



Patents Act 1977

1977 CHAPTER 37

PART II

PROVISIONS ABOUT INTERNATIONAL CONVENTIONS

International applications for patents

89 Effect of filing international application for a patent

- (1) Subject to the provisions of this Act, an international application for a patent (UK) for which a date of filing has been accorded (whether by the Patent Office or by any other body) under the Patent Co-operation Treaty (in this section referred to as the Treaty) shall, until this subsection ceases to apply to the application, be treated for the purposes of Parts I and III of this Act as an application for a patent under this Act having that date as its date of filing and—
- (a) the application, if published in accordance with the Treaty and if it satisfies relevant conditions, shall be so treated as published under section 16 above, subject, however, to subsection (7) below ;
 - (b) where the date of filing an application is re-dated under the Treaty to a later date, that date shall be so treated as the date of filing the application;
 - (c) any declaration of priority made under the Treaty shall be so treated as a declaration made under section 5(2) above;
 - (d) where a period of time relevant to priority is extended under the Treaty, the period of twelve months specified in section 5(2) above shall be treated as altered correspondingly;
 - (e) any statement of the name of the inventor under the Treaty shall be so treated as a statement filed under section 13(2) above ; and
 - (f) an amendment of the application made in accordance with the Treaty shall, if it satisfies the relevant conditions, be so treated as made under this Act.
- (2) Accordingly, until subsection (1) above ceases to apply to an application filed or published in accordance with the Treaty, the applicant shall, subject to subsection (7) below, have the same rights and remedies in relation to the application as an applicant

Status: This is the original version (as it was originally enacted).

for a patent under this Act has in relation to a filed or, as the case may be, a published application for such a patent.

- (3) Notwithstanding anything in subsection (1) above, the provisions of the Treaty and not those of this Act relating to publication, search, examination and amendment shall apply to any such application until all the relevant conditions are satisfied and, if those conditions are not satisfied before the end of the prescribed period, the application shall be taken to be withdrawn.
- (4) The relevant conditions—
- (a) in the case of an application, are that a copy of the application and, if it is not in English, a translation into English have been filed at the Patent Office and the filing fee has been paid to the Patent Office by the applicant; and
 - (b) in the case of an amendment, are that a copy of the amendment and, if it is not in English, a translation into English have been filed at the Patent Office.
- (5) The comptroller shall on payment of the prescribed fee publish any translation filed at the Patent Office under subsection (4) above.
- (6) Before the relevant conditions are satisfied, subsection (1) above shall not operate so as to secure that an international application for a patent (UK) is to be treated for the purposes of section 8 above as an application for a patent under this Act and shall not affect the application of section 12 above to an invention for which an international application of a patent is made or proposed to be made, but when the relevant conditions are satisfied the international application shall be so treated and accordingly section 12 above shall not apply to it.
- (7) For the purposes of sections 55 and 69 above an international application for a patent (UK) published in accordance with the Treaty—
- (a) shall, if published in English, be treated as published under section 16 above on its publication in accordance with the Treaty;
 - (b) shall, if published in any other language and if the relevant conditions are satisfied, be treated as published under section 16 above on the publication of a translation of the application under subsection (5) above;
- but, if the application is published in a language other than English, the applicant may recover a payment by virtue of section 55 above in respect of the use of the invention in question before publication of that translation, or may bring proceedings by virtue of section 69 above in respect of an act mentioned in that section which is done before publication of that translation, if before that use or the doing of that act he has sent by post or delivered to the government department who made use or authorised the use of the invention, or, as the case may be, to the person alleged to have done the act, a translation into English of the specification of the application.
- (8) Subsection (1) above shall cease to apply to an international application for a patent (UK) if—
- (a) the application is withdrawn or deemed to be withdrawn ; or
 - (b) the designation of the United Kingdom in the application is withdrawn or deemed to be withdrawn;

except where the application or the designation of the United Kingdom in the application is deemed to be withdrawn under the Treaty because of an error or omission in the Patent Office or any other institution having functions under the Treaty or of an application not being received by the International Bureau, owing to circumstances

outside the applicant's control, before the end of the time limited for that purpose by the Treaty.

- (9) Where the relevant conditions are satisfied before the end of the prescribed period, the comptroller shall refer the application for so much of the examination and search as is required by sections 17 and 18 above as he considers appropriate in view of any examination and search carried out under the Treaty, and those sections shall apply with any necessary modifications accordingly.
- (10) The foregoing provisions of this section shall not apply to an international application for a patent (UK) which is treated by virtue of the European Patent Convention as an application for a European patent (UK) or which contains an indication that the applicant wishes to obtain a European patent (UK).
- (11) If an international application for a patent which purports to designate 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 the Patent Office or any other institution having functions under the Treaty, he may direct that the application shall be treated as an application under this Act.