

CONSULTATION PAPER

THE PATENTS ACT 2004: PATENT OFFICE OPINIONS AND OTHER CHANGES TO THE PATENTS RULES

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I. SUMMARY

Subject

1. This consultation paper sets out proposals for amending the Patents Rules 1995, as part of the process of implementing certain provisions of the Patents Act 2004.

Purpose of the consultation

2. The Patents Act 2004 (“the 2004 Act”) amends the Patents Act 1977 (“the 1977 Act”), which is the statute governing the patent system in the UK. Many of the changes made by the 2004 Act are already in force, along with some consequential changes to the Patents Rules 1995 (“the Rules”). However, some of the provisions of the 2004 Act require more substantial changes to be made to the Rules before they can take effect. The purpose of this consultation is seek views on those rules changes and so on how certain provisions of the 2004 Act should be implemented.
3. The consultation paper describes how we propose to implement the various provisions. It also presents the draft rules changes in Annex A. We are keen to have comments and suggestions both on the proposed implementation and the draft rules themselves. We want to take full account of the public’s views and so responses will be most welcome from anyone interested in the operation of the patent system in the United Kingdom – but especially from those who have been, are, or expect to be users of the system. The consultation will help ensure that the provisions of the 2004 Act are implemented in the most helpful way possible.

Summary of proposals

4. The proposals contained in this consultation document are presented in two parts. The first part deals with the implementation of section 13 of the 2004 Act, which allows the Patent Office to issue opinions in relation to patent validity and infringement. The second part deals with the implementation of various other provisions of the 2004 Act – namely, those which relate to renewal fee payment periods, co-ownership, security for costs, keeping inventor details confidential and revocation by the patent holder. The relevant provisions of the 1977 Act, as amended by the 2004 Act, are reproduced at Annex B.

Who is being consulted

5. Copies of this consultation paper have been sent to the individuals and organisations listed in Annex C. It is also available on the Patent Office website

at www.patent.gov.uk/about/consultations/index.htm and on paper from Fraser Daviss, telephone 01633 814322 or email fraser.daviss@patent.gov.uk

How and when to respond

6. Please send your responses by **17 AUGUST 2005** to:

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Patents Legal Section
The Patent Office
Concept House
Cardiff Road
Newport NP10 8QQ

Tel: 01633 814521

Fax: 01633 814491

E-mail: james.porter@patent.gov.uk

7. Please indicate in what capacity your response is submitted. If you are responding on behalf of a representative group, please give a summary of the people and organisations that you represent.
8. It should be remembered that the consultation does not ask whether we should implement the provisions of the 2004 Act, but asks how they should be implemented. Following a full consultation in 2002/3, the provisions of the 2004 Act were agreed by Parliament after detailed scrutiny.
9. This consultation document has been prepared in accordance with the Government Code of Practice on Written Consultations. The Code criteria are set out in Annex D. Also contained there are the contact details for the Patent Office's consultation co-ordinator. Please contact her if you have any comments or complaints about the way in which this consultation has been handled.

Openness and publication of responses

10. This is part of a public consultation exercise. As such, your responses will be made public unless you make clear in responding that you want them to remain confidential. In this respect, it is noted that many fax and e-mail responses automatically carry a statement that the contents are confidential or only for the eyes of the recipient. In the context of this consultation, such statements will not be construed as being a request for confidentiality. A specific request should be made if you do not wish your response to be available to the public. We will handle any personal data that you provide in accordance with the Data Protection Act 1998 and the Freedom of Information Act 2000.

II. PATENT OFFICE OPINIONS

Introduction

11. This Part of the consultation paper concerns the procedures under new sections 74A and 74B of the 1977 Act, which will be inserted by section 13 of the 2004 Act when that section is brought into force. Section 74A allows anyone to ask the comptroller of the Patent Office for a non-binding opinion on an issue of patent validity or infringement. Section 74B enables rules to be made providing for the review of an opinion in certain circumstances. Draft rules implementing sections 74A and 74B are shown in Annex A (rules 78A to 78K), and the following paragraphs set out the proposed procedure under those rules.

Aims of the opinion procedure and the likely fee

12. We propose that it will cost around £200 to request an opinion. The Patent Office aims to provide a low-cost service which helps to resolve patent disputes, and thus encourages further innovation, by providing a quick, balanced and affordable way for parties to get an impartial assessment of key issues in a patent dispute. An opinion may focus parties' minds on those key issues and help them test the strength of their case, thus better enabling them to negotiate a settlement. The proposed fee is therefore set on the basis that the opinions procedure will be used largely for these purposes. If it transpires that the procedure is used heavily for other purposes, unrelated to negotiation and dispute resolution, and the demand is therefore not as planned, the fee may need to be increased. Users may also be aware that the Office is undertaking a review of its fee structure and fee-setting policy generally, which may also later impact on this fee – and a consultation on this will be launched in due course.

Filing a request for an opinion (rule 78B)

13. Anyone may ask for an opinion on any UK patent or European patent (UK), and they will do so by filing a new Form. They will not need to declare an interest, although the requester will be required to disclose any relevant UK or EPO proceedings (underway or completed) of which he is aware. He will also be asked to disclose any known interested parties (e.g. with whom he is negotiating or in dispute) in order that they can be notified of the request.

14. The requester will file a written statement setting out fully the question to be considered in the opinion, including the facts to be taken into account. It may be necessary to include relevant prior art, a description of the product or process, relevant drawings, formulae etc. A witness statement or other evidence may be filed (e.g. in relation to prior use) and all material will be required in duplicate.

Register entries (rule 78C)

15. As soon as a request is filed, we propose that a Register entry is made indicating that an opinion in relation to validity or infringement has been requested on a particular date. An entry would also be made on refusal or withdrawal of a

request, or on issue of an opinion. We would welcome views on whether the Register entries should identify the requester.

Refusal or withdrawal of a request (rule 78D)

16. As soon as possible after the request is filed, the Office will assess whether the request should be refused under section 74A(3). Rule 78D(1) provides that a request will be refused where it appears that it is frivolous or vexatious. Assessing these matters will require the Office to look at previous requests in relation to the patent and the patent proprietor, as well as substantive issues. The rule also provides that a request will be refused if the matter has already been dealt with in proceedings. Furthermore, the Office must also refuse a request in any other case where it concludes that an opinion would be inappropriate in all the circumstances (see section 74A(3)(b) and rule 78D(3)(b)). For example, a request would be refused where it does no more than repeat arguments already considered pre-grant or in a previous opinion. A request may also be refused where related proceedings (either in the UK or at the EPO) are underway but not completed – although whether it is appropriate to refuse the request would depend on all the circumstances. For example, an opinion issued to parties already involved in proceedings could sometimes be helpful, and the courts may encourage or could direct parties to seek such an opinion.
17. If a request is to be refused, the Office will inform the requester and give the reasons for refusal. He will be entitled to a hearing on the matter under section 101. As is made clear in section 74A(6), no other parties can be involved in that hearing, and only the requester has the right of appeal. If a request is refused then the patent proprietor (who will not have been involved up to this point unless he is the requester) will be informed. The request papers and the decision not to proceed will be publicly available on the patent file. It is possible that a request may be refused at a later stage in the opinion process, after the request has been advertised and other parties have made observations. For example, a third party may provide a good reason why the request should be refused. If so, the same procedures will apply, but any party who submitted observations would be informed (as well as the patent proprietor).
18. A requester may withdraw the request for an opinion at any time, without having to give reasons. If so, we propose that the comptroller should not be able to continue of his own motion. This is different from practice under revocation proceedings where, if the applicant for revocation withdraws, the comptroller continues (in the public interest) to consider whether the patent is invalid and should be revoked. Equivalent procedures to those governing refusal of a request would apply in terms of notifying third parties, and we would expect all the papers to remain public. Since no opinion will have been issued, we foresee no problems if another party later requests an opinion on the same issue.
19. The Office will have the discretion to refund all or part of the request fee if a request is refused. No refund will be available where a request is withdrawn.

Notification and advertisement of the request (rule 78E)

20. If the request is proceeded with, the Office will send copies of the written statement to interested parties. If appropriate, we will also send them copies of any other material submitted – evidence or prior art documents for example. The interested parties will include (if they are not the requester) the patent proprietor, licensees shown on the Register, any parties mentioned in the request, anyone who has set up a relevant caveat under rule 92 (as amended) and anyone else that the Office considers is likely to have an interest.
21. We also propose that the request is advertised generally. One option is to put a notice in the Patents and Designs Journal saying that a request has been received and that the public may see it and file observations. However, it may save significant time if this information was instead advertised on our website. It would be helpful to know if, in the interests of keeping the opinions process as quick and efficient as possible, this would be an acceptable alternative to advertising requests in the Journal.

Submitting observations (rule 78F)

22. Anyone will be able to submit written observations for four weeks after the advertisement appears. This will include parties who have been notified directly, so the Office will ensure that they are notified on or before the date that the advertisement appears, and are informed of the deadline. The written observations will have to be confined to the issues raised in the request and are required in duplicate. Thus observations filed at this stage will not be allowed to broaden the scope of the opinion by raising unrelated new issues. If an opinion on such issues is required then we would expect a further, separate request for an opinion to be made. It may be that the observations reveal that the request should be refused, in which case the procedure described in paragraph 17 will follow.
23. The observations will be sent to the requester, who will be given four weeks to respond. The response must strictly be in reply to issues raised in the observations, so again if new issues are raised, a further opinion would need to be requested. Where the patent proprietor or exclusive licensee made the request, he will (like any other requester) see all the observations and be able to make observations in reply. However, where he is not the requester, he will in any case be sent a copy of all the observations filed – but will not be given the chance to make observations in reply unless the comptroller thinks it is particularly appropriate.

Issuing the opinion (rule 78G)

24. The opinion will be reasoned and we intend a firm view to be stated – rather than (for example) trying to assess the likelihood of invalidity or infringement in percentage terms. The opinion will only be as good as the written statements and observations themselves – and it may be necessary for the opinion to reflect the constraints imposed by those submissions. Thus a statement which alleges prior use may result in a conditional opinion stating that the patent is invalid if the alleged prior use did occur (but coming to no view as to whether or not it did). A

statement which describes a particular product may result in an opinion stating that the product as described does infringe (but coming to no view as to whether the product has correctly been described).

25. In almost all cases, the examiner would be expected to base his opinion on the information available to him. However, there may be rare occasions where it would be helpful for the examiner to seek further information from an observer or the requester before completing his opinion. We suggest that, as a matter of practice, the examiner may consider doing this only when there is insufficient information to come to an opinion (probably a very rare occurrence, given that a conditional opinion would be possible) and there is a strong possibility that contacting the requester or observer will improve matters. This would be consistent with how the Office deals with observations on patent applications under section 21 – but views are welcome on whether this would be appropriate.
26. A copy of the opinion will be sent to the requester and (regardless of whether they submitted observations or not) to the patent proprietor and exclusive licensee if there is one. A copy will also go to any party who submitted observations. The opinion and all the papers associated with it will be open to public inspection, so that parties may come to the Office to inspect them or may request copies. Depending on the number of opinions issued, it may be possible to make the opinions themselves available on the Office website. We would be interested to know if users would welcome this service.

Extensions of time periods

27. We suggest that any time period mentioned above should be extendable at the comptroller's discretion – that is, under existing rule 110(1). Given the aims of the opinion procedure, the Office would in practice expect to grant only short extensions and only for very good reasons.

Confidentiality orders

28. Rules 93 and 94 set out certain restrictions concerning when documents sent to the Office are open to public inspection. In particular, any document is kept confidential for 14 days from filing, and during that time the sender may ask for it to remain confidential for a longer period or indefinitely. With regard to opinions, there are two possible approaches. One is that the general provisions should apply to documents filed during the opinion process. In practice confidentiality orders are only issued in exceptional circumstances, and we would expect the same to apply in respect of material submitted during the opinion process.
29. However, it is in our view preferable to remove the opinions procedure from the scope of the confidentiality provisions, so that material involved in an opinion cannot be kept confidential at all. This has the particular advantage that statements or observations would not have to be kept confidential for 14 days before forwarding them to other parties. To have to do so for every opinion request would introduce significant delays and so defeat the point of having a helpfully quick opinion issued.

Reviews of opinions given under section 74A

30. New section 74B allows provision to be made for the comptroller to review an opinion in prescribed circumstances. Such a review will allow the correctness of the opinion to be considered in full proceedings before the comptroller, but may only be applied for by the patent proprietor or an exclusive licensee (the draft rules use the term “patent holder” to cover both). The reason that section 74B restricts the availability of review proceedings in this way is that a third party (e.g. the requester of the opinion) who wants an opinion set aside has existing mechanisms for doing so. A third party who dislikes an opinion that the patent is wholly or partially valid may apply for revocation of that patent. A third party who dislikes an opinion that a particular act infringes the patent can apply for a declaration of non-infringement. But such mechanisms are not always available to the patent holder when the opinion is adverse to him – which is where a review plays its part.

Applying for a review of an opinion (rule 78H)

31. We propose that an application for a review must be made within 3 months of the opinion being issued. This avoids a long period of uncertainty over the status of an opinion, but it may also give time for revocation or infringement proceedings to be launched, which will deal in a binding fashion with the issues raised in the opinion. It will not be possible to bring review proceedings if the issues raised in the opinion have been (or fall to be) decided in other proceedings, since there is no sense in reviewing the status of a non-binding opinion on an issue that has been, or will be, determined in a binding way by other proceedings. It should be noted that the 3 month period would be extendable under rule 110(1) at the discretion of the comptroller. Whilst we would expect extensions to be granted rarely, this could allow a review to be sought where (for example) relevant other proceedings had been started, but later terminated without determining the matter raised in the opinion.
32. A patent holder who wishes to apply for a review will use existing Form 2/77 (slightly modified) and pay the standard fee of £50 – the same as for launching any other proceedings before the comptroller. The Form will be accompanied by a written statement in duplicate, setting out fully the grounds on which a review is sought. The applicant will also have to provide copies of any evidence or other document referred to in the statement – although we would be interested to hear whether users think it would be appropriate to allow those supporting documents to be filed at a later date. The applicant will also have to disclose any relevant UK or EPO proceedings (underway or completed) of which he is aware.
33. The patent holder may apply to have an adverse opinion on validity set aside, and this would include an opinion which suggested that the patent was only partially valid. It is important to provide this opportunity since – in the absence of a third party launching revocation proceedings or committing an allegedly infringing act – the patent holder may have no other way of tackling an adverse opinion on validity that he feels is wrong.

34. The patent holder may also apply to have an adverse opinion on infringement set aside, but only where the opinion has come to that adverse view as a result of (what the patent holder believes is) an erroneous construction of the patent specification. Generally speaking, if the opinion has concluded that no infringement is taking place and the patent holder disagrees, he may sue for infringement. This could include the circumstances where the patent holder disagrees with the way that the claims have been construed. But suing for infringement is not possible if the opinion was sought on a potential or hypothetical act, and in such circumstances it would be unfair to deny the patent holder a chance to overturn an infringement opinion based on a construction of the claims which is adverse to him. Thus it is proposed to allow a review of an infringement opinion where the sole issue at stake is the construction of the claims.

Proceeding with the review – involving other parties (rule 78I)

35. The Office will send a copy of the statement and any supporting documents to the original requester of the opinion – if they are not the applicant for review themselves. Those who submitted observations will also be sent a copy of the statement and (if appropriate) the supporting documents. The Register will be updated to show that an application has been filed for a review of the opinion and an advertisement will be put in the Journal.
36. Anyone who wishes to file a statement in support of, or contesting, the applicant's statement (and so become a party to the review proceedings) will have four weeks from the publication of the Journal advertisement or, if later, two months from the date of the opinion to do so. This includes parties who have been notified directly, so the Office will make sure they are notified on or before the date that the advertisement appears, and are informed of the deadline. The comptroller will send copies of any such statements to the other parties. So the proceedings may be *ex parte* or *inter partes*, depending on whether the original requester of the opinion, or anyone else, chooses to get involved. To allow maximum flexibility in expediting any further stages, the comptroller has the power to direct subsequent procedure.

Outcome of a review (rule 78J)

37. As with other proceedings before the comptroller, a hearing will be appointed if the parties wish it, or a decision may be reached on the papers. In either case, a reasoned decision will issue in the standard format, and this will either set aside the opinion, wholly or in part, or find no reason to do so. We suggest that a review decision should be able where appropriate to set aside an opinion, but uphold the conclusions that the opinion reached for different reasons – see rule 78J(2). For example, an opinion may state that a patent is invalid for lack of novelty. If the review sets that opinion aside, it may nevertheless (on the basis of the material submitted) be able to conclude that there is a lack of inventive step. In effect, therefore, the review will in such cases replace the opinion with a different one reaching the same conclusion. Rule 78J(3) accordingly makes clear that such a conclusion has the same non-binding status as the original opinion.

Rule 78J(4) ensures, more generally, that issues determined for the purposes of review proceedings may still be re-litigated in subsequent proceedings.

38. If the review proceedings are *inter partes*, we would expect the comptroller's usual costs regime to apply. As for other decisions, the parties will be sent copies of the decision, an advertisement will be put in the Journal and the Register updated.
39. We suggest that it would be right for the hearing officer to take account of all the material filed during the opinion stage when coming to a decision. However, care would be needed where the person who filed observations at the opinion stage chose not to be a party to the review proceedings. The applicant for the review would not be able to cross-examine that person on any evidence they filed, although he may benefit from having his view of their evidence or observations unchallenged. It would be for the hearing officer to give the appropriate weight to the observations in such circumstances.
40. Section 74B(2)(c) allows a review to be treated in prescribed circumstances as proceedings for infringement, revocation or a declaration of non-infringement. However, under our proposals the review will not come to a binding decision on patent validity or infringement, but is restricted to setting aside the opinion or leaving it to stand. A patent with an adverse opinion, which is subject to a review upholding the opinion, will remain simply a patent with an adverse opinion – although naturally that opinion may carry more weight after the review procedure is completed. It would not be appropriate for a review which performs such a function to (for example) go on to revoke the patent or make an award of damages for infringement. Furthermore, since the review proceedings are wholly concerned with whether a non-binding opinion should be set aside or not, it is important that no party is estopped from arguing the points considered in the review proceedings during later proceedings for revocation, infringement or non-infringement. As already noted, rule 78J(4) makes that clear.

Amendment of the patent during review proceedings

41. Amendment of the patent during a review will not be possible under section 75, because review proceedings are not proceedings in which validity may be put in issue. However, if the patent holder were to file amendments under section 27 during the course of the review, the hearing officer would be free to stay the review proceedings if that was appropriate.

Appealing a decision on a review (rule 78K)

42. Under section 74B(2)(d), the right to appeal a decision on a review may be limited to prescribed cases. If an opinion adverse to the patent holder is set aside on review, it would be disproportionate for the original requester (or anyone else) to be able to appeal that decision, and have the court consider in full proceedings whether to reinstate a non-binding opinion. Such a person will in any event be able to have the issues determined by a court by bringing revocation proceedings or proceedings for a declaration of non-infringement. Thus rule 78K does not allow for such appeals. Under that rule, a review decision will only be appealable

if it upholds an opinion either wholly or in part. In other words, if after a review an opinion adverse to the patent holder remains, the patent holder will be entitled to appeal.

III. OTHER CHANGES TO THE PATENTS RULES

Introduction

43. This Part of the consultation paper concerns various other provisions of the 2004 Act which, before they can be implemented, require significant changes to the Rules. For this reason, the provisions were not commenced with others on 1 January 2005, but will be commenced at the same time as the necessary rules changes. The draft rules are included in Annex A.

Renewal fee payment periods

44. Section 8 of the 2004 Act amends sections 25, 28 and 46 of the 1977 Act, in order to allow rules to set out a new regime for the payment of renewal fees. That new regime will align the UK with most other countries in the world, by allowing for the payment of renewal fees up to the end of the calendar month in which the anniversary of filing occurs. The period for late payment (with an additional fee) and for restoration of the patent will also move to the end of the relevant month.

45. The rules on renewals are necessarily somewhat complex, as they must deal with renewal fees on both UK and European patents, and with so-called “late grant” cases – where the patent is granted close to or after the time for payment of the first renewal fee. The approach taken by the draft rules is to define – for the various situations – a “renewal date”. The period for payment then always ends at the end of the calendar month in which that renewal date falls. However, the patent always ceases for non-payment at the end of the renewal date and not at the end of the period for payment.

46. In most cases, the first renewal date is the fourth anniversary of the date of filing. These standard cases are dealt with in rule 39A(2). The renewal fee payment period runs for 3 calendar months and ends on the last day of the month in which the renewal date falls. For example, if the fourth anniversary of the filing date is 17 September 2004, the first renewal fee can be paid any time in July, August or September of that year. If the fee is not paid, the patent will cease on 17 September 2004.

47. Draft rule 39A(3) deals with UK patents which are granted later than 3 years and 9 months after filing. The first renewal fee can be paid at any time from grant until the end of the third calendar month after grant. Draft rule 3A(2) of the Patents (Fees) Rules 1998 makes clear that this first fee includes any amounts payable in respect of anniversaries preceding the date of grant. Thus existing practice is unchanged in this respect.

48. Draft rule 39A(4) sets out the position in respect of the first renewal fee for a European patent which is granted later than 3 years and 9 months after filing. This position is different from that for UK “late grant” patents, because for a European patent no payment in respect of previous (pre-grant) years is made to the UK Patent Office. The effect of paragraph (4)(a) is that the renewal date for the first year after grant is the anniversary of the filing date or 3 months from

grant, whichever is the later. Again, the first renewal fee is due at the end of the month in which the renewal date falls.

49. After the first renewal fee has been paid, the position in respect of all patents (whether UK or EP(UK), and whether “late grant” or not) becomes much more straightforward. Draft rule 39B ensures that, for all cases, the subsequent renewal dates are always tied to the anniversary of filing, with the payment period ending at the end of the relevant calendar month.
50. For example, a UK patent application is filed on 20 April 2002 and granted on 3 April 2006. It is therefore a “late grant” case to which rule 39A(3) applies. The renewal fee which would have been due at the end of April 2006 may be paid any time up until the end of July 2006. Subsequent renewal fees are tied to the anniversary of filing, and so will be payable by the end of April each year after 2006. Thus the current position in respect of UK late grant cases is maintained, except that the payment period ends at the end of the relevant calendar month.
51. As a further example, consider a European patent that is granted 4 years 7 months after filing. The first renewal date is the fifth anniversary of filing and the fee can be paid up until the end of the month in which the anniversary falls. No fee in respect of the fourth anniversary is payable to the UK Office. If a European patent is granted 5 years 10 months after filing, the renewal fee for the sixth anniversary is due by the end of the third calendar month from grant. Again, fees for the fourth and fifth anniversaries are not payable to the UK Office. The draft provisions therefore also maintain the current position in respect of “late grant” European cases, except that the payment period ends at the end of the relevant calendar month.
52. Those parts of existing rule 39 which deal with notification of non-payment are now contained in a new rule 39C. Also, minor amendments to rule 92(1)(e) and paragraph 2(4)(ii) of Schedule 2 reflect the fact that the 2004 Act amends section 25(4) with the effect that the period for late payment also ends on the last day of the relevant month.
53. By the amendment to rule 41, the restoration period will also end on the last day of the relevant month. At present, this period is 19 months from the date the patent ceased to have effect. However, we do not believe anyone has ever made (and we would not accept) an application for restoration before the expiry of the 6 month late payment period – since it will only be known whether the patent has definitely ceased once the late payment period has expired and no payment has been made. The restoration period is therefore now defined as running for 13 calendar months from the end of the late payment period. Rule 42 is also updated to be consistent with new rules 39 to 41.

Co-ownership

54. Section 9 of the 2004 Act amends section 36(3) of the 1977 Act to clarify the rights of co-owners in respect of amendment and revocation of their patent. Unless the co-owners have agreed to make other arrangements, they must act jointly if they wish the patent to be amended. Similarly, unless they agree that it

should be possible, one co-owner cannot seek revocation of the patent against the wishes of the others.

55. Other than some modification of rule 75 (dealt with in paragraphs 66 and 67), we believe no rules changes are necessary. As a matter of practice, if one co-owner were to apply for the patent to be amended or revoked, the Patent Office would contact him or his agent in order to clarify the position in respect of the other co-owners. Under section 36(3) as amended, the applicant for amendment or revocation would need to demonstrate that the other co-owners had consented to his actions, or that the co-owners had all agreed that he could act alone.

Security for costs

56. Under section 107(4) as amended by the 2004 Act, rules may prescribe conditions under which the comptroller may make an order for security for costs. (Note that under section 107(4)(b) the comptroller is required to satisfy himself that it would be just in all the circumstances to make such an order.) Our stated intention has always been to ensure that the comptroller's practice closely follows that under the provisions of the Civil Procedure Rules, and so draft rule 89A reflects closely the relevant provisions of rule 25.13 CPR.

57. It should be noted that, unlike the CPR provisions, neither the draft rule nor section 107(4) is written in terms of the defendant seeking security from the claimant. One important reason for this is that in *ex parte* proceedings which become subject to opposition, neither side can wholly be regarded as a claimant or defendant. For example, in opposed amendment proceedings the patent proprietor launches the proceedings but the opposer makes them *inter partes* by filing a notice of opposition. Both sides have a substantial onus to discharge – see *Intel Corporation's Patent* [2002] RPC 48 (paragraphs 17-26). Thus security for costs can continue to be required from the opposer in these and other circumstances.

Keeping inventor details confidential

58. The 2004 Act makes changes to sections 16, 24 and 123 of the 1977 Act so that an inventor may (if he is not the patent applicant) have his name and address kept confidential by the Patent Office.
59. The applicant will still be required to supply the Office with a statement identifying the inventors and explaining how he has derived the right to the patent from them (using Form 7/77). However, under draft rule 15A any inventor can apply to the comptroller to waive his right to be mentioned publicly. Thus he may ask for his name and address, or just his address, to be kept from the public. That request must be made on or after the date of filing of the application but before the application is ready for publication under section 16.
60. The rule provides that an inventor's address may be withheld as-of-right. However, if the inventor wants his name and address withheld, he will need to provide reasons to satisfy the comptroller that it is right to do so. This is part of achieving the right balance with the new provisions, which were introduced in order to meet concerns about inventors working in controversial technologies. Of

course, an inventor may produce other legitimate reasons for wanting his details kept confidential, and each request would be judged on its merits. But requiring sufficient reasons allows the provisions to be used when it is appropriate to do so, whilst keeping to a minimum the concerns expressed by some that a right to confidentiality could remove a useful tool for searching patent applications and evaluating inventions.

61. Draft rule 27 ensures that, where the inventor's request has been accepted, no document will be published under section 16 which identifies the inventor's name and/or address. In particular, if the name is to be withheld then it will not appear with the other bibliographic data on the front page of the published patent application (the "A-specification"). Instead, a footnote on the front page will indicate that the inventor has waived his right to be mentioned. Under section 24, the same will apply to the published patent as granted (the "B-specification"). If there are other inventors, who do want their details made public, then they will of course continue to appear on the A- and B-specifications.
62. Draft rule 15A(5) and (6) allows for an inventor to change his mind and have his details made public – subject to any conditions that the comptroller may wish to impose. (For example, if the inventor changed his mind after publication of the A-specification, the comptroller may not feel it appropriate to re-publish the specification just in order to show the inventor's name).
63. As far as the Register is concerned, it has been possible for some years for an inventor to have his address removed. The draft rules show that rule 44(2) is amended in order to extend this to cover both the inventor's name and address.
64. Under section 118, documents which relate to a patent application become open to public inspection when the application is published – subject to (amongst other things) a list of restrictions in rule 93(4). That rule is amended by the draft rules so that any document, including the Form 7/77, which reveals the inventor's name and/or address can be withheld from public inspection. However, the provision allows the comptroller to provide access to the information in a particular case. This may allow, for example, disclosure of an inventor's name to other parties in *bona fide* entitlement or inventorship proceedings.
65. A final point concerns the grant certificate, which shows the inventor's name and is sent to the patent applicant when the patent is granted. We suggest that, if the inventor has had his request for confidentiality accepted, his name should not appear on the certificate. No rules changes are necessary to achieve this.

Revocation by the patent holder

66. Current rule 75 is written on the assumption that the applicant for revocation and the patent proprietor will be on opposing sides of a revocation action. However, the 2004 Act amends section 72(1) in order to make clear that the patent proprietor is not excluded from the definition that "any person" may seek revocation. Thus it will now be clear that the patent proprietor, or all the co-owners acting jointly, may seek revocation of the patent. Furthermore, it is

possible in limited circumstances for one co-owner to seek revocation – see paragraph 54.

67. The changes to rule 75 therefore reflect the clarified position. Draft rule 75(8) deals with the situation where one or more co-owners seek revocation of the patent, but other co-owner(s) oppose that revocation. It makes clear that, in the main provisions of rule 75, the “proprietor” means (in these circumstances) those co-owners who are not seeking revocation. Furthermore, where the proprietor (or all the co-owners) apply for revocation, draft rule 75(9) disapplies the main provisions of rule 75 and allows in these unusual circumstances for the comptroller to direct how the procedure should best continue – in what would presumably be *ex parte* proceedings.

ANNEX A

THE DRAFT CHANGES TO THE PATENTS RULES

Introduction

This Annex shows the draft changes proposed to be made to the Patents Rules 1995 and the Patents (Fees) Rules 1998. Deletions are shown in strike-out and additions are shown underlined.

Draft changes to the Patents Rules 1995

Rule 15A – Waiving the right to be mentioned

(1) The inventor may, before preparations for the application's publication have been completed by the Patent Office, apply to the comptroller in writing to waive his right –

(a) to have his name and address mentioned; or

(b) to have his address mentioned.

unless the inventor is also the applicant (or a joint applicant) for a patent.

(2) An application by an inventor to waive his right to have his name and address mentioned –

(a) shall include his reasons for making the application; and

(b) shall be accepted by the comptroller where the comptroller is satisfied by those reasons.

(3) An application by an inventor to waive his right to have his address mentioned shall be accepted by the comptroller.

(4) Where the comptroller has accepted an inventor's application to make a waiver under this rule, the inventor may apply to the comptroller to end that waiver.

(5) The comptroller may, if he thinks fit, accept an application to end a waiver, and his acceptance may be made subject to such conditions as he may direct.

Rule 27 – ~~Period for publication of application~~ Publication of application

~~The period prescribed for the purposes of section 16 shall be the period of eighteen months calculated from the declared priority date or, where there is no declared priority date, the date of filing the application.~~

(1) The period prescribed for the purposes of section 16(1) shall be –

(a) where there is no declared priority date, the period of 18 months beginning with the date of filing of the application; or

(b) where there is a declared priority date, the period of 18 months beginning with that date.

(2) Where the inventor's application to waive his right –

(a) to have his name and address mentioned; or

(b) to have his address mentioned,

has been accepted by the comptroller, the inventor's name and address (or, as the case may be, his address) shall not be published under section 16.

Rule 39 – Renewal of patents

~~(1) If, except in the case of a European patent (UK), it is desired to keep a patent in force for a further year after the expiration of the fourth or any succeeding year from the date of filing an application for that patent as determined in accordance with section 15, Patents Form 12/77, in respect of the next succeeding year, shall be filed and the prescribed renewal fee paid in the three months ending with the fourth or, as the case may be, succeeding anniversary of the date of filing:~~

~~Provided that, where a patent is granted in the three months ending with the fourth or any succeeding anniversary as so determined or at any time thereafter, Patents Form 12/77, in respect of the fifth or succeeding year may be filed and the prescribed renewal fee paid not more than three months before the expiration of the fourth or relevant succeeding year but before the expiration of three months from the date on which the patent is granted.~~

~~(2) If it is desired, at the expiration of the fourth or any succeeding year from the date of filing an application for a European patent (UK), as determined in accordance with Article 80 of the European Patent Convention, and provided that mention of the grant of the patent is, or has been, published in the European Patent Bulletin, to keep the patent in force, Patents Form 12/77 shall be filed and the prescribed renewal fee paid in the three months ending with the fourth or, as the case may be, succeeding anniversary of the date of filing as so determined:~~

~~Provided that, where any renewal fee is due on, or within the period of three months after, the date of publication in the European Patent Bulletin of the mention of the grant of the patent, that renewal fee may be paid within those three months.~~

~~(3) On receipt of the prescribed renewal fee, the comptroller shall (if the patent has been granted) issue a certificate of payment.~~

~~(4) Where the period for payment of a renewal fee pursuant to paragraph (1) or (2) above has expired, the comptroller shall, not later than six weeks after the last date for payment under that paragraph and if the fee still remains unpaid, send to the proprietor of the patent a notice reminding him that payment is overdue and of the consequences of non payment.~~

~~(5) The comptroller shall send a notice under paragraph (4) above to—~~

~~(a) the address specified by the proprietor on payment of the last renewal fee; or~~

~~(b) where another address has been notified to him for that purpose by the proprietor since the last renewal, that address,~~

~~and, in any other case, the address for service entered in the register.~~

~~(6) A request for extending the period for payment of a renewal fee shall be made on Patents Form 12/77 and shall be accompanied by the prescribed renewal fee and the prescribed additional fee for late payment.~~

Rule 39 – Renewal of patents: general

(1) In this rule and in rules 39A to 39C –

“prescribed period” means the period prescribed by rule 39A or 39B for the payment of a renewal fee;

“renewal date” has the meaning given in rules 39A(2) to (4) and 39B(3);

“renewal fee” means the fee prescribed in respect of a renewal date.

(2) If the renewal fee is not paid by the end of the prescribed period, the patent shall cease to have effect at the end of the renewal date.

(3) Subject to paragraph (4), Patents Form 12/77 must be filed within the prescribed period.

(4) Where payment is made pursuant to section 25(4), Patents Form 12/77 must accompany the renewal fee and the prescribed additional fee.

(5) On receipt of the renewal fee the comptroller shall issue a certificate of payment.

Rule 39A – Renewal of patents: first renewal

(1) This rule prescribes the period for the payment of a renewal fee in respect of the first renewal date.

(2) Subject to paragraphs (3) and (4) –

(a) the first renewal date is the fourth anniversary of the date of filing; and

(b) the prescribed period is the period of three months ending with the last day of the month in which that renewal date falls.

(3) Where a patent is granted under the Act in the period of three months ending with the fourth anniversary of the date of filing, or at any time after that anniversary –

(a) the first renewal date is the last day of the period of three months beginning with the date on which the patent was granted; and

(b) the prescribed period begins with the date on which the patent was granted and ends with the last day of the month in which that renewal date falls.

(4) Where the grant of a patent is mentioned in the European Patent Bulletin in the period of three months ending with the fourth anniversary of the date of filing, or at any time after that anniversary –

(a) the first renewal date is the later of –

(i) the last day of the period of three months beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin (case A); or

(ii) the next anniversary of the date of filing to fall after the date on which the grant of the patent was so mentioned (case B); and

(b) the prescribed period is –

(i) in case A, the period beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin and ending with the last day of the month in which that renewal date falls; or

(ii) in case B, the period of three months ending with the last day of the month in which that renewal date falls.

Rule 39B – Renewal of patents: subsequent renewals

(1) This rule prescribes the period for the payment of a renewal fee in respect of renewal dates subsequent to the first renewal date.

(2) The prescribed period is the period of three months ending with the last day of the month in which the renewal date falls.

(3) For those purposes –

(a) the second renewal date is the next anniversary of the date of filing to fall after the first renewal date; and

(b) each subsequent renewal date is the anniversary of the previous renewal date.

Rule 39C – Renewal notice

(1) This rule applies where the renewal fee has not been received by the end of the prescribed period.

(2) The comptroller shall, within the period of six weeks immediately following the renewal date, and if the fee remains unpaid, send a renewal notice to the proprietor of the patent.

(3) The comptroller shall send the renewal notice to –

(a) the address specified by the proprietor on payment of the last renewal fee (or to another address that has since been notified to him for that purpose by the proprietor); or

(b) where such an address has not been so specified or notified, the address for service entered in the register.

(4) The renewal notice shall remind the registered proprietor of the patent –

(a) that payment is overdue; and

(b) of the consequences of non-payment.

Rule 41 – Restoration of lapsed patents under section 28

(1) An application under section 28 for the restoration of a patent –

~~(a) may be made at any time within the period of nineteen months beginning on the day on which it ceased to have effect;~~

(a) may be made at any time during the period ending with the thirteenth month after the end of the period specified in section 25(4); and

(b) shall be made on Patents Form 16/77 supported by evidence of the statements made in it;

and the comptroller shall publish in the Journal notice of the making of the application.

[paragraphs (2) to (4) are unchanged]

Rule 42 – Notification of lapsed patent

~~Where a patent has ceased to have effect because a renewal fee has not been paid within the period prescribed in rule 39(1) or (2) and the extended period specified in section 25(4) has expired without~~

~~the renewal fee and prescribed additional fee having been paid, the comptroller shall, within six weeks after the expiration of the extended period, notify the proprietor of the patent of the fact and draw his attention to the provisions of section 28.~~

(1) This rule applies where –

(a) a patent has ceased to have effect because a renewal fee has not been paid by the end of the period prescribed by rule 39A or 39B, and

(b) the renewal fee and the prescribed additional fee have not been paid by the end of the period specified in section 25(4) (“the extended period”).

(2) The comptroller shall, within the period of six weeks immediately following the end of the extended period, send a notice to the proprietor of the patent –

(a) stating that the extended period has expired, and

(b) referring him to the provisions of section 28.

(3) The comptroller shall send the notice to the address specified by rule 39C(3).

Rule 44 – Entries in the register

(1) No entry shall be made in the register in respect of any application for a patent before the application has been published in accordance with section 16.

(2) Upon such publication, the comptroller shall cause to be entered in the register –

(a) the name and address of the applicant or applicants;

(b) the name and address of the person or persons stated by the applicant or applicants to be believed to be the inventor or inventors;

(c) the title of the invention;

(d) the date of filing and the file number of the application for the patent;

(e) the date of filing and the file number of any application declared for the purposes of section 5(2) or 127(4) and the country in or for which the application was made;

(f) the date on which the application was published; and

(g) the address for service of the applicant or applicants.

Provided that the comptroller may omit from ~~the register, the address of the person or persons stated by the applicant or applicants to be believed to be the inventor or inventors, if so requested by the applicant or applicants~~ the register the name and address (or, as the case may be, the address) of the inventor where he has waived his right to be mentioned.

[paragraphs (3) and (4) are unchanged]

Rule 75 – Procedure on application for revocation under section 72

[paragraphs (1) to (7) are unchanged]

(8) Where an applicant is one of the proprietors of the patent, any reference in this rule to the proprietor of the patent shall be construed as a reference to those other proprietors who do not make the application.

(9) Where the proprietor of the patent makes (or, where there is more than one proprietor, all the proprietors make) an application for revocation of a patent –

(a) paragraphs (2) to (8) do not apply; and

(b) the comptroller shall give such directions as he may think fit with regard to the procedure for determining the application.

Opinions by Patent Office

Rule 78A – Interpretation

In rules 78B to 78K, unless the context otherwise requires –

“request” means a request for an opinion under section 74A;

“requester” means the person who makes that request;

“patent” means the patent to which that request relates;

“patent holder” means the proprietor of that patent (but includes any exclusive licensee of the patent);

“proceedings” means proceedings (whether pending or concluded) before the comptroller, the court or the European Patent Office.

Rule 78B – Request for an opinion under section 74A

(1) A request shall be made on Patents Form 17/77 and shall be accompanied by a copy and a statement setting out fully –

(a) the question upon which an opinion is sought;

(b) any matters of fact which are requested to be taken into account.

(2) The statement shall be accompanied by –

(a) the name and address of any persons having an interest in that question who are to be notified under rule 78E(1)(d); and

(b) particulars of any proceedings of which the requester is aware which may be relevant to that question.

(3) The statement shall be accompanied by a copy of any evidence or other document which is referred to in the statement.

(4) Each such statement, evidence or other document must be provided in duplicate.

Rule 78C – Entry in the register

The comptroller shall cause to be entered in the register –

(a) a notice that a request under section 74A(1)(a) or (b) has been received;

(b) a notice that a request has been refused or withdrawn; and

(c) such other particulars concerning opinions or requests as he may think fit.

Rule 78D – Refusal or withdrawal of request

(1) The comptroller shall not issue an opinion if –

(a) the request appears to him to be frivolous or vexatious; or

(b) the question upon which the opinion is sought appears to him to have been sufficiently answered in any other proceedings.

(2) The comptroller shall not issue an opinion if the requester gives him notice in writing that the request is withdrawn.

(3) If the comptroller intends at any time –

(a) to refuse the request because the condition in paragraph (1)(a) or (b) is satisfied; or

(b) to refuse the request because, in accordance with section 74A(3)(b), he considers it inappropriate in all the circumstances to issue an opinion,

he shall notify the requester accordingly.

Rule 78E – Notification and advertisement of request

(1) Unless a request has been refused, the comptroller shall notify the following persons of the request (except where the person concerned is the requester) –

(a) the patent holder;

(b) any holder of a licence or sub-licence under the patent which has been registered under rule 46;

(c) any person who has made a request in respect of the patent under rule 92(1)(ff); and

(d) any person who is specified under rule 78B(2)(a).

(2) In addition, the comptroller may notify of the request any persons who appear to him to be likely to have an interest in the question upon which the opinion is sought.

(3) The comptroller shall send a copy of the form and statement filed under rule 78B(1) to each person so notified (together with a copy of such other documents filed under rule 78B as he sees fit).

(4) The comptroller shall advertise a request in such manner as he may think fit.

Rule 78F – Submission of observations and reply

(1) If the request has not been refused, any person may, before the end of the relevant period, file observations (which must be in duplicate) on any issue raised by the request.

(2) Such observations may include reasons why the comptroller should refuse the request.

(3) The comptroller shall send to the requester a copy of any observations filed under paragraph (1).

(4) The requester may, before the end of the relevant period, file observations confined strictly to matters in reply.

(5) Except where the person concerned is the requester –

(a) the comptroller shall send to the patent holder a copy of any observations filed under paragraph (1) and (4); but

(b) unless the comptroller so directs, the patent holder may not file any observations in reply.

(6) The relevant period is –

(a) for the purposes of paragraph (1), the period of four weeks beginning on the date of advertisement under rule 78E(4);

(b) for the purposes of paragraph (4), the period of four weeks beginning on the date that observations are sent to the requester under paragraph (3).

Rule 78G – Issue of the opinion

(1) After the end of the period mentioned in rule 78F(6)(b), the comptroller shall refer the request to an examiner for the preparation of the opinion.

(2) The comptroller shall issue the opinion by sending a copy to –

(i) the requester;

(ii) the patent holder; and

(iii) any person who filed observations under rule 78F(1).

Rule 78H – Review of opinion

(1) The patent holder may, before the end of the period of three months beginning with the date on which the opinion is issued, apply to the comptroller for a review of the opinion.

(2) However, such proceedings for a review may not be brought (or if brought may not be continued) if other proceedings have been brought in which the issue raised by the review has been (or falls to be) decided.

(3) The application shall be made on Form 2/77, and shall be accompanied by a copy and a statement setting out fully the grounds on which the review is sought.

(4) The statement shall contain particulars of any proceedings of which the applicant is aware which may be relevant to the question whether the proceedings for a review may be brought or continued.

(5) The applicant must provide a copy of any evidence or other document which is referred to in the statement.

(6) Each such statement, evidence or other document must be provided in duplicate.

(7) The application may be made on the following grounds –

(a) that the opinion wrongly concluded that the patent was invalid, or was invalid to a limited extent; or

(b) that, by reason of its interpretation of the specification of the patent, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

Rule 78I – Procedure on review

(1) Upon receipt of the application, the comptroller shall –

(a) send to the requester (if different from the applicant) a copy of the form, statement and other documents filed under rule 78H; and

(b) send to all persons who filed observations under rule 78F a copy of the form and statement (together with such other documents filed under rule 78H as he sees fit).

(2) The comptroller shall advertise the application in such manner as he may think fit.

(3) Before the end of the relevant period, any person may file a statement in support of the application or a counter-statement contesting it (which in either case must be in duplicate), and on so doing shall become a party to the proceedings.

(4) The relevant period is the later to end of the following periods –

(a) the period of four weeks beginning with the date that the application is advertised under paragraph (2);

(b) the period of two months beginning with the date on which the opinion is issued under rule 78G(2).

(5) The comptroller shall send a copy of each statement filed under paragraph (3) to the other parties.

(6) The comptroller may give such directions as he thinks fit with regard to the subsequent procedure.

Rule 78J – Outcome of review

(1) Upon the completion of the proceedings under rule 78I the comptroller shall either –

(a) set aside the opinion in whole or in part; or

(b) decide that no reason has been shown for the opinion to be set aside.

(2) Where the opinion that is set aside concluded that the patent was invalid, or was invalid to a limited extent, the comptroller may decide that the conclusion is to be upheld for reasons different from those given in the opinion.

(3) A conclusion which is upheld under paragraph (2) shall not be binding for any purposes.

(4) A decision under paragraph (1)(a), (1)(b) or (2) shall not estop any party to proceedings from raising any issue regarding the validity or the infringement of the patent.

Rule 78K – Appeals against a decision on review

No appeal under section 97 shall lie from a decision to set aside the opinion under rule 78J(1)(a), except where the appeal relates to a part of the opinion that is not set aside.

Rule 89A – Security for costs or expenses

(1) The conditions prescribed for the purposes of making an order for security for costs under section 107(4) are that the party against whom the order is made –

(a) is resident outside the United Kingdom, but not resident in –

(i) a Brussels Contracting State,

(ii) a Lugano Contracting State, or

(iii) a Regulation State,

as defined in section 1(3) of the Civil Jurisdiction and Judgments Act 1982;

(b) is a company or other body (whether incorporated inside or outside the United Kingdom) and there is reason to believe that it will be unable to pay another party's costs if ordered to do so;

(c) has changed his address for service with a view to evading the consequences of the litigation;

(d) has failed to furnish an address for service or furnished an incorrect address for service; or

(e) has taken steps in relation to his assets that would make it difficult to enforce an order for costs against him.

(2) In relation to proceedings in Scotland, references in this rule to costs are to be construed as references to expenses.

Rule 92 – Request for information under section 118

(1) A request under section 118 for information relating to any patent or application for a patent may be made –

[sub-paragraphs (a) to (d) are unchanged]

(e) as to when a renewal fee has been paid within the period ~~of six months referred to~~ specified in section 25(4);

(f) as to when a patent has ceased to have effect and/or an application for restoration of a patent has been filed;

(ff) as to when an opinion has been requested under rule 78B;

[sub-paragraphs (g) to (i) are unchanged]

[paragraphs (2) to (4) are unchanged]

Rule 93 – Inspection of documents under section 118

[paragraphs (1) to (3) are unchanged]

(4) The restrictions referred to in paragraph (1) above are –

(a) that no document (other than a document filed under rules 78B, 78D or 78F) shall be open to inspection until fourteen days after it has been filed at the Patent Office;

(b) that documents prepared in the Patent Office solely for use therein shall not be open to inspection;

(c) that any document sent to the Patent Office, at its request or otherwise, for inspection and subsequent return to the sender, shall not be open to inspection;

(d) that no document filed at the Patent Office in connection with an application under section

40(1) or (2) or section 41(8) shall be open to inspection unless the comptroller otherwise directs;

(e) that no request made under rule 48, 49(2), 52(2) or 92 or this rule shall be open to inspection;

(f) that documents in respect of which the comptroller issues directions under rule 94 that they are to be treated as confidential shall not be open to inspection, save as permitted in accordance with that rule; ~~and~~

(g) that any documents issued by the Patent Office which the comptroller considers should be treated as confidential shall not be open to inspection unless the comptroller otherwise directs; and

(h) that, where the comptroller has accepted an inventor's application to waive his right –

(i) to have his name and address mentioned; or

(ii) to have his address mentioned.

no document containing his name and address (or, as the case may be, his address) shall be open to inspection unless the comptroller otherwise directs.

[paragraphs (5) and (6) are unchanged]

Rule 94 – Confidential documents

(1) A person filing at, or sending to, the Patent Office, a document other than a Patents Form or a document filed under rules 78B, 78D or 78E, or any party to any proceedings to which the document relates, may, within fourteen days of the filing or sending of the document, request the comptroller (giving reasons for the request) to direct that the document or any part of it specified by him be treated as confidential, and the comptroller may, at his discretion, so direct; and while the request is being considered by the comptroller, that document or part thereof (hereinafter referred to as the relevant document) shall not be open to public inspection.

[paragraphs (2) to (5) are unchanged]

Rule 102 – Remission of fees

[paragraph (1) is unchanged]

(1A) The comptroller may remit the whole or part of the fee payable in respect of a request for an opinion under section 74A where he has refused the request.

(2) In cases falling within paragraph (1)(b) or (1A) above a request for remission of the whole or part of the fee shall be made in writing by the applicant or the requester of the opinion to the comptroller.

(3) No appeal shall lie from any decision of the comptroller under this rule.

Rule 108 – Proceedings in Scotland

(1) Where there is more than one party to the proceedings under section 8, 12, 37, 40(1) or (2), 41(8), 61(3), 71 or 72, or under rule 78H, any party thereto may request the comptroller to direct that the hearing or hearings, if any, in such proceedings shall be held in Scotland and –

[remaining provisions unchanged]

Schedule 2 paragraph 2 – General availability of biological material

[sub-paragraphs (1) to (3) are unchanged]

(4) A request under sub-paragraph (1) above shall comprise, on the part of the person to whom the request relates, undertakings for the benefit of the applicant for, or proprietor of, the patent –

(a) not to make the biological material, or any material derived from it, available to any other person; and

(b) not to use the biological material, or any material derived from it, otherwise than for experimental purposes relating to the subject matter of the invention,

and both undertakings shall have effect –

(i) during any period before the application for a patent has been withdrawn, has been taken to be withdrawn, has been treated as having been withdrawn, has been refused or is treated as having been refused (including any further period allowed under rule 100 or rule 110(1) or (4) but excluding, where an application is reinstated under either of those rules, the period before it is reinstated);

(ii) if a patent is granted on the application, during any period for which the patent is in force and during the period ~~of six months referred to~~ specified in section 25(4).

[sub-paragraphs (5) to (8) are unchanged]

Draft changes to the Patents (Fees) Rules 1998

Rule 3

~~The fees to be paid in respect of any matters arising under the Patents Act 1977 or arising under the Patents Act 1949 shall be those specified in Parts A and B of the Schedule to these Rules; and in any case where a form specified in Part A or B of the Schedule as the corresponding form in relation to any matter is required by the Patents Rules 1995 or, as the case may be, the Patents Rules 1968 to be used, that form shall be accompanied by the fee, if any, specified in respect of that matter or, where payment may be made within a prescribed period of time after the form has been filed, the fee so specified shall be paid within that period.~~

(1) Except where rule 3A or 3B applies, the fees to be paid in respect of any matters arising under the Patents Act 1977 or the Patents Act 1949 are those specified in Parts A and B of the Schedule.

(2) Where a form –

(a) is required to be used by the Patents Rules 1995 or the Patents Rules 1968, and

(b) is specified in Part A or Part B of the Schedule as the corresponding form in relation to any matter,

that form shall be accompanied by the fee specified in respect of that matter.

(3) Paragraph (2) is without prejudice to any provision of those Rules which permits payment to be made before or after the form has been filed.

Rule 3A

(1) Subject to paragraphs (2) and (3), the fee to be paid to keep a patent in force after a renewal date which falls on the anniversary indicated in the first column of the first table in Part A1 of the Schedule is the amount specified in relation to that anniversary in the second column.

(2) Where rule 39A(3) of the 1995 Rules applies, the fee to be paid to keep a patent in force after the first renewal date is the sum of the following amounts –

(a) the amount specified in relation to the relevant anniversary, and

(b) the amounts specified in relation to all previous anniversaries.

(3) Where rule 39A(4) of the 1995 Rules applies, the fee to be paid to keep a patent in force after the first renewal date is the amount specified in relation to the relevant anniversary.

(4) For the purposes of paragraphs (2) and (3), the relevant anniversary is the last anniversary to fall on or before the first renewal date.

Rule 3B

(1) The additional fees prescribed for late payment under section 25(4) of the Patents Act 1977 are specified in the second table in Part A1 of the Schedule.

(2) Where payment is made before the end of the month indicated in the first column of that table, the fee to be paid is the amount specified in the second column.

Schedule to the Patents (Fees) Rules

In Part A of the Schedule, the entry (for Patents Form 12/77) which shows renewal fees and late payment fees will be omitted, and replaced by the following new Part A1.

PART A1

1. Table of renewal fees

<i>Anniversary of date of filing</i>	<i>Amount</i> £
fourth	50
fifth	70
sixth	90
seventh	110
eighth	130
ninth	150
tenth	170
eleventh	190
twelfth	210
thirteenth	230

fourteenth	250
fifteenth	270
sixteenth	300
seventeenth	330
eighteenth	360
nineteenth	400

2. Table of additional fees

<i>Month beginning after the expiry of the period for payment of the renewal fee</i>	<i>Amount of additional renewal fee £</i>
first	0
second	24
third	48
fourth	72
fifth	96
sixth	120

ANNEX B

RELEVANT PROVISIONS OF THE PATENTS ACT 1977 (AS AMENDED BY THE PATENTS ACT 2004)

Introduction

This Annex shows the provisions of the 1977 Act which are relevant to this consultation, and shows how they are to be amended by the 2004 Act. Deletions are shown in strike-out and additions are shown underlined.

Section 16 – Publication of application

(1) Subject to section 22 below and to any prescribed restrictions, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the comptroller shall, unless the application is withdrawn or refused before preparations for its publication have been completed by the Patent Office, publish it as filed (including not only the original claims but also any amendments of those claims and new claims subsisting immediately before the completion of those preparations) and he may, if so requested by the applicant, publish it as aforesaid during that period, and in either event shall advertise the fact and date of its publication in the journal.

[*Subsection (2) is unchanged*]

Section 24 – Publication and certificate of grant

(1) As soon as practicable after a patent has been granted under this Act the comptroller shall publish in the journal a notice that it has been granted.

(2) The comptroller shall, as soon as practicable after he publishes a notice under subsection (1) above, send the proprietor of the patent a certificate in the prescribed form that the patent has been granted to the proprietor.

(3) The comptroller shall, at the same time as he publishes a notice under subsection (1) above in relation to a patent publish the specification of the patent, the names of the proprietor and (if different) the inventor and any other matters constituting or relating to the patent which in the comptroller's opinion it is desirable to publish.

(4) Subsection (3) above shall not require the comptroller to identify as inventor a person who has waived his right to be mentioned as inventor in any patent granted for the invention.

Section 25 – Term of patent

~~(3) A patent shall cease to have effect at the end of the period prescribed for the payment of any renewal fee if it is not paid within that period.~~

(3) Where any renewal fee in respect of a patent is not paid by the end of the period prescribed for payment (the "prescribed period") the patent shall cease to have effect at the end of such day, in the final month of that period, as may be prescribed.

(4) If during ~~the period of six months immediately following the end of the prescribed period~~ the period ending with the sixth month after the month in which the prescribed period ends the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Act as if it had never expired, and accordingly –

- (a) anything done under or in relation to it during that further period shall be valid;
- (b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and
- (c) an act which would constitute the use of the patented invention for the services of the Crown if the patent had not expired shall constitute that use.

Section 28 – Restoration of lapsed patents

(3) If the comptroller is satisfied that the failure of the proprietor of the patent –

- (a) to pay the renewal fee within the prescribed period; or
- (b) to pay that fee and any prescribed additional fee ~~within the period of six months immediately following the end of that period~~ within the period ending with the sixth month after the month in which the prescribed period ended.

was unintentional, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.

Section 32 – Register of patents etc

(2) Without prejudice to any other provision of this Act or rules, rules may make provision with respect to the following matters, including provision imposing requirements as to any of those matters –

- (a) the registration of patents and of published applications for patents;
- (b) the registration of transactions, instruments or events affecting rights in or under patents and applications;
- (ba) the entering on the register of notices concerning opinions issued, or to be issued, under section 74A below;

[*subsequent sub-paragraphs are unchanged*]

Section 36 – Co-ownership

(3) Subject to the provisions of sections 8 and 12 above and section 37 below and to any agreement for the time being in force, where two or more persons are proprietors of a patent one of them shall not without the consent of the other or others –

- (a) amend the specification of the patent or apply for such an amendment to be allowed or for the patent to be revoked, or
- (b) grant a licence under the patent or assign or mortgage a share in the patent or in Scotland cause or permit security to be granted over it.

Section 46 – Patentee’s application for entry in register that licences are available as of right

(3) Where such an entry is made in respect of a patent –

[*sub-paragraphs (a) to (c) are unchanged*]

- ~~(d) the renewal fee payable in respect of the patent after the date of the entry shall be half the fee which would be payable if the entry had not been made.~~

(d) if the expiry date in relation to a renewal fee falls after the date of the entry, that fee shall be half the fee which would be payable had the entry not been made.

(3A) An undertaking under subsection (3)(c) above may be given at any time before final order in the proceedings, without any admission of liability.

(3B) For the purposes of subsection (3)(d) above the expiry date in relation to a renewal fee is the day at the end of which, by virtue of section 25(3) above, the patent in question ceases to have effect if that fee is not paid.

Section 62 – Restriction on recovery of damages for infringement

(2) In proceedings for infringement of a patent the court or the comptroller may, if it or he thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during ~~any further period specified under~~ the further period specified in section 25(4) above, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.

Section 72 – Power to revoke patents on application

(1) Subject to the following provisions of this Act, the court or the comptroller may ~~on the application of any person~~ by order revoke a patent for an invention on the application of any person (including the proprietor of the patent) on (but only on) any of the following grounds, that is to say –

[*sub-paragraphs are unchanged*]

Section 74 – Proceedings in which validity of patent may be put in issue

(8) It is hereby declared that for the purposes of this Act the validity of a patent is not put in issue merely because –

(a) the comptroller is considering its validity in order to decide whether to revoke it under section 73 above, or

(b) its validity is being considered in connection with an opinion under section 74A below or a review of such an opinion.

Opinions by Patent Office

Section 74A – Opinions as to validity or infringement

(1) The proprietor of a patent or any other person may request the comptroller to issue an opinion –

(a) as to whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;

(b) as to whether, or to what extent, the invention in question is not patentable because the condition in section 1(1)(a) or (b) above is not satisfied.

(2) Subsection (1) above applies even if the patent has expired or has been surrendered.

(3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so –

(a) in such circumstances as may be prescribed, or

(b) if for any reason he considers it inappropriate in all the circumstances to do so.

(4) An opinion under this section shall not be binding for any purposes.

(5) An opinion under this section shall be prepared by an examiner.

(6) In relation to a decision of the comptroller whether to issue an opinion under this section –

(a) for the purposes of section 101 below, only the person making the request under subsection (1) above shall be regarded as a party to a proceeding before the comptroller; and

(b) no appeal shall lie at the instance of any other person.

Section 74B – Reviews of opinions under section 74A

(1) Rules may make provision for a review before the comptroller, on an application by the proprietor or an exclusive licensee of the patent in question, of an opinion under section 74A above.

(2) The rules may, in particular –

(a) prescribe the circumstances in which, and the period within which, an application may be made;

(b) provide that, in prescribed circumstances, proceedings for a review may not be brought or continued where other proceedings have been brought;

(c) make provision under which, in prescribed circumstances, proceedings on a review are to be treated for prescribed purposes as if they were proceedings under section 61(1)(c) or (e), 71(1) or 72(1)(a) above;

(d) provide for there to be a right of appeal against a decision made on a review only in prescribed cases.

Section 107 – Costs and expenses in proceedings before the comptroller

~~(4) If any of the following persons, that is to say –~~

~~(a) any person by whom a reference is made to the comptroller under section 8, 12 or 37 above;~~

~~(b) any person by whom an application is made to the comptroller for the revocation of a patent;~~

~~(c) any person by whom notice of opposition is given to the comptroller under section 27(5), 29(2), 47(6) or 52(1) above, or section 117(2) below;~~

~~neither resides nor carries on business in the United Kingdom, the comptroller may require him to give security for the costs or expenses of the proceedings and in default of such security being given may treat the reference, application or notice as abandoned.~~

(4) The comptroller may make an order for security for costs or expenses against any party to proceedings before him under this Act if –

(a) the prescribed conditions are met, and

(b) he is satisfied that it is just to make the order, having regard to all the circumstances of the case;

and in default of the required security being given the comptroller may treat the reference, application or notice in question as abandoned.

Section 123 – Rules

(2) Without prejudice to the generality of subsection (1) above, rules may make provision –

[paragraphs (a) to (h) are unchanged]

~~(i) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;~~

(i) giving effect to an inventor's rights to be mentioned conferred by section 13, and providing for an inventor's waiver of any such right to be subject to acceptance by the comptroller;

[subsequent paragraphs are unchanged]

ANNEX C

WHERE COPIES OF THIS CONSULTATION HAVE BEEN SENT

ABPI
ACID
Agricultural Engineers Association
Allvoice
Anti-Counterfeiting Group
Arnander Irvine & Zietman
Ashurst Morris Crisp
Association of British Insurers
AURIL
Babcock International Ltd
Baker & McKenzie
Bar Council, The
Beresford & Co
Berwin Leighton Paisner
Bharat Electronics Ltd
Biotechnology and BSRC
BPP Leeds IP Group
British Brands Group, The
British Generics Manufacturers Association Ltd
British Library, The
British Pharmaceutical Group Ltd
British Poultry & Meat Federation
British Retail Consortium
Cardiff Law School
Chemical Industries Association
CIMMYT
CIPA
Clifford Chance
Competition Law Association
Confederation of British Industry
Consumers' Association Ltd
Cranfield University
Crop Protection Association
Davenport Lyons
Deloitte & Touche
DTI
EC Laws Committee - LES Britain & Ireland
Eureka Manufacturing Co. Ltd
Europe Analytica
Federation of the Electronics Industry
FICPI
Frank B Dehn
Freshfields
Gallafent & Co
Gill Jennings & Every
Greenpeace
Harbottle & Lewis
Howrey Simon Arnold & White
Incorporated Society of British Advertisers
International Chambers of Commerce
Inventorslink Inc
IPLA
ITMA
Lancaster University
Law Society of Scotland, The
Law Society, The
Linklaters & Paines
Lodestar Translations
Lovells
Magister Ltd
Marketforce Communications
Marks & Clerk
Mewburn Ellis
Microsoft Ltd
Mishcon de Reya
MoD
Norton Rose
Office of Government Commerce
Olswang
Patents judges
Pfizer Limited
PJB Publications
Practical Law Company
Preventative Medicines Tech Inc.
RWS Group
SCRIPT
SIBLE University of Sheffield
Simmons & Simmons
State Patent Bureau of the Republic of Lithuania
Taylor & Meyer
TMPDF
University of Alicante
University of Cambridge
University of London Queen Mary & Westfield
College
University of Oxford
University of Strathclyde
Urquhart-Dykes & Lord
Vereenigde
Visteon Global Technologies
Wedlake Bell

ANNEX D

THE CONSULTATION CODE OF PRACTICE CRITERIA

The six consultation criteria

1. Consult widely throughout the process, allowing a minimum of 12 weeks for written consultation at least once during the development of the policy.
2. Be clear about what your proposals are, who may be affected, what questions are being asked and the timescale for responses.
3. Ensure that your consultation is clear, concise and widely accessible.
4. Give feedback regarding the responses received and how the consultation process influenced the policy.
5. Monitor your department's effectiveness at consultation, including through the use of a designated consultation coordinator.
6. Ensure your consultation follows better regulation best practice, including carrying out a Regulatory Impact Assessment if appropriate.

These criteria must be reproduced within all consultation documents.

Comments about the consultation process

If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Co-ordinator, who is:

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Concept House
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