



Patents Act 1949

1949 CHAPTER 87

Voluntary endorsement of patent

35 Endorsement of patent " licences of right "

- (1) At any time after the sealing of a patent the patentee may apply to the comptroller for the patent to be endorsed with the words " licences of right "; and where such an application is made, the comptroller shall notify the application to any person entered on the register as entitled to an interest in the patent, and if satisfied, after giving any such person an opportunity to be heard, that the patentee is not precluded by contract from granting licences under the patent, cause the patent to be endorsed accordingly.
- (2) Where a patent is endorsed under this section—
 - (a) any person shall, at any time thereafter, be entitled as of right to a licence under the patent upon such terms as may, in default of agreement, be settled by the comptroller on the application of the patentee or the person requiring the licence ;
 - (b) the comptroller may, on the application of the holder of any licence granted under the patent before the endorsement, order the licence to be exchanged for a licence to be granted by virtue of the endorsement upon terms to be settled as aforesaid ;
 - (c) if in proceedings for infringement of the patent (otherwise than by the importation of goods) the defendant undertakes to take a licence upon terms to be settled by the comptroller as aforesaid, no injunction shall be granted against him, and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence had been granted before the earliest infringement;
 - (d) the renewal fees payable in respect of the patent after the date of the endorsement shall be one half of the renewal fees which would be payable if the patent were not so endorsed.
- (3) The licensee under any licence granted by virtue of the endorsement of a patent under this section shall (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) be entitled to call upon the

patentee to take proceedings to prevent any infringement of the patent; and if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as if he were patentee, making the patentee a 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.

- (4) An application for the endorsement of a patent under this section shall contain a statement (to be verified in such manner as may be prescribed) that the patentee is not precluded by contract from granting licences under the patent; and the comptroller may require from the applicant such further evidence as he may think necessary.
- (5) An application made under this section for the endorsement of a patent of addition shall be treated as an application for the endorsement of the patent for the main invention also, and an application made under this section for the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the endorsement of the patent of addition also; and, where a patent of addition is granted in respect of a patent already endorsed under this section, the patent of addition shall also be so endorsed.
- (6) All endorsements of patents under this section shall be entered in the register of patents and shall be published in the Journal and in such other manner as the comptroller thinks desirable for bringing the endorsement to the notice of manufacturers.
- (7) An appeal shall lie from any decision of the comptroller under this section.

36 Cancellation of endorsement under section 35

- (1) At any time after a patent has been endorsed under the last foregoing section, the patentee may apply to the comptroller for cancellation of the endorsement; and where such an application is made and the balance paid of all renewal fees which would have been payable if the patent had not been endorsed, the comptroller may, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application, cancel the endorsement accordingly.
- (2) Within the prescribed period after a patent has been endorsed as aforesaid, any person who claims that the patentee is, and was at the time of the endorsement, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the comptroller for cancellation of the endorsement.
- (3) Where the comptroller is satisfied, on application made under the last foregoing subsection, that the patentee is and was precluded as aforesaid, he shall cancel the endorsement; and thereupon the patentee shall be liable to pay, within such period as may be described, a sum equal to the balance of all renewal fees which would have been payable if the patent had not been endorsed, and if that sum is not paid within that period the patent shall cease to have effect at the expiration of that period.
- (4) Where the endorsement of a patent is cancelled under this section, the rights and liabilities of the patentee shall thereafter be the same as if the endorsement had not been made.
- (5) The comptroller shall advertise in the prescribed manner any application made to him under this section ; and within the prescribed period after such advertisement—

- (a) in the case of an application under subsection (1) of this section, any person interested ; and
 - (b) in the case of an application under subsection (2) of this section, the patentee, may give notice to the comptroller of opposition to the cancellation.
- (6) Where any such notice of opposition is given, the comptroller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.
- (7) An application made under this section for the cancellation of the endorsement of a patent of addition shall be treated as an application for the cancellation of the endorsement of the patent for the main invention also, and an application made under this section for the cancellation of the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the cancellation of the endorsement of the patent of addition also.
- (8) An appeal shall lie from any decision of the comptroller under this section.