



Patents Act 1977

1977 CHAPTER 37

PART I

NEW DOMESTIC LAW

Infringement

60 Meaning of infringement.

- (1) Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say—
 - (a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;
 - (b) where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;
 - (c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.
- (2) Subject to the following provisions of this section, a person (other than the proprietor of the patent) also infringes a patent for an invention if, while the patent is in force and without the consent of the proprietor, he supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.
- (3) Subsection (2) above shall not apply to the supply or offer of a staple commercial product unless the supply or the offer is made for the purpose of inducing the person

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supplied or, as the case may be, the person to whom the offer is made to do an act which constitutes an infringement of the patent by virtue of subsection (1) above.

[^{F1}(3A) Subsections (1) and (2) shall not apply to an act done in relation to a product that is subject to a patent where the product has been put on the market in the United Kingdom or the European Economic Area by or with the consent of the proprietor of the patent unless—

- (a) there exist legitimate reasons for the proprietor of the patent to oppose the act for the purpose of protecting the proprietor's property, and
- (b) the opposition to the act interferes with the rights of any other person no more than is necessary to achieve that purpose.]

[^{F2}(4)

(5) An act which, apart from this subsection, would constitute an infringement of a patent for an invention shall not do so if—

- (a) it is done privately and for purposes which are not commercial;
- (b) it is done for experimental purposes relating to the subject-matter of the invention;
- (c) it consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;
- (d) it consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of such a ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the internal or territorial waters of the United Kingdom;
- (e) it consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing the United Kingdom (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft, hovercraft or vehicle;
- (f) it consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing the United Kingdom as aforesaid or of the importation into the United Kingdom, or the use or storage there, of any part or accessory for such an aircraft.

[^{F3}(g) it consists of the use by a farmer of the product of his harvest for propagation or multiplication by him on his own holding, where there has been a sale of plant propagating material to the farmer by the proprietor of the patent or with his consent for agricultural use;

(h) it consists of the use of an animal or animal reproductive material by a farmer for an agricultural purpose following a sale to the farmer, by the proprietor of the patent or with his consent, of breeding stock or other animal reproductive material which constitutes or contains the patented invention.]

[^{F4}(i) it consists of—

- (i) an act done in conducting a study, test or trial which is necessary for and is conducted with a view to the application of paragraphs 1 to 5 of article 13 of Directive [2001/82/EC](#) or paragraphs 1 to 4 of article 10 of Directive [2001/83/EC](#), or
- (ii) any other act which is required for the purpose of the application of those paragraphs.]

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- [^{F5}(j) it consists of a use referred to in Article 27(c) of the Agreement on a Unified Patent Court;
 - (k) subject to subsection (6H), it consists of an act or use referred to in Article 27(k) of the Agreement on a Unified Patent Court.]
 - (6) For the purposes of subsection (2) above a person who does an act in relation to an invention which is prevented only by virtue of paragraph (a), (b) or (c) of subsection (5) above from constituting an infringement of a patent for the invention shall not be treated as a person entitled to work the invention, but—
 - (a) the reference in that subsection to a person entitled to work an invention includes a reference to a person so entitled by virtue of section 55 above, and
 - (b) a person who by virtue of [^{F6}section 20B(4) or (5) above or][^{F7}section 28A(4) or (5)] above or section 64 below [^{F8}or section 117A(4) or (5) below] is entitled to do an act in relation to the invention without it constituting such an infringement shall, so far as concerns that act, be treated as a person entitled to work the invention.
- [^{F9}(6A) Schedule A1 contains—
 - (a) provisions restricting the circumstances in which subsection (5)(g) applies; and
 - (b) provisions which apply where an act would constitute an infringement of a patent but for subsection (5)(g).
- (6B) For the purposes of subsection (5)(h), use for an agricultural purpose—
 - (a) includes making an animal or animal reproductive material available for the purposes of pursuing the farmer’s agricultural activity; but
 - (b) does not include sale within the framework, or for the purposes, of a commercial reproduction activity.
- (6C) In paragraphs (g) and (h) of subsection (5) “sale” includes any other form of commercialisation.]
- [^{F10}(6D) For the purposes of subsection (5)(b), anything done in or for the purposes of a medicinal product assessment which would otherwise constitute an infringement of a patent for an invention is to be regarded as done for experimental purposes relating to the subject-matter of the invention.
- (6E) In subsection (6D), “medicinal product assessment” means any testing, course of testing or other activity undertaken with a view to providing data for any of the following purposes—
 - (a) obtaining or varying an authorisation to sell or supply, or offer to sell or supply, a medicinal product (whether in the United Kingdom or elsewhere);
 - (b) complying with any regulatory requirement imposed (whether in the United Kingdom or elsewhere) in relation to such an authorisation;
 - (c) enabling a government or public authority (whether in the United Kingdom or elsewhere), or a person (whether in the United Kingdom or elsewhere) with functions of—
 - (i) providing health care on behalf of such a government or public authority, or
 - (ii) providing advice to, or on behalf of, such a government or public authority about the provision of health care,

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to carry out an assessment of suitability of a medicinal product for human use for the purpose of determining whether to use it, or recommend its use, in the provision of health care.

(6F) In subsection (6E) and this subsection—

“medicinal product” means a medicinal product for human use or a veterinary medicinal product;

“medicinal product for human use” has the meaning given by article 1 of Directive 2001/83/EC;

“veterinary medicinal product” has the meaning given by article 1 of Directive 2001/82/EC.

(6G) Nothing in subsections (6D) to (6F) is to be read as affecting the application of subsection (5)(b) in relation to any act of a kind not falling within subsection (6D).]

[^{F11}(6H) Subsection 5(k) applies to an act or use in relation to a European patent (UK) or a European patent with unitary effect, but does not apply to an act or use in relation to a patent granted by the comptroller.]

(7) In this section—

“relevant ship” and “relevant aircraft, hovercraft or vehicle” mean respectively a ship and an aircraft, hovercraft or vehicle registered in, or belonging to, any country, other than the United Kingdom, which is a party to the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 [^{F12}or which is a member of the World Trade Organisation]; and

“exempted aircraft” means an aircraft to which [^{F13}section 89 of the Civil Aviation Act 1982] section 53 of the ^{M1}Civil Aviation Act 1949 (aircraft exempted from seizure in respect of patent claims) applies.

[^{F14}“Directive 2001/82/EC” means Directive 2001/82/EC of the European Parliament and of the Council on the Community code relating to veterinary medicinal products as amended by [^{F15}Directive 2004/28/EC] of the European Parliament and of the Council;

“Directive 2001/83/EC” means Directive 2001/83/EC of the European Parliament and of the Council on the Community code relating to medicinal products for human use, as amended by Directive 2002/98/EC of the European Parliament and of the Council, by Commission Directive 2003/63/EC and by Directives 2004/24/EC and 2004/27/EC of the European Parliament and of the Council]

Textual Amendments

- F1** S. 60(3A) inserted (31.12.2023 immediately before the end of 2023) by [The Intellectual Property \(Exhaustion of Rights\) \(Amendment\) Regulations 2023 \(S.I. 2023/1287\)](#), regs. 1(b), 3
- F2** S. 60(4) repealed (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), Sch. 2 para. 13, [Sch. 3](#); S.I. 2004/3205, art. 2(g)(k) (with art. 9)
- F3** S. 60(5)(g)(h) inserted (28.7.2000) by [S.I. 2000/2037](#), [reg. 4\(a\)](#)
- F4** S. 60(5)(i) inserted (30.10.2005) by [Medicines \(Marketing Authorisations Etc.\) Amendment Regulations 2005 \(S.I. 2005/2759\)](#), regs. 1(a), 3(a)
- F5** S. 60(5)(j)(k) inserted (coming into force in accordance with art. 1(2)) by [The Patents \(European Patent with Unitary Effect and Unified Patent Court\) Order 2016 \(S.I. 2016/388\)](#), arts. 1(2), [2\(3\)](#) (with art. 3)

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- F6** Words in s. 60(6)(b) inserted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), **11(a)** (with arts. 20-23)
- F7** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 8(a)**
- F8** Words in s. 60(6)(b) inserted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), **11(b)** (with arts. 20-23)
- F9** S. 60(6A)(6B)(6C) inserted (28.7.2000) by [S.I. 2000/2037](#), **reg. 4(b)**
- F10** S. 60(6D)-(6G) inserted (1.10.2014) by [The Legislative Reform \(Patents\) Order 2014 \(S.I. 2014/1997\)](#), arts. 1(2), 2
- F11** S. 60(6H) inserted (coming into force in accordance with art. 1(2)) by [The Patents \(European Patent with Unitary Effect and Unified Patent Court\) Order 2016 \(S.I. 2016/388\)](#), arts. 1(2), **2(4)** (with art. 3)
- F12** Words in s. 60(7) in the definition of “relevant ship” and “relevant aircraft, hovercraft or vehicle” inserted (29.7.1999) by virtue of [S.I. 1999/1899](#), **reg. 7**
- F13** Words substituted by [Civil Aviation Act 1982 \(c. 16, SIF 9\)](#), s. 109, **Sch. 15 para. 19**
- F14** Words in s. 60(7) inserted (30.10.2005) by [Medicines \(Marketing Authorisations Etc.\) Amendment Regulations 2005 \(S.I. 2005/2759\)](#), regs. 1(a), **3(b)**
- F15** Words in s. 60(7) substituted (1.10.2014) by [Intellectual Property Act 2014 \(c. 18\)](#), s. 24(1), **Sch. para. 5**; [S.I. 2014/2330](#), art. 3, Sch.

Marginal Citations

- M1** 1949 c. 67.

61 Proceedings for infringement of patent.

- (1) Subject to the following provisions of this Part of this Act, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made—
- (a) for an injunction or interdict restraining the defendant or defender from any apprehended act of infringement;
 - (b) for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
 - (c) for damages in respect of the infringement;
 - (d) for an account of the profits derived by him from the infringement;
 - (e) for a declaration or declarator that the patent is valid and has been infringed by him.
- (2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.
- (3) The proprietor of a patent and any other person may by agreement with each other refer to the comptroller the question whether that other person has infringed the patent and on the reference the proprietor of the patent may make any claim mentioned in subsection (1)(c) or (e) above.
- (4) Except so far as the context requires, in the following provisions of this Act—
- (a) any reference to proceedings for infringement and the bringing of such proceedings includes a reference to a reference under subsection (3) above and the making of such a reference;
 - (b) any reference to a [^{F16}claimant] or pursuer includes a reference to the proprietor of the patent; and

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- (c) any reference to a defendant or defender includes a reference to any other party to the reference.
- (5) If it appears to the comptroller on a reference under subsection (3) above that the question referred to him would more properly be determined by the court, he may decline to deal with it and the court shall have jurisdiction to determine the question as if the reference were proceedings brought in the court.
- (6) Subject to the following provisions of this Part of this Act, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted the court or the comptroller shall apply the principles applied by the court in relation to that kind of relief immediately before the appointed day.
- [^{F17}(7) If the comptroller awards any sum by way of damages on a reference under subsection (3) above, then—
 - (a) in England and Wales, the sum shall be recoverable, if [^{F18}the county court] so orders, [^{F19}under section 85 of the County Courts Act 1984] or otherwise as if it were payable under an order of that court;
 - (b) in Scotland, payment of the sum may be enforced in like manner as an extract registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland;
 - (c) in Northern Ireland, payment of the sum may be enforced as if it were a money judgment.]

Textual Amendments

- F16** Word in s. 61(4)(b) substituted (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 2 para. 14](#); [S.I. 2004/3205](#), [art. 2\(k\)](#) (with [art. 9](#))
- F17** S. 61(7) inserted (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), [ss. 11](#), 17(1); [S.I. 2004/3205](#), [art. 2\(d\)](#) (with [art. 9](#))
- F18** Words in s. 61(7)(a) substituted (E.W.S.) (22.4.2014) by [Crime and Courts Act 2013 \(c. 22\)](#), s. 61(3), [Sch. 9 para. 52](#); [S.I. 2014/954](#), [art. 2\(c\)](#) (with [art. 3](#)) (with transitional provisions and savings in [S.I. 2014/956](#), arts. 3-11)
- F19** Words in s. 61(7)(a) substituted (6.4.2014) by [Tribunals, Courts and Enforcement Act 2007 \(c. 15\)](#), s. 148, [Sch. 13 para. 41](#) (with [s. 89](#)); [S.I. 2014/768](#), [art. 2\(1\)\(b\)](#)

62 Restrictions on recovery of damages for infringement.

- (1) In proceedings for infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant or defender who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed; and a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word “patent” or “patented”, or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent [^{F20}or a relevant internet link] accompanied the word or words in question.
- [^{F21}(1A) The reference in subsection (1) to a relevant internet link is a reference to an address of a posting on the internet—
 - (a) which is accessible to the public free of charge, and
 - (b) which clearly associates the product with the number of the patent.]

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- (2) In proceedings for infringement of a patent the court or the comptroller may, if it or he thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during [^{F22}the further period specified in] section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.
- (3) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, [^{F23}the court or the comptroller shall, when awarding damages or making an order for an account of profits in proceedings for an infringement of the patent committed before the decision to allow the amendment, take into account the following—
- (a) whether at the date of infringement the defendant or defender knew, or had reasonable grounds to know, that he was infringing the patent;
 - (b) whether the specification of the patent as published was framed in good faith and with reasonable skill and knowledge;
 - (c) whether the proceedings are brought in good faith.]

Textual Amendments

- F20** Words in s. 62(1) inserted (1.10.2014) by [Intellectual Property Act 2014 \(c. 18\)](#), **ss. 15(1)**, 24(1); S.I. 2014/2330, **art. 3**, **Sch.** (with **art. 5**)
- F21** S. 62(1A) inserted (1.10.2014) by [Intellectual Property Act 2014 \(c. 18\)](#), **ss. 15(2)**, 24(1); S.I. 2014/2330, **art. 3**, **Sch.**
- F22** Words in s. 62(2) substituted (1.10.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), **Sch. 2 para. 15**; S.I. 2005/2471, **art. 2(g)**
- F23** Words in s. 62(3) substituted (29.4.2006) by [Intellectual Property \(Enforcement, etc\) Regulations 2006 \(S.I. 2006/1028\)](#), **art. 1**, **Sch. 2 para. 2**

63 Relief for infringement of partially valid patent.

- (1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the comptroller may, subject to subsection (2) below, grant relief in respect of that part of the patent which is found to be valid and infringed.
- (2) Where in any such proceedings it is found that a patent is only partially valid, the court or the comptroller shall [^{F24}, when awarding damages, costs or expenses or making an order for an account of profits, take into account the following—
- (a) whether at the date of the infringement the defendant or defender knew, or had reasonable grounds to know, that he was infringing the patent;
 - (b) whether the specification of the patent was framed in good faith and with reasonable skill and knowledge;
 - (c) whether the proceedings are brought in good faith;
- and any relief granted shall be subject to the discretion of the court or the comptroller as to costs or expenses and as to the date from which damages or an account should be reckoned.]
- (3) As a condition of relief under this section the court or the comptroller may direct that the specification of the patent shall be amended to its or his satisfaction upon an application made for that purpose under section 75 below, and an application may

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be so made accordingly, whether or not all other issues in the proceedings have been determined.

[^{F25}(4) The court or the comptroller may also grant relief under this section in the case of a European patent (UK) on condition that the claims of the patent are limited to its or his satisfaction by the European Patent Office at the request of the proprietor.]

Textual Amendments

F24 Words in s. 63(2) substituted (29.4.2006) by [Intellectual Property \(Enforcement, etc\) Regulations 2006 \(S.I. 2006/1028\)](#), art. 1, **Sch. 2 para. 3**

F25 S. 63(4) inserted (13.12.2007) by [Patents Act 2004 \(c. 16\)](#), **ss. 3(1)**, 17(1); [S.I. 2007/3396](#), art. 2(e)

[^{F26}64 **Right to continue use begun before priority date.**

- (1) Where a patent is granted for an invention, a person who in the United Kingdom before the priority date of the invention—
 - (a) does in good faith an act which would constitute an infringement of the patent if it were in force, or
 - (b) makes in good faith effective and serious preparations to do such an act, has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent; but this right does not extend to granting a licence to another person to do the act.
- (2) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (1) may—
 - (a) authorise the doing of that act by any partners of his for the time being in that business, and
 - (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.
- (3) Where a product is disposed of to another in exercise of the rights conferred by subsection (1) or (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.]

Textual Amendments

F26 S. 64 substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 17**

65 **Certificate of contested validity of patent.**

- (1) If in any proceedings before the court or the comptroller the validity of a patent to any extent is contested and that patent is found by the court or the comptroller to be wholly or partially valid, the court or the comptroller may certify the finding and the fact that the validity of the patent was so contested.
- (2) Where a certificate is granted under this section, then, if in any subsequent proceedings before the court or the comptroller for infringement of the patent concerned or for revocation of the patent a final order or judgment or interlocutor is made or given

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in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the court or the comptroller otherwise directs, be entitled to his costs or expenses as between solicitor and own client (other than the costs or expenses of any appeal in the subsequent proceedings).

66 Proceedings for infringement by a co-owner.

- (1) In the application of section 60 above to a patent of which there are two or more joint proprietors the reference to the proprietor shall be construed—
 - (a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 36 above or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and
 - (b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 36 above or any such agreement, is or are the proper person or persons to give the requisite consent.
- (2) One of two or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

67 Proceedings for infringement by exclusive licensee.

- (1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the proprietor of the patent in the provisions of this Act relating to infringement shall be construed accordingly.
- (2) In awarding damages or granting any other relief in any such proceedings the court or the comptroller shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.
- (3) In any proceedings taken by an exclusive licensee by virtue of this section the proprietor of the patent shall be made a party to the proceedings, but if made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

68 Effect of non-registration on infringement proceedings.

Where by virtue of a transaction, instrument or event to which section 33 above applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent and the patent is subsequently infringed^{F27}... before the transaction, instrument or event is registered [^{F28}, in proceedings for such an infringement, the court or comptroller shall not award him costs or expenses] unless—

- (a) the transaction, instrument or event is registered within the period of six months beginning with its date; or
- (b) the court or the comptroller is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.

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Textual Amendments

- F27** Words in s. 68 repealed (29.4.2006) by virtue of [Intellectual Property \(Enforcement, etc\) Regulations 2006 \(S.I. 2006/1028\)](#), art. 1, [Sch. 2 para. 4\(a\)](#), Sch. 4
- F28** Words in s. 68 inserted (29.4.2006) by [Intellectual Property \(Enforcement, etc\) Regulations 2006 \(S.I. 2006/1028\)](#), art. 1, [Sch. 2 para. 4\(b\)](#)

69 Infringement of rights conferred by publication of application.

- (1) Where an application for a patent for an invention is published, then, subject to subsections (2) and (3) below, the applicant shall have, as from the publication and until the grant of the patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court or before the comptroller for damages in respect of any act which would have infringed the patent; and (subject to subsections (2) and (3) below) references in sections 60 to 62 and 66 to 68 above to a patent and the proprietor of a patent shall be respectively construed as including references to any such application and the applicant, and references to a patent being in force, being granted, being valid or existing shall be construed accordingly.
- (2) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only—
 - (a) after the patent has been granted; and
 - (b) if the act would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Patent Office.
- (3) Section 62(2) and (3) above shall not apply to an infringement of the rights conferred by this section, but in considering the amount of any damages for such an infringement, the court or the comptroller shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 16 above, that a patent would be granted conferring on the proprietor of the patent protection from an act of the same description as that found to infringe those rights, and if the court or the comptroller finds that it would not have been reasonable, it or he shall reduce the damages to such an amount as it or he thinks just.

^{F29}70 Threats of infringement proceedings

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that—
 - (a) a patent exists, and
 - (b) a person intends to bring proceedings (whether in a court in the United Kingdom or elsewhere) against another person for infringement of the patent by—
 - (i) an act done in the United Kingdom, or
 - (ii) an act which, if done, would be done in the United Kingdom.

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- (2) References in this section and in section 70C to a “recipient” include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

Textual Amendments

F29 Ss. 70-70F substituted for s. 70 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), [ss. 1\(2\)](#), 8; S.I. 2017/771, [reg. 2\(1\)\(a\)](#) (with [reg. 3](#))

70A Actionable threats

- (1) Subject to subsections (2) to (5), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.
- (2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—
- (a) where the invention is a product, making a product for disposal or importing a product for disposal, or
 - (b) where the invention is a process, using a process.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a) or (b).
- (4) A threat of infringement proceedings is not actionable if the threat—
- (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to a product or process, and
 - (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to that product or process.
- (5) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication.
- (6) In sections 70C and 70D “an actionable threat” means a threat of infringement proceedings that is actionable in accordance with this section.

Textual Amendments

F29 Ss. 70-70F substituted for s. 70 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), [ss. 1\(2\)](#), 8; S.I. 2017/771, [reg. 2\(1\)\(a\)](#) (with [reg. 3](#))

70B Permitted communications

- (1) For the purposes of section 70A(5), a communication containing a threat of infringement proceedings is a “permitted communication” if—
- (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
 - (b) all of the information that relates to the threat is information that—
 - (i) is necessary for that purpose (see subsection (5)(a) to (c) for some examples of necessary information), and

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- (ii) the person making the communication reasonably believes is true.
- (2) Each of the following is a “permitted purpose”—
 - (a) giving notice that a patent exists;
 - (b) discovering whether, or by whom, a patent has been infringed by an act mentioned in section 70A(2)(a) or (b);
 - (c) giving notice that a person has a right in or under a patent, where another person's awareness of the right is relevant to any proceedings that may be brought in respect of the patent.
- (3) The court may, having regard to the nature of the purposes listed in subsection (2)(a) to (c), treat any other purpose as a “permitted purpose” if it considers that it is in the interests of justice to do so.
- (4) But the following may not be treated as a “permitted purpose”—
 - (a) requesting a person to cease doing, for commercial purposes, anything in relation to a product or process,
 - (b) requesting a person to deliver up or destroy a product, or
 - (c) requesting a person to give an undertaking relating to a product or process.
- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” (see subsection (1)(b)(i))—
 - (a) a statement that a patent exists and is in force or that an application for a patent has been made;
 - (b) details of the patent, or of a right in or under the patent, which—
 - (i) are accurate in all material respects, and
 - (ii) are not misleading in any material respect; and
 - (c) information enabling the identification of the products or processes in respect of which it is alleged that acts infringing the patent have been carried out.

Textual Amendments

F29 Ss. 70-70F substituted for s. 70 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

70C Remedies and defences

- (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—
 - (a) a declaration that the threat is unjustified;
 - (b) an injunction against the continuance of the threat;
 - (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.
- (2) In the application of subsection (1) to Scotland—
 - (a) “declaration” means “declarator”, and
 - (b) “injunction” means “interdict”.

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- (3) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the patent.
- (4) It is a defence for the person who made the threat to show—
 - (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in section 70A(2)(a) or (b) in relation to the product or the use of a process which is the subject of the threat, and
 - (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

Textual Amendments

F29 Ss. 70-70F substituted for s. 70 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

70D Professional advisers

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the conditions in subsection (3) are met.
- (2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—
 - (a) is acting in a professional capacity in providing legal services or the services of a trade mark attorney or a patent attorney, and
 - (b) is regulated in the provision of legal services, or the services of a trade mark attorney or a patent attorney, by one or more regulatory bodies (whether through membership of a regulatory body, the issue of a licence to practise or any other means).
- (3) The conditions are that—
 - (a) in making the communication the professional adviser is acting on the instructions of another person, and
 - (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.
- (4) This section does not affect any liability of the person on whose instructions the professional adviser is acting.
- (5) It is for a person asserting that subsection (1) applies to prove (if required) that at the material time—
 - (a) the person concerned was acting as a professional adviser, and
 - (b) the conditions in subsection (3) were met.

Textual Amendments

F29 Ss. 70-70F substituted for s. 70 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), **ss. 1(2)**, 8; S.I. 2017/771, reg. 2(1)(a) (with reg. 3)

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70E Supplementary: pending registration

- (1) In sections 70 and 70B references to a patent include references to an application for a patent that has been published under section 16.
- (2) Where the threat of infringement proceedings is made after an application has been published (but before grant) the reference in section 70C(3) to “the patent” is to be treated as a reference to the patent as granted in pursuance of that application.

Textual Amendments

- F29** Ss. 70-70F substituted for s. 70 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), [ss. 1\(2\)](#), 8; S.I. 2017/771, [reg. 2\(1\)\(a\)](#) (with [reg. 3](#))

70F Supplementary: proceedings for delivery up etc.

In section 70(1)(b) the reference to proceedings for infringement of a patent includes a reference to proceedings for an order under section 61(1)(b) (order to deliver up or destroy patented products etc.) [^{F30}and proceedings in the Unified Patent Court for an order for delivery up made in accordance with articles 32(1)(c) and 62(3) of the Agreement on a Unified Patent Court.]]

Textual Amendments

- F29** Ss. 70-70F substituted for s. 70 (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), [ss. 1\(2\)](#), 8; S.I. 2017/771, [reg. 2\(1\)\(a\)](#) (with [reg. 3](#))
- F30** Words in s. 70F inserted (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017](#) (c. 14), [ss. 1\(3\)](#), 8; S.I. 2017/771, [reg. 2\(2\)](#) (with [reg. 3](#))

Changes to legislation:

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Changes and effects yet to be applied to the whole Act associated Parts and Chapters:

Whole provisions yet to be inserted into this Act (including any effects on those provisions):

- s. 56(4)(a)(iiia) and word added by [S.I. 2006/1056 Sch. para. 2\(b\)](#) (This amendment comes into force on the day on which 2005 asp 13, s. 20 comes into force, see art. 1(2)(b))
- s. 63(3)(a) words in s. 63(3) renumbered as s. 63(3)(a) by [2004 c. 16 s. 2\(4\)](#) (Amendment not applied to legislation.gov.uk. S. 2(4) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)
- s. 63(3)(b) and word inserted by [2004 c. 16 s. 2\(4\)](#) (Amendment not applied to legislation.gov.uk. S. 2(4) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)