



INTELLECTUAL
PROPERTY OFFICE

Parts 5 and 6 of the Copyright, Designs and Patents Act 1988 [Patents related sections] (as amended)

An unofficial consolidated version of
the Patents related sections of Parts 5 and 6 of

The Copyright, Designs and Patents Act 1988

produced by Patents Legal Section

1 January 2010.

Note to users

This is an unofficial consolidation of the Patents related sections of Parts 5 and 6 of the Copyright Designs and Patents Act 1988, as amended up to and including 1 January 2010. This consolidation therefore includes amendments made by:

The Constitutional Reform Act 2005

The Legal Services Act 2007

The Legal Services Act 2007 (Consequential Amendments) Order 2009

While the greatest care has been taken in this unofficial consolidation, the Office does not accept any responsibility for errors or omissions, nor for any consequences of such errors or omissions.

Patents Legal Section

1 January 2010.

Copyright, Designs and Patents Act
Parts 5 and 6
[Patents related sections only]

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Part 5: PATENT AGENTS AND TRADE MARK AGENTS

Patent Agents

Persons permitted to carry on business of a Patent Agent

274. -(1) Any individual, partnership or body corporate may, subject to the following provisions of this Part and to the Legal Services Act 2007, carry on the business of acting as agent for others for the purpose of -

- (a) applying for or obtaining patents, in the United Kingdom or elsewhere, or
- (b) conducting proceedings before the comptroller relating to applications for, or otherwise in connection with, patents.

(2) This does not affect any restriction under the European Patent Convention as to who may act on behalf of another for any purpose relating to European patents.

The register of patent attorneys

275. -(1) There is to continue to be a register of persons who act as agent for others for the purpose of applying for or obtaining patents.

(2) In this Part a registered patent attorney means an individual whose name is entered on the register kept under this section.

(3) The register is to be kept by the Chartered Institute of Patent Attorneys.

(4) The Secretary of State may, by order, amend subsection (3) so as to require the register to be kept by the person specified in the order.

(5) Before making an order under subsection (4), the Secretary of State must consult the Legal Services Board.

(6) An order under this section must be made by statutory instrument.

(7) An order under this section may not be made unless a draft of it has been laid before, and approved by a resolution of, each House of Parliament.

Regulation of patent attorneys

275A. -(1) The person who keeps the register under section 275 may make regulations which regulate—

(a) the keeping of the register and the registration of persons;

(b) the carrying on of patent attorney work by registered persons.

(2) Those regulations may, amongst other things, make—

(a) provision as to the educational and training qualifications, and other requirements, which must be satisfied before an individual may be registered or for an individual to remain registered;

(b) provision as to the requirements which must be met by a body (corporate or unincorporate) before it may be registered, or for it to remain registered, including provision as to the management and control of the body;

(c) provision as to the educational, training and other requirements to be met by regulated persons;

(d) provision regulating the practice, conduct and discipline of registered persons or regulated persons;

(e) provision authorising in such cases as may be specified in the regulations the erasure from the register of the name of any person registered in it, or the suspension of a person's registration;

(f) provision requiring the payment of such fees as may be specified in or determined in accordance with the regulations;

(g) provision about the provision to be made by registered persons in respect of complaints made against them;

(h) provision about the keeping by registered persons or regulated persons of records and accounts;

(i) provision for reviews of or appeals against decisions made under the regulations;

(j) provision as to the indemnification of registered persons or regulated persons against losses arising from claims in respect of civil liability incurred by them.

(3) Regulations under this section may make different provision for different purposes.

(4) Regulations under this section which are not regulatory arrangements within the meaning of the Legal Services Act 2007 are to be treated as such arrangements for the purposes of that Act.

(5) Before the appointed day, regulations under this section may be made only with the approval of the Secretary of State.

(6) The powers conferred to make regulations under this section are not to be taken to prejudice—

(a) any other power which the person who keeps the register may have to make rules or regulations (however they may be described and whether they are made under an enactment or otherwise);

(b) any rules or regulations made by that person under any such power.

(7) In this section—

“appointed day” means the day appointed for the coming into force of paragraph 1 of Schedule 4 to the Legal Services Act 2007;

“manager”, in relation to a body, has the same meaning as in the Legal Services Act 2007 (see section 207);

“patent attorney work” means work done in the course of carrying on the business of acting as agent for others for the purpose of—

(a) applying for or obtaining patents, in the United Kingdom or elsewhere, or

(b) conducting proceedings before the comptroller relating to applications for, or otherwise in connection with, patents;

“registered person” means—

(a) a registered patent attorney, or

(b) a body (corporate or unincorporate) registered in the register kept under section 275;

“regulated person” means a person who is not a registered person but is a manager or employee of a body which is a registered person.

Persons entitled to describe themselves as patent agents

276. –(1) An individual who is not a registered patent attorney shall not –

(a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "patent agent" or "patent attorney"; or

(b) in the course of a business otherwise describe himself, or permit himself to be described, as a "patent agent" or "patent attorney".

(2) A partnership or other unincorporated body shall not –

(a) carry on a business under any name or other description which contains the words "patent agent" or "patent attorney"; or

(b) in the course of a business otherwise describe itself, or permit itself to be described as, a firm of "patent agents" or "patent attorneys",

unless the partnership or other body is registered in the register kept under section 275.

(3) A body corporate shall not –

(a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "patent agent" or "patent attorney"; or

(b) in the course of a business otherwise describe itself, or permit itself to be described as, a "patent agent" or "patent attorney",

unless the body corporate is registered in the register kept under section 275.

(4) Subsection (3) does not apply to a company which began to carry on business as a patent agent before 17th November 1917 if the name of a director or the manager of the company who is a registered patent attorney is mentioned as being so registered in all professional advertisements, circulars or letters issued by or with the company's consent on which its name appears.

(5) Where this section would be contravened by the use of the words "patent agent" or "patent attorney" in reference to an individual, partnership or body corporate, it is equally contravened by the use of other expressions in reference to that person, or his business or place of business, which are likely to be understood as indicating that he is entitled to be described as a "patent agent" or "patent attorney".

(6) A person who contravenes this section commits an offence and is liable on summary conviction to a fine not exceeding level 5 on the standard scale; and proceedings for such an offence may be begun

at any time within a year from the date of the offence.

(7) This section has effect subject to -

(a) section 277 (persons entitled to describe themselves as European patent attorneys, &c), and

(b) section 278(1) (use of term "patent attorney" in reference to solicitors).

Persons entitled to describe themselves as European Patent Attorneys, &c

277. -(1) The term "European patent attorney" or "European patent agent" may be used in the following cases without any contravention of section 276.

(2) An individual who is on the European list may-

(a) carry on business under a name or other description which contains the words "European patent attorney" or "European patent agent", or

(b) otherwise describe himself, or permit himself to be described, as a "European patent attorney" or "European patent agent".

(3) A partnership of which not less than the prescribed number or proportion of partners is on the European list may -

(a) carry on a business under a name or other description which contains the words "European patent attorneys" or "European patent agents", or

(b) otherwise describe itself, or permit itself to be described, as a firm which carries on the business of a "European patent attorney" or "European patent agent".

(4) A body corporate of which not less than the prescribed number or proportion of directors is on the European list may -

(a) carry on a business under a name or other description which contains the words "European patent attorney" or "European patent agent", or

(b) otherwise describe itself, or permit itself to be described as, a company which carries on the business of a "European patent attorney" or "European patent agent".

(5) Where the term "European patent attorney" or "European patent agent" may, in accordance with this section, be used in reference to an individual, partnership or body corporate, it is equally permissible to use other expressions in reference to that person, or to his business or place of business, which are likely to be understood as indicating that he is entitled to be described as a "European patent attorney" or "European patent agent."

Use of the term "patent attorney": supplementary provisions

278. -(1) The term "patent attorney" may be used in reference to a solicitor, and a firm of solicitors may be described as a firm of "patent attorneys", without any contravention of section 276.

(2) No offence is committed under the enactments restricting the use of certain expressions in reference to persons not qualified to act as solicitors -

(a) by the use of the term "patent attorney" in reference to a registered patent agent, or

(b) by the use of the term "European patent attorney" in reference to a person on the European list.

(3) The enactments referred to in subsection (2) are section 21 of the Solicitors Act 1974, section 31 of the Solicitors (Scotland) Act 1980 and Article 22 of the Solicitors (Northern Ireland) Order 1976.

Power to prescribe conditions etc for mixed partnerships and bodies corporate

279. [repealed]

Privilege for communications with patent agents

280. -(1) This section applies to -

(a) communications as to any matter relating to the protection of any invention, design, technical information, trade mark or service mark, or as to any matter involving passing off, and

(b) documents, materials or information relating to any matter mentioned in paragraph (a).

(2) Where a patent attorney acts for a client in relation to a matter mentioned in subsection (1), any communication, document, material or information to which this section applies is privileged from disclosure in like manner as if the

patent attorney had at all material times been acting as the client's solicitor.

(3) In subsection (2) "patent attorneys" means –

(a) a registered patent attorney or a person who is on the European list,

(b) a partnership entitled to describe itself as a firm of patent attorneys or as a firm carrying on the business of a European patent attorney,

(ba) an unincorporated body (other than a partnership) entitled to describe itself as a patent attorney, or

(c) a body corporate entitled to describe itself as a patent attorney or as a company carrying on the business of a European patent attorney

Power of comptroller to refuse to deal with certain agents

281. –(1) This section applies to business under the Patents Act 1949, the Registered Designs Act 1949 or the Patents Act 1977.

(2) The Secretary of State may make rules authorising the comptroller to refuse to recognise as agent in respect of any business to which this section applies –

(a) a person who has been convicted of an offence under section 88 of the Patents Act 1949, section 114 of the Patents Act 1977 or section 276 of this Act;

(b) a person whose name has been erased from and not restored to, or who is suspended from, the register of patent attorneys on the ground of misconduct;

(c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of patent attorneys, render the person liable to have the person's name erased from the register on the ground of misconduct;

(d) a partnership or body corporate of which one of the partners or directors is a person whom the comptroller could refuse to recognise under paragraph (a), (b) or (c) above.

(3) The rules may contain such incidental and supplementary provisions as appear to the

Secretary of State to be appropriate and may, in particular, prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct.

(4) Rules made under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either Houses of Parliament.

Supplementary

Offences committed by partnerships and bodies corporate

285. –(1) Proceedings for an offence under this Part alleged to have been committed by a partnership shall be brought in the name of the partnership and not in that of the partners; but without prejudice to any liability of theirs under subsection (4) below.

(2) The following provisions apply for the purposes of such proceedings as in relation to a body corporate –

(a) any rules of court relating to the service of documents;

(b) in England, Wales or Northern Ireland, Schedule 3 to the Magistrates' Courts Act 1980 or Schedule 4 to the Magistrates' Courts (Northern Ireland) Order 1981 (procedure on charge of offence).

(3) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(4) Where a partnership is guilty of an offence under this Part, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.

(5) Where an offence under this Part committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.

Interpretation

286. –(1) In this part –

"the comptroller" means the Comptroller-General of Patents, Designs and Trade Marks;

"director", in relation to a body corporate whose affairs are managed by its members, means any member of the body corporate;

"the European list" means the list of professional representatives maintained by the European Patent Office in pursuance of the European Patent Convention;

"registered patent attorney" has the meaning given by section 275(2);

"registered trade mark attorney" has the meaning given by section 282(1)

Part 6: PATENTS

Patents County Courts

Patents county courts: special jurisdiction

287. –(1) The Lord Chancellor may, with the concurrence of the Lord Chief Justice, by order made by statutory instrument designate any county court as a patents county court and confer on it jurisdiction (its "special jurisdiction") to hear and determine such descriptions of proceedings –

(a) relating to patents or designs, or

(b) ancillary to, or arising out of the same subject matter as, proceedings relating to patents or designs, as may be specified in the order.

(2) The special jurisdiction of a patents county court is exercisable throughout England and Wales, but rules of court may provide for a matter pending in one such court to be heard and determined in another or partly in that and partly in another.

(3) A patents county court may entertain proceedings within its special jurisdiction notwithstanding that no pecuniary remedy is sought.

(4) An order under this section providing for the discontinuance of any of the special jurisdiction of a patents county court may make provision as to proceedings pending in the court when the order comes into operation.

(5) Nothing in this section shall be construed as affecting the ordinary jurisdiction of a county court.

(6) The Lord Chief Justice of England and Wales may nominate a judicial office holder (as defined in

section 109(4) of the Constitutional Reform Act 2005) to exercise his functions under this section.

Financial limits in relation to proceedings within special jurisdiction of patent county court

288. –(1) Her Majesty may by Order in Council provide for limits of amount or value in relation to any description of proceedings within the special jurisdiction of a patents county court.

(2) If a limit is imposed on the amount of a claim of any description and the plaintiff has a cause of action for more than that amount, he may abandon the excess; in which case a patents county court shall have jurisdiction to hear and determine the action, but the plaintiff may not recover more than that amount.

(3) Where the court has jurisdiction to hear and determine an action by virtue of subsection (2), the judgment of the court in the action is in full discharge of all demands in respect of the cause of action, and entry of the judgment shall be made accordingly.

(4) If the parties agree, by a memorandum signed by them or by their respective solicitors or other agents, that a patents county court shall have jurisdiction in any proceedings, that court shall have jurisdiction to hear and determine the proceedings notwithstanding any limit imposed under this section.

(5) No recommendation shall be made to Her Majesty to make an Order under this section unless a draft of the Order has been laid before and approved by a resolution of each House of Parliament.

Transfer of proceedings between High Court and patent county court

289. –(1) No order shall be made under section 41 of the County Courts Act 1984 (power of High Court to order proceedings to be transferred from the county court) in respect of proceedings within the special jurisdiction of a patents county court

(2) In considering in relation to proceedings within the special jurisdiction of a patents county court whether an order should be made under section 40 or 42 of the County Courts Act 1984 (transfer of proceedings from or to the High Court), the court shall have regard to the financial position of the parties and may order the transfer of the proceedings to a patents county court or, as the case may be, refrain from ordering their transfer to the High Court notwithstanding that the

proceedings are likely to raise an important question of fact or law.

Limitation of costs where pecuniary claim could have been brought in patents county court

290. –(1) Where an action is commenced in the High Court which could have been commenced in a patents county court and in which a claim for a pecuniary remedy is made, then, subject to the provisions of this section, if the plaintiff recovers less than the prescribed amount, he is not entitled to recover any more costs than those to which he would have been entitled if the action had been brought in the county court.

(2) For this purpose a plaintiff shall be treated as recovering the full amount recoverable in respect of his claim without regard to any deduction made in respect of matters not falling to be taken into account in determining whether the action could have been commenced in a patents county court.

(3) This section does not affect any question as to costs if it appears to the High Court that there was reasonable ground for supposing the amount recoverable in respect of the plaintiff's claim to be in excess of the prescribed amount.

(4) The High Court, if satisfied that there was sufficient reason for bringing the action in the High Court, may make an order allowing the costs or any part of the costs on the High Court scale or on such one of the county court scales as it may direct.

(5) This section does not apply to proceedings brought by the Crown.

(6) In this section "the prescribed amount" means such amount as may be prescribed by Her Majesty for the purposes of this section by Order in Council.

(7) No recommendation shall be made to her Majesty to make an Order under this section unless a draft of the Order has been laid before and approved by a resolution of each House of Parliament.

Proceedings in patents county court

291. –(1) Where a county court is designated a patents county court, the Lord Chief Justice shall, after consulting the Lord Chancellor, nominate a person entitled to sit as a judge of that court as the patents judge.

(2) County court rules shall make provision for securing that, so far as is practicable and appropriate –

(a) proceedings within the special jurisdiction of a patents county court are dealt with by the patents judge, and

(b) the judge, rather than a registrar or other officer of the court, deals with interlocutory matters in the proceedings.

(3) County court rules shall make provision empowering a patents county court in proceedings within its special jurisdiction, on or without the application of any party –

(a) to appoint scientific advisers or assessors to assist the court, or

(b) to order the Patent Office to inquire into and report on any question of fact or opinion.

(4) Where the court exercises either of those powers on the application of a party, the remuneration of fees payable to the Patent Office shall be at such rate as may be determined in accordance with county court rules and shall be costs of the proceedings unless otherwise ordered by the judge.

(5) Where the court exercises either of those powers of its own motion, the remuneration or fees payable to the Patent Office shall be at such rate as may be determined by the Lord Chancellor with the approval of the Treasury and shall be paid out of money provided by Parliament.

(6) The Lord Chief Justice of England and Wales may nominate a judicial office holder (as defined in section 109(4) of the Constitutional Reform Act 2005) to exercise his functions under subsection (1).

Rights and duties of registered patent agents in relation to proceedings in patents county court

292. [repealed]

Licences of right in respect of certain patents

Restriction of acts authorised by certain licences.

293. In paragraph 4(2)(c) of Schedule 1 to the Patents Act 1977 (licences to be available as of right where term of existing patent extended), at the end insert ", but subject to paragraph 4A below", and after that paragraph insert –

"4A - (1) If the proprietor of a patent for an invention which is a product files a

declaration with the Patent Office in accordance with this paragraph, the licences to which persons are entitled by virtue of paragraph 4(2)(c) above shall not extend to a use of the product which is excepted by or under this paragraph.

(2) Pharmaceutical use is excepted, that is -

(a) use as a medicinal product within the meaning of the Medicines Act 1968, and

(b) the doing of any other act mentioned in section 60(1)(a) above with a view to such use.

(3) The Secretary of State may by order except such other uses as he thinks fit; and an order may -

(a) specify as an excepted use any act mentioned in section 60(1)(a) above, and

(b) make different provision with respect to acts done in different circumstances or for different purposes.

(4) For the purposes of this paragraph the question what uses are excepted, so far as that depends on -

(a) orders under section 130 of the Medicines Act 1968 (meaning of "medicinal product"), or

(b) orders under sub-paragraph (3) above, shall be determined in relation to a patent at the beginning of the sixteenth year of the patent.

(5) A declaration under this paragraph shall be in the prescribed form and shall be filed in the prescribed manner and within the prescribed time limits.

(6) A declaration may not be filed -

(a) in respect of a patent which has at the commencement of section 293 of the Copyright, Designs and Patents Act 1988 passed the end of its fifteenth year; or

(b) if at the date of filing there is -
(i) an existing licence for any description of excepted use of the product, or
(ii) an outstanding application under section 46(3)(a) or (b) above for the settlement by the comptroller of the terms of a

licence for any description of excepted use of the product, and, in either case, the licence took or is to take effect at or after the end of the sixteenth year of the patent.

(7) Where a declaration has been filed under this paragraph in respect of a patent -

(a) section 46(3)(c) above (restriction of remedies for infringement where licences available as of right) does not apply to an infringement of the patent in so far as it consists of the excepted use of the product after the filing of the declaration; and

(b) section 46(3)(d) above (abatement of renewal fee if licences available as of right) does not apply to the patent".

When application may be made for settlement of terms of licence

294. In Schedule 1 to the Patents Act 1977, after the paragraph inserted by section 293 above, insert -

"4B - (1) An application under section 46(3)(a) or (b) above for the settlement by the comptroller of the terms on which a person is entitled to a licence by virtue of paragraph 4(2)(c) above is ineffective if made before the beginning of the sixteenth year of the patent.

(2) This paragraph applies to applications made after the commencement of section 294 of the Copyright, Designs and Patents Act 1988 and to any application made before the commencement of that section in respect of a patent which has not at the commencement of that section passed the end of its fifteenth year."

Patents: miscellaneous amendments

295. The Patents Act 1949 and the Patents Act 1977 are amended in accordance with Schedule 5.