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**Changes to legislation:** There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, Cross Heading: Effect of filing international application for patent. (See end of Document for details)

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## SCHEDULES

### SCHEDULE 5

#### PATENTS: MISCELLANEOUS AMENDMENTS

##### *Effect of filing international application for patent*

- 24 (1) Section 89 of the Patents Act 1977 (effect of filing international application for patent) is amended as follows.
- (2) After subsection (3) insert—
- “(3A) If the relevant conditions are satisfied with respect to an application which is amended in accordance with the Treaty and the relevant conditions are not satisfied with respect to any amendment, that amendment shall be disregarded.”.
- (3) After subsection (4) insert—
- “(4A) In subsection (4)(a) “a copy of the application” includes a copy of the application published in accordance with the Treaty in a language other than that in which it was filed.”.
- (4) For subsection (10) (exclusion of certain applications subject to European Patent Convention) substitute—
- “(10) The foregoing provisions of this section do not apply to an application which falls to be treated as an international application for a patent (UK) by reason only of its containing an indication that the applicant wishes to obtain a European patent (UK); but without prejudice to the application of those provisions to an application which also separately designates the United Kingdom.”.
- (5) The amendments in this paragraph shall be deemed always to have had effect.
- (6) This paragraph shall be repealed by the order bringing the following paragraph into force.
- 25 For section 89 of the <sup>M1</sup>Patents Act 1977 (effect of filing international application for patent) substitute—

##### **“89 Effect of international application for patent.**

- (1) An international application for a patent (UK) for which a date of filing has been accorded under the Patent Co-operation Treaty shall, subject to—  
section 89A (international and national phases of application), and  
section 89B (adaptation of provisions in relation to international application),

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be treated for the purposes of Parts I and III of this Act as an application for a patent under this Act.

- (2) If the application, or the designation of the United Kingdom in it, is withdrawn or (except as mentioned in subsection (3)) deemed to be withdrawn under the Treaty, it shall be treated as withdrawn under this Act.
- (3) An application shall not be treated as withdrawn under this Act if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Treaty—
  - (a) because of an error or omission in an institution having functions under the Treaty, or
  - (b) because, owing to circumstances outside the applicant's control, a copy of the application was not received by the International Bureau before the end of the time limited for that purpose under the Treaty, or in such other circumstances as may be prescribed.
- (4) For the purposes of the above provisions an application shall not be treated as an international application for a patent (UK) by reason only of its containing an indication that the applicant wishes to obtain a European patent (UK), but an application shall be so treated if it also separately designates the United Kingdom.
- (5) If an international application for a patent which designates the United Kingdom is refused a filing date under the Treaty and the comptroller determines that the refusal was caused by an error or omission in an institution having functions under the Treaty, he may direct that the application shall be treated as an application under this Act, having such date of filing as he may direct.

#### **89A International and national phases of application.**

- (1) The provisions of the Patent Co-operation Treaty relating to publication, search, examination and amendment, and not those of this Act, apply to an international application for a patent (UK) during the international phase of the application.
- (2) The international phase of the application means the period from the filing of the application in accordance with the Treaty until the national phase of the application begins.
- (3) The national phase of the application begins—
  - (a) when the prescribed period expires, provided any necessary translation of the application into English has been filed at the Patent Office and the prescribed fee has been paid by the applicant; or
  - (b) on the applicant expressly requesting the comptroller to proceed earlier with the national phase of the application, filing at the Patent Office—
    - (i) a copy of the application, if none has yet been sent to the Patent Office in accordance with the Treaty, and
    - (ii) any necessary translation of the application into English, and paying the prescribed fee.

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For this purpose a “copy of the application” includes a copy published in accordance with the Treaty in a language other than that in which it was originally filed.

- (4) If the prescribed period expires without the conditions mentioned in subsection (3)(a) being satisfied, the application shall be taken to be withdrawn.
- (5) Where during the international phase the application is amended in accordance with the Treaty, the amendment shall be treated as made under this Act if—
  - (a) when the prescribed period expires, any necessary translation of the amendment into English has been filed at the Patent Office, or
  - (b) where the applicant expressly requests the comptroller to proceed earlier with the national phase of the application, there is then filed at the Patent Office—
    - (i) a copy of the amendment, if none has yet been sent to the Patent Office in accordance with the Treaty, and
    - (ii) any necessary translation of the amendment into English;otherwise the amendment shall be disregarded.
- (6) The comptroller shall on payment of the prescribed fee publish any translation filed at the Patent Office under subsection (3) or (5) above.

#### **89B Adaptation of provisions in relation to international application.**

- (1) Where an international application for a patent (UK) is accorded a filing date under the Patent Co-operation Treaty—
  - (a) that date, or if the application is re-dated under the Treaty to a later date that later date, shall be treated as the date of filing the application under this Act,
  - (b) any declaration of priority made under the Treaty shall be treated as made under section 5(2) above, and where in accordance with the Treaty any extra days are allowed, the period of 12 months specified in section 5(2) shall be treated as altered accordingly, and
  - (c) any statement of the name of the inventor under the Treaty shall be treated as a statement filed under section 13(2) above.
- (2) If the application, not having been published under this Act, is published in accordance with the Treaty it shall be treated, for purposes other than those mentioned in subsection (3), as published under section 16 above when the conditions mentioned in section 89A(3)(a) are complied with.
- (3) For the purposes of section 55 (use of invention for service of the Crown) and section 69 (infringement of rights conferred by publication) the application, not having been published under this Act, shall be treated as published under section 16 above—
  - (a) if it is published in accordance with the Treaty in English, on its being so published; and
  - (b) if it is so published in a language other than English—
    - (i) on the publication of a translation of the application in accordance with section 89A(6) above, or

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- (ii) on the service by the applicant of a translation into English of the specification of the application on the government department concerned or, as the case may be, on the person committing the infringing act.

The reference in paragraph (b)(ii) to the service of a translation on a government department or other person is to its being sent by post or delivered to that department or person.

- (4) During the international phase of the application, section 8 above does not apply (determination of questions of entitlement in relation to application under this Act) and section 12 above (determination of entitlement in relation to foreign and convention patents) applies notwithstanding the application; but after the end of the international phase, section 8 applies and section 12 does not.
- (5) When the national phase begins the comptroller shall refer the application for so much of the examination and search under section 17 and 18 above as he considers appropriate in view of any examination or search carried out under the Treaty.”

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**Marginal Citations**

**M1** 1977 c. 37.

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