


# Kluwer Patent Blog

## Draft Intellectual Property (Unjustified Threats) Bill published in the UK

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On 13 October 2015, the Law Commission of the United Kingdom published the final report of the project to reform the law of unjustified (groundless) threats.

The report is the culmination of years of work, which started in 2012. After a consultation  round, a report was published in 2014 and 18 recommendations for reform were made. The Government asked the Law Commission to draft a Bill based on these recommendations. In the report, [which is available on the Law Commission's website](#), this Intellectual Property (Unjustified Threats) Bill is published and explained.

The Bill is made up of nine clauses, of which six set out the substance of the reform for each of the national and Community rights concerned. The later clauses deal with technical matters such as territorial extent and commencement.

As the reports sets out (4.12): ‘A major criticism of the current law is that there are unnecessary and confusing differences in the threat provisions which apply to different rights. The draft Bill removes these differences. Each of the five substantive sections follows the same structure and is the same in almost all material respects.

(4.15) The Bill provisions are in a new order. For each right, the substantive clause follows this sequence:

(1) The first section defines what a threat is for the purposes of the threats provisions. The definition mainly follows the current case law. However, the required link between the threat and the UK changes. The threat must be understood to relate to an act done (or one which would be done) in the UK.

(2) Not all threats are actionable; the second section defines which are not. As in the current law, actions may not be brought for threats which refer to primary acts (such as making or importing a product). The section also extends (to trade marks and designs) the current exception in patent cases for threats made to a primary actor. That is someone who does, or intends to do, a primary act. For example, a maker or importer.

(3) The third section introduces the concept of “permitted communications”. Where certain conditions are met, a threat made to a secondary actor will not be actionable. This exclusion does not apply to express threats to sue for infringement. The section gives guidance on what may be

said and for what purpose thereby resolving the uncertainty of the current law.

(4) The fourth section sets out the remedies and defences. The range of remedies is unchanged. The defence whereby a threatener is not liable for threats where efforts to find the primary actor were unsuccessful is extended to trade marks and designs (it is currently available only for patents). Currently the threatener must use “best endeavours” to find the primary actor. This is changed to “all reasonable steps”.

(5) The fifth section is entirely new. It prevents threats actions from being brought against professional advisers who act on instructions and who identify their client in the communication.’

In its report, the Law Commission makes recommendations about applying the threats provisions to the Unitary Patent when it comes into existence. It thinks that section 70 of the Patents Act 1977 should apply to Unitary Patents and to European Patents (UK) that have not opted out of the jurisdiction of the Unified Patent Court during the transitional period just as much as opted out EP(UK)s.

Also, it recommends a new test for a threat of infringement proceedings which is that a reasonable person in the position of a recipient would understand from the communication that a person (a) Has a right in a Unitary Patent, European Patent (UK) or national patent, Community trade mark or national trade mark, Community registered or unregistered design or national registered or unregistered design; and (b) Intends to bring proceedings against another person for infringement of one or more of those rights by: (i) An act done in the United Kingdom, or (ii) An act which, if done, would be done in the United Kingdom.

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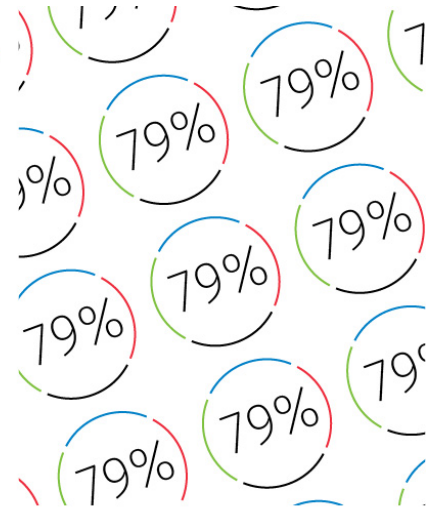
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