



# Patents Act 1949

## 1949 CHAPTER 87

*Proceedings for infringement, etc.*

### **59 Restrictions on recovery of damages for infringement**

- (1) In proceedings for the infringement of a patent damages shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the patent existed; and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the application to an article of the word "patent", "patented", or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanied the word or words in question.
- (2) In any proceeding for infringement of a patent the court may, if it thinks fit, refuse to award any damages in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.
- (3) Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages shall be awarded in any proceeding in respect of the use of the invention before the date of the decision allowing the amendment, unless the court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.
- (4) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of a patent.

### **60 Order for account in action for infringement**

In an action for infringement of a patent the plaintiff shall be entitled, at his option, to an account of profits in lieu of damages.

**61 Counterclaim for revocation in action for infringement**

A defendant in an action for infringement of a patent may, without presenting a petition, apply in accordance with rules of court by way of counterclaim in the action for revocation of the patent.

**62 Relief for infringement of partially valid specification**

- (1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed:

Provided that the court shall not grant relief by way of damages or costs except in the circumstances mentioned in the next following subsection.

- (2) Where the patent is dated before the first day of November, nineteen hundred and thirty-two, or the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages should be reckoned.
- (3) As a condition of relief under subsection (1) or subsection (2) of this section the court may direct that the specification shall be amended to its satisfaction upon an application made for that purpose under section thirty of this Act, and such an application may be made accordingly whether or not all other issues in the proceedings have been determined.
- (4) In relation to a patent which is dated before the first day of November, nineteen hundred and thirty-two, the provisions of this section shall have effect notwithstanding anything in subsection (3) of section fifty-nine of this Act.

**63 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 like right as the patentee to take proceedings in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or granting any other relief in any such proceedings, the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.
- (2) In any proceedings taken by the holder of an exclusive licence by virtue of this section, the patentee shall, unless he is joined as plaintiff in the proceedings, be added as defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

**64 Certificate of contested validity of specification**

- (1) If in any proceedings before the court the validity of any claim of a specification is contested, and that claim is found by the court to be valid, the court may certify that the validity of that claim was contested in those proceedings.

- (2) Where any such certificate has been granted, then if in any subsequent proceedings before the court for infringement of the patent or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent, that party shall, unless the court otherwise directs, be entitled to his costs as between solicitor and client so far as concerns the claim in respect of which the certificate was granted:

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

## **65 Remedy for groundless threats of infringement proceedings**

- (1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby may bring an action against him for any such relief as is mentioned in the next following subsection.
- (2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief that is to say:—
- (a) a declaration to the effect that the threats are unjustifiable;
  - (b) an injunction against the continuance of the threats; and
  - (c) such damages, if any, as he has sustained thereby.
- (3) For the avoidance of doubt it is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

## **66 Power of court to make declaration as to non-infringement**

- (1) A declaration that the use by any person of any process, or the making or use or sale by any person of any article, does not or would not constitute an infringement of a claim of a patent may be made by the court in proceedings between that person and the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or licensee, if it is shown—
- (a) that the plaintiff has applied in writing to the patentee or licensee for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the process or article in question; and
  - (b) that the patentee or licensee has refused or neglected to give such an acknowledgment.
- (2) The costs of all parties in proceedings for a declaration brought by virtue of this section shall, unless for special reasons the court thinks fit to order otherwise, be paid by the plaintiff.
- (3) The validity of a claim of the specification of a patent shall not be called in question in proceedings for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid.

- (4) Proceedings for a declaration may be brought by virtue of this section at any time after the date of the publication of the complete specification in pursuance of an application for a patent, and references in this section to the patentee shall be construed accordingly.

**67 Reference to comptroller of disputes as to infringement**

- (1) Any dispute between a patentee or an exclusive licensee and any other person—
- (a) whether any claim of the specification of a patent is infringed by anything done by that other person; or
  - (b) whether any such claim which is alleged to be so infringed is valid,
- may, by agreement between the parties, be referred to the comptroller for determination in accordance with such procedure as may be prescribed by rules made by the Board of Trade under this Act:

Provided that if it appears to the comptroller that any dispute referred to him under this section involves questions which would more properly be determined by the court, he may decline to deal therewith.

- (2) If on a reference under this section the comptroller finds that any claim of the specification of the patent is valid and is infringed, he may, subject to the provisions of this section and of section fifty-nine of this Act, grant relief by way of damages; but the damages awarded in the proceedings shall not (unless otherwise agreed between the parties) exceed one thousand pounds.
- (3) Subsection (1) of section thirty and section sixty-two of this Act shall apply to proceedings before the comptroller on a reference under this section as they apply to proceedings for infringement of a patent before the court.
- (4) The Arbitration Acts, 1889 and 1934, shall not apply to proceedings before the comptroller on a reference under this section.
- (5) The decision of the comptroller on a reference under this section shall not be binding upon any party thereto in any subsequent proceedings before the court for infringement of the patent or for revocation of the patent; but a patentee or licensee shall not be entitled, in any such subsequent proceedings for infringement, to any relief in respect of an alleged infringement which was in issue in proceedings under this section.