



Patents Act 2004

2004 CHAPTER 16

Other amendments of the 1977 Act

13 Opinions by Patent Office as to validity or infringement

(1) After section 74 of the 1977 Act there is inserted—

“Opinions by Patent Office

74A Opinions as to validity or infringement

- (1) The proprietor of a patent or any other person may request the comptroller to issue an opinion—
 - (a) as to whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;
 - (b) as to whether, or to what extent, the invention in question is not patentable because the condition in section 1(1)(a) or (b) above is not satisfied.
- (2) Subsection (1) above applies even if the patent has expired or has been surrendered.
- (3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so—
 - (a) in such circumstances as may be prescribed, or
 - (b) if for any reason he considers it inappropriate in all the circumstances to do so.
- (4) An opinion under this section shall not be binding for any purposes.
- (5) An opinion under this section shall be prepared by an examiner.
- (6) In relation to a decision of the comptroller whether to issue an opinion under this section—

Changes to legislation: There are currently no known outstanding effects for the Patents Act 2004, Section 13. (See end of Document for details)

- (a) for the purposes of section 101 below, only the person making the request under subsection (1) above shall be regarded as a party to a proceeding before the comptroller; and
- (b) no appeal shall lie at the instance of any other person.

74B Reviews of opinions under section 74A

- (1) Rules may make provision for a review before the comptroller, on an application by the proprietor or an exclusive licensee of the patent in question, of an opinion under section 74A above.
- (2) The rules may, in particular—
 - (a) prescribe the circumstances in which, and the period within which, an application may be made;
 - (b) provide that, in prescribed circumstances, proceedings for a review may not be brought or continued where other proceedings have been brought;
 - (c) make provision under which, in prescribed circumstances, proceedings on a review are to be treated for prescribed purposes as if they were proceedings under section 61(1)(c) or (e), 71(1) or 72(1) (a) above;
 - (d) provide for there to be a right of appeal against a decision made on a review only in prescribed cases.”
- (2) In section 74 of that Act (proceedings in which validity of patent may be put in issue), in subsection (8), after “the validity of a patent is not put in issue merely because” there is inserted “ (a) ” and at the end there is inserted “or
 - (b) its validity is being considered in connection with an opinion under section 74A below or a review of such an opinion.”
- (3) In section 32(2) of that Act (rules about the register of patents), after paragraph (b) there is inserted—
 - “(ba) the entering on the register of notices concerning opinions issued, or to be issued, under section 74A below;”.

Commencement Information

II S. 13 in force at 1.10.2005 by S.I. 2005/2471, art. 2(c)

Changes to legislation:

There are currently no known outstanding effects for the Patents Act 2004, Section 13.