

BUTTERWORTHS
INTELLECTUAL
PROPERTY LAW
HANDBOOK

Ninth edition

Consultant Editor
JEREMY PHILLIPS



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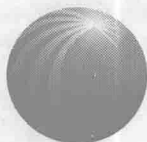
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PREFACE

Two years have passed since I wrote a preface for the eighth edition of this *Handbook*. Those two years have seen an extraordinary degree of debate and upheaval within the world of intellectual property, in a sequence of events which has so far made little mark on existing legislation at either national or international level. Foremost among the most seismic of events have been: (i) the decline and fall of The Pirate Bay and the phoenix-like ascent from its ashes of the Pirate Parties, now represented in the European Parliament; (ii) the apparently unstoppable advance of Google Book, which seems to be mopping up three hundred years of copyright in the printed word as it eliminates all opposition; (iii) the equally irresistible encroachment of Google Search and AdWords upon the ability of the trade mark owner to control the use and indeed the destiny of his trade marks online; (iv) the use of reverse payments and standard-setting cartels by patent owners as a means of dictating the terms on which generic pharmaceutical and electronic goods enter the market; (v) the composition by UNCITRAL of a set of norms which national governments are to be encouraged to observe when protecting the interests of lenders who advance money on the security of intellectual property rights; and (vi) the emergence of access to the internet as a human right, this being a right that may be both capable and worthy of protecting against the claim of copyright owners to prevent the unauthorised sharing of files containing recorded cinematographic and music works. Whether these events will resolve into legislation that will find its way into the statute books is anyone's guess.

Meanwhile, my prediction in 2007 that the next big thing in intellectual property would be the wiki has proved woefully wide of the mark. The wider issue of control and ownership of, and liability for, user-generated content has continued to fascinate and enthrall the IP community—and the wiki occupies just one small corner of the stage on which the limelight continues to be held by Facebook, MySpace, blogs and Twitter.

Within Europe, while these major debates have taken place we have seen a legislative output that consists almost entirely of irritating legislative distractions. Back in the early 1990s provisions permitting the reverse engineering of computer software and the making of back-up copies were greeted with apoplexy by some software houses who confidently predicted that the Software Directive would mean the end of software as we knew it. Nothing of the sort happened. The Directive is about as sleepy a backwater as one can imagine. Yet the Directive has been repealed and reissued because it has fulfilled the conditions for automatic tidying-up that Brussels has imposed for Community legislation. Not many people are likely to be affected by this—though the exact opposite effect has been achieved by the repeal and consolidation of the Council Regulation on the Community trade mark and the First Council Directive on the approximation of trade mark law, which have been inconveniently renumbered despite the vigorous pleas of all users of the system to leave the situation alone until the time to consider reform arises.

But enough of the law for now; let's turn to the production of this *Handbook*. As Consultant Editor I should like to pay tribute to the admirable professionalism of the members of the LexisNexis team with whom I worked, who have kept me on my toes, keeping one eye on the production timetable and another on the quality of the product. I also owe grateful thanks to my colleagues at Olswang. These include the triumvirate of partners Michael Burdon, Clive Gringras and Nigel Swycher, whose encouragement and guidance both kindles my enthusiasm and keeps its flames within manageable boundaries, and the patient, efficient Claire Walker whose nominations of materials for inclusion, each accompanied by the appropriate disclaimer, have enriched my own suggestions of items for inclusion both in this and in its shortly-to-be-published companion, the *Butterworths E-Commerce and IT Law Handbook*.

Jeremy Phillips
High Holborn
September 2009

CONTENTS

Preface

page v

PART I PATENTS

Patents Act 1977	[1]
Contracting Out (Functions in Relation to Applications for Patents) Order 2002, SI 2002/3052	[151]
Patents Act 2004 (Commencement No 1 and Consequential and Transitional Provisions) Order 2004, SI 2004/2177, arts 1, 6–8	[157]
Regulatory Reform (Patents) Order 2004, SI 2004/2357, arts 1, 20–23	[161]
Patents Act 2004 (Commencement No 2 and Consequential, etc and Transitional Provisions) Order 2004, SI 2004/3205, arts 1, 2, 9	[166]
Patents Act 2004 (Commencement No 3 and Transitional Provisions) Order 2005, SI 2005/2471	[169]
Patents (Convention Countries) Order 2007, SI 2007/276	[173]
Patents Rules 2007, SI 2007/3291	[176]
Convention on the Grant of European Patents (European Patent Convention) (5 October 1973)	[361]
Protocol on jurisdiction and the recognition of decisions in respect of the right to the grant of a European Patent (Protocol on Recognition)	[539]
Protocol on privileges and immunities of the European Patent Organisation (Protocol on Privileges and Immunities)	[541]
Protocol on the centralisation of the European Patent System and on its introduction (Protocol on Centralisation)	[542]
Protocol on the interpretation of Article 69 of the Convention	[550]
Protocol on the Staff Complement of the European Patent Office at the Hague (Protocol on Staff Complement)	[552]
Decision of the Administrative Council on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000	[731]
Patent Co-operation Treaty (June 19 1970, as amended)	[733]
Regulations under the Patent Co-operation Treaty (June 19 1970, as amended)	[802]
Patent Law Treaty (June 1 2000)	[917]
Regulations under the Patent Law Treaty (June 1 2000)	[944]
Regulation 816/2006 of the European Parliament and of the Council	[965]
Patents Act 1977: Patentable subject matter (2 November 2006)	[985]
Regulation 469/2009 concerning the supplementary protection certificate for medicinal products	[986]

PART II COPYRIGHT

Public Lending Right Act 1979	[1001]
Public Lending Right Scheme 1982 (Commencement) Order 1982, SI 1982/719	[1007]
Copyright, Designs and Patents Act 1988	[1010]
Copyright Tribunal Rules 1989, SI 1989/1129	[1410]
Broadcasting Act 1990, ss 176, 201, 203, 204	[1499]
Broadcasting Act 1996, ss 137, 149, 150	[1503]
Copyright and Rights in Performances (Notice of Seizure) Order 1989, SI 1989/1006	[1506]
Copyright (Customs) Regulations 1989, SI 1989/1178	[1509]
Copyright (Librarians and Archivists) (Copying of Copyright Material) Regulations 1989, SI 1989/1212	[1520]
Copyright (Material Open to Public Inspection) (Marking of Copies of Plans and Drawings) Order 1990, SI 1990/1427	[1531]

Duration of Copyright and Rights in Performances Regulations 1995, SI 1995/3297, regs 1–4, 12–36	[1533]
Copyright and Related Rights Regulations 1996, SI 1996/2967, regs 1–4, 16–17B, 19, 25–36	[1562]
Copyright and Rights in Databases Regulations 1997, SI 1997/3032, regs 1–4, 12–30	[1583]
Copyright and Related Rights Regulations 2003, SI 2003/2498, regs 1, 30–40 ..	[1609]
Artist's Resale Right Regulations 2006, SI 2006/346	[1621]
Copyright (Certification of Licensing Scheme for Educational Recording of Broadcasts) (Educational Recording Agency Limited) Order 2007, SI 2007/266.....	[1640]
Parliamentary Copyright (National Assembly for Wales) Order 2007, SI 2007/1116	[1644]
Copyright and Performances (Application to Other Countries) Order 2008, SI 2008/677	[1646]
Council Directive 93/83/EEC on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission	[1654]
Directive of the European Parliament and of the Council 2006/115 on rental right and lending right and on certain rights related to copyright in the field of intellectual property	[1682]
Directive of the European Parliament and of the Council 2006/116/EC on the term of protection of copyright and certain related rights.....	[1700]
Directive 2009/24 on the legal protection of computer programs	[1716]

PART III DESIGNS

Registered Designs Act 1949	[1801]
Copyright (Industrial Process and Excluded Articles) (No 2) Order 1989, SI 1989/1070	[1876]
Registered Designs Regulations 2001, SI 2001/3949, regs 1, 10–14	[1879]
Registered Designs Regulations 2003, SI 2003/550	[1885]
Community Designs (Designation of Community Design Courts) Regulations 2005, SI 2005/696.....	[1889]
Community Design Regulations 2005, SI 2005/2339	[1891]
Regulatory Reform (Registered Designs) Order 2006, SI 2006/1974, arts 1, 18, 19.....	[1902]
Registered Designs Rules 2006, SI 2006/1975.....	[1905]
Designs (Convention Countries) Order 2007, SI 2007/277	[1955]
Council Regulation 6/2002/EC on Community Designs	[1958]
Commission Regulation 2245/2002/EC implementing Council Regulation 6/2002/EC on Community Designs.....	[2076]

PART IV UNREGISTERED DESIGN RIGHT

Design Right (Semiconductor Topographies) Regulations 1989, SI 1989/1100	[2201]
Design Right (Proceedings before Comptroller) Rules 1989, SI 1989/1130	[2212]

PART V TRADE MARKS

Trade Marks Act 1994.....	[2251]
Trade Marks (Customs) Regulations 1994, SI 1994/2625.....	[2365]
Tobacco Advertising and Promotion (Brandsharing) Regulations 2004, SI 2004/1824	[2372]
Institute of Trade Mark Attorneys Order 2005, 2005/240	[2379]
Community Trade Mark Regulations 2006, SI 2006/1027	[2381]
Trade Marks (Relative Grounds) Order 2007, SI 2007/1976	[2393]
Trade Marks Rules 2008, SI 2008/1797	[2398]

Trade Marks (International Registration) Order 2008, SI 2008/2206	[2482]
First Council Directive 89/104/EEC to approximate the laws of the Member States relating to trade marks	[2497]
Council Regulation 40/94/EEC on the Community trade mark	[2514]
Commission Regulation 2868/95/EC implementing Council Regulation (EC) No 40/94 on the Community trade mark	[2681]
Commission Regulation 2869/95/EC on the Fees Payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).....	[2815]
Commission Regulation 216/96/EC laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs).....	[2830]
Council Decision 2003/793/EC approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989	[2848]
Directive 2008/95 to approximate the laws of the Member States relating to trade marks	[2851]
Regulation 207/2009	[2872]
Madrid Agreement Concerning the International Registration of Marks (14 April 1891).....	[3041]
Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (adopted at Madrid on 27 June 1989).....	[3068]
Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (April 1, 2007).....	[3094]
Trademark Law Treaty (adopted at Geneva on October 27, 1994)	[3138]
Regulations under the Trademark Law Treaty (adopted at Geneva on October 27, 1994)	[3163]
The .eu Alternative Dispute Resolution Rules 2005 (the “ADR Rules”)	[3171]
Supplemental ADR Rules of the Arbitration Court attached to the Economic Chamber of the Czech Republic and Agricultural Chamber of the Czech Republic 2005	[3174]

PART VI PLANT VARIETIES PROTECTION

Plant Varieties and Seeds Act 1964.....	[3210]
Plant Varieties Act 1997	[3223]
Plant Varieties and Seeds Tribunal Rules 1974, SI 1974/1136.....	[3279]
Plant Variety Rights Office (Extension of Functions) Regulations 1995, SI 1995/2655	[3313]
Patents and Plant Variety Rights (Compulsory Licensing) Regulations 2002, SI 2002/247	[3315]
Council Regulation 2100/94/EC on Community plant variety rights.....	[3342]
Commission Regulation 1239/95/EC of 31 May 1995 establishing implementing rules for the application of Council Regulation (EC) No 2100/94 as regards proceedings before the Community Plant Variety Office	[3461]
Commission Regulation 1768/95/EC of 24 July 1995 implementing rules on the agricultural exemption provided for in Article 14 (3) of Council Regulation (EC) No 2100/94 on Community plant variety rights.....	[3556]
International Convention for the protection of new varieties of plants	[3575]

PART VII MISCELLANEOUS

Human Rights Act 1998	[3601]
London Olympic Games and Paralympic Games Act 2006	[3629]
Civil Procedure Rules 1998, SI 1998/3132, Part 63	[3677]
Goods Infringing Intellectual Property Rights (Customs) Regulations 2004, SI 2004/1473	[3695]

Intellectual Property (Enforcement, etc) Regulations 2006, SI 2006/1028.....	[3708]
Council Regulation 3286/94/EC laying down Community procedures in the field of the common commercial policy in order to ensure the exercise of the Community's rights under international trade rules, in particular those established under the auspices of the World Trade Organization	[3713]
Directive of the European Parliament and of the Council 2001/84/EC on the resale right for the benefit of the author of an original work of art	[3729]
Directive of the European Parliament and of the Council 2004/48/EC on the enforcement of intellectual property rights.....	[3743]
Directive of the European Parliament and of the Council 2005/29/EC concerning unfair business-to-consumer commercial practices in the internal market	[3765]

PART VIII EC MATERIALS

Directive of the European Parliament and of the Council 96/9/EC on the legal protection of databases	[3846]
Directive of the European Parliament and of the Council 98/44/EC on the legal protection of biotechnological inventions	[3863]
Directive of the European Parliament and of the Council 98/71/EC on the legal protection of designs	[3881]
Directive of the European Parliament and of the Council 98/84/EC on the legal protection of services based on, or consisting of, conditional access ..	[3904]
Commission Regulation 2790/99/EC on the application of Article 81(3) of the Treaty to categories of vertical agreements and concerted practices.....	[3913]
Commission Regulation 2659/2000/EC on the application of Article 81(3) of the Treaty to categories of research and development agreements	[3927]
Directive of the European Parliament and the Council 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society.....	[3937]
Council Directive 2003/49/EC on a common system of taxation applicable to interest and royalty payments made between associated companies of different Member States	[3951]
Council Regulation 1383/2003/EC concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights.....	[3963]
Commission Regulation 772/2004/EC on the application of Article 81(3) of the Treaty to categories of technology transfer agreements	[3988]
Council Regulation 509/2006 on agricultural products and foodstuffs as traditional specialities guaranteed.....	[3999]
Council Regulation 510/2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.....	[4023]
Directive of the European Parliament and of the Council 2006/114 concerning misleading and comparative advertising.....	[4046]
Commission Regulation 1898/2006/EC laying down detailed rules of implementation of Council Regulation (EC) No 510/2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.....	[4060]
Directive 2008/121/EC of the European Parliament and of the Council of 14 January 2009 on textile names.....	[4088]

PART IX INTERNATIONAL

Paris Convention for the Protection of Industrial Property (20 March 1883).....	[4101]
The Hague Agreement Concerning the International Deposit of Industrial Designs (November 6, 1925) (The Hague Act of November 28, 1960).....	[4147]
International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (Rome, 26 October 1961)	[4180]
Locarno Agreement Establishing an International Classification for Industrial Designs (October 8, 1968).....	[4214]
Universal Copyright Convention (as revised at Paris on 24 July 1971)	[4230]
Berne Convention for the Protection of Literary and Artistic Works (Paris Act, 24 July 1971).....	[4259]
Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of their Phonograms (Geneva, October 29, 1971).....	[4312]
Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (Brussels, May 21, 1974)	[4325]
Agreement on Trade-related aspects of Intellectual Property Rights	[4337]
WIPO Copyright Treaty (Adopted by the Diplomatic Conference on December 20, 1996).....	[4410]
WIPO Performances and Phonograms Treaty (Adopted by the Diplomatic Conference on December 20, 1996)	[4435]
Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Adopted by the Diplomatic Conference on 2 July, 1999)	[4468]
Regulations under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (2 July, 1999).....	[4502]
Agreed Statements by the Diplomatic Conference Regarding the Geneva Act and the Regulations Under the Geneva Act	[4534]
Convention on Biological Diversity (Rio, June 1992).....	[4535]
Uniform Domain Name Dispute Resolution Policy (ICANN) (October 24, 1999)	[4580]
Rules for Uniform Domain Name Dispute Resolution Policy (ICANN) (October 24, 1999)	[4581]
Convention for the Safeguarding of the Intangible Cultural Heritage (UNESCO) (Paris, 17 October 2003)	[4582]
Singapore Treaty on the Law of Trademarks (27 March 2006)	[4622]
Regulations under the Singapore Treaty on the Law of Trademarks	[4654]
Index.....	p 1823

PART I PATENTS

PATENTS ACT 1977

(1977 c 37)

ARRANGEMENT OF SECTIONS

PART I
NEW DOMESTIC LAW*Patentability*

1	Patentable inventions	[1]
2	Novelty	[2]
3	Inventive step	[3]
4	Industrial application	[4]
4A	Methods of treatment or diagnosis	[5]
5	Priority date	[6]
6	Disclosure of matter, etc, between earlier and later applications	[7]

*Right to apply for and obtain a patent
and be mentioned as inventor*

7	Right to apply for and obtain a patent	[8]
8	Determination before grant of questions about entitlement to patents, etc	[9]
9	Determination after grant of questions referred before grant	[10]
10	Handling of application by joint applicants	[11]
11	Effect of transfer of application under s 8 or 10	[12]
12	Determination of questions about entitlement to foreign and convention patents, etc	[13]
13	Mention of inventor	[14]

Applications

14	Making of application	[15]
15	Date of filing application	[16]
15A	Preliminary examination	[17]
16	Publication of application	[18]

Examination and search

17	Search	[19]
18	Substantive examination and grant or refusal of patent	[20]
19	General power to amend application before grant	[21]
20	Failure of application	[22]
20A	Reinstatement of applications	[23]
20B	Effect of reinstatement under section 20A	[24]
21	Observations by third party on patentability	[25]

Security and safety

22	Information prejudicial to national security or safety of public	[26]
23	Restrictions on applications abroad by United Kingdom residents	[27]

Provisions as to patents after grant

24	Publication and certificate of grant	[28]
25	Term of patent	[29]
26	Patent not to be impugned for lack of unity	[30]
27	General power to amend specification after grant	[31]
28	Restoration of lapsed patents	[32]
28A	Effect of order for restoration of patent	[33]
29	Surrender of patents	[34]

Property in patents and applications, and registration

30	Nature of, and transactions in, patents and applications for patents	[35]
31	Nature of, and transactions in, patents and applications for patents in Scotland	[36]
32	Register of patents etc	[37]
33	Effect of registration, etc, on rights in patents	[38]
34	Rectification of register	[39]
36	Co-ownership of patents and applications for patents	[40]
37	Determination of right to patent after grant	[41]
38	Effect of transfer of patent under s 37	[42]

Employees' inventions

39	Right to employees' inventions	[43]
----	--------------------------------------	------

40	Compensation of employees for certain inventions	[44]
41	Amount of compensation	[45]
42	Enforceability of contracts relating to employee's inventions	[46]
43	Supplementary	[47]

Contracts as to patented products, etc

44	Avoidance of certain restrictive conditions	[48]
----	---	------

Licences of right and compulsory licences

46	Patentee's application for entry in register that licences are available as of right	[50]
47	Cancellation of entry made under s 46	[51]
48	Compulsory licences: general	[52]
48A	Compulsory licences: WTO proprietors	[53]
48B	Compulsory licences: other cases	[54]
49	Provisions about licences under s 48	[55]
50	Exercise of powers on applications under s 48	[56]
50A	Powers exercisable following merger and market investigations	[57]
51	Powers exercisable in consequence of report of Competition Commission	[58]
52	Opposition, appeal and arbitration	[59]
53	Compulsory licences; supplementary provisions	[60]
54	Special provisions where patented invention is being worked abroad	[61]

Use of patented inventions for services of the Crown

55	Use of patented inventions for services of the Crown	[62]
56	Interpretation, etc, of provisions about Crown use	[63]
57	Rights of third parties in respect of Crown use	[64]
57A	Compensation for loss of profit	[65]
58	References of disputes as to Crown use	[66]
59	Special provisions as to Crown use during emergency	[67]

Infringement

60	Meaning of infringement	[68]
61	Proceedings for infringement of patent	[69]
62	Restrictions on recovery of damages for infringement	[70]
63	Relief for infringement of partially valid patent	[71]
64	Right to continue use begun before priority date	[72]
65	Certificate of contested validity of patent	[73]
66	Proceedings for infringement by a co-owner	[74]
67	Proceedings for infringement by exclusive licensee	[75]
68	Effect of non-registration on infringement proceedings	[76]
69	Infringement of rights conferred by publication of application	[77]
70	Remedy for groundless threats of infringement proceedings	[78]
71	Declaration or declarator as to non-infringement	[79]

Revocation of patents

72	Power to revoke patents on application	[80]
73	Comptroller's power to revoked patents on his own initiative	[81]

Putting validity in issue

74	Proceedings in which validity of patent may be put in issue	[82]
----	---	------

Opinions by Patent Office

74A	Opinions as to validity or infringement	[83]
74B	Reviews of opinions under section 74A	[84]

*General provisions as to amendment
of patents and applications*

75	Amendment of patent in infringement or revocation proceedings	[85]
76	Amendments of applications and patents not to include added matter	[86]
76A	Biotechnological inventions	[87]

PART II

PROVISIONS ABOUT INTERNATIONAL CONVENTIONS

European patents and patent applications

77	Effect of European patent (UK)	[88]
78	Effect of filing an application for a European patent (UK)	[89]

79	Operation of s 78 in relation to certain European patent applications	[90]
80	Authentic text of European patents and patent applications	[91]
81	Conversion of European patent applications	[92]
82	Jurisdiction to determine questions as to right to a patent	[93]
83	Effect of patent decisions of competent authorities of other states	[94]

International applications for patents

89	Effect of international application for patent	[95]
89A	International and national phases of application	[96]
89B	Adaptation of provisions in relation to international application	[97]

Convention countries

90	Orders in Council as to convention countries	[98]
----	--	------

Miscellaneous

91	Evidence of conventions and instruments under conventions	[99]
92	Obtaining evidence for proceedings under the European Patent Convention	[100]
93	Enforcement of orders for costs	[101]
94	Communication of information to the European Patent Office, etc	[102]
95	Financial provisions	[103]

PART III MISCELLANEOUS AND GENERAL

Legal proceedings

97	Appeals from the comptroller	[104]
98	Proceedings in Scotland	[105]
99	General powers of the court	[106]
99A	Power of Patents Court to order report	[107]
99B	Power of Court of Session to order report	[108]
100	Burden of proof in certain cases	[109]
101	Exercise of comptroller's discretionary powers	[110]
102	Right of audience, &c in proceedings before comptroller	[111]
102A	Right of audience, &c in proceedings on appeal from the comptroller	[112]
103	Extension of privilege for communications with solicitors relating to patent proceedings	[113]
105	Extension of privilege in Scotland for communications relating to patent proceedings	[114]
106	Costs and expenses in proceedings before the Court	[115]
107	Costs and expenses in proceedings before the comptroller	[116]
108	Licences granted by order of comptroller	[117]

Offences

109	Falsification of register, etc.	[118]
110	Unauthorised claim of patent rights	[119]
111	Unauthorised claim that patent has been applied for	[120]
112	Misuse of title "Patent Office"	[121]
113	Offences by corporations	[122]

Immunity of department

116	Immunity of department as regards official acts	[123]
-----	---	-------

Administrative provisions

117	Correction of errors in patents and applications	[124]
117A	Effect of resuscitating a withdrawn application under section 117	[125]
117B	Extension of time limits specified by comptroller	[126]
118	Information about patent applications and patents, and inspection of documents	[127]
119	Service by post	[128]
120	Hours of business and excluded days	[129]
121	Comptroller's annual report	[130]

Supplemental

122	Crown's right to sell forfeited articles	[131]
123	Rules	[132]
124	Rules, regulations and orders; supplementary	[133]
124A	Use of electronic communications	[134]
125	Extent of invention	[135]

125A	Disclosure of invention by specification: availability of samples of biological material	[136]
127	Existing patents and applications	[137]
128	Priorities between patents and applications under 1949 Act and this Act.....	[138]
128A	EU compulsory licences	[138A]
128B	Supplementary protection certificates.....	[138B]
129	Application of Act to Crown	[139]
130	Interpretation	[140]
131	Northern Ireland.....	[141]
131A	Scotland.....	[142]
132	Short title, extent, commencement, consequential amendments and repeals	[143]

SCHEDULES:

Schedule A1—Derogation from patent protection in respect of biotechnological inventions	[144]
Schedule A2—Biotechnological inventions	[145]
Schedule 1—Application of 1949 Act to Existing Patents and Applications.....	[146]
Schedule 2—Application of this Act to Existing Patents and Applications.....	[147]
Schedule 4—Transitional Provisions.....	[148]
Schedule 4A—Supplementary Protection Certificates.....	[149]

An Act to establish a new law of patents applicable to future patents and applications for patents; to amend the law of patents applicable to existing patents and applications for patents; to give effect to certain international conventions on patents; and for connected purposes

[29 July 1977]

PART I NEW DOMESTIC LAW

Patentability

1 Patentable inventions

(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say—

- (a) the invention is new;
- (b) it involves an inventive step;
- (c) it is capable of industrial application;
- (d) the grant of a patent for it is not excluded by subsections (2) and (3) [or section 4A] below;

and references in this Act to a patentable invention shall be construed accordingly.

(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of—

- (a) a discovery, scientific theory or mathematical method;
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
- (d) the presentation of information;

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

[(3) A patent shall not be granted for an invention the commercial exploitation of which would be contrary to public policy or morality.

(4) For the purposes of subsection (3) above exploitation shall not be regarded as contrary to public policy or morality only because it is prohibited by any law in force in the United Kingdom or any part of it.]

(5) The Secretary of State may by order vary the provisions of subsection (2) above for the purpose of maintaining them in conformity with developments in science and technology; and no such order shall be made unless a draft of the order has been laid before, and approved by resolution of, each House of Parliament.

[1]

NOTES

Sub-s (1): words in square brackets inserted by the Patents Act 2004, s 16(1), Sch 2, paras 1, 2.

Sub-ss (3), (4): substituted by the Patents Regulations 2000, SI 2000/2037, regs 2, 3, in relation to applications for patents made on or after 28 July 2000.

2 Novelty

(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say—

- (a) that matter was contained in the application for that other patent both as filed and as published; and
- (b) the priority date of that matter is earlier than that of the invention.

(4) For the purposes of this section the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring later than the beginning of the period of six months immediately preceding the date of filing the application for the patent and either—

- (a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person—
 - (i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or
 - (ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) above or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;
- (b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor; or
- (c) the disclosure was due to, or made in consequence of the inventor displaying the invention at an international exhibition and the applicant states, on filing the application, that the invention has been so displayed and also, within the prescribed period, files written evidence in support of the statement complying with any prescribed conditions.

(5) In this section references to the inventor include references to any proprietor of the invention for the time being.

(6) ...

[2]

NOTES

Sub-s (6): repealed by the Patents Act 2004, s 16(1), (2), Sch 2, paras 1, 3, Sch 3.

3 Inventive step

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

[3]

4 Industrial application

(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.

(2), (3) ...

[4]

NOTES

Sub-s (1): words omitted repealed by the Patents Act 2004, s 16(1), (2), Sch 2, paras 1, 4(a), Sch 3.

Sub-ss (2), (3): repealed by the Patents Act 2004, s 16(1), (2), Sch 2, paras 1, 4(b), Sch 3.

[4A Methods of treatment or diagnosis

(1) A patent shall not be granted for the invention of—

- (a) a method of treatment of the human or animal body by surgery or therapy, or
- (b) a method of diagnosis practised on the human or animal body.

(2) Subsection (1) above does not apply to an invention consisting of a substance or composition for use in any such method.

(3) In the case of an invention consisting of a substance or composition for use in any such method, 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.

(4) In the case of an invention consisting of a substance or composition for a specific use in any such method, 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 that specific use does not form part of the state of the art.]

[5]

NOTES

Commencement: 13 December 2007.

Inserted by the Patents Act 2004, s 1.

5 Priority date

(1) For the purposes of this Act the priority date of an invention to which an application for a patent relates and also of any matter (whether or not the same as the invention) contained in any such application is, except as provided by the following provisions of this Act, the date of filing the application.

(2) If in or in connection with an application for a patent (the application in suit) a declaration is made, whether by the applicant or any predecessor in title of his, complying with the relevant requirements of rules and specifying one or more earlier relevant applications for the purposes of this section made by the applicant or a predecessor in title of his and [the application in suit has a date of filing during the period allowed under subsection (2A)(a) or (b) below], then—

- (a) if an invention to which the application in suit relates is supported by matter disclosed in the earlier relevant application or applications, the priority date of that invention shall instead of being the date of filing the application in suit be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them;
- (b) the priority date of any matter contained in the application in suit which was also disclosed in the earlier relevant application or applications shall be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.

[(2A) The periods are—

- (a) the period of twelve months immediately following the date of filing of the earlier specified relevant application, or if there is more than one, of the earliest of them; and
- (b) where the comptroller has given permission under subsection (2B) below for a late declaration to be made under subsection (2) above, the period commencing immediately after the end of the period allowed under paragraph (a) above and ending at the end of the prescribed period.

(2B) The applicant may make a request to the comptroller for permission to make a late declaration under subsection (2) above.

(2C) The comptroller shall grant a request made under subsection (2B) above if, and only if—

- (a) the request complies with the relevant requirements of rules; and
- (b) the comptroller is satisfied that the applicant's failure to file the application in suit within the period allowed under subsection (2A)(a) above was unintentional.]

(3) Where an invention or other matter contained in the application in suit was also disclosed in two earlier relevant applications filed by the same applicant as in the case of the application in suit or a predecessor in title of his and the second of those relevant applications was specified in or in connection with the application in suit, the second of those relevant applications shall, so far as concerns that invention or matter, be disregarded unless—

- (a) it was filed in or in respect of the same country as the first; and
- (b) not later than the date of filing the second, the first (whether or not so specified) was unconditionally withdrawn, or was abandoned or refused, without—
 - (i) having been made available to the public (whether in the United Kingdom or elsewhere);
 - (ii) leaving any rights outstanding; and
 - (iii) having served to establish a priority date in relation to another application, wherever made.

(4) The foregoing provisions of this section shall apply for determining the priority date of an invention for which a patent has been granted as they apply for determining the priority date of an invention to which an application for that patent relates.

(5) In this section “relevant application” means any of the following applications which has a date of filing, namely—

- (a) an application for a patent under this Act;
- (b) an application in or for a convention country (specified under section 90 below) for protection in respect of an invention or an application which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to such an application.