



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.
- (3) Sections 58(7) to (9) and 63 above shall apply to the case where, after proceedings for the infringement of a European patent have been commenced before the court or the comptroller but have not been finally disposed of, it is established in proceedings before the European Patent Office that the patent is only partially valid as those

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provisions 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.

- (4) Subject to subsection (6) below, where a European patent (UK) is amended or revoked in accordance with the European Patent Convention, the amendment shall be treated for the purposes of Parts I and III of this Act as if it had been made, or as the case may be the patent shall be treated for those purposes as having been revoked, under this Act.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 section 28(6) above, and subsections (8) and (9) of that section shall apply accordingly.
- (6) 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 a translation of the amendment into English is filed at the Patent Office and the prescribed fee is paid before the end of the prescribed period.
- (7) Where a translation of a specification or amendment into English is not filed in accordance with subsection (6)(a) or (b) above, 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.

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;

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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 specified in section 5(2) 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 (6) 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 ;
 - (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.
- (5) Subsections (1) to (3) above shall cease to apply to an application for a European patent (UK) when the application is refused or withdrawn or deemed to be withdrawn, or the designation of the United Kingdom in the application is withdrawn or deemed to be withdrawn, but if the rights of the applicant are re-established under the European Patent Convention, subsections (1) to (3) above shall as from the re-establishment of those rights again apply to the application.
- (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 section 28(6) above, and section 28(8) and (9) above shall apply to the exercise of any such right 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

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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.

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—

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- (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,

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 section 28(6) above, and section 28(8) and (9) above shall apply to the exercise of any such right accordingly.

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 filing 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 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.

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 ;

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 proper law of 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 proper law of 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.

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

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- (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 Patent agents and other representatives

- (1) No individual shall carry on for gain in the United Kingdom, alone or in partnership with any other person, the business of acting as agent or other representative of other persons for the purpose of applying for or obtaining European patents or for the purpose of conducting proceedings in connection with such patents before the European Patent Office or the comptroller, or hold himself out or permit himself to be held out as so carrying on such a business, unless he satisfies the condition that his name and that of each of his partners appears on the European list.
- (2) Subsection (1) above shall not prohibit a barrister, advocate or solicitor of any part of the United Kingdom from conducting or otherwise taking part in any proceedings in connection with European patents before the European Patent Office or the comptroller to the same extent as he is entitled to take part in the corresponding proceedings in connection with patents under this Act before the Patent Office or the comptroller.
- (3) A body corporate shall not for gain act or describe itself or hold itself out as entitled to act as agent or other representative of other persons for any purpose mentioned in subsection (1) above unless permitted to do so under the European Patent Convention.
- (4) Any person who contravenes subsection (1) or (3) above shall be liable on summary conviction to a fine not exceeding £1,000.
- (5) Proceedings for an offence under this section may be begun at any time within twelve months from the date of the offence.
- (6) A person who does any act mentioned in subsection (1) above, but satisfies the condition mentioned in that subsection, shall not be treated as contravening section 114 below so long as he does not describe himself as a patent agent without qualification and does not hold himself out or permit himself to be held out as carrying on any business other than one mentioned in that subsection.
- (7) In this section " the European list" means the list of professional representatives maintained by the European Patent Office in pursuance of the European Patent Convention.

85 European patent attorneys

- (1) For the avoidance of doubt, it is hereby declared that any person whose name appears on the European list shall not be guilty of an offence under section 21 of the Solicitors Act 1974 or Article 22 of the Solicitors (Northern Ireland) Order 1976 by reason only of his describing himself as a European patent attorney.
- (2) A person whose name appears on the European list shall not be guilty of an offence under any of the enactments mentioned in subsection (3) below by reason only of the preparation by him of any document (other than a deed) for use in proceedings before the comptroller under this Act, in relation to a European patent or application for such a patent.

- (3) The enactments referred to in subsection (2) above (which prohibit the preparation for reward of certain instruments or writs by persons not legally qualified) are—
- (a) section 22 of the Solicitors Act 1974 ;
 - (b) section 39 of the Solicitors (Scotland) Act 1933 ; and
 - (c) Article 23 of the Solicitors (Northern Ireland) Order 1976
- (4) In this section "the European list" means the list of professional representatives maintained by the European Patent Office in pursuance of the European Patent Convention.