



Patents Act 1977

1977 CHAPTER 37

PART I

NEW DOMESTIC LAW

Right to apply for and obtain a patent and be mentioned as inventor

8 Determination before grant of questions about entitlement to patents, etc.

- (1) At any time before a patent has been granted for an invention (whether or not an application has been made for it)—
- (a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or
 - (b) any of two or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;
- and the comptroller shall determine the question and may make such order as he thinks fit to give effect to the determination.
- (2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below,—
- (a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;
 - (b) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly;

Status: This is the original version (as it was originally enacted).

- (c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred;
 - (d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.
- (3) Where a question is referred to the comptroller under subsection (1)(a) above and—
- (a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;
 - (b) any such application is refused under subsection 2(c) above before the comptroller has disposed of the reference (whether the reference was made before or after the publication of the application); or
 - (c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference, but after the publication of the application;
- the comptroller may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 76 below, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.
- (4) Where a person refers a question under subsection (1)(b) above relating to an application, any order under subsection (1) above may contain directions to any person for transferring or granting any right in or under the application.
- (5) If any person to whom directions have been given under subsection (2)(d) or (4) above fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the comptroller may, on application made to him by any person in whose favour or on whose reference the directions were given, authorise him to do that thing on behalf of the person to whom the directions were given.
- (6) Where on a reference under this section it is alleged that, by virtue of any transaction, instrument or event relating to an invention or an application for a patent, any person other than the inventor or the applicant for the patent has become entitled to be granted (whether alone or with any other persons) a patent for the invention or has or would have any right in or under any patent so granted or any application for any such patent, an order shall not be made under subsection (2)(a), (b) or (d) above on the reference unless notice of the reference is given to the applicant and any such person, except any of them who is a party to the reference.
- (7) If it appears to the comptroller on a reference of a question under this section that the question involves matters which would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so.
- (8) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.