



# Patents Act 1977

## 1977 CHAPTER 37

### PART I

#### NEW DOMESTIC LAW

##### *Examination and search*

#### 17 [F<sup>1</sup>Search.]

[F<sup>2</sup>(1) The comptroller shall refer an application for a patent to an examiner for a search if, and only if—

- (a) the comptroller has referred the application to an examiner for a preliminary examination under section 15A(1) above;
- (b) the application has not been withdrawn or treated as withdrawn;
- (c) before the end of the prescribed period—
  - (i) the applicant makes a request to the Patent Office in the prescribed form for a search; and
  - (ii) the fee prescribed for the search (“the search fee”) is paid;
- (d) the application includes—
  - (i) a description of the invention for which a patent is sought; and
  - (ii) one or more claims; and
- (e) the description and each of the claims comply with the requirements of rules as to language.]

(2) [F<sup>3</sup>On a preliminary examination of an application the examiner shall determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act and shall report his determination to the comptroller.]

(3) [F<sup>3</sup>If it is reported to the comptroller under subsection (2) above that not all the formal requirements are complied with, he shall give the applicant an opportunity to make observations on the report and to amend the application within a specified period (subject to section 15(5) above) so as to comply with those requirements (subject,

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however, to section 76 below), and if the applicant fails to do so the comptroller may refuse the application. ]

(4) Subject to subsections (5) and (6) below, on a search requested under this section, the examiner shall make such investigation as in his opinion is reasonably practicable and necessary for him to identify the documents which he thinks will be needed to decide, on a substantive examination under section 18 below, whether the invention for which a patent is sought is new and involves an inventive step.

(5) On any such search the examiner shall determine whether or not the search would serve any useful purpose on the application as for the time being constituted and—

(a) if he determines that it would serve such a purpose in relation to the whole or part of the application, he shall proceed to conduct the search so far as it would serve such a purpose and shall report on the results of the search to the comptroller; and

(b) if he determines that the search would not serve such a purpose in relation to the whole or part of the application, he shall report accordingly to the comptroller;

and in either event the applicant shall be informed of the examiner's report.

(6) If it appears to the examiner, either before or on conducting a search under this section, that an application relates to two or more inventions, but that they are not so linked as to form a single inventive concept, he shall initially only conduct a search in relation to the first invention specified in the claims of the application, but may proceed to conduct a search in relation to another invention so specified if the applicant pays the search fee in respect of the application so far as it relates to that other invention.

(7) After a search has been requested under this section for an application the comptroller may at any time refer the application to an examiner for a supplementary search, and [<sup>F4</sup>subsections (4) and (5) above] shall apply in relation to a supplementary search as [<sup>F4</sup>they apply] in relation to any other search under this section.

[<sup>F5</sup>(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,

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

#### Textual Amendments

**F1** S. 17 heading substituted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), **6(2)** (with arts. 20-23)

**F2** S. 17(1) substituted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), **6(3)** (with arts. 20-23)

**F3** S. 17(2)(3) ceased to have effect (1.1.2005) by virtue of [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), **6(4)** (with arts. 20-23)

**F4** Words substituted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 3(2)**

**F5** S. 17(8) added by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para. 3(3)**

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## 18 Substantive examination and grant or refusal of patent.

(1) Where the conditions imposed by section 17(1) above for the comptroller to refer an application to an examiner for a <sup>F6</sup>... search are satisfied and at the time of the request under that subsection or within the prescribed period—

- (a) a request is made by the applicant to the Patent Office in the prescribed form for a substantive examination; and
- (b) the prescribed fee is paid for the examination;

the comptroller shall refer the application to an examiner for a substantive examination; and if no such request is made or the prescribed fee is not paid within that period, the application shall be treated as having been withdrawn at the end of that period.

[<sup>F7</sup>(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.]

(2) On a substantive examination of an application the examiner shall investigate, to such extent as he considers necessary in view of any examination [<sup>F8</sup>carried out under section 15A above] and search carried out under section 17 above, whether the application complies with the requirements of this Act and the rules and shall determine that question and report his determination to the comptroller.

(3) If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.

(4) If the examiner reports that the application, whether as originally filed or as amended in pursuance of [<sup>F9</sup>section 15A] above, this section or section 19 below, complies with those requirements at any time before the end of the prescribed period, the comptroller shall notify the applicant of that fact and, subject to subsection (5) and sections 19 and 22 below and on payment within the prescribed period of any fee prescribed for the grant, grant him a patent.

(5) Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

### Textual Amendments

**F6** Words in s. 18(1) omitted (1.1.2005) by virtue of [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), 7(2) (with arts. 20-23)

**F7** S. 18(1A) inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 295, **Sch. 5 para.**

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- F8** Words in s. 18(2) inserted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), 7(3) (with arts. 20-23)
- F9** Words in s. 18(4) substituted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), 7(4) (with arts. 20-23)

## 19 General power to amend application before grant.

- (1) At any time before a patent is granted in pursuance of an application the applicant may, in accordance with the prescribed conditions and subject to section 76 below, amend the application of his own volition.
- (2) The comptroller may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a patent so as to acknowledge a registered trade mark.

### Modifications etc. (not altering text)

- C1** S. 19(2) extended by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 67A\)](#) s. 2(3), Sch. 2 Pt. I para. 1(2)(e)(i)
- S. 19(2) amended (31.10.1994) by [1994 c. 26, s. 106\(1\)](#), [Sch. 4 para. 1\(2\)](#); [S.I. 1994/2550, art. 2](#)

## 20 Failure of application.

- (1) If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.
- (2) If at the end of that period an appeal to the court is pending in respect of the application or the time within which such an appeal could be brought has not expired, that period—
  - (a) where such an appeal is pending, or is brought within the said time or before the expiration of any extension of that time granted (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, shall be extended until such date as the court may determine;
  - (b) where no such appeal is pending or is so brought, shall continue until the end of the said time or, if any extension of that time is so granted, until the expiration of the extension or last extension so granted.

## <sup>F10</sup>20A Reinstatement of applications

- (1) Subsection (2) below applies where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is—
  - (a) set out in this Act or rules, or
  - (b) specified by the comptroller.
- (2) Subject to subsection (3) below, the comptroller shall reinstate the application if, and only if—
  - (a) the applicant requests him to do so;

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- (b) the request complies with the relevant requirements of rules; and
  - (c) he is satisfied that the failure to comply referred to in subsection (1) above was unintentional.
- (3) The comptroller shall not reinstate the application if—
- (a) an extension remains available under this Act or rules for the period referred to in subsection (1) above; or
  - (b) the period referred to in subsection (1) above is set out or specified—
    - (i) in relation to any proceedings before the comptroller;
    - (ii) for the purposes of section 5(2A)(b) above; or
    - (iii) for the purposes of a request under this section or section 117B below.
- (4) Where the application was made by two or more persons jointly, a request under subsection (2) above may, with the leave of the comptroller, be made by one or more of those persons without joining the others.
- (5) If the application has been published under section 16 above, then the comptroller shall publish notice of a request under subsection (2) above in the prescribed manner.
- (6) The reinstatement of an application under this section shall be by order.
- (7) If an application is reinstated under this section the applicant shall comply with the requirement referred to in subsection (1) above within the further period specified by the comptroller in the order reinstating the application.
- (8) The further period specified under subsection (7) above shall not be less than two months.
- (9) If the applicant fails to comply with subsection (7) above the application shall be treated as having been withdrawn on the expiry of the period specified under that subsection.

#### Textual Amendments

**F10** Ss. 20A, 20B inserted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), 8 (with arts. 20-23)

### **20B Effect of reinstatement under section 20A**

- (1) The effect of reinstatement under section 20A of an application for a patent is as follows.
- (2) Anything done under or in relation to the application during the period between termination and reinstatement shall be treated as valid.
- (3) If the application has been published under section 16 above before its termination anything done during that period which would have constituted an infringement of the rights conferred by publication of the application if the termination had not occurred shall be treated as an infringement of those rights—
  - (a) if done at a time when it was possible for the period referred to in section 20A(1) above to be extended, or
  - (b) if it was a continuation or repetition of an earlier act infringing those rights.

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- (4) If the application has been published under section 16 above before its termination and, after the termination and before publication of notice of the request for its reinstatement, a person—
- (a) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place, 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 reinstatement of the application and the grant 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) above 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 a right conferred by subsection (4) or (5) above, 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 applicant.
- [ The above provisions apply in relation to the use of a patented invention for the
- <sup>F11</sup>(6A) 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).]
- (7) In this section “termination”, in relation to an application, means—
- (a) the refusal of the application, or
  - (b) the application being treated as having been refused or withdrawn.]

#### Textual Amendments

**F10** Ss. 20A, 20B inserted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), arts. 1(2), **8** (with arts. 20-23)

**F11** S. 20B(6A) inserted (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(2), **Sch. 2 para. 7** (see S.I. 2004/2357, art. 1(2))

## 21 Observations by third party on patentability.

- (1) Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations, and the comptroller shall consider the observations in accordance with rules.
- (2) It is hereby declared that a person does not become a party to any proceedings under this Act before the comptroller by reason only that he makes observations under this section.

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