



# Patents Act 1977

## 1977 CHAPTER 37

### PART II

#### PROVISIONS ABOUT INTERNATIONAL CONVENTIONS

##### *European patents and patent applications*

#### **77 Effect of European patent (UK).**

- (1) Subject to the provisions of this Act, a European patent (UK) shall, as from the publication of the mention of its grant in the European Patent Bulletin, be treated for the purposes of Parts I and III of this Act as if it were a patent under this Act granted in pursuance of an application made under this Act and as if notice of the grant of the patent had, on the date of that publication, been published under section 24 above in the journal; and—
- (a) the proprietor of a European patent (UK) shall accordingly as respects the United Kingdom have the same rights and remedies, subject to the same conditions, as the proprietor of a patent under this Act;
  - (b) references in Parts I and III of this Act to a patent shall be construed accordingly; and
  - (c) any statement made and any certificate filed for the purposes of the provision of the convention corresponding to section 2(4)(c) above shall be respectively treated as a statement made and written evidence filed for the purposes of the said paragraph (c).
- (2) Subsection (1) above shall not affect the operation in relation to a European patent (UK) of any provisions of the European Patent Convention relating to the amendment or revocation of such a patent in proceedings before the European Patent Office.
- [<sup>F1</sup>(3) Where in the case of a European patent (UK)—
- (a) proceedings for infringement, or proceedings under section 58 above, have been commenced before the court or the comptroller and have not been finally disposed of, and

*Status: Point in time view as at 06/04/2005. This version of this part contains provisions that are prospective.*

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- (b) it is established in proceedings before the European Patent Office that the patent is only partially valid,  
 the provisions of section 63 or, as the case may be, of subsections (7) to (9) of section 58 apply as they apply to proceedings in which the validity of a patent is put in issue and in which it is found that the patent is only partially valid.]
- [<sup>F2</sup>(4) Where a European patent (UK) is amended in accordance with the European Patent Convention, the amendment shall have effect for the purposes of Parts I and III of this Act as if the specification of the patent had been amended under this Act; but subject to subsection (6)(b) below.
- (4A) Where a European patent (UK) is revoked in accordance with the European Patent Convention, the patent shall be treated for the purposes of Parts I and III of this Act as having been revoked under this Act.]
- (5) Where—
- (a) under the European Patent Convention a European patent (UK) is revoked for failure to observe a time limit and is subsequently restored; and
  - (b) between the revocation and publication of the fact that it has been restored a person begins in good faith to do an act which would, apart from section 55 above, constitute an infringement of the patent or makes in good faith effective and serious preparations to do such an act;
- he shall have the rights conferred by [<sup>F3</sup>section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly.]
- (6) [<sup>F4</sup>While this subsection is in force—
- (a) subsection (1) above shall not apply to a European patent (UK) the specification of which was published in French or German, unless a translation of the specification into English is filed at the Patent Office and the prescribed fee is paid before the end of the prescribed period;
  - (b) subsection (4) above shall not apply to an amendment made in French or German unless [<sup>F5</sup>a translation into English of the specification as amended] is filed at the Patent Office and the prescribed fee is paid before the end of the prescribed period.]
- (7) Where [<sup>F6</sup>such a translation is not filed], the patent shall be treated as always having been void.
- (8) The comptroller shall publish any translation filed at the Patent Office under subsection (6) above.
- (9) Subsection (6) above shall come into force on a day appointed for the purpose by rules and shall cease to have effect on a day so appointed, without prejudice, however, to the power to bring it into force again.

#### Textual Amendments

- F1** S. 77(3) substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 21(2)**
- F2** S. 77(4)(4A) substituted for subsection (4) by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 21(3)**
- F3** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 8(b)**

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- F4** S. 77(6) ceased to have effect (6.4.2005) by virtue of [The Patents \(Translations\) Rules 2005 \(S.I. 2005/687\)](#), art. [1 rule 23](#)
- F5** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 21\(4\)](#)
- F6** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 21\(5\)](#)

**Modifications etc. (not altering text)**

- C1** S. 77(9): 1.9.1987 appointed by [S.I. 1987/288](#), [rule 4\(1\)](#) (subject to a saving in [rule 4\(2\)](#))

**78 Effect of filing an application for a European patent (UK).**

- (1) Subject to the provisions of this Act, an application for a European patent (UK) having a date of filing under the European Patent Convention shall be treated for the purposes of the provisions of this Act to which this section applies as an application for a patent under this Act having that date as its date of filing and having the other incidents listed in subsection (3) below, but subject to the modifications mentioned in the following provisions of this section.
- (2) This section applies to the following provisions of this Act:—
- section 2(3) and so much of section 14(7) as relates to section 2(3);
  - section 5;
  - section 6;
  - so much of section 13(3) as relates to an application for and issue of a certificate under that subsection;
  - sections 30 to 33;
  - section 36;
  - sections 55 to 69;
  - section 74, so far as relevant to any of the provisions mentioned above;
  - section 111; and
  - section 125.
- (3) The incidents referred to in subsection (1) above in relation to an application for a European patent (UK) are as follows:—
- (a) any declaration of priority made in connection with the application under the European Patent Convention shall be treated for the purposes of this Act as a declaration made under section 5(2) above;
  - (b) where a period of time relevant to priority is extended under that convention, the period of twelve months [<sup>F7</sup>allowed under section 5(2A)(a)] above shall be so treated as altered correspondingly;
  - (c) where the date of filing an application is re-dated under that convention to a later date, that date shall be so treated as the date of filing the application;
  - (d) the application, if published in accordance with that convention, shall, subject to subsection (7) and section 79 below, be so treated as published under section 16 above;
  - (e) any designation of the inventor under that convention or any statement under it indicating the origin of the right to a European patent shall be treated for the purposes of section 13(3) above as a statement filed under section 13(2) above;

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- (f) registration of the application in the register of European patents shall be treated as registration under this Act.
- (4) Rules under section 32 above may not impose any requirements as to the registration of applications for European patents (UK) but may provide for the registration of copies of entries relating to such applications in the European register of patents.
- [<sup>F8</sup>(5) Subsections (1) to (3) above shall cease to apply to an application for a European patent (UK), except as mentioned in subsection (5A) below, if—
- (a) the application is refused or withdrawn or deemed to be withdrawn, or
  - (b) the designation of the United Kingdom in the application is withdrawn or deemed to be withdrawn,
- but shall apply again if the rights of the applicant are re-established under the European Patent Convention, as from their re-establishment.
- (5A) The occurrence of any of the events mentioned in subsection (5)(a) or (b) shall not affect the continued operation of section 2(3) above in relation to matter contained in an application for a European patent (UK) which by virtue of that provision has become part of the state of the art as regards other inventions.]
- (6) Where between those subsections ceasing to apply to any such application and the re-establishment of the rights of the applicant a person begins in good faith to do an act which would, apart from section 55 above, constitute an infringement of the application if those subsections then applied, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by [<sup>F9</sup>section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly.]
- (7) While this subsection is in force, an application for a European patent (UK) published by the European Patent Office under the European Patent Convention in French or German shall be treated for the purposes of sections 55 and 69 above as published under section 16 above when a translation into English of the claims of the specification of the application has been filed at and published by the Patent Office and the prescribed fee has been paid, but an applicant—
- (a) may recover a payment by virtue of section 55(5) above in respect of the use of the invention in question before publication of that translation; or
  - (b) may bring proceedings by virtue of section 69 above in respect of an act mentioned in that section which is done before publication of that translation;
- if before that use or the doing of that act he has sent by post or delivered to the government department who made use or authorised the use of the invention, or, as the case may be, to the person alleged to have done the act, a translation into English of those claims.
- (8) Subsection (7) above shall come into force on a day appointed for the purpose by rules and shall cease to have effect on a day so appointed, without prejudice, however, to the power to bring it into force again.

#### Textual Amendments

- F7** Words in s. 78(3)(b) substituted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), 14 (with arts. 20-23)
- F8** S. 78(5)(5A) substituted for subsection (5) by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 22](#)

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**F9** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 8\(b\)](#)

**Modifications etc. (not altering text)**

**C2** S. 78(8): 1.9.1986 appointed by [S.I. 1987/288](#), [rule 4\(1\)](#) (subject to saving in [rule 4\(2\)](#))

**79 Operation of s. 78 in relation to certain European patent applications.**

- (1) Subject to the following provisions of this section, section 78 above, in its operation in relation to an international application for a patent (UK) which is treated by virtue of the European Patent Convention as an application for a European patent (UK), shall have effect as if any reference in that section to anything done in relation to the application under the European Patent Convention included a reference to the corresponding thing done under the Patent Co-operation Treaty.
- (2) Any such international application which is published under that treaty shall be treated for the purposes of section 2(3) above as published only when a copy of the application has been supplied to the European Patent Office in English, French or German and the relevant fee has been paid under that convention.
- (3) Any such international application which is published under that treaty in a language other than English, French or German shall, subject to section 78(7) above, be treated for the purposes of sections 55 and 69 above as published only when it is re-published in English, French or German by the European Patent Office under that convention.

**80 Authentic text of European patents and patent applications.**

- (1) Subject to subsection (2) below, the text of a European patent or application for such a patent in the language of the proceedings, that is to say, the language in which proceedings relating to the patent or the application are to be conducted before the European Patent Office, shall be the authentic text for the purposes of any domestic proceedings, that is to say, any proceedings relating to the patent or application before the comptroller or the court.
- (2) Where the language of the proceedings is French or German, a translation into English of the specification of the patent under section 77 above or of the claims of the application under section 78 above shall be treated as the authentic text for the purpose of any domestic proceedings, other than proceedings for the revocation of the patent, if the patent or application as translated into English confers protection which is narrower than that conferred by it in French or German.
- (3) If any such translation results in a European patent or application conferring the narrower protection, the proprietor of or applicant for the patent may file a corrected translation with the Patent Office and, if he pays the prescribed fee within the prescribed period, the Patent Office shall publish it, but—
  - (a) any payment for any use of the invention which (apart from section 55 above) would have infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted, shall not be recoverable under that section,
  - (b) the proprietor or applicant shall not be entitled to bring proceedings in respect of an act which infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted,

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unless before that use or the doing of the act the corrected translation has been published by the Patent Office or the proprietor or applicant has sent the corrected translation by post or delivered it to the government department who made use or authorised the use of the invention or, as the case may be, to the person alleged to have done that act.

- (4) Where a correction of a translation is published under subsection (3) above and before it is so published a person begins in good faith to do an act which would not constitute an infringement of the patent or application as originally translated but would (apart from section 55 above) constitute an infringement of it under the amended translation, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by [F10section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly.]

#### Textual Amendments

**F10** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 8\(b\)](#)

## 81 Conversion of European patent applications.

- (1) The comptroller may direct that on compliance with the relevant conditions mentioned in subsection (2) below an application for a European patent (UK) shall be treated as an application for a patent under this Act in the following cases:—
- (a) where the application is deemed to be withdrawn under the provisions of the European Patent Convention relating to the restriction of the processing of applications;
  - (b) where under the convention the application is deemed to be withdrawn because it has not, within the period required by the convention, been received by the European Patent Office.
- (2) The relevant conditions referred to above are that—
- (a) in the case of an application falling within subsection (1)(a) above, the European Patent Office transmits a request of the applicant to the Patent Office that his application should be converted into an application under this Act, together with a copy of the files relating to the application;
  - (b) in the case of an application falling within subsection (1)(b) above,—
    - (i) the applicant requests the comptroller within the relevant prescribed period (where the application was filed with the Patent Office) to give a direction under this section, or
    - (ii) the central industrial property office of a country which is party to the convention, other than the United Kingdom, with which the application was filed transmits within the relevant prescribed period a request that the application should be converted into an application under this Act, together with a copy of the application; and
  - (c) in either case the applicant within the relevant prescribed period pays the [F11application fee] and if the application is in a language other than English, files a translation into English of the application and of any amendments previously made in accordance with the convention.

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- (3) Where an application for a European patent falls to be treated as an application for a patent under this Act by virtue of a direction under this section—
- (a) the date which is the date of filing the application under the European Patent Convention shall be treated as its date of filing for the purposes of this Act, but if that date is re-dated under the convention to a later date, that later date shall be treated for those purposes as the date of filing the application;
  - (b) if the application satisfies a requirement of the convention corresponding to any of the requirements of this Act or rules designated as formal requirements, it shall be treated as satisfying that formal requirement;
  - (c) any document filed with the European Patent Office under any provision of the convention corresponding to any of the following provisions of this Act, that is to say, sections 2(4)(c), 5, 13(2) and 14, or any rule made for the purposes of any of those provisions, shall be treated as filed with the Patent Office under that provision or rule; and
  - (d) the comptroller shall refer the application for only so much of the examination and search required by sections [F12 15A,] 17 and 18 above as he considers appropriate in view of any examination and search carried out under the convention, and those sections shall apply with any necessary modifications accordingly.

#### Textual Amendments

- F11** Words in s. 81(2)(c) substituted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), **15(2)** (with arts. 20-23)
- F12** Word in s. 81(3)(d) inserted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), **15(3)** (with arts. 20-23)

## 82 Jurisdiction to determine questions as to right to a patent.

- (1) The court shall not have jurisdiction to determine a question to which this section applies except in accordance with the following provisions of this section.
- (2) Section 12 above shall not confer jurisdiction on the comptroller to determine a question to which this section applies except in accordance with the following provisions of this section.
- (3) This section applies to a question arising before the grant of a European patent whether a person has a right to be granted a European patent, or a share in any such patent, and in this section “employer-employee question” means any such question between an employer and an employee, or their successors in title, arising out of an application for a European patent for an invention made by the employee.
- (4) The court and the comptroller shall have jurisdiction to determine any question to which this section applies, other than an employer-employee question, if either of the following conditions is satisfied, that is to say—
  - (a) the applicant has his residence or principal place of business in the United Kingdom; or
  - (b) the other party claims that the patent should be granted to him and he has his residence or principal place of business in the United Kingdom and the applicant does not have his residence or principal place of business in any of the relevant contracting states;

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and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom.

- (5) The court and the comptroller shall have jurisdiction to determine an employer-employee question if either of the following conditions is satisfied, that is to say—
- (a) the employee is mainly employed in the United Kingdom; or
  - (b) the employee is not mainly employed anywhere or his place of main employment cannot be determined, but the employer has a place of business in the United Kingdom to which the employee is attached (whether or not he is also attached elsewhere);

and also if in either of those cases there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom or, where there is such evidence of such an agreement, if the [<sup>F13</sup>law applicable to] the contract of employment does not recognise the validity of the agreement.

- (6) Without prejudice to subsections (2) to (5) above, the court and the comptroller shall have jurisdiction to determine any question to which this section applies if there is written evidence that the parties have agreed to submit to the jurisdiction of the court or the comptroller, as the case may be, and, in the case of an employer-employee question, the [<sup>F13</sup>law applicable to] the contract of employment recognises the validity of the agreement.
- (7) If, after proceedings to determine a question to which this section applies have been brought before the competent authority of a relevant contracting state other than the United Kingdom, proceedings are begun before the court or a reference is made to the comptroller under section 12 above to determine that question, the court or the comptroller, as the case may be, shall stay or sist the proceedings before the court or the comptroller unless or until the competent authority of that other state either—
- (a) determines to decline jurisdiction and no appeal lies from the determination or the time for appealing expires, or
  - (b) makes a determination which the court or the comptroller refuses to recognise under section 83 below.
- (8) References in this section to the determination of a question include respectively references to—
- (a) the making of a declaration or the grant of a declarator with respect to that question (in the case of the court); and
  - (b) the making of an order under section 12 above in relation to that question (in the case of the court or the comptroller).
- (9) In this section and section 83 below “relevant contracting state” means a country which is a party to the European Patent Convention and has not exercised its right under the convention to exclude the application of the protocol to the convention known as the Protocol on Recognition.

#### Textual Amendments

- F13** Words in s. 82(5)(6) substituted (1.4.1991) by [Contracts \(Applicable Law\) Act 1990 \(c. 36, SIF 30\)](#), s. 5, [Sch. 4 para. 3](#); [S.I. 1991/707](#), [art. 2](#)



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### 83 Effect of patent decisions of competent authorities of other states.

- (1) A determination of a question to which section 82 above applies by the competent authority of a relevant contracting state other than the United Kingdom shall, if no appeal lies from the determination or the time for appealing has expired, be recognised in the United Kingdom as if it had been made by the court or the comptroller unless the court or he refuses to recognise it under subsection (2) below.
- (2) The court or the comptroller may refuse to recognise any such determination that the applicant for a European patent had no right to be granted the patent, or any share in it, if either—
  - (a) the applicant did not contest the proceedings in question because he was not notified of them at all or in the proper manner or was not notified of them in time for him to contest the proceedings; or
  - (b) the determination in the proceedings in question conflicts with the determination of the competent authority of any relevant contracting state in proceedings instituted earlier between the same parties as in the proceedings in question.

84 ..... F14

#### Textual Amendments

F14 S. 84 repealed by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 303(2), [Sch. 8](#)

85 ..... F15

#### Textual Amendments

F15 S. 85 repealed by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 303(2), [Sch. 8](#)

### *Community patents*

PROSPECTIVE

### <sup>F16</sup>86 Implementation of Community Patent Convention.

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#### Textual Amendments

F16 S. 86 repealed (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 1 para. 6](#), [Sch. 3](#); S.I. 2004/3205, [art. 2\(g\)\(i\)](#) (with [art. 9](#))

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PROSPECTIVE

<sup>F17</sup>87 Decisions on Community Patent Convention.

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**Textual Amendments**

<sup>F17</sup> S. 87 repealed (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), Sch. 1 para. 6, **Sch. 3**; S.I. 2004/3205, art. 2(g)(i) (with art. 9)

88 ..... <sup>F18</sup>

**Textual Amendments**

<sup>F18</sup> S. 88 repealed by Copyright, Designs and Patents Act 1988 (c. 48, SIF 67A), ss. 295, 305(3), Sch. 5 para. 23, **Sch. 8**

*International applications for patents*

[<sup>F19</sup>89 **Effect of international application for patent.**

- (1) An international application for a patent (UK) for which a date of filing has been accorded under the Patent Co-operation Treaty shall, subject to—
  - section 89A (international and national phases of application), and
  - section 89B (adaptation of provisions in relation to international application),
 be treated for the purposes of Parts I and III of this Act as an application for a patent under this Act.
- (2) If the application, or the designation of the United Kingdom in it, is withdrawn or (except as mentioned in subsection (3)) deemed to be withdrawn under the Treaty, it shall be treated as withdrawn under this Act.
- (3) An application shall not be treated as withdrawn under this Act if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Treaty—
  - (a) because of an error or omission in an institution having functions under the Treaty, or
  - (b) because, owing to circumstances outside the applicant’s control, a copy of the application was not received by the International Bureau before the end of the time limited for that purpose under the Treaty,
 or in such other circumstances as may be prescribed.

<sup>F20</sup>(4) .....

- (5) If an international application for a patent which designates the United Kingdom is refused a filing date under the Treaty and the comptroller determines that the refusal was caused by an error or omission in an institution having functions under the Treaty,

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he may direct that the application shall be treated as an application under this Act, having such date of filing as he may direct.]

#### Textual Amendments

- F19** Ss. 89-89B substituted for s. 89 by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 25](#)
- F20** S. 89(4) repealed (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 1 para. 7](#), [Sch. 3](#); S.I. [2004/3205](#), [art. 2\(g\)\(i\)](#) (with [art. 9](#))

#### [<sup>F21</sup>89A International and national phases of application.

- (1) The provisions of the Patent Co-operation Treaty relating to publication, search, examination and amendment, and not those of this Act, apply to an international application for a patent (UK) during the international phase of the application.
- (2) The international phase of the application means the period from the filing of the application in accordance with the Treaty until the national phase of the application begins.
- (3) The national phase of the application begins—
  - (a) when the prescribed period expires, provided any necessary translation of the application into English has been filed at the Patent Office and the prescribed fee has been paid by the applicant; or
  - (b) on the applicant expressly requesting the comptroller to proceed earlier with the national phase of the application, filing at the Patent Office—
    - (i) a copy of the application, if none has yet been sent to the Patent Office in accordance with the Treaty, and
    - (ii) any necessary translation of the application into English, and paying the prescribed fee.

For this purpose a “copy of the application” includes a copy published in accordance with the Treaty in a language other than that in which it was originally filed.
- (4) If the prescribed period expires without the conditions mentioned in subsection (3)(a) being satisfied, the application shall be taken to be withdrawn.
- (5) Where during the international phase the application is amended in accordance with the Treaty, the amendment shall be treated as made under this Act if—
  - (a) when the prescribed period expires, any necessary translation of the amendment into English has been filed at the Patent Office, or
  - (b) where the applicant expressly requests the comptroller to proceed earlier with the national phase of the application, there is then filed at the Patent Office—
    - (i) a copy of the amendment, if none has yet been sent to the Patent Office in accordance with the Treaty, and
    - (ii) any necessary translation of the amendment into English;otherwise the amendment shall be disregarded.
- (6) The comptroller shall on payment of the prescribed fee publish any translation filed at the Patent Office under subsection (3) or (5) above.]

*Status: Point in time view as at 06/04/2005. This version of this part contains provisions that are prospective.*

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### Textual Amendments

**F21** Ss. 89-89B substituted for s. 89 by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 25](#)

### [<sup>F22</sup>89B Adaptation of provisions in relation to international application.

- (1) Where an international application for a patent (UK) is accorded a filing date under the Patent Co-operation Treaty—
  - (a) that date, or if the application is re-dated under the Treaty to a later date that later date, shall be treated as the date of filing the application under this Act,
  - (b) any declaration of priority made under the Treaty shall be treated as made under section 5(2) above, and where in accordance with the Treaty any extra days are allowed, the period of 12 months [<sup>F23</sup>allowed under section 5(2A)(a) above] shall be treated as altered accordingly, and
  - (c) any statement of the name of the inventor under the Treaty shall be treated as a statement filed under section 13(2) above.
- (2) If the application, not having been published under this Act, is published in accordance with the Treaty it shall be treated, for purposes other than those mentioned in subsection (3), as published under section 16 above when the [<sup>F24</sup>national phase of the application begins or, if later, when published in accordance with the Treaty] .
- (3) For the purposes of section 55 (use of invention for service of the Crown) and section 69 (infringement of rights conferred by publication) the application, not having been published under this Act, shall be treated as published under section 16 above—
  - (a) if it is published in accordance with the Treaty in English, on its being so published; and
  - (b) if it is so published in a language other than English—
    - (i) on the publication of a translation of the application in accordance with section 89A(6) above, or
    - (ii) on the service by the applicant of a translation into English of the specification of the application of the government department concerned or, as the case may be, on the person committing the infringing act.

The reference in paragraph (b)(ii) to the service of a translation on a government department or other person is to its being sent by post or delivered to that department or person.
- (4) During the international phase of the application, section 8 above does not apply (determination of questions of entitlement in relation to application under this Act) and section 12 above (determination of entitlement in relation to foreign and convention patents) applies notwithstanding the application; but after the end of the international phase, section 8 applies and section 12 does not.
- (5) When the national phase begins the comptroller shall refer the application for so much of the examination and search [<sup>F25</sup>under sections 15A,] 17 and 18 above as he considers appropriate in view of any examination or search carried out under the Treaty.]

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#### Textual Amendments

- F22** Ss. 89-89B substituted for s. 89 by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, [Sch. 5 para. 25](#)
- F23** Words in s. 89B(1)(b) substituted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), [16\(2\)](#) (with arts. 20-23)
- F24** Words in s. 89B(2) substituted (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 1 para. 8](#); [S.I. 2004/3205](#), art. 2(i) (with art. 9)
- F25** Words in s. 89B(5) substituted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), [16\(3\)](#) (with arts. 20-23)

#### *Convention countries*

### **90 Orders in Council as to convention countries.**

- (1) Her Majesty may with a view to the fulfilment of a treaty or international convention, arrangement or engagement, by Order in Council declare that any country specified in the Order is a convention country for the purposes of section 5 above.
- (2) Her Majesty may by Order in Council direct that any of the Channel Islands, any colony . . . <sup>F26</sup> shall be taken to be a convention country for those purposes.
- (3) For the purposes of subsection (1) above every colony, protectorate, and territory subject to the authority or under the suzerainty of another country, and every territory administered by another country under the trusteeship system of the United Nations shall be taken to be a country in the case of which a declaration may be made under that subsection.

#### Textual Amendments

- F26** Words repealed by [Statute Law \(Repeals\) Act 1986 \(c. 12\)](#), s. 1(1), [Sch. 1 Pt. VI](#)

#### *Miscellaneous*

### **91 Evidence of conventions and instruments under conventions.**

- (1) Judicial notice shall be taken of the following, that is to say—
  - (a) the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty (each of which is hereafter in this section referred to as the relevant convention);
  - (b) any bulletin, journal or gazette published under the relevant convention and the register of European [<sup>F27</sup>patents kept under the European Patent Convention] ; and
  - (c) any decision of, or expression of opinion by, the relevant convention court on any question arising under or in connection with the relevant convention.
- (2) Any document mentioned in subsection (1)(b) above shall be admissible as evidence of any instrument or other act thereby communicated of any convention institution.

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- (3) Evidence of any instrument issued under the relevant convention by any such institution, including any judgment or order of the relevant convention court, or of any document in the custody of any such institution or reproducing in legible form any information in such custody otherwise than in legible form, or any entry in or extract from such a document, may be given in any legal proceedings by production of a copy certified as a true copy by an official of that institution; and any document purporting to be such a copy shall be received in evidence without proof of the official position or handwriting of the person signing the certificate.
- (4) Evidence of any such instrument may also be given in any legal proceedings—
- (a) by production of a copy purporting to be printed by the Queen’s Printer;
  - (b) where the instrument is in the custody of a government department, by production of a copy certified on behalf of the department to be a true copy by an officer of the department generally or specially authorised to do so;
- and any document purporting to be such a copy as is mentioned in paragraph (b) above of an instrument in the custody of a department shall be received in evidence without proof of the official position or handwriting of the person signing the certificate, or of his authority to do so, or of the document being in the custody of the department.
- (5) In any legal proceedings in Scotland evidence of any matter given in a manner authorised by this section shall be sufficient evidence of it.
- (6) In this section—
- “convention institution” means an institution established by or having functions under the relevant convention;
- “relevant convention court” does not include a court of the United Kingdom or of any other country which is a party to the relevant convention; and
- “legal proceedings”, in relation to the United Kingdom, includes proceedings before the comptroller.

#### Textual Amendments

**F27** Words in s. 91(1) substituted (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 2 para. 20](#); [S.I. 2004/3205](#), [art. 2\(k\)](#) (with [art. 9](#))

## 92 Obtaining evidence for proceedings under the European Patent Convention.

- (1) Sections 1 to 3 of the <sup>M1</sup>Evidence (Proceedings in Other Jurisdictions) Act 1975 (provisions enabling United Kingdom courts to assist in obtaining evidence for foreign courts) shall apply for the purpose of proceedings before a relevant convention court under the European Patent Convention as they apply for the purpose of civil proceedings in a court exercising jurisdiction in a country outside the United Kingdom.
- (2) In the application of those sections by virtue of this section any reference to the High Court, the Court of Session or the High Court of Justice in Northern Ireland shall include a reference to the comptroller.
- (3) Rules under this Act may include provision—
- (a) as to the manner in which an application under section 1 of the said Act of 1975 is to be made to the comptroller for the purpose of proceedings before a relevant convention court under the European Patent Convention; and

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- (b) subject to the provisions of that Act, as to the circumstances in which an order can be made under section 2 of that Act on any such application.
- (4) Rules of court and rules under this Act may provide for an officer of the European Patent Office to attend the hearing of an application under section 1 of that Act before the court or the comptroller, as the case may be, and examine the witnesses or request the court or comptroller to put specified questions to the witnesses.
- (5) Section 1(4) of the <sup>M2</sup>Perjury Act 1911 and [<sup>F28</sup>Article 3(4) of the Perjury (Northern Ireland) Order 1979] (statements made for the purposes, among others, of judicial proceedings in a tribunal of a foreign state) shall apply in relation to proceedings before a relevant convention court under the European Patent Convention as they apply to a judicial proceeding in a tribunal of a foreign state.

#### Textual Amendments

**F28** Words substituted by S.I. 1979/1714 (N.I. 19), Sch. 1 para. 28

#### Marginal Citations

**M1** 1975 c. 34.

**M2** 1911 c. 6.

### 93 Enforcement of orders for costs.

If the European Patent Office orders the payment of costs in any proceedings before it—

- (a) in England and Wales the costs shall, if a county court so orders, be recoverable by execution issued from the county court or otherwise as if they were payable under an order of that court;
- (b) in Scotland the order may be enforced in like manner as [<sup>F29</sup>a recorded decree arbitral][<sup>F29</sup>an extract registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland.];
- (c) in Northern Ireland the order may be enforced as if it were a money judgment.

#### Textual Amendments

**F29** Words commencing “an extract registered” substituted (S.) for the words “a recorded decree arbitral” by Debtors (Scotland) Act 1987 (c. 18, SIF 45:2), s. 108(1), Sch. 6 paras. 1, 20

### 94 Communication of information to the European Patent Office, etc.

It shall not be unlawful by virtue of any enactment to communicate the following information in pursuance of the European Patent Convention to the European Patent Office or the competent authority of any country which is party to the Convention, that is to say—

- (a) information in the files of the court which, in accordance with rules of court, the court authorises to be so communicated;
- (b) information in the files of the Patent Office which, in accordance with rules under this Act, the comptroller authorises to be so communicated.

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## 95 Financial provisions.

- (1) There shall be paid out of moneys provided by Parliament any sums required by any Minister of the Crown or government department to meet any financial obligation of the United Kingdom under the European Patent Convention,<sup>F30</sup> ... or the Patent Co-operation Treaty.
- (2) Any sums received by any Minister of the Crown or government department in pursuance of [<sup>F31</sup>that convention ] or that treaty shall be paid into the Consolidated Fund.

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### Textual Amendments

**F30** Words in s. 95(1) repealed (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), Sch. 2 para. 21(a), [Sch. 3](#); [S.I. 2004/3205](#), art. 2(g)(k) (with art. 9)

**F31** Words in s. 95(2) substituted (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 2 para. 21\(b\)](#); [S.I. 2004/3205](#), art. 2(k) (with art. 9)



**Status:**

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**Changes to legislation:**

Patents Act 1977, Part II is up to date with all changes known to be in force on or before 12 June 2024. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations.