SCHEDULES

SCHEDULE 5 U.K.

Section 295.

PATENTS: MISCELLANEOUS AMENDMENTS

Withdrawal of application before publication of specification

1 In section 13(2) of the [M1]Patents Act 1949 (duty of comptroller to advertise acceptance of and publish complete specification) after the word "and", in the first place where it occurs, insert ", unless the application is withdrawn,".

Marginal Citations
M1 1949 c. 87.

Correction of clerical errors

2 (1) In section 15 of the [M2]Patents Act 1977 (filing of application), after subsection (3) insert—

"(3A) Nothing in subsection (2) or (3) above shall be construed as affecting the power of the comptroller under section 117(1) below to correct errors or mistakes with respect to the filing of drawings.".

(2) The above amendment applies only in relation to applications filed after the commencement of this paragraph.

Marginal Citations
M2 1977 c. 37.

Supplementary searches

3 (1) Section 17 of the Patents Act 1977 (preliminary examination and search) is amended as follows.

(2) In subsection (7) (supplementary searches) for "subsection (4) above" substitute "subsections (4) and (5) above" and for "it applies" substitute "they apply".

(3) After that subsection add—

"(8) A reference for a supplementary search in consequence of—

(a) an amendment of the application made by the applicant under section 18(3) or 19(1) below, or

(b) a correction of the application, or of a document filed in connection with the application, under section 117 below,

Changes to legislation: *There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5. (See end of Document for details)*

shall be made only on payment of the prescribed fee, unless the comptroller directs otherwise.”.

4 In section 18 of the Patents Act 1977 (substantive examination and grant or refusal of patent), after subsection (1) insert—

“(1A) If the examiner forms the view that a supplementary search under section 17 above is required for which a fee is payable, he shall inform the comptroller, who may decide that the substantive examination should not proceed until the fee is paid; and if he so decides, then unless within such period as he may allow—

(a) the fee is paid, or

(b) the application is amended so as to render the supplementary search unnecessary,

he may refuse the application.”.

5 In section 130(1) of the Patents Act 1977 (interpretation), in the definition of “search fee”, for “section 17 above” substitute “section 17(1) above”.

Application for restoration of lapsed patent

6 (1) Section 28 of the Patents Act 1977 (restoration of lapsed patents) is amended as follows.

(2) For subsection (1) (application for restoration within period of one year) substitute—

“(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the comptroller within the prescribed period.

(1A) Rules prescribing that period may contain such transitional provisions and savings as appear to the Secretary of State to be necessary or expedient.”.

(3) After subsection (2) insert—

“(2A) Notice of the application shall be published by the comptroller in the prescribed manner.”.

(4) In subsection (3), omit paragraph (b) (requirement that failure to renew is due to circumstances beyond proprietor’s control) and the word “and” preceding it.

This amendment does not apply to a patent which has ceased to have effect in accordance with section 25(3) of the [M3]Patents Act 1977 (failure to renew within prescribed period) and in respect of which the period referred to in subsection (4) of that section (six months’ period of grace for renewal) has expired before commencement.

(5) Omit subsections (5) to (9) (effect of order for restoration).

Marginal Citations

M3 1977 c. 37.

7 After that section insert—

"**28A Effect of order for restoration of patent.**

(1) The effect of an order for the restoration of a patent is as follows.

(2) Anything done under or in relation to the patent during the period between expiry and restoration shall be treated as valid.

(3) Anything done during that period which would have constituted an infringement if the patent had not expired shall be treated as an infringement—

(a) if done at a time when it was possible for the patent to be renewed under section 25(4), or

(b) if it was a continuation or repetition of an earlier infringing act.

(4) If after it was no longer possible for the patent to be so renewed, and before publication of notice of the application for restoration, a person—

(a) began in good faith to do an act which would have constituted an infringement of the patent if it had not expired, or

(b) made in good faith effective and serious preparations to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the patent; but this right does not extend to granting a licence to another person to do the act.

(5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (4) may—

(a) authorise the doing of that act by any partners of his for the time being in that business, and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(6) Where a product is disposed of to another in exercise of the rights conferred by subsection (4) or (5), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

(7) The above provisions apply in relation to the use of a patent for the services of the Crown as they apply in relation to infringement of the patent.".

8 In consequence of the above amendments—

(a) in section 60(6)(b) of the [M4]Patents Act 1977, for "section 28(6)" substitute "section 28A(4) or (5)"; and

(b) in sections 77(5), 78(6) and 80(4) of that Act, for the words from "section 28(6)" to the end substitute "section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly.".

Marginal Citations

M4 1977 c. 37.

Changes to legislation: *There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5. (See end of Document for details)*

Determination of right to patent after grant

9 (1) Section 37 of the Patents Act 1977 (determination of right to patent after grant) is amended as follows.

(2) For subsection (1) substitute—

"(1) After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question—

(a) who is or are the true proprietor or proprietors of the patent,

(b) whether the patent should have been granted to the person or persons to whom it was granted, or

(c) whether any right in or under the patent should be transferred or granted to any other person or persons;

and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.".

(3) Substitute "this section"—

(a) in subsections (4) and (7) for "subsection (1)(a) above", and

(b) in subsection (8) for "subsection (1) above".

10 In section 74(6) (meaning of "entitlement proceedings"), for "section 37(1)(a) above" substitute "section 37(1) above".

Employees' inventions

11 (1) In section 39 of the Patents Act 1977 (right to employees' inventions), after subsection (2) add—

"(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

(a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or

(b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.".

(2) In section 43 of the [M5]Patents Act 1977 (supplementary provisions with respect to employees' inventions), in subsection (4) (references to patents to include other forms of protection, whether in UK or elsewhere) for "in sections 40 to 42" substitute "in sections 39 to 42.".

Marginal Citations

M5 1977 c. 37.

Undertaking to take licence in infringement proceedings

12 (1) Section 46 of the Patents Act 1977 (licences of right) is amended as follows.

(2) In subsection (3)(c) (undertaking to take licence in infringement proceedings) after the words "(otherwise than by the importation of any article" insert "from a country which is not a member State of the European Economic Community".

(3) After subsection (3) insert—

"(3A) An undertaking under subsection (3)(c) above may be given at any time before final order in the proceedings, without any admission of liability.".

Power of comptroller on grant of compulsory licence

13 In section 49 of the Patents Act 1977 (supplementary provisions with respect to compulsory licences), omit subsection (3) (power to order that licence has effect to revoke existing licences and deprive proprietor of power to work invention or grant licences).

Powers exercisable in consequence of report of Monopolies and Mergers Commission

14 For section 51 of the Patents Act 1977 (licences of right: application by Crown in consequence of report of Monopolies and Mergers Commission) substitute—

"**51 Powers exercisable in consequence of report of Monopolies and Mergers Commission.**

(1) Where a report of the Monopolies and Mergers Commission has been laid before Parliament containing conclusions to the effect—

(a) on a monopoly reference, that a monopoly situation exists and facts found by the Commission operate or may be expected to operate against the public interest,

(b) on a merger reference, that a merger situation qualifying for investigation has been created and the creation of the situation, or particular elements in or consequences of it specified in the report, operate or may be expected to operate against the public interest,

(c) on a competition reference, that a person was engaged in an anti-competitive practice which operated or may be expected to operate against the public interest, or

(d) on a reference under section 11 of the Competition Act 1980 (reference of public bodies and certain other persons), that a person is pursuing a course of conduct which operates against the public interest,

the appropriate Minister or Ministers may apply to the comptroller to take action under this section.

(2) Before making an application the appropriate Minister or Ministers shall publish, in such manner as he or they think appropriate, a notice describing the nature of the proposed application and shall consider any representations which may be made within 30 days of such publication by persons whose interests appear to him or them to be affected.

(3) If on an application under this section it appears to the comptroller that the matters specified in the Commission's report as being those which in the Commission's opinion operate, or operated or may be expected to operate, against the public interest include—

Changes to legislation: *There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5. (See end of Document for details)*

(a) conditions in licences granted under a patent by its proprietor restricting the use of the invention by the licensee or the right of the proprietor to grant other licences, or

(b) a refusal by the proprietor of a patent to grant licences on reasonable terms

he may by order cancel or modify any such condition or may, instead or in addition, make an entry in the register to the effect that licences under the patent are to be available as of right.

(4) In this section "the appropriate Minister or Ministers" means the Minister or Ministers to whom the report of the Commission was made.".

Compulsory licensing: reliance on statements in competition report

15 In section 53(2) of the [M6]Patents Act 1977 (compulsory licensing: reliance on statements in reports of Monopolies and Mergers Commission)—

(a) for "application made in relation to a patent under sections 48 to 51 above" substitute "application made under section 48 above in respect of a patent"; and

(b) after "Part VIII of the Fair Trading Act 1973" insert "or section 17 of the Competition Act 1980".

Marginal Citations

M6 1977 c. 37.

Crown use: compensation for loss of profit

16 (1) In the Patents Act 1977, after section 57 insert—

"**57A Compensation for loss of profit.**

(1) Where use is made of an invention for the services of the Crown, the government department concerned shall pay—

(a) to the proprietor of the patent, or

(b) if there is an exclusive licence in force in respect of the patent, to the exclusive licensee,

compensation for any loss resulting from his not being awarded a contract to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process.

(2) Compensation is payable only to the extent that such a contract could have been fulfilled from his existing manufacturing or other capacity; but is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract.

(3) In determining the loss, regard shall be had to the profit which would have been made on such a contract and to the extent to which any manufacturing or other capacity was under-used.

(4) No compensation is payable in respect of any failure to secure contracts to supply the patented product or, as the case may be, to perform the patented

process or supply a thing made by means of the patented process, otherwise than for the services of the Crown.

(5) The amount payable shall, if not agreed between the proprietor or licensee and the government department concerned with the approval of the Treasury, be determined by the court on a reference under section 58, and is in addition to any amount payable under section 55 or 57.

(6) In this section "the government department concerned", in relation to any use of an invention for the services of the Crown, means the government department by whom or on whose authority the use was made.

(7) In the application of this section to Northern Ireland, the reference in subsection (5) above to the Treasury shall, where the government department concerned is a department of the Government of Northern Ireland, be construed as a reference to the Department of Finance and Personnel.".

(2) In section 58 of the [M7]Patents Act 1977 (reference of disputes as to Crown use), for subsection (1) substitute—

"(1) Any dispute as to—

(a) the exercise by a government department, or a person authorised by a government department, of the powers conferred by section 55 above,

(b) terms for the use of an invention for the services of the Crown under that section,

(c) the right of any person to receive any part of a payment made in pursuance of subsection (4) of that section, or

(d) the right of any person to receive a payment under section 57A,

may be referred to the court by either party to the dispute after a patent has been granted for the invention.";

and in subsection (4) for "under this section" substitute "under subsection (1)(a), (b) or (c) above".

(3) In section 58(11) of the Patents Act 1977 (exclusion of right to compensation for Crown use if relevant transaction, instrument or event not registered), after "section 57(3) above)" insert ", or to any compensation under section 57A above,".

(4) The above amendments apply in relation to any use of an invention for the services of the Crown after the commencement of this section, even if the terms for such use were settled before commencement.

Marginal Citations

M7 1977 c. 37.

Right to continue use begun before priority date

17 For section 64 of the Patents Act 1977 (right to continue use begun before priority date) substitute—

Changes to legislation: *There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5. (See end of Document for details)*

"**64 Right to continue use begun before priority date.**

(1) Where a patent is granted for an invention, a person who in the United Kingdom before the priority date of the invention—

(a) does in good faith an act which would constitute an infringement of the patent if it were in force, or

(b) makes in good faith effective and serious preparations to do such an act,

has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent; but this right does not extend to granting a licence to another person to do the act.

(2) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (1) may—

(a) authorise the doing of that act by any partners of his for the time being in that business, and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(3) Where a product is disposed of to another in exercise of the rights conferred by subsection (1) or (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.".

Revocation on grounds of grant to wrong person

18 In section 72(1) of the [M8]Patents Act 1977 (grounds for revocation of patent), for paragraph (b) substitute—

"(b) that the patent was granted to a person who was not entitled to be granted that patent;".

Marginal Citations

M8 1977 c. 37.

Revocation where two patents granted for same invention

19 In section 73 of the Patents Act 1977 (revocation on initiative of comptroller), for subsections (2) and (3) (revocation of patent where European patent (UK) granted in respect of same invention) substitute—

"(2) If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend

the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent.

(3) The comptroller shall not take action under subsection (2) above before—

(a) the end of the period for filing an opposition to the European patent (UK) under the European Patent Convention, or

(b) if later, the date on which opposition proceedings are finally disposed of;

and he shall not then take any action if the decision is not to maintain the European patent or if it is amended so that there are not two patents in respect of the same invention.

(4) The comptroller shall not take action under subsection (2) above if the European patent (UK) has been surrendered under section 29(1) above before the date on which by virtue of section 25(1) above the patent under this Act is to be treated as having been granted or, if proceedings for the surrender of the European patent (UK) have been begun before that date, until those proceedings are finally disposed of; and he shall not then take any action if the decision is to accept the surrender of the European patent.”.

Applications and amendments not to include additional matter

20 For section 76 of the [M9]Patents Act 1977 (amendments of applications and patents not to include added matter) substitute—

“**76 Amendments of applications and patents not to include added matter.**

(1) An application for a patent which—

(a) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted, and

(b) discloses additional matter, that is, matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed,

may be filed under section 8(3), 12 or 37(4) above, or as mentioned in section 15(4) above, but shall not be allowed to proceed unless it is amended so as to exclude the additional matter.

(2) No amendment of an application for a patent shall be allowed under section 17(3), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

(3) No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it—

(a) results in the specification disclosing additional matter, or

(b) extends the protection conferred by the patent.”.

Marginal Citations

M9 1977 c. 37.

Changes to legislation: *There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5. (See end of Document for details)*

Effect of European patent (UK)

21 (1) Section 77 of the Patents Act 1977 (effect of European patent (UK)) is amended as follows.

(2) For subsection (3) (effect of finding of partial validity on pending proceedings) substitute—

"(3) Where in the case of a European patent (UK)—

(a) proceedings for infringement, or proceedings under section 58 above, have been commenced before the court or the comptroller and have not been finally disposed of, and

(b) it is established in proceedings before the European Patent Office that the patent is only partially valid,

the provisions of section 63 or, as the case may be, of subsections (7) to (9) of section 58 apply as they 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.".

(3) For subsection (4) (effect of amendment or revocation under European Patent Convention) substitute—

"(4) Where a European patent (UK) is amended in accordance with the European Patent Convention, the amendment shall have effect for the purposes of Parts I and III of this Act as if the specification of the patent had been amended under this Act; but subject to subsection (6)(b) below.

(4A) Where a European patent (UK) is revoked in accordance with the European Patent Convention, the patent shall be treated for the purposes of Parts I and III of this Act as having been revoked under this Act.".

(4) In subsection (6) (filing of English translation), in paragraph (b) (amendments) for "a translation of the amendment into English" substitute "a translation into English of the specification as amended".

(5) In subsection (7) (effect of failure to file translation) for the words from "a translation" to "above" substitute "such a translation is not filed".

The state of the art: material contained in patent applications

22 In section 78 of the [M10]Patents Act 1977 (effect of filing an application for a European patent (UK)), for subsection (5) (effect of withdrawal of application, &c.) substitute—

"(5) Subsections (1) to (3) above shall cease to apply to an application for a European patent (UK), except as mentioned in subsection (5A) below, if—

(a) the application is refused or withdrawn or deemed to be withdrawn, or

(b) the designation of the United Kingdom in the application is withdrawn or deemed to be withdrawn,

but shall apply again if the rights of the applicant are re-established under the European Patent Convention, as from their re-establishment.

(5A) The occurrence of any of the events mentioned in subsection (5)(a) or (b) shall not affect the continued operation of section 2(3) above in relation to

matter contained in an application for a European patent (UK) which by virtue of that provision has become part of the state of the art as regards other inventions.”.

Marginal Citations

M10 1977 c. 37.

Jurisdiction in certain proceedings

23 Section 88 of the Patents Act 1977 (jurisdiction in legal proceedings in connection with Community Patent Convention) is repealed.

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 [M11]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

Changes to legislation: *There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5. (See end of Document for details)*

section 89B (adaptation of provisions in relation to international application),

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.

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—

Changes to legislation: *There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5. (See end of Document for details)*

(i) on the publication of a translation of the application in accordance with section 89A(6) above, or

(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.”.

Marginal Citations

M11 1977 c. 37.

Proceedings before the court or the comptroller

26 In the [M12]Patents Act 1977, after section 99 (general powers of the court) insert—

“**99A Power of Patents Court to order report.**

(1) Rules of court shall make provision empowering the Patents Court in any proceedings before it under this Act, on or without the application of any party, to order the Patent Office to inquire into and report on any question of fact or opinion.

(2) Where the court makes such an order on the application of a party, the fee payable to the Patent Office shall be at such rate as may be determined in accordance with rules of court and shall be costs of the proceedings unless otherwise ordered by the court.

(3) Where the court makes such an order of its own motion, the fee payable to the Patent Office shall be at such rate as may be determined by the Lord Chancellor with the approval of the Treasury and shall be paid out of money provided by Parliament.

99B Power of Court of Session to order report.

(1) In any proceedings before the Court of Session under this Act the court may, either of its own volition or on the application of any party, order the Patent Office to inquire into and report on any question of fact or opinion.

(2) Where the court makes an order under subsection (1) above of its own volition the fee payable to the Patent Office shall be at such rate as may be determined by the Lord President of the Court of Session with the consent of the Treasury and shall be defrayed out of moneys provided by Parliament.

(3) Where the court makes an order under subsection (1) above on the application of a party, the fee payable to the Patent Office shall be at such rate as may be provided for in rules of court and shall be treated as expenses in the cause.”.

Marginal Citations
M12 1977 c. 37.

27 For section 102 of the [M13]Patents Act 1977 (right of audience in patent proceedings) substitute—

“**102 Right of audience, &c. in proceedings before comptroller.**

(1) A party to proceedings before the comptroller under this Act, or under any treaty or international convention to which the United Kingdom is a party, may appear before the comptroller in person or be represented by any person whom he desires to represent him.

(2) No offence is committed under the enactments relating to the preparation of documents by persons not legally qualified by reason only of the preparation by any person of a document, other than a deed, for use in such proceedings.

(3) Subsection (1) has effect subject to rules made under section 281 of the Copyright, Designs and Patents Act 1988 (power of comptroller to refuse to recognise certain agents).

(4) In its application to proceedings in relation to applications for, or otherwise in connection with, European patents, this section has effect subject to any restrictions imposed by or under the European Patent Convention.

102A Right of audience, &c. in proceedings on appeal from the comptroller.

(1) A solicitor of the Supreme Court may appear and be heard on behalf of any party to an appeal under this Act from the comptroller to the Patents Court.

(2) A registered patent agent or a member of the Bar not in actual practice may do, in or in connection with proceedings on an appeal under this Act from the comptroller to the Patents Court, anything which a solicitor of the Supreme Court might do, other than prepare a deed.

(3) The Lord Chancellor may by regulations—

(a) provide that the right conferred by subsection (2) shall be subject to such conditions and restrictions as appear to the Lord Chancellor to be necessary or expedient, and

(b) apply to persons exercising that right such statutory provisions, rules of court and other rules of law and practice applying to solicitors as may be specified in the regulations;

Changes to legislation: *There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5. (See end of Document for details)*

and different provision may be made for different descriptions of proceedings.

(4) Regulations under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

(5) This section is without prejudice to the right of counsel to appear before the High Court.".

Marginal Citations
M13 1977 c. 37.

Provision of information

28 In section 118 of the [M14]Patents Act 1977 (information about patent applications, &c.), in subsection (3) (restriction on disclosure before publication of application: exceptions) for "section 22(6)(a) above" substitute "section 22(6) above".

Marginal Citations
M14 1977 c. 37.

Power to extend time limits

29 In section 123 of the Patents Act 1977 (rules), after subsection (3) insert—

"(3A) It is hereby declared that rules—

(a) authorising the rectification of irregularities of procedure, or

(b) providing for the alteration of any period of time,

may authorise the comptroller to extend or further extend any period notwithstanding that the period has already expired.".

Availability of samples of micro-organisms

30 In the Patents Act 1977 after section 125 insert—

"**125A Disclosure of invention by specification: availability of samples of micro-organisms.**

(1) Provision may be made by rules prescribing the circumstances in which the specification of an application for a patent, or of a patent, for an invention which requires for its performance the use of a micro-organism is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(2) The rules may in particular require the applicant or patentee—

(a) to take such steps as may be prescribed for the purposes of making available to the public samples of the micro-organism, and

(b) not to impose or maintain restrictions on the uses to which such samples may be put, except as may be prescribed.

(3) The rules may provide that, in such cases as may be prescribed, samples need only be made available to such persons or descriptions of persons as may be prescribed; and the rules may identify a description of persons by reference to whether the comptroller has given his certificate as to any matter.

(4) An application for revocation of the patent under section 72(1)(c) above may be made if any of the requirements of the rules cease to be complied with.”.

Changes to legislation:
There are currently no known outstanding effects for the Copyright, Designs and Patents Act 1988, SCHEDULE 5.