

The Innovation Patents (Bailiwick of Guernsey) Ordinance, 2014

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The Innovation Patents (Bailiwick of Guernsey) Ordinance, 2014

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 GENERAL

Innovation patents.

1. (1) Subject to the provisions of this Ordinance, innovation patents shall be available for any innovations, including products or processes, in all fields of technology and commerce, provided that the innovations -

- (a) are new,
- (b) involve an innovative step, and
- (c) are capable of industrial or commercial application, and

references in this Ordinance to an "**innovation patent**" shall be construed accordingly.

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

(3) For the purposes of subsection (2) 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.

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

^b Order in Council No. XIV of 2004.

(4) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as innovations which are susceptible of industrial or commercial application within the meaning of subsection (1).

(5) Subsection (4) shall not prevent a product consisting of a substance or composition being treated as capable of industrial or commercial application merely because it is an innovation for use in any such method.

(6) 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 an innovation patent concerning a biotechnological innovation provided that the innovation satisfies the principles set out in Part I of Schedule 1.

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

(8) Notwithstanding subsection (1), anything which consists of -

- (a) a discovery, scientific theory or mathematical method,
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever,
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business,
- (d) the presentation of information;

is not an innovation for the purpose of this Ordinance, but this shall only prevent anything from being treated as an innovation to the extent that an innovation patent or application for an innovation patent relates to that thing as such.

Novelty.

2. (1) An innovation shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be taken to comprise all matter (whether a product, a service, a process, information about the same or anything

else) which has, at any time before the priority date of an innovation, been made available to the public (whether in the Bailiwick or elsewhere) by written or oral description, by use or in any other way.

(3) For the purposes of this section the disclosure of matter constituting an innovation shall be disregarded in the case of an application for an innovation patent if occurring later than the beginning of the period of six months immediately preceding the priority date of the innovation to which the application relates, where -

- (a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person, or
- (b) the disclosure occurred because the innovation was displayed at an international exhibition.

(4) A person who claims that disclosure of a matter should be disregarded under subsection (3) shall, if so requested by the Registrar, provide the Registrar with such evidence as he may reasonably require in support of that claim.

Innovative step.

3. (1) An innovation shall be considered as involving an innovative step if it exhibits an advantage having regard to the state of the art as described in section 2(2).

(2) The advantage referred to in subsection (1) must be a practical or technical advantage for the manufacture or use of the product or process in question, or another benefit to the user, for example in the field of education, financial services, computer programs, biotechnology or entertainment.

(3) An innovation is to be taken to involve an innovative step unless, to a person skilled in and having regard to the relevant art as it existed before the priority date of the relevant claim, it only varies from the state of the art in ways that make no substantial contribution to the working of the innovation.

Industrial or commercial application.

4. An innovation shall be taken to be capable of industrial or commercial application if it can be made or used in any kind of industry or

commerce, for example in the field of agriculture, education, financial services, computer programs, biotechnology or entertainment.

Priority Date.

5. (1) For the purposes of this Ordinance the priority date -
- (a) of an innovation to which an application for an innovation patent relates, and
 - (b) of any matter (whether or not the same as the innovation) contained in any such application,

is, except as provided by the following provisions of this Ordinance, the date of filing the application.

(2) Any person who has duly filed an application ("**the first application**") for an innovation patent or a patent in a State being a party to the Paris Convention for the Protection of Industrial Property as from time to time revised, or his successors in title, shall enjoy, for the purpose of filing an innovation patent application in respect of the same innovation in the Bailiwick, a right of priority during a period of twelve months from the date of filing of the first application.

- (3) Any filing that is equivalent to a regular national filing under -
- (a) the domestic law of the Member State where it was made, or
 - (b) bilateral or multilateral agreements relating to intellectual property rights, which have been entered into by or on behalf of the States of Guernsey,

shall be recognised as giving rise to a right of priority.

(4) "**Regular national filing**" means any filing that is sufficient to establish the date on which the application was filed in the Member State concerned, whatever the outcome of the application may be.

Innovation Patent Register.

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

- (a) innovation patents may be registered, and
- (b) persons may be registered as the proprietors of those innovation patents.

(2) The Innovation Patent Register need not be kept in documentary form.

(3) The Innovation Patent Register shall contain –

- (a) the dates on which innovation patents are granted,
- (b) the names and addresses of persons registered in it as the proprietors of innovation patents,
- (c) the date on which persons were so registered,
- (d) details of the person, or persons, whom the applicant believes to be the innovator, or joint innovator, of the innovation,
- (e) notices of assignments and transmissions of innovation patents registered in it,
- (f) details of any limitations subject to which innovation patents are registered in it, and
- (g) 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) in the absence of regulations under subparagraph (i), as the Registrar may think fit.

- (4) Subject to subsection (5) -
- (a) the Innovation Patent Register 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 Innovation Patent Register.

(5) Where it appears to the Registrar that the publication of information, or the communication of information to any person or class of persons, is prohibited or restricted by law, or, in his opinion is otherwise objectionable, the Registrar may impose a prohibition or restriction on the publication or communication of information in respect of that innovation patent.

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

Evidence of entries in register.

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

(2) A copy or extract of an entry in the Innovation Patent Register supplied under section 6(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

APPLICATIONS FOR GRANTS, REGISTRATION AND POST GRANT

Entitlement to grant.

8. (1) An innovation patent for an innovation may be granted -
- (a) to the innovator or joint innovators,
 - (b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law or by virtue of an enforceable term of any agreement

entered into with the innovator before the making of the innovation, was or were at the time of the making of the innovation entitled to the whole of the property in it (other than equitable interests) in the Bailiwick, or

- (c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) or any person so mentioned and the successor or successors in title of another person so mentioned;

and to no other person.

(2) In this Ordinance "**innovator**" in relation to an innovation means the actual deviser of the innovation and "**joint innovator**" shall be construed accordingly.

(3) Except so far as the contrary is established, a person who makes an application for an innovation patent shall be taken to be the person who is entitled under subsection (2) to be granted an innovation patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

Right to be mentioned as innovator.

9. (1) Subject to subsection (2), the innovator or joint innovators of an innovation shall have a right to be mentioned as such in any innovation patent granted for the innovation.

(2) A person who has waived his right to be mentioned as innovator, or joint innovator, in any innovation patent granted for the innovation, shall not enjoy the right under subsection (1).

Applications for grant and registration.

10. (1) A person wishing to be granted an innovation patent and registered as the proprietor of that innovation patent in the Innovation Patent Register shall apply in that behalf to the Registrar.

(2) The innovation patent application shall relate -

- (a) to one innovation only, or

- (b) to a group of innovations so linked as to form a single general innovative concept.

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

- (a) a specification which -

- (i) has a title of the innovation and a designation of the classification of the innovation,

- (ii) describes -

- (A) the innovation in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, and

- (B) the kind of industry or commerce in which it can be made or used,

- (iii) incorporates one or more claims to the innovation, but not exceeding five or such other number -

- (A) as may from time to time be prescribed or,

- (B) in the absence of regulations under item A, as the Registrar may think fit,

which claims shall be clear and concise and supported by the description,

- (iv) includes a statement clearly and concisely setting out the state of the art (as described in section 2(2)) which is most pertinent to the claimed innovation, as known to the applicant

at, or just prior to, the priority date of the innovation,

(v) includes a statement clearly and concisely setting out -

(A) the nature of the innovative step, and

(B) the advantage exhibited (as described in section 3),

as known to the applicant at, or just prior to, the priority date of the innovation,

(vi) includes any drawing referred to in the description, claim or claims, and

(vii) includes an abstract which shall serve only for use as technical information and may not be taken into account for any other purpose and, in particular, not for the purpose of interpreting the scope of the protection sought,

(b) a statement, made by a person accredited by the Registrar, in such form as the Registrar may from time to time determine, that following consideration of -

(i) the specification and claims, and

(ii) any searches carried out by the maker of the statement (the details of which searches shall be attached to the statement),

the innovation for which the innovation patent is sought appears, to the best of his professional judgement, to be new and involves an innovative step under sections 2 and 3 respectively,

- (c) the appropriate fee, and
 - (d) such other information, documents or action as the Registrar may reasonably require, either at submission or at any time prior to grant, for the purpose of determining the application.
- (4) Without prejudice to the generality of subsection (3)(d) –
- (a) the additional information, documents or action which the Registrar may require includes -
 - (i) a statement, where the applicant is not the sole innovator or the applicants are not the joint innovators, indicating the derivation of his or their entitlement to exercise the rights to the innovation patent,
 - (ii) information concerning any claim concerning the priority date of -
 - (A) the innovation to which the application relates, or
 - (B) any other innovation patent or innovation patent application,
 - (iii) information concerning any claim regarding non-prejudicial disclosure as mentioned in section 2(4),
 - (iv) in relation to any innovation which requires for its performance the use of a micro-organism, information concerning the availability to the public of samples of the micro-organism, and
 - (v) a requirement for the applicant to give notice of the application in such manner, and for such period –

- (A) as may from time to time be prescribed,
or
 - (B) in the absence of regulations under item
A, as the Registrar may think fit, and
- (b) the Registrar's requirements may differ as between
different applications.
- (5) Every application under this Ordinance shall be made in the
English language.
- (6) The contents of any document accompanying an application
made to the Registrar under this Ordinance -
- (a) shall be in the English language, or
 - (b) where the language used is not the English language,
shall be translated into English by a translator
approved by the Registrar.
- (7) A translation made under subsection (6)(b) shall be certified
by the translator in such manner as the Registrar may determine and shall
accompany the original document to which it relates.
- (8) The Registrar may, if so requested by the applicant, grant a
deferral of the obligation to submit the statement under subsection 3(b) for such
period, not exceeding 12 months as the Registrar thinks fit, commencing upon the
date of submission of the application for an innovation patent to which the statement
relates.

Examination as to formal requirements of applications.

11. (1) If an innovation patent application has been accorded a date of
filing, and is not refused or withdrawn by virtue of this section, the Registrar shall
examine whether the requirements of section 10 and of any regulations,
determination or requirement, made under that section (the "**formal requirements**")
have been met.

(2) Where, upon examination under subsection (1), the Registrar determines that any formal requirements have not been met he may, subject to subsection (3), by notice in writing given to the applicant, require the applicant to provide such additional information, document or other matter as he may reasonably require to enable him further to determine the matter.

(3) Where, upon examination under subsection (1), the Registrar determines that the claim, or claims, included in the specification accompanying the application does, or do, not comply with the requirements of section 10(2), he may -

- (a) restrict the examination to the single innovation, or single group of innovations forming a single general innovative, first stated in the claim or claims, and
- (b) by notice in writing given to the applicant, require the applicant to amend it, or them, accordingly,

and, until any such requirement is met, the Registrar shall not be obliged to complete any examination.

(4) The Registrar -

- (a) shall refuse an application under section 10 -
 - (i) which is not accompanied by the appropriate fee in accordance with section 10(3)(c), or
 - (ii) where the Registrar has granted a deferral under section 10(8) and the period of the deferral has expired without the statement referred to in the subsection having been submitted, and
- (b) may refuse an application for registration which is not made in accordance with any of the other provisions of section 10.

(4) Where the Registrar decides to refuse an application for

registration in the Innovation Patent Register under subsection (3), he shall serve notice in writing of the decision on the applicant in accordance with the provisions of section 21.

(5) Save as otherwise provided, at any time before an innovation patent is granted, an applicant may amend his application of his own volition in accordance with such conditions -

- (a) as may from time to time be prescribed, or
- (b) in the absence of regulations under paragraph (a), as the Registrar may think fit.

(6) Any amendment made under this section shall be invalid to the extent that it extends the subject-matter disclosed in the application as filed.

(7) The Registrar may, without an application being made to him for the purpose, amend the specification (including, for the avoidance of doubt, the abstract) contained in an application for an innovation patent so as to acknowledge a registered trade mark.

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

(9) Except as otherwise provided, nothing in this Ordinance providing for the examination by the Registrar of an innovation patent application shall be construed as imposing any obligation upon the Registrar to consider or to have regard to, for the purpose of such examination, any question as to -

- (a) the eligibility of the innovation for the grant of an innovation patent,
- (b) whether the applicant is entitled to any priority claimed in the application,
- (c) whether the innovation is properly disclosed in the application, or
- (d) any other related matter.

Publication of application.

12. (1) When the Registrar has completed his examination of an application for an innovation patent, he shall, as soon as possible thereafter, publish the application, together with such accompanying documents and information as he shall determine.

(2) The Registrar shall (unless the application is withdrawn or refused before preparations for its publication have been completed) -

- (a) advertise the fact and date of publication under subsection (1) in such manner as he shall determine, and
- (b) invite any person to send to him in writing, within 2 months of the date of publication (or such longer period as the Registrar may determine), observations on the question of whether an innovation patent should be granted.

(3) The Registrar may omit from the specification of a published application for an innovation patent any matter -

- (a) which in his opinion disparages any person in a way likely to damage him, or
- (b) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

(4) Where an application for an innovation patent has been published, but an innovation patent has not been granted to the applicant, any other person may make observations in writing to the Registrar on the question of whether an innovation patent should be granted, which observations the Registrar may take into account for the purpose of finally determining the application.

(5) It is declared that a person does not become a party to any proceedings under this Ordinance before the Registrar by reason only that he makes observations under this section.

(6) Notwithstanding the other provisions of this section, the Registrar may, in his discretion, publish -

- (a) any innovation patent application, together with such accompanying documents and information as he shall determine, on a second or additional occasion, and
- (b) any observations upon any application,

in such manner, for such period and for such purpose, as he may determine.

Determination before grant of questions about entitlement to innovation patents.

13. (1) At any time before an innovation patent has been granted for an innovation (whether or not an application has been made for it) -

- (a) any person may refer to the Registrar the question whether he is entitled to be granted (alone or with any other persons) an innovation patent for that innovation or has, or would have, any right in or under any innovation patent so granted or any application for such an innovation patent, or
- (b) any of two or more co-proprietors of an application for an innovation patent for that innovation may so refer the question whether any right in or under the application should be transferred or granted to any other person;

and the Registrar shall determine the question and may make such order as he thinks fit to give effect to the determination.

(2) Where a person refers a question relating to an innovation under subsection (1)(a) to the Registrar after an application for an innovation patent for the innovation has been filed and before an innovation patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the Registrar, the Registrar may without prejudice to the generality of subsection (1) and subject to subsection (6) –

- (a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant,
 - (b) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly,
 - (c) refuse to grant an innovation patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred, or
 - (d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.
- (3) Where a question is referred to the Registrar under subsection (1)(a), and –
- (a) the Registrar orders an application for an innovation patent for the innovation to which the question relates to be amended,
 - (b) any such application is refused under subsection (2)(c) before the Registrar has disposed of the reference (whether the reference was made before or after the publication of the application), or
 - (c) any such application is refused under any other provision of this Ordinance, or is withdrawn before the Registrar has disposed of the reference (whether the application is refused or withdrawn before or after its publication);

the Registrar may order that any person by whom the reference was made may, within the prescribed period or, in the absence of regulations under this subsection, such period as the Registrar may think fit, make a new application for an innovation patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, provided that it does not extend the subject-matter disclosed in the earlier application, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.

(4) Where a person refers a question under subsection (1)(b) relating to an application, any order under subsection (1) may contain directions to any person for transferring or granting any right in or under the application.

(5) If any person to whom directions have been given under subsection (2)(d) or (4) fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the Registrar may, on application made to him by any person in whose favour or on whose reference the directions were given, authorise him to do that thing on behalf of the person to whom the directions were given.

(6) Where on a reference under this section it is alleged that, by virtue of any transaction, instrument or event relating to an innovation or an application for an innovation patent, any person other than the innovator or the applicant for the innovation patent has become entitled to be granted (whether alone or with any other persons) an innovation patent for the innovation or has or would have any right in or under any innovation patent so granted or any application for any such innovation patent, an order shall not be made under subsection (2)(a), (b) or (d) on the reference unless notice of the reference is given to the applicant and any such person, except any of them who is a party to the reference.

(7) If it appears to the Registrar on a reference of a question under this section that the question involves matters which would more properly be determined by the Royal Court, he may decline to deal with it and, without prejudice to the Royal Court's jurisdiction to determine any such question and make a declaration, the Royal Court shall have jurisdiction to do so.

(8) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

Grant and registration of innovation patents in Register.

14. (1) If on examination, and following publication, by the Registrar as provided for under this Ordinance, an application for an innovation patent is found to have satisfied the requirements of this Ordinance, and there are no other circumstances (having regard, for example, to section 1(2)) that, in the opinion of the Registrar, make it inappropriate for him to grant the application, he shall grant the application and register the innovation patent in the Innovation Patent Register.

(2) Where the Registrar decides -

- (a) to refuse an application, 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 21.

(3) After an application has been granted under this section the Registrar shall -

- (a) publish in the prescribed manner or, in the absence of regulations under this paragraph, such manner as the Registrar may think fit -
 - (i) the specification of the innovation patent,
 - (ii) the statement accompanying the application under section 10(3)(b), and
 - (iii) the names of the proprietor and, if different, the innovator,
- (b) issue a certificate of grant, and
- (c) advertise the grant by notice in the prescribed manner or, in the absence of regulations under this paragraph, such manner as the Registrar may think fit.

(4) The Registrar may, in any publication under subsection (3)(a), publish in addition to the matters specified in that subsection any other matters relating to the innovation patent which in the Registrar's opinion it is desirable to publish.

Certificate and date of registration.

15. (1) The Registrar shall, on registration of a person as the proprietor of an innovation patent in the Innovation Patent Register, 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 an innovation patent in the Innovation Patent Register has effect on and from the date of registration.

Dual protection.

16. Where an application for registration as the proprietor of a patent under the Registered Patents and Biotechnological Inventions (Bailiwick of Guernsey) Ordinance, 2009 ("**the 2009 Ordinance**") and an application for an innovation patent under this Ordinance have been filed by the same applicant in respect of the same invention or innovation -

- (a) the innovation patent, if granted first, shall be deemed void from, and upon, the grant of the application under the 2009 Ordinance, and
- (b) the innovation patent application shall, if pending on the date of the grant of the application under the 2009 Ordinance, be deemed abandoned as of that date.

Term of innovation patent.

17. (1) An application granted under section 14 -

(a) shall take effect on the date on which it is granted, and

(b) subject to –

(i) subsection (2),

(ii) modification under section 19 or 23(3), or

(iii) revocation under section 23,

shall remain in force until the end of the period of 8 years beginning with the date of filing the application for the innovation patent, provided that any appropriate renewal fee has been paid.

(2) The Department may by regulations made under this subsection amend the period mentioned in subsection (1).

General power to amend specification after grant.

18. (1) Subject to the following provisions of this section the Registrar may, on an application made by the person registered as proprietor of an innovation patent in the Innovation Patent Register, allow the specification of the innovation patent to be amended subject to such conditions, if any, as he thinks fit.

(2) No amendment shall be allowed under this section -

(a) where there are pending before the Royal Court or the Registrar proceedings in which the validity of the innovation patent may be put in issue,

(b) which results in the specification of the innovation patent disclosing matter extending beyond that disclosed in the application as first filed, or

- (c) which extends the protection conferred by the innovation patent beyond that originally granted under section 14.

(3) An amendment of a specification of an innovation patent under this section shall have effect and be deemed always to have had effect from the grant of the innovation patent.

(4) A person may give notice to the Registrar of his opposition to an application under this section by the person registered as proprietor of an innovation patent in the Innovation Patent Register, and if he does so the Registrar shall notify the proprietor and consider the opposition in deciding whether to grant the application.

Modification of registration.

19. (1) The Registrar may, on the application of –

- (a) the person registered as proprietor of an innovation patent in the Innovation Patent Register,
- (b) the innovator of the innovation to which an innovation patent relates, or
- (c) of his own motion,

modify the particulars of any registration for the purposes mentioned in subsection (2).

(2) The purposes are to record -

- (a) the restoration of a lapsed innovation patent,
- (b) any limitation which attaches to an innovation patent,
- (c) the identity of the innovator, or joint innovator, or
- (d) any other matter the Registrar thinks fit.

(3) The provisions of section 10 apply to an application under this section as they apply to an application for grant and registration under that section.

(4) Where the Registrar decides, other than on the application of the person registered as proprietor in the Innovation Patent Register, to modify a registration, the Registrar shall serve notice in writing of the decision on that person in accordance with the provisions of section 21.

Power to correct clerical errors.

20. (1) The Registrar may correct any error -

(a) in the Innovation Patent Register, or

(b) in an application for -

(i) grant and registration under section 10,

(ii) amendment of specification under section 18,

(iii) modification under section 19, or

(iv) revocation under section 23(3).

(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.

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

21. Notice of a decision of the Registrar -

- (a) to refuse an application for the grant of an innovation patent,
- (b) to require an applicant to do any thing under section 11(2) or (3),
- (c) to refuse an application for registration in the Innovation Patent Register,
- (d) other than with the consent of the applicant, to include an entry in a registration of a limitation, or
- (e) other than on the application of the person registered as proprietor in the Innovation Patent Register -
 - (i) to modify, amend or revoke a registration, or
 - (ii) to enter any right, title or interest in the Innovation Patent Register under section 32,

shall state the grounds of the Registrar's decision and give particulars of the right of appeal conferred by section 64.

Innovation patent not to be impugned for lack of unity.

22. No person may in any proceeding object to an innovation patent or to an amendment of a specification of an innovation patent on the ground that the claims contained in the specification of the innovation patent, as they stand or, as the case may be, as proposed to be amended, relate -

- (a) to more than one innovation, or

- (b) to a group of innovations which are not so linked as to form a single innovative concept.

Revocation of innovation patents.

23. (1) The Registrar shall revoke an innovation patent -

- (a) if the person registered as the proprietor in the Innovation Patent Register applies to the Registrar for revocation (and the provisions of section 10 apply as appropriate 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 innovation patent upon application under subsection (2),
 - (c) if the appropriate renewal fee has not been paid within -
 - (i) the prescribed period, or
 - (ii) in the absence of regulations under subparagraph (i), such period as the Registrar may think fit, or
 - (d) if the Registrar determines that the grant of the innovation patent was obtained -
 - (i) fraudulently,
 - (ii) on a misrepresentation, or
 - (iii) on any non-disclosure, or inaccurate disclosure, of any prescribed material information, whether or not the person under a duty to provide the information knew or ought reasonably to have known of such information or the inaccuracy.
- (2) Any person may apply to the Royal Court for an order

requiring the Registrar to revoke an innovation patent, on the ground that -

- (a) the innovation to which the innovation patent relates does not meet the criteria for an innovation patent under section 1, 2, 3 or 4,
- (b) the commercial exploitation of the innovation to which the innovation patent relates, would be contrary to public policy or morality as provided under sections 1(2) and (3),
- (c) the innovation patent was granted to a person who was not entitled to be granted that innovation patent,
- (d) the innovation patent does not disclose the innovation in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art,
- (e) the subject-matter of the innovation patent extends beyond the content of the innovation patent application as filed,
- (f) the protection conferred by the innovation patent has been extended by an amendment which should not have been allowed, or
- (g) within a period of 3 years following grant, the registered innovation has not been put to genuine industrial or commercial use in the Bailiwick, or any part of the Bailiwick, by the proprietor or with his consent or, if used since grant, that such use has been suspended for an uninterrupted period of 3 years, and, in either case, there are no proper reasons for non-use.

(3) If the grounds for revocation affect the innovation patent only partially, an amendment may be allowed, in the discretion of the Registrar, to the relevant specification.

Registrar's power to seek revised statement.

24. In dealing with any issue relating to an innovation patent (including without limitation, the grant of an innovation patent), the Registrar shall have the power, at the applicant's expense and upon prior notice being given to him in the manner prescribed or, in the absence of regulations under this section, such manner as the Registrar may think fit -

- (a) to refer any statement made under section 10(3)(b) and such other material as may be relevant, to -
 - (i) the person who made the statement, or
 - (ii) such other suitably qualified person, or organisation, as the Registrar thinks fit,
- (b) to request the person who made the statement to provide a further or revised statement made in accordance with section 10(3)(b), and
- (c) to act upon any statement provided pursuant to any such request, as the Registrar thinks fit.

Power to require use of forms.

25. (1) The Registrar may require the use of such forms as he may direct for any purpose relating to the registration of an innovation patent or any other proceedings before him under this Ordinance.

(2) The forms, and any directions of the Registrar as to their use, shall be published in such manner as he thinks fit or as may be prescribed.

Costs and security for costs.

26. Provision may be made by regulations of the Department empowering the Registrar, in such cases as may be prescribed, to require a party to proceedings before him to pay his reasonable costs or to give security for costs in relation to proceedings before the Registrar under this Ordinance or proceedings on appeal, and as to the consequences if the costs are not paid or security is not given.

Evidence before Registrar.

27. Provision may be made by regulations of the Department -

- (a) as to the giving of evidence in proceedings before the Registrar under this Ordinance by affidavit,
- (b) conferring on the Registrar for the purposes of such proceedings all such powers as may be reasonably necessary including as regards the administration of the oath, the examination of witnesses on oath, the discovery and production of documents and the summoning and attendance of witnesses.

Exclusion of liability in respect of official acts.

28. (1) The Registrar shall not be taken to warrant the validity of the registration of an innovation patent under this Ordinance or under any treaty, convention, arrangement or engagement extending to the Bailiwick.

(2) The Registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Ordinance, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.

(3) No proceedings lie against an officer of the Registrar in respect of any matter for which, by virtue of this section, the Registrar is not liable.

(4) The provisions of this section are in addition to and not in derogation from the provisions of the Intellectual Property (Office of Registrar) (Bailiwick of Guernsey) Ordinance, 2005 excluding the liability of the States, the Registrar and other persons in respect of anything done or omitted to be done in the discharge or purported discharge of their respective functions.

PART III

RIGHTS AND NATURE OF RIGHTS OF PROPRIETORS OF INNOVATION
PATENTS

Rights given by registration as proprietor of innovation patent.

29. (1) The registration of a person as the proprietor of an innovation patent in the Innovation Patent Register confers on that person the following exclusive rights -

- (a) in respect of an innovation patent where the subject matter is a product, to prevent third parties who do not have his consent from the acts of making, disposing of, offering to dispose of, using or importing the product or keeping it whether for disposal or otherwise in the Bailiwick,
- (b) in respect of an innovation patent where the subject matter is a process, to prevent third parties who do not have his consent, from the act of using the process or offering it for use in the Bailiwick 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 his exclusive rights under the innovation patent,
- (c) in respect of an innovation patent where the subject matter is a process, to prevent third parties who do not have his consent from 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 in the Bailiwick, and
- (d) in respect of a innovation patent 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) The rights under subsection (1) include the right to use the term "**Guernsey Innovation Patent**" or Symbol "**(GIP)**" on, or in relation to, the innovation to which the innovation patent relates.

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

1.

Co-ownership.

30. (1) Where two or more persons are registered as proprietors of an innovation patent in the Innovation Patent Register, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the rights conferred under section 29.

(2) Where two or more persons are registered as proprietors of an innovation patent in the Innovation Patent Register, 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 innovation 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 VIII, amount to an infringement of the rights conferred under section 29, and

(b) any such act shall not amount to an infringement of the rights conferred under section 29.

(3) Subject to any agreement for the time being in force, where two or more persons are registered as proprietors of an innovation patent in the Innovation Patent Register 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 innovation patent, or assign a share in the innovation patent.

(4) Where two or more persons are registered as proprietors of an innovation patent in the Innovation Patent Register, anyone else may supply one of those persons with the means, relating to an essential element of the innovation, for putting the innovation into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the rights conferred under section 29.

(5) Where an innovation which is a product is disposed of by any of two or more persons, who are registered as proprietors of the innovation patent relating to the innovation concerned, to any person, that person and any other person claiming through him shall be entitled to deal with the innovation 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.

Nature of rights.

31. (1) The rights conferred under section 29 upon the person registered in the Innovation Patent Register as proprietor of the innovation patent -

- (a) are personal or movable property, which may be transferred by assignment, testamentary disposition or operation of law as personal or movable property, and
- (b) subsist 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 Innovation Patent Register, the person or persons registered as proprietor of an innovation patent in the Innovation Patent Register may -

- (a) assign, grant licences under or otherwise deal with the rights conferred under section 29, and
- (b) give effectual receipts for any consideration for any such assignment, licence or dealing.

Registration of assignments, etc.

32. (1) Where a person becomes entitled -

- (a) to an innovation patent registered in the Innovation Patent Register or to a share in such an innovation patent by assignment, transmission or operation of law, or

- (b) to any other interest in such an innovation patent, as licensee or otherwise,

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

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

(2) The provisions of section 10 apply 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 an innovation patent, or a share or other interest in an innovation 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 innovation patent, or a share therein by assignment, transmission or operation of law -
 - (i) register him in the Innovation Patent Register as proprietor or co-proprietor of the innovation 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 amend, rectify or modify the Innovation Patent Register under section 18, 19 or 23, a document in respect of which no entry is made in the Innovation Patent Register under subsection (4) shall not be admitted in any court as evidence of the title of any person to an innovation patent, or to any share or other interest in such an innovation 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 Innovation Patent Register, to enter any right, title or interest in the Innovation Patent Register under this section, the Registrar shall serve notice in writing of the decision on that person in accordance with the provisions of section 21.

Effect of registration etc. on rights in innovation patent.

33. (1) Any person who claims to have acquired the property in an innovation 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 an innovation 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 an innovation patent,
- (b) the grant, or assignment, of a licence or sub-licence under an innovation patent,
- (c) the death of the proprietor, or one of the proprietors of any such innovation patent, or any person having a right in or under an innovation patent, and the vesting by an assent of personal representatives of a innovation patent or any such right,
- (d) any order or directions of a court, or other competent authority, transferring an innovation 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.

PART IV

ANTI-COMPETITIVE PROVISIONS IN CONTRACTS AND LICENCES

Avoidance of certain restrictive conditions.

34. (1) Subject to this section, any condition or term of a contract for the supply of an innovation patent product or of a licence to work an innovation patent, or of a contract relating to any such supply or licence, shall be void in so far as it purports –

- (a) in the case of a contract for supply, to require the person supplied to acquire from the supplier, or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the

supplier or his nominee, anything other than the innovation patent product,

- (b) in the case of a licence to work an innovation patent, to require the licensee to acquire from the licensor or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the licensor or his nominee, anything other than the product which is the registered innovation or (if it is a process) other than any product obtained directly by means of the process or to which the process has been applied,
- (c) in either case, to prohibit the person supplied or licensee from using articles (whether innovation patent products or not) which are not supplied by any innovation patent process which does not belong to, the supplier or licensor, or his nominee, or to restrict the right of the person supplied or licensee to use any such articles or process.

(2) Subsection (1) does not apply to contracts made or licences granted before the commencement of this Ordinance.

(3) In proceedings against any person for infringement of an innovation patent it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the innovation patent made by or with the consent of the plaintiff or a licence under the innovation patent granted by him or with his consent and containing in either case a condition or term void by virtue of this section.

(4) A condition or term of a contract or licence shall not be void by virtue of this section if –

- (a) at the time of the making of the contract or granting of the licence the supplier or licensor was willing to supply the innovation patent product, or grant a licence to work the innovation patent, as the case may be, to the person supplied or licensee, on reasonable terms

specified in the contract or licence and without any such condition or term as is mentioned in subsection (1), and

- (b) the person supplied or licensee is entitled under the contract or licence to relieve himself of his liability to observe the condition or term on giving to the other party 3 months' notice in writing and subject to payment to that other party of such compensation (being, in the case of a contract to supply, a lump sum or rent for the residue of the term of the contract and, in the case of a licence, a royalty for the residue of the term of the licence) as may in default of agreement between the parties be determined by -
 - (i) an arbitrator appointed by agreement between the parties, or
 - (ii) in default of such agreement, the Royal Court.

(5) If in any proceeding it is alleged that any condition or term of a contract or licence is void by virtue of this section it shall lie on the supplier or licensor to prove the matters set out in subsection (4)(a).

(6) A condition or term of a contract or licence shall not be void by virtue of this section by reason only -

- (a) that it prohibits any person from selling goods other than those supplied by a specified person, or
- (b) in the case of a contract for the hiring of or licence to use an innovation patent product, that it reserves to the bailor or licensor, or his nominee, the right to supply such new parts of the innovation patent product as may be required to put or keep it in repair.

Determination of parts of certain contracts.

35. (1) This section applies to -

- (a) any contract for the supply of an innovation patent product,
- (b) any licence to work an innovation patent, or
- (c) any contract relating to any such supply or licence, where the innovation patent or all the innovation patents by which the product or innovation was protected at the time of the making of the contract or granting of the licence has or have ceased to be in force.

(2) Notwithstanding anything to the contrary in the contract or licence or in any other contract, a contract or licence to which this section applies may to the extent (and only to the extent) that the contract or licence relates to the innovation patent product or innovation, be determined by either party on giving 3 months' notice in writing to the other party.

(3) In subsection (1) "**innovation patent product**" and "**innovation patent innovation**" include respectively a product and an innovation which is the subject of an application for an innovation patent, and that subsection shall apply in relation to an innovation patent by which any such product or innovation was protected and which was granted after the time of the making of the contract or granting of the licence in question, on an application for an innovation patent which had been filed before that time, as it applies to an innovation patent in force at that time.

(4) If, on an application under this subsection made by either party to a contract or licence falling within subsection (1), a court is satisfied that, in consequence of the innovation patent or innovation patents concerned ceasing to be in force, it would be unjust to require the applicant to continue to comply with all terms and conditions of the contract or licence, it may make such order varying those terms or conditions as, having regard to all the circumstances of the case, it thinks just as between the parties.

(5) The foregoing provisions of this section apply to contracts and licences whether made before or after the commencement of this section.

(6) The provisions of this section shall be without prejudice to any rule of law relating to the frustration of contracts and any right of determining a contract or licence exercisable apart from this section.

PART V
LICENCES OF RIGHT AND COMPULSORY LICENCES

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

36. (1) The person registered as proprietor of an innovation patent may, at any time, apply to the Registrar for an entry to be made in the Innovation Patent Register to the effect that licences under the innovation 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 innovation patent and applying under subsection (1)) registered as having a right in or under the innovation patent and, if satisfied that the person registered as proprietor of the innovation patent and applying under subsection (1) is not precluded by contract from granting licences under the innovation patent, shall make the appropriate entry in the Innovation Patent Register.

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

- (a) any person shall, at any time after the entry is made, be entitled as of right to a licence under the innovation 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 innovation patent or the person requiring the licence,
- (b) the Registrar may, on the application of the holder of any licence granted under the innovation 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 innovation 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 innovation 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 innovation patent to take proceedings to prevent any infringement of the innovation 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 an innovation 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 36.

37. (1) At any time after an entry has been made under section 36 in respect of an innovation 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 innovation patent or that all licensees under the innovation patent consent to the application, make the appropriate cancellation in the Innovation Patent Register.

(3) Within the prescribed period after an entry has been made under section 36 in respect of an innovation 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 innovation 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 innovation patent is and was so precluded, he shall make the appropriate cancellation in the Innovation Patent Register; 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 innovation 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 innovation 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), any person, and
 - (b) in the case of an application under subsection (3), the person registered as proprietor of the innovation patent,

may within the prescribed period 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.

38. (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 innovation patent,
- (b) for an entry to be made in the Innovation Patent Register to the effect that licences under the innovation 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 innovation patent.

(2) Subject to section 39, 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 an innovation patent even though the applicant is already the holder of a licence under the innovation 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 innovation patent is for 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 innovation patent concerned to grant a licence or licences on reasonable terms -
 - (i) the exploitation in the Bailiwick of any other innovation, or invention, which
 - (A) has been registered under this Ordinance, or the Registered Patents and Biotechnological Inventions (Bailiwick of Guernsey) Ordinance, 2009, and
 - (B) involves an important technical advance of considerable economic significance in relation to, the innovation for which the innovation patent concerned was granted or, the invention,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 innovation patent concerned on the grant of licences under the innovation patent, or on the disposal or use of the product or use

of the process subject to the innovation patent, the manufacture, use or disposal of materials not protected by the innovation patent, or the establishment or development of commercial or industrial activities in the Bailiwick, is unfairly prejudiced.

Provisions concerning orders under section 38.

39. (1) No order shall be made under section 38 in respect of an innovation patent unless -

- (a) the applicant has made reasonable efforts to obtain a licence from the person registered as proprietor of the innovation 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 38 if the innovation patent is in the field of semi-conductor technology.

(3) No order shall be made under section 38 in respect of an innovation patent on the ground mentioned in section 38(4)(b)(i) unless the Royal Court is satisfied that the person registered as proprietor of the innovation patent for the other innovation is able and willing to grant the person registered as proprietor of the innovation patent concerned and his licensees a licence under the innovation patent for the other innovation on reasonable terms.

(4) A licence granted -

- (a) in pursuance of an order made under section 38, 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 innovation patent for the other innovation is also assigned.

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

38 -

- (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 innovation patent, 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 innovation 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 38.

40. (1) Where the Royal Court is satisfied, on an application made under section 38 in respect of an innovation patent, that the manufacture, use or disposal of materials not protected by the innovation patent is unfairly prejudiced by reason of conditions imposed by the person registered as proprietor of the innovation patent -

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

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

(2) Where an application under section 38 is made in respect of an innovation patent by a person who holds a licence under the innovation 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 36(5) and (6) shall apply to a licence granted in pursuance of an order under section 38 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 36.

Exercise of powers on applications under section 38.

41. (1) The powers of the Royal Court on an application under section 38 shall be exercised with a view to securing the following general purposes -

- (a) that innovations 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 innovator or other person beneficially entitled to an innovation patent shall receive reasonable remuneration having regard to the nature of the innovation,
- (c) that the interests of any person for the time being working or developing an innovation in the Bailiwick under the protection of an innovation 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 38, take account of the following matters -

- (a) the nature of the innovation, the time which has elapsed since first registration and the measures

already taken by the person registered as proprietor of the innovation patent or any licensee to make full use of the innovation,

- (b) the ability of any person to whom a licence would be granted under the order concerned to work the innovation to the public advantage, and
- (c) the risks to be undertaken by that person in providing capital and working the innovation 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.

42. (1) The person registered in the Innovation Patent Register as the proprietor of the innovation patent concerned or any other person wishing to oppose an application under sections 38 to 41 may, in accordance with rules of court, give to the Royal Court notice of opposition; and the Royal Court shall consider any such opposition in deciding whether to grant the application.

(2) Where an order or entry has been made under section 38 -

- (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.

43. (1) The Royal Court may order that any entry is made in the Innovation Patent Register under section 38 to 41 notwithstanding any contract which would have precluded the entry on the application of the person registered as proprietor of the innovation patent under section 36.

(2) An entry made in the Innovation Patent Register under sections 38 to 41 shall for all purposes have the same effect as an entry made under section 36.

(3) No order shall be made in pursuance of an application under sections 38 to 41 which would be at variance with the provisions of any international instrument which have been applied or extended to, or in respect of, Guernsey.

Special provisions where innovation is being worked abroad.

44 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 an innovation patent in pursuance of an application under sections 38 to 41 if -

- (a) the innovation concerned is being commercially worked in any country specified in the regulations, and
- (b) demand in the Bailiwick for any innovation to which the innovation product relates resulting from that working is being met by importation from that

country.

Special provisions concerning compulsory licences and plant breeders' rights.

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

- (a) the applicant cannot acquire or exploit plant breeders' rights without infringing an innovation patent,
- (b) the applicant has applied unsuccessfully to the proprietor of the innovation patent concerned for a licence to use that innovation patent to acquire or exploit plant breeders' rights, and
- (c) the new plant variety, in respect of which the applicant wishes to acquire or exploit the plant breeders' rights, constitutes significant technical progress of considerable economic interest in relation to the innovation to which the innovation patent relates.

(2) Subject to the provisions of Schedule 2 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 innovation to which the innovation patent relates, in so far as the licence is necessary for the exploitation of the new variety, on the conditions set out in **Schedule 2** 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 V
INFRINGEMENT

Infringement of right conferred under section 29.

46. (1) Subject to the provisions of this section, a right conferred under section **29** upon the person registered as proprietor of the innovation patent concerned is infringed by a person who, without the consent of that proprietor -

- (a) does anything which by virtue of Part III 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 innovation with any of the means, relating to an essential element of the innovation, for putting the innovation 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 innovation 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) A right conferred under section 29 upon the person registered as proprietor of the innovation patent concerned is not infringed if, within the period of one year immediately prior to the alleged infringement, the registered innovation had not been put to genuine industrial or commercial use in the Bailiwick by the proprietor or with his consent and there were no proper reasons for non-use.

(4) A right conferred under section 29 upon the person registered as proprietor of the innovation 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 innovation,
- (c) is done solely for uses reasonably related to the development and submission of information under a law applicable in the Bailiwick, or elsewhere, 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 (6)) 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 innovation patent or with his consent for agricultural use,

- (j) (subject to subsection (7)) 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 innovation patent or with his consent, of breeding stock or other animal reproductive material which constitutes or contains the innovation to which the innovation patent relates.

(5) For the purposes of subsection (1)(b) a person who does an act in relation to an innovation which is prevented only by virtue of subsection (4) (a), (b), (c) or (d) from constituting an infringement of a right conferred under section 29 shall not be treated as a person entitled to work the innovation, but -

- (a) the reference in that subsection to a person entitled to work an innovation includes a reference to a person so entitled by virtue of section 58 (Crown or States use) and
- (b) a person who by virtue of section 50 (Right to continue use begun before first registration) is entitled to do an act in relation to the innovation without it constituting such an infringement shall, so far as concerns that act, be treated as a person entitled to work the innovation.

(6) Regulations may prescribe -

- (a) provisions restricting the circumstances in which subsection (4)(i) applies, and
- (b) provisions which apply where an act would constitute an infringement of the rights to use an innovation to which the innovation patent relates but for subsection

(4)(i).

(7) For the purposes of subsection (4)(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.

(8) In subsection (4)(i) and (j) "**sale**" includes any other form of commercialisation.

(9) 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 ^c,

"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 37 of the Aviation (Bailiwick of Guernsey) Law, 2008^d (Exemption of aircraft and parts thereof from seizure on patent claims) applies.

Proceedings for infringement of right conferred under section 29.

47. (1) Subject to the following provisions of this Part, civil proceedings may be brought by the person registered as proprietor of an innovation

^c Official Journal L 311. 28.11.2001, p. 67.

^d Registered on the Records of the Island of Guernsey on 1st December 2008.

patent in respect of any act alleged to infringe a right conferred under section 29 in respect of the innovation 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 product to which the innovation patent relates in relation to which any 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 innovation patent is valid, and
 - (ii) any right to use the innovation the subject of the innovation patent 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 an innovation 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.

48. (1) In proceedings for infringement of a right conferred under section 29 -

- (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 innovation patent existed.

(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 innovation patent existed, by reason only of the application to a product of -

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

unless the registered number of the innovation patent accompanied the word, words or symbol in question.

Assessment of damages.

49. (1) In proceedings for infringement of a right conferred under section 29, where a defendant -

- (a) knew, or
- (b) had reasonable grounds to know,

that at the date of the infringement it involved an innovation to which the innovation patent related, 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.

50. (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 a right conferred under section 29, 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 a right 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 innovation patent.

Proceedings for infringement where there are co-proprietors.

51. (1) In the application of section 46 (Infringement of right under section 29) to an innovation 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 30 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 30 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 an innovation patent may without the concurrence of the other or others bring proceedings in respect of an act alleged to infringe a right conferred under section 29, but shall not do so unless the other or others is or are made parties to the proceedings; but the other or 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.

52. (1) Subject to the provisions of this section, the holder of an exclusive licence to exercise a right conferred under section 29 shall have the same right as the registered proprietor of the innovation patent concerned to bring proceedings in respect of any infringement of the right conferred under section 29,

committed after the date of the licence; and references to the registered proprietor of the innovation 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 right 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 innovation patent in the Innovation Patent Register 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.

53. Where by virtue of a transaction, instrument or event to which section 33 (Effect of registration etc. on rights in innovation patents) applies a person becomes the proprietor, or one of the proprietors, or an exclusive licensee of an innovation patent and a right conferred under section 29 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.

54. (1) Where a person (whether or not the registered proprietor of, or entitled to any other right in, an innovation patent) by circulars, advertisements or otherwise threatens another person with proceedings for any infringement of a right conferred under section 29, 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 a right conferred under section 29 -

(a) the plaintiff shall be entitled to the relief claimed only if he shows that the right 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 a right conferred under section 29 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 29, it shall be a defence for A to prove that he used his best endeavours, without success, to discover -

- (a) where the innovation 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 innovation 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 innovation is a process and the alleged infringement is an act falling within section 29(3)(c), 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.

55. 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 an innovation 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 innovation 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 VII
RIGHT TO EMPLOYEE'S INNOVATIONS

Right to employee's innovations.

56. (1) Notwithstanding anything in any rule of law, an innovation 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 innovation might reasonably be expected to result from the carrying out of his duties, or
- (b) the innovation was made in the course of the duties of the employee and, at the time of making the innovation, 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 innovation 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 innovation 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 an innovation patent, or

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

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 innovation.

Supplementary provisions.

57. (1) This Part shall not apply to an innovation made by an employee unless at the same time as he made the innovation 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 innovation 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 innovation by another employee.

(3) Any reference in section 56 to an innovation patent is a reference to an innovation patent or other similar protection 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 innovation.

(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 VIII
USE OF INNOVATION PATENTS FOR THE SERVICES OF THE CROWN OR
THE STATES

Crown or States use etc. of innovation to which innovation patents relate.

58. (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 an innovation patent in the Innovation Patent Register and without infringing the rights conferred under section 29, or any other right under this Ordinance, do any relevant act in the Bailiwick concerning an innovation to which the innovation patent relates for the services of the Crown or the States.

- (2) In this Part -
- (a) "**any relevant act**" means -
 - (i) where the innovation 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 innovation 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 innovation or any product obtained directly by means of the innovation 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 innovation, for putting the innovation 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 innovation by virtue of this section is, in this Part referred to as "**use of the innovation**"; and "**use**" in relation to an innovation, 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 innovation, 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 innovation patent concerned to do anything in relation to the innovation.

(5) Where any use of an innovation 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 innovation 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 innovation 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.

59. (1) Any reference in section 58 to an innovation to which an innovation patent relates, in relation to any time, is a reference to an innovation in respect of which first registration has occurred, or subsequently, occurs.

(2) In this Ordinance, unless the 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 58(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 58(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.

60. (1) In relation to -

- (a) any use made for the services of the Crown or the States of an innovation 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 58, 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 an innovation patent in the Innovation Patent Register,

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 innovation, 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 innovation patent concerned in the Innovation Patent Register, 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^e.

(6) In this section "**semi-conductor product**" has the meaning given by section 1 of the Unregistered Design Rights (Semiconductor Topographies) (Bailiwick of Guernsey) Ordinance, 2006.

Compensation for loss of profit.

^e Ordinance No. XIX of 2005.

61. (1) Where use is made of an innovation 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 innovation patent in the Innovation Patent Register, or
- (b) where there is an exclusive licence in force in respect of the innovation patent, to the exclusive licensee,

compensation for any loss resulting from his not being awarded a contract to supply the product to which the innovation patent relates or, as the case may be, to perform the process to which the innovation patent relates or supply a thing made by means of the said 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 Innovation Patent Register 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 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 product to which the innovation patent relates or, as the case may be, to perform the process to which the innovation patent relates or supply a thing made by means of the said 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 62.

(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 innovation 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.

62. (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 58,
 - (b) terms for the use of an innovation for the services of the Crown or the States under section 58, or
 - (c) the right of any person to receive a payment under section 61,

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 innovation, 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 innovation 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 innovation 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 innovation 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 an innovation patent in the Innovation Patent Register 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.

63. (1) During a period of emergency the powers exercisable in relation to an innovation by virtue of section 58 include power to use the innovation 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^f declaring a state of emergency to exist remains in force.

PART IX APPEALS AND RECTIFICATION

^f 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 of appeal to Royal Court from decisions of Registrar.

64. (1) An appeal to the Royal Court lies from any decision of the Registrar under this Ordinance, except as otherwise expressly provided by regulations of the Department.

For this purpose "**decision**" includes any act of the Registrar in exercise of a discretion vested in him by or under this Ordinance.

(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 rule 52(3) of the Royal Court Civil Rules,

2007^g.

- (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^h ("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.

65. (1) The Royal Court may, subject to subsection (3), on the application of any person aggrieved, order the Registrar to rectify the Innovation Patent Register by making, revoking or modifying any entry made therein in accordance with any provision of section 14, 19, 23, or 32.

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

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

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

with the rectification of the Innovation Patent Register.

(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 Innovation Patent Register accordingly.

(5) A rectification of the Innovation Patent Register 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.

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

66. (1) A person aggrieved by a decision of the Royal Court concerning an application under Part V (Licences of right and compulsory licences) 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.

Registration to be prima facie evidence of validity.

67. In all legal proceedings relating to an innovation patent (including proceedings for rectification of the Register) the registration of a person as proprietor of an innovation patent is prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

Certificate of validity of contested registration.

68. (1) If in proceedings before a court in the Bailiwick the validity of the registration of an innovation patent is contested and it is found by the court that the innovation patent is validly registered, the court may give a certificate to that effect.

(2) If the court gives such a certificate and in subsequent proceedings before a court in the Bailiwick -

- (a) the validity of the registration is again questioned, and
- (b) the proprietor obtains a final order or judgment in his favour,

he is entitled to his costs on an indemnity basis unless the court directs otherwise.

This subsection does not extend to the costs of an appeal in any such proceedings.

Registrar's appearance in proceedings involving the Register.

69. (1) In proceedings before the Royal Court involving an application for -

- (a) the revocation of the registration of an innovation patent, or
- (b) the rectification of the Register,

the Registrar is entitled to appear and to be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Royal Court, the Registrar

may instead of appearing submit to the Court a statement in writing signed by him, giving particulars of -

- (a) any proceedings before him in relation to the matter in issue,
- (b) the grounds of any decision given by him affecting it,
- (c) the practice of the office of Registrar in like cases, and
- (d) such matters relevant to the issues and within his knowledge as Registrar as he thinks fit,

and the statement shall be deemed to form part of the evidence in the proceedings.

(3) Anything which the Registrar is or may be authorised or required to do under this section may be done on his behalf by a duly authorised officer.

Power to release Registrar from proceedings.

70. (1) If the Registrar is a party to any proceedings before the Royal Court in which there is in issue any question which falls to be determined as between -

- (a) the proprietor of a registered innovation patent or an applicant for the registration of an innovation patent, and
- (b) any other person (for example, the proprietor of an earlier innovation patent or earlier right),

the Registrar may apply to the Court to be released from the proceedings so far as they relate to the determination of that question.

(2) On an application under this section by the Registrar the Royal Court may -

- (a) subject to such terms and conditions and to such extent as it thinks fit, order that he be released, and

- (b) make such order as to the costs of the determination of the application and of the question in issue as it thinks fit in consequence of his release (including, without limitation, an order that he shall be awarded his costs and shall not be liable for the costs of any other party).

(3) The reference in subsection (1) to proceedings before the Royal Court includes, without limitation -

- (a) proceedings on an application under section 23 for revocation of the registration of an innovation patent,
- (b) proceedings on an application under section 65 for the rectification of the Register, and
- (c) proceedings on an appeal under section 66.

(4) The powers conferred on the Royal Court by this section are without prejudice to its powers otherwise arising.

PART XI OFFENCES

Falsification of Register, etc.

71. (1) If a person makes, or causes or permits to be made, a false entry in the Innovation Patent Register, 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 Innovation Patent Register, 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 innovation patent rights.

72. (1) If a person falsely represents that anything disposed of by him for value is a product to which an innovation patent product relates 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 words "**innovation patent**" or "**innovation patented**" or the symbol "**(GIP)**" or anything expressing or implying that the article is a product to which an innovation patent relates, shall be taken to represent that the article is a product to which an innovation patent relates.

(3) Subsection (1) does not apply where the representation is made in respect of a product after the registration of the innovation 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 innovation patent has been applied for.

73. (1) If a person represents that an application for registration of an innovation 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 "**innovation patent applied for**", "**registration applied for**" or "**innovation patent pending**", or anything expressing or implying that an application for registration of an innovation 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.

74. (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.

75. (1) If the innovation to which an innovation 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 innovation 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 innovation.

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

(2) The Protocol (which is set out in Schedule 3) on the Interpretation of Article 69 of the European Patent Convention (which Article contains a provision corresponding, in the case of a patent, 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.

Recognition of attorneys.

77. (1) Any act required or authorised by this Ordinance to be done by or in relation to a person in connection with the grant of an innovation patent, registration of a person as the proprietor of an innovation patent in the Innovation Patent Register or any other procedure relating to an innovation 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 a registered patent attorney with an address for service in the Bailiwick and authorised by that person orally or in writing.

(2) In the absence of regulations under subsection (1), the Registrar may make such provision as he thinks fit corresponding to that which could be made by such regulations.

Interpretation.

78. (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,

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

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

"Biotechnological innovation" means an innovation 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 Innovation Patent Register, 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 Innovation Patent Register which is not in documentary form, means a copy or extract in a visible and legible form in which it can be taken away,

"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

^j Ordres en Conseil Vol. XXIV, p. 87, Vol. XXVII, p. 242; Vol. XXIX, pp. 127 and 419 and cf. No. I of 1996; Ordinances No. XIX of 1994; No. XVII of 1998; No. XLVII of 2001 and No. XVIII of 2003.

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

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, 1987¹,

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

"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,

"exclusive licence" means a licence in writing signed by or on behalf of the person registered in the Innovation Patent Register as proprietor of an innovation 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 innovation to which the innovation patent relates, and "exclusive licensee" and "non-exclusive licence" shall be construed accordingly,

"first registration" means the first registration in the Innovation Patent Register of a person as the proprietor of an innovation patent in accordance with the grant of an application under section 10,

"formal requirements": see section 11(1),

"Government department of the United Kingdom" includes any Northern Ireland department, any part of the Scottish Administration and any

¹ Recueil d'Ordonnances Tome XXIV, pp. 79, 238 and 262.

committee of the National Assembly for Wales,

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

"innovation" means an innovation which satisfies the criteria described in sections 1 to 4,

"innovation patent" means an innovation patent granted under section 14(1), which –

- (a) is in force under section 17, and
- (b) has not been revoked under section 23,

"innovation patent product" means -

- (a) a product which is an innovation for which an innovation patent has been granted, or
- (b) in relation to a innovation patent process, a product obtained directly by means of the process or to which the process has been applied,

"innovation patent process" means a process for which an innovation patent has been granted,

"Innovation Patent Register" means the Register established under section 6 in which persons are registered as the proprietors of innovation patents,

"innovator": see section 8(2),

"international instrument" includes any international convention or agreement,

"joint innovator": see section 8(2),

"laws" include rules, practice and procedures,

"**limitation**", in relation to the registration of an innovation patent, means any limitation, restriction, term or condition subject to which the innovation patent is registered in the Innovation Patent Register 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 innovation patents, or innovation patent applications,

"**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,

"**priority date**" means the date determined as such under section 5,

"**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 attorney**" means a person whose name is entered in the register of patent attorneys kept in accordance with section 16 of the Registered Patents and Biotechnological Inventions (Bailiwick of Guernsey) Ordinance, 2009,

^m Ordinance No. IV of 2007.

ⁿ Ordinance No. XXIX of 2005.

"registered trade mark" means a trade mark entered in the Register of Trade Marks established under section 61 of the Trade Marks (Bailiwick of Guernsey) Ordinance, 2006⁰,

"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 79 for the constitution of the Royal Court for the purposes of this Ordinance),

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

"semi-conductor product": see section 60(6),

"services of the Crown or the States" and **"use for the services of the Crown or the States"** : see section 59(2) and (as respects any period of emergency within the meaning of section 63) see section 63,

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

"the States" (other than for the purposes of Part VIII, in relation to which see section 58(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,

"the 1922 Law" means the Loi ayant rapport aux Patentés, Dessins et Marques de Fabrique, 1922,

⁰ Ordinance No. I of 2006.

"**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^p,

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

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

and other words or expressions which are defined in the Intellectual Property (Enabling Provisions) (Bailiwick of Guernsey) Law, 2004^q 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 innovation being "**worked**" in the Bailiwick include references to the innovation being worked by the importation into the Bailiwick for the purpose of putting the innovation patented product on the market or stocking it for that purpose.

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

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

^q Order in Council No. XIV of 2004.

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

(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.

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

- (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 power of Department to make regulations.

80. (1) The Department may make regulations -

- (a) for the purposes of any provision of this Ordinance authorising the making of regulations with respect to any matter, and
- (b) for prescribing anything authorised or required by any provision of this Ordinance to be prescribed,

and generally for regulating practice and procedure under this Ordinance.

(2) Provision may, in particular, be made -

- (a) as to the manner of filing of applications and other documents,
- (b) requiring and regulating the translation of documents and the filing and authentication of any translation,
- (c) as to the service of documents,

- (d) authorising the rectification of irregularities of procedure,
- (e) prescribing time limits for anything required to be done in connection with any proceeding under this Ordinance,
- (f) providing for the extension of any time limit so prescribed, or specified by the Registrar, whether or not it has already expired.

However, if regulations are not so made, the Registrar may adopt such practice and procedure as he thinks fit as to the matters in respect of which regulations may be made.

General provisions as to subordinate legislation.

81. (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) 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 regulations be annulled, the regulations shall cease to have effect but without prejudice to anything done under them or to the making of new regulations.

Saving for forfeited goods.

82. 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.

Guernsey ships.

83. (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 (Bailiwick of Guernsey) Law, 2002^s.

Citation.

84. This Ordinance may be cited as the Innovation Patents (Bailiwick of Guernsey) Ordinance, 2014.

Extent.

85. This Ordinance has effect throughout the Bailiwick.

^s Order in Council No. VIII of 2004.

Commencement.

86. 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.

SCHEDULE 1

PART I

PRINCIPLES CONCERNING BIOTECHNOLOGICAL INNOVATIONS

1. An application for registration of an innovation patent under this Ordinance shall not be refused solely on the ground that the innovation to which the innovation 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 innovation even if it previously occurred in nature.

3. The following are not appropriate innovations for innovation patent protection -

- (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 an innovation registrable as an innovation patent, 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 grant of an innovation patent as filed.

PART II

PROTECTION CONFERRED BY INNOVATION PATENTS CONCERNING BIOTECHNOLOGICAL INNOVATIONS

6. The protection conferred by an innovation patent on a biological material possessing specific characteristics as a result of the innovation 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 an innovation patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the innovation 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 an innovation 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 innovation 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

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 45(1) must give notice of the application to the person who is registered as proprietor of the innovation patent concerned in the Innovation Patent Register 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 innovation patent concerned, or any other person, wishes to oppose an application under section 45(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 45(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 innovation patent licence shall -
- (a) not be exclusive,
 - (b) entitle the person registered as proprietor of the innovation patent concerned to an appropriate royalty, and
 - (c) entitle the person registered as the proprietor of the innovation 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 innovation 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 innovation 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 innovation 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 innovation 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 innovation 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 innovation 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 innovation 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 innovation patent licence, or
- (b) cross licence under paragraph 2(2) or 3(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 innovation 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 innovation 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 innovation patent licence or the cross licence ordered to be granted under paragraph 2(2) or 2(3).

Interpretation.

5. In this Schedule -

"**compulsory innovation patent licence**" means a licence ordered to be granted by the Royal Court under section 45(2), and

"**party**" means the person who is registered as the proprietor of the innovation patent concerned or the applicant, as the case may be, in an application under section 45(1) or their respective successors in title.

SCHEDULE 3

PROTOCOL ON THE INTERPRETATION OF ARTICLE 69 OF THE
EUROPEAN PATENT CONVENTION

Article 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.