

SCHEDULE 2

Regulation 2(2)

Amendments to other primary legislation

Amendment of the Patents Act 1977

1. The Patents Act 1977(1) shall be amended as follows.
2. In section 62 (restrictions on recovery of damages for infringement), in subsection (3) for the words from “no damages” to the end of the subsection there shall be substituted—

“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.”.
3. In section 63 (relief for infringement of partially valid patent), in subsection (2) for the words from “not grant relief” to the end of the subsection there shall be substituted—

“, 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.”.
4. In section 68 (effect of non-registration on infringement proceedings)—
 - (a) the words from “, the court or comptroller shall” to “occurring” shall be omitted; and
 - (b) before the word “unless”, there shall be inserted “, in proceedings for such an infringement, the court or comptroller shall not award him costs or expenses”.
- 5.—(1) In section 130 (interpretation), in subsection (1), in the definition of “formal requirements” for “section 17” there shall be substituted “section 15A”.

(2) Sub-paragraph (1) does not apply to an application for a patent to which article 20, 21 or 22 of the Regulatory Reform (Patents) Order 2004(2) applies.

Amendment of the Copyright, Designs and Patents Act 1988

6. The Copyright, Designs and Patents Act 1988(3) is amended as follows.

(1) 1977 c. 37; there are amendments but none is relevant.

(2) SI 2004/2357.

(3) 1988 c. 48; sections 114(6), 204(6) and 231(6) were amended by section 106(1) of, and paragraph 8 of Schedule 3 to, the Trade Marks Act 1994; section 172A was inserted by, and sections 179, 211 and 212 were amended by, SI 1995/3297; section 172A and 179 were amended by SI 1996/2967; there are other amendments but none is relevant.

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7. In section 114 (order as to disposal of infringing copy or other article), in subsection (6) for the words from “under this section” to the end of the subsection there shall be substituted—

- “(a) under this section or under section 204 or 231 of this Act;
- (b) under section 24D of the Registered Designs Act 1949;
- (c) under section 19 of Trade Marks Act 1994 (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027)); or
- (d) under regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).”.

8.—(1) Section 172A (meaning of EEA and related expressions) shall be amended as follows.

(2) For subsection (1) there shall be substituted—

“(1) In this Part—

“the EEA” means the European Economic Area; and

“EEA state” means a member State, Iceland, Liechtenstein or Norway.”.

(3) In subsection (2), for the words “an EEA national” there shall be substituted “a national of an EEA State”.

9. In section 179 (index of defined expressions), for the words “EEA, EEA national and EEA state” there shall be substituted “the EEA, EEA state and national of an EEA state”.

10. After section 197 there shall be inserted—

“Presumptions relevant to recordings of performances

197A.—(1) In proceedings brought by virtue of this Part with respect to the rights in a performance, where copies of a recording of the performance as issued to the public bear a statement that a named person was the performer, the statement shall be admissible as evidence of the fact stated and shall be presumed to be correct until the contrary is proved.

(2) Subsection (1) does not apply to proceedings for an offence under section 198 (criminal liability for making etc. illicit recordings); but without prejudice to its application in proceedings for an order under section 199 (order for delivery up in criminal proceedings).”.

11. In section 204 (order as to disposal of illicit recording), in subsection (6) for the words from “under this section” to the end of the subsection there shall be substituted—

- “(a) under this section or under section 114 or 231 of this Act;
- (b) under section 24D of the Registered Designs Act 1949;
- (c) under section 19 of Trade Marks Act 1994 (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027)); or
- (d) under regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).”.

12. In section 211(1) (expressions having same meaning as in copyright provisions), for the entry “EEA national,” there shall be substituted the entries “the EEA,” and “EEA state,”.

13. In section 212 (index of defined expressions), for the words “EEA national” there shall be substituted “the EEA and EEA state”.

14. In section 231 (orders as to disposal of infringing articles, &c), in subsection (6) for the words from “under this section” to the end of the subsection there shall be substituted—

- “(a) under this section or under section 114 or 204 of this Act;
- (b) under section 24D of the Registered Designs Act 1949;

- (c) under section 19 of Trade Marks Act 1994 (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027)); or
- (d) under regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).”.

Amendment of the Trade Marks Act 1994

15. The Trade Marks Act 1994(4) shall be amended as follows.

16. In section 19 (order as to disposal of infringing goods, materials or articles), in subsection (6) for the words from “under this section” to the end of the subsection there shall be substituted—

- “(a) under this section (including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027));
- (b) under section 24D of the Registered Designs Act 1949;
- (c) under section 114, 204 or 231 of the Copyright, Designs and Patents Act 1988; or
- (d) under regulation 1C of the Community Design Regulations 2005 (SI 2005/2339).”.

17. In section 25 (registration of transactions affecting registered trade mark), in subsection (4), for the words from “, then unless” to the end of the subsection there shall be substituted—

“and the mark is infringed before the prescribed particulars of the transaction are registered, in proceedings for such an infringement, the court shall not award him costs unless—

- (a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date, or
- (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter.”.

18. In section 55 (the Paris Convention), in subsection (1)(b) after the words “that Convention” there shall be inserted “or to that Agreement”.

(4) 1994 c. 26; section 55 was amended by SI 1999/1899; there are other amendments but none is relevant.