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Jeff Watson
The Patent Office
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15 February 2006

Our ref:C17P16/06

Dear Jeff

Implementation of the Enforcement Directive

Proposed amendments to sections 62, 63 and 68, Patents Act 1977 and section 2, Patents Act 2004 (to be implemented by rules under the European Communities Act 1972)

You asked, with a very short deadline for reply, for our comments on these recently proposed amendments and on whether they would resolve any potential conflict between Article 13 of the Enforcement Directive and the Patents Act 1977.

The main thrust of the proposed amendments concerning sections 62(3) and 63(2) is to add additional complexity to what are already complex provisions. Their effect appears to be that even in the situation where the specification of a patent has been amended after grant to ensure that the patent is not invalid, or where the patent has been declared partially invalid during litigation, it will be enforceable from the date of grant if the infringer "had reasonable grounds for knowing" that he was infringing, even when the original specification was drafted in less than good faith, and with less than reasonable skill and knowledge.

We do not consider that these amendments to the primary legislation should be made. They certainly should not be made at such short notice, by rule, without adequate time in which to fully consider their implications. The existing provisions serve as a strong discouragement to inadequate, poor faith, drafting. We consider that it is important for sloppy drafting to be discouraged by providing, as under the existing legislation, that damages are not available until the specification is satisfactory. We also consider that the proposed changes will lead to speculative litigation about what the infringer should have known from reading a badly drafted specification of an apparently invalid or partially valid patent.

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We do not believe these changes are necessary to comply with the directive. The Enforcement Directive is silent about the operative date for damages where the patent as granted is in need of amendment or is only partially valid. In the same way as other directives, the directive is not a comprehensive code dealing with all situations, but a framework where details are left to national law. Our preliminary view is that the amendments proposed are not necessary for the implementation of the directive.

Turning now to the other proposed amendments, an account of profits is to be treated in the same way as damages. While this seems sensible, we see no ground in the directive for making this change. We also see no ground in the directive for changing section 68 so that an unregistered assignee or licensee will be able to receive damages etc. The directive (article 4) provides that owners and licensees must apply "in accordance with the provisions of the applicable law". Finally, we see no justification for modifying the good faith requirements by adjustment of section 2, PA 2004. This change will further dilute the need to prepare the specification in good faith.

We would appreciate the opportunity to discuss these proposed amendments with the Patent Office, if they are to be pursued, in due time.

Yours sincerely,

Sheila Draper

Secretary, TMPDF