

CHAPTER 12

SECTION 48 COMPULSORY LICENCES

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12 COMPULSORY LICENCES

INTRODUCTION

12.01 Under section 48, applications may be made to the Comptroller for him to:

- a) order the grant of a licence under a patent or
- b) make an entry in the register making licences under a patent available as of right.

The grounds on which an application may be made are set out in section 48A(1) if the patent proprietor is a World Trade Organisation proprietor (as defined in section 48(5)). For proprietors who are not World Trade Organisation proprietors, the grounds are set out in section 48B(1).

The Patents & Trade Marks (World Trade Organisation) Regulations 1999 replaced the previous section 48 with the current sections 48, 48A and 48B with effect from 29 July 1999. The amendments bring the section more clearly in line with Articles 30 and 31 of the GATT Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) (1994).

Who may apply?

12.02 Any person may apply for a licence, including an existing licensee (section 48(1)).

Period during which an application may be made

12.03 An application may be made at any time after three years from the date of grant of the patent (Section 48(1)).

INITIAL ACTION

Formal Requirements

12.04 Follow procedures at 1.04 to 1.07.

Action by Litigation Assistant (A1)

12.05 Follow procedures at 1.08 to 1.09.

STATEMENT OF GROUNDS

What should the statement of grounds contain?

12.06 Follow procedures at 1.11 to 1.12.

12.07 The statement should set out the grounds on which the application is made; these should be one or more of those specified in section 48A(1) or section 48B(1).

WTO (World Trade Organisation) Proprietors

12.08 The grounds under section 48A(1) apply when the proprietor is a WTO (World Trade Organisation) proprietor. The latter is defined in section 48(5):

Section 48(5)

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

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

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

12.09 The grounds under section 48A are concerned with demand for a product being met on reasonable terms.

12.10 Section 48A(2)-(6) places certain restrictions on orders or entries in the register in respect of certain grounds under section 48A(1).

Non-WTO (World Trade Organisation) Proprietors

12.11 The grounds under section 48B(1) apply when the proprietor is a not a WTO proprietor. They are concerned with whether or not the invention is being worked or sufficiently worked.

12.12 Section 48B(2)-(5) places certain restrictions on orders or entries in the register in respect of certain grounds under section 48B(1).

What happens if the statement of grounds does not comply?

12.13 Follow procedures at 1.13 to 1.18

ADVERTISING THE APPLICATION

12.14 The application should be advertised in the Journal for opposition purposes (see rule 75).

PECS:- Advert is created in Word and imported using manual import (doc code is ADVERT)

OPPOSITION

12.15 Any person may oppose the application (see sections 52(1) and 52(2)(b) and rule 76(3)(c)).

12.16 Notice of opposition should be given on Patents Form 15. This should be filed within four weeks of the date of the advertisement of the application in the Journal. **This period can not be extended.** (See rule 76(2)(b)).

12.17 Two copies of Patents Form 15 should be filed along with two copies of a statement setting out fully the facts and grounds on which the claimant relies and the remedy which he is seeking. (See rule 76(1) and (4)).

12.18 The statement of grounds needs to be verified by a statement of truth (rule 76).

12.19 Follow procedures at 1.06 to 1.18

PECS:- Message to be sent to Inter Partes team: User = Case Officer (as allocated by B3); Message is "See new F15".

Serving the notice of opposition (see also Chapters 1 and 2)

12.20 Follow procedure for Patents Form 2 set out in paragraph 1.19.

COUNTER - STATEMENT

12.21 Follow procedures at 1.25 to 1.26.

MANAGEMENT OF PROCEEDINGS

12.22 Follow procedures at 1.28 to 1.40.

EVIDENCE ROUNDS

12.23 Follow procedures at 1.41 to 1.53.

DECISION

12.24 Follow procedures at 1.54 to 1.56.

12.25 If an application under section 48(1)(a) is allowed, the Comptroller may

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order under section 48(2)(a) the grant of a licence to the claimant on such terms as he thinks fit (see section 49). In settling the terms of any licence ordered, particular notice is taken of the provisions of sections 50 and 48A or 48B as appropriate. The royalty for a compulsory licence under section 48 should be one which would be negotiated between a willing licensor and a willing licensee.

- 12.26 If an application under section 48(1)(b) is allowed, the Comptroller may order under section 48(2)(b) that an entry be made on the register to the effect that licences under the patent are available as of right. If an application is refused, the patent is unaffected.

Updating the Register - free text entries

- 12.27 Using OPTICS, a free text entry should be made reflecting the decision as shown below:

In a decision of the comptroller dated the application filed on under section 48 for a compulsory licence/licence of right was allowed/refused. (Delete/insert text as necessary).