

Changes to legislation: There are currently no known outstanding effects for the Patents Act 2004, SCHEDULE 1. (See end of Document for details)

SCHEDULES

SCHEDULE 1

Section 5

AMENDMENTS RELATING TO INTERNATIONAL OBLIGATIONS

1 The 1977 Act is amended as follows.

Commencement Information

11 Sch. 1 para. 1 in force at 1.1.2005 by S.I. 2004/3205, art. 2(i) (with art. 9)

2 In section 77 (effect of European patent (UK)), in subsection (5)(a), after “restored” there is inserted “ or is revoked by the Board of Appeal and is subsequently restored by the Enlarged Board of Appeal ”.

Commencement Information

12 Sch. 1 para. 2 in force at 13.12.2007 by S.I. 2007/3396, art. 2(j)

3 (1) Section 78 (effect of filing an application for a European patent (UK)) is amended as follows.

(2) In subsection (5A), at the end there is inserted “ ; 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. ”

(3) For subsection (6) there is substituted—

“(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.

(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.

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(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.”

Commencement Information

I3 Sch. 1 para. 3 in force at 13.12.2007 by S.I. 2007/3396, art. 2(j) (with art. 3)

4 In section 80 (authentic text of European patents and patent applications), for subsection (4) there is substituted—

“(4) Where a correction of a translation is published under subsection (3) above and before it is so published a person—

- (a) begins in good faith to do an act which would not constitute an infringement of the patent as originally translated, or of the rights conferred by publication of the application as originally translated, but would do so under the amended translation, 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 the publication of the corrected translation and notwithstanding the grant of the patent.

(5) Subsections (5) and (6) of section 28A above have effect for the purposes of subsection (4) above as they have effect for the purposes of that section and as if—

- (a) the references to subsection (4) of that section were references to subsection (4) above;
- (b) the reference to the registered proprietor of the patent included a reference to the applicant.

(6) Subject to subsection (5) above, the right conferred by subsection (4) above does not extend to granting a licence to another person to do the act in question.

(7) Subsections (4) to (6) 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 patent or of the rights conferred by the publication of the application.

“Patented invention” has the same meaning as in section 55 above.”

Commencement Information

I4 Sch. 1 para. 4 in force at 13.12.2007 by S.I. 2007/3396, art. 2(j)

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- 5 (1) Section 81 (conversion of European patent applications) is amended as follows.
- (2) In subsection (1), for the words following “this Act” there is substituted “ where the application is deemed to be withdrawn under the provisions of the European Patent Convention relating to the time for forwarding applications to the European Patent Office ”.
- (3) In subsection (2)—
- (a) paragraph (a) and the “that” preceding it are omitted;
 - (b) in paragraph (b), for the words preceding sub-paragraph (i) there is substituted “ that ”;
 - (c) in paragraph (c), for “in either case” there is substituted “ that ”.

Commencement Information

I5 Sch. 1 para. 5 in force at 13.12.2007 by S.I. 2007/3396, art. 2(j)

- 6 Sections 86 and 87 (implementation of Community Patent Convention and decisions under it) are omitted.

Commencement Information

I6 Sch. 1 para. 6 in force at 1.1.2005 by S.I. 2004/3205, art. 2(i) (with art. 9)

- 7 Section 89(4) (circumstances in which application treated as an international application for a patent (UK)) is omitted.

Commencement Information

I7 Sch. 1 para. 7 in force at 1.1.2005 by S.I. 2004/3205, art. 2(i) (with art. 9)

- 8 In section 89B(2) (adaptation of provisions in relation to international applications), for the words following “when the” there is substituted “ national phase of the application begins or, if later, when published in accordance with the Treaty ”.

Commencement Information

I8 Sch. 1 para. 8 in force at 1.1.2005 by S.I. 2004/3205, art. 2(i) (with art. 9)

- 9 (1) Section 130 (interpretation) is amended as follows.
- (2) In subsection (1)—
- (a) in the definition of “application for a European patent (UK)” and “international application for a patent (UK)”, after “and” there is inserted “ (subject to subsection (4A) below) ”;
 - (b) at the end of the definition of “designate” there is inserted “ and includes a reference to a country being treated as designated in pursuance of the convention or treaty ”.
- (3) After subsection (4) there is inserted—

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“(4A) An international application for a patent is not, by reason of being treated by virtue of the European Patent Convention as an application for a European patent (UK), to be treated also as an international application for a patent (UK).”

(4) After subsection (5) there is inserted—

“(5A) References in this Act to the amendment of a patent or its specification (whether under this Act or by the European Patent Office) include, in particular, limitation of the claims (as interpreted by the description and any drawings referred to in the description or claims).”

Commencement Information

- I9** Sch. 1 para. 9(1)(2)(a)(3) in force at 1.1.2005 by S.I. 2004/3205, **art. 2(i)** (with art. 9)
I10 Sch. 1 para. 9(2)(b) in force at 1.1.2005 for specified purposes by S.I. 2004/3205, **art. 2(j)** (with art. 9)
I11 Sch. 1 para. 9(2)(b) in force at 13.12.2007 for specified purposes by S.I. 2007/3396, **art. 2(k)**
I12 Sch. 1 para. 9(4) in force at 13.12.2007 by S.I. 2007/3396, **art. 2(j)**

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