>“Community Patent Convention” means the Convention for the European Patent for the Common Market <i>and “Community patent” means a patent granted under that convention;</i><sup>204</sup></p> <p>[...]</p> <p>“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;</p> <p>[...]</p> <p>“relevant convention court”, in relation to any proceedings under the European Patent Convention, <i>the Community Patent Convention</i><sup>205</sup> 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;</p> <p>[...]</p> <p>(2) [...]</p>	<p>(1) In this Act, except so far as the context otherwise requires—</p> <p>“application for a European patent (UK)” and <b>(subject to subsection (4A) below)</b><sup>206</sup> “international application for a patent (UK)” each mean an application of the relevant description which, on its date of filing, designates the United Kingdom;</p> <p>[...]</p> <p>“Community Patent Convention” means the Convention for the European Patent for the Common Market;</p> <p>[...]</p> <p>“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 <b>and includes a reference to a country being treated as designated in pursuance of the convention or treaty;</b><sup>207</sup></p> <p>[...]</p> <p>“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;</p> <p>[...]</p> <p>(2) [...]</p>

<sup>204</sup> Amended by Schedule 2, Part 26 (a) of the Bill

<sup>205</sup> Amended by Schedule 2, Part 26 (b) of the Bill

<sup>206</sup> Amended by Schedule 1, Part 9 (2) (a) of the Bill

<sup>207</sup> Amended by Schedule 1, Part 9 (2) (b) of the Bill

<p>(3) [...]</p> <p>(4) [...]</p> <p>(5) [...]</p>	<p>(3) [...]</p> <p>(4) [...]</p> <p><b>(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).<sup>208</sup></b></p> <p>(5) [...]</p> <p><b>(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).<sup>209</sup></b></p>
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<b>1977 Act, Section 131, Northern Ireland</b>	Text as amended by the Bill
<p>In the application of this Act to Northern Ireland—</p> <p>(a) “enactment” includes an enactment of the Parliament of Northern Ireland and a Measure of the Northern Ireland Assembly;</p> <p>(b) any reference to a government department includes a reference to a Department of the Government of Northern Ireland;</p> <p>(c) any reference to the Crown includes a reference to the Crown in right of Her Majesty’s Government in Northern Ireland;</p> <p>(d) any reference to the [Companies Act 1985] includes a reference to the corresponding enactments in force in Northern Ireland; and</p> <p>(e) . . .</p>	<p>In the application of this Act to Northern Ireland—</p> <p>(a) “enactment” includes an enactment of the Parliament of Northern Ireland and a Measure of the Northern Ireland Assembly;</p> <p>(b) any reference to a government department includes a reference to a Department of the Government of Northern Ireland;</p> <p>(c) any reference to the Crown includes a reference to the Crown in right of Her Majesty’s Government in Northern Ireland;</p> <p>(d) any reference to the [Companies Act 1985] includes a reference to the corresponding enactments in force in Northern Ireland; and</p> <p>(e) . . .</p> <p><b>(f) any reference to a claimant includes a reference to a plaintiff.<sup>210</sup></b></p>

<sup>208</sup> Amended by Schedule 1, Part 9 (3) of the Bill

<sup>209</sup> Amended by Schedule 1, Part 9 (4) of the Bill

<sup>210</sup> Amended by Schedule 2, Part 27 of the Bill