

EXPLANATORY MEMORANDUM TO
THE PATENTS (CONVENTION COUNTRIES) (AMENDMENT) ORDER 2009

2009 No. 2746

1. This explanatory memorandum has been prepared by the Intellectual Property Office (the operating name of The Patent Office), an Executive Agency of the Department for Business Innovation and Skills and is laid before Parliament by Command of her Majesty.

2. Purpose of the Instrument

2.1 This instrument declares Cape Verde to be a convention country for the purposes of the Patents Act 1977 (c.37) (“the 1977 Act”) as amended.

3. Matters of special interest to the Joint Committee on Statutory Instruments

None

4. Legislative Content

4.1 This instrument is being made under section 90(1) and section 124(3) of the 1977 Act.

4.2 The purpose of this Order is to amend the Patents (Convention Countries) Order 2007 and update the list of countries that are convention countries for the purpose of section 5 of the 1977 Act. Cape Verde is considered to be a convention country for these purposes as it is a signatory to the TRIPs Agreement.

5. Territorial Extent and Application

5.1 This instrument applies to all of the United Kingdom and to the Isle of Man. It does not apply to the Channel Islands.

5.2 Under section 132(2) of the 1977 Act, the Isle of Man is considered to be part of the United Kingdom. Patent processing for the whole of the United Kingdom, including the Isle of Man, is dealt with at the Intellectual Property Office. There are no options to consider in the Order, as it is merely a necessary change to the list of countries, but the Isle of Man was advised prior to it being made.

5.3 The 1977 Act does not extend to the Channel Islands as they have their own legislation on this subject.

6. European Convention of Human Rights

As this instrument is subject to the negative resolution procedure and does not amend primary legislation, no statement is required.

7. Policy background

7.1 For a patent applicant the first filing date is crucial and under the Paris Convention and/or the Agreement establishing The World Trade Organisation (“WTO”) (including TRIPs), a UK applicant is able to rely on a patent application made within a member State of the same convention.

7.2 This automatic right reduces the burden on applicants as it gives them a year to decide whether to file further applications as it guarantees the first filing date.

7.3 Cape Verde became a member of the WTO on 23rd July 2008. This instrument amends the Patents (Convention Countries) Order 2007 to include Cape Verde.

Consolidation

7.4 The instruments are constantly reviewed and can be amended during the common commencement dates in April and October. On this occasion only minor amendments have been made to them. This is the first amendment and so it is not necessary to consolidate at this stage. An informal consolidation will, however be available on the website of the Intellectual Property Office.

8. Consultation outcome

8.1 The Department has not consulted the public on this Order. This is because the changes made by this Instrument are a requirement of the United Kingdom’s existing international obligations.

9. Guidance

9.1 The amending Order will be published on the Intellectual Property Office website alongside the existing Orders once approved by Privy Council.

10. Impact

10.1 An Impact Assessment has not been prepared as this Instrument has no impact on the private, voluntary or public sectors.

11. Regulating small business

11.1 The legislation does not apply to small business and has no direct impact on UK business.

11.2 There is no need to minimise the impact of the requirements on small firms employing up to 20 people because the changes confirm the one year first filing protection for patent applicants in the UK that they are already aware of.

12. Monitoring & Review

12.1 We now meet our international obligation to grant reciprocity for first filing date for Patent applicants.

12.2 The review and updating of our Orders in Council to grant this reciprocity to new accession States is continuous.

13. Contact

Helen James at the Intellectual Property Office (the operating name of The Patent Office), an executive agency of the Department of Business, Innovation and Skills can answer any queries regarding the instrument.

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