



Patents Act 1977

1977 CHAPTER 37

PART I

NEW DOMESTIC LAW

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

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.

(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

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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 [F¹whether before or] , 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 [F²or the] 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.

Textual Amendments

- F1** Words in s. 12(6)(a) inserted (1.1.2005) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 2 para. 5\(a\)](#); [S.I. 2004/3205](#), [art. 2\(k\)](#) (with [art. 9](#))

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F2 Words in s. 12(6)(c) substituted (1.1.2005) by Patents Act 2004 (c. 16), s. 17(1), **Sch. 2 para. 5(b)**; S.I. 2004/3205, art. 2(k) (with art. 9)

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Changes and effects yet to be applied to the whole Act associated Parts and Chapters:

Whole provisions yet to be inserted into this Act (including any effects on those provisions):

- s. 56(4)(a)(iiia) and word added by [S.I. 2006/1056 Sch. para. 2\(b\)](#) (This amendment comes into force on the day on which 2005 asp 13, s. 20 comes into force, see art. 1(2)(b))
- s. 63(3)(a) words in s. 63(3) renumbered as s. 63(3)(a) by [2004 c. 16 s. 2\(4\)](#) (Amendment not applied to legislation.gov.uk. S. 2(4) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)
- s. 63(3)(b) and word inserted by [2004 c. 16 s. 2\(4\)](#) (Amendment not applied to legislation.gov.uk. S. 2(4) was repealed (29.4.2006) by S.I. 2006/1028, art. 2(4), Sch. 4)