

*These notes refer to the Patents Act 2004 (c.16)
which received Royal Assent on 22nd July 2004*

PATENTS ACT 2004

EXPLANATORY NOTES

COMMENTARY ON SECTIONS

Schedule 1 paragraph 9, sub-paragraph (2)(b)

42. Under the EPC, the applicant chooses (“designates”) which of the contracting states he wishes the European patent to cover. Under EPC 2000, all the contracting states will automatically be deemed to be designated on filing of the European patent application. *Paragraph 9(2)(b)* amends the definition of “designate” in the 1977 Act in order to make clear that, where a country is deemed to be designated under EPC 2000, that country is treated as designated under the 1977 Act. It follows that every European patent application is treated under the 1977 Act as an application for a European patent (UK), because every European patent application is treated as having designated the UK on filing.
43. The amended definition of “designate” also applies to the designation of states or regions under the PCT. From 1st January 2004, a revision to the Regulations under the PCT means that all the contracting states and regions of the PCT are automatically deemed to be designated on filing of an international application. It follows that every international application for a patent is treated as an international application for a patent (UK), because every international application is treated as having designated the UK on filing.
44. It will continue to be possible under both the EPC and PCT to withdraw the designation of a contracting state or region from an application at any time. Therefore, as in the past, withdrawal of a designation does not change the fact that the country or region concerned was designated on filing. Withdrawing the UK designation at any time will therefore not stop a European or international patent application from being defined under the 1977 Act as an application for a European patent (UK) or an international application for a patent (UK) respectively. However, withdrawal of the UK designation will, as previously, continue to have the effects set out in section 78 (for European applications) and section 89 (for international applications). Thus withdrawing the UK designation will mean that patent protection is not obtained in the UK.