

*Status: Point in time view as at 04/04/2005.*

*Changes to legislation: Patents Act 1977, SCHEDULE 1 is up to date with all changes known to be in force on or before 30 July 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. (See end of Document for details)*

## SCHEDULES

### SCHEDULE 1

Section 127.

#### APPLICATION OF 1949 ACT TO EXISTING PATENTS AND APPLICATIONS

- 1 (1) The provisions of the 1949 Act referred to in sub-paragraph (2) below shall continue to apply on and after the appointed day in relation to existing patents and applications (but not in relation to patents and applications for patents under this Act).
- (2) The provisions are sections 1 to 10, 11(1) and (2), 12, 13, 15 to 17, 19 to 21, 22(1) to (3), 23 to 26, 28 to 33, 46 to 53, 55, 56, 59 to 67, 69, 76, 80, 87(2), 92(1), 96, 101, 102(1) and 103 to 107.
- (3) Sub-paragraph (1) above shall have effect subject to the following provisions of this Schedule, paragraph 2(b) of Schedule 3 below and the provisions of Schedule 4 below.
- 2 (1) In section 6 of the 1949 Act, at the end of the proviso to subsection (3) (post-dating of application) there shall be inserted  
“and—  
(c) no application shall, on or after the appointed day, be postdated under this subsection to a date which is that of the appointed day or which falls after it ””  
  
and there shall be inserted at the end of subsection (4) “ ; but no application shall on or after the appointed day be post-dated under this subsection to a date which is that of the appointed day or which falls after it”.
- (2) At the end of subsection (5) of that section (ante-dating) there shall be inserted “ ; but a fresh application or specification may not be filed on or after the appointed day in accordance with this subsection and those rules unless the comptroller agrees that he will direct that the application or specification shall be ante-dated to a date which falls before the appointed day”.

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

- C1** The text of ss. 127(5), 132(6),(7); [Sch. 1 para. 2\(1\),\(2\)](#), 5, 7(1)(2), 8; [Sch. 3](#); [Sch. 5 paras 4, 5\(1\), \(2\), \(3\)](#), 6; [Sch. 6](#) is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

- 3 (1) This paragraph and paragraph 4 below shall have effect with respect to the duration of existing patents after the appointed day, and in those paragraphs—
  - (a) “old existing patent” means an existing patent the date of which fell eleven years or more before the appointed day and also any patent of addition where the patent for the main invention is, or was at any time, an old existing patent by virtue of the foregoing provision;
  - (b) “new existing patent” means any existing patent not falling within paragraph (a) above; and

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- (c) any reference to the date of a patent shall, in relation to a patent of addition, be construed as a reference to the date of the patent for the main invention.
- (2) Sections 23 to 25 of the 1949 Act (extension of patents on grounds of inadequate remuneration and war loss) shall not apply to a new existing patent.
- (3) The period for which the term of an old existing patent may be extended under section 23 or 24 of that Act shall not exceed in the aggregate four years, except where an application for an order under the relevant section has been made before the appointed day and has not been disposed of before that day.
- 4 (1) The term of every new existing patent under section 22(3) of the 1949 Act shall be twenty instead of sixteen years from the date of the patent, but—
- (a) the foregoing provision shall have effect subject to section 25(3) to (5) above; and
  - (b) on and after the end of the sixteenth year from that date a patent shall not be renewed under section 25(3) to (5) above except by or with the consent of the proprietor of the patent.
- (2) Where the term of a new existing patent is extended by this paragraph,—
- (a) any licence in force under the patent from immediately before the appointed day until the end of the sixteenth year from the date of the patent shall, together with any contract relating to the licence, continue in force so long as the patent remains in force (unless determined otherwise than in accordance with this sub-paragraph), but, if it is an exclusive licence, it shall after the end of that year be treated as a non-exclusive licence;
  - (b) notwithstanding the terms of the licence, the licensee shall not be required to make any payment to the proprietor for working the invention in question after the end of that year;
  - (c) every such patent shall after the end of that year be treated as endorsed under section 35 of the 1949 Act (licences of right) <sup>F1</sup>, but subject to paragraph 4A below].
- (3) Where the term of a new existing patent is extended by this paragraph and any government department or any person authorised by a government department—
- (a) has before the appointed day, used the invention in question for the services of the Crown; and
  - (b) continues to so use it until the end of the sixteenth year from the date of the patent,
- any such use of the invention by any government department or person so authorised, after the end of that year, may be made free of any payment to the proprietor of the patent.
- (4) Without prejudice to any rule of law about the frustration of contracts, where any person suffers loss or is subjected to liability by reason of the extension of the term of a patent by this paragraph, the court may on the application of that person determine how and by whom the loss or liability is to be borne and make such order as it thinks fit to give effect to the determination.

#### Textual Amendments

**F1** Words inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\), s. 293](#)

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- [<sup>F2</sup>4A (1) If the proprietor of a patent for an invention which is a product files a declaration with the Patent Office in accordance with this paragraph, the licences to which persons are entitled by virtue of paragraph 4(2)(c) above shall not extend to a use of the product which is excepted by or under this paragraph.
- (2) Pharmaceutical use is excepted, that is—
- (a) use as a medicinal product within the meaning of the Medicines Act 1968, and
  - (b) the doing of any other act mentioned in section 60(1)(a) above with a view to such use.
- (3) The Secretary of State may by order except such other uses as he thinks fit; and an order may—
- (a) specify as an excepted use any act mentioned in section 60(1)(a) above, and
  - (b) make different provision with respect to acts done in different circumstances or for different purposes.
- (4) For the purposes of this paragraph the question what uses are excepted, so far as that depends on—
- (a) orders under section 130 of the Medicines Act 1968 (meaning of “medicinal product”), or
  - (b) orders under sub-paragraph (3) above,
- shall be determined in relation to a patent at the beginning of the sixteenth year of the patent.
- (5) A declaration under this paragraph shall be in the prescribed form and shall be filed in the prescribed manner and within the prescribed time limits.
- (6) A declaration may not be filed—
- (a) in respect of a patent which has at the commencement of section 293 of the Copyright, Designs and Patents Act 1988 passed the end of its fifteenth year; or
  - (b) if at the date of filing there is—
    - (i) an existing licence for any description of excepted use of the product, or
    - (ii) an outstanding application under section 46(3)(a) or (b) above for the settlement by the comptroller of the terms of a licence for any description of excepted use of the product,and, in either case, the licence took or is to take effect at or after the end of the sixteenth year of the patent.
- (7) Where a declaration has been filed under this paragraph in respect of a patent—
- (a) section 46(3)(c) above (restriction of remedies for infringement where licences available as of right) does not apply to an infringement of the patent in so far as it consists of the excepted use of the product after the filing of the declaration; and
  - (b) section 46(3)(d) above (abatement of renewal fee if licences available as of right) does not apply to the patent.]

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#### Textual Amendments

**F2** Sch. 1 para. 4A inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 293

- [<sup>F3</sup>4B (1) An application under section 46(3)(a) or (b) above for the settlement by the comptroller of the terms on which a person is entitled to a licence by virtue of paragraph 4(2)(c) above is ineffective if made before the beginning of the sixteenth year of the patent.
- (2) This paragraph applies to applications made after the commencement of section 294 of the Copyright, Designs and Patents Act 1988 and to any application made before the commencement of that section in respect of a patent which has not at the commencement of that section passed the end of its fifteenth year.]
- (5) No order shall be made on an application under sub-paragraph (4) above which has the effect of imposing a liability on any person other than the applicant unless notification of the application is given to that person.

#### Textual Amendments

**F3** Sch. 1 para. 4B inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 294

- 5 In section 26(3) of the 1949 Act (no patent of addition unless date of filing of complete specification was the same as or later than the date of filing of complete specification in respect of main invention) after “main invention” there shall be inserted “and was earlier than the date of the appointed day”.

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

**C2** The text of ss. 127(5), 132(6),(7); [Sch. 1 para. 2\(1\),\(2\)](#), 5, 7(1)(2), 8; [Sch. 3](#); [Sch. 5 paras 4, 5\(1\)](#), (2), (3), 6; [Sch. 6](#) is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

- 6 Notwithstanding anything in section 32(1)(j) of the 1949 Act (ground for revocation that patent was obtained on a false suggestion or representation), it shall not be a ground of revoking a patent under that subsection that the patent was obtained on a false suggestion or representation that a claim of the complete specification of the patent had a priority date earlier than the date of filing the application for the patent, but if it is shown—
- (a) on a petition under that section or an application under section 33 of that Act; or
- (b) by way of defence or on a counterclaim on an action for infringement;
- that such a suggestion or representation was falsely made, the priority date of the claim shall be taken to be the date of filing the application for that patent.
- 7 (1) In section 33 of the 1949 Act (revocation of patent by comptroller), in subsection (1) for the words preceding the proviso there shall be substituted—
- “(1) Subject to the provisions of this Act, a patent may, on the application of any person interested, be revoked by the comptroller on any of the grounds set out in section 32(1) of this Act.”
- (2) At the end of the said section 33 there shall be added the following subsection:—

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“(5) A decision of the comptroller or on appeal from the comptroller shall not estop any party to civil proceedings in which infringement of a patent is in issue from alleging that any claim of the specification is invalid on any of the grounds set out in section 32(1) of this Act, whether or not any of the issues involved were decided in that decision.”

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

**C3** The text of ss. 127(5), 132(6),(7); [Sch. 1 para. 2\(1\),\(2\)](#), 5, 7(1)(2), 8; [Sch. 3](#); [Sch. 5 paras 4, 5\(1\)](#), (2), (3), 6; [Sch. 6](#) is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

8 In section 101(1) of the 1949 Act (interpretation) there shall be inserted in the appropriate place—

““appointed day” means the day appointed under section 132 of the Patents Act 1977 for the coming into operation of Schedule 1 to that Act;”

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

**C4** The text of ss. 127(5), 132(6),(7); [Sch. 1 para. 2\(1\),\(2\)](#), 5, 7(1)(2), 8; [Sch. 3](#); [Sch. 5 paras 4, 5\(1\)](#), (2), (3), 6; [Sch. 6](#) is in the form in which it was originally enacted: it was not reproduced in Statutes in Force and does not reflect any amendments or repeals which may have been made prior to 1.2.1991.

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