

## SCHEDULES

### SCHEDULE 4

Section 127.

#### TRANSITIONAL PROVISIONS

##### *General*

- 1 In so far as any instrument made or other thing done under any provision of the 1949 Act which is repealed by virtue of this Act could have been made or done under a corresponding provision of this Act, it shall not be invalidated by the repeals made by virtue of this Act but shall have effect as if made or done under that corresponding provision.

##### *Use of patented invention for services of the Crown*

- 2 (1) Any question whether—
- (a) an act done before the appointed day by a government department or a person authorised in writing by a government department amounts to the use of an invention for the services of the Crown ; or
  - (b) any payment falls to be made in respect of any such use (whether to a person entitled to apply for a patent for the invention, to the patentee or to an exclusive licensee) ;
- shall be determined under sections 46 to 49 of that Act and those sections shall apply accordingly.
- (2) Sections 55 to 59 above shall apply to an act so done on or after the appointed day in relation to an invention—
- (a) for which an existing patent has been granted or an existing application for a patent has been made ; or
  - (b) which was communicated before that day to a government department or any person authorised in writing by a government department by the proprietor of the patent or any person from whom he derives title ;
- and shall so apply subject to sub-paragraph (3) below, the modifications contained in paragraph 2 of Schedule 2 above and the further modification that sections 55(5) (b) and 58(10) above shall not apply in relation to an existing application.
- (3) Where an act is commenced before the appointed day and continues to be done on or after that day, then, if it would not amount to the use of an invention for the services of the Crown under the 1949 Act, its continuance on or after that day shall not amount to such use under this Act.

##### *Infringement*

- 3 (1) Any question whether an act done before the appointed day infringes an existing patent or the privileges or rights arising under a complete specification which has been published shall be determined in accordance with the law relating to

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infringement in force immediately before that day and, in addition to those provisions of the 1949 Act which continue to apply by virtue of Schedule 1 above, section 70 of that Act shall apply accordingly.

- (2) Sections 60 to 71 above shall apply to an act done on or after the appointed day which infringes an existing patent or the privileges or rights arising under a complete specification which has been published (whether before, on or after the appointed day) as they apply to infringements of a patent under this Act or the rights conferred by an application for such a patent, and shall so apply subject to sub-paragraph (3) below, the modifications contained in paragraph 2 of Schedule 2 above and the further modification that section 69(2) and (3) above shall not apply in relation to an existing application.
- (3) Where an act is commenced before the appointed day and continues to be done on or after that day, then, if it would not, under the law in force immediately before that day, amount to an infringement of an existing patent or the privileges or rights arising under a complete specification, its continuance on or after that day shall not amount to the infringement of that patent or those privileges or rights.

#### *Notice of opposition*

- 4 (1) Where notice of opposition to the grant of a patent has been given under section 14 of the 1949 Act before the appointed day, the following provisions shall apply:—
- (a) if issue has been joined on the notice before the appointed day, the opposition, any appeal from the comptroller's decision on it and any further appeal shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court;
- (b) in any other case, the notice shall be taken to have abated immediately before the appointed day.
- (2) Sub-paragraph (1)(a) above shall have effect subject to paragraph 12(2) below.

#### *Secrecy*

- 5 (1) Where directions given under section 18 of the 1949 Act in respect of an existing application (directions restricting publication of information about inventions) are in force immediately before the appointed day, they shall continue in force on and after that day and that section shall continue to apply accordingly.
- (2) Where sub-paragraph (1) above does not apply in the case of an existing application section 18 of the 1949 Act shall not apply to the application but section 22 of this Act shall.
- (3) Where the comptroller has before the appointed day served a notice under section 12 of the Atomic Energy Act 1946 (restrictions on publication of information about atomic energy etc.) in respect of an existing application that section shall continue to apply to the application on and after that day; but where no such notice has been so served that section shall not apply to the application on and after that day.

### *Revocation*

- 6 (1) Where before the appointed day an application has been made under section 33 of the 1949 Act for the revocation of a patent (the original application), the following provisions shall apply:—
- (a) if issue has been joined on the application before the appointed day, the application, any appeal from the comptroller's decision on it and any further appeal shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court;
  - (b) if issue has not been so joined, the original application shall be taken to be an application under section 33 of the 1949 Act for the revocation of the patent on whichever of the grounds referred to in section 32(1) of that Act corresponds (in the comptroller's opinion) to the ground on which the original application was made, or, if there is no ground which so corresponds, shall be taken to have abated immediately before the appointed day.
- (2) Sub-paragraph (1)(a) above shall have effect subject to paragraph 11(3) below.
- 7 (1) This paragraph applies where an application has been made before the appointed day under section 42 of the 1949 Act for the revocation of a patent.
- (2) Where the comptroller has made no order before that day for the revocation of the patent under that section, the application shall be taken to have abated immediately before that day.
- (3) Where the comptroller has made such an order before that day, then, without prejudice to section 38 of the Interpretation Act 1889, section 42 shall continue to apply to the patent concerned on and after that day as if this Act had not been enacted.

### *Licences of right and compulsory licences*

- 8 (1) Sections 35 to 41 and 43 to 45 of the 1949 Act shall continue to apply on and after the relevant day—
- (a) to any endorsement or order made or licence granted under sections 35 to 41 which is in force immediately before that day; and
  - (b) to any application made before that day under sections 35 to 41.
- (2) Any appeal from a decision or order of the comptroller instituted under sections 35 to 41 or 43 to 45 on or after the relevant day (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.
- (3) In this paragraph " the relevant day " means, in relation to section 41, the date of the passing of this Act and, in relation to sections 35 to 40 and 43 to 45, the appointed day.

### *Convention countries*

- 9 (1) Without prejudice to paragraph 1 above, an Order in Council declaring any country to be a convention country for all purposes of the 1949 Act or for the purposes of section 1(2) of that Act and in force immediately before the appointed day shall be treated as an Order in Council under section 90 above declaring that country to be a convention country for the purposes of section 5 above.

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- (2) Where an Order in Council declaring any country to be a convention country for all purposes of the 1949 Act or for the purposes of section 70 of that Act is in force immediately before the appointed day, a vessel registered in that country (whether before, on or after that day) shall be treated for the purposes of section 60 above, as it applies by virtue of paragraph 3(2) above to an existing patent or existing application, as a relevant ship and an aircraft so registered and a land vehicle owned by a person ordinarily resident in that country shall be so treated respectively as a relevant aircraft and a relevant vehicle.

*Appeals from court on certain petitions for revocation*

- 10       Where the court has given judgment on a petition under section 32(1)(j) of the 1949 Act before the appointed day, any appeal from the judgment (whether instituted before, on or after that day) shall be continued or instituted and be disposed of under the old law.

*Appeals from comptroller under continuing provisions of 1949 Act*

- 11       (1) In this paragraph "the continuing 1949 Act provisions " means the provisions of the 1949 Act which continue to apply on and after the appointed day as mentioned in paragraph 1 of Schedule 1 above.
- (2) This paragraph applies where—
- (a) the comptroller gives a decision or direction (whether before or on or after the appointed day) under any of the continuing 1949 Act provisions, and
  - (b) an appeal lies under those provisions from the decision or direction;
- but this paragraph applies subject to the foregoing provisions of this Schedule.
- (3) Where such an appeal has been instituted before the Appeal Tribunal before the appointed day, and the hearing of the appeal has begun but has not been completed before that day, the appeal (and any further appeal) shall be continued and disposed of under the old law.
- (4) Where such an appeal has been so instituted, but the hearing of it has not begun before the appointed day, it shall be transferred by virtue of this sub-paragraph to the Patents Court on that day and the appeal (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.
- (5) Any such appeal instituted on or after the appointed day shall lie to the Patents Court or, where the proceedings appealed against were held in Scotland, the Court of Session; and accordingly, the reference to the Appeal Tribunal in section 31(2) of the 1949 Act shall be taken to include a reference to the Patents Court or (as the case may be) the Court of Session.
- (6) Section 97(3) of this Act shall apply to any decision of the Patents Court on an appeal instituted on or after the appointed day from a decision or direction of the comptroller under any of the continuing 1949 Act provisions as it applies to a decision of that Court referred to in that subsection, except that for references to the sections mentioned in paragraph (a) of that subsection there shall be substituted references to sections 33, 55 and 56 of the 1949 Act.

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*Appeals from comptroller under repealed provisions of 1949 Act*

- 12 (1) This paragraph applies where an appeal to the Appeal Tribunal has been instituted before the appointed day under any provision of the 1949 Act repealed by this Act.
- (2) Where the hearing of such an appeal has begun but has not been completed before that day, the appeal (and any further appeal) shall be continued and disposed of under the old law.
- (3) Where the hearing of such an appeal has not begun before that day, it shall be transferred by virtue of this sub-paragraph to the Patents Court on that day and the appeal (and any further appeal) shall be prosecuted under the old law, but as if references in the 1949 Act and rules made under it to the Appeal Tribunal were references to the Patents Court.

*Appeals from Appeal Tribunal to Court of Appeal*

- 13 Section 87(1) of the 1949 Act shall continue to apply on and after the appointed day to any decision of the Appeal Tribunal given before that day, and any appeal by virtue of this paragraph (and any further appeal) shall be prosecuted under the old law.

*Rules*

- 14 The power to make rules under section 123 of this Act shall include power to make rules for any purpose mentioned in section 94 of the 1949 Act.

*Supplementary*

- 15 Section 97(2) of this Act applies to—
- (a) any appeal to the Patents Court by virtue of paragraph 4(1)(a), 6(1)(a), 8(2) or 11(5) above, and
  - (b) any appeal which is transferred to that Court by virtue of paragraph 11(4) or 12(3) above,
- as it applies to an appeal under that section ; and section 97 of this Act shall apply for the purposes of any such appeal instead of section 85 of the 1949 Act.
- 16 In this Schedule " the old law " means the 1949 Act, any rules made under it and any relevant rule of law as it was or they were immediately before the appointed day.
- 17 For the purposes of this Schedule—
- (a) issue is joined on a notice of opposition to the grant of a patent under section 14 of the 1949 Act when the applicant for the patent files a counter-statement fully setting out the grounds on which the opposition is contested ;
  - (b) issue is joined on an application for the revocation of a patent under section 33 of that Act when the patentee files a counter-statement fully setting out the grounds on which the application is contested.
- 18 (1) Nothing in the repeals made by this Act in sections 23 and 24 of the 1949 Act shall have effect as respects any such application as is mentioned in paragraph 3(3) of Schedule 1 above.
- (2) Nothing in the repeal by this Act of the Patents Act 1957 shall have effect as respects existing applications.

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- (3) Section 69 of the 1949 Act (which is not repealed by this Act) and section 70 of that Act (which continues to have effect for certain purposes by virtue of paragraph 3 above) shall apply as if section 68 of that Act has not been repealed by this Act and as if paragraph 9 above had not been enacted.