Draft Order laid before Parliament under section 88A(6) of the Patents Act 1977 and paragraph 2(2) of Schedule 2 to the European Communities Act 1972, for approval by resolution of each House of Parliament.

DRAFT STATUTORY INSTRUMENTS

2016 No. XXXX

PATENTS

The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016

Made - - - - ***

Coming into force in accordance with Article 1(2)

The Secretary of State has been designated for the purposes of section 2(2) of the European Communities Act 1972(**1**) in relation to intellectual property (including both registered and unregistered rights)(**2**).

The Secretary of State makes this Order in exercise of the powers conferred by that section and section 88A of the Patents Act 1977(**3**).

In accordance with section 88A(6) of that Act and paragraph 2(2) of Schedule 2 to the European Communities Act 1972(**4**), a draft of the Order was laid before Parliament and approved by resolution of each House of Parliament.

Citation, commencement and extent

1.—(1) This Order may be cited as the Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016.

(2) This Order comes into force on the date of entry into force of the Agreement on a Unified Patent Court signed at Brussels on 19th February 2013(**5**).

(3) This Order has the same extent as the Patents Act 1977, except that it does not extend to the Isle of Man.

(**1**) 1972 c.68; section 2(2) was amended by the Legislative and Regulatory Reform Act 2006 (c.51), section 27(1)(a) and the European Union (Amendment) Act 2008 (c.7), Schedule, Part 1.
(**2**) S.I. 2006/608.
(**3**) 1977 c.37; section 17 of the Intellectual Property Act 2014 (c.18), which inserted section 88A into the Patents Act 1977, was brought into force on 1st October 2014 by S.I. 2014/2330.
(**4**) Paragraph 2(2) of Schedule 2 was amended by the Legislative and Regulatory Reform Act 2006 (c.51), section 27(2)(a).
(**5**) Cm 8653. The date on which the treaty enters into force for the United Kingdom may be found on the relevant page on UK Treaties Online at this link: http://treaties.fco.gov.uk/treaties/treatyrecord.htm?tid=14651

Amendments to the Patents Act 1977

2.—(1) The Patents Act 1977 is amended as follows.

(2) In section 58 (references of disputes as to Crown use), in subsection (6)(**6**), after "Act," insert "or, in the case of a European patent (UK), has been allowed under any of the provisions in the Agreement on a Unified Patent Court,".

(3) In section 60 (meaning of infringement) in subsection (5)(**7**), after paragraph (i) insert—

"(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.".

(4) In section 60 (meaning of infringement) after subsection (6G)(**8**), insert—

"(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.".

(5) In section 77 (effect of European patent (UK))(**9**)—

(a) in subsections (4), (4A) and (5A), after "European Patent Convention" insert "or the Agreement on a Unified Patent Court";

(b) in subsection (5)(a)—

(i) after "European Patent Convention" insert "or the Agreement on a Unified Patent Court"; and

(ii) at the end after "Enlarged Board of Appeal" insert "or is revoked and subsequently restored by the Unified Patent Court";

(c) after subsection (9), insert—

"(10) Subsection (1) does not apply and is to be treated as never having applied in respect of a European patent (UK) whose unitary effect is registered by the European Patent Office in the Register for unitary patent protection (see, in particular, the Unitary Patent Regulation).".

(6) After section 83, insert—

"**European patent with unitary effect and Unified Patent Court**

83A.—(1) Schedule A3 contains provision about the application of this Act in relation to the European patent with unitary effect.

(2) Schedule A4 contains provision about the jurisdiction of the Unified Patent Court in relation to the European patent (UK) and the European patent with unitary effect."

(7) In section 91 (evidence of conventions and instruments under conventions)(**10**)—

(a) in subsection (1)(a), after "the Community Patent Convention" insert ", the Agreement on a Unified Patent Court";

(b) in subsection (6), in the definition of "relevant convention court", after "party to the relevant convention", insert "but does include the Unified Patent Court;".

(**6**) Section 58(6) was amended by the Patents Act 2004 (c.16), section 2(2)(a).
(**7**) Section 60(5) was amended by S.I. 2000/2037 and S.I. 2005/2759.
(**8**) Section 60(6G) was inserted by S.I. 2014/1997.
(**9**) Section 77 was amended by the Copyright, Designs and Patents Act 1988 (c.48), Schedule 5, paragraphs 8 and 21; the Patents Act 2004 (c.16), Schedule 1, paragraph 2; S.I. 2005/687; the Intellectual Property Act 2014 (c.18), Schedule, paragraph 6.
(**10**) Section 91 was amended by the Patents Act 2004 (c.16), Schedule 2, paragraph 20.

(8) In section 92 (obtaining evidence for proceedings under the European Patent Convention)(**11**), in subsections (1) and (5), after "European Patent Convention" insert "or proceedings before the Unified Patent Court".

(9) In section 130 (interpretation)(**12**)—

(a) in subsection (1), insert the following definitions at the appropriate places—

> ""Agreement on a Unified Patent Court" means the Agreement on a Unified Patent Court signed at Brussels on 19th February 2013;
>
> "European patent with unitary effect" has the same meaning as in Article 2 of the Unitary Patent Regulation;
>
> "Unified Patent Court" means the court established under the Agreement on a Unified Patent Court;
>
> "Unitary Patent Regulation" means Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection(**13**).".

(b) in subsection (1), in the definition of "court", after paragraph (c) insert—

> "or the Unified Patent Court, as respects the jurisdiction which it has by virtue of Schedule A4;";

(c) in subsection (6), after paragraph (c), insert—

> "(d) The Agreement on a Unified Patent Court;".

(10) After Schedule A2, insert—

"SCHEDULE A3

EUROPEAN PATENT WITH UNITARY EFFECT

Meaning of "relevant statutory provisions"

1. In this Schedule "relevant statutory provisions" means—

(a) the provisions of this Act which, by virtue of paragraph 2, apply in relation to the European patent with unitary effect, and

(b) the other provisions of this Act which, by virtue of the Unitary Patent Regulation, are to be treated as applying in relation to the European patent with unitary effect (see, in particular, Article 7 of that Regulation).

Provisions applied by this Schedule to the European patent with unitary effect

2. The following provisions of this Act apply in relation to a European patent with unitary effect, subject to paragraphs 3 and 4—

section 48 (compulsory licences: general);

section 48A (compulsory licences: WTO proprietors);

section 48B (compulsory licences: other cases);

(**11**) Section 92 was amended by S.I. 1979/1714 (N.I. 19).

(**12**) Section 130(1) was amended by the Armed Forces Act 1981 (c.55), section 22(1) and (3); the Copyright, Designs and Patents Act 1988 (c.48), Schedule 5, paragraph 5, Schedule 7, paragraph 23 and Schedule 8; S.I. 2000/2037; the Patents Act 2004 (c.16), Schedule 1, paragraph 9(1) and (2), Schedule 2, paragraph 27, and Schedule 3; S.I. 2004/2357; S.I. 2006/1028; Crime and Courts Act 2013 (c.22), Schedule 9, Part 2, paragraph 27; S.I. 2013/2602.

(**13**) OJ No L 361, 31.12.2012, p1.

section 49 (provisions about licences under section 48);

section 50 (exercise of powers on applications under section 48);

section 50A (powers exercisable following merger and market investigations);

section 51 (powers exercisable in consequence of report of Competition and Markets Authority);

section 52 (opposition, appeal and arbitration);

section 53 (compulsory licences; supplementary provisions);

section 54 (special provisions where patented invention is being worked abroad);

section 55 (use of patented inventions for services of the Crown);

section 56 (interpretation, etc., of provisions about Crown use);

section 57 (rights of third parties in respect of Crown use);

section 57A (compensation for loss of profit);

section 58(1) to (6) and (9A) to (13) (references of disputes as to Crown use);

section 59 (special provisions as to Crown use during emergency);

section 60 (meaning of infringement);

section 64 (right to continue use begun before priority date);

section 73(2) to (4) (Comptroller's power to revoke patents on his own initiative);

section 74A (opinions on matters prescribed in the rules);

section 74B (reviews of opinions under section 74A);

section 76A (biotechnological inventions);

section 77(4) to (5A) (effect of European patent (UK));

section 80(1) (authentic text of European patents and patent applications);

sections 97 to 100 (legal proceedings) so far as they relate to proceedings which do not fall within the exclusive jurisdiction of the Unified Patent Court as set out in paragraph 1 of Schedule A4;

section 101 (exercise of comptroller's discretionary powers);

section 102 (right of audience, &c in proceedings before comptroller);

sections 103 (extension of privilege for communications with solicitors relating to patent proceedings) and 105 (extension of privilege in Scotland for communications relating to patent proceedings) so far as they relate to proceedings before the comptroller;

section 107 (costs and expenses in proceedings before the comptroller);

section 108 (licences granted by order of comptroller);

section 110 (unauthorised claim of patent rights);

section 116 (immunity of department as regards official acts);

section 118 (information about patent applications and patents, and inspection of documents);

section 123 (rules);

section 124 (rules, regulations and orders; supplementary);

section 125 (extent of invention);

section 128A (EU compulsory licences);

section 128B (supplementary protection certificates).

Manner of application of relevant statutory provisions

3. The relevant statutory provisions apply in relation to a European patent with unitary effect in the same way as they apply in relation to a European patent (UK).

Modifications of relevant statutory provisions

4.—(1) In their application in relation to the European patent with unitary effect, the relevant statutory provisions which are referred to in this paragraph have effect subject to the modifications set out in this paragraph.

(2) In section 7(2)(b), the reference to the United Kingdom is a reference to any of the Participating Member States.

(3) In sections 30(7) and 31(7), references to proceedings by virtue of section 61 or 69 are references to equivalent proceedings in the Unified Patent Court.

(4) In sections 33(1)(a), 33(4), 37(2), 37(7), 38(2) and 38(3), the reference to registration is a reference to registration in the Register for unitary patent protection.

(5) In sections 48(1)(b), 48B(4), 50A(4), 51(3), 53(3), and 53(4), the reference to the register is a reference to the Register for unitary patent protection.

(6) In sections 48(2)(b), 50A(4), 51(3), 53(3), 53(4) and 53(5), the reference to making an entry is a reference to directing the making of an entry.

(7) In sections 48B(2)(b) and 50(2)(a), the reference to the journal is a reference to the European Patent Bulletin.

(8) In section 55(5)(b), the reference to the Patent Office is a reference to the European Patent Office.

(9) In section 59(2), the reference to section 69 includes a reference to Article 67 of the European Patent Convention.

(10) In section 60—

(a) in subsections (1), (2), and (5)(d), (e) and (f), the references to the United Kingdom are references to the territory of a Contracting Member State in which the European patent with unitary effect has effect;

(b) in subsection (7)—

(i) in the definition of "relevant ship" and "relevant aircraft, hovercraft or vehicle", the reference to the United Kingdom is a reference to a Contracting Member State in which the European patent with unitary effect has effect; and

(ii) in the definition of "exempted aircraft", the reference to an aircraft to which section 89 of the Civil Aviation Act 1982(**14**) applies is a reference to an aircraft other than an aircraft of a Contracting Member State in which the European patent with unitary effect has effect.

Interpretation

5. In this Schedule—

(**14**) 1982 c.16.