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Patents Act 1977

1977 CHAPTER 37

PART I

NEW DOMESTIC LAW

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

7 Right to apply for and obtain a patent.

- (1) Any person may make an application for a patent either alone or jointly with another.
- (2) A patent for an invention may be granted—
 - (a) primarily to the inventor or joint inventors;
 - (b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;
 - (c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned;and to no other person.
- (3) In this Act “inventor” in relation to an invention means the actual deviser of the invention and “joint inventor” shall be construed accordingly.
- (4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

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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;
- (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.

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- (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 right or obligations as such.

9 Determination after grant of questions referred before grant.

If a question with respect to a patent or application is referred by any person to the comptroller under section 8 above, whether before or after the making of an application for the patent, and is not determined before the time when the application is first in order for a grant of a patent in pursuance of the application, that fact shall not prevent the grant of a patent, but on its grant that person shall be treated as having referred to the comptroller under section 37 below any question mentioned in that section which the comptroller thinks appropriate.

10 Handling of application by joint applicants.

If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the comptroller may, on a request made by any of the parties, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require.

11 Effect of transfer of application under s. 8 or 10.

- (1) Where an order is made or directions are given under section 8 or 10 above that an application for a patent shall proceed in the name of one or some of the original applicants (whether or not it is also to proceed in the name of some other person), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under either of those sections, continue in force and be treated as granted by the persons in whose name the application is to proceed.

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- (2) Where an order is made or directions are given under section 8 above that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant (on the ground that the original applicant or applicants was or were not entitled to be granted the patent), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under that section and subject to subsection (3) below, lapse on the registration of that person or those persons as the applicant or applicants or, where the application has not been published, on the making of the order.
- (3) If before registration of a reference under section 8 above resulting in the making of any order mentioned in subsection (2) above—
- (a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in the United Kingdom or made effective and serious preparations to do so; or
 - (a) a licensee of the applicant, acting in good faith, worked the invention in the United Kingdom or made effective and serious preparations to do so;
- that or those original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention.
- (4) Any such licence shall be granted for a reasonable period and on reasonable terms.
- (5) Where an order is made as mentioned in subsection (2) above, the person in whose name the application is to proceed or any person claiming that he is entitled to be granted any such licence may refer to the comptroller the question whether the latter is so entitled and whether any such period is or terms are reasonable, and the comptroller shall determine the question and may, if he considers it appropriate, order the grant of such a licence.

12 Determination of questions about entitlement to foreign and convention patents, etc.

- (1) At any time before a patent is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not that application has been made)—
- (a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or
 - (b) any of two or more co-proprietors of an application for such 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 so far as he is able to and may make such order as he thinks fit to give effect to the determination.
- (2) 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.

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- (3) Subsection (1) above, in its application to a European patent and an application for any such patent, shall have effect subject to section 82 below.
- (4) Section 10 above, except so much of it as enables the comptroller to regulate the manner in which an application is to proceed, shall apply to disputes between joint applicants for any such patent as is mentioned in subsection (1) above as it applies to joint applicants for a patent under this Act.
- (5) Section 11 above shall apply in relation to—
- (a) any orders made under subsection (1) above and any directions given under section 10 above by virtue of subsection (4) above; and
 - (b) any orders made and directions given by the relevant convention court with respect to a question corresponding to any question which may be determined under subsection (1) above;

as it applies to orders made and directions given apart from this section under section 8 or 10 above.

- (6) In the following cases, that is to say—
- (a) where an application for a European patent (UK) is refused or withdrawn, or the designation of the United Kingdom in the application is withdrawn, after publication of the application but before a question relating to the right to the patent has been referred to the comptroller under subsection (1) above or before proceedings relating to that right have begun before the relevant convention court;
 - (b) where an application has been made for a European patent (UK) and on a reference under subsection (1) above or any such proceedings as are mentioned in paragraph (a) above the comptroller, the court or the relevant convention court determines by a final decision (whether before or after publication of the application) that a person other than the applicant has the right to the patent, but that person requests the European Patent Office that the application for the patent should be refused; or
 - (c) where an international application for a patent (UK) is withdrawn, or the designation of the United Kingdom in the application is withdrawn, whether before or after the making of any reference under subsection (1) above but after publication of the application;

the comptroller may order that any person (other than the applicant) appearing to him to be entitled to be granted a patent under this Act may within the prescribed period make an application for such a patent for the whole or part of any matter comprised in the earlier application (subject, however, to section 76 below) and that if the application for a patent under this Act is filed, it shall be treated as having been filed on the date of filing the earlier application.

- (7) In this section—
- (a) references to a patent and an application for a patent include respectively references to protection in respect of an invention and an application which, in accordance with the law of any country other than the United Kingdom or any treaty or international convention, is equivalent to an application for a patent or for such protection; and
 - (b) a decision shall be taken to be final for the purposes of this section when the time for appealing from it has expired without an appeal being brought or, where an appeal is brought, when it is finally disposed of.

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13 Mention of inventor.

- (1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.
- (2) Unless he has already given the Patent Office the information hereinafter mentioned, an applicant for a patent shall within the prescribed period file with the Patent Office a statement—
 - (a) identifying the person or persons whom he believes to be the inventor or inventors; and
 - (b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent;and, if he fails to do so, the application shall be taken to be withdrawn.
- (3) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.

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