



Patents Act 1977

1977 CHAPTER 37

PART II

PROVISIONS ABOUT INTERNATIONAL CONVENTIONS

European patents and patent applications

78 Effect of filing an application for a European patent (UK).

- (1) Subject to the provisions of this Act, an application for a European patent (UK) having a date of filing under the European Patent Convention shall be treated for the purposes of the provisions of this Act to which this section applies as an application for a patent under this Act having that date as its date of filing and having the other incidents listed in subsection (3) below, but subject to the modifications mentioned in the following provisions of this section.
- (2) This section applies to the following provisions of this Act:—
 - section 2(3) and so much of section 14(7) as relates to section 2(3);
 - section 5;
 - section 6;
 - so much of section 13(3) as relates to an application for and issue of a certificate under that subsection;
 - sections 30 to 33;
 - section 36;
 - sections 55 to 69;
 - [^{F1}sections 70 to 70F]
 - section 74, so far as relevant to any of the provisions mentioned above;
 - section 111; and
 - section 125.
- (3) The incidents referred to in subsection (1) above in relation to an application for a European patent (UK) are as follows:—

Changes to legislation: Patents Act 1977, Section 78 is up to date with all changes known to be in force on or before 08 February 2024. There are changes that may be brought into force at a future date. Changes that have been made appear in the content and are referenced with annotations. (See end of Document for details) View outstanding changes

- (a) any declaration of priority made in connection with the application under the European Patent Convention shall be treated for the purposes of this Act as a declaration made under section 5(2) above;
 - (b) where a period of time relevant to priority is extended under that convention, the period of twelve months [^{F2}allowed under section 5(2A)(a)] above shall be so treated as altered correspondingly;
 - (c) where the date of filing an application is re-dated under that convention to a later date, that date shall be so treated as the date of filing the application;
 - (d) the application, if published in accordance with that convention, shall, subject to subsection (7) and section 79 below, be so treated as published under section 16 above;
 - (e) any designation of the inventor under that convention or any statement under it indicating the origin of the right to a European patent shall be treated for the purposes of section 13(3) above as a statement filed under section 13(2) above;
 - (f) registration of the application in the register of European patents shall be treated as registration under this Act.
- (4) Rules under section 32 above may not impose any requirements as to the registration of applications for European patents (UK) but may provide for the registration of copies of entries relating to such applications in the European register of patents.
- [^{F3}(5) Subsections (1) to (3) above shall cease to apply to an application for a European patent (UK), except as mentioned in subsection (5A) below, if—
- (a) the application is refused or withdrawn or deemed to be withdrawn, or
 - (b) the designation of the United Kingdom in the application is withdrawn or deemed to be withdrawn,
- but shall apply again if the rights of the applicant are re-established under the European Patent Convention, as from their re-establishment.
- (5A) The occurrence of any of the events mentioned in subsection (5)(a) or (b) shall not affect the continued operation of section 2(3) above in relation to matter contained in an application for a European patent (UK) which by virtue of that provision has become part of the state of the art as regards other inventions.][^{F4}; and the occurrence of any event mentioned in subsection (5)(b) shall not prevent matter contained in an application for a European patent (UK) becoming part of the state of the art by virtue of section 2(3) above as regards other inventions where the event occurs before the publication of that application.]
- [^{F5}(6) Where, between subsections (1) to (3) above ceasing to apply to an application for a European patent (UK) and the re-establishment of the rights of the applicant, a person—
- (a) begins in good faith to do an act which would constitute an infringement of the rights conferred by publication of the application if those subsections then applied, or
 - (b) makes in good faith effective and serious preparations to do such an act,
- he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding subsections (1) to (3) applying again and notwithstanding the grant of the patent.

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- (6A) Subsections (5) and (6) of section 20B above have effect for the purposes of subsection (6) above as they have effect for the purposes of that section and as if the references to subsection (4) of that section were references to subsection (6) above.
- (6B) Subject to subsection (6A) above, the right conferred by subsection (6) above does not extend to granting a licence to another person to do the act in question.
- (6C) Subsections (6) to (6B) above apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to an infringement of the rights conferred by publication of the application (or, as the case may be, infringement of the patent).
- “Patented invention” has the same meaning as in section 55 above.]
- (7) While this subsection is in force, an application for a European patent (UK) published by the European Patent Office under the European Patent Convention in French or German shall be treated for the purposes of sections 55 and 69 above as published under section 16 above when a translation into English of the claims of the specification of the application has been filed at and published by the Patent Office and the prescribed fee has been paid, but an applicant—
- (a) may recover a payment by virtue of section 55(5) above in respect of the use of the invention in question before publication of that translation; or
 - (b) 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 those claims.
- (8) Subsection (7) above shall come into force on a day appointed for the purpose by rules and shall cease to have effect on a day so appointed, without prejudice, however, to the power to bring it into force again.

Textual Amendments

- F1** Words in s. 78(2) inserted (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017 \(c. 14\)](#), [ss. 1\(6\)](#), 8; [S.I. 2017/771](#), [reg. 2\(1\)\(a\)](#) (with [reg. 3](#))
- F2** Words in s. 78(3)(b) substituted (1.1.2005) by [The Regulatory Reform \(Patents\) Order 2004 \(S.I. 2004/2357\)](#), [arts. 1\(2\)](#), [14](#) (with [arts. 20-23](#))
- F3** S. 78(5)(5A) substituted for subsection (5) by [Copyright, Designs and Patents Act 1988 \(c. 48\)](#), [SIF 67A](#), s. 295, [Sch. 5 para. 22](#)
- F4** Words in s. 78(5A) inserted (13.12.2007) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 1 para. 3\(2\)](#); [S.I. 2007/3396](#), [art. 2\(j\)](#) (with [art. 3](#))
- F5** S. 78(6)-(6C) substituted for s. 78(6) (13.12.2007) by [Patents Act 2004 \(c. 16\)](#), s. 17(1), [Sch. 1 para. 3\(3\)](#); [S.I. 2007/3396](#), [art. 2\(j\)](#)

Modifications etc. (not altering text)

- C1** S. 78(8): 1.9.1986 appointed by [S.I. 1987/288](#), [rule 4\(1\)](#) (subject to saving in [rule 4\(2\)](#))

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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)