



# Copyright, Designs and Patents Act 1988

## 1988 CHAPTER 48

### PART VI

#### PATENTS

##### *Patents county courts*

#### **287 Patents county courts: special jurisdiction**

- (1) The Lord Chancellor may 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.

**288 Financial limits in relation to proceedings within special jurisdiction of patents county court**

- (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.

**289 Transfer of proceedings between High Court and patents county court**

- (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.

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

- (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.

## **291 Proceedings in patents county court**

- (1) Where a county court is designated a patents county court, the Lord Chancellor shall 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 or 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.

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

- (1) A registered patent agent may do, in or in connection with proceedings in a patents county court which are within the special jurisdiction of that court, anything which a solicitor of the Supreme Court might do, other than prepare a deed.
- (2) The Lord Chancellor may by regulations provide that the right conferred by subsection (1) shall be subject to such conditions and restrictions as appear to the Lord

Chancellor to be necessary or expedient; and different provision may be made for different descriptions of proceedings.

- (3) A patents county court has the same power to enforce an undertaking given by a registered patent agent acting in pursuance of this section as it has, by virtue of section 142 of the County Courts Act 1984, in relation to a solicitor.
- (4) Nothing in section 143 of the County Courts Act 1984 (prohibition on persons other than solicitors receiving remuneration) applies to a registered patent agent acting in pursuance of this section.
- (5) The provisions of county court rules prescribing scales of costs to be paid to solicitors apply in relation to registered patent agents acting in pursuance of this section.
- (6) Regulations under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

*Licences of right in respect of certain patents*

**293 Restriction of acts authorised by certain licences**

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.”.

## **294 When application may be made for settlement of terms of licence**

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 Patents: miscellaneous amendments**

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