



# Patents Act 1977

## 1977 CHAPTER 37

### PART I

#### NEW DOMESTIC LAW

#### *Examination and search*

#### **17 Preliminary examination and search**

- (1) Where an application for a patent has a date of filing and is not withdrawn, and before the end of the prescribed period—
  - (a) a request is made by the applicant to the Patent Office in the prescribed form for a preliminary examination and a search; and
  - (b) the prescribed fee is paid for the examination and search (the search fee);the comptroller shall refer the application to an examiner for a preliminary examination and search, except that he shall not refer the application for a search until it includes one or more claims.
- (2) 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) 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, 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,

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*Status: This is the original version (as it was originally enacted).*

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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 subsection (4) above shall apply in relation to a supplementary search as it applies in relation to any other search under this section.

## **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 preliminary examination and 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.
- (2) On a substantive examination of an application the examiner shall investigate, to such extent as he considers necessary in view of any examination 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 section 17 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.

## **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.

## **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.

## **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.