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The Registered Patents and Biotechnological Inventions (Bailiwick of Guernsey) Ordinance, 2009

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The Registered Patents and Biotechnological Inventions (Bailiwick of Guernsey) Ordinance, 2009

THE STATES, in pursuance of their resolution of the 27th November, 2002^a, and in exercise of the powers conferred on them by sections 1 and 3 of the Intellectual Property (Enabling Provisions) (Bailiwick of Guernsey) Law, 2004^b and of all other powers enabling them in that behalf, hereby order:-

PART I

PATENTS & REGISTER OF PATENTS

Patents, patentable inventions and biotechnological inventions.

1. (1) In this Ordinance, unless the context requires otherwise, "**patent**" includes any right associated with a patent which operates so as to extend the life of the patent, such as a right under a supplementary protection certificate.

(2) Subject to the provisions of this Ordinance, patents may be registered in respect of any inventions, whether products or processes, in all fields of technology, provided that the inventions -

- (i) are new,
- (ii) involve an inventive step, and
- (iii) are capable of industrial application, and

references in this Ordinance to a "**patentable invention**" shall be construed accordingly.

^a Article XIX of Billet d'État No. XXIII of 2002.

^b Order in Council No. XIV of 2004.

(3) A patent for an invention, the commercial exploitation of which would be contrary to public policy or morality, shall not be registered under this Ordinance.

(4) For the purposes of subsection (3) behaviour shall not be regarded as contrary to public policy or morality only because it is prohibited by any law in force in the Bailiwick.

(5) For the avoidance of doubt any provision of, or made under, this Ordinance is to have effect, insofar as it is appropriate, in relation to a patent concerning a biotechnological invention provided that the invention satisfies the principles set out in Part I of Schedule 1.

(6) The Department may by regulation amend Part I of Schedule 1.

Register of Patents.

2. (1) The Registrar shall establish and maintain a register to be called the Register of Patents in which, subject to the provisions of this Ordinance -

(a) patents may be registered, and

(b) persons may be registered as the proprietors of those patents.

(2) The Register of Patents need not be kept in documentary form.

(3) The Register of Patents shall contain -

(a) the names and addresses of persons registered in it as

the proprietors of patents,

- (b) the date on which persons were so registered,
 - (c) details of the person, or persons, whom the applicant believes to be the inventor, or joint inventor, of the patented invention,
 - (d) notices of assignments and transmissions of patents registered in it,
 - (e) details of any limitations subject to which patents are registered in it, and
 - (f) such other matters (including, for the avoidance of doubt, those enabling compliance with international conventions and treaties such as the Rio Convention on Biological Diversity) -
 - (i) as may be prescribed, or
 - (ii) as the Registrar may think fit.
- (4) Subject to subsection (5) -
- (a) the Register of Patents shall be open for public inspection at all convenient times, and
 - (b) the Registrar shall, on payment of the appropriate fee, supply copies and extracts (certified or uncertified) of any entry in the Register of Patents.

(5) Where it appears to the Registrar that a patent entered in the Register of Patents is one in respect of which the publication of information, or the communication of information to any person or class of persons, should be prohibited or restricted, the Registrar may –

(a) upon the application of the person registered as proprietor of the patent in the Register of Patents, or

(b) of his own motion,

impose such reasonable prohibition or restriction on the publication or communication of information in respect of that patent as he thinks fit.

(6) No notice of any trust, whether express, implied or constructive, shall be entered in the Register of Patents, and the Registrar is not affected by any such notice.

Evidence of entries in register.

3. (1) The Register of Patents is prima facie evidence of anything required or authorised to be entered in it.

(2) A copy or extract of an entry in the Register of Patents supplied under section 2(4) and purporting to be a certified copy or extract is admissible in evidence without further proof and without production of the original.

PART II REGISTRATION

Entitlement to registration.

4. (1) Only the overseas registered proprietor of an overseas registered patent may be registered as the proprietor of a patent in the Register of Patents, and in this Ordinance –

- (a) an "**oversea registered patent**" means a patent registered in a designated country in accordance with the laws relating to the registration of patents in force in that country,
- (b) the "**oversea registered proprietor**" of an oversea registered patent means the person registered in a designated country as the proprietor of that patent in accordance with the laws described in paragraph (a), and
- (c) a "**designated country**" means a country or office mentioned in Schedule 2.

(2) Regulations of the Department under this section may amend Schedule 2 and, in particular -

- (a) may add to the Schedule any country or office in a country which, in the opinion of the Department, gives effect to the provisions of the TRIPS Agreement, and
- (b) may remove from the Schedule any country or office in a country which, in the opinion of the Department, fails any longer to give effect to the provisions of the TRIPS Agreement.

(3) References in this Ordinance (however expressed) -

- (a) to a designated country, include references to an office which is described in Schedule 2,

- (b) to registration, or being registered in a designated country, include references to registration, or being registered by such an office in accordance with the laws relating to the registration of patents which govern that office, and
- (c) to the laws relating to the registration of patents in force in a designated country, include references to the laws relating to the registration of patents which govern that office,

and the provisions of this Ordinance shall be construed accordingly with such modifications as may be necessary.

Applications for registration.

5. (1) A person wishing to be registered as the proprietor of a patent in the Register of Patents shall apply in that behalf to the Registrar.

(2) An application for registration shall be made in such form and manner as the Registrar may determine and shall be accompanied by -

- (a) such information and documents as the Registrar may reasonably require for the purpose of determining the application,
- (b) the appropriate fee, and
- (c) anything else prescribed by regulations of the Department under this subsection.

(3) Following receipt of an application for registration the Registrar-

(a) may by notice in writing require the applicant to provide such additional information and documents as the Registrar may reasonably require for the purpose of determining the application, and

(b) shall –

(i) publish such particulars of the application, in such manner and for such period, as he thinks fit, or as may be prescribed and

(ii) invite written observations upon the application.

(4) Any information or document to be provided to the Registrar under this section shall be in such form, and authenticated in such manner, as the Registrar may require.

(5) The Registrar's requirements under subsections (2), (3) and (4) may differ as between different applications.

(6) An application for registration may be withdrawn by notice in writing to the Registrar at any time before it is determined.

(7) The Registrar -

(a) shall refuse an application for registration -

(i) which is not accompanied by the appropriate fee, or

(ii) which relates to such inventions, or description of inventions, as regulations of the Department under this subsection may prescribe as inventions, or a description of inventions, the registration of which is prohibited under this Ordinance, and

(b) may refuse an application for registration which is not otherwise made in accordance with the provisions of this Ordinance.

(8) The Registrar shall consider any written observations received by him further to publication of an application under subsection (3)(b) before reaching any decision under section 6(1).

Registration of patents in Register.

6. (1) Subject to section 5, the Registrar shall, following receipt of an application under section 5 from a person wishing to be registered as the proprietor of a patent in the Register of Patents, grant the application if and only if he is satisfied that -

- (a) the patent is an overseas registered patent,
- (b) the applicant is the overseas registered proprietor of that patent,
- (c) the invention to which the patent relates meets the criteria for a patentable invention under section 1(2), and
- (d) there are no other circumstances (having regard, for example, to the other provisions of section 1) that, in

the opinion of the Registrar, make it inappropriate for him to grant the application.

(2) The registration shall include the entry on the Register of Patents of any limitation which attaches to the registration of the patent in the designated country concerned and which has been made under the laws relating to the registration of patents in force in that country.

(3) Where the Registrar decides -

- (a) to refuse an application for registration in the Register of Patents, or
- (b) other than with the consent of the applicant, to include an entry in the registration of a limitation,

he shall serve notice in writing of the decision on the applicant in accordance with the provisions of section 12.

(4) Where there is more than one oversea registered patent for the same invention and different persons are registered as proprietors in the relevant designated countries, the first such person to apply for registration in the Register of Patents shall be entitled to be registered as proprietor and, for the avoidance of doubt, in the event that two or more applications for registration are received by the Registrar on the same day, the Registrar shall have complete discretion to decide which applicant shall be registered.

Certificate and date of registration.

7. (1) The Registrar shall, on registration of a person as the proprietor of a patent in the Register of Patents, issue a certificate of registration.

(2) The Registrar may -

- (a) if satisfied that the certificate of registration has been lost or destroyed, and in any other case in which he thinks it expedient, and
- (b) on payment of the appropriate fee,

furnish copies of the certificate.

(3) The registration of a person as the proprietor of a patent in the Register of Patents has effect on and from the date of registration.

Revocation of registration within 5 years of first registration.

8. (1) This section applies in respect of a registered patent, where less than five years has elapsed from the date of first registration of that patent.

(2) The Registrar shall revoke the registration of a person as the proprietor of a patent in the Register of Patents -

- (a) if, subject to the provisions of subsections (3) and (4), it appears to the Registrar that -
 - (i) the registration of the relevant overseas registered patent in the designated country concerned has been revoked, cancelled or declared to be invalid under the laws relating to the registration of patents in force there, or
 - (ii) the right in the overseas registered patent has expired in that country by reason of a failure to extend the duration of the right, under those laws,

- (b) if it appears to the Registrar that, otherwise than as mentioned in paragraph (a) -
 - (i) the patent is not or is no longer an overseas registered patent, or
 - (ii) the person is not or is no longer the overseas registered proprietor of that patent,
 - (c) if that person applies to the Registrar for his registration to be revoked (and, subject to any modifications specified by the Registrar, the provisions of section 5 apply to an application under this paragraph as they apply to an application for registration under that section), or
 - (d) if the appropriate renewal fee has not been paid within the prescribed period.
- (3) If in the designated country concerned, an appeal is instituted against -
- (a) the revocation or cancellation of the registration of an overseas registered patent, or
 - (b) a declaration that the registration of an overseas registered patent is invalid,

the Registrar shall not under subsection (2)(a)(i) revoke the registration of a person as the proprietor of the relevant registered patent before the appeal is finally disposed of.

(4) If, in the designated country concerned, an application is made under the laws relating to the registration of patents in force there for -

- (a) the extension of the right in an overseas registered patent, or
- (b) an order for the restoration of the right in an overseas registered patent,

the Registrar shall not under subsection (2)(a)(ii) revoke the registration of a person as the proprietor of the relevant registered patent unless and until the application is refused (and, if proceedings are instituted against the refusal, before the proceedings are finally disposed of).

(5) A decision of the Registrar to revoke a registration, other than on the application of the person registered as proprietor, shall not have effect until the end of the period within which, under section 31, an appeal can be brought against the revocation or, if an appeal is brought within that period, and unless the Royal Court orders otherwise, until the appeal is finally disposed of.

(6) Where the Registrar decides, other than on the application of the person registered as proprietor of a patent, to revoke a registration, the Registrar shall serve notice in writing of the decision on that person in accordance with the provisions of section 12.

(7) A registration which is revoked under this section shall be treated as being invalid ab initio or from such later date as the Registrar may direct.

Revocation of registration after 5 years following first registration.

9. (1) This section applies in respect of a registered patent, where five years or more has elapsed from the date of first registration of that patent.

(2) The Registrar shall revoke the registration of a person as the proprietor of a patent in the Register of Patents -

- (a) if that person applies to the Registrar for his registration to be revoked (and the provisions of section 5, subject to any modifications specified by the Registrar, apply to an application under this paragraph as they apply to an application for registration under that section),
- (b) if the Royal Court orders the Registrar to revoke the registration upon application under subsection (3),
- (c) if the appropriate renewal fee has not been paid within the prescribed period, or
- (d) on the date upon which the right in the patent expires as provided under subsection (4).

(3) Any person may apply to the Royal Court for an order requiring the Registrar to revoke the registration of a person as the proprietor of the patent in the Register of patents, on the ground that the commercial exploitation of the patent is contrary to public policy or morality under section 1(3).

(4) The right in a patent expires -

- (a) on the date upon which the right in the relevant oversea registered patent expires in the designated country concerned, or
- (b) if later, on the date upon which any extension of the

term of the patent, granted under Schedule 3, expires.

Registration of assignments, etc.

10. (1) Where a person becomes entitled -
- (a) to a patent registered in the Register of Patents or to a share in such a patent by assignment, transmission or operation of law, or
 - (b) to any other interest in such a patent, as licensee or otherwise,

he may apply to the Registrar for registration in the Register of Patents of -

- (i) his title as proprietor or co-proprietor or, as the case may be,
- (ii) notice of his interest.

(2) The provisions of section 5 apply, subject to such modifications as the Registrar may determine, to an application under subsection (1) as they apply to an application for registration under that section.

(3) An application under subsection (1) for registration of the title or interest of a person becoming entitled to a registered patent, or a share or other interest in a patent, by or by virtue of an assignment, licence or other instrument, may be made by the assignor, licensor or other party to that instrument, as the case may be.

(4) Where an application is made under subsection (1) for registration of the title or interest of any person, the Registrar shall -

- (a) where the applicant has become entitled to the registered patent, or a share therein by assignment, transmission or operation of law -
 - (i) register him in the Register of Patents as proprietor or co-proprietor of the patent, and
 - (ii) enter in the Register particulars of the instrument or event by which he derives title, or
- (b) in any other case, enter in the Register -
 - (i) notice of his entitlement or interest, and
 - (ii) particulars of the instrument or event by which he derives title or, as the case may be, by which the interest is created.

(5) Except for the purposes of an application to rectify or modify the Register of Patents under section 13 or 14, a document in respect of which no entry is made in the Register of Patents under subsection (4) shall not be admitted in any court as evidence of the title of any person to a registered patent, or to any share or other interest in such a patent, unless the Royal Court directs otherwise.

(6) Where the Registrar decides, other than on the application of the person registered as proprietor in the Register of Patents, to enter any right, title or interest in the Register of Patents under this section, the Registrar shall serve notice in writing of the decision on that person in accordance with the provisions of section 12.

Effect of registration etc. on rights in registered patent.

11. (1) Any person who claims to have acquired the property in a

registered patent by virtue of any transaction, instrument or event to which this section applies shall be entitled as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event

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- (a) the earlier transaction, instrument or event was not registered, and
- (b) the person claiming under the later transaction, instrument or event, did not know of the earlier transaction, instrument or event .

(2) Subsection (1) shall apply equally to the case where any person claims to have acquired any right in or under a registered patent by virtue of a transaction, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.

(3) This section applies to the following transactions, instruments and events -

- (a) the assignment of -
 - (i) a patent, or
 - (ii) the right conferred under section 34,
- (b) the grant, or assignment, of a licence or sub-licence under a patent,
- (c) the death of the proprietor, or one of the proprietors of

any such patent, or any person having a right in or under a patent,

- (d) any order or directions of a court, or other competent authority, transferring a patent, or any right under it, to any person, and
- (e) the event by virtue of which the court or authority had power to make any such order, or give any such directions.

(4) Where an application for the registration of a transaction, instrument or event has been made, but the transaction, instrument or event has not been registered, then, for the purposes of subsection (1)(a), registration of the application shall be treated as registration of the transaction, instrument or event.

Notice of Registrar's decision to refuse registration, etc.

12. Notice of a decision of the Registrar -

- (a) to refuse an application for registration in the Register of Patents, or
- (b) other than with the consent of the applicant, to include an entry in a registration of a limitation, or
- (c) other than on the application of the person registered as proprietor in the Register of Patents -
 - (i) to revoke or modify a registration, or
 - (ii) to enter any right, title or interest in the Register of Patents under section 10,

shall state the grounds of the Registrar's decision and give particulars of the right of appeal conferred by section 31.

PART III
MODIFICATION & CORRECTION BY REGISTRAR

Modification of registration.

13. (1) The Registrar may, on the application of the person registered as proprietor of a patent in the Register of Patents, the inventor of a patented invention or of his own motion, modify the particulars of any registration in order to replicate -

- (a) the registration of the patent in the designated country concerned, or
- (b) any modification, correction or rectification made to the registration of the patent in that country,

under the laws relating to the registration of patents in force there.

(2) For the avoidance of doubt and without limiting the generality of the power of the Registrar under subsection (1), a modification may be made under this section for the following purposes -

- (a) to record -
 - (i) the extension of the term for which a patent is granted,
 - (ii) the restoration of a lapsed patent,

- (iii) the amendment of the specification of a patent,
 - (iv) any limitation which attaches to a patent, or
 - (v) the identity of the inventor, or joint inventor, or
- (b) to register a patent of addition;

provided that the modification is necessary in order to replicate the registration of the patent in the designated country concerned and which has been made under the laws relating to the registration of patents in force in that country.

(3) The provisions of section 5 apply, subject to any modifications specified by the Registrar, to an application under this section as they apply to an application for registration under that section.

(4) Where the Registrar decides, other than on the application of the person registered as proprietor in the Register of Patents, to modify a registration, the Registrar shall serve notice in writing of the decision on that person in accordance with the provisions of section 12.

(5) For the avoidance of doubt, the inventor of a registered patent has the right to be mentioned as such in the Register of Patents.

Power to correct clerical errors.

- 14.** (1) The Registrar may correct any error -
- (a) in the Register of Patents or
 - (b) in an application for -
 - (i) registration, or

(ii) modification under section 13.

(2) A correction may be made under this section -

(a) on a request in writing, and on payment of the appropriate fee, by the person registered as proprietor or by the applicant for registration or modification (as the case may be), or

(b) of the Registrar's own motion.

(3) Where the Registrar proposes to make a correction otherwise than on a request under subsection (2)(a), he shall -

(a) give notice of the proposal to the person registered as proprietor, or to the applicant for registration or modification (as the case may be), and

(b) give them an opportunity to be heard before making the correction.

PART IV

PATENT ATTORNEYS

Recognition of attorneys.

15. Any act required or authorised by this Ordinance to be done by or in relation to a person in connection with the registration of a person as the proprietor of a patent in the Register of Patents, or any procedure relating to a registered patent -

(a) may, except as otherwise provided by regulations of

the Department, and

(b) must, where regulations of the Department so provide,

be done by or in relation to an attorney authorised by that person orally or in writing.

Register of patent attorneys.

16. (1) The Department may make regulations requiring the keeping of a register of persons who act as attorney for others for the purpose of applying for the registration of any person as the proprietor of a patent in the Register of Patents, or for such other purposes as may be prescribed; and in this Ordinance a "**registered patent attorney**" means a person whose name is entered in the register kept pursuant to regulations under this section.

The register shall be known as "**the register of patent attorneys**".

(2) Regulations under subsection (1) may contain such provision as the Department thinks fit regulating the registration of persons, and may in particular -

- (a) require the payment of such fees as may be prescribed,
- (b) specify qualifications and standards of competence which must be held, or observed, by persons –
 - (i) wishing to have their names, or
 - (ii) whose names are,

entered in the register, and

- (c) authorise in prescribed cases the erasure from the register of patent attorneys of the name of any person registered in it, or the suspension of a person's registration.

(3) Regulations under subsection (1) may delegate the keeping of the register to another person, and may confer on that person -

- (a) power to make rules -
 - (i) in respect of the payment of fees, in the cases and subject to the limits prescribed by the regulations, and
 - (ii) in respect of any other matter which could be provided for by the regulations, and
- (b) such other functions, including disciplinary functions, as may be prescribed by the regulations.

Unregistered persons not to be described as registered patent attorneys.

17. (1) An individual who is not a registered patent attorney shall not

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- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "registered patent attorney", or
- (b) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered patent attorney.

- (2) A partnership shall not -
- (a) carry on a business under any name or other description which contains the words "registered patent attorney", or
 - (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a firm of registered patent attorneys,

unless all the partners are registered patent attorneys or the partnership satisfies such conditions as may be prescribed for the purposes of this section.

- (3) A body corporate shall not -
- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "registered patent attorney", or
 - (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a registered patent attorney,

unless all the directors of the body corporate are registered patent attorneys or the body satisfies such conditions as may be prescribed for the purposes of this section.

(4) A person who contravenes this section is guilty of an offence and is liable on summary conviction to a fine not exceeding level 5 on the uniform scale.

(5) The provisions of this section have effect only if regulations have been made under section 16(1) requiring the keeping of the register of patent

attorneys.

Power to prescribe conditions, etc, for mixed partnerships and bodies corporate.

18. (1) The Department may make regulations prescribing the conditions to be satisfied for the purposes of section 17 -

- (a) in relation to a partnership where not all the partners are qualified persons, or
- (b) in relation to a body corporate where not all the directors are qualified persons,

and imposing requirements to be complied with by such partnerships or bodies corporate.

(2) Regulations under subsection (1) may, in particular -

- (a) prescribe conditions as to the number or proportion of partners or directors who must be qualified persons,
- (b) impose requirements as to -
 - (i) the identification of qualified and unqualified persons in professional advertisements, circulars or letters issued by or with the consent of the partnership or body corporate and which relate to its business, and
 - (ii) the manner in which a partnership or body corporate is to organise its affairs so as to secure that qualified persons exercise a

sufficient degree of control over the activities of unqualified persons.

(3) Contravention of a requirement imposed by regulations made under this section is an offence for which a person is liable on summary conviction to a fine not exceeding level 5 on the uniform scale.

(4) In this section "**qualified person**" means a registered patent attorney.

Privilege for communications with registered patent attorneys.

19. (1) This section applies to communications as to any matter relating to the protection of any invention, design, technical information, trade mark, service mark, registered patent, or as to any matter involving passing off.

(2) Any such communication -

(a) between a person and his patent attorney, or

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent attorney,

is privileged from disclosure in legal proceedings in the same way as a communication between a person and his Advocate or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his Advocate.

(3) In subsection (2) a "**patent attorney**" means -

(a) a registered patent attorney,

- (b) a partnership entitled to describe itself as a firm of registered patent attorneys, or
- (c) a body corporate entitled to describe itself as a registered patent attorney.

Power of Registrar to refuse to deal with certain attorneys.

20. (1) The Department may make regulations authorising the Registrar to refuse to recognise as attorney in respect of any business under this Ordinance -

- (a) a person who has been convicted of an offence under section 17,
- (b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of patent attorneys on the ground of misconduct, incompetence or other good cause,
- (c) a person who is found by the Registrar to have been guilty of such conduct as would, in the case of an individual registered in the register of patent attorneys, render him liable to have his name erased from the register on the ground of misconduct,
- (d) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognise under paragraph (a), (b) or (c).

(2) Regulations under subsection (1) may prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct.

PART V
LICENCES OF RIGHT AND COMPULSORY LICENCES

Proprietor's application for entry in Register that licences are available as of right.

21. (1) The person registered as proprietor of a registered patent may, at any time, apply to the Registrar for an entry to be made in the Register of Patents to the effect that licences under the patent are to be available as of right.

(2) Where an application under subsection (1) is made, the Registrar shall give notice of the application to any person (other than the person registered as proprietor of the patent and applying under subsection (1)) registered as having a right in or under the patent and, if satisfied that the person registered as proprietor of the patent and applying under subsection (1) is not precluded by contract from granting licences under the patent, shall make the appropriate entry in the Register of Patents.

(3) Where an entry is made in accordance with subsection (2) in respect of a patent -

(a) any person shall, at any time after the entry is made, be entitled as of right to a licence under the patent on such terms as may be -

(i) settled by agreement, or

(ii) in default of agreement, settled by the Registrar on the application of the person registered as proprietor of the patent or the person requiring the licence,

- (b) the Registrar may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled,
- (c) if in proceedings for infringement of the patent the defendant undertakes to take a licence on such terms, 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 on those terms had been granted before the earliest infringement, and
- (d) any appropriate renewal fee payable in respect of the patent after the date of the entry shall be half any fee which would be payable if the entry had not been made.

(4) An undertaking under subsection (3)(c) may be given at any time before the making of a final order in the proceedings, without any admission of liability.

(5) The licensee under a licence of right may (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) request the person registered as proprietor of the patent to take proceedings to prevent any infringement of the patent; and if the person registered as proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were the registered proprietor, making the person registered as proprietor a defendant.

(6) A person registered as proprietor of a patent added as defendant under subsection (5), shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Cancellation of entry made under section 21.

22. (1) At any time after an entry has been made under section 21 in respect of a patent, the person registered as proprietor may apply to the Registrar for cancellation of the entry.

(2) Where -

- (a) an application is made under subsection (1), and
- (b) the balance, of any appropriate renewal fee which would have been payable if the entry had not been made, is paid,

the Registrar may, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application, make the appropriate cancellation in the Register of Patents.

(3) Within three months (or such other period as may be prescribed) after an entry has been made under section 21 in respect of a patent, any person who claims that the person registered as proprietor is, and was at the time of the entry, precluded by a contract in which the claimant is interested from granting licences under the patent, may apply to the Registrar for cancellation of the entry.

(4) Where the Registrar is satisfied, on an application under subsection (3), that the person registered as proprietor of the patent is and was so precluded, he shall make the appropriate cancellation in the Register of Patents; and the person registered as proprietor shall then be liable to pay, within a period specified by the Registrar, a sum equal to the balance of any appropriate renewal

fees which would have been payable if the entry had not been made, and the registration of the person as proprietor of the patent shall cease to have effect at the expiration of that period if that sum is not so paid.

(5) Where an entry is cancelled under this section, the rights and liabilities of the person registered as proprietor of the patent shall afterwards be the same as if the entry had not been made.

(6) Where an application has been made under this section, then -

- (a) in the case of an application under subsection (1) above, any person, and
- (b) in the case of an application under subsection (3) above, the person registered as proprietor of the patent,

may within three months (or such other period as may be prescribed) from the date of the making of the application give notice to the Registrar of opposition to the cancellation; and the Registrar shall, in considering the application, determine whether the opposition is justified.

Compulsory licences.

23. (1) At any time after the expiration of three years, or of such other period as may be prescribed, from the date of first registration, any person may apply to the Royal Court on one or more of the relevant grounds -

- (a) for a licence under the registered patent,
- (b) for an entry to be made in the Register of Patents to the effect that licences under the patent are to be available as of right, or

- (c) where the applicant is a department of the States, or a Government department of the United Kingdom, for the grant to any person specified in the application of a licence under the patent.

(2) Subject to section 24, if it is satisfied that any of the relevant grounds are established, the Royal Court may -

- (a) where the application is under subsection (1)(a), order the grant of a licence to the applicant on such terms as the Royal Court thinks fit,
- (b) where the application is under subsection (1)(b), order the Registrar to make such an entry as is there mentioned,
- (c) where the application is under subsection (1)(c), order the grant of a licence to the person specified in the application on such terms as the Royal Court thinks fit.

(3) An application may be made under this section in respect of a registered patent even though the applicant is already the holder of a licence under the patent; and no person shall be estopped or barred from alleging any of the matters specified in the relevant grounds by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted a licence.

(4) In this section "**the relevant grounds**" are -

- (a) where the patented invention is a product, that a demand in the Bailiwick for that product is not being

met on reasonable terms,

(b) that by reason of the refusal of the person registered as proprietor of the patent concerned to grant a licence or licences on reasonable terms -

(i) the exploitation in the Bailiwick of any other patented invention which -

(A) has been registered under Part II, and

(B) involves an important technical advance of considerable economic significance in relation to the invention for which the patent concerned was granted,

is prevented or hindered, or

(ii) the establishment or development of commercial or industrial activities in the Bailiwick is unfairly prejudiced, or

(c) that by reason of conditions imposed by the person registered as proprietor of the patent concerned on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the Bailiwick, is unfairly prejudiced.

Provisions concerning orders under section 23.

24. (1) No order shall be made under section 23 in respect of a patent unless -

- (a) the applicant has made efforts to obtain a licence from the person registered as proprietor of the patent on reasonable commercial terms and conditions, and
- (b) his efforts have not been successful within a reasonable period.

(2) No order shall be made under section 23 if the patented invention is in the field of semi-conductor technology.

(3) No order shall be made under section 23 in respect of a patent on the ground mentioned in section 23(4)(b)(i) unless the Royal Court is satisfied that the person registered as proprietor of the patent for the other invention is able and willing to grant the person registered as proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms.

(4) A licence granted -

- (a) in pursuance of an order made under section 23, and
- (b) in circumstances where the Royal Court is satisfied as to the matters referred to in subsection (3),

shall not be assigned except to a person to whom the patent for the other invention is also assigned.

(5) A licence granted in pursuance of an order made under section 23 -

- (a) shall not be exclusive,
- (b) shall not be assigned except to a person to whom there is also assigned the part of the enterprise that enjoys the use of the patented invention, or the part of the goodwill that belongs to that part,
- (c) shall be predominantly for the supply of the market in the British Islands,
- (d) shall include conditions entitling the person registered as proprietor of the patent concerned to remuneration adequate in the circumstances of the case, taking into account the economic value of the licence, and
- (e) shall be limited in scope and in duration to the purpose for which the licence was granted.

Provisions about licences under section 23.

25. (1) Where the Royal Court is satisfied, on an application made under section 23 in respect of a patent, that the manufacture, use or disposal of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the person registered as proprietor of the patent -

- (a) on the grant of licences under the patent, or
- (b) on the disposal or use of the patented product or the use of the patented process,

it may (subject to the provisions of that section) order the grant of licences under the patent to such customers of the applicant as it thinks fit as well as to the applicant.

(2) Where an application under section 23 is made in respect of a patent by a person who holds a licence under the patent, the Royal Court -

- (a) may, if it orders the grant of a licence to the applicant, order the existing licence to be cancelled, or
- (b) may, instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.

(3) Sections 21(5) and (6) shall apply to a licence granted in pursuance of an order under section 23 and to a licence granted by virtue of an entry under that section as it applies to a licence granted by virtue of an entry under section 21.

Exercise of powers on applications under section 23.

26. (1) The powers of the Royal Court on an application under section 23 shall be exercised with a view to securing the following general purposes -

- (a) that inventions which can be worked on a commercial scale in the Bailiwick and which should in the public interest be so worked shall be worked in the Bailiwick without undue delay and to the fullest extent that is reasonably practicable,
- (b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention,
- (c) that the interests of any person for the time being working or developing an invention in the Bailiwick

under the protection of a patent shall not be unfairly prejudiced.

(2) Subject to subsection (1), the Royal Court shall, in determining whether to make an order in pursuance of any application under section 23, take account of the following matters -

- (a) the nature of the invention, the time which has elapsed since first registration and the measures already taken by the person registered as proprietor of the patent or any licensee to make full use of the invention,
- (b) the ability of any person to whom a licence would be granted under the order concerned to work the invention to the public advantage, and
- (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted,

but shall not be required to take account of matters subsequent to the making of the application.

Opposition, appeal and arbitration.

27. (1) The person registered in the Register of Patents as the proprietor of the patent concerned or any other person wishing to oppose an application under sections 23 to 26 may, in accordance with rules of court, give to the Royal Court notice of opposition; and the Royal Court shall consider any opposition in deciding whether to grant the application.

(2) Where an order or entry has been made under section 23 -

- (a) the proprietor or any other person may, in accordance with rules of court, apply to the Royal Court to have the order revoked or the entry cancelled on the grounds that the circumstances which led to the making of the order or entry have ceased to exist and are unlikely to recur,
- (b) any person wishing to oppose an application under paragraph (a) may, in accordance with rules of court, give to the Royal Court notice of opposition, and
- (c) the Royal Court shall consider any opposition in deciding whether to grant the application.

(3) If it appears to the Royal Court on an application under subsection (2)(a) that the circumstances which led to the making of the order or entry have ceased to exist and are unlikely to recur, it may -

- (a) revoke the order or cancel the entry; and
- (b) terminate any licence granted to a person in pursuance of the order or entry subject to such terms and conditions as it thinks necessary for the protection of the legitimate interests of that person.

(4) Her Majesty's Procureur shall be entitled to appear and be heard in connection with determination by the Royal Court of any application in respect of which notice of opposition has been given under subsection (1).

Compulsory licences; supplementary provisions.

28. (1) The Royal Court may order that any entry is made in the Register of Patents under section 23 to 26 notwithstanding any contract which would

have precluded the entry on the application of the person registered as proprietor of the patent under section 21.

(2) An entry made in the Register of Patents under sections 23 to 26 shall for all purposes have the same effect as an entry made under section 21.

(3) No order shall be made in pursuance of an application under sections 23 to 26 which would be at variance with the provisions of any international instrument which has been applied or extended to, or in respect of, Guernsey.

Special provisions where patented invention is being worked abroad.

29. The Department may by regulations provide that the Royal Court may not (otherwise than for purposes of the public interest) make an order in respect of a patent in pursuance of an application under sections 23 to 26 if -

- (a) the invention concerned is being commercially worked in any country specified in the order, and
- (b) demand in the Bailiwick for any patented product resulting from that working is being met by importation from that country.

Special provisions concerning compulsory licences and plant breeders' rights.

30. (1) Where a person cannot acquire or exploit plant breeders' rights in a new variety without infringing a registered patent, he may apply to the Royal Court for a licence under the patent on the grounds that -

- (a) the applicant cannot acquire or exploit plant breeders' rights without infringing a prior patent,
- (b) the applicant has applied unsuccessfully to the

proprietor of the patent concerned for a licence to use that patent to acquire or exploit plant breeders' rights, and

- (c) the new plant variety, in which the applicant wishes to acquire or exploit the plant breeders' rights, constitutes significant technical progress of considerable economic interest in relation to the invention protected by the patent.

(2) Subject to the provisions of Schedule 4 to this Ordinance, if it is satisfied that the grounds under subsection (1)(a) to (c) are established, the Royal Court may order the grant of a licence to the applicant to use the invention protected by the patent, in so far as the licence is necessary for the exploitation of the new variety, on the conditions set out in Schedule 5 and on such other terms as the Court think fit.

(3) If and so far as any agreement purports to bind any person not to apply for a licence under subsection (1), it shall be void.

PART VI

APPEALS AND RECTIFICATION

Right of appeal to Royal Court from decisions of Registrar.

31. (1) If the Registrar decides -
- (a) to refuse an application for registration in the Register of Patents,
 - (b) other than with the consent of the applicant, to include an entry in a registration of a limitation,

- (c) other than -
 - (i) on the application of the person registered as proprietor in the Register of Patents, or
 - (ii) so as to comply with an order of the Royal Court -
 - (A) to revoke or modify a registration, or
 - (B) to enter any right, title or interest in the Register of Patents under section 10, or
- (d) to refuse an application for an entry to be made in the Register of Patents under section 21(1),
- (e) to settle terms under section 21(3)(a)(ii),
- (f) to make an order under section 21(3)(b),
- (g) to cancel any entry in the Register of Patents under section 22(2) or (4), or
- (h) determine whether opposition is justified under section 22(6),

then the applicant for registration or for a licence, the holder of any licence or the person registered as proprietor, as the case may be, may appeal against the decision to the Royal Court.

(2) The grounds of an appeal under this section are that the Registrar's decision was ultra vires, unreasonable in law or wrong.

- (3) An appeal under this section shall be instituted -
- (a) within a period of 28 days (or such longer period as the Royal Court may allow in a case where it is satisfied that it was not reasonably practicable for notice of appeal to be presented within such period of 28 days) immediately following the date of the notice of the Registrar's decision, and
 - (b) by summons served on the Registrar stating the grounds and material facts on which the appellant relies.

(4) The Registrar may, where an appeal under this section has been instituted, apply to the Royal Court, by summons served on the appellant, for an order that the appeal shall be dismissed for want of prosecution; and on hearing the application the Royal Court may -

- (a) dismiss the appeal or dismiss the Registrar's application (in either case on such terms and conditions as the Royal Court may direct), or
- (b) make such other order as the Royal Court considers just;

and the provisions of this subsection are without prejudice to the inherent powers of the Royal Court or to the provisions of rules 52(3), (4) and (5) of the Royal Court Civil Rules, 2007^c.

^c O.R.C. No. IV of 2007.

- (5) On an appeal under this section the Royal Court may -
- (a) set the decision of the Registrar aside and, if the Royal Court considers it appropriate to do so, remit the matter to him with such directions as the Royal Court thinks fit, or
 - (b) confirm the decision of the Registrar, in whole or in part.

(6) An appeal from a decision of the Royal Court made on an appeal under this section lies, with leave of the Royal Court or Court of Appeal, to the Court of Appeal on a question of law.

(7) Section 21 of the Court of Appeal (Guernsey) Law, 1961^d ("Powers of a single judge") applies to the powers of the Court of Appeal to give leave to appeal under subsection (6) as it applies to the powers of the Court of Appeal to give leave to appeal under Part II of that Law.

(8) This section does not confer a right of appeal on a question which has been determined by the Royal Court on an application by the Registrar for directions, or for a determination of a question of fact, law or procedure, under section 18 of the Intellectual Property (Office of Registrar) (Bailiwick of Guernsey) Ordinance, 2005.

Rectification of Register.

32. (1) The Royal Court may, subject to subsection (3), on the application of any person aggrieved, order the Registrar to rectify the Register of Patents by making, revoking or modifying any entry made therein in accordance with any provision of section 6, 8, 10, or 13.

^d Ordres en Conseil Vol. XVIII, p. 315.

(2) In proceedings under this section the Royal Court may determine any question which it is necessary or expedient to decide in connection with the rectification of the Register of Patents.

(3) A copy of an application for an order under this section shall be served on the Registrar not less than 21 days (or such other period as the Royal Court may, in its absolute discretion, direct) before the day of the hearing, and the Registrar is entitled to appear and be heard on the application and shall appear if so ordered by the Royal Court.

(4) A copy of an order of the Royal Court under this section shall be served on the Registrar who shall, on receipt thereof, rectify the Register of Patents accordingly.

(5) A rectification of the Register of Patents under this section has effect as follows -

- (a) an entry made has effect on and from the date on which it should have been made,
- (b) an entry modified has effect as if originally made in its modified form, and
- (c) an entry revoked shall be deemed never to have had effect,

unless the Royal Court directs otherwise in any particular case.

(6) The orders which may be made by the Royal Court under this section include (without prejudice to the generality of the Royal Court's powers) an order for the entry on the Register of Patents of a limitation in order to replicate any

limitation which attaches to the registration of the patent in the designated country concerned and which has been made under the laws relating to the registration of patents in force in that country.

Right of appeal from decisions of Royal Court on applications under Part V.

33. (1) A person aggrieved by a decision of the Royal Court concerning an application under Part V may, with leave of the Royal Court or Court of Appeal, appeal against the decision to the Court of Appeal.

(2) Section 21 of the Court of Appeal (Guernsey) Law, 1961 ("Powers of a single judge") applies to the powers of the Court of Appeal to give leave to appeal under subsection (1) as it applies to the powers of the Court of Appeal to give leave to appeal under Part II of that Law.

PART VII

RIGHTS AND NATURE OF RIGHTS OF PROPRIETORS OF PATENTS

Right given by registration as proprietor of patent.

34. (1) The registration of a person as the proprietor of a patent in the Register of Patents gives him -

- (a) the exclusive right to use in the Bailiwick the invention to which the patent relates, and
- (b) in respect of a patentable invention of a type described in Part II of Schedule 1, the protection in the Bailiwick described in that Part,

subject to any limitation attaching to the registration in question.

(2) For the purposes of subsection (1) any reference to the use of an invention means a reference to -

(a) where the invention is a product, making, disposing of, offering to dispose of, using or importing the product or keeping it whether for disposal or otherwise,

(b) where the invention is a process, using the process or offering it for use in the Bailiwick, in circumstances where -

(i) the person using it or offering it for use knows, or

(ii) it is obvious to a reasonable person, that,

using it in the Bailiwick without the consent of the proprietor would be an infringement of the right conferred by subsection (1),

(c) where the invention is a process, disposing of, offering to dispose of, using or importing any product obtained directly by means of that process or keeping any such product whether for disposal or otherwise.

(3) The Department may by regulation amend Part II of Schedule 1.

Co-ownership.

35. (1) Where two or more persons are registered as proprietors of a patent in the Register of Patents, each of them shall, subject to any agreement to the

contrary, be entitled to an equal undivided share in the right conferred under section 34.

(2) Where two or more persons are registered as proprietors of a patent in the Register of Patents, then, subject to the provisions of this section and subject to any agreement to the contrary -

- (a) each of them shall be entitled, by himself or his agents, to do in respect of the invention concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would, apart from this subsection and Part IX, amount to an infringement of the right conferred under section 34, and
- (b) any such act shall not amount to an infringement of the right conferred under section 34.

(3) Subject to any agreement for the time being in force, where two or more persons are registered as proprietors of a patent in the Register of Patents one of them shall not without the consent of the other or others -

- (a) apply for the registration to be revoked or modified, or
- (b) grant a licence under the patent, or assign a share in the patent.

(4) Where two or more persons are registered as proprietors of a patent in the Register of Patents, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the right conferred under section 34.

(5) Where an invention which is a product is disposed of by any of two or more persons, who are registered as proprietors of the registered patent relating to the invention concerned, to any person, that person and any other person claiming through him shall be entitled to deal with the invention in the same way as if it had been disposed of by a sole registered proprietor.

(6) Nothing in subsection (1) or (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

Duration and nature of rights.

36. (1) The right conferred under section 34 upon the person registered in the Register of Patents as proprietor of the patent -

(a) is personal or movable property, which may be transferred by assignment, testamentary disposition or operation of law as personal or movable property, and

(b) subsists as long as the registration subsists.

(2) Without prejudice to the generality of subsection (1), and subject to any rights vested in any other person of which notice is entered in the Register of Patents, the person or persons registered as proprietor of a patent in the Register of Patents may -

(a) assign, grant licences under or otherwise deal with the right conferred under section 34, and

(b) give effectual receipts for any consideration for any such assignment, licence or dealing.

PART VIII
INFRINGEMENT

Infringement of right conferred under section 34.

37. (1) Subject to the provisions of this section, the right conferred under section 34 upon the person registered as proprietor of the patent concerned is infringed by a person who, without the consent of that proprietor -

- (a) does anything which by virtue of Part VII is the exclusive right of the person so registered, or
- (b) supplies or offers to supply in the Bailiwick a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the Bailiwick.

(2) Subsection (1)(b) shall not apply to the supply or offer of a staple commercial product, unless the supply or the offer is made for the purpose of inducing the person supplied or, as the case may be, the person to whom the offer is made to do an act which constitutes an infringement of the right by virtue of subsection (1)(a).

(3) The right conferred under section 34 upon the person registered as proprietor of the patent concerned is not infringed by an act which -

- (a) is done privately and for purposes which are not commercial,

- (b) is done for experimental and research purposes relating to the subject-matter of the invention,
- (c) is done solely for uses reasonably related to the development and submission of information -
 - (i) under a law applicable in the Bailiwick, or
 - (ii) under the law of a designated country,

which regulates the manufacture, use or sale of any prescribed medicine, drug or veterinary biological product; provided that any information submitted under this paragraph is treated by the recipient in a manner which is consistent with that required, in respect of information of that type, under the Directive on the Community code relating to medicinal products for human use,

- (d) consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a medical practitioner or dentist or consists of dealing with a medicine so prepared,
- (e) consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of such a ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the internal or territorial waters of the Bailiwick,

- (f) consists of the harvesting and use of biological material obtained in the field of agriculture which was due to chance or which was technically unavoidable,
- (g) consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing the Bailiwick (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft, hovercraft or vehicle,
- (h) consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing the Bailiwick as aforesaid or of the importation into the Bailiwick, or the use or storage there, of any part or accessory for such an aircraft,
- (i) (subject to subsection (5)) consists of the use by a farmer of the product of his harvest for propagation or multiplication by him on his own holding, where there has been a sale of plant propagating material to the farmer by the person registered as proprietor of the patent or with his consent for agricultural use,
- (j) (subject to subsection (6)) consists of the use of an animal or animal reproductive material by a farmer for an agricultural purpose following a sale to the farmer, by the person registered as proprietor of the patent or with his consent, of breeding stock or other animal reproductive material which constitutes or contains the patented invention.

(4) For the purposes of subsection (1)(b) a person who does an act in relation to an invention which is prevented only by virtue of subsection (3) (a), (b) (c) or (d) from constituting an infringement of the right conferred under section 34 shall not be treated as a person entitled to work the invention, but -

(a) the reference in that subsection to a person entitled to work an invention includes a reference to a person so entitled by virtue of section 48, and

(b) a person who by virtue of section 41 is entitled to do an act in relation to the invention without it constituting such an infringement shall, so far as concerns that act, be treated as a person entitled to work the invention.

(5) Regulations may prescribe -

(a) provisions restricting the circumstances in which subsection (3)(i) applies, and

(b) provisions which apply where an act would constitute an infringement of the right to use a patented invention but for subsection (3)(i).

(6) For the purposes of subsection (3)(j), use for an agricultural purpose -

(a) includes making an animal or animal reproductive material available for the purposes of pursuing the farmer's agricultural activity, but

(b) does not include sale within the framework, or for the purposes, of a commercial reproduction activity.

(7) In subsection (3)(i) and (j) "sale" includes any other form of commercialisation.

(8) In this section -

"the Directive on the Community code relating to medicinal products for human use" means Directive 2001/83/EC of the European Parliament and of the Council, as amended^e,

"relevant ship" and **"relevant aircraft, hovercraft or vehicle"** mean respectively a ship and an aircraft, hovercraft or vehicle registered in, or belonging to, any country, other than the Bailiwick, which is a party to the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 or which is a member of the World Trade Organisation, and

"exempted aircraft" means an aircraft to which section 89 of the Civil Aviation Act 1982^f (aircraft exempted from seizure in respect of patent claims) applies.

Proceedings for infringement of right conferred under section 34.

38. (1) Subject to the following provisions of this Part, civil proceedings may be brought by the person registered as proprietor of a patent in respect of any act alleged to infringe the right conferred under section 34 in respect

^e Official Journal L 311. 28.11.2001, p. 67, amended by Directives 2003/63/EC (OJ L 159. 27.6.2003, p. 46) and 2004/27/EC (OJ L 136. 31.3.2004, p. 34).

^f An Act of Parliament (1982 c. 16); the Act was extended to the Bailiwick of Guernsey by United Kingdom S. I.'s 1992/230 and 1992/806.

of the patent and (without prejudice to any other jurisdiction of the court which is seized of the matter) in those proceedings a claim may be made -

- (a) for an injunction restraining the defendant from any apprehended act of infringement,
- (b) for an order for the defendant to deliver up or destroy any patented product in relation to which the right is infringed or any article in which that product is inextricably comprised,
- (c) for damages in respect of the infringement,
- (d) for an account of the profits derived by the defendant from the infringement, and
- (e) for a declaration that -
 - (i) the registration of the person as proprietor of the patent is valid, and
 - (ii) his right to use the patented invention has been infringed by the defendant.

(2) The court shall not, in respect of the same infringement, both award the person registered as proprietor of a patent damages and order that he shall be given an account of the profits.

(3) Subject to the following provisions of this Part, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted the court shall apply the principles applied by the Royal Court in relation to that kind of relief immediately before the commencement of this

section.

Restrictions on recovery of damages for infringement.

39. (1) In proceedings for infringement of the right conferred under section 34 -

- (a) damages shall not be awarded, and
- (b) no order shall be made for an account of profits,

against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent was a registered patent.

(2) For the purposes of subsection (1), a person shall not be taken to have been aware or to have had reasonable grounds for supposing that the patent was a registered patent, by reason only of the application to a product of -

- (a) the words "**registered patent**" or "**patented**", or
- (b) any word or words expressing or implying that a patent for the product has been registered,

unless the registered number of the registration in the Register of Patents, or in any relevant designated country, accompanied the word or words in question.

Assessment of damages.

40. (1) In proceedings for infringement of the right conferred under section 34, where a defendant -

- (a) knew, or

(b) had reasonable grounds to know,

that at the date of the infringement the patent was a registered patent, any damages awarded to the plaintiff shall be appropriate to the actual prejudice the plaintiff suffered as a result of the infringement.

(2) When awarding such damages -

(a) all relevant factors shall be taken into account, including in particular -

(i) the negative economic consequences, including any lost profits, which the plaintiff has suffered, and any unfair profits made by the defendant, and

(ii) elements other than economic factors, including the moral prejudice caused to the plaintiff by the infringement, or

(b) where appropriate, they may be awarded on the basis of the royalties or fees which would have been due had the defendant obtained a licence.

(3) This section does not affect the operation of any enactment or rule of law relating to remedies for the infringement of intellectual property rights except to the extent that it is inconsistent with the provisions of this section.

Right to continue use begun before first registration.

41. (1) A person, who in the Bailiwick before the date of first registration -

- (a) does in good faith an act which would constitute an infringement of the right conferred under section 34, or
- (b) makes in good faith effective and serious preparations to do such an act,

has the right to continue to do the act or, as the case may be, to do the act, notwithstanding registration; but this right does not extend to granting a licence to another person to do the act.

(2) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred under subsection (1) may -

- (a) authorise the doing of that act by any partners of his for the time being in that business, and
- (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(3) Where a product is disposed of to another in exercise of the rights conferred under subsection (1) or (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the person registered as proprietor of the patent.

Certificate of contested validity of registration.

42. (1) If in any proceedings before a court in the Bailiwick the validity of the registration of a patent in the Register of Patents is contested, and it is found by the court that the patent is, to any extent, validly registered, the court may

certify that the validity of the registration of the patent was contested in those proceedings.

(2) Where such a certificate is granted, then if in any subsequent proceedings before a court in the Bailiwick for infringement of the right in the patent or for invalidation of the registration of the patent a final order or judgment is made or given in favour of the person registered as proprietor, he is, unless the court directs otherwise, entitled to his costs on an indemnity basis.

(3) Subsection (2) does not apply to the costs of an appeal in any such subsequent proceedings.

Proceedings for infringement where there are co-proprietors.

43. (1) In the application of section 37 to a patent of which there are two or more co-proprietors the reference to the proprietor shall be construed -

- (a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 35 or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement, and
- (b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 35 or any such agreement, is or are the proper person or persons to give the requisite consent.

(2) One of two or more persons who are registered as co-proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the right conferred under section 34, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant shall not be liable for any costs or expenses unless he enters an

appearance and takes part in the proceedings.

Proceedings for infringement by exclusive licensee.

44. (1) Subject to the provisions of this section, the holder of an exclusive licence to exercise the right conferred under section 34 shall have the same right as the registered proprietor of the patent concerned to bring proceedings in respect of any infringement of the right conferred under section 34, committed after the date of the licence; and references to the registered proprietor of the patent in the provisions of this Ordinance relating to infringement shall be construed accordingly.

(2) 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 as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(3) In any proceedings taken by an exclusive licensee by virtue of this section the person registered as proprietor of the patent in the Register of Patents shall be made a party to the proceedings, but if made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Effect of non-registration on infringement proceedings.

45. Where by virtue of a transaction, instrument or event to which section 11 applies a person becomes the proprietor, or one of the proprietors, or an exclusive licensee of a registered patent and the right conferred under section 34 is subsequently infringed before the transaction, instrument or event is registered, in proceedings for such an infringement, the court shall not award him costs or expenses unless -

(a) the transaction, instrument or event is registered within

the period of 6 months beginning with its date, or

- (b) the court is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable.

Remedy for groundless threats of infringement proceedings.

46. (1) Where a person (whether or not the registered proprietor of, or entitled to any other right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for any infringement of the right conferred under section 34, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4), bring proceedings in the court against the person making the threats, claiming any relief mentioned in subsection (4).

(2) In any proceedings under subsection (1), the plaintiff shall, subject to subsection (3), be entitled to the relief claimed if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them.

(3) If the defendant proves that the acts in respect of which proceedings were threatened constitute, or, if done, would constitute an infringement of the right conferred under section 34 -

- (a) the plaintiff shall be entitled to the relief claimed only if he shows that the right conferred under section 34 alleged to be infringed is invalid in a relevant respect, and
- (b) even if the plaintiff does show that the right is invalid in a relevant respect, he shall not be entitled to the relief claimed if the defendant proves that at the time

of making the threats he did not know, and had no reason to suspect, that the right was invalid in that respect.

(4) The relief is -

- (a) a declaration to the effect that the threats are unjustifiable,
- (b) an injunction against the continuance of the threats, and
- (c) damages in respect of any loss which the plaintiff has sustained by the threats.

(5) Proceedings may not be brought under this section for -

- (a) a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process, or
- (b) a threat, made to a person who has made or imported a product for disposal or used a process, to bring proceedings for an infringement alleged to consist of doing anything else in relation to that product or process.

(6) For the purposes of this section a person does not threaten another person with proceedings for infringement of the right conferred under section 34 if he merely -

- (a) provides factual information about the right,

- (b) makes enquiries of the other person for the sole purpose of discovering whether, or by whom, the right has been infringed as mentioned in subsection (5)(a), or
- (c) makes an assertion about the right for the purposes of any enquiries so made.

(7) In proceedings under this section for threats made by one person (A) to another (B) in respect of an alleged infringement of a right conferred under section 34, it shall be a defence for A to prove that he used his best endeavours, without success, to discover -

- (a) where the invention to which the right relates is a product, the identity of the person (if any) who made or (in the case of an imported product) imported it for disposal,
- (b) where the invention is a process and the alleged infringement consists of offering it for use, the identity of a person who used the process,
- (c) where the invention is a process and the alleged infringement is an act falling within section 34(2)(b)(iii), the identity of the person who used the process to produce the product in question;

and that he notified B accordingly, before or at the time of making the threats, identifying the endeavours used.

Declaration as to non-infringement.

47. Without prejudice to the jurisdiction of the court to make a declaration apart from this section, a declaration that an act does not, or a proposed act would not, constitute an infringement of a registered patent may be made by the court in proceedings between the person doing or proposing to do the act and the registered proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown -

- (a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the act in question, and
- (b) that the proprietor has refused or failed to give any such acknowledgment.

PART IX

USE OF PATENTED INVENTIONS FOR THE SERVICES OF THE CROWN OR THE STATES

Crown or States use etc. of patented inventions.

48. (1) Notwithstanding anything in this Ordinance -

- (a) the States or any department of the States,
- (b) any Government department of the United Kingdom,
and
- (c) any person authorised in writing by any department of the States or by any Government department of the United Kingdom,

may, without the consent or licence of the person registered as proprietor of a patent

in the Register of Patents and without infringing the right conferred under section 34, or any other right under this Ordinance, do any relevant act in the Bailiwick in relation to a patented invention for the services of the Crown or the States.

(2) In this Part -

(a) "**any relevant act**" means -

(i) where the invention is a product -

(A) making, using, importing or keeping the product, or selling or offering to sell it where to do so would be incidental or ancillary to making, using, importing or keeping it, or

(B) in any event, selling or offering to sell it for foreign defence purposes or for the production or supply of specified drugs and medicines, or disposing or offering to dispose of it (otherwise than by selling it) for any purpose whatever,

(ii) where the invention is a process, using it or doing in relation to any product obtained directly by means of the process anything mentioned in subparagraph (i),

(iii) without prejudice to the foregoing, where the invention or any product obtained directly by means of the invention is a specified drug or medicine, selling or offering to sell the drug or

medicine,

(iv) supplying or offering to supply to any person any of the means, relating to an essential element of the invention, for putting the invention into effect,

(v) disposing or offering to dispose of anything which was made, used, imported or kept in the exercise of the powers conferred under subsection (1) and which is no longer required for the purpose for which it was made, used, imported or kept (as the case may be), and

(b) "**the States**" means the States of Guernsey, the States of Alderney or the Chief Pleas of Sark, as the case may be.

(3) Any act done in relation to an invention by virtue of this section is, in this Part referred to as "**use of the invention**"; and "**use**" in relation to an invention, in this Part shall be construed accordingly.

(4) The authority of a department of the States or a Government department of the United Kingdom, in respect of an invention, may be given under this section either before or after first registration and either before or after the use in respect of which the authority is given is made, and may be given to any person whether or not he is authorised directly or indirectly by the person registered as proprietor of the registered patent concerned to do anything in relation to the invention.

(5) Where any use of an invention is made by or with the authority of a department of the States or a Government department of the United

Kingdom ("**the relevant person**") under this section, then, unless it appears to the relevant person that it would be contrary to the public interest to do so, the relevant person shall notify the person registered as proprietor of the patent as soon as practicable after the second of the following events, that is to say, the use is begun and the date of first registration, and furnish him with such information as to the extent of the use as he may from time to time require.

(6) A person acquiring anything disposed of in the exercise of powers conferred by this section, and any person claiming through him, may deal with it in the same manner as if the patent were held on behalf of the States or the Crown, as the case may be.

Interpretation, etc, of provisions concerning use for the services of the Crown or States.

49. (1) Any reference in section 48 to a patented invention, in relation to any time, is a reference to an invention in respect of which first registration has occurred, or subsequently, occurs.

(2) In this Ordinance, unless context requires otherwise -

"the services of the Crown or the States" includes -

- (a) the supply of anything for foreign defence purposes,
- (b) the production or supply of specified drugs and medicines, and
- (c) such purposes relating to the production or use of atomic energy, or research into matters connected therewith as the Department thinks necessary or expedient; and

"use for the services of the Crown or the States" shall be construed accordingly.

(3) In section 48(2)(a)(i)(B) and subsection (2)(a), references to a sale or supply of anything for foreign defence purposes are references to a sale or supply of the thing -

(a) to the government of any country outside the British Islands, in pursuance of an agreement or arrangement between Her Majesty's Government in the United Kingdom and the government of that country, where the thing is required for the defence of that country or of any other country whose government is party to any agreement or arrangement with Her Majesty's Government in respect of defence matters, or

(b) to the United Nations, or to the government of any country belonging to that organisation, in pursuance of an agreement or arrangement between Her Majesty's Government and that organisation or government, where the thing is required for any armed forces operating in pursuance of a resolution of that organisation or any organ of that organisation.

(4) For the purposes of section 48(2)(a)(i)(B) and (iii) and subsection (2)(b), specified drugs and medicines are drugs and medicines which are required for the provision of such pharmaceutical, medical and dental services specified for the purposes in regulations of the Department.

Rights of third parties in respect of use for the services of the Crown or States.

50. (1) In relation to -

- (a) any use made for the services of the Crown or the States of an invention by a department of the States, any Government department of the United Kingdom or any person authorised by any such department, by virtue of section 48, or
- (b) anything done for the services of the Crown or the States to the order of a department of the States or any Government department of the United Kingdom by the person registered as proprietor of a patent in the Register of Patents,

the provisions of any licence, assignment or agreement to which this subsection applies shall be of no effect so far as those provisions restrict or regulate the working of the invention, or the use of any model, document or information relating to it, or provide for the making of payments in respect of, or calculated by reference to, such working or use; and the reproduction or publication of any model or document in connection with the said working or use shall not be deemed to be an infringement of any copyright or design right subsisting in the model or document or of any topography right.

(2) Subsection (1) applies to a licence, assignment or agreement which is made, whether before or after the commencement of this section, between (on the one hand) any person who is the person registered as proprietor of the patent concerned in the Register of Patents, or anyone who derives title from any such person or from whom such person derives title, and (on the other hand) any person whatever other than a department of the States or any Government department of the United Kingdom.

(3) Nothing in this section shall be construed as authorising the disclosure to a department of the States or any Government department of the United Kingdom or any other person of any model, document or information to the

use of which this section applies in contravention of any such licence, assignment or agreement as is mentioned in this section.

(4) For the purpose of this section "**topography right**" is, subject to subsection (5), the exclusive right to make a reproduction of the whole or a substantial part of the topography or deal in such a reproduction or a semi-conductor product incorporating such a reproduction; and a person deals in a reproduction or a semi-conductor product if he sells or hires it, offers or exposes it for sale or hire or imports it into the Bailiwick for the purpose of selling or hiring it.

(5) The right described in subsection (4) does not include -

- (a) the making of any reproduction privately for non-commercial purposes,
- (b) the making of any reproduction for the purpose of analysing or evaluating the topography or analysing, evaluating or teaching the concepts, processes, systems or techniques embodied in it,
- (c) dealing in any reproduction or product after it has been sold or hired within -
 - (i) the British Islands by or with the licence of the owner of topography right in the topography, or
 - (ii) the territory of any Member State (other than the United Kingdom) by or with the consent of the person, or one of the persons, for the time being entitled to import it into or sell or hire it within that territory,

- (d) any act restricted by copyright in the topography as an artistic work within the meaning of section 4 of the Copyright (Bailiwick of Guernsey) Ordinance, 2005^g.

Compensation for loss of profit.

51. (1) Where use is made of an invention for the services of the Crown or the States, the department of the States or the Government department of the United Kingdom concerned shall pay -

- (a) to the person registered as proprietor of the patent in the Register of Patents, or
- (b) where there is an exclusive licence in force in respect of the registered patent, to the exclusive licensee,

compensation for any loss resulting from his not being awarded a contract to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process.

(2) Compensation under this section is payable only to the extent that such a contract as is mentioned in subsection (1) could have been fulfilled from the existing manufacturing or other capacity of the person registered as proprietor in the Register of Patents or licensee to whom compensation is payable; but is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract.

(3) In determining any loss for the purposes of subsection (1), regard shall be had to the profit which would have been made on such a contract as is mentioned in subsection (1) and to the extent to which any manufacturing or other

^g Ordinance No. XIX of 2005.

capacity as is mentioned in subsection (1) was under-used.

(4) No compensation under this section is payable in respect of any failure to secure contracts to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process, otherwise than for the services of the States or the Crown.

(5) The amount of compensation payable under this section shall, if not agreed between the person registered as proprietor or licensee and the department of the States or the Government department of the United Kingdom concerned, be determined by the Royal Court on a reference under section 52.

(6) In this section "**the department of the States or the Government department of the United Kingdom concerned**", in relation to any use of an invention for the services of the Crown or the States, means the department of the States or the Government department of the United Kingdom by whom or on whose authority the use was made.

References of disputes as to use for services of Crown or States.

- 52.** (1) Any dispute as to -
- (a) the exercise by a department of the States or any Government department of the United Kingdom, or any person authorised in writing by any department of the States or any Government department of the United Kingdom, of the powers conferred by section 48,
 - (b) terms for the use of an invention for the services of the Crown or the States under section 48, or
 - (c) the right of any person to receive a payment under section 51,

may be referred to the Royal Court by either party to the dispute after first registration.

(2) If in proceedings concerning a dispute referred under subsection (1), the Royal Court, upon representations made by or on behalf of a department of the States or any Government department of the United Kingdom, determines that the disclosure -

- (a) of any document recording the invention, or
- (b) of any evidence relating to the trial of any issue arising in the proceedings,

would be prejudicial to the public interest, the disclosure may be made confidentially to any Advocate acting for the other party or to an independent expert mutually agreed upon.

(3) In determining under this section any dispute between a department of the States or any Government department of the United Kingdom and any person as to the terms for the use of an invention for the services of the Crown or the States, the Royal Court shall have regard to -

- (a) any benefit or compensation which that person or any person from whom he derives title may have received or may be entitled to receive directly or indirectly from the department of the States or any Government department of the United Kingdom in respect of the invention in question, and
- (b) whether that person or any person from whom he derives title has in the Royal Court's opinion without

reasonable cause failed to comply with a request of the department of the States or any Government department of the United Kingdom concerned to use the invention for the services of the Crown or the States on reasonable terms.

(4) On a reference under this section, the Royal Court may grant relief by way of an award of compensation in such amount, subject to such terms and conditions and payable to such person as appears reasonable, in all the circumstances, to the Royal Court.

(5) One of two or more persons who are registered as co-proprietors of a patent in the Register of Patents may, without the concurrence of the others, refer a dispute to the Royal Court under this section, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Special provisions concerning use for services of Crown or States during emergency.

53. (1) During a period of emergency the powers exercisable in relation to an invention by virtue of section 48 include power to use the invention for any purpose which appears to the department of the States or Government department of the United Kingdom concerned necessary or expedient -

- (a) for the efficient prosecution of any war in which Her Majesty may be engaged,
- (b) for the maintenance of supplies and services essential to the life of the community,
- (c) for securing a sufficiency of supplies and services

essential to the well-being of the community,

- (d) for promoting the productivity of industry, commerce, agriculture and fisheries,
- (e) for fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade,
- (f) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community, or
- (g) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any country outside the Bailiwick which is in grave distress as the result of war.

(2) References in this Ordinance to the services of the Crown or the States include, as respects a period of emergency, references to the purposes set out in subsection (1).

(3) In this section "**period of emergency**" means a period during which an order made by the Emergency Powers Authority under the Emergency Powers (Bailiwick of Guernsey) Law, 1965^h declaring a state of emergency to exist remains in force.

PART X

^h Ordres en Conseil Vol. XX, p. 6; amended by Vol. XXXI, p. 154; Order in Council No. XIV of 2001; Ordinance No. XXXIII of 2003 and Order in Council No. VII of 2005.

RIGHT TO EMPLOYEE'S INVENTIONS

Right to employee's inventions.

54. (1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Law and all other purposes if -

- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties, or
- (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done -

- (a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or

- (b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

(4) In subsection (3), the reference to application for a patent includes -

- (a) an application for registration under Part II, and
- (b) an application for a patent, or any other protection, under the law of a country outside the Bailiwick or any convention or treaty which has been ratified on behalf of, or extended to, Guernsey.

Supplementary provisions.

55. (1) This Part shall not apply to an invention made by an employee unless at the same time as he made the invention one of the following conditions was satisfied in his case:

- (a) he was mainly employed in the Bailiwick, or
- (b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in the Bailiwick to which the employee was attached, whether or not he was also attached elsewhere.

(2) In this Part, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his

making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee.

(3) Any references in section 54 to a patent and to a patent granted are respectively references to a patent or other protection and to its being granted under the law in force in any country or under any convention or treaty.

(4) Nothing in this Part shall be construed as precluding the operation of an agreement or contract in relation to the right to an invention.

(5) For the avoidance of doubt, this Part (or any provision of this Part) shall not apply where its operation has been excluded by any contract or agreement.

PART XI OFFENCES

Falsification of Register, etc.

56. (1) If a person makes, or causes or permits to be made, a false entry in the Register of Patents, knowing or having reason to believe that it is false, he is guilty of an offence.

(2) If a person -

(a) makes or causes or permits to be made anything falsely purporting to be a copy of or extract from an entry in the Register of Patents, or

(b) produces or tenders or causes or permits to be produced or tendered in evidence any such thing,

knowing or having reason to believe that it is false, he is guilty of an offence.

- (3) A person guilty of an offence under this section is liable -
 - (a) on summary conviction, to imprisonment for a term not exceeding 3 months, or a fine not exceeding level 5 on the uniform scale, or both,
 - (b) on conviction on indictment, to imprisonment for a term not exceeding two years, or a fine, or both.

Unauthorised claim of patent rights.

57. (1) If a person falsely and dishonestly represents that anything disposed of by him for value is a patented product he shall, subject to the following provisions of this section, be liable on summary conviction to a fine not exceeding level 3 on the uniform scale.

(2) For the purposes of subsection (1) a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word "**patent**" or "**patented**" or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

(3) Subsection (1) does not apply where the representation is made in respect of a product after the registration of the patent for that product or, as the case may be, the process in question has expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(4) In proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of the offence.

Unauthorised claim that registration of patent has been applied for.

58. (1) If a person represents that an application for registration of a patent has been made under this Ordinance in respect of any article disposed of for value by him and -

- (a) no such application has been made, or
- (b) any such application has been refused or withdrawn,

he shall, subject to the following provisions of this section, be liable on summary conviction to a fine not exceeding level 3 on the uniform scale.

(2) Subsection (1)(b) does not apply where the representation is made (or continues to be made) before the expiry of a period which commences with the refusal or withdrawal and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(3) For the purposes of subsection (1) a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words "**patent applied for**", "**registration applied for**" or "**patent pending**", or anything expressing or implying that an application for registration of a patent has been made under this Ordinance, shall be taken to represent that an application has been made in respect of it.

(4) In any proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of such an offence.

Offences committed by bodies corporate and partnerships, etc.

59. (1) Where an offence under this Ordinance is committed by a

body corporate and is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, any director, manager, secretary or other similar officer of the body corporate, or any person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and may be proceeded against and punished accordingly.

(2) Where the affairs of a body corporate are managed by its members, subsection (1) applies to a member in connection with his functions of management as if he were a director.

(3) Proceedings for an offence under this Ordinance alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not in that of the partners, but without prejudice to any liability of the partners under subsection (5).

(4) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(5) Where an offence under this Ordinance is committed by a partnership and is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, any partner or any person purporting to act in that capacity, he as well as the partnership is guilty of the offence and may be proceeded against and punished accordingly.

PART XII

MISCELLANEOUS AND GENERAL PROVISIONS

Burden of proof in certain cases.

60. (1) If the invention to which a registered patent relates is a process for obtaining a new product, the same product produced by a person, other than the person registered as the proprietor of the patent, or a licensee of his shall, unless the contrary is proved, be taken in any proceedings to have been obtained by

that process.

(2) In considering whether a party has discharged the burden imposed upon him by this section, the court shall not require him to disclose any manufacturing or commercial secrets if it appears to the court that it would be unreasonable to do so.

Extent of invention.

61. (1) For the purposes of this Ordinance an invention to which a registered patent relates shall, unless the context requires otherwise, be taken to be that specified in a claim of the specification of the patent as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent shall be determined accordingly.

(2) The Protocol (which is set out in Schedule 5) on the Interpretation of Article 69 of the European Patent Convention (which Article contains a provision corresponding to subsection (1)) shall, as for the time being in force, apply for the purposes of subsection (1) as it applies for the purposes of the Article.

Interpretation.

62. (1) In this Ordinance, unless the context requires otherwise, the following words and expressions shall be construed in accordance with this subsection or the other provisions of this Ordinance referred to against them in this subsection -

"**Advocate**" means an advocate of the Royal Court of Guernsey,

"**appropriate fee**" and "**appropriate renewal fee**" mean the fee or renewal fee, as the case may be, determined by the Registrar after consultation with the Department,

"**Bailiff**" includes the Bailiff, the Deputy Bailiff, a Lieutenant Bailiff, the Juge-Délegué and a Judge of the Royal Courtⁱ,

"**Bailiwick**" means the Bailiwick of Guernsey and the territorial waters adjacent to the Bailiwick,

"**biological material**" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system,

"**biotechnological invention**" means an invention which concerns a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used,

"**certified**", in relation to a copy or extract of an entry in the Register of Patents, means a copy or extract signed by the Registrar and sealed with his official seal,

"**commercial purposes**" : see subsection (2),

"**Community instrument**" has the meaning given by section 1(1) of the European Communities (Bailiwick of Guernsey) Law, 1973^j

"**copy**" or "**extract**", in relation to an entry in the Register of Patents which is not in documentary form, means a copy or extract in a visible and legible form in which it can be taken away,

ⁱ The office of Judge of the Royal Court was established by the Royal Court (Reform) (Guernsey) Law, 2008.

^j Ordres en Conseil Vol. XXIV, p. 87, Vol. XXVII, p. 242; Vol. XXIX, pp. 127 and 419; Order in Council No. XXV of 2002; Ordinances No. XIX of 1994; No. XVII of 1998; No. XLVII of 2001 No. XVIII of 2003 and No. II of 2007.

"Council" means the Council of the European Union,

"country" includes any territory, including a customs territory as that concept is understood in the context of the World Trade Organisation Agreement,

"Court of Appeal" means the court established by the Court of Appeal (Guernsey) Law, 1961,^k

"Crown" includes the Crown in right of the Bailiwick,

"customs Laws" and **"excise Laws"** mean those provisions of the Customs and Excise (General Provisions) (Bailiwick of Guernsey) Law, 1972, and any other enactment for the time being in force, relating to customs or, as the case may be, excise,

"a department of the States" means any department, council or committee of the States of Guernsey, the States of Alderney or the Chief Pleas of Sark, however called,

"dentist" means a recognised dentist within the meaning of the Doctors, Dentists and Pharmacists Ordinance, 1987,^l

"Department" means the States of Guernsey Commerce and Employment Department,

"designated country" : see sections 4(1)(c) and 4(2),

"designated country concerned" means, in relation to -

^k Ordres en Conseil Vol. XVIII, p. 315.

^l Recueil d'Ordonnances Tome XXIV, pp. 79, 238 and 262.

- (a) a patent entered in the Register of Patents, or
- (b) an oversea registered patent,

the designated country in which that patent is registered under the laws relating to the registration of patents in force in that country,

"Economic Community" has the meaning given by section 1(1) of the European Communities (Bailiwick of Guernsey) Law, 1973,

"enactment" means a Law, an Ordinance and any subordinate legislation and includes a Community instrument,

"European Patent Convention" means the Convention on the Grant of European Patents,

"exclusive licence" means a licence in writing signed by or on behalf of the person registered in the Register of Patents as proprietor of a patent conferring on the licensee, or on him and persons authorised by him, to the exclusion of all other persons (including the proprietor), any right in respect of the invention to which the patent relates, and **"exclusive licensee"** and **"non-exclusive licence"** shall be construed accordingly;

"first registration" means the first registration in the Register of Patents of a person as the proprietor of a patent in accordance with the grant of an application under section 5,

"Government department of the United Kingdom" includes any Northern Ireland department, any part of the Scottish Administration and any committee of the National Assembly for Wales,

"Her Majesty's Procureur" includes Her Majesty's Comptroller,

"invention" : see section 61(1),

"laws" include rules, practice and procedures,

"limitation", in relation to the registration of a patent, means any limitation, restriction, term or condition subject to which the patent is registered in the Register of Patents or, as the context may require, in the designated country concerned,

"medical practitioner" means a recognised medical practitioner within the meaning of the Doctors, Dentists and Pharmacists Ordinance, 1987,

"Member State" means a member state of the Economic Community,

"office" includes any authority or body responsible for the registration of patents, or patent applications,

"oversea registered patent" : see section 4(1)(a),

"oversea registered proprietor" : see section 4(1)(b),

"patented invention" means an invention to which a registered patent relates,

"patented product" means -

- (a) a product which is an invention for which a patent has been granted, or

- (b) in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied,

"patented process" means a process for which a patent has been granted,

"patent of addition" means a patent granted in respect of any improvement in, or modification of, a patented invention,

"plant breeders' rights" has the meaning given by section 1 of the Registered Plant Breeders' Rights (Bailiwick of Guernsey) Ordinance, 2007^m,

"prescribed" means prescribed by regulations,

"Register of Patents" means the Register established under section 2 in which persons are registered as the proprietors of patents,

"Register of Plant Breeders' Rights" means the register established under section 2 of the Registered Plant Breeders' Rights (Bailiwick of Guernsey) Ordinance, 2007,

"Registrar" means the Registrar of Intellectual Property appointed under the Intellectual Property (Office of Registrar) (Bailiwick of Guernsey) Ordinance, 2005ⁿ,

"registered patent" means a patent in respect of which a person is registered as the proprietor in accordance with the grant of an application

^m Ordinance No. IV of 2007.

ⁿ Ordinance No. XXIX of 2005, Recueil d'Ordonnances Tome XXX, p. 581.

under section 5, and whose registration has not been revoked under section 8 or 9,

"register of patent attorneys" means the register kept pursuant to regulations under section 16,

"registered patent attorney" means a person whose name is entered in the register of patent attorneys,

"regulations" means regulations made by the Department under this Ordinance,

"the Rio Convention on Biological Diversity" means the convention on biological diversity concluded at Rio de Janeiro on the 5th of June 1992,

"Royal Court" means the Royal Court of Guernsey sitting as an Ordinary Court (and see section 63 for the constitution of the Royal Court for the purposes of this Ordinance),

"rules of court" means rules of the Royal Court of Guernsey,

"services of the Crown or the States" and **"use for the services of the Crown or the States"** : see section 49(2) and (as respects any period of emergency within the meaning of section 53) see section 53,

"specification" means in relation to a registered patent, the description, claims and drawings contained in the application for the patent,

"the States" (other than for the purposes of Part IX, in relation to which see section 48(2)(b)) means the States of Guernsey,

"subordinate legislation" means any, regulation, rule, order, notice,

rule of court, resolution, scheme, warrant, byelaw or other instrument made under any enactment and having legislative effect,

"supplementary protection certificate" means a valid certificate of a type granted under, or in conformity with, any Community Instrument relating to the creation of supplementary protection certificates such as, without limitation, Council Regulation (EC) No. 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products^o or Council Regulation (EC) No. 1610/96 of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products,^p

"the 1922 Law" means the Loi ayant rapport aux Patentes, Dessins et Marques de Fabrique, 1922^q,

"TRIPS Agreement" means the agreement set out in Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994.

"uniform scale" means the uniform scale of fines from time to time specified under the Uniform Scale of Fines (Bailiwick of Guernsey) Law, 1989^r,

"variety" has the meaning given by section 42 of the Registered Plant Breeders' Rights (Bailiwick of Guernsey) Ordinance, 2007,

^o Official Journal L 182, 02/07/92 p. 1.

^p Official Journal L 198, 08/08/96 p. 30.

^q Ordres en Conseil Vol. VII, p. 1 and Vol. XVIII, p. 129; Recueil d'Ordonnances Tome XXX, p. 724 and Ordinance No. I of 2006

^r Ordres en Conseil Vol. XXXI, p. 278.

"**worked**" : see subsection (2),

and other words or expressions which are defined in the Intellectual Property (Enabling Provisions) (Bailiwick of Guernsey) Law, 2004 have the same meanings as in that Law.

(2) Unless the context requires otherwise, references in this Ordinance -

(a) to an act being done in relation to a product for "**commercial purposes**" are to its being done with a view to the product in question being sold or hired in the course of a business, and

(b) to an invention being "**worked**" in the Bailiwick include references to the invention being worked by the importation into the Bailiwick for the purpose of putting the patented product on the market or stocking it for that purpose.

(3) The Interpretation (Guernsey) Law, 1948^s applies to the interpretation of this Ordinance throughout the Bailiwick.

(4) Any reference in this Ordinance to an enactment is a reference thereto as from time to time amended, re-enacted (with or without modification), extended or applied.

Constitution of the Royal Court.

63. For the purposes of this Ordinance, the Royal Court -

^s Ordres en Conseil Vol. XIII, p. 355.

- (a) is constituted by the Bailiff sitting unaccompanied by the Jurats,
- (b) may appoint one or more assessors to assist it in the determination of any appeal or other matter over which it has jurisdiction under this Ordinance, and
- (c) has, in relation to functions conferred on it by this Ordinance, jurisdiction throughout the Bailiwick.

General provisions as to subordinate legislation.

64. (1) Regulations and rules of court under this Ordinance -

- (a) may be amended or repealed by subsequent regulations or rules of court hereunder,
- (b) may contain such transitional, consequential, incidental, supplementary and savings provisions as may appear to be necessary or expedient, and
- (c) in the case of regulations, may contain provision making consequential amendments to this Ordinance.

(2) Any power conferred by this Ordinance to make regulations or rules of court may be exercised -

- (a) in relation to all cases to which the power extends, or in relation to all those cases subject to specified exceptions, or in relation to any specified cases or classes of cases,
- (b) so as to make, as respects the cases in relation to which

it is exercised -

- (i) the full provision to which the power extends, or any lesser provision (whether by way of exception or otherwise),
- (ii) the same provision for all cases, or different provision for different cases or classes of cases, or different provision for the same case or class of case for different purposes,
- (iii) any such provision either unconditionally or subject to any prescribed conditions.

(3) Any Order or regulations under this Ordinance shall be laid before a meeting of the States of Deliberation of Guernsey as soon as possible after being made; and if at that or the next meeting the States of Deliberation resolve that the Order or regulations be annulled, the Order or regulations shall cease to have effect but without prejudice to anything done under the Order or regulations or to the making of a new Order or new regulations.

Saving for forfeited goods.

65. Nothing in this Ordinance affects the right of the States or any person deriving title directly or indirectly from the States, to sell, dispose of or use articles forfeited under the customs Laws or excise Laws.

Repeal and saving.

66. (1) The Loi ayant rapport aux Patentes, Dessins et Marques de Fabrique, 1922 is repealed.

(2) A patent which immediately before the commencement of this Ordinance was registered in the register of patents kept under Part II of the 1922

Law, and any other entry made in that register, shall on the commencement of this Ordinance be deemed to be a patent registered, or an entry made, in the Register of Patents established under this Ordinance; and any limitations subject to which the patent was registered under the 1922 Law shall apply in respect of the deemed registration under this subsection.

(3) A person who immediately before the commencement of this Ordinance was registered in the register of patents kept under Part II of the 1922 Law as proprietor of a patent so registered shall on the commencement of this Ordinance be deemed to be a person registered as proprietor of that patent in the Register of Patents established under this Ordinance; and any limitations subject to which he was registered under the 1922 Law shall apply in respect of his deemed registration under this subsection.

(4) For the purposes of giving effect to subsections (2) and (3) -

- (a) the Registrar shall replicate, in the Register of Patents established under this Ordinance, all entries made in the register kept under Part II of the 1922 Law, and
- (b) the deemed registrations effected by those subsections shall have effect from the date of commencement of this Ordinance.

(5) Any reference in any enactment (however expressed) to -

- (a) a patent entered in the register of patents kept under Part II of the 1922 Law, or
- (b) a person registered in that register as proprietor of such a patent,

shall be construed after the date of commencement of this Ordinance as a reference to (as the case may require) -

- (i) a patent registered in the Register of Patents established under this Ordinance, or
- (ii) a person so registered as proprietor of such a patent.

(6) Any reference, however expressed, in any enactment to Part II of the 1922 Law or any provision thereof shall, unless the contrary intention appears, be construed as a reference to this Ordinance or (as the case may be) to the corresponding provision of this Ordinance.

(7) References in this section however expressed to the registration of a patent in the register of patents kept under Part II of the 1922 Law are references to the entry on that register of a patent under the seal of the Patent Office established in England to the effect that the patent has been registered in England.

(8) The term of a patent which, immediately before the commencement of this Ordinance, was registered in the register of patents kept under Part II of the 1922 Law shall not be extended or curtailed by reason of the operation of this section.

Guernsey ships.

67. (1) This Ordinance applies to things done on a Guernsey ship as it applies to things done in the Bailiwick.

(2) In this section "**Guernsey ship**" means a ship registered in

Guernsey under the Merchant Shipping Act 1894^t.

Citation.

68. This Ordinance may be cited as the Registered Patents and Biotechnological Inventions (Bailiwick of Guernsey) Ordinance, 2009.

Extent.

69. This Ordinance has effect throughout the Bailiwick.

Commencement.

70. This Ordinance shall come into force on such day as the Department may by Order appoint; and different days may be appointed for different purposes.

K.H. TOUGH,
Her Majesty's Greffier.

^t An Act of Parliament (57 & 58 Vict. c. 60).

SCHEDULE 1

PART I

PRINCIPLES CONCERNING BIOTECHNOLOGICAL INVENTIONS

1. An application for registration of a patent under this Ordinance shall not be refused solely on the ground that the invention to which the patent relates is -
 - (a) a product consisting of or containing biological material, or
 - (b) a process by which biological material is produced, processed or used.

2. Biological material which is isolated from its natural environment or produced by means of a technical process may be the subject of an invention even if it previously occurred in nature.

3. The following are not patentable inventions -
 - (a) the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene,
 - (b) processes for cloning human beings,
 - (c) uses of human embryos for industrial or commercial purposes, and
 - (d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial

medical benefit to man or animal, and also animals resulting from such processes.

4. An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

5. The industrial application of a sequence or partial sequence of a gene must be disclosed in the application for the oversea registered patent as filed.

PART II

PROTECTION CONFERRED BY REGISTERED PATENTS CONCERNING BIOTECHNOLOGICAL INVENTIONS

6. The protection conferred by a registered patent on a biological material possessing specific characteristics as a result of the invention shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

7. The protection conferred by a registered patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the invention shall extend to biological material directly obtained through that process and to any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

8. The protection conferred by a registered patent on a product containing or consisting of genetic information shall extend to all material, save as provided for in paragraph 3 above, in which the product is incorporated and in which the genetic information is contained and performs its function.

9. The protection referred to in paragraphs 6, 7 and 8 shall not extend to biological material obtained from the propagation or multiplication of biological material placed on the market by the proprietor of the patent or with his consent, where the multiplication or propagation necessarily results from the application for which the biological material was marketed, provided that the material obtained is not subsequently used for other propagation or multiplication.

SCHEDULE 2

DESIGNATED COUNTRIES

Australia

Austria

Canada

China

France

Germany

India

Ireland

Israel

Japan

New Zealand

Norway

Russian Federation

Sweden

United Kingdom

United States of America

The European Patents Office

SCHEDULE 3

EXTENSION OF TERM OF PATENT

Grant of extension – unreasonable delay.

1. (1) The proprietor of a qualifying registered patent may apply to the Registrar for an extension to the term of the patent on the ground that -

- (a) there was an unreasonable delay by the Registrar in granting an application for registration of the patent under Part II, or
- (b) there was an unreasonable delay in the issue of the relevant overseas registered patent by the relevant designated country.

(2) If the Registrar is satisfied that the grounds of an application made under subparagraph (1) are made out, he may grant an extension to the term of the patent for a period of no more than 5 years.

(3) In determining the period by which to extend the term of a patent under subparagraph (2), the Registrar shall take into account such matters as he deems appropriate including -

- (a) the period by which the relevant overseas registered patent may have been extended, and
- (b) any conditions attached to any such extension,

but he shall not be bound to extend the term of the patent by any such period as may be relevant for the purposes of item (a).

Grant of extension - qualifying registered medical product or plant protection product patent.

2. (1) The proprietor of a qualifying registered medicinal product patent or a qualifying registered plant protection product patent may apply to the Registrar for an extension to the term of the patent on the ground that -

- (a) there was an unreasonable curtailment of the opportunity to exploit the patent caused by the process of obtaining marketing approval for the relevant medicinal or plant protection product, being the first medicinal or plant protection product to obtain marketing approval which uses the substance as an active ingredient, and
- (b) the term of the patent has not previously been extended on this ground.

(2) If the Registrar is satisfied that the grounds of an application made under subparagraph (1) are made out, he may grant an extension to the term of the patent for a period of no more than 5 years.

(3) In determining the period by which to extend the term of a patent under subparagraph (2), the Registrar shall take into account such matters as he deems appropriate including -

- (a) the period by which the relevant overseas registered patent may have been extended,
- (b) whether a supplementary protection certificate has been granted in respect of the relevant overseas registered patent, and

- (c) any conditions attached to any such extension,

but he shall not be bound to extend the term of the patent by any such period as may be relevant for the purposes of items (a) or (b).

(4) Where the term of a patent has been extended under subparagraph (2), the protection conferred by the patent during the term of the extension shall apply only to the substance referred to in subparagraph (1)(a).

Applications under paragraphs 1 or 2.

- 3. (1) An application under paragraph 1 or 2 shall be –
 - (a) made in the prescribed form and within any prescribed period,
 - (b) filed in the prescribed manner, and
 - (c) accompanied by –
 - (i) the appropriate fee, and
 - (ii) any prescribed documents,

and the Registrar may refuse an application which is not made in accordance with the provisions of this paragraph.

(2) As soon as practicable after the Registrar has extended the term of a patent under this Schedule, he shall –

- (a) send to the proprietor a certificate of extension of the patent term in the prescribed form specifying –

- (i) the period of the extension, and
 - (ii) any limitation on the protection conferred by the patent during the term of the extension, and
- (b) publish a notice of the extension in such manner as the Registrar may determine.

(3) The proprietor of a patent who has made an application under this Schedule may withdraw the application by informing the Registrar in writing of the withdrawal of the application, and any such withdrawal shall not be revocable.

Interpretation.

4. In this Schedule, unless the context requires otherwise -

"medicinal product" means any substance or combination of substances presented for treating or preventing disease in human beings or animals and any substance or combination of substances which may be administered to human beings or animals with a view to making a medical diagnosis or to restoring, correcting or modifying physiological functions in humans or in animals,

"plant protection product" means an active substance or preparation containing one or more active substances, put up in the form in which they are supplied to the user, intended to -

- (a) protect plants or plant products against all harmful organisms or prevent the action of such organisms, in so far as such substances or preparations are not otherwise defined below,

- (b) influence the life processes of plants, other than as a nutrient (e.g. plant growth regulators),
- (c) preserve plant products,
- (d) destroy undesirable plants, or
- (e) destroy parts of plants or check or prevent undesirable growth of plants;

"qualifying registered medicinal product patent" means a qualifying registered patent relating to a medicinal product,

"qualifying registered plant protection product patent" means a qualifying registered patent relating to a plant protection product,

"qualifying registered patent" means a registered patent where five years or more have elapsed from the date of first registration of that patent, and

the **"term"** of a qualifying registered patent, a qualifying registered medicinal product patent or a qualifying registered plant protection product patent means the term of the relevant overseas registered patent under the law of the relevant designated country.

SCHEDULE 4

COMPULSORY LICENCES: PLANT BREEDERS' RIGHTS

Duty to notify and consider representations of proprietor and others.

1. (1) A person who makes an application under section 30(1) must give notice of the application to the person who is registered as proprietor of the patent concerned in the Register of Patents at least 28 days before the first hearing of the application is due to take place.

(2) If the person who is registered as proprietor of the patent concerned, or any other person, wishes to oppose an application under section 30(1) he may, in accordance with rules of court, give to the Royal Court and the applicant notice of opposition.

(3) Where a notice has been given under subparagraph (2), the Royal Court shall, when deciding whether to grant an application under section 30(1) -

- (a) consider the contents of the notice, and
- (b) give the person who has given the notice the opportunity to be heard.

Conditions.

2. (1) A compulsory patent licence shall -
- (a) not be exclusive,
 - (b) entitle the person registered as proprietor of the patent concerned to an appropriate royalty, and

- (c) entitle the person registered as the proprietor of the patent concerned to a cross licence on reasonable terms to use the new plant variety.

(2) Where the Royal Court orders the grant of a compulsory patent licence to a person who is registered as the proprietor of plant breeders' rights, in the Register of Plant Breeders' Rights, in respect of the new plant variety, the person registered as the proprietor of the patent concerned may request, a cross licence on reasonable terms of the plant breeders' rights to use the new plant variety in respect of which the compulsory patent licence has been granted and, on such request, the Court shall order the grant of such a cross licence to that person.

(3) Where the Royal Court orders the grant of a compulsory patent licence to a person who has yet to be registered as the proprietor of plant breeders' rights, in the Register of Plant Breeders' Rights, in respect of the new plant variety, the person who is registered as the proprietor of the patent concerned may request a cross licence on reasonable terms of the plant breeders' rights to use the new plant variety in respect of which the compulsory patent licence has been granted and, on such request -

- (a) the Court shall order the grant of such a cross licence to that person, and
- (b) the cross licence shall come into effect on the registration of the holder of the compulsory patent licence as the proprietor of plant breeders' rights, in the Register of Plant Breeders' Rights, in respect of the new plant variety.

Variation.

3. On application at any time by a party to the Royal Court in accordance with rules of court, the Court may extend, limit or in any other respect vary an order for grant of a -

- (a) compulsory patent licence, or
- (b) cross licence under paragraph 2(2) or 2(3),

and extend, limit or in any other respect vary the licence granted under the order.

Revocation.

4. (1) A party may, at any time, apply to the Royal Court in accordance with rules of court to revoke an order for the grant of a -

- (a) compulsory patent licence, or
- (b) cross licence under paragraph 2(2) or 2(3),

if the circumstances which led to the order for grant have ceased to exist or are unlikely to recur.

(2) If on receipt by the Royal Court of an application under paragraph (1), the Court is satisfied that the circumstances which led to an order for grant of a -

- (a) compulsory patent licence, or
- (b) cross licence under paragraph 2(2) or 2(3),

have ceased to exist or are unlikely to recur, the Court may revoke the order and terminate the licence granted under the order, subject to such terms and conditions as it thinks necessary for the protection of the legitimate interests of the holder of

the compulsory patent licence or the cross licence ordered to be granted under paragraph 2(2) or 2(3).

Interpretation.

5. In this Schedule -

"**compulsory patent licence**" means a licence ordered to be granted by the Royal Court under section 30(2), and

"**party**" means the person who is registered as the proprietor of the patent concerned or the applicant, as the case may be, in an application under section 30(1) or their respective successors in title.

SCHEDULE 5

PROTOCOL ON THE INTERPRETATION OF ARTICLE 69 OF THE
EUROPEAN PATENT CONVENTIONArticle 1

General principles

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

Article 2

Equivalents

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

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