

*Changes to legislation: There are currently no known outstanding effects for the Patents Act 2004. (See end of Document for details)*

## SCHEDULES

### SCHEDULE 1

Section 5

#### AMENDMENTS RELATING TO INTERNATIONAL OBLIGATIONS

1 The 1977 Act is amended as follows.

#### Commencement Information

**11** Sch. 1 para. 1 in force at 1.1.2005 by S.I. 2004/3205, art. 2(i) (with art. 9)

2 In section 77 (effect of European patent (UK)), in subsection (5)(a), after “restored” there is inserted “ or is revoked by the Board of Appeal and is subsequently restored by the Enlarged Board of Appeal ”.

#### Commencement Information

**12** Sch. 1 para. 2 in force at 13.12.2007 by S.I. 2007/3396, art. 2(j)

3 (1) Section 78 (effect of filing an application for a European patent (UK)) is amended as follows.

(2) In subsection (5A), at the end there is inserted “ ; and the occurrence of any event mentioned in subsection (5)(b) shall not prevent matter contained in an application for a European patent (UK) becoming part of the state of the art by virtue of section 2(3) above as regards other inventions where the event occurs before the publication of that application. ”

(3) For subsection (6) there is substituted—

“(6) Where, between subsections (1) to (3) above ceasing to apply to an application for a European patent (UK) and the re-establishment of the rights of the applicant, a person—

- (a) begins in good faith to do an act which would constitute an infringement of the rights conferred by publication of the application if those subsections then applied, or
- (b) makes in good faith effective and serious preparations to do such an act,

he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding subsections (1) to (3) applying again and notwithstanding the grant of the patent.

(6A) Subsections (5) and (6) of section 20B above have effect for the purposes of subsection (6) above as they have effect for the purposes of that section and as if the references to subsection (4) of that section were references to subsection (6) above.

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(6B) Subject to subsection (6A) above, the right conferred by subsection (6) above does not extend to granting a licence to another person to do the act in question.

(6C) Subsections (6) to (6B) above apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to an infringement of the rights conferred by publication of the application (or, as the case may be, infringement of the patent).

“Patented invention” has the same meaning as in section 55 above.”

**Commencement Information**

**I3** Sch. 1 para. 3 in force at 13.12.2007 by S.I. 2007/3396, art. 2(j) (with art. 3)

4 In section 80 (authentic text of European patents and patent applications), for subsection (4) there is substituted—

“(4) Where a correction of a translation is published under subsection (3) above and before it is so published a person—

- (a) begins in good faith to do an act which would not constitute an infringement of the patent as originally translated, or of the rights conferred by publication of the application as originally translated, but would do so under the amended translation, or
- (b) makes in good faith effective and serious preparations to do such an act,

he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding the publication of the corrected translation and notwithstanding the grant of the patent.

(5) Subsections (5) and (6) of section 28A above have effect for the purposes of subsection (4) above as they have effect for the purposes of that section and as if—

- (a) the references to subsection (4) of that section were references to subsection (4) above;
- (b) the reference to the registered proprietor of the patent included a reference to the applicant.

(6) Subject to subsection (5) above, the right conferred by subsection (4) above does not extend to granting a licence to another person to do the act in question.

(7) Subsections (4) to (6) above apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to an infringement of the patent or of the rights conferred by the publication of the application.

“Patented invention” has the same meaning as in section 55 above.”

**Commencement Information**

**I4** Sch. 1 para. 4 in force at 13.12.2007 by S.I. 2007/3396, art. 2(j)

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- 5 (1) Section 81 (conversion of European patent applications) is amended as follows.
- (2) In subsection (1), for the words following “this Act” there is substituted “ where the application is deemed to be withdrawn under the provisions of the European Patent Convention relating to the time for forwarding applications to the European Patent Office ”.
- (3) In subsection (2)—
- (a) paragraph (a) and the “that” preceding it are omitted;
  - (b) in paragraph (b), for the words preceding sub-paragraph (i) there is substituted “ that ”;
  - (c) in paragraph (c), for “in either case” there is substituted “ that ”.

**Commencement Information**

**I5** Sch. 1 para. 5 in force at 13.12.2007 by S.I. 2007/3396, art. 2(j)

- 6 Sections 86 and 87 (implementation of Community Patent Convention and decisions under it) are omitted.

**Commencement Information**

**I6** Sch. 1 para. 6 in force at 1.1.2005 by S.I. 2004/3205, art. 2(i) (with art. 9)

- 7 Section 89(4) (circumstances in which application treated as an international application for a patent (UK)) is omitted.

**Commencement Information**

**I7** Sch. 1 para. 7 in force at 1.1.2005 by S.I. 2004/3205, art. 2(i) (with art. 9)

- 8 In section 89B(2) (adaptation of provisions in relation to international applications), for the words following “when the” there is substituted “ national phase of the application begins or, if later, when published in accordance with the Treaty ”.

**Commencement Information**

**I8** Sch. 1 para. 8 in force at 1.1.2005 by S.I. 2004/3205, art. 2(i) (with art. 9)

- 9 (1) Section 130 (interpretation) is amended as follows.
- (2) In subsection (1)—
- (a) in the definition of “application for a European patent (UK)” and “international application for a patent (UK)”, after “and” there is inserted “ (subject to subsection (4A) below) ”;
  - (b) at the end of the definition of “designate” there is inserted “ and includes a reference to a country being treated as designated in pursuance of the convention or treaty ”.
- (3) After subsection (4) there is inserted—

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“(4A) An international application for a patent is not, by reason of being treated by virtue of the European Patent Convention as an application for a European patent (UK), to be treated also as an international application for a patent (UK).”

(4) After subsection (5) there is inserted—

“(5A) References in this Act to the amendment of a patent or its specification (whether under this Act or by the European Patent Office) include, in particular, limitation of the claims (as interpreted by the description and any drawings referred to in the description or claims).”

**Commencement Information**

- I9** Sch. 1 para. 9(1)(2)(a)(3) in force at 1.1.2005 by S.I. 2004/3205, **art. 2(i)** (with art. 9)  
**I10** Sch. 1 para. 9(2)(b) in force at 1.1.2005 for specified purposes by S.I. 2004/3205, **art. 2(j)** (with art. 9)  
**I11** Sch. 1 para. 9(2)(b) in force at 13.12.2007 for specified purposes by S.I. 2007/3396, **art. 2(k)**  
**I12** Sch. 1 para. 9(4) in force at 13.12.2007 by S.I. 2007/3396, **art. 2(j)**

SCHEDULE 2

Section 16

MINOR AND CONSEQUENTIAL AMENDMENTS

1 (1) The 1977 Act is amended as follows.

(2) In this Schedule, “the Regulatory Reform Order” means the Regulatory Reform (Patents) Order 2004.

**Commencement Information**

- I13** Sch. 2 para. 1 in force at 1.1.2005 by S.I. 2004/3205, **art. 2(k)** (with art. 9)

2 In section 1 (patentable inventions), in subsection (1)(d), after “subsections (2) and (3)” there is inserted “ or section 4A ”.

**Commencement Information**

- I14** Sch. 2 para. 2 in force at 13.12.2007 by S.I. 2007/3396, **art. 2(l)**

3 In section 2 (novelty), subsection (6) is omitted.

**Commencement Information**

- I15** Sch. 2 para. 3 in force at 13.12.2007 by S.I. 2007/3396, **art. 2(l)**

4 In section 4 (industrial application)—

- (a) in subsection (1), “Subject to subsection (2) below”, and  
 (b) subsections (2) and (3),  
 are omitted.

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**Commencement Information**

**I16** Sch. 2 para. 4 in force at 13.12.2007 by S.I. 2007/3396, art. 2(l)

- 5 In section 12 (reference before grant of foreign or convention patent of questions about entitlement etc), in subsection (6)—
- (a) in paragraph (a), after “application is withdrawn” there is inserted “ whether before or ”;
  - (b) in paragraph (c), for “but after” there is substituted “ or the ”.

**Commencement Information**

**I17** Sch. 2 para. 5 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

- 6 In section 16(1) (publication of application), after “section 22 below” there is inserted “ and to any prescribed restrictions ”.

**Commencement Information**

**I18** Sch. 2 para. 6 in force at 1.10.2005 by S.I. 2005/2471, art. 2(g)

- 7 In section 20B (inserted by the Regulatory Reform Order) (effect of reinstatement of applications), after subsection (6) there is inserted—
- “(6A) The above provisions apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to infringement of the rights conferred by publication of the application for a patent (or, as the case may be, infringement of the patent).
- “Patented invention” has the same meaning as in section 55 below.”
- 8 (1) Section 22 (information prejudicial to defence of realm or safety of public) is amended as follows.
- (2) In the heading, for “defence of realm” there is substituted “ national security ”.
  - (3) In subsections (1) and (5)(a), (c) and (d), for “the defence of the realm” there is substituted “ national security ”.
  - (4) In subsection (6)—
    - (a) in paragraph (a), for the words from “inspect and authorise” to “in connection with it” there is substituted—
      - “(i) inspect the application and any documents sent to the comptroller in connection with it;
      - (ii) authorise a government body with responsibility for the production of atomic energy or for research into matters connected with its production or use, or a person appointed by such a government body, to inspect the application and any documents sent to the comptroller in connection with it;”;
    - (b) for the words from “that Authority” to the end there is substituted “ a government body or a person appointed by a government body carries out an inspection which the body or person is authorised to carry out under

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paragraph (a) above, the body or (as the case may be) the person shall report on the inspection to the Secretary of State as soon as practicable.”

**Commencement Information**

**I19** Sch. 2 para. 8 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

9 In section 24 (publication and certificate of grant), after subsection (3) there is inserted—

“(4) Subsection (3) above shall not require the comptroller to identify as inventor a person who has waived his right to be mentioned as inventor in any patent granted for the invention.”

**Commencement Information**

**I20** Sch. 2 para. 9 in force at 1.10.2005 by S.I. 2005/2471, art. 2(g)

- 10 (1) Section 38 (effect of transfer of patent under section 37) is amended as follows.
- (2) In subsection (3), after “new proprietor or proprietors” there is inserted “ or, as the case may be, the new applicant ”.
- (3) In subsection (5), after “proprietors of the patent” there is inserted “ or, as the case may be, the new applicant ”.

**Commencement Information**

**I21** Sch. 2 para. 10 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

11 In section 41(10) (method of enforcing in Scotland certain orders made by comptroller), for “a recorded decree arbitral” there is substituted “ an extract registered decree arbitral bearing a warrant for execution issued by the sheriff court of any sheriffdom in Scotland. ”

**Commencement Information**

**I22** Sch. 2 para. 11 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

12 Section 53(1) (compulsory licences: Community Patent Convention) is omitted.

**Commencement Information**

**I23** Sch. 2 para. 12 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

13 Section 60(4) (meaning of infringement: Community Patent Convention) is omitted.

**Commencement Information**

**I24** Sch. 2 para. 13 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

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- 14 In section 61 (proceedings for infringement of patent), in subsection (4)(b), for “plaintiff” there is substituted “ claimant ”.

**Commencement Information**

**I25** Sch. 2 para. 14 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

- 15 In section 62(2) (discretion to refuse damages etc for infringement committed while fees unpaid), for “any further period specified under” there is substituted “ the further period specified in ”.

**Commencement Information**

**I26** Sch. 2 para. 15 in force at 1.10.2005 by S.I. 2005/2471, art. 2(g)

- 16 In section 63 (relief for infringement of partially valid patent), in subsection (2), for “plaintiff” there is substituted “ claimant ”.

**Commencement Information**

**I27** Sch. 2 para. 16 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

- 17 In section 70 (remedy for groundless threats of infringement proceedings), in subsection (3)(c), for “plaintiff” there is substituted “ claimant ”.

**Commencement Information**

**I28** Sch. 2 para. 17 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

- 18 In section 72(1) (power to revoke patents on application), “on the application of any person” is omitted and after the first mention of “invention” there is inserted “ on the application of any person (including the proprietor of the patent) ”.

**Commencement Information**

**I29** Sch. 2 para. 18 in force at 1.10.2005 by S.I. 2005/2471, art. 2(g)

- 19 In section 75 (amendment of patent in infringement or revocation proceedings), in subsection (1), for “is” there is substituted “ may be ”.

**Commencement Information**

**I30** Sch. 2 para. 19 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

- 20 In section 91(1) (evidence relating to the conventions: judicial notice), for “or Community patents kept under it” there is substituted “ patents kept under the European Patent Convention ”.

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**Commencement Information**

**I31** Sch. 2 para. 20 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

- 21 In section 95 (financial provision)—
- (a) in subsection (1), “the Community Patent Convention” is omitted;
  - (b) in subsection (2), for “either of those conventions” there is substituted “that convention”.

**Commencement Information**

**I32** Sch. 2 para. 21 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

- 22 In sections 103 and 105 (legal privilege), in the definition of “the relevant conventions” in subsection (2), “the Community Patent Convention” is omitted.

**Commencement Information**

**I33** Sch. 2 para. 22 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

- 23 In section 117A (inserted by the Regulatory Reform Order) (effect of resuscitating applications), after subsection (6) there is inserted—
- “(7) The above provisions apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to infringement of the rights conferred by publication of the application for a patent (or, as the case may be, infringement of the patent).

“Patented invention” has the same meaning as in section 55 above.”

- 24 (1) Section 120 (hours of business and excluded days) is amended as follows.
- (2) In subsection (1)—
- (a) for “Rules may specify” there is substituted “ The comptroller may give directions specifying ”;
  - (b) for “and may specify” there is substituted “ and the directions may specify ”.
- (3) After subsection (2) there is inserted—
- “(3) Directions under this section shall be published in the prescribed manner.”

**Commencement Information**

**I34** Sch. 2 para. 24 in force at 22.9.2004 by S.I. 2004/2177, art. 2 (with arts. 6, 8)

- 25 In section 121 (comptroller’s annual report)—
- (a) for “1st June” there is substituted “ 1st December ”;
  - (b) for “year”, in both places, there is substituted “ financial year ”;
  - (c) “the Community Patent Convention” is omitted;
  - (d) for “those conventions” there is substituted “ that convention ”.



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**Commencement Information**

**I35** Sch. 2 para. 25 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

26 (1 Section 123 (rules) is amended as follows.

(2) In subsection (2), for paragraph (i) there is substituted—

“(i) giving effect to an inventor’s rights to be mentioned conferred by section 13, and providing for an inventor’s waiver of any such right to be subject to acceptance by the comptroller;”.

(3) After that subsection there is inserted—

“(2A) The comptroller may set out in directions any forms the use of which is required by rules; and any such directions shall be published in the prescribed manner.”

(4) Subsections (4) and (5) are omitted.

**Commencement Information**

**I36** Sch. 2 para. 26(1)(3)(4) in force at 22.9.2004 by S.I. 2004/2177, art. 2 (with arts. 7, 8)

**I37** Sch. 2 para. 26(2) in force at 1.10.2005 by S.I. 2005/2471, art. 2(g)

27 In section 130(1) (interpretation)—

- (a) the definition of “Community patent” and the “and” preceding it are omitted;
- (b) in the definition of “relevant convention court”, “the Community Patent Convention” is omitted.

**Commencement Information**

**I38** Sch. 2 para. 27 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

28 In section 131 (Northern Ireland), at the end there is inserted—

“(f) any reference to a claimant includes a reference to a plaintiff.”

**Commencement Information**

**I39** Sch. 2 para. 28 in force at 1.1.2005 by S.I. 2004/3205, art. 2(k) (with art. 9)

SCHEDULE 3

Section 16

REPEALS

**Commencement Information**

**I40** Sch. 3 in force at 22.9.2004 for specified purposes by S.I. 2004/2177, art. 2

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- I41** Sch. 3 in force at 1.1.2005 for specified purposes by [S.I. 2004/3205, art. 2\(f\)](#) (with art. 9)
- I42** Sch. 3 in force at 1.10.2005 for specified purposes by [S.I. 2005/2471, art. 2\(f\)](#)
- I43** Sch. 3 in force at 13.12.2007 in so far as not already in force by [S.I. 2007/3396, art. 2\(i\)](#)

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<b><i>Short title and chapter</i></b>	<b><i>Extent of repeal</i></b>
Patents Act 1977 (c. 37)	Section 2(6). In section 4— (a) in subsection (1), the words “Subject to subsection (2) below”; (b) subsections (2) and (3). In section 41(4) and (5), the words “a patent for”. Section 53(1). Section 60(4). In section 72— (a) in subsection (1), the words “on the application of any person”; (b) in subsection (4), the words “under section 75 below”. In section 81(2), paragraph (a) and the word “that” preceding it. Sections 86 and 87. Section 89(4). In section 95(1), the words “the Community Patent Convention”. In section 103(2), in the definition of “the relevant conventions”, the words “the Community Patent Convention”. In section 105(2), in the definition of “the relevant conventions”, the words “the Community Patent Convention”. In section 106, in the heading, the words “under s. 40”. In section 121, the words “the Community Patent Convention”. In section 123, subsections (4) and (5). In section 130(1)— (a) the definition of “Community patent” and the word “and” preceding it; (b) in the definition of “relevant convention court”, the words “the Community Patent Convention”.

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