

CONSULTATION PAPER

PATENTS RULES: MODERNISATION AND CONSOLIDATION

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CONSULTATION PAPER

PATENTS RULES: MODERNISATION AND CONSOLIDATION

Introduction

1. The Patents Rules 1995 (S.I. 1995/2093, as amended) set out procedural and administrative requirements which apply to patents and patent applications. This consultation paper presents a fully modernised and consolidated draft of the Rules. It also proposes some specific changes to certain rules, and seeks comments on those proposals.

Summary

2. We suggest that it is time for a substantial modernisation of the 1995 Rules. The most significant proposal is a completely new approach to the rules on litigation at the Patent Office – with a set of generic rules of procedure which better reflect current litigation practice.
3. Other proposals concern the removal of some fee-bearing Forms, introduction of a Welsh language scheme, updating of some formal requirements (in particular to set out requirements in respect of sequence listings), and updating of provisions generally to reflect modern working practices – such as the availability of documents over the internet and the electronic filing of patent applications.
4. Furthermore the draft Rules include modernised provisions dealing with supplementary protection certificates¹, the new EC Regulation on medicinal products for paediatric use, and the recent EC Regulation on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems.
5. A similar modernisation exercise was undertaken last year for registered designs, resulting in the Registered Designs Rules 2006².

Background

6. The Patents Rules 1995 are the main piece of secondary legislation made under the Patents Act 1977. They regulate the business and procedure of the Patent Office in respect of patents and patent applications – and so they give details of (for example) formal and filing requirements, time

1 These are currently dealt with in a separate piece of legislation – the Patents (Supplementary Protection Certificates) Rules 1997 (S.I. 1997/64).

2 See www.opsi.gov.uk/si/si2006/20061975.htm

periods and deadlines, and procedures concerning how patent disputes are resolved at the Office.

7. The 1995 Rules have been amended 11 times since they came into force. Further details can be found from the Office's view of the 1995 Rules as they currently stand³.
8. As a result, some users have commented that a consolidated version of the Patents Rules would now be helpful and appropriate. However, the 1995 Rules themselves were in large part based on previous Rules packages, and so the wording of many rules can be traced back to 1978 (or earlier). Furthermore, some areas of the Rules are increasingly seen as being at odds with best practice (for example, in the area of case management during litigation) or are seen as unnecessarily lacking in flexibility.
9. The idea of a complete modernisation was therefore put forward, and was welcomed in an informal consultation exercise in late 2005⁴.
10. The following paragraphs set out the more significant proposed changes to the Rules. Full details of these, and of all the more minor alterations and improvements, can be found in the concordance in Annex B.

Proposed structure of the Patents Rules 2007

11. Part 1 (Introductory) sets out definitions, matters of interpretation and provisions concerning Forms and documents.
12. Part 2 (Applications for patents) contains rules which govern the procedure for making and prosecuting a patent application. It therefore contains the rules on claiming priority, inventorship, formal requirements, missing parts, divisional applications, search and examination, amendment before grant, reinstatement and other related matters. It does not contain rules on pre-grant entitlement or inventorship disputes. Most of this material is currently in rules 5 to 6C and 15 to 37 of the 1995 Rules.
13. Part 3 (Granted patents) contains rules which govern post-grant non-contentious matters. Rules on post-grant amendment (but not opposition), renewal fees and restoration, and surrender appear here. This largely corresponds to rules 38 to 43 of the 1995 Rules.
14. Part 4 (The Register and other information) contains rules which apply to the Register of patents, including inspection and correction. These are presently in rules 44 to 53 of the 1995 Rules. It also contains rules regarding access to information generally – such as the rules on caveat requests, inspection of documents that are open to the public,

3 See www.patent.gov.uk/patent/p-decisionmaking/p-law/p-law-legislation.htm

4 See www.patent.gov.uk/about/about-consult/about-informal/about-informal-archive.htm

confidentiality requests and bibliographic information. These matters are currently set out in rules 92 to 96 of the 1995 Rules.

15. Part 5 (European patents (UK)) contains rules which relate to the translation of European patents (UK), the conversion of applications for a European patent (UK), and related matters. It covers what is currently in rules 80 to 84, 86 and 87 of, and some of Schedule 4 to, the 1995 Rules.
16. Part 6 (International applications) contains rules which relate to international applications in the national phase (currently rule 85 of the 1995 Rules) and rules which relate to the Office's role as a receiving office (rules 117 to 120 of the 1995 Rules).
17. Part 7 (Proceedings heard before the comptroller) contains the rules which relate to proceedings before the comptroller in respect of patents and supplementary protection certificates. Almost all the rules in this part are generic and apply to all such proceedings. However, a few specific provisions remain, which relate to one type of proceeding, where this is necessary. This is a significant change from the approach in the 1995 Rules – see paragraphs 21 to 27 below.
18. Part 8 (Opinions) contains the rules which regulate the opinions and review procedures under sections 74A and 74B of the 1977 Act – currently in rules 77A to 77K of the 1995 Rules.
19. Part 9 (Miscellaneous) sweeps up various provisions, including those dealing with address for service, making corrections, remission of fees, extensions of time limits, interrupted days, delays in communications, translations, supplementary protection certificates, official publications and other matters.
20. Proposed Schedules set out detailed provisions on biological material deposits, formal requirements and the extension of time limits. Another Schedule sets out the different classes of proceedings before the comptroller. A fifth provides an index of all terms that are defined in the draft Rules, and two further Schedules contain transitional provisions and repeals.

New rules on litigation at the Office

21. We propose to simplify the rules relating to litigation before the comptroller, for the benefit of users and the Office. At present, every type of dispute has its own collection of rules, which means that the structure of the Patents Rules is unnecessarily complex. Furthermore, many of the specific rules on litigation are very repetitious, with similar procedural points being repeated for each of the disputes which can arise. As a result these rules occupy a disproportionate amount of space in the Rules as a whole.

22. However, there are also arbitrary differences between the rules for different types of dispute, and this in itself creates unnecessary complexity. The differences lie not just in the details but also in the extent to which procedures are prescribed rather than being left to the comptroller's discretion. Furthermore, those rules which are over-prescriptive don't always provide the flexibility to cope with the range of circumstances that can arise. They are also misleading in the sense that, in practice, cases rarely manage to step through the prescribed procedures with no deviations on the way. Moreover, some of the most-prescriptive – and hence longest – rules are for types of dispute that hardly ever occur.
23. Most importantly, there is a significant range of matters on which the existing Rules are largely silent, including the case management powers which the Office is increasingly exercising in order to simplify and accelerate proceedings and reduce their cost to customers.
24. Thus we propose to replace all these rules with a single, common set of rules that apply, so far as possible, to all types of dispute. The litigation rules have the following main features:
- (a) an over-riding objective for the conduct of proceedings which corresponds to that adopted by the courts under the Civil Procedure Rules;
 - (b) the statement and counter-statement stages are prescribed in generic terms, but with a clear indication of what each needs to contain;
 - (c) the time for filing the counter-statement is to be specified by the comptroller so as to give more flexibility if there are problems with the statement;
 - (d) a general duty on the comptroller to notify every person likely to have an interest in the case;
 - (e) evidence rounds to be specified by the comptroller (as is already the case for many types of dispute), again to give more flexibility;
 - (f) general powers for case management and other issues such as striking out.
25. These rules are not intended to change the way a straightforward case is handled. Such a case will still go through much the same steps, and follow much the same timetable, as at present. However, they will eliminate most of the unnecessary complexities mentioned above and be flexible enough to cater for the wide range of situations which arise in proceedings before the comptroller. They will also give greater scope for the use of case management to help bring proceedings to a conclusion more quickly, fairly and effectively.

26. The rules cater for patent proceedings which are started by the claimant filing a Form 2 (e.g. revocation proceedings), and also for proceedings which result when a third party opposes an application by a patent proprietor by filing a Form 15 (e.g. opposition to amendment). And they also cater for proceedings which can be launched in respect of supplementary protection certificates by filing a Form SP3 (e.g. SPC invalidity proceedings). A few provisions for specific types of disputes remain necessary and these are provided for in the last few rules of Part 7.
27. Finally, some rules in Part 7 cover matters which apply not just to litigation between two or more parties, but to any hearing before the comptroller – such as, for example, an *ex parte* hearing on whether a patent application has complied with the formal or substantive requirements. The general powers that hearing officers have in such circumstances have therefore been clarified.

Modernisation of the drafting

28. The new Rules as a whole have been drafted in a modern, consistent way throughout. This compares with the 1995 Rules as amended, where a mix of styles has resulted from some rules being copied out from the Patents Rules 1978 (or earlier) whilst others have been inserted in the modern style. The basic tenets that have been adopted are:
- (a) provisions are shorter, with generally one concept per provision;
 - (b) provisions have been drafted to reflect modern working practices, such as electronic communication, electronic case-files within the Office, the availability of documents over the internet, and electronic libraries of priority documents. For example, there will no longer be a need to file a copy of a granted EP specification when requesting amendment – since these are available to the comptroller over the internet. Another example is that it will be possible to correct a specification, which has been filed electronically, when conversion errors arise following the conversion of the document from one format to another;
 - (c) plain English is used wherever possible, so phrases such as “without prejudice to”, “hereunder”, “aforementioned”, “thereof” and so on are generally avoided;
 - (d) wording of the Act is not repeated in a rule simply in order to provide context;
 - (e) there is an index of defined terms;
 - (f) more detailed matters, as appropriate, are put into Schedules (including the lists of formal requirements);

(g) the “/77” part of Form numbers are dropped, as are other matters which relate solely to procedures under the Patents Act 1949 (e.g. rule 67 of the 1995 Rules and Form 58/77).

29. This is also an opportunity to tackle some provisions in the 1995 Rules which are inconsistent or have become obscure. In particular, the long and complex rule 85 (which relates to international applications) has been thoroughly reviewed, and details of the provisions replacing it can be found in the concordance.

Abolition of Form 11/77

30. We propose to remove the requirement for a Form 11/77 (with £40 fee) when making a request for an amendment or correction. This will simply be done in writing, identifying the amendment or correction concerned – see draft rules 31, 35 and 105.

31. Pre-grant, the form is generally regarded by users and the Office as more trouble than it is worth. In particular, under rule 36 of the 1995 Rules the applicant may amend the description, drawings and claims (after substantive examination) once of his own volition and also in response to any objections. Further amendments (even if entirely desirable and made at the same time as responding to objections) in theory require a form and fee to be paid – although applicants rarely file one and examiners rarely require it.

32. Post-grant, the requirement to file a form hampers the reasonably recent arrangements that have been made for filing and advertising applications for amendment electronically.

Abolition of Form 53/77

33. We propose to remove the requirement for a Form 53/77 (with £135 fee) to be filed once a restoration or an extension of time has been agreed.

34. At present, certain extensions of time are requested under rule 110 of the 1995 Rules, using a Form 52/77 (with £135 fee). If that request is agreed to, a Form 53/77 is then required before the extension is given effect. This essentially penalises the successful applicant, while those applications which are unsuccessful are not penalised in this way. Similarly, under rule 41 of the 1995 Rules, once an application for restoration has been agreed, a Form 53/77 is required before the restoration is effected.

35. Under the proposed new Rules, certain extensions of time will continue to be requested on a Form 52 (with £135 fee). However, no further Form will be required under draft rule 108 to give the extension effect. Similarly, where restoration has successfully been applied for, there is no requirement for a Form 53 to effect the restoration – although draft rule 36(4) and section 28(3) maintain the requirement that a Form 12 is filed, along with payment of the outstanding renewal fees.

Formal requirements; sequence listings

36. We propose to simplify and update the formal requirements for patent applications, currently set out in rules 18 and 20 of the 1995 Rules. Outdated requirements are to be removed and unnecessarily restrictive ones liberalised. Details of the various changes are given in the concordance in Annex B – in particular in relation to Schedule 2 of the draft Rules.
37. Furthermore, requirements relating to sequence listings in patent applications are set out for the first time – see in particular draft rules 13 and 14, and Schedule 2. The requirements in relation to the presentation of such listings in patent applications are linked to those requirements as set out under the Patent Co-operation Treaty⁵.

Divisional applications, etc

38. The 1995 Rules contain a number of somewhat unclear and inconsistent provisions in respect of time periods on divisional applications, and new applications made following entitlement proceedings. The draft Rules generally refer to all such applications as “new applications”, and give an opportunity to introduce a clearer regime.
39. Under draft rules 21, 22 and 28, an applicant who initiates a “new application” will have the same period as calculated on the earlier application in which to file the Form 7, priority document, claims, abstract, application fee, description (if a reference to an earlier application was filed), Form 9A and Form 10. However, this is subject to having a minimum of 2 months from initiating the new application in which to do these things. The exception is if the new application is filed with less than 6 months to go before the end of the period for getting the application in order. (Note that the end of this period is called the “compliance date” in the proposed new Rules.) In this case, all these documents must be provided on initiating the new application. We believe that this provides a more uniform, and fairer, regime than under the current rules.
40. Furthermore, the requirement to file a Form 3 and evidence when requesting permission to make a late declaration of priority under section 5(2B) is waived in respect of all “new applications”. This is because a divisional or other new application can only have a priority declaration which is also made in respect of the earlier application. Thus, if a Form and evidence has been filed in relation to that earlier application, and the comptroller has allowed the late declaration to be made as a result, there is no need to go through the same steps again in respect of any “new application”. This is set out in draft rule 7.

⁵ Currently in WIPO Standard ST.25. See www.wipo.int/scit/en/standards/standards.htm

Certification of documents

41. In respect of providing copies of documents which relate to patents and patent applications, the Office currently offers three levels of certification: uncertified (£5), certified by rubber stamp (£16), and fully certified with signature and seal (£22). The rubber stamp option is now rarely used, and so draft rules 46 and 48 provide for a simpler regime, with only uncertified or fully certified options. This change would simplify Office procedures by removing a little-used service. Nevertheless, it is recognised that those who opt for the rubber stamp certification do make a small saving, and so we propose that the fee for a fully certified copy could be lowered slightly to reflect this fact and the efficiency savings in the Office that would result.

Welsh language documents

42. Various rules are modified to remove obstacles to the implementation of a Welsh language scheme. In particular, changes are made so that the Office can, if desired, allow patent applications to be filed and prosecuted in Welsh. Thus documents which are filed in Welsh will not be required by rules to be translated into English by the filer. Details of the Office's Welsh language scheme as a whole will be published separately.

Supplementary protection certificates ("SPCs")

43. Detailed provisions on SPCs are currently set out in the Patents (Supplementary Protection Certificate) Rules 1997 (S.I. 1997/64). There is scope for some modernisation of these provisions. It would, in our view, also make sense if the various proceedings which can be launched in respect of SPCs (e.g. invalidity proceedings) were to be catered for within the general framework for proceedings before the comptroller, as set out in Part 7 of the draft Patents Rules.

44. Thus updated provisions on SPCs are incorporated into the draft Patents Rules. Note in particular that proceedings in respect of SPCs are included in rule 76(3) and Schedule 3 Part 1. Other matters concerning SPCs are dealt with in draft rules 106 and 116. There is then no need for separate SPC Rules, and so the 1997 SPC Rules would be revoked.

45. Furthermore, the new EC Regulation on medicinal products for paediatric use⁶ will allow an SPC holder or applicant to extend his SPC term by 6 months if he can show that he has complied with a "paediatric investigation plan" concerning paediatric use of the medicinal product concerned. The provisions on SPCs within the draft Patents Rules have been drafted to reflect this position. In particular, rule 116(1) sets out that a paediatric extension can be applied for on a new Form SP4. We propose that the fee to accompany the Form be £200, and that no further fee will be payable on

⁶ Regulation (EC) No. 1901/2006 published 27 December 2006

grant of the extension. Proceedings to revoke a paediatric extension (set out in the new EC Regulation) are included in Part 7 of the draft Rules.

46. It should be noted that, although we intend the Rules to take effect on 1 October 2007, under the terms of Articles 36 and 57 of the new EC Regulation it will not be possible to make an application for an extension until 26 July 2008 (in the circumstances provided for in Article 7 of that Regulation) and until 26 January 2009 (in the circumstances provided for in Article 8 of that Regulation).
47. More details on the rules governing SPCs and the new paediatric extensions are set out in the concordance in Annex B.

The EC compulsory licensing Regulation

48. The recent EC Regulation on the compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems⁷ provides for the availability of a compulsory licence for anyone who wishes to make a specific patented pharmaceutical product solely in order to export it to a developing country with a particular public health problem.
49. The Regulation sets out a number of proceedings which may take place before the comptroller as a result, for example proceedings to apply for, modify or revoke such a licence. It is desirable to have rules setting out the procedural details associated with such proceedings. These proceedings have a good fit with the general framework for proceedings before the comptroller, and so have been swept up within Part 7 of the draft Patents Rules. Once again, Annex B gives some more details.

The draft Patents Rules 2007

50. The draft Patents Rules 2007 are presented in Annex A. We are keen to have comments and suggestions both on the main proposals and on the draft Rules themselves.
51. To help with understanding all of the proposed changes, large and small, a detailed concordance between existing and draft rules is provided in Annex B. A draft Regulatory Impact Assessment is shown in Annex C.
52. Subject to the outcome of this consultation, we propose that the Patents Rules 2007 will be made and published in early Summer and will come into force on 1 October 2007. This delay in commencement will give users and the Office the opportunity to adjust to the new provisions and the re-numbering. It will also give the time for updated guidance to be issued, as well as any comptroller's directions.

⁷ Regulation (EC) No. 816/2006 published 9 June 2006

The draft Patents (Fees) Rules 2007

53. Changes to Form numbering and deletion of some Forms will require modification of the Patents (Fees) Rules 1998. However, these Rules have also been amended over the years and so a consolidation is again proposed. The draft Patents (Fees) Rules 2007 are presented in Annex D.

How and when to respond

54. Please send your responses by **Tuesday 5 June 2007** to:

James Porter
The Patent Office
Concept House
Cardiff Road
Newport NP10 8QQ

Tel: 01633 814521
Fax: 01633 814491
E-mail: consultation@patent.gov.uk

55. Responses may be sent by post, fax or email. 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.

56. You should contact the Office's consultation co-ordinator (see Annex E) with any comments or complaints about the handling of this consultation.

Who is being consulted

57. This consultation document has been prepared in accordance with the Government Code of Practice on Written Consultations, set out in Annex E. Copies have been sent to the individuals and organisations listed in Annex F. It is also available on the Office website⁸ and on paper from James Porter (contact details in paragraph 54).

Openness and publication of responses

58. Your response will be made public unless you make clear that you want it to remain confidential. In this respect, 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 taken as a request for confidentiality, and you should make a specific request if you do not wish your response to be made 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.

⁸ See www.patent.gov.uk/about/about-consult/about-formal/about-formal-current.htm

ANNEX A

DRAFT PATENTS RULES 2007

STATUTORY INSTRUMENTS

2007 No.

PATENTS

Patents Rules 2007

Made - - - -

Laid before Parliament

Coming into force - -

The Secretary of State, in exercise of the powers conferred upon him by sections 14(6), 25(5), 32, 74B, 92, 123, 125A and 130(2) of the Patents Act 1977⁽⁹⁾, following consultation with the Council on Tribunals in accordance with section 8(1) of the Tribunals and Inquiries Act 1992⁽¹⁰⁾, makes the following Rules—

PART 1

INTRODUCTORY

Citation and commencement

1. These Rules may be cited as the Patents Rules 2007 and shall come into force on the [].

General Interpretation

- 2.—(1) In these Rules—

“application number” includes file number;

“initiation date” means the date on which a new application was initiated by documents, mentioned in section 15(1), being filed at the Patent Office;

“new application”, unless the contrary intention appears, means a new application filed under section 8(3), 12(6) or 37(4) or as mentioned in section 15(9);

“termination” has the meaning given by section 20B(7) and “terminated” shall be construed accordingly;

also see the index of defined expressions (rule 120 and Schedule 5).

⁽⁹⁾ 1977 c. 37.

⁽¹⁰⁾ 1992 c. 53.

(2) In these Rules “the Act” means the Patents Act 1977 and, unless the contrary intention appears, “section” means a section of that Act.

(3) Where a period of time has been altered under rules 20(4), 81 or 107 to 111, any reference in these Rules to the period of time shall be construed as a reference to the period as altered.

(4) For the purposes of these Rules, a document is available to the comptroller where—

- (a) it is in electronic storage (whether in the Patent Office or elsewhere) and he can access it by using electronic communications; or
- (b) it is kept at the Patent Office,

and he has been furnished with sufficient information to obtain a copy of the document.

(5) But a document may be treated as unavailable to the comptroller where—

- (a) its accuracy cannot be verified to his satisfaction; or
- (b) he has to pay to access it.

The declared priority date

3.—(1) For the purposes of these Rules the “declared priority date” shall be the date of filing of the earliest relevant application specified in a declaration made for the purposes of section 5(2) in, or in connection with, an application in suit.

(2) For the purposes of these Rules there shall be “no declared priority date” if—

- (a) no declaration has been made for the purposes of section 5(2); or
- (b) every declaration made has been withdrawn or disregarded before the end of the relevant period.

(3) The relevant period ends—

- (a) in the case of an application which falls to be treated as an application for a patent under the Act by virtue of a direction under section 81, when that direction is given.
- (b) in the case of an international application for a patent (UK), when the national phase of the application begins; and
- (c) in any other case, when preparations for the application’s publication have been completed by the Patent Office.

(4) In this rule references to declarations made for the purposes of section 5(2) include declarations treated as made for those purposes.

Forms and documents

4.—(1) The forms of which the use is required by these Rules are those set out in directions under section 123(2A).

(2) Such a requirement to use a form is satisfied by the use of a form which is acceptable to the comptroller and contains the information required by the form as so set out.

(3) Such directions shall be published in accordance with rule 117(c).

(4) Any form or other document filed under the Act or these Rules shall, unless the comptroller otherwise directs, use only one side of each sheet of paper and the other side shall remain blank; otherwise the comptroller may, if he thinks fit, take no further action in relation to that sheet of paper.

(5) But where the information is delivered in electronic form or using electronic communications—

- (a) a requirement under these Rules to use a form; and
- (b) the requirement in paragraph (4),

shall not apply.

PART 2

APPLICATIONS FOR PATENTS

International exhibitions

International exhibitions

5.—(1) — The statement mentioned in section 2(4)(c) that an invention has been displayed at an international exhibition shall be in writing.

(2) The prescribed period for the purposes of section 2(4)(c) shall be the period of 4 months beginning with the date of filing.

(3) But paragraphs (1) and (2) shall not apply where rule 67(2) applies.

(4) The written evidence required by section 2(4)(c) shall be in the form of—

- (a) a certificate issued by the authority responsible for the international exhibition; and
- (b) a statement identifying the invention as being the invention displayed at the exhibition, which has been duly authenticated by that authority.

(5) The certificate shall include the opening date of the exhibition (or if later, the date on which the invention was first displayed).

(6) The comptroller may publish a statement in the journal that a particular exhibition falls within the definition of “international exhibition” in section 130(1).

Declarations of priority

Declaration of priority for the purposes of section 5(2)

6.—(1) Subject to paragraph (2) and rule 7(9), a declaration for the purposes of section 5(2) shall be made at the time of filing the application for a patent.

(2) Subject to rule 7(9), a declaration for the purposes of section 5(2) may be made after the date of filing provided that—

- (a) it is made on Patents Form 3;
- (b) it is made before the end of the period of 16 months beginning immediately following the date of filing of the earlier relevant application (or if there is more than one, the earliest of them) specified in that declaration; and
- (c) the condition in paragraph (3) is met.

(3) The condition is that—

- (a) the applicant has not made a request under section 16(1) for publication of the application during the period prescribed for the purposes of that section; or
- (b) any request made was withdrawn before preparations for the application’s publication have been completed by the Patent Office.

(4) A declaration for the purposes of section 5(2) shall specify—

- (a) the date of filing of each earlier relevant application; and
- (b) the country it was filed in or in respect of.

(5) In the case of a new application filed as mentioned in section 15(9), no declaration shall be made which has not also been made in, or in connection with, the earlier application.

(6) In these Rules, “priority application” means an earlier relevant application specified in the declaration.

Request to the comptroller for permission to make a late declaration under section 5(2B)

7.—(1) The period prescribed for the purposes of section 5(2A)(b) shall be the period of 2 months.

(2) Subject to paragraph (4), a request under section 5(2B) shall be —

- (a) made on Form 3; and
- (b) supported by evidence of why the application in suit was not filed before the end of the period allowed under section 5(2A)(a).

(3) Where that evidence does not accompany the request, the comptroller shall specify a period within which the evidence shall be filed.

(4) In relation to a new application, a request under section 5(2B) may be made in writing and no evidence shall accompany it.

(5) Subject to paragraph (6) and rule 66(3), a request under section 5(2B) may only be made before the end of the period allowed under section 5(2A)(b).

(6) But where a new application is filed after the end of the period allowed under section 5(2A)(b), a request under section 5(2B) may be made on the initiation date.

(7) A request under section 5(2B) may only be made where—

- (a) the condition in paragraph (8) is met; or
- (b) the request is made in relation to an international application for a patent (UK).

(8) The condition is that—

- (a) the applicant has not made a request under section 16(1) for publication of the application during the period prescribed for the purposes of that section; or
- (b) any request made was withdrawn before preparations for the application's publication have been completed by the Patent Office.

(9) Where an applicant makes a request under section 5(2B), he shall make the declaration for the purposes of section 5(2) at the same time as making that request.

Filing of priority documents to support a declaration under section 5(2)

8.—(1) In respect of each priority application to which this paragraph applies the applicant shall, before the end of the relevant period, furnish to the comptroller the application number of that application; otherwise the declaration made for the purposes of section 5(2), in so far as it relates to the priority application, shall be disregarded.

(2) In respect of each priority application to which this paragraph applies the applicant shall, before the end of the relevant period, furnish to the comptroller a copy of that application—

- (a) duly certified by the authority with which it was filed; or
- (b) otherwise verified to the satisfaction of the comptroller,

otherwise the declaration made for the purposes of section 5(2), in so far as it relates to the priority application, shall be disregarded.

(3) Paragraph (1) applies to every priority application except where the application in suit is an international application for a patent (UK) and the application number of the priority application was indicated in compliance with the Patent Co-operation Treaty.

(4) Paragraph (2) applies to every priority application except where—

- (a) the application in suit is an international application for a patent (UK) and a certified copy of the priority application was filed in compliance with the Patent Co-operation Treaty; or
- (b) the priority application or a copy of the priority application is available to the comptroller.

(5) The relevant period is the period of 16 months beginning with the declared priority date (but see rule 21).

Translation of priority documents

9.—(1) The comptroller may direct the applicant to comply with the requirements of paragraph (4), if—

- (a) a copy of the priority application—
 - (i) was furnished in accordance with rule 8(2);
 - (ii) was filed in compliance with the European Patent Convention;
 - (iii) was filed in compliance with the Patent Co-operation Treaty; or
 - (iv) has been made by the comptroller in accordance with rule 112(2);
- (b) that copy is in a language other than English or Welsh; and
- (c) the matters disclosed in the priority application are relevant to the determination of whether or not an invention, to which the application in suit relates, is new or involves an inventive step.

(2) In his direction under paragraph (1), the comptroller shall specify a period within which the applicant must comply with the requirements of paragraph (4).

(3) But the comptroller shall not specify a period that ends after the grant of the patent.

(4) Where the comptroller has given a direction under paragraph (1), the applicant shall, before the end of the period specified by the comptroller, file—

- (a) an English or Welsh translation of the priority application; or
- (b) a declaration that the application in suit is a complete translation into English or Welsh of the priority application,

otherwise the declaration made for the purposes of section 5(2), in so far as it relates to the priority application, shall be disregarded.

Mention of the inventor

Mention of the inventor

10.—(1) Subject to rules 21, 58(4), 59(3) and 68(2), the period prescribed for the purposes of section 13(2) shall be the period of 16 months beginning with —

- (a) where there is no declared priority date, the date of filing of the application;
- (b) where there is a declared priority date, that date.

(2) A statement filed under section 13(2) shall be made on Patents Form 7; and the applicant shall file an additional copy of the statement for each inventor who is not also an applicant.

(3) An inventor or joint inventor, if not mentioned in any published application for a patent for the invention, shall be mentioned in an addendum or an erratum to the application.

(4) Where a person has not been mentioned as sole or joint inventor in pursuance of section 13, any person who alleges that the former ought to have been so mentioned may apply to the comptroller for that person to be mentioned as such in any patent granted for the invention, if possible in any published application for a patent for the invention, and, if not so mentioned, in the manner prescribed by paragraph (3).

Waiving the right to be mentioned

11.—(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 as those of the inventor; or
- (b) to have his address mentioned as that of the inventor.

(2) An application by an inventor under paragraph (1)(a)—

- (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 under paragraph (1)(b) 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.
- (6) An application under paragraph (1)(a) or (b) or under paragraph (4) may also be made by a person who is not the inventor, but who has been identified as such for the purposes of section 13(2).
- (7) Where a person makes an application in reliance on paragraph (6), the reference in this rule to an application to waive his right to have his name and address (or his address) mentioned shall be construed as a reference to an application not to have his name and address (or his address) mentioned; and paragraphs (4) and (5) shall be construed accordingly.

Form and content of applications

Applications for the grant of patents under sections 14 and 15

- 12.**—(1) A request for the grant of a patent shall be made on Patents Form 1.
- (2) Where the documents filed at the Patent Office to initiate an application for a patent did not include the applicant's name and address, the comptroller shall notify the applicant that his name and address are required.
- (3) Where the applicant has been so notified, he shall, before the end of the period of 2 months beginning with the date of the notification, file his name and address; otherwise the comptroller may refuse his application.
- (4) The specification mentioned in section 14(2)(b) shall be preceded by the title of the invention and shall be set out in the following order—
- (a) description;
 - (b) the claim or claims; and
 - (c) any drawing referred to in the description or any claim.
- (5) But paragraph (4) shall not apply where an application is delivered in electronic form or using electronic communications.
- (6) The title of the invention shall be short and indicate the matter to which the invention relates.
- (7) Where the specification includes drawings, the description shall include a list of drawings briefly describing each of them.
- (8) Where—
- (a) the documents filed at the Patent Office to initiate an application for a patent include something which is or appears to be a description of the invention in a language other than English or Welsh; and
 - (b) the applicant has not filed a translation into English or Welsh of that thing;
- the comptroller shall notify the applicant that a translation is required.
- (9) Where the applicant has been so notified, he shall, before the end of the period of 2 months beginning with the date of the notification, file a translation; otherwise the comptroller may refuse his application.

Biological material and sequence listings

- 13.**—(1) The provisions of Schedule 1 prescribe the circumstances in which the specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(2) Where the specification of an application for a patent includes a sequence, it shall also include a sequence listing.

(3) The sequence listing shall comply with any requirements under the Patent Co-operation Treaty relating to the presentation of listings.

(4) A sequence listing shall, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications (this applies even where the application for the patent is not delivered in electronic form or using electronic communications).

(5) A sequence listing may be set out either in the description or at the end of the application (and accordingly rule 12(4) shall not apply).

(6) In these Rules “sequence” and “sequence listing” have the same meaning as under the Treaty.

Size and presentation of application

14.—(1) The contents of all documents (including annotations to drawings) contained in an application for a patent shall be in English or Welsh.

(2) The requirements for the documents contained in an application for a patent (other than drawings) are set out in Parts 1 and 2 of Schedule 2.

(3) The requirements for a drawing contained in an application are set out in Parts 1 and 3 of that Schedule.

(4) All documents contained in an application (including drawings) shall comply with the requirements set out in Part 4 of that Schedule.

(5) Paragraphs (2) and (3) shall not apply to an application, or a sequence listing contained in an application, which is delivered in electronic form or using electronic communications.

The abstract

15.—(1) The abstract shall start with a title for the invention.

(2) The abstract shall contain a concise summary of the matter contained in the specification.

(3) That summary shall include—

(a) an indication of the technical field to which the invention belongs;

(b) the technical problem to which the invention relates;

(c) the gist of the solution to that problem using the invention;

(d) the principal use of the invention.

(4) Where the specification contains any drawings, the abstract shall include an indication of which drawing should accompany the abstract when it is published.

(5) Where a feature of the invention included in the abstract is illustrated in a drawing, the feature shall be followed by the reference for that feature used in that drawing.

(6) Where it appears to the comptroller that a drawing included in the specification better characterises the invention he shall publish it with the abstract.

(7) The abstract shall not contain statements on any merits or value of the invention or its speculative application.

Single inventive concept

16.—(1) For the purposes of the Act, two or more inventions shall be treated as being so linked as to form a single inventive concept where there exists between those inventions a technical relationship which involves one or more of the same or corresponding special technical features.

(2) In paragraph (1), “special technical features” means those technical features which define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

References under section 15(1)(c)(ii)

17.—(1) A reference made under section 15(1)(c)(ii) shall include—

- (a) the date of filing of the earlier relevant application;
- (b) its application number; and
- (c) the country it was filed in or in respect of.

(2) Subject to paragraph (3), the copy of the application provided under section 15(10)(b)(ii) shall—

- (a) be duly certified by the authority with which it was filed or otherwise verified to the satisfaction of the comptroller; and
- (b) where it is in a language other than English or Welsh, be accompanied by—
 - (i) a translation into English or Welsh of that application; or
 - (ii) a declaration that the description filed under sub-paragraph (i) of section 15(10)(b) is a complete and accurate translation into English or Welsh of the description contained in the application provided under sub-paragraph (ii) of that provision.

(3) Where the application or a copy of the application is available to the comptroller it shall, for the purposes of section 15(10)(b)(ii), be treated as having been filed in accordance with rules.

Missing parts

18.—(1) The period prescribed for the purposes of section 15(5)(b) and (6) shall be the period beginning with the date of filing of the application for a patent and ending with the date of the preliminary examination.

(2) But where the applicant is notified under section 15A(9) that a drawing or part of the description of the invention has been found to be missing, the period prescribed for the purposes of section 15(5)(b) and (6) shall be the period of 2 months beginning with the date of the notification.

(3) An applicant may only withdraw a missing part by giving written notice to the comptroller.

(4) A request made under section 15(7)(b) shall be made in writing and shall—

- (a) include sufficient information to identify where in the priority application the contents of the document filed under section 15(5)(b) were included; and
- (b) be made before the end of the period prescribed for the purpose of section 15(5)(b).

(5) Any request under section 15(7)(b) shall be considered never to have been made where—

- (a) the priority application does not contain every missing part filed under section 15(5);
- (b) the applicant fails, before the end of the relevant period, to furnish to the comptroller copies of all earlier relevant applications—
 - (i) duly certified by the authority with which they were filed, or
 - (ii) otherwise verified to the satisfaction of the comptroller.

(6) But paragraph (5)(b) shall not apply in respect of an earlier relevant application where that application or a copy of the application is available to the comptroller.

(7) The relevant period is—

- (a) the period of 16 months beginning with the declared priority date; or
- (b) if it expires earlier, the period of 4 months beginning with the date on which the request was made under section 15(7)(b).

New applications

New applications filed as mentioned in section 15(9)

19.—(1) A new application for a patent may be filed as mentioned in section 15(9)—

- (a) before the end of the relevant period; or
 - (b) if earlier, before the earlier application is terminated or withdrawn.
- (2) Such an application shall include a statement that it is filed as mentioned in section 15(9).
- (3) The relevant period is—
- (a) where an applicant is notified under section 18(4) that his earlier application complies with the requirements of the Act and these Rules, the period of 2 months beginning with the date of that notification; or
 - (b) in any other case, the period ending 3 months before the compliance date of the earlier application.

New applications under section 8(3), 12(6) and 37(4)

20.—(1) The period prescribed for filing a new application under section 8(3) or section 12(6) shall be the relevant period.

(2) A new application for a patent may be filed under section 37(4) before the end of the relevant period.

- (3) The relevant period is—
- (a) where the comptroller’s decision to make an order under those provisions is not appealed, the period of 3 months beginning with the date on which the order was made; or
 - (b) where that decision is appealed, the period of 3 months beginning with the date on which the appeal was finally disposed of.

(4) But the comptroller may, if he thinks fit, shorten the relevant period; and any such alteration shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the comptroller may direct.

Extensions for new applications

21.—(1) Where a new application is filed—

- (a) the period prescribed for the purposes of section 13(2) shall be—
 - (i) the period of 2 months beginning with its initiation date; or
 - (ii) if it expires later, the period prescribed by rule 10(1);
- (b) the relevant period for the purposes of rule 8 shall be—
 - (i) the period of 2 months beginning with its initiation date; or
 - (ii) if it expires later, the period specified in rule 8(5),

and the reference in rule 10(1) to the date of the filing of the application shall be construed as a reference to the date of filing of the earlier application.

(2) But where the new application is filed less than 6 months before the compliance date—

- (a) the period prescribed for the purposes of section 13(2) shall be the period ending with its initiation date; and
- (b) the relevant period for the purposes of rule 8 shall be the period ending with its initiation date (and rule 8(5) shall not apply).

(3) The second requirement in Schedule 1 shall be complied with—

- (a) on the initiation date; or
- (b) if it expires later, before the end of the relevant period specified in paragraph 3(3) of that Schedule.

Period for filing contents of application

Periods prescribed for the purposes of section 15(10) and 17(1)

22.—(1) The period prescribed for the purposes of section 15(10)(a) and (b)(i) shall be the relevant period.

(2) Subject to rules 58(4), 59(3) and 68(3), the period prescribed for the purposes of section 15(10)(c) and (d) and section 17(1) shall be the relevant period.

(3) The period prescribed for the purpose of section 15(10)(b)(ii) shall be the period of 4 months beginning with the date of filing of the application.

(4) But paragraphs (1) to (3) shall not apply to a new application.

(5) In relation to a new application—

(a) the period prescribed for the purposes of section 15(10)(a), (b)(i), (c) and (d) and section 17(1) shall be—

- (i) the period of 2 months beginning with its initiation date; or
- (ii) if it expires later, the relevant period, and

(b) the period prescribed for the purposes of section 15(10)(b)(ii) shall be—

- (i) the period of 2 months beginning with its initiation date; or
- (ii) if it expires later, the period of 4 months beginning with the date of filing of the earlier application,

and the reference in paragraph (7) to the date of filing of the application shall be construed as a reference to the date of filing of the earlier application.

(6) But where the new application is filed less than 6 months before the compliance date, the period prescribed for the purposes of section 15(10)(a) to (d) and section 17(1) shall be the period ending with its initiation date.

(7) The relevant period is—

(a) where there is no declared priority date, the period of 12 months beginning with the date of filing of the application; or

(b) where there is a declared priority date—

- (i) the period of 12 months beginning with the declared priority date; or
- (ii) if it expires later, the period of 2 months beginning with the date of filing of the application.

Preliminary examination

Preliminary examination under section 15A

23.—(1) On the preliminary examination of an application the examiner shall determine whether the application complies with the requirements of rules 6 to 9.

(2) The examiner shall report to the comptroller his determinations under paragraph (1); and the comptroller shall notify the applicant accordingly.

Correcting a declaration made for the purposes of section 5(2)

24.—(1) Where, on the preliminary examination of an application, the examiner finds that a declaration made for the purposes of section 5(2) specifies a date of filing for an earlier relevant application—

- (a) more than 12 months before the date of filing of the application in suit; or
- (b) where the comptroller has given permission for a late declaration to be made under section 5(2), more than 14 months before the date of filing of the application in suit,

he shall report this finding to the comptroller; and the comptroller shall notify the applicant accordingly.

(2) Where the comptroller has notified the applicant, the applicant shall, before the end of the relevant period, provide the comptroller with a corrected date; otherwise the declaration, in so far as it relates to the earlier relevant application, shall be disregarded.

(3) The relevant period is the period of 2 months beginning with the date of that notification.

(4) In paragraph (2), “corrected date” means a date that would not have been reported by the examiner under paragraph (1).

Formal requirements

25.—(1) Subject to paragraphs (2) and (3), the requirements of the following provisions of these Rules shall be formal requirements—

- (a) rule 12(1) (application for a patent on Form 1);
- (b) rule 14(1) (application in English or Welsh); and
- (c) rule 14(2) and (3) (form of documents and drawings).

(2) Where an application is delivered in electronic form or using electronic communications, only the requirements of rule 14(1) shall be formal requirements.

(3) Where an international application for a patent (UK) was filed in accordance with the provisions of the Patent Co-operation Treaty, the requirements mentioned in paragraph (1) shall be treated as complied with to the extent that the application complies with any corresponding provision of that Treaty.

Publication of application

Publication of application

26.—(1) The period prescribed for the purposes of section 16(1) shall be the period of 18 months beginning with—

- (a) where there is no declared priority date, the date of filing of the application; or
- (b) where there is a declared priority date, that date.

(2) Where a person’s application under rule 11(1)(a) or (b) has been accepted by the comptroller, the comptroller shall ensure that the application for the patent as published does not mention his name and address as those of the person believed to be the inventor (or, as the case may be, his address as that of the person so believed).

Search and substantive examination

Search under section 17

27.—(1) A request under section 17(1)(c)(i) for a search shall be made on Patents Form 9A.

(2) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner’s report made under section 17.

(3) Where an examiner only conducts a search in relation to the first of two or more inventions, in accordance with section 17(6), he shall report this fact to the comptroller; and the comptroller shall notify the applicant accordingly.

(4) The applicant shall pay any search fee in relation to those inventions (other than the first) on or before the relevant date.

(5) The relevant date is the first day of the 3 month period ending with the compliance date of the application.

(6) The fee for a supplementary search under section 17(8), or a search under section 17(6), shall be accompanied by Patents Form 9A.

Request for substantive examination under section 18

28.—(1) A request for a substantive examination of an application shall be made on Patents Form 10.

(2) Subject to paragraph (3) and rules 60 and 68(4), the period prescribed for the purposes of section 18(1) shall be the period of 6 months beginning with the date the application was published.

(3) Where the comptroller has given directions under section 22(1) or (2) in relation to information contained in the application, the period prescribed for the purposes of section 18(1) shall be the relevant period.

(4) But paragraphs (2) and (3) shall not apply to a new application.

(5) In relation to a new application, the period prescribed for the purposes of section 18(1) shall be—

- (a) the period of 2 months beginning with its initiation date; or
- (b) if it expires later, the relevant period,

and the reference in paragraph (7) to the date of filing of the application shall be construed as a reference to the date of filing of the earlier application

(6) But where the new application is filed less than 6 months before the compliance date, the period prescribed for the purposes of section 18(1) shall be the period ending with its initiation date.

(7) The relevant period is the period of 2 years beginning with—

- (a) where there is no declared priority date, the date of filing of the application; or
- (b) where there is a declared priority date, that date.

Substantive examination reports

29.—(1) Whenever the examiner reports to the comptroller under section 18 on whether the application complies with the requirements of the Act and these Rules, the comptroller shall send a copy of that report to the applicant.

(2) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner's report.

(3) For the purposes of rule 30 and 31—

- (a) “first substantive examination report” means the first report sent to the applicant under paragraph (1); and
- (b) “first observations report” means a report sent to the applicant under paragraph (1) which meets the condition in paragraph (4).

(4) The condition is that—

- (a) a person has made observations to the comptroller under section 21(1) on the question whether the invention is a patentable invention;
- (b) the examiner has reported to the comptroller, as a consequence of those observations, that the invention does not comply with the requirements of the Act or these Rules; and
- (c) the comptroller has not previously sent the applicant a report, relating to those observations, under paragraph (1).

Period for putting application in order and compliance date

30.—(1) The period prescribed for the purposes of section 18(4) and 20(1) is the relevant period.

(2) Subject to paragraphs (3) and (4), the relevant period is—

- (a) the period of 4 years and 6 months beginning with—
 - (i) where there is no declared priority date, the date of filing of the application; or
 - (ii) where there is a declared priority date, that date; or
 - (b) if it expires later, the period of 12 months beginning with the date on which the first substantive examination report is sent to the applicant.
- (3) Subject to paragraph (4), where a new application is filed the relevant period is—
- (a) where it is filed under section 8(3), 12(6) or 37(4)—
 - (i) the period specified in paragraph (2) in relation to the earlier application; or
 - (ii) if it expires later, the period of 18 months beginning with the initiation date; and
 - (b) where it is filed as mentioned in section 15(9), the period specified in paragraph (2) in relation to the earlier application.
- (4) Where the first observations report is sent to the applicant during the last 3 months of the period specified in paragraphs (2) or (3), the relevant period is the period of 3 months beginning with the date on which that report is sent.
- (5) In this Part, the “compliance date”, in relation to an application, means the last day of the relevant period.

Amendment of application before grant

- 31.**—(1) A request to amend an application for a patent under section 19(1) shall be made in writing.
- (2) The conditions prescribed under section 19(1) are as follows.
 - (3) The applicant may only amend his application within the amendment period.
 - (4) But after the end of the amendment period, the applicant may—
 - (a) where the first substantive examination report states that his application complies with the requirements of the Act and these Rules, amend his application once before the end of the period of 2 months beginning with the date on which that report was sent; or
 - (b) in any other case, amend his application once provided that he does so at the same time as he makes his first observations on, or amendments to, his application under section 18(3).
 - (5) The amendment period is the period beginning with the date on which the applicant is informed of the examiner’s report under section 17(5) and—
 - (a) ending with the date on which the comptroller sends him the first substantive examination report; or
 - (b) where the first substantive examination report is sent before preparations for the application’s publication have been completed by the Patent Office, ending with the date on which the applicant makes his first observations on, or amendments to, his application under section 18(3) (and paragraph (4) shall not apply).
 - (6) The applicant may not amend his application to add a sequence listing.
 - (7) The condition in paragraphs (3), (4) and (6) shall not apply—
 - (a) where the comptroller consents to the amendment; or
 - (b) to an amendment of a request for the grant of a patent.
 - (8) Where the comptroller’s consent is required, or the applicant wishes to amend the request for the grant of a patent, he shall include the reasons for the amendment.

Reinstatement of applications under section 20A

- 32.**—(1) A request under section 20A for the reinstatement of an application shall be made before the end of the relevant period.
- (2) The relevant period is—

- (a) the period of 2 months beginning with the date on which the removal of the cause of non-compliance occurred; or
 - (b) if it expires earlier, the period of 12 months beginning with the date on which the application was terminated.
- (3) The request shall be made on Patents Form 14.
- (4) Where the comptroller is required to publish a notice under section 20A(5), it shall be published in the journal.
- (5) The applicant shall file evidence in support of that request.
- (6) Where that evidence does not accompany the request, the comptroller shall specify a period within which the evidence shall be filed .
- (7) Where, upon consideration of that evidence, the comptroller is not satisfied that a case for an order under section 20A has been made out, he shall notify the applicant accordingly.
- (8) The applicant may, before the end of the period of 1 month beginning with the date of that notification, request to be heard by the comptroller.
- (9) Where the applicant requests a hearing, the comptroller shall give him an opportunity to be heard; after which the comptroller shall determine whether the request under section 20A shall be allowed or refused.
- (10) Where the comptroller reinstates the application after a notice was published under paragraph (4), he shall advertise the fact in the journal.
- (11) In determining the date on which the removal of the cause of non-compliance occurred, the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.

Observations by third parties on patentability

33.—(1) The comptroller shall send to the applicant a copy of any observations on patentability he receives under section 21.

(2) But paragraph (1) shall not apply where, in the opinion of the comptroller, those observations would—

- (a) disparage any person in a way likely to damage him, or
- (b) be generally expected to encourage offensive, immoral or anti-social behaviour.

(3) The comptroller may, if he thinks fit, send to the applicant a copy of any documents referred to in the observations.

(4) The comptroller shall send to an examiner any observations on patentability.

(5) But paragraph (4) shall not apply where the observations are received after the examiner has reported under section 18(4) that an application complies with the requirements of the Act and these Rules.

PART 3

GRANTED PATENTS

Certificate and amendment

Certificate of grant

34. The certificate of grant of a patent shall be in a form which includes—

- (a) the name of the proprietor;
- (b) the date of filing of the application; and
- (c) the number of the patent.

Amendment of specification after grant

35.—(1) An application by the proprietor of a patent for the specification of the patent to be amended shall—

- (a) be made in writing;
- (b) identify the proposed amendments; and
- (c) state the reason for making those amendments.

(2) The application shall, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications.

(3) The comptroller may, if he thinks fit, direct the proprietor to file a copy of the specification with the amendment applied for marked on it.

(4) Where the specification of a European patent (UK) was published in a language other than English, the proprietor shall file a translation into English of the part of the specification which he is applying to amend and a translation of the amendment.

(5) The comptroller may, if he thinks fit, direct the proprietor to file a translation into English of the specification as published.

(6) Where the court or the comptroller allows the proprietor of a patent to amend the specification of the patent, the comptroller may direct him to file an amended specification which complies with the requirements of Schedule 2.

Renewal

Renewal of patents: general

36.—(1) In this rule and in rules 37 to 41—

“renewal date” has the meaning given in rules 37(2) to (4) and 38(3);

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

“renewal period” means the period prescribed by rule 37 or 38 for the payment of a renewal fee.

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

(3) Patents Form 12 must be filed before the end of the renewal period.

(4) But where payment is made pursuant to section 25(4) or section 28(3), Patents Form 12 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.

Renewal of patents: first renewal

37.—(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 renewal period is the period of 3 months ending with the last day of the month in which that renewal date falls.

(3) Where a patent is granted under the Act during the period of 3 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 3 months beginning with the date on which the patent was granted; and

(b) the renewal 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 during the period of 3 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 3 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 renewal 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 the first renewal date falls; or
 - (ii) in case B, the period of 3 months ending with the last day of the month in which the first renewal date falls.

Renewal of patents: subsequent renewals

38.—(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 renewal period is the period of 3 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.

Renewal notice

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

(2) The comptroller shall, before the end of the period of 6 weeks beginning immediately after the end of the renewal period, 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 proprietor of the patent—

- (a) that payment is overdue; and
- (b) of the consequences of non-payment.

Restoration of lapsed patents under section 28

40.—(1) An application under section 28 for restoration of a patent may be made at any time before the end of the period ending with the thirteenth month after the month in which the period specified in section 25(4) ends.

(2) The application shall be made on Patents Form 16.

(3) The notice of the application shall be published in the journal.

(4) The applicant shall file evidence in support of the application.

(5) Where that evidence does not accompany the application, the comptroller shall specify a period within which the evidence shall be filed.

(6) Where, upon consideration of that evidence, the comptroller is not satisfied that a case for an order under section 28 has been made out, he shall notify the applicant accordingly.

(7) The applicant may, before the end of the period of 1 month beginning with the date of that notification, request to be heard by the comptroller.

(8) Where the applicant requests a hearing, the comptroller shall give the applicant an opportunity to be heard; after which he shall determine whether the application under section 28 shall be granted or refused.

(9) Where the comptroller grants the application he shall advertise the fact in the journal.

Notification of lapsed patent

41.—(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 renewal period, 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, before the end of the period of 6 weeks beginning immediately after 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 39(3).

Surrender and cancelling entry that licences available as of right

Surrender

42. The notice of an offer by a proprietor to surrender a patent shall be in writing and include—

- (a) a declaration that no action is pending before the court for infringement or revocation of the patent; or
- (b) where such an action is pending, the particulars of the action.

Application for, and cancellation of, an entry that licences are available as of right

43.—(1) An application under section 46(1) shall be made on Patents Form 28.

(2) Where an entry is made in the register to the effect that licences under a patent are to be available as of right, the comptroller shall advertise the fact in the journal.

(3) An application under section 47(1) for the cancellation of an entry made under section 46 shall be made on Patents Form 30.

(4) The period prescribed for the purposes of section 47(3) shall be the period of 2 months beginning with the date on which the entry was made under section 46.

PART 4

THE REGISTER AND OTHER INFORMATION

Entries in the register

44.—(1) When an application for a patent is published, the following matters shall be entered in the register—

- (a) the name of the applicant;
- (b) the name and address of the person identified as the inventor;
- (c) the address of the applicant and his address for service;
- (d) the title of the invention;
- (e) the date of filing of the application for a patent;
- (f) the application number;
- (g) where a declaration has been made for the purposes of section 5(2)—
 - (i) the date of filing of each earlier relevant application specified in the declaration;
 - (ii) its application number; and
 - (iii) the country it was filed in or in respect of;
- (h) the date of the application's publication.

(2) But where a person's application under rule 11(1)(a) or (b) has been accepted by the comptroller, the comptroller may omit from the register his name and address (or, as the case may be, his address) as that of the person believed to be the inventor.

(3) Where the application for a patent has been published, the following matters shall be entered in the register as soon as practicable after the event—

- (a) the date on which a request is made by an applicant for the substantive examination of his application;
- (b) the date on which an application is terminated or withdrawn.

(4) When the patent is granted, the following matters shall be entered in the register—

- (a) the date on which the comptroller granted the patent;
- (b) the name of the proprietor of the patent;
- (c) where the address of the proprietor or his address for service was not entered in the register under paragraph (1), that address or address for service.

(5) In relation to a request for an opinion under section 74A, the following matters shall be entered in the register as soon as practicable after the event—

- (a) a notice that a request under section 74A(1)(a) or (b) has been received;
- (b) a notice that such a request has been refused or withdrawn; and
- (c) a notice that an opinion has been issued.

(6) A notice of any transaction, instrument or event mentioned in section 33(3) shall be entered in the register as soon as practicable after it occurs (or, if later, when the application is published).

(7) The comptroller may, at any time, enter in the register such other particulars as he may think fit.

Advertisement in relation to register

45. The comptroller may publish or advertise such things done under the Act or these Rules in relation to the register as he may think fit.

Copies of entries in, or extracts from, the register and certified facts

46.—(1) An application under section 32(6) for a certified copy of an entry in the register, or a certified extract from the register, shall be made on Patents Form 23.

(2) A person may apply on Patents Form 23 for an uncertified copy of an entry in the register or an uncertified extract from the register; and he shall be entitled to such a copy or extract on payment of the prescribed fee.

(3) A person may apply on Patents Form 23 for a certificate which certifies that—

- (a) an entry has or has not been made in the register; or
- (b) something which the comptroller is authorised to do has or has not been done.

Registrations of transactions, instruments and events

47.—(1) An application to register (or in the case of an application for a patent which has not been published, to give notice of) any transaction, instrument or event mentioned in section 33(3) shall—

- (a) be made on Patents Form 21; and
- (b) include evidence establishing the transaction, instrument or event.

(2) The comptroller may direct that such evidence as he may require in connection with the application shall be sent to him within such period as he may specify.

Copies of documents and corrections in relation to the register

Copies of documents

48.—(1) A person may apply to the comptroller for a certified copy of any relevant document; and he shall be entitled to such a copy.

(2) A person may apply to the comptroller for an uncertified copy of any relevant document; and he shall be entitled to such a copy.

(3) But a person is not entitled to a copy of a relevant document where—

- (a) it is not available for inspection under section 118; or
- (b) making or providing such a copy would infringe copyright.

(4) The relevant documents are—

- (a) any application for a patent which has been published;
- (b) any specification of a patent; and
- (c) any other document, or extract from any such document, kept at the Patent Office.

(5) An application under paragraph (1) or (2) shall be made on Patents Form 23.

Correction of name, address and address for service

49.—(1) Any person may request that a correction to his name, address or address for service—

- (a) be entered in the register; or
- (b) be made to any application or other document filed at the Patent Office.

(2) A request under paragraph (1) to correct a name shall be made on Patents Form 20.

(3) Any other request under paragraph (1) shall be made in writing.

(4) Where the comptroller has reasonable doubts about whether he should make the correction—

- (a) he shall inform the person making the request of the reason for his doubts; and
- (b) he may require that person to file evidence in support of the request.

(5) Where the comptroller has no doubts (or no longer has doubts) about whether he should make the correction, it shall be entered in the register or made to the application or document.

(6) For the purposes of this rule, a request for a correction includes a correction made for the purposes of section 117.

Request for correction of error

50.—(1) Subject to rule 49, any person may request the correction of an error in the register or in any document filed at the Patent Office in connection with registration.

(2) The request shall be—

- (a) made in writing; and
- (b) accompanied by sufficient information to identify the nature of the error and the correction requested.

(3) Where the comptroller has reasonable doubts about whether there is an error—

- (a) he shall inform the person making the request of the reason for his doubts; and
- (b) he may require that person to furnish a written explanation of the nature of the error or evidence in support of the request.

(4) Where the comptroller has no doubts (or no longer has doubts) about whether an error has been made he shall make such correction as he may agree with the proprietor of the patent (or, as the case may be, the applicant).

Requests for information or documents

Restrictions on inspection of documents

51.—(1) For the purposes of section 118(1) the prescribed restrictions are those set out in paragraphs (2) and (3).

(2) No document may be inspected—

- (a) where that document was prepared by the comptroller, an examiner or the Patent Office for internal use only;
- (b) where the circumstances specified in section 118(4) exist, before the end of the period of 14 days beginning with the date of the notification under rule 52(2);
- (c) where it is a request or application made under section 118 or rules 46(2), 48(2) or 54(1);
- (d) where the document includes matter—
 - (i) which in the comptroller's opinion disparages any person in a way likely to damage him, or
 - (ii) the inspection of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

(3) Unless in a particular case the comptroller otherwise directs, no document may be inspected—

- (a) where the document was filed at the Patent Office in connection with an application under section 40(1), (2) or 41(8);
- (b) where it is treated as a confidential document (under rule 53);
- (c) where—
 - (i) the document was prepared by the comptroller, an examiner or the Patent Office other than for internal use; and
 - (ii) it contains information which the comptroller considers should remain confidential;
- (d) where it relates to an international application for a patent and the International Bureau would not be permitted to allow access to that document under the Patent Co-operation Treaty;
- (e) where—
 - (i) the comptroller has accepted a person's application under rule 11(1)(a) or (b); and

- (ii) that person's name and address can be identified from the document as those of the inventor or of the person believed to be the inventor (or, as the case may be, his address can be so identified).
- (4) In this rule references to a document include part of a document.

Request for information where section 118(4) applies

52.—(1) Where the circumstances specified in section 118(4) exist, a request under section 118(1) shall be accompanied by evidence verifying their existence.

(2) The comptroller shall notify the applicant for the patent of any request.

(3) The notification shall be accompanied by a copy of the request and the accompanying evidence.

(4) The applicant may, before the end of the period of 14 days beginning with the date of the notification, inform the comptroller that the circumstances specified in section 118(4) do not exist; otherwise the comptroller may treat him as accepting that those circumstances exist.

Confidential documents

53.—(1) Where a person files a document at the Patent Office or sends it to an examiner or the comptroller, any person may request that the document be treated as a confidential document.

(2) The comptroller shall refuse any request where it relates to—

- (a) a Patents Form; or
- (b) any document filed in connection with a request under section 74A.

(3) A request to treat a document as confidential shall—

- (a) be made before the end of the period of 14 days beginning with the date on which the document was—
 - (i) filed at the Patent Office, or
 - (ii) received by the comptroller, an examiner or the Patent Office; and
- (b) include reasons for the request.

(4) Where a request has been made under paragraph (1), the document shall be treated as confidential until the comptroller refuses that request or gives a direction under paragraph (5).

(5) Where it appears that there is good reason for the document to remain confidential, the comptroller may direct that the document shall be treated as a confidential document; otherwise he shall refuse the request made under paragraph (1).

(6) But where the comptroller believes there is no longer a good reason for the direction under paragraph (5) to continue in force, he shall revoke it.

(7) In this rule references to a document include part of a document.

Requests for certain information

54.—(1) A person may request to be notified of a relevant event on Patents Form 49.

(2) Where a person has made such a request, the comptroller shall notify him that the relevant event has occurred as soon as practicable after the event.

(3) But the comptroller shall not give him information or permit him to inspect a document unless he would be entitled to such information or to inspect such a document under section 118.

(4) A request on Patents Form 49 shall only be for information regarding a single relevant event.

(5) For the purposes of paragraph (1), in relation to an application for a patent, the following are relevant events—

- (a) an applicant requesting, or failing to request, a substantive examination before the end of the period prescribed for the purposes of section 18(1);

- (b) the application being published;
 - (c) the notice of grant of the patent being published under section 24;
 - (d) the application being terminated or withdrawn.
- (6) For the purposes of paragraph (1), in relation to a patent, the following are relevant events—
- (a) a request for an opinion under section 74A;
 - (b) the patent ceasing to have effect by reason of section 25(3);
 - (c) the renewal fee and any additional fee being paid during the period specified in section 25(4);
 - (d) an application being made for the restoration of the patent which has ceased to have effect.
- (7) For the purposes of paragraph (1), in relation to a patent or an application for a patent, the following are relevant events—
- (a) an entry being made in the register;
 - (b) a document becoming available for inspection under section 118 (by reason of a prescribed restriction no longer applying to the document);
 - (c) an application to register a transaction, instrument or event being made under rule 47;
 - (d) a matter being published in the journal.

Bibliographic information about an unpublished application

55. For the purposes of section 118(3)(b) the following bibliographic information is prescribed—

- (a) the name of the applicant;
- (b) the title of the invention;
- (c) the number of the application;
- (d) the date of filing of the application;
- (e) where a declaration has been made for the purposes of section 5(2)—
 - (i) the date of filing of each earlier relevant application specified in the declaration;
 - (ii) its application number; and
 - (iii) the country it was filed in or in respect of;
- (f) where an application has been terminated or withdrawn, that information; and
- (g) where a transaction, instrument or event mentioned in section 33(3) is notified to the comptroller, that information.

PART 5

EUROPEAN PATENTS (UK)

Translations

Translations of European patents (UK)

56.—(1) A translation into English of—

- (a) the specification of the European patent (UK), which is filed under section 77(6); or
- (b) the claims of the specification of the application for a European patent (UK), which is filed under section 78(7),

shall be accompanied by Patents Form 54.

- (2) The translation shall comply with the requirements set out in Parts 1 to 3 of Schedule 2.
- (3) The translation and Patents Form 54 shall be filed in duplicate.
- (4) But paragraphs (2) and (3) shall not apply where a translation is delivered in electronic form or using electronic communications.
- (5) Where the specification includes any drawings all annotations in French or German shall be replaced with annotations in English.
- (6) The period prescribed for the purposes of section 77(6)(a) shall be the period of 3 months beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin.
- (7) The period prescribed for the purposes of section 77(6)(b) shall be the period of 3 months beginning with the date of publication, by the European Patent Office, of the specification as amended.
- (8) No translation may be filed under section 77(6)(a) or (b) before the beginning of the period prescribed for the purposes of that provision.

Corrected translations

- 57.**—(1) A corrected translation filed under section 80(3) shall be accompanied by Patents Form 54.
- (2) The corrected translation shall comply with the requirements set out in Parts 1 to 3 of Schedule 2.
- (3) Where the corrected translation includes any drawings all annotations in French or German shall be replaced with annotations in English.
- (4) The corrected translation and Patents Form 54 shall be filed in duplicate.
- (5) But paragraphs (2) to (4) shall not apply where a translation is delivered in electronic form or using electronic communications.
- (6) The period prescribed for the purposes of section 80(3) for payment of the prescribed fee shall be the period of 14 days beginning with the day the corrected translation is filed.

Conversion requests

Procedure for making a conversion request under section 81(2)(b)(i)

- 58.**—(1) A request under section 81(2)(b)(i) shall be—
- (a) made in writing; and
 - (b) accompanied by a copy of the notification by the European Patent Office that the application has been deemed to be withdrawn.
- (2) When making such a request, a person may also request the comptroller to send—
- (a) a copy of his application for a European patent (UK); and
 - (b) a copy of the request,
- to the central industrial property office of any contracting state designated in the application.
- (3) The period prescribed for the purposes of section 81(2)(b)(i) shall be the period of 3 months beginning with the date of the notification mentioned in paragraph (1)(b).
- (4) Where a request has been made under section 81(2)(b)(i), the period prescribed for the purposes of sections 13(2), 15(10)(d) and 81(2)(c) shall be the period of 2 months beginning with the date on which the comptroller received that request.
- (5) In paragraph (2) “contracting state” means a country which is a party to the European Patent Convention.

Procedure for making a conversion request under section 81(2)(b)(ii)

59.—(1) The period prescribed for the purposes of section 81(2)(b)(ii) shall be the period of 20 months beginning with—

- (a) where there is no declared priority date, the date of filing of the application; or
- (b) where there is a declared priority date, that date.

(2) Where a request, transmitted under section 81(2)(b)(ii), has been received by the comptroller, he shall notify the applicant accordingly.

(3) Where a request has been transmitted under section 81(2)(b)(ii), the period prescribed for the purposes of sections 13(2), 15(10)(d) and 81(2)(c) shall be the period of 4 months beginning with the date of that notification.

Request for substantive examination following a direction under section 81

60. Where an application for a European patent (UK) falls to be treated as an application for a patent under the Act by virtue of a direction under section 81, the period prescribed for the purposes of section 18(1) shall be the period of 2 years beginning with—

- (a) where there is no declared priority date, the date of filing of the application; or
- (b) where there is a declared priority date, that date.

Obligations to other contracting parties to the European Patent Convention

Recognition of patent decision of competent authorities of other states

61.—(1) Where in proceedings before the comptroller a person seeks recognition of a relevant determination, he shall furnish to the comptroller a copy of the determination duly certified by the relevant official of the competent authority.

(2) In paragraph (1), “relevant determination” means the determination of a question to which section 82 applies by the competent authority of a relevant contracting state other than the United Kingdom.

Procedure for obtaining evidence for proceedings under the European Patent Convention

62.—(1) An application to the comptroller for an order under the Evidence (Proceedings in Other Jurisdictions) Act 1975(**11**) as applied by section 92(1) shall be—

- (a) made in writing;
- (b) supported by written evidence;
- (c) accompanied by the request as a result of which the application is made, and where appropriate, a translation of the request into English; and
- (d) accompanied by the prescribed fee.

(2) The application shall be made without notice.

(3) The comptroller may permit an officer of the European Patent Office to—

- (a) attend the hearing and examine the witnesses; or
- (b) request the comptroller to put specified questions to the witnesses.

Communication of information to the European Patent Office

63. The comptroller may authorise any information in the files of the Patent Office to be communicated to the European Patent Office or to a competent authority of any country which is a

(11) 1975 c. 34.

party to the European Patent Convention, except where that information cannot be communicated under section 118.

PART 6 INTERNATIONAL APPLICATIONS

Interpretation

Interpretation relating to international applications

64.—(1) In these Rules the following have the same meaning as they have in the Patent Co-operation Treaty—

- “competent receiving Office”;
- “International Preliminary Examination Report”;
- “International Preliminary Report on Patentability”;
- “International Search Report”;
- “International Searching Authority”;
- “receiving Office”.

Filing at the Patent Office

Filing of international applications at the Patent Office

65.—(1) An international application for a patent filed at the Patent Office as a competent receiving Office under the Patent Co-operation Treaty shall be filed—

- (a) in English or Welsh; and
- (b) in triplicate.

(2) Where less than 3 copies of the application are filed, the comptroller may direct the applicant to pay any copying costs.

(3) Where the Patent Office was acting on behalf of the International Bureau as the receiving Office, the comptroller shall only transmit an international application for a patent filed at the Patent Office to the International Bureau and the International Searching Authority after the appropriate fee has been paid.

(4) A request under the Treaty for a certified copy of an international application for a patent (including any corrections to that application) filed at the Patent Office as the competent receiving Office shall be filed on Patents Form 23.

Beginning the national phase, international exhibitions and altered prescribed periods

Beginning of national phase

66.—(1) The prescribed period for the purposes of section 89A(3)(a) and (5)(a) shall be the period of 31 months beginning with—

- (a) where there is no declared priority date, the date of filing of the application;
- (b) where there is a declared priority date, that date.

(2) But where the applicant has been notified under rule 69(5), the period prescribed for the purposes of section 89A(3)(a) and (5)(a) shall be the period of 3 months beginning with the date of the notification.

(3) Where an international application for a patent (UK) has begun the national phase, a request may be made under section 5(2B) before the end of the period of 1 month beginning with the date the national phase of the application begins.

International exhibitions

67.—(1) Paragraph (2) applies where an applicant, on filing an international application for a patent (UK), states in writing to the receiving office that the invention has been displayed at an international exhibition.

(2) The prescribed period for the purposes of section 2(4)(c) shall be the period of 2 months beginning with the date on which the national phase begins.

Altered prescribed periods

68.—(1) This rule applies to an international application for a patent (UK) which has begun the national phase of the application.

(2) The period prescribed for the purposes of section 13(2) shall be—

- (a) the period prescribed by rule 10(1); or
- (b) if it expires later, the period of 2 months beginning with the date on which the national phase begins.

(3) The period prescribed for the purposes of section 15(10)(c) and (d) and 17(1) shall be—

- (a) the period prescribed by rule 22(2); or
- (b) if it expires later, the period of 2 months beginning with the date on which the national phase begins.

(4) The period prescribed for the purposes of section 18(1) shall be—

- (a) the period of 33 months beginning with—
 - (i) where there is no declared priority date, the date of filing of the application; or
 - (ii) where there is a declared priority date, that date; or
- (b) if it expires later, the period of 2 months beginning with the date on which the national phase begins.

Translations

Necessary translations under section 89A(3) and (5)

69.—(1) A translation is necessary for the purposes of section 89A(3) where any of the following are not in English—

- (a) the international application for a patent (UK) as published in accordance with the Patent Co-operation Treaty;
- (b) where the information mentioned in paragraphs 3(2)(a) and (b) of Schedule 1 (biological material) has been provided, that information.

(2) Where the applicant expressly requests the comptroller to proceed with the national phase before the end of the period prescribed by rule 66(1), the translation shall include the request and abstract.

(3) But paragraph (2) shall not apply where a copy of the application, as published in accordance with the Treaty, is available to the comptroller.

(4) A translation of an amendment is necessary for the purposes of section 89A(5) where any amendment made to the application—

- (a) has been published under the Treaty; or
- (b) has been annexed to the International Preliminary Examination Report.

(5) At the end of the period prescribed by rule 66(1), the comptroller shall notify the applicant that a necessary translation is missing if—

- (a) a translation of the application has been filed, but a translation of the amendment has not been filed; or
- (b) the information mentioned in paragraphs 3(2)(a) and (b) of Schedule 1 (biological material) has been provided, but a translation of that information has not been filed,

and the prescribed fee has been paid.

Requirements of necessary translations

70.—(1) This rule applies to translations which are necessary for the purposes of section 89A(3) and (5).

(2) Such a translation is only necessary to the extent that the application is in a language other than English or Welsh.

(3) Where the application includes a drawing which is annotated, the translation shall include—

- (a) a copy of the original drawing where the original annotations have been replaced by annotations in English; or
- (b) a new drawing with the annotations in English.

(4) Where a title has been established for the application by the International Searching Authority, the translation shall include that title (and not any title which was included in the application as it was originally filed).

(5) Where—

- (a) the description of the invention includes a sequence listing; and
- (b) the listing complies with the relevant requirements of the Treaty,

the translation of the application may exclude a translation of the sequence listing.

(6) This rule applies to translations of amendments as it applies to translations of applications; and references to the application shall be construed accordingly.

Application deemed withdrawn or filing date refused under the Patent Co-operation Treaty

Directions under section 89(3) and (5)

71.—(1) The applicant may, before the end of the relevant period, make a written request to the comptroller to give a direction under section 89(5).

(2) The applicant may notify the comptroller that the circumstances mentioned in section 89(3) or rule 72 apply to his application.

(3) The request under paragraph (1) shall be accompanied by—

- (a) a statement of the reasons for the request; and
- (b) the fee prescribed for the purposes of section 89A(3).

(4) The relevant period shall be the period of 2 months beginning with the date on which—

- (a) the International Bureau; or
- (b) the receiving Office,

notifies the applicant that his international application for a patent (UK) is refused a filing date under the Patent Co-operation Treaty.

(5) Where the applicant has made a request to the comptroller under paragraph (1), the comptroller may direct the applicant to furnish him with any document, information or evidence within such period as the comptroller may specify.

(6) Where the applicant fails, before the end of the period specified, to comply with a direction given under paragraph (5), the comptroller may treat him as having withdrawn his request.

(7) Where section 89(3) applies or a direction has been given under section 89(5) the comptroller may—

- (a) alter any period of time (whether it has already expired or not) specified in the Act or listed in Parts 1 to 3 of Schedule 4; and
- (b) amend any document kept at the Patent Office in relation to the application, subject to such conditions as the comptroller may direct.

Circumstance prescribed for the purposes of section 89(3)

72. The other circumstance prescribed for the purposes of section 89(3) is where the comptroller determines that, in comparable circumstances in relation to an application under the Act (other than an international application for a patent (UK)), he would have exercised his powers under rule 107 or 108 to prevent the application being treated as withdrawn.

PART 7

PROCEEDINGS HEARD BEFORE THE COMPTROLLER

Introductory

Proceedings to which this Part applies

- 73.—(1) This Part applies to the following proceedings heard before the comptroller—
- (a) applications, references and requests under the provisions mentioned in Part 1 of Schedule 3;
 - (b) oppositions under the provisions mentioned in Part 2 of that Schedule.
- (2) The rules listed in Part 4 of that Schedule apply to any proceedings heard before the comptroller under the Act.

Overriding objective

- 74.—(1) In proceedings to which this Part applies the comptroller's overriding objective shall be to deal with cases justly.
- (2) Dealing with a case justly includes, so far as is practicable—
- (a) ensuring that the parties are on an equal footing;
 - (b) saving expense;
 - (c) dealing with the case in ways which are proportionate—
 - (i) to the amount of money involved;
 - (ii) to the importance of the case;
 - (iii) to the complexity of the issues; and
 - (iv) to the financial position of each party.
 - (d) ensuring that it is dealt with expeditiously and fairly; and
 - (e) allotting to it an appropriate share of the resources available to the comptroller, while taking into account the need to allot resources to other cases.
- (3) The comptroller shall seek to give effect to the overriding objective when he—
- (a) exercises any power given to him by this Part; or
 - (b) interprets any rule in this Part.
- (4) The parties are required to help the comptroller to further the overriding objective.

Publication of notices

75.—(1) The comptroller shall advertise in the journal any event to which it is possible to object under any of the provisions mentioned in Part 2 or 3 of Schedule 3 (but this is subject to rule 105(5)).

(2) For the purposes of rule 76 and 77, the “relevant notice” means the advertisement in the journal mentioned in paragraph (1).

Conduct of hearings

Starting proceedings

76.—(1) Proceedings are started when a person (in this Part, the “claimant”) files in duplicate—

- (a) the relevant form; and
- (b) his statement of grounds.

(but see rule 89).

(2) Any person may give notice of opposition—

- (a) in the case of section 75(2), before the end of the period of 2 weeks beginning with the date of the relevant notice; and
- (b) in the case of any of the other provisions mentioned in Part 2 of Schedule 3, before the end of the period of 4 weeks beginning with the date of the relevant notice.

(3) For the purposes of paragraph (1) and rule 77 the “relevant form” means—

- (a) in relation to applications or requests under the provisions of the Medicinal Regulation or the Plant Protection Regulation mentioned in Part 1 of Schedule 3, Form SP3;
- (b) in relation to applications or references under any other provision mentioned in Part 1 of that Schedule, Form 2; and
- (c) in relation to oppositions under the provisions mentioned in Part 2 of that Schedule, Form 15.

(4) A statement of grounds shall—

- (a) include a concise statement of the facts and grounds on which the claimant relies;
- (b) where appropriate, include the period or terms of the licence which he believes are reasonable;
- (c) specify the remedy which he seeks;
- (d) where it accompanies an application under the Community Compulsory Licensing Regulation, include any information required by that Regulation,

and it shall be verified by a statement of truth.

Notification of the parties

77.—(1) The comptroller shall notify—

- (a) the applicant for, or proprietor of, the patent which is the subject matter of the case;
- (b) every person who appears to the comptroller to be likely to have an interest in the case,

that proceedings have started.

(2) But where a person mentioned in paragraph (1)—

- (a) is the claimant; or
- (b) has indicated in writing to the comptroller that he supports the claimant’s case,

the comptroller has no duty to notify him.

(3) The comptroller shall send the relevant form and the statement of grounds with the notification under paragraph (1).

(4) In that notification, the comptroller shall specify a period within which the persons notified may file a counter-statement.

(5) Any counter-statement shall be filed in duplicate before the end of the period specified under paragraph (4).

(6) But paragraph (4) and (5) shall not apply to an opposition under any of the provisions mentioned in Part 3 of Schedule 3.

(7) In such oppositions, any counter-statement shall be filed in duplicate before the end of the period of 4 weeks beginning with the date of the relevant notice.

(8) A person who files a counter-statement under paragraphs (5) or (7) shall for the purposes of this Part be a “defendant”.

(9) Where—

(a) a person was notified under paragraph (1); and

(b) that person fails to file a counter-statement under paragraph (5) or (7),

the comptroller shall treat him as supporting the claimant’s case.

(10) The period prescribed for the purposes of section 47(6) shall be the period prescribed by paragraph (7).

The counter-statement

78.—(1) In his counter-statement the defendant shall state—

(a) which of the allegations in the statement of grounds he denies;

(b) which of the allegations he is unable to admit or deny, but which he requires the claimant to prove; and

(c) which of the allegations he admits,

and it shall be verified by a statement of truth.

(2) Where the defendant denies an allegation—

(a) he must state his reasons for doing so; and

(b) if he intends to put forward a different version of events from that given by the claimant, he must state his own version.

(3) A defendant who fails to deal with an allegation in a counter-statement shall be taken to admit that allegation.

(4) But a defendant who—

(a) fails to deal with an allegation; but

(b) has set out in his counter-statement the nature of his case in relation to the issue to which the allegation is relevant,

shall be taken to require the allegation to be proved.

(5) In these Rules—

(a) “statement of case” means the statement of grounds filed by the claimant or the counter-statement filed by the defendant; and

(b) references to the statement of case include part of the statement of case.

and a statement of case shall comply with the requirements of Part 1 of Schedule 2.

Copies of documents

79.—(1) Where a relevant statement refers to any other document, a copy of that document shall accompany the relevant statement.

(2) Where more than one copy of a relevant statement is filed, each copy of the statement shall be accompanied by a copy of the document.

(3) But paragraphs (1) and (2) shall not apply where—

- (a) the relevant statement is sent to the comptroller; and
- (b) the document it refers to was published by the comptroller or is kept at the Patent Office.

(4) In this rule “relevant statement” means a witness statement, statement of case, affidavit or statutory declaration.

Evidence rounds and the hearing

80.—(1) When the defendant has filed a counter-statement, the comptroller shall—

- (a) send the counter-statement to the claimant; and
- (b) specify the periods within which evidence may be filed by the claimant and the defendant.

(2) The comptroller may, at any time if he thinks fit, give leave to either party to file evidence upon such terms as he thinks fit.

(3) Under this rule, evidence shall only be considered to be filed when—

- (a) it has been received by the comptroller; and
- (b) it has been sent to all the other parties to the proceedings.

(4) The comptroller shall then give the parties an opportunity to be heard.

(5) Where any party requests to be heard, the comptroller shall send to the parties notice of a date for the hearing.

(6) When the comptroller has decided the matter he shall notify all the parties of his decision, including his reasons for making the decision.

Alteration of time limits

81.—(1) The comptroller may extend or shorten (or further extend or shorten) any period of time which has been specified under any provision of this Part.

(2) An extension may be granted under paragraph (1) notwithstanding the period of time specified has expired.

General powers of the comptroller in relation to proceedings before him

82.—(1) Except where the Act or these Rules otherwise provide, the comptroller may give such directions as to the management of the proceedings as he thinks fit, in particular he may—

- (a) require a document, information or evidence to be filed;
- (b) require a translation of a specification of a patent or application or any other document which is not in English;
- (c) require a party or a party’s legal representative to attend a hearing;
- (d) hold a hearing and receive evidence by telephone or by using any other method of direct oral communication;
- (e) allow a statement of case to be amended;
- (f) stay the whole, or any part, of the proceedings either generally or until a specified date or event;
- (g) consolidate proceedings;
- (h) direct that part of any proceedings be dealt with as separate proceedings;
- (i) direct that the parties attend a case management conference or pre-hearing review.

(2) The comptroller may control the evidence by giving directions as to—

- (a) the issues on which he requires evidence;
- (b) the nature of the evidence which he requires to decide those issues; and

(c) the way in which the evidence is to be placed before him,
and the comptroller may use his power under this paragraph to exclude evidence which would otherwise be admissible.

(3) When the comptroller gives directions under any provision of this Part, he may—

- (a) make them subject to conditions; and
- (b) specify the consequence of failure to comply with the directions or a condition.

Striking out a statement of case and summary judgment

83.—(1) A party may apply to the comptroller for him to strike out a statement of case or to give summary judgment.

(2) If it appears to the comptroller that—

- (a) the statement of case discloses no reasonable grounds for bringing or defending the claim;
- (b) the statement of case is an abuse of process or is otherwise likely to obstruct the just disposal of the proceedings; or
- (c) there has been a failure to comply with a section, a rule or a previous direction given by the comptroller,

he may strike out the statement of case.

(3) The comptroller may give summary judgment against a claimant or defendant on the whole of a case or on a particular issue if—

- (a) he considers that—
 - (i) that claimant has no real prospect of succeeding on the case or issue; or
 - (ii) that defendant has no real prospect of successfully defending the case or issue; and
- (b) there is no other compelling reason why the case or issue should be disposed of at a hearing.

Hearings in public

84.—(1) Subject to paragraphs (3) and (4), any hearing before the comptroller in proceedings between two or more parties relating to an application for a patent, or a patent, shall be held in public.

(2) Any party to the proceedings may apply to the comptroller for a hearing to be held in private.

(3) The comptroller shall only grant an application under paragraph (2) where—

- (a) there is good reason for the hearing to be held in private; and
- (b) all the parties to the proceedings have had an opportunity to be heard on the matter,

and where the application is granted the hearing shall be in private.

(4) Any hearing—

- (a) of an application under paragraph (2); or
- (b) relating to an application for a patent which has not been published,

shall be held in private.

(5) In this rule a reference to a hearing includes any part of a hearing.

(6) Nothing in this rule shall prevent a member of the Council on Tribunals or of its Scottish Committee from attending a hearing.

Security for costs or expenses

85.—(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⁽¹²⁾;
- (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 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 shall be construed as references to expenses.

Powers of comptroller to compel attendance of witnesses and production of documents

86. The comptroller shall have the powers of a judge of the High Court (in Scotland, the Court of Session) as regards—

- (a) the attendance of witnesses; and
- (b) the discovery and production of documents,

but he shall have no power to punish summarily for contempt.

Evidence in proceedings before the comptroller

87.—(1) Subject as follows, evidence filed under this Part may be given—

- (a) by witness statement, statement of case, affidavit, statutory declaration; or
- (b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement or a statement of case may only be given in evidence if it includes a statement of truth.

(3) The general rule is that evidence is to be by witness statement unless the comptroller directs or any enactment requires otherwise.

(4) A witness statement, affidavit or statutory declaration shall comply with the requirements of Part 1 of Schedule 2, unless the comptroller otherwise directs.

(5) For the purposes of this Part, a statement of truth—

- (a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and
- (b) shall be dated and signed by—
 - (i) in the case of a witness statement, the person making the statement,

⁽¹²⁾ 1982 c. 27; section 1(3) was substituted by SI 1990/2591, and then amended by section 2(5) and (6) of the Civil Jurisdiction and Judgments Act 1991 (c. 12) and by SI 2000/1824 and 2001/3929.

(ii) in any other case, the party or his legal representative.

(6) In this Part, a witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

Proceedings in Scotland

88.—(1) Where there is more than one party to proceedings, a party to the proceedings may apply to the comptroller to hold proceedings in Scotland.

(2) An application made under paragraph (1) shall be granted—

- (a) where all the parties consent to the proceedings being held in Scotland; or
- (b) where the comptroller considers it appropriate.

(3) A refusal of an application made under paragraph (1) is excepted from the right of appeal conferred by section 97.

Proceedings started under section 46(3) by a person other than the proprietor

89.—(1) An application by a person other than the proprietor to the comptroller under section 46(3)(a) or (b) shall be—

- (a) made on Patents Form 2; and
- (b) accompanied by two copies of the draft of the licence he proposes should be granted.

(2) The comptroller shall notify the proprietor of the patent that an application has been made.

(3) The comptroller shall send a copy of the licence with the notification.

(4) In the notification, the comptroller shall specify a period within which the proprietor may file a statement of grounds.

(5) The proprietor shall file a statement of grounds in accordance with rule 76(4); otherwise he shall be treated as supporting the applicant's case.

(6) Proceedings shall continue under this Part as if they had been started under rule 76(1); and for those purposes the proprietor shall be “the claimant” and applicant shall be “the defendant”.

Licences following entitlement proceedings

90.—(1) The period prescribed for the purposes of section 11(3) and (3A) shall be the period of 2 months beginning with —

- (a) where section 11 is applied by section 12(5), the date on which the order under section 12(1) was made; and
- (b) in any other case, the date on which the order under section 8 was made.

(2) The period prescribed for the purposes of section 38(3) shall be the period of 2 months beginning with the date on which the order mentioned in section 38(2) was made.

Period prescribed for applications by employee for compensation

91.—(1) The period prescribed for the purposes of section 40(1) and (2) shall be the period beginning with the date of grant of the patent and ending 1 year after the patent ceased to have effect.

(2) But if an application for restoration is made under section 28 and—

- (a) the application is granted, the period prescribed under paragraph (1) shall continue as if the patent had remained continuously in effect; or
- (b) the application is refused, the period prescribed for the purposes of section 40(1) and (2) shall be—
 - (i) the period prescribed under paragraph (1); or

- (ii) if it expires later, the period of 6 months beginning with the date on which the application was refused.

PART 8 OPINIONS

Interpretation

Interpretation

92. In this Part, unless the context otherwise requires—

- “request” means a request for an opinion under section 74A;
- “requester” means the person who makes that request;
- “patent in suit” means the patent to which that request relates;
- “patent holder” means the proprietor of that patent and any exclusive licensee of the patent;
- “relevant proceedings” means proceedings (whether pending or concluded) before the comptroller, the court or the European Patent Office.

Request for opinion

Request for an opinion under section 74A

93.—(1) A request shall be made on Patents Form 17 and shall be accompanied by a copy and a statement setting out fully—

- (a) the question upon which an opinion is sought;
- (b) the requester’s submissions on that question; and
- (c) 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, of whom the requester is aware, having an interest in that question; and
- (b) particulars of any relevant proceedings of which the requester is aware which relate to the patent in suit and which may be relevant to that question.

(3) However, where the requester is acting as an agent in making the request, the persons referred to in paragraph (2)(a) do not include the person for whom the requester is so acting.

(4) The statement shall be accompanied by a copy of any evidence or other document (except a document which has been published by the comptroller or is kept at the Patent Office) which is referred to in the statement.

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

Refusal or withdrawal of request

94.—(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 considered in any relevant 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.

Notification and advertisement of request

95.—(1) 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 in suit which has been registered under rule 47;
- (c) any person who has made a request in respect of the patent in suit under rule 54 regarding an opinion being requested under rule 93; and
- (d) any person who is specified under rule 93(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 93(1) to each person so notified, together with a copy of such other documents filed under rule 93 as he sees fit.

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

(5) However, if the request is refused or withdrawn before a notification has been made under paragraph (1)—

- (a) the patent holder alone shall be notified of the request (and of the fact that it has been refused or withdrawn); and
- (b) paragraphs (3) and (4) shall not apply.

Submission of observations and observations in reply

96.—(1) If the request has not been refused or withdrawn, any person may, before the end of the relevant period, file observations on any issue raised by the request.

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

(3) Any person who files observations under paragraph (1) shall ensure that, before the end of the relevant period, a copy of those observations is received—

- (a) where that person is not the patent holder, by the patent holder; and
- (b) by the requester.

(4) A person to whom observations are sent under paragraph (3) may, during the period of 2 weeks beginning immediately after the end of the relevant period, file observations confined strictly to matters in reply.

(5) Any person who files observations under paragraph (4) shall ensure that, within that period of 2 weeks, a copy of those observations is received—

- (a) where that person is the requester, by the patent holder; and
- (b) where that person is the patent holder, by the requester.

(6) If it is reasonably possible, the observations filed under this rule and the copies of such observations shall be delivered only in electronic form or using electronic communications.

(7) For the purposes of this rule, the relevant period is the period of 4 weeks beginning with the date of advertisement under rule 95(4).

Issue of the opinion

97.—(1) After the end of the procedure under rule 96, the comptroller shall refer the request to an examiner for the preparation of the opinion.

- (2) The comptroller shall issue the opinion that has been prepared by sending a copy to—
- (a) the requester;
 - (b) the patent holder; and
 - (c) any other person who filed observations under rule 96(1).

Review of opinion

Review of opinion

98.—(1) The patent holder may, before the end of the period of 3 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 the issue raised by the review has been decided in other relevant proceedings.

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

(4) The statement shall contain particulars of any relevant 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 application may be made on the following grounds only—

- (a) that the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent; or
- (b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

Procedure on review

99.—(1) Upon receipt of the application, the comptroller shall send a copy of the form and statement filed under rule 98 to—

- (a) the requester (if different from the applicant); and
- (b) any person who filed observations under rule 96.

(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—

- (a) the period of 4 weeks beginning with the date on which the application is advertised under paragraph (2); or
- (b) if it expires later, the period of 2 months beginning with the date on which the opinion is issued under rule 97(2).

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

(6) The rules listed in Parts 4 and 5 of Schedule 3 shall apply to the proceedings.

(7) For those purposes—

- (a) references to “the claimant” shall be construed as a reference to the applicant; and
- (b) references to “the defendant” shall be construed as a reference to any other party.

Outcome of review

100.—(1) Upon the completion of the proceedings under rule 99 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) A decision under paragraph (1)(a) or (b) shall not estop any party to any proceedings from raising any issue regarding the validity or the infringement of the patent.

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

PART 9

MISCELLANEOUS

Agents and advisers

Agents

101.—(1) Any act required or authorised by the Act or these Rules to be done by or to any person in connection with an application for a patent, or any procedure relating to a patent, may be done by or to an agent authorised by that person orally or in writing.

(2) But an agent shall only be treated as authorised under paragraph (1)—

- (a) where an agent is appointed when a person starts or joins any proceeding under the Act, once the comptroller has been notified of his appointment in writing; or
- (b) where an agent is appointed after a person has started or joined any such proceeding, once Patents Form 51 has been filed in duplicate.

(3) Where an agent has been authorised under paragraph (1), the comptroller may, in any particular case, require the signature or presence of his principal.

Appointing advisers

102.—(1) The comptroller may appoint an adviser to assist him in any proceeding before him.

(2) The comptroller shall settle any question or instructions to be given to the adviser.

Address for service

Address for service

103.—(1) For the purposes of any proceeding under the Act or these Rules, an address for service shall be furnished by—

- (a) an applicant for the grant of a patent;
- (b) a person who makes any other application or reference, or gives any notice of opposition, under the Act;
- (c) any person opposing such an application, notice or reference.

(2) The proprietor of a patent, or any person who has registered any right in or under a patent or application, may furnish an address for service by notifying the comptroller.

(3) Where a person has furnished an address for service under paragraph (1) or (2), he may substitute a new address for service by notifying the comptroller.

(4) An address for service furnished under paragraph (1)(a) or (2) shall be an address in the United Kingdom, another EEA State or the Channel Islands.

(5) An address for service furnished under paragraph (1)(b) or (c) shall be an address in the United Kingdom, unless in a particular case the comptroller otherwise directs.

(6) In this rule, “EEA State” means a member State, Iceland, Liechtenstein or Norway.

Failure to furnish an address for service

104.—(1) Where—

- (a) a person has failed to furnish an address for service under rule 103(1); and
- (b) the comptroller has sufficient information enabling him to contact that person,

the comptroller shall direct that person to furnish an address for service.

(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of 2 months beginning with the date of the direction, furnish an address for service.

(3) Paragraph (4) applies where—

- (a) a direction was given under paragraph (1) and the period prescribed by paragraph (2) has expired; or
- (b) the comptroller had insufficient information to give a direction under paragraph (1),

and the person has failed to furnish an address for service.

(4) Where this paragraph applies—

- (a) in the case of an applicant for the grant of a patent, the application shall be treated as withdrawn; and
- (b) in the case of a person mentioned in rule 103(1)(b), his application, reference or notice of opposition shall be treated as withdrawn; and
- (c) in the case of a person mentioned in rule 103(1)(c), he shall be deemed to have withdrawn from the proceedings.

(5) In this rule an “address for service” means an address which complies with the requirements of rule 103(4) or (5).

Corrections and remissions of fees

Correction of errors

105.—(1) A request to the comptroller to correct an error or mistake under section 117 shall be made in writing and identify the proposed correction.

(2) The comptroller may, if he thinks fit, require the person requesting a correction to produce a copy of the document indicating the correction.

(3) Where the request is to correct a specification of a patent or application, the request shall not be granted unless the correction is obvious (meaning that it is immediately evident that nothing else could have been intended in the original specification).

(4) But paragraph (3) shall not apply where the error in the specification of the patent is connected to the application being delivered in electronic form or using electronic communications.

(5) Where the comptroller determines that no person could reasonably object to the correction no advertisement shall be published under rule 75(1).

(6) Where the comptroller is required to publish a notice under section 117(3), it shall be published in the journal.

(7) This rule shall not apply to a correction of a name, address or address for service (which may be corrected under rule 49).

Remission of fees

- 106.**—(1) A person may apply to the comptroller for the remission of a fee.
- (2) The comptroller may remit the whole or part of the search fee where—
- (a) in relation to an international application for a patent (UK), a copy of the International Search Report for that application is available to the comptroller; or
 - (b) a new application for a patent is filed as mentioned in section 15(9) and, in connection with the earlier application, the applicant has already paid the search fee for the invention described in the new application.
- (3) The comptroller may remit the whole or part of any fee where—
- (a) a person has requested the comptroller or an examiner to do something in accordance with the Act or these Rules; and
 - (b) the request is withdrawn before it is carried out.
- (4) 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.
- (5) Where a supplementary protection certificate lapses or is declared invalid, the comptroller shall remit any fee which has been paid in respect of the relevant period.
- (6) The relevant period is the period—
- (a) beginning with the next anniversary of the start date following the date the certificate lapsed or was declared invalid; and
 - (b) ending with the date the certificate would have expired but for its lapse or invalidity.
- (7) Any decision of the comptroller under this rule is excepted from the right of appeal conferred by section 97.
- (8) In this rule, the start date is the first day following the day on which the basic patent expires.

Correction of irregularities

107.—(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

- (2) Any rectification made under paragraph (1) shall be made—
- (a) after giving the parties such notice, and
 - (b) subject to such conditions,

as the comptroller may direct.

(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

- (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and
- (b) it appears to the comptroller that the irregularity should be rectified.

Time limits and delays

Extension of time limits

108.—(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the rules listed in Parts 1 and 2 of Schedule 4.

(2) The comptroller shall extend, by a period of 2 months, any period of time prescribed by the rules listed in Part 2 of Schedule 4 where—

- (a) a request is filed on Patents Form 52;

- (b) no previous request has been made under this paragraph;
 - (c) that request is filed before the end of the period of 2 months beginning with the date on which the relevant period of time expired.
- (3) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by the rules listed in Part 2 of Schedule 4 where—
- (a) a request is filed on Patents Form 52; and
 - (b) the person making the request has furnished evidence supporting the grounds of the request, except where the comptroller otherwise directs.
- (4) A request under paragraph (2) or (3) for more than one period of time to be extended may only be made on a single form where—
- (a) the periods of time all relate to one patent or one application for a patent, and
 - (b) if the request were granted, all the extended periods of time would expire on the same date.
- (5) Any extension made under paragraphs (1) or (3) shall be made—
- (a) after giving the parties such notice, and
 - (b) subject to such conditions,

as the comptroller may direct, except that a period of time prescribed by the rules listed in Part 3 of Schedule 4 may only be extended (or further extended) for a period of 2 months.

(6) An extension may be granted under paragraph (1) or (3) notwithstanding the period of time prescribed by the relevant rule has expired.

(7) But no extension may be granted in relation to the periods of time prescribed by the rules listed in Part 3 of Schedule 4 after the end of the period of 2 months beginning immediately after the period of time as prescribed (or previously extended) has expired (but see section 20A).

Extension of time limits specified by comptroller

109.—(1) A request made under section 117B(2) shall be—

- (a) in writing; and
- (b) made before the end of the period prescribed by paragraph (2).

(2) The period prescribed for the purposes of section 117B(3) shall be the period of 2 months beginning immediately after the expiry of the period to which section 117B(2) applies.

Interrupted Days

110.—(1) The comptroller may certify any day as an interrupted day where—

- (a) there is an event or circumstance causing an interruption in the normal operation of the Patent Office; or
- (b) there is a general interruption or subsequent dislocation in the postal services of the United Kingdom.

(2) Any certificate of the comptroller given under paragraph (1) shall be posted in the Patent Office and advertised in the journal.

(3) The comptroller shall, where the time for doing anything under the Act expires on an interrupted day, extend that time to the next following day not being an interrupted day (or an excluded day).

(4) In this rule—

“excluded day” means a day specified as an excluded day in directions given under section 120; and

“interrupted day” means a day which has been certified as such under paragraph (1).

Delays in communication services

111.—(1) The comptroller shall extend any period of time specified in the Act or these Rules where he is satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the comptroller may direct.

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, electronic communications, and courier.

Copies available to the comptroller

Copies available to the comptroller

112.—(1) This rule applies where an applicant is not required to file a copy of an application at the Patent Office because that application or a copy of that application is available to the comptroller.

(2) Where this rule applies the comptroller shall make a copy (or further copy) of that application and certify it accordingly.

Translations

Translations

113.—(1) Where any document filed at the Patent Office, or sent to the comptroller, is in a language other than English or Welsh it shall be accompanied by a translation into English of that document.

(2) But paragraph (1) shall not apply to the following documents—

- (a) where the documents filed to initiate an application for a patent include something which is or appears to be a description of the invention, the document containing that thing (see rules 12(8) and (9));
- (b) a priority application (see rule 9);
- (c) a copy of an application provided under section 15(10)(b)(ii) (see rule 17);
- (d) a copy of a specification of a European patent (UK) filed in connection with an application by the proprietor to amend the specification (see rule 35(4));
- (e) a copy of an application for a European patent (UK) provided under section 81(2)(b)(ii) (see section 81(2)(c));
- (f) an international application for a patent (UK), where a translation of the application or an amendment to it is a necessary translation (see rules 69 and 70);
- (g) a document referred to in paragraph (5).

(3) Where more than one copy of the document mentioned in paragraph (1) is filed or sent, a corresponding number of translations shall accompany it.

(4) Where a document to which paragraph (1) applies is not accompanied by a translation, the comptroller may, if he thinks fit, take no further action in relation to that document.

(5) In relation to an international application for a patent (UK), where any document which is in a language other than English or Welsh is—

- (a) referred to in an International Search Report or International Preliminary Report on Patentability; or

(b) cited in an International Preliminary Examination Report, and the relevant report is filed at the Patent Office, the comptroller may direct that a translation into English of that document be filed.

(6) Where a direction is given under paragraph (5) a translation of that document shall be filed before the end of the period of 2 months beginning with the date on which the direction is given; otherwise the comptroller may, if he thinks fit, take no further action in relation to the application.

(7) In this rule a reference to a document includes a reference to a part of a document.

Translations in proceedings in relation to a European patent (UK)

114.—(1) Where—

- (a) proceedings are started before the comptroller in relation to a European patent (UK); and
- (b) the specification of that patent was published in French or German,

the person who starts those proceedings shall file at the Patent Office a translation into English of the specification.

(2) But paragraph (1) shall not apply where—

- (a) a translation into English of the specification has been filed under section 77(6); or
- (b) the comptroller directs that a translation is unnecessary.

(3) Where, in the course of such proceedings, leave is given to amend the specification of the patent, the proprietor shall file at the Patent Office a translation of the amendment into the language in which the specification of the patent was published.

(4) This rule applies to making a request for an opinion under section 74A as it applies to proceedings started before the comptroller.

Establishing the accuracy of translations

115. If the comptroller has reasonable doubts about the accuracy of any translation of a document that has been filed at the Patent Office by any person in accordance with the Act or these Rules—

- (a) he shall notify that person of the reasons for his doubts; and
- (b) he may require that person to furnish evidence to establish that the translation is accurate,

and where that person fails to furnish evidence the comptroller may, if he thinks fit, take no further action in relation to that document.

Supplementary Protection Certificates

Supplementary protection certificates

116.—(1) An application for—

- (a) a supplementary protection certificate shall be made on Form SP1; and
- (b) an extension of the duration of a supplementary protection certificate under Article 8 of the Medicinal Regulation shall be made on Form SP4.

(2) The period prescribed for the purposes of section 125B(4) shall be—

- (a) the period of 3 months ending with the start date; or
- (b) where the certificate is granted after the beginning of that period, the period of 3 months beginning with the date the supplementary protection certificate is granted.

(3) The comptroller shall send a notice to the applicant for the certificate—

- (a) before the beginning of the period of 2 months immediately preceding the start date; or

- (b) where the certificate is granted as mentioned in paragraph (2)(b), on the date the certificate is granted.
- (4) The notice shall notify the applicant for the certificate of—
 - (a) the fact that payment is required for the certificate to take effect;
 - (b) the prescribed fee due;
 - (c) the date before which payment must be made; and
 - (d) the start date.
- (5) The prescribed fee shall be accompanied by Form SP2; and once the certificate has taken effect no further fee may be paid to extend the term of the certificate unless an application for an extension of the duration of the certificate is made under the Medicinal Regulation.
- (6) Where the prescribed fee is not paid before the end of the period prescribed for the purposes of section 125B(4), the comptroller shall, before the end of the period of 6 weeks beginning immediately after the end of that prescribed period, and if the fee remains unpaid, send a notice to the applicant for the certificate.
- (7) The notice shall remind the applicant for the certificate—
 - (a) that payment is overdue; and
 - (b) of the consequences of non-payment.
- (8) The comptroller shall send the notices under this rule to—
 - (a) the applicant's address for service; and
 - (b) the address to which a renewal notice would be sent to the proprietor of the basic patent under rule 39(3).
- (9) In this rule, the start date is the first day following the day on which the basic patent expires.

Publications

The journal

- 117.** The comptroller shall publish a journal containing—
- (a) particulars of applications for and grants of patents and of other proceedings under the Act;
 - (b) any directions given under section 120(1) specifying hours of business or excluded days;
 - (c) any directions under section 123(2A) setting out forms; and
 - (d) any other information that the comptroller considers to be generally useful or important.

Reports of cases

- 118.** The comptroller shall make arrangements for the publication of—
- (a) reports of cases relating to patents, trade marks, registered designs or design right decided by him; and
 - (b) reports of cases relating to patents (whether under the Act or otherwise), trade marks, registered designs, copyright and design right decided by any court or body (whether in the United Kingdom or elsewhere).

Publication and sale of documents

- 119.** The comptroller may arrange for the publication and sale of copies of documents (in particular, specifications of patents and applications for patents) in the Patent Office.

Index, transitional provisions and repeals

Index

120. Schedule 5 contains an index of provisions defining or otherwise explaining expressions used in these Rules (other than those used only in the same rule or paragraph of a Schedule).

Transitional provisions and repeals

121.—(1) Schedule 6 (transitional provisions) shall have effect.

(2) The instruments set out in Schedule 7 (repeals) shall be revoked to the extent specified.

SCHEDULE 1

Rule 13(1)

BIOLOGICAL MATERIAL

Introductory

1.—(1) In this Schedule—

“authorisation certificate” means a certificate issued by the comptroller authorising a depositary institution to make available a sample of biological material;

“Budapest Treaty” means the Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure signed at Budapest on 28th April 1977, as amended on 26th September 1980, and includes references to the regulations made under that Treaty;

“expert” means independent expert; and

“first requirement” means the first requirement in paragraph 3;

“international depositary authority” means a depositary institution which has acquired the status of international depositary authority as provided in the Budapest Treaty;

“second requirement” means the second requirement in paragraph 3.

(2) In this Schedule “depositary institution” means an institution which—

- (a) carries out the functions of receiving, accepting and storing biological material and the furnishing of samples of such biological material (whether generally or of a specific type); and
- (b) conducts its affairs, in so far as they relate to the carrying out of those functions, in an objective and impartial manner.

Specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material

2.—(1) This paragraph applies where the specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material does not disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(2) Where this paragraph applies, the specification is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art, if—

- (a) the first requirement and the second requirement are satisfied; and
- (b) the specification of the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material.

The first and second requirement

3.—(1) The first requirement is that—

- (a) on or before the date of filing of the application, the biological material has been deposited in a depositary institution; and
- (b) that institution will be able to furnish subsequently a sample of the biological material.

- (2) The second requirement is that before the end of the relevant period—
- (a) the name of the depositary institution and the accession number of the deposit are included in the specification; and
 - (b) where the biological material was deposited by a person other than the applicant (“the depositor”)—
 - (i) a statement is filed which identifies the name and address of the depositor; and
 - (ii) a statement by the depositor has been filed, which authorises the applicant to refer to the biological material in his application and irrevocably authorises the making available to the public of the biological material in accordance with this Schedule.
- (3) The relevant period is the first to expire of—
- (a) the period of 16 months—
 - (i) where there is no declared priority date, beginning with the date of filing of the application; or
 - (ii) where there is a declared priority date, beginning with that date;
 - (b) where the applicant has made a request under section 16(1) to publish the application during the period prescribed for the purposes of that section, the period ending with the date of the request; or
 - (c) where the applicant was notified under rule 52(2), the period of 1 month beginning with the date of the notification.
- (4) Where—
- (a) the application is filed with the European Patent Office and documents have been filed under the provisions of the European Patent Convention corresponding to sub-paragraph (2); or
 - (b) the application in suit is an international application for a patent (UK) and documents have been filed in accordance with the Patent Co-operation Treaty under the provisions of the Treaty corresponding to sub-paragraph (2),

the second condition shall be treated as having been met.

- (5) In this paragraph—

“accession number” means the number given to the deposit by a depositary institution;

“specification” means the specification of an application for a patent.

A request by a person for biological material to be made available

4.—(1) This paragraph applies when paragraph 7 does not apply.

(2) Where an application for a patent has been published, any person may request the comptroller to issue an authorisation certificate.

(3) Where the application has not been published, a person who has been notified in accordance with section 118(4) may request the comptroller to issue an authorisation certificate.

(4) A request shall be made on Patents Form 8.

(5) Where the biological material has been deposited at an international depositary authority, the request shall be accompanied by any form required by the Budapest Treaty.

(6) Where the comptroller grants the request, he shall send copies of the request and the certificate (and any form required by the Budapest Treaty) to—

- (a) the applicant for, or the proprietor of, the patent;
- (b) the depositary institution; and
- (c) the person making the request.

The undertaking

5.—(1) A request made under paragraph 4 or 7 shall include an undertaking by the person making the request—

- (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, except for experimental purposes relating to the subject matter of the invention,

subject as follows.

(2) The applicant for, or the proprietor of, a patent may agree to limit the effect of the undertaking in a particular case.

(3) The undertaking shall cease to have effect—

- (a) when the application for a patent is terminated or withdrawn (but it will continue to have effect if the application is reinstated or resuscitated); or
- (b) when the patent ceases to have effect.

(4) Where a request is made—

- (a) by a government department or any person authorised in writing by a government department; and
- (b) for the purposes of using the patented invention for the services of the Crown,

no undertaking is required and any undertaking by the government department or the person so authorised shall not have effect.

(5) Where—

- (a) a licence under the patent to which the undertaking relates is available as of right; or
- (b) a compulsory licence in respect of the patent to which the undertaking relates has been granted,

any undertaking made shall have no effect to the extent necessary to give effect to any such licence.

Restriction of availability of biological material to experts

6.—(1) Where the first or the second condition are met (except in relation to Crown use), paragraph 7 applies until the end of the relevant period.

(2) The first condition is—

- (a) the applicant requests on Patents Form 8A that a sample of the biological material should only be made available to an expert; and
- (b) that request is made before the preparations for the application's publication have been completed by the Patent Office.

(3) The second condition is that, in relation to an international application for a patent (UK), the applicant made a reference to deposited biological material in accordance with the Patent Co-operation Treaty.

(4) Where the first condition is met, the comptroller shall, when he publishes the application, include a notice that the provisions of paragraph 7 apply.

(5) The relevant period is—

- (a) where the patent is granted, the period ending with the date on which the patent was granted; and
- (b) where the application is terminated or withdrawn, the period of 20 years beginning with the date of filing.

Request for a sample to be made available to expert

7.—(1) A request for a sample to be made available to an expert shall be made on Patents Form 8 and shall include details of the expert.

(2) Where the biological material has been deposited at an international depositary authority, the request shall be accompanied by any form required by the Budapest Treaty.

(3) The comptroller shall send a copy of Patents Form 8 to the applicant for the patent.

(4) Before the end of the period of 1 month beginning with the date on which a copy of Patents Form 8 is sent by the comptroller, the applicant may give notice of his objection to the particular expert; and where he objects the comptroller shall determine the matter.

(5) Where—

- (a) the applicant does not object to the sample being made available; or
- (b) following an objection, the comptroller decides that the sample should be made available to the particular expert,

the comptroller shall issue a certificate authorising the release of a sample to the expert.

(6) A copy of Patents Form 8 (and any form required by the Budapest Treaty) and any certificate issued under sub-paragraph (5) shall be sent to—

- (a) the applicant for the patent;
- (b) the depositary institution where the sample of the biological material is stored,
- (c) the expert, and
- (d) the person who made the request.

New deposits

8.—(1) This paragraph applies where the first, second or third circumstance occurs.

(2) The first circumstance is that the biological material ceases to be available at the depositary institution because it is no longer viable.

(3) The second circumstance is that—

- (a) the depositary institution is, for any other reason, unable to supply the biological material;
or
- (b) the place where the biological material is deposited is no longer a depositary institution for that type of material (whether temporarily or permanently).

(4) The third circumstance is that the biological material is transferred to a different depositary institution.

(5) The first requirement and the second requirement shall be treated as having been complied with throughout the relevant period, if and only if—

- (a) where the first or second circumstance occurs—
 - (i) a new deposit of biological material is made at the relevant depositary before the end of the relevant period, and
 - (ii) that deposit is accompanied by a statement, signed by the person making the deposit, that the biological material deposited is the same as that originally deposited; and
- (b) in all circumstances, the applicant or proprietor, before the end of the relevant period, applies to the comptroller to amend the specification of the application for the patent, or the patent, so that it meets the second requirement.

(6) The relevant period is the period beginning when the first, second or third circumstance occurs and ending—

- (a) 3 months after the date on which the depositor is notified by the depositary institution that the first, second or third circumstance occurred; or

(b) where it expires later, 3 months after the date on which that circumstance is advertised in the journal.

(7) The relevant depositary is—

(a) where only the first circumstance occurs, the depositary institution where the original deposit was made; or

(b) in any other case, any depositary institution.

SCHEDULE 2

Rule 14

FORMAL AND OTHER REQUIREMENTS

PART 1

REQUIREMENTS: ALL DOCUMENTS

1. Only A4 matt white paper shall be used.
2. Any paper used shall be free from tears, folds or similar damage and its contents must be suitable for reproduction.
3. Frames (lines surrounding matter) shall not be used.

PART 2

REQUIREMENTS: DOCUMENTS (OTHER THAN DRAWINGS)

4. The pages of the description and claims shall be numbered consecutively in a single series.
5. But where a sequence listing is set out at the end of the application, it shall be numbered consecutively in a separate series.
6. Page numbers shall be located at the top or bottom of the page (but not in the margin) in the centre.
7. The minimum margins in any document (except a drawing: see paragraph 11) shall be 20mm.
8. Each of the following—
 - (a) the request for the grant of a patent;
 - (b) the description;
 - (c) the claims;
 - (d) the abstract,shall begin on a new sheet of paper.
9. The abstract, description and claims shall use at least 1.5 line spacing, except where they form part of a translation or a sequence listing.
10. The capital letters in any typeface or font used shall be more than 2mm high.

PART 3

REQUIREMENTS: DRAWINGS

11. There shall be a margin around any drawing which shall be at least—
 - (a) at the top and left side, 20mm;
 - (b) at the right side, 15mm; and
 - (c) at the bottom, 10mm.
12. All drawings shall be numbered consecutively in a single series.

13. The drawings shall begin on a new sheet of paper.
14. The pages containing the drawings shall be numbered consecutively in a single series.
15. Drawings shall comprise black lines and shall not be shaded.
16. Drawings may include cross-hatching to illustrate the cross-sections of a thing.
17. Any scale or other reference for making measurement shall be represented diagrammatically.
18. Any drawing shall be produced so that it would still be clear if it were reduced by linear reduction to two thirds of its original size.
19. No drawing shall be included in the description, the claims, the abstract or the request for the grant of a patent.
20. The capital letters in any typeface or font used in any drawing shall be more than 3mm high.

PART 4

OTHER REQUIREMENTS

21. References shall only be included in the drawing where they are mentioned in either the description or the claims.
22. Tables of information may only be included in the claims if the comptroller agrees.
23. The terminology and any references used shall be consistent throughout the application for a patent.
24. Only standard international units of measurement shall be used in the application; and where no standard exists, units shall be used which are generally accepted in the field.
25. Only technical terms, signs and symbols which are generally accepted in the field shall be used.

PROCEEDINGS HEARD BEFORE THE COMPTROLLER

PART 1

APPLICATIONS, REFERENCES AND REQUESTS

Patents Act 1977

- section 8(1) (reference regarding entitlement in relation to a patent under the Act)
- section 10 (request for directions for handling a joint application)
- section 11(5) (reference regarding entitlement to a licence to continue working after transfer of application)
- section 12(1) (reference regarding entitlement in relation to a foreign or convention patent)
- section 12(4) (reference involving joint applications on entitlement in relation to a foreign or convention patent)
- section 13(3) (application to comptroller to remove person mentioned as inventor)
- section 37(1) (determination of right to patent after grant)
- section 38(5) (reference regarding entitlement to a licence to continue working after transfer of patent)
- section 40 (application for compensation by an employee)
- section 41(8) (application to vary order for compensation for certain inventions)
- section 46(3) (application to settle terms of licence available as of right)
- section 47(3) (application to cancel licence available as of right)
- section 48(1) (application for a compulsory licence)
- section 50A(2) (application following merger and market investigation)
- section 51(1) (application by Minister following report of Competition Commission)
- section 52(2)(a) (application to cancel compulsory licence)
- section 61(3) (reference on question of infringement before the comptroller)
- section 71 (declaration of non-infringement)
- section 72 (application to revoke patent)

Patents Rules 2007

- rule 10(4) (application to be mentioned as inventor)
- rule 88(1) (application to hear proceedings in Scotland)
- paragraph 7(4) of Schedule 1 (notification of objection to expert)

Community Compulsory Licensing Regulation

- Article 5(c) of the Community Compulsory Licensing Regulation (application to terminate compulsory licence)
- Article 6(1) of that Regulation (application for a compulsory licence)

Article 10(8) of that Regulation (application to access books and records)

Article 16(1), second paragraph, of that Regulation (application for a review of a compulsory licence)

Article 16(4) of that Regulation (application for modification of a compulsory licence)

Medicinal Regulation and Plant Protection Regulation

Article 14(d) of the Medicinal Regulation and the Plant Protection Regulation (request to review lapse of supplementary protection certificate)

Article 15 of those Regulations (application for declaration of invalidity of supplementary protection certificate)

Article 15a of the Medicinal Regulation (application for revocation of an extension of the duration of a supplementary protection certificate)

PART 2

OPPOSITIONS WHICH START PROCEEDINGS

Patents Act 1977

section 27(5) (opposition to amendment of specification after grant)

section 29(2) (opposition to surrender of patent)

section 47(6) (opposition to cancellation of licence available as of right), where the application was made by the proprietor of the patent

section 75(2) (opposition to amendment during infringement or revocation proceedings)

section 117(2) (opposition to correction of error in patents and applications)

PART 3

OPPOSITIONS AFTER PROCEEDINGS HAVE STARTED

Patents Act 1977

section 47(6) (opposition to cancellation of licence available as of right), where the application was made by a person other than the proprietor of the patent

section 52(1) (opposition to an application for compulsory licence or under section 50A or 51)

section 52(2)(b) (opposition to an application to cancel a compulsory licence)

PART 4

RULES WHICH APPLY TO ANY PROCEEDINGS HEARD BEFORE THE COMPTROLLER

Patents Rules 2007

rule 74 (overriding objective)

rule 79 (copies of documents)

rule 80(2) to (6) (evidence and the hearing)

- rule 81 (alteration of time limits)
- rule 82 (general powers of the comptroller in relation to proceedings before him)
- rule 84 (hearings in public)
- rule 87 (evidence in proceedings before the comptroller)

PART 5

RULES WHICH APPLY TO A REVIEW OF AN OPINION

Patents Rules 2007

- rule 83 (striking out a statement of case and summary judgment)
- rule 85 (security for costs or expenses)
- rule 86 (powers of comptroller to compel attendance of witness and production of documents)
- rule 88 (proceedings in Scotland)

EXTENSION OF TIME LIMITS

PART 1

PERIODS OF TIME THAT CANNOT BE EXTENDED

- rule 6(2)(b) (declaration of priority for the purposes of section 5(2) made after the date of filing)
- rule 7(1) (period for making a request to the comptroller for permission to make a late declaration of priority)
- rule 32(1) (application to reinstate a terminated application)
- rule 37 and 38 (renewal of patents)
- rule 40(1) (application to restore a lapsed patent)
- rule 43(4) (application to cancel entry that licence available as of right)
- rule 58(1) (request for a direction under section 81)
- rule 59(1) (request from a foreign industrial property office for a direction under section 81)
- rule 66(3) (period for making a request to the comptroller for permission to make a late declaration of priority in respect of an international application for a patent (UK))
- rule 76(2) (notice of opposition), except in relation to an opposition under section 27(5) where there are pending before the court or the comptroller proceedings in which the validity of the patent is put in issue
- rule 77(7) and (10) (opposition periods)
- rule 104(2) (period for filing an address for service), in relation to an application for a patent
- rule 109 (extension of time limits specified by comptroller)
- rule 116(2) (fee for supplementary protection certificate)
- paragraph 8(5) of Schedule 1 (new deposits of biological material)

PART 2

PERIODS OF TIME THAT MAY BE EXTENDED

UNDER RULES 108(2) OR 108(3)

- rule 8(1) and (2) (filing of information and priority documents)
- rule 10(1) (filing of statement of inventorship and the right to be granted a patent)
- rule 18 (missing parts)
- rule 21 (extensions for new applications)
- rule 22(1), (2) and (4)(a) (periods prescribed for the purposes of section 15(10) and 17(1))
- rule 28 (request for substantive examination)
- rule 30 (period for putting an application in order)
- rule 56(6) and (7) (filing of a translation of European patent (UK) specifications)
- rule 58(4) (request under section 81(2)(i))

rule 59(3) (request under section 81(2)(ii))
rule 60 (request for substantive examination following a direction under section 81)
rule 66 (international applications for patents: entry into national phase)
rule 68 (international applications for patents: altered prescribed periods)
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PART 3

PERIODS OF TIME TO WHICH

RULE 108(5) AND 108(7) RELATE

rule 10(1) (filing of statement of inventorship and the right to be granted a patent)
rule 12(3) and (9) (filing of name and address and translations)
rule 19 (new applications filed as mentioned in section 15(9))
rule 21(1)(a) and (2)(a) (extensions for new applications)
rule 22 (periods prescribed for the purposes of section 15(10) and 17(1))
rule 28 (request for substantive examination)
rule 30 (period for putting application in order)
rule 58(4) (request under section 81(2)(b)(i))
rule 59(3) (request under section 81(2)(b)(ii))
rule 60 (request for substantive examination following a direction under section 81)
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patent holder	rule 92
patent in suit	rule 92
priority application	rule 6(6)
receiving office	rule 64
relevant form	rule 76(3)
relevant notice	rule 75(2)
relevant proceedings	rule 92

renewal date	rule 36(1)
renewal fee	rule 36(1)
renewal period	rule 36(1)
request	rule 92
requester	rule 92
second requirement	paragraph 1 of Schedule 1
section	rule 2(2)
sequence listing	rule 13(6)
statement of case	rule 78(5)
statement of truth	rule 87(5)
termination and terminated	rule 2(1)
witness statement	rule 87(6)

TRANSITIONAL PROVISIONS

Interpretation

1. In this Schedule, the “1995 Rules” means the Patents Rules 1995(13) as they had effect immediately prior to their revocation by these Rules.

Periods of time

2. Where—

- (a) in relation to an application for a patent, or a patent;
- (b) a period of time prescribed by the 1995 Rules for the purposes of a particular provision of the Act has not expired before the date on which these Rules come into force, and
- (c) the period of time prescribed by these Rules would expire before the period mentioned in paragraph (b),

the period prescribed for the purposes of the particular provision shall be that prescribed under the 1995 Rules.

Applications to which certain amendments made to the Act by the Regulatory Reform (Patents) Order 2004 do not apply.

3.—(1) This paragraph applies to an application for a patent to which article 20, 21 or 22 of the Regulatory Reform (Patents) Order 2004(14) applies.

(2) Any reference in these Rules to—

- (a) section 15(9) of the Act shall be construed as a reference to section 15(4) of the unamended Act;
- (b) section 15(10)(a) of the Act shall be construed as a reference to section 15(5)(a) of the unamended Act;
- (c) section 15(10)(b) or (c) of the Act shall be disregarded;
- (d) section 15(10)(d) of the Act shall be construed as a reference to section 15(5)(b) of the unamended Act;
- (e) section 17(1)(c)(i) of the Act shall be construed as a reference to section 17(1)(a) of the unamended Act;
- (f) Patents Form 9A shall be construed as a reference to Patents Form 9.

(3) The following provisions shall not apply—

- rule 6(2) and (3) (declaration of priority made after date of filing)
- rule 7 (permission to make late declaration under section 5(2B))
- rule 12(2), (3), (8) and (9) (notifications of deficiencies in application)
- rule 17 (references under section 15(1)(c)(ii))
- rule 18 (missing parts)
- rule 22(3) (prescribed period for filing copy of referred to application).

(13) SI 1995/2093; as amended by SI 1999/1092, 1999/1899, 1999/3197, 2001/1412, 2002/529, 2003/512, 2004/2177 (C. 94), 2004/2358, 2004/3205 (C. 140), 2005/2496 and 2006/760.

(14) SI 2004/2357.

(4) The period prescribed for the purposes of section 15(2) and (3) of the unamended Act shall be the period of 1 month beginning with the date on which the comptroller notifies the applicant that the drawing is missing.

(5) In this paragraph “unamended Act” means the Act as it has effect immediately before the Regulatory Reform (Patents) Order 2004 came into effect.

Translations of European patents (London Agreement)

4.—(1) On the appointed day rule 56(1)(a), (4), (6) and (7) shall cease to have effect.

(2) In this paragraph, the appointed day has the same meaning as given in rule 2 of the Patents (Translations) Rules 2005(15).

Proceedings before the comptroller to be treated as under Part 7 of these Rules

5.—(1) This paragraph applies to—

- (a) any application or reference under the provisions mentioned in Part 1 of Schedule 3;
- (b) any opposition under the provisions mentioned in Part 2 of that Schedule; and
- (c) any proceedings under regulation 8(1) of the Patents and Trade Marks (World Trade Organisation) Regulations 1999(16),

which was started before these Rules came into force.

(2) The proceedings to which this paragraph applies shall be treated as started under Part 7 of these Rules.

(3) Any period of time prescribed under any rule in the 1995 Rules—

- (a) for the filing of a counter-statement shall be treated as if that period were specified under rule 77(5);
- (b) for the filing of evidence shall be treated as if that period were specified under rule 80(1).

Security for costs

6. Rule 85 shall not apply in respect of proceedings started before 1st October 2005.

Patents relating to biological material filed before 7th January 1991

7.—(1) This paragraph applies where an application for a patent (and to patents granted in pursuance of such applications) was filed before 7th January 1991(17).

(2) Schedule 1 of these Rules shall have effect with the following modifications.

(3) In paragraph 2 the words “or concerns” shall be omitted.

(4) Any reference to “biological material”—

- (a) in paragraphs 3(1)(a), 5 and 8 shall be construed as a reference to “culture of the micro-organisms”; and
- (b) other than in those provisions, shall be construed as a reference to “micro-organism”.

(5) For the purposes of paragraph 3(2) the relevant period is the period of two months beginning with the date of filing of the application for a patent.

(6) The following provisions shall not have effect—

paragraph 3(3) (defining relevant period)

paragraph 6 (restriction of availability of biological material to experts);

(15) SI 2005/687.

(16) SI 1999/1899.

(17) The date that section 125A of the Patents Act 1977 came into effect (see paragraph 30 of Schedule 5 to the Copyright, Designs and Patents Act 1988 (c. 48)) and SI 1990/2168.

paragraph 7 (request for sample to be made available to expert).

(7) In paragraph 6(5), in paragraph (b), for the words from “the period of 20 years” to the end of that provision there shall be substituted “the period ending with the date on which the application was terminated or withdrawn”.

Patents relating to biological material filed between 7th January 1991 and 27th July 2000

8.—(1) This paragraph applies to applications for patents (and to patents granted in pursuance of such applications) filed during the period beginning with 7th January 1991 and ending with 27th July 2000(**18**).

(2) Schedule 1 of these Rules shall have effect with the following modifications.

(3) In paragraph 2 the words “or concerns” shall be omitted.

(4) Any reference to “biological material”—

(a) in paragraphs 3(1)(a), 5 and 8, shall be construed as a reference to “culture of the micro-organisms”; and

(b) other than in those provisions, shall be construed as reference to “micro-organism”.

(5) Paragraph 2(2)(b) (requirement that application contains relevant information) shall not have effect.

(6) In paragraph 6(5), in paragraph (b), for the words from “the period of 20 years” to the end of that provision there shall be substituted “the period ending with the date on which the application was terminated or withdrawn”.

(7) The specification of an application for a patent, or of a patent, shall mention any international agreement under which the micro-organism is deposited.

Continued application of Patents Rules 1968 to existing patents

9.—(1) This paragraph and paragraph 10 apply to existing patents and applications.

(2) For the purposes of this paragraph, rules 2, 9(1) and (3), 104 and 107(2), 112, 115 and 158 set out in Schedule 4 of the Patents Rules 1978(**19**) shall be treated as if they have been substituted for the corresponding rules in the Patents Rules 1968(**20**).

(3) The following provisions in the Patents Rules 1968 (notwithstanding their revocation by the Patents Rules 1978) shall continue to apply— rules 2, 4, 5, 9 to 31, 33 to 47, 40 to 63, 69 to 77, 84, 97, 103 to 107(2), 112 to 116 to 118, 128 to 132, 136, 150, 153, 154, 156 to 158 and Schedule 4.

(4) Rule 83 of the Patents Rules 1968 shall continue to apply only for the purposes of rule 89 of those Rules.

(5) In the provisions of the Patents Rules 1968 as they apply by virtue of this paragraph, a reference to a specified provision of those Rules other than one of those provisions shall be construed as a reference to the corresponding provision of these Rules (any provision of these Rules being treated as corresponding to a provision of those Rules if it was made for purposes which are the same as or similar to that provision of those Rules).

Application of these Rules to existing patents and applications

10.—(1) The provisions of Parts 1, 3 (except rules 34 and 35), 4 and 9 of these Rules shall apply to existing patents and applications.

(2) In those provisions as they apply by virtue of this paragraph, a reference to a specified provision of these Rules other than one of those provisions shall be construed as a reference to the

(**18**) The date that SI 2000/2037 came into force (see regulation 6, which limits the amendments to applications made after the provision came into force).

(**19**) SI 1978/216.

(**20**) SI 1968/1389.

corresponding provision of the Patent Rules 1968 (any provision of those Rules being treated as corresponding to a provision of these Rules if it was made for purposes which are the same as or similar to that provision of these Rules).

SCHEDULE 7

Rule 121(2)

REVOCATIONS

<i>Title and number</i>	<i>Extent of revocation</i>
Patents Rules 1978 (SI 1978/216)	Rule 124.
Patents Rules 1995 (SI 1995/2093)	The whole rules.
Patents (Supplementary Protection Certificates) Rules 1997 (SI 1997/64)	The whole rules.
Patents (Fees) Rules 1998 (SI 1998/1778)	The whole rules.
Patents (Fees) (Amendment) Rules 1999 (1999/1093)	The whole rules.
Patents and Trade Marks (World Trade Organisation Regulations 1999 (SI 1999/1899)	Regulations 9 to 12.
Patents (Amendment) Rules 1999 (SI 1999/1092)	The whole rules.
Patents (Amendment) (No. 2) Rules 1999 (SI 1999/3197)	The whole rules.
Patents (Amendment) Rules 2001 (SI 2001/1412)	The whole rules.
Patent (Amendment) Rules 2002 (SI 2002/529)	The whole rules.
Patents (Electronic Communications) (Amendment) Rules 2003 (SI 2003/513)	The whole rules.
Patents Act 2004 (Commencement No. 1 and Consequential and Transitional Provisions) Order 2004 (SI 2004/2177) (C.94)	Articles 3 to 5.
Patent (Amendment) Rules 2004 (SI 2004/2358)	The whole rules.
Patents Act 2004 (Commencement No. 2 and Consequential, etc. and Transitional Provisions) Order 2004 (SI 2004/3205) (C.140)	Articles 3 to 8 Article 9(2).
Patent (Amendment) Rules 2005 (SI 2005/2496)	The whole rules.
Patents, Trade Marks and Designs (Address For Service, etc) Rules 2006 (SI 2006/760)	Rules 4 to 9.
Patents (Amendment) Rules 2007 (SI 2007/[])	The whole rules.

ANNEX B

RULES CONCORDANCE

This commentary is intended to provide a guide to the draft Patents Rules 2007. In particular it shows where the effect of rules in the Patents Rules 1995 (as amended) or the Patents (Supplementary Protection Certificates) Rules 1997 has been modified or replicated. This commentary is not intended to be used to interpret the Patent Rules 2007 if, and when, they come into force.

Rule number in draft 2007 Rules	“Equivalent” rule in 1995 Rules or (where indicated) 1997 SPC Rules	Comments
PART 1 – INTRODUCTORY		
1	1	None
2	2 and 3 r 2 amended by: SI 1999/1092 and 2004/2358 r 3 amended by: SI 2004/2177	<p>Paragraph (1) includes a new definition for “application number” and “new application”. The definition of “initiation date” has been simplified from that in rule 2 of the 1995 Rules.</p> <p>New paragraph (3) makes it clear that throughout the Rules any reference to a time period is a reference to that period as altered. This makes separate provision unnecessary elsewhere in the Rules (for example the reference in rule 34(2)(c) of the 1995 Rules).</p> <p>New paragraph (4) creates a new concept of a document being “available to the comptroller”. This is to facilitate the use of electronic libraries and online resources. The term “electronic storage” is the same as that used in the Electronic Communications Act 2000, although neither there nor in these rules is the term defined.</p> <p>Paragraph (5) provides that certain documents may be treated as not so available. This includes where they cannot be verified to the comptroller’s satisfaction (e.g. they don’t come from a recognised electronic digital library) or the comptroller has to pay to obtain the document.</p> <p>Rules 3(b) and (c) of the 1995 Rules have not been included as the relevant constructions are self-evident and setting them out explicitly does not conform with modern drafting practice.</p>

		<p>The definition of “Journal” in rule 2 of the 1995 Rules has not been included since the definition set out in sections 123(6) and 130(1) of the 1977 Act can be relied upon.</p> <p>Finally, an index of defined expressions has been included in rule 120 and Schedule 5.</p>
3	2 amended SI 1999/1092 and 2004/2358	<p>This rule replaces the definition previously found in rule 2 of the 1995 Rules. The rule addresses some points raised in the <i>CIPA Guide</i> [5-07]. However, in general it is not intended to change the way the “declared priority date” is calculated for the purposes of the Rules.</p> <p>New rule 3(4) covers declarations which are treated as declarations under section 5(2) of the Act by virtue of section 89B(1)(b) – thus rendering rule 2(d) of the 1995 Rules unnecessary. Rule 2(c) of the 1995 Rules is also considered unnecessary by virtue of the operation of section 81(3)(c) in conjunction with section 5(2).</p> <p>In addition, this rule now includes a definition of “no declared priority date”. Although the term was used in the 1995 Rules it was never defined. This anomaly has now been remedied.</p> <p>The provision in rule 2(b) of the 1995 Rules is spent and so has not been included.</p>
4	4 amended SI 2003/513 and 2004/2177	<p>The reference presently in rule 4(2)(a) of the 1995 Rules is thought to be unnecessary. Either a replica form will satisfy new rule 4(2) or it will not, but no separate provision for replica forms is needed.</p> <p>The requirement in paragraph (4) is a result of the Patent Office moving to wholly electronic case-files (with paper documents being scanned in). Where documents are sent and both sides of the paper are used the comptroller may take no further action in relation to that piece of paper.</p> <p>Paragraph (5) is intended to replace rule 4(3) of the 1995 Rules. The provisions of rule 4 are disapplied where the information is delivered in electronic form or using electronic communications. However, the comptroller will give directions under section 124A as to any requirements which will apply.</p> <p>Note that, throughout the Rules, the “/77” has been dropped from all Form numbering.</p>

PART 2 – APPLICATIONS FOR PATENTS		
5	5	<p>This rule has been redrafted in a modern style, but the effect is intended to be the same as rule 5 of the 1995 Rules.</p> <p>The new rule makes an explicit reference to the written evidence mentioned in section 2(4)(c), which contrasts with rule 5(2) of the 1995 Rules.</p>
6	6 substituted by SI 2004/2358	<p>This rule is unchanged in effect, but the phrase to “the country in or for which it [the earlier relevant application] was made” in rule 6(4)(b) of the 1995 Rules has been replaced with “the country it was filed in or in respect of”. This matches the wording of section 5(3)(a).</p> <p>The definition of “priority application” now applies throughout the entire rules.</p>
7	6A inserted by SI 2004/2358 amended by SI 2007/XXXX	<p>The main change in this rule relates to “new applications” (recall the new definition in rule 2). Under rule 6A of the 1995 Rules a request under section 5(2B) for a late declaration on a new application had to be made on a Form 3/77 and be accompanied by evidence – despite the fact that the same process had to be undertaken for the same late declaration on the earlier application. This was unduly burdensome in relation to new applications and so paragraphs (4) and (6) provide a more liberal regime in relation to new applications.</p> <p>Paragraph (3) makes clear that, if evidence is not provided at the time of making the request, it may be provided within a specified period.</p> <p>Changes to rule 6A of the 1995 Rules to be made by the Patents (Amendment) Rules 2007 on 1 April 2007 are carried across into draft rule 7.</p>
8	6B inserted by SI 2004/2358	<p>Rule 6B(3)(a) and rule 6B(4)(a) of the 1995 Rules have been omitted, as they are unnecessary by reason of section 81(3)(c).</p> <p>Paragraph (2) represents rule 6B(2) of the 1995 Rules. However, it has been split up to include sub-paragraphs to make it easier to read.</p> <p>Paragraph (3) represents rule 6B(3)(b) of the 1995 Rules, although, following the general approach in the Rules, the specific regulation of the PCT is no longer mentioned. This approach has been adopted throughout the Rules and is</p>

		<p>intended to make them more future-proof. It should be noted that section 130(6) specifies that references to the EPC and the PCT include references to the Regulations made under those Treaties.</p> <p>Paragraph (4) represents rule 6B(4)(b) and (c) of the 1995 Rules. Paragraph (4)(b) now waives the requirement to file a certified copy where a copy is available to the comptroller. This is to allow for the use of electronic libraries of priority applications.</p> <p>A “relevant period” has been defined for this rule to reflect the new approach taken in rule 21.</p>
9	<p>6C inserted by SI 2004/2358</p>	<p>The following minor changes have been made to rule 6C of the 1995 Rules.</p> <p>The references to the particular rules in the EPC Implementing Regulations and the PCT Regulations have been removed (see comments above).</p> <p>In addition the comptroller will no longer be able to direct a translation be filed where the original is in Welsh.</p> <p>Paragraph (1)(c) also makes it possible for the comptroller to direct a translation be filed for the purposes of determining whether an invention is “new” as well as for the purpose of determining whether it involves an “inventive step”.</p> <p>The drafting of paragraph (3) has been slightly simplified.</p>
10	<p>14 and 15 r 14: amended by SI 1999/3197 r 15: amended by SI 2004/2358</p>	<p>Paragraph (1) represents rule 15(1) of the 1995 Rules.</p> <p>Paragraph (2) represents rule 15(1A) and (2) of the 1995 Rules. The words after the semi-colon replace rule 15(2) of the 1995 Rules, but the phrasing is shortened considerably. Also, the distinction between foreign-filed and UK priority applications has been removed.</p> <p>Paragraph (3) replaces rule 14(5) of the 1995 Rules, but is drafted to be in closer conformity with the rule-making powers in section 13(1).</p> <p>Paragraph (4) allows any person to make an application to have an inventor mentioned in accordance with section 13(1). In the 1995 Rules this right to apply exists only by implication. This provision sets out that right expressly.</p> <p>The remainder of rule 14 of the 1995 Rules is now dealt with under Part 7 of the new Rules.</p>

11	15A inserted by SI 2005/2496	There is a very minor modification to the punctuation of paragraph (7), but this does not change the legal effect of this provision.
12	16 amended by SI 2003/513 and 2004/2358	<p>Paragraphs (1) to (3) replicate rule 16(1) to (1B) of the 1995 Rules.</p> <p>Paragraphs (4) and (5) replace rule 16(2) of the 1995 Rules, but they are intended to have the same effect as the old provision, although are now drafted in a more modern style. Note that the title of the invention is now referred to as preceding the specification, rather than being a part of it, to reflect the fact that section 14(2)(b) does not refer to the title as being part of the specification. However, no change in practice is intended.</p> <p>Paragraph (7) replaces rule 16(4) of the 1995 Rules. The term “figure” has been omitted from the Rules as it was unclear what (if any) distinction there is between a “drawing” and a “figure” included in a drawing (the Act repeatedly refers to “drawings”, but never to “figures”).</p> <p>Paragraphs (8) and (9) replace rule 16(5) and (6). These provisions remove the references to a “description in English, with a declaration that it is a complete and accurate translation” since no distinction in practice has been identified between that and a “translation into English”. They also make amendments so that where an application is filed in Welsh no translation is required.</p>
13	17 amended by SI 2001/1412	<p>Paragraph (1) has been drafted to more accurately reflect section 125A. Schedule 1 is discussed below.</p> <p>Paragraphs (2) to (5) are new. They make certain special provisions for “sequence listings”.</p> <p>Paragraph (2) mandates that where an application includes a sequence it shall also include a sequence listing.</p> <p>Paragraph (3) requires that listing to comply with the relevant standard under the PCT. At present that standard is WIPO Standard ST.25 (set out in Annex C to the Administrative Instructions of the PCT). This standard is likely to be amended in the future and the provision is drafted so as to future-proof it (the Administrative Instructions are made under the PCT and so are covered by section 130(6)).</p> <p>Paragraph (4) requires a sequence listing, where reasonably possible, to be sent in electronic form. This applies whether</p>

		<p>or not the application as a whole is sent electronically.</p> <p>Paragraph (5) allows sequence listings to be included at the end of the application, rather than in the description, thereby giving greater flexibility to applicants.</p> <p>Paragraph (6) sets out a definition of “sequence” and “sequence listing” which applies to the whole Rules.</p>
14 and Schedule 2	18 and 20 rr 18 and 20: amended by SI 2003/513 r 20: amended by SI 2007/XXXX	<p>Paragraph (1) replaces rule 20(1) of the 1995 Rules, with minor drafting modifications and the allowance of the documents to be in Welsh.</p> <p>Paragraphs (2) to (4) give effect to the various parts of Schedule 2. The formal requirements themselves are set out in that Schedule. They are simplified from those found in rule 18 and 20 of the 1995 Rules and some requirements have been abolished or liberalised (see detailed comments later).</p> <p>Paragraph (5) replaces rule 18(4) and 20(16) of the 1995 Rules.</p>
15	19	<p>This rule is not intended to change current practice.</p> <p>Paragraph (1) replaces rule 19(1) of the 1995 Rules.</p> <p>Paragraph (2) replaces the opening words of rule 19(2) of the 1995 Rules.</p> <p>Rule 19(3) of the 1995 Rules is thought to be unnecessary as the 150 word limit is not strict. However, the practice will continue so that an abstract is unlikely to be considered “concise” if it extends beyond 150 words.</p> <p>Paragraph (3) replaces most of the rest of rule 19(2) of the 1995 Rules. The direction in the present rule that where appropriate, the abstract shall contain the chemical formula that best characterises the invention has been removed. Once more, the practice is not intended to change, but it is felt that the addition of this requirement adds nothing as applicants will include the formula where they think it appropriate in any event.</p> <p>Paragraphs (4) to (6) replace rule 19(4) of the 1995 Rules, with minor modernisation of the drafting.</p> <p>Paragraph (7) replaces the last sentence of rule 19(2) of the 1995 Rules.</p>

		Rule 19(5) of the 1995 Rules has not been replicated. If the rest of the rule is complied with then the abstract should continue to perform the function set out that provision.
16	22 amended by SI 1999/1092	Paragraph (1) represents rule 22(1) of the 1995 Rules . However, the drafting has been modified to be in greater accord with section 14(6). In particular, the drafting avoids the need to spell out that the rule applies where multiple inventions are claimed in a single claim as well as where they are claimed in separate claims. Further, considering the opening words of section 14(6) it is unnecessary to restate the opening words of rule 22(1) of the 1995 Rules .
17	22A inserted by SI 2004/2358	There are four minor changes from rule 22A of the 1995 Rules . First, the requirements to provide a translation where the original application is in Welsh have been removed. Secondly, the wording of paragraph (1)(c) has been modified to reflect the wording of section 5(3). Thirdly, where a copy of the application is “available to the comptroller” (rather than just kept at the Patent Office) it shall be treated as filed in accordance with rules. Fourthly, it will be possible for an application to be verified to the comptroller’s satisfaction instead of it being formally certified.
18	23 substituted by SI 2004/2358	Paragraph (1) is not expressed to be subject to paragraph (2). Instead, the approach adopted in these Rules is to use the term “but” in a following provision where it clearly modifies the application of the first. Similarly, the word “but” has been inserted at the beginning of paragraph (6). Note that paragraph (5)(b) has been modified so that it will be possible for an application to be verified to the comptroller’s satisfaction instead of being formally certified.
19	24 amended by SI 1999/1092, 1999/3197 and 2004/2358	The drafting of this Rule has been modernised. It is intended to have the same effect as rule 24 of the 1995 Rules . Paragraph (1)(a) sets the standard period within which an application may be filed as mentioned in section 15(9) (it should be noted that this term is used, rather than “under section 15(9)” as in the 1995 Rules , to follow the Act).

		<p>Paragraph (1)(b) replaces rule 24(2)(a) of the 1995 Rules, however the defined term “terminated” is used.</p> <p>The references in rule 24 of the 1995 Rules to the period being extended are no longer necessary because of rule 2(3).</p> <p>Paragraph (2) reflects current practice. It is loosely based on the opening wording of rule 24(1) of the 1995 Rules.</p> <p>Paragraph (3)(a) reflects the effect of the proviso to rule 24(1) of the 1995 Rules.</p> <p>Paragraph (3)(b) reflects the effect of the time period prescribed in rule 24(1) of the Rules.</p> <p>Rule 24(2)(c) of the 1995 Rules is unnecessary because section 15(9) itself makes clear that a divisional application can only be filed before the earlier application is granted.</p> <p>Rule 24(2)(b) of the 1995 Rules is unnecessary as, at the compliance date, the earlier application will either be terminated or granted. Paragraph (1)(b) cuts off the possibility of filing a new application if the earlier application is terminated, and (as noted above) section 15(9) cuts off that possibility if the earlier application is granted.</p>
20	10 and 56	<p>This rule consolidates rules 10 and 56 of the 1995 Rules.</p> <p>Paragraph (1) relates to that previously covered by rule 10 of the 1995 Rules.</p> <p>Paragraph (2) relates to that previously covered by rule 56 of the 1995 Rules.</p> <p>The time period for making a new application under sections 8(3), 12(6) and 37(4) has been rationalised. Under rule 10 of the 1995 Rules the period of 3 months begins either when the time limit for bringing an appeal expires (presently 28 days: CPR PD 52 paragraphs 17.1-17.3) or when the appeal is finally disposed of.</p> <p>Under paragraph (3), the 3-month period begins when the order is made or when the appeal is finally disposed of. In effect the time limit for making a new application (when no appeal is lodged) has been reduced by 28 days, although it is extendable at the comptroller’s discretion.</p> <p>Rule 110(2) of the 1995 Rules allows the comptroller to shorten the period prescribed in rule 56 of the 1995 Rules. Paragraph (4) retains this power (and applies it to filing</p>

		applications under section 8(3) and 12(6) as well). This power is referred to explicitly in rule 20 because it is the only time period outside of Part 7 which may be shortened.
21	26 substituted by SI 2004/2358	<p>This rule is more liberal than rule 26 of the 1995 Rules. It is also drafted differently as a result of changes made elsewhere in the Rules.</p> <p>Paragraph (1)(a) adjusts the period prescribed for the purposes of section 13(2) in relation to a new application. This replaces the simple reference in rule 26 of the 1995 Rules to rule 15(1) of the 1995 Rules. The period prescribed for the purposes of filing the Form 7 is now the same as that for the earlier application, or two months from initiation of the new application – whichever is the later.</p> <p>Similarly, under paragraph (1)(b) the “relevant period” for filing priority documents is the same as prescribed by rule 8 for the earlier application, or two months from initiation of the new application – whichever is the later.</p> <p>Paragraph (2) limits the liberal approach (and so follows the approach presently adopted in rule 26 of the 1995 Rules) where the new application is filed less than 6 months before the compliance date (the new term for the “end of the rule 34 period”).</p> <p>Paragraph (3) replaces rule 26(b) of the 1995 Rules. There is no change of practice intended.</p>
22	25 substituted by SI 2004/2358	<p>This rule has been redrafted to make it clearer in respect of new applications.</p> <p>Paragraphs (1) to (3) prescribe the periods for sections 15(10) and 17(1) in relation to normal applications. There is intended to be no change of practice.</p> <p>Paragraph (4) disapplies paragraphs (1) to (3) in relation to new applications.</p> <p>Paragraph (5) replaces rule 25(4)(a) of the 1995 Rules. This removes the anomaly that a new application filed a few days before the end of the “relevant period” must comply with the obligations before the end of that period, but one filed a few days later may have 2 months to comply. Thus for a new application, the obligations of the rule must be met within the same period as for the earlier application, or two months from initiation of the new application – whichever is the later. A gloss has been added at the end of paragraph (5) to make it clear that the reference in paragraph (7) to the date</p>

		<p>of filing refers to that of the earlier application.</p> <p>Paragraph (6) replaces rule 25(4)(b) of the 1995 Rules.</p> <p>Paragraph (7) replaces rule 25(5) of the 1995 Rules.</p>
23	28 substituted by SI 2004/2358	Only very minor drafting changes have been made.
24	29 substituted by SI 2004/2358	Only the title has changed, along with minor drafting changes.
25	31 amended by SI 2003/513 and 2006/760	<p>Paragraph (1) sets out what constitutes the formal requirements for paper applications. These requirements are now set out in Schedule 2, although the obligations to comply with the Schedule 2 requirements are in rule 14.</p> <p>Paragraph (2) sets out what constitutes the formal requirements for electronic applications.</p> <p>The special provision for applications for a European patent (UK) in rule 31(2) of the 1995 Rules has been removed as it is unnecessary by reason of section 81(3)(c).</p> <p>Paragraph (3) replaces the special provisions for international applications (UK) in rule 31(2) of the 1995 Rules.</p>
26	27 substituted by SI 2005/2496	Only minor drafting changes have been made for reasons of consistency.
27	28A and 32 r 28A: inserted by SI 2004/2358 r 32: amended by SI 1999/3197 and 2004/2358	<p>Paragraph (1) replicates rule 28A(1) of the 1995 Rules.</p> <p>Paragraph (2) replaces rules 28A(2) and 32(4) of the 1995 Rules.</p> <p>Paragraph (3) replaces rule 32(1) of the 1995 Rules. The rule adopts the new approach that all notifications are sent by “the comptroller” and not by “the Patent Office”.</p> <p>Paragraphs (4) and (5) replace rule 32(2) of the 1995 Rules. Some of the matter in rule 32(2) of the 1995 Rules has not been repeated as it is set out in section 17(6).</p> <p>Paragraph (6) replaces the form requirement in rule 32(2) and (3) of the 1995 Rules.</p>

28	33(1) to (3) and (5) amended by SI 2002/529 and 2004/2358	<p>This Rule has been redrafted to reflect modern drafting practice, and to clarify and liberalise the position in respect of new applications. In this respect, the rule is intended to mirror the drafting of rule 22.</p> <p>Paragraph (1) replaces rule 33(1) of the 1995 Rules.</p> <p>Paragraph (2) replaces rule 33(2) of the 1995 Rules. It should be noted that the reference to publication “in accordance with section 16” has been omitted by reason of section 130(5).</p> <p>Paragraph (3) replaces the opening of rule 33(3) of the 1995 Rules (except that it relies on the relevant period).</p> <p>Paragraph (4) disapplies paragraphs (2) and (3) to new applications.</p> <p>Paragraph (5) replaces rule 33(5) of the 1995 Rules with a more liberal provision. Therefore, where a new application is filed, the request for substantive examination may be filed within the same period as the earlier application, or within 2 months of the initiation date, whichever is the later. This echoes the approach taken in rule 22.</p> <p>Paragraph (6) is new – and again follows rule 22. It states that where a new application is filed less than 6 months before the compliance date, the request for substantive examination shall be made on the initiation date.</p> <p>Paragraph (7) defines the relevant period; this period reflects the usual case set out in rule 33 of the 1995 Rules.</p>
29	33(4)	<p>Paragraph (1) requires the comptroller to send a report to the applicant. This duty is implicit in the Act and the 1995 Rules, but it is now set out formally.</p> <p>Paragraph (2) replaces the second half of rule 33(4) of the 1995 Rules.</p> <p>The remainder of the Rule defines certain terms used in rules 30 and 31.</p> <p>The definition of “first substantive examination report” is intended to replace the informal (and uncertain) use of the phrase “first report under section 18”.</p> <p>The definition of “first observations report” and paragraph (4) is intended to cover the situation in rule 34(2) of the 1995 Rules.</p>

30	34 amended by SI 2004/2358	<p>The rule has been redrafted in a modern style. The effect is intended to be unchanged. Paragraph (1) is used simply to avoid repetition of the phrase “period prescribed for the purposes of section 18(4) and 20” throughout the rule.</p> <p>Paragraph (2) replaces rule 34(1)(a) of the 1995 Rules. This provision uses the term “first substantive examination” as defined in rule 29. The new wording is thought to render unnecessary the clarification contained in rule 34(1A) of the 1995 Rules.</p> <p>Paragraph (3)(a) replaces rule 34(1)(b) of the 1995 Rules.</p> <p>Paragraph (3)(b) replaces rule 34(1)(c) of the 1995 Rules.</p> <p>Paragraph (4) (in combination with the definition of “first observation report in rule 29) replaces rule 34(2) of the 1995 Rules.</p> <p>Paragraph (5) defines a new term: the “compliance date”. The term replaces what is presently known informally as “the end of the rule 34 period”, and appears at various points in the Rules.</p>
31	35 and 36	<p>Paragraph (1) removes the need for a Form 11/77 (and fee) when requesting an amendment pre-grant. Any such request can now simply to be made in writing.</p> <p>The rest of the rule is simply meant to replicate the effect of rules 35 and 36 of the Patents Rules 1995 and be more transparent, without changing practice.</p> <p>Paragraph (2) is included to make the rule more closely reflect the prescription provided for in section 19(1).</p> <p>Paragraph (3) sets out the general rule that amendments can normally be made with the “amendment period”.</p> <p>Paragraph (4) allows amendments after the amendment period in limited circumstances.</p> <p>Sub-paragraph (a) allows one amendment before the end of the period of 2 months beginning with the first substantive report, where that report notifies the applicant that his application complies with the Act and rules (this represents rule 36(4)(a)(ii) of the 1995 Rules).</p> <p>Sub-paragraph (b) allows one amendment following the first substantive examination report, which has to be made at the same time as the observations or amendments under section</p>

		<p>18(3) (this represents rule 36(4)(a)(i) of the 1995 Rules).</p> <p>Paragraph (5) defines the amendment period. It starts the period when the search report is issued under section 17(5) (this represents rule 36(2) of the 1995 Rules) and it ends either when the first substantive examination report is sent (representing rule 36(3) of the 1995 Rules) or, if that report is sent before publication, it ends when the observations, and amendments, under section 18(3) are made (representing rule 36(4)(b) of the 1995 Rules).</p> <p>Paragraph (6) is new. It prohibits someone adding a sequence listing as an amendment (such listing should be filed when the application itself is filed).</p> <p>Paragraph (7)(a) (combined with paragraph (8)) allows the conditions on amendment to be waived with the comptroller's consent, and this represents rule 36(6) of the 1995 Rules.</p> <p>Paragraph (7)(b) (combined with paragraph (8)) represents rule 35 of the 1995 Rules, and so disapplies the conditions on amendment, in respect of amendment of Form 1.</p> <p>Rule 36(5) of the 1995 Rules is no longer necessary as the drafting of the new rule makes this point clear.</p>
32	36A inserted by SI 2004/2358	<p>This rule is largely unchanged, save some modernising of the drafting to bring consistency.</p> <p>However, paragraph (6) states that, if evidence is not provided at the time of making the request, it may provided within a specified period. This is a change from the 14 day period which was prescribed by virtue of rule 36A and rule 107 of the 1995 Rules. It makes the provision consistent with rules 7 and 40 in this respect.</p>
33	37	<p>Again, the operation of the rule is largely unchanged, but some provisions have been updated.</p> <p>Paragraph (1) replaces rule 37(1)(a) of the 1995 Rules.</p> <p>Paragraph (2) is new. It allows the comptroller not to send the observations where they are libellous, offensive etc.</p> <p>Paragraph (3) replaces rule 37(1)(b) of the 1995 Rules. However, instead of simply excusing the duty in certain cases (the approach in rule 37(2) of the 1995 Rules) the comptroller now has a simple discretion whether to send the documents referred to in the observations.</p>

		Paragraphs (4) and (5) replace rule 37(3) of the 1995 Rules .
PART 3 – GRANTED PATENTS		
34	38 amended by SI 1999/3197	There is a new requirement that the certificate of grant must include the number of the patent (which reflects long-standing practice).
35	40 amended by SI 1999/3197, 2003/513 and 2004/2358	<p>Paragraph (1) represents rule 40(1) of the 1995 Rules. However, Patents Form 11/77 has been abolished and therefore the request can be made in writing.</p> <p>It is also thought that the word “clearly” in “clearly identify” is not necessary. Either the amendment is “identified” for the purposes of the rule, or it is not.</p> <p>Paragraph (2) represents rule 40(1A) of the 1995 Rules.</p> <p>Paragraph (3) represents rule 40(7) of the 1995 Rules.</p> <p>Paragraph (4) represents rule 40(6)(a) of the 1995 Rules.</p> <p>Paragraph (5) represents the tailpiece of rule 40(6) of the 1995 Rules.</p> <p>Paragraph (6) replaces rule 40(8), rule 53(c), rule 53(ii) and rule 77(2) of the 1995 Rules.</p> <p>Rules 40(1B) to (5) of the 1995 Rules are now dealt with in Part 7.</p> <p>Rule 40(6)(b) of the 1995 Rules has not been retained as European patent specifications are available on the Internet and so are always available to the comptroller.</p> <p>Rule 77(1) of the 1995 Rules has not been retained, since section 73 itself makes clear that the patentee must be given an opportunity of making observations or amendments. The period for doing so will be specified by the comptroller, but no change in practice is intended.</p>
36	39 substituted by SI 2005/2496	This rule replicates rule 39 of the 1995 Rules . However, the term “prescribed period” used in rules 39 to 39C of the 1995 Rules has been changed to “renewal period” (following suggestions that the original phrase is confusing).
37	39A inserted by SI	No changes (except that mentioned in relation to rule 36).

	2005/2496	
38	39B inserted by SI 2005/2496	No changes (except that mentioned in relation to rule 36).
39	39C inserted by SI 2005/2496	No changes (except that mentioned in relation to rule 36).
40	41 amended by SI 2005/2496	<p>The drafting of this rule has been modernised and is now consistent with the drafting of rule 32 (rule 36A of the 1995 Rules). In particular, paragraph (5) states that, if evidence is not provided at the time of making the application for restoration, it may provided within a specified period. This is a change from the 14 day period which was prescribed by virtue of rule 41 and rule 107 of the 1995 Rules. It makes the provision consistent with rules 7 and 32 in this respect.</p> <p>The definition of the period set out in paragraph (1) has been slightly amended from that found in rule 41(1)(a) of the 1995 Rules. It now fits more closely with the wording of section 25(4), but no change in effect is intended.</p> <p>As far as the provisions of rule 41(4) of the 1995 Rules are concerned, the requirement for the applicant to file Patents Form 53/77 has been abolished. The requirement to file Patents Form 12 is now contained in rule 36(4), and the requirement to pay the unpaid renewal fees is stated in section 28(3) and so does not need restating in the Rules.</p>
41	42 substituted by SI 2005/2496	No changes (except that mentioned in relation to rule 36).
42	43 amended by SI 1999/3197	<p>This rule reflects rule 43(1)(a) of the 1995 Rules.</p> <p>The remainder of rule 43 of the 1995 Rules is dealt with under Part 7 of the Rules.</p>
43	61, 63 and 64	<p>Paragraph (1) replaces rule 61(1) of the 1995 Rules.</p> <p>Paragraph (2) replaces rule 61(2) of the 1995 Rules.</p> <p>Paragraph (3) reflects rule 63(a) of the 1995 Rules.</p> <p>Paragraph (4) prescribes the two month period currently found in rule 64(1)(a) of the 1995 Rules.</p> <p>Rule 63(b) of the 1995 Rules has not been replicated as this</p>

		<p>requirement is set out in section 47(2).</p> <p>Rule 63(c) of the 1995 Rules and rule 64(1)(c) of the 1995 Rules are unnecessary by reason of rule 75 (in Part 7). In other words, applications under section 47(1) or 47(3) must be advertised under that rule, since they are capable of being opposed. The requirement in rule 64(1)(a) of the 1995 Rules that a Form 2/77 is used, and the provisions of rule 64(1)(b) and rule 64(2) of the 1995 Rules are unnecessary by reason of the fact that section 47(3) proceedings are included in the general provisions on proceedings in Part 7.</p>
PART 4 – THE REGISTER AND OTHER INFORMATION		
44	<p>44, 51 and 77C</p> <p>r 44: amended by SI 1999/3197 and 2005/2496</p> <p>r77C: inserted by SI 2005/2496</p>	<p>Paragraph (1) represents rule 44(1) and (2) of the 1995 Rules. The drafting has been clarified and updated in a number of respects.</p> <p>Paragraph (2) represents rule 44(2A) of the 1995 Rules.</p> <p>Paragraph (3) represents rule 44(3)(a) and (b) of the 1995 Rules. It also limits such entries to where the application has not been published (as did rule 44(1) of the 1995 Rules).</p> <p>Paragraph (4) represents rule 44(3)(c) to (e) of the 1995 Rules. It also makes it clear such entries should be made when the patent is granted.</p> <p>Paragraph (5) represents rule 77C of the 1995 Rules. Rule 77C(d) of the 1995 Rules has not been retained as this is covered by paragraph (7).</p> <p>Paragraph (6) represents rule 44(3)(f) of the 1995 Rules. It also includes the timing of the entry.</p> <p>Paragraph (7) represents rule 44(4) of the 1995 Rules and the second part of rule 51 of the 1995 Rules.</p> <p>The remainder of rule 51 of the 1995 Rules is no longer necessary following the new litigation procedure in Part 7.</p> <p>Rule 49 of the 1995 Rules has not been included. Therefore, the register at the Patent Office will be freely open for inspection at all convenient times (see section 32(5)). (The Register is also always available on the Patent Office website).</p>
45	50	Only very minor drafting changes have been made.

46	52	<p>Paragraph (1) replaces rule 52(1)(a) of the 1995 Rules, insofar as it relates to the register.</p> <p>Paragraph (2) replaces rule 52(2) of the 1995 Rules to the extent that rule relates to the register. This paragraph also makes it clear that person is entitled to a copy (to be more closely in accord with section 32(6)).</p> <p>Paragraph (3) replaces rule 52(1)(c) of the 1995 Rules, however it removes the express reference to section 32(10).</p> <p>As far as rule 52 of the 1995 Rules relates to other documents, it is replaced by rule 48.</p> <p>Rule 52(1)(b) of the 1995 Rules (where a rubber stamp is used to authentic a document) has been abolished as it is almost never requested and serves no additional purpose.</p>
47	46 and 53 r 46: amended by SI 1999/3197 and 2004/2358	<p>Paragraph (1) replaces rules 46(1) and (2) of the 1995 Rules. The requirements in rule 46(2) of the 1995 Rules have not been set out explicitly. A document signed by the assignor or mortgagor (&c) would be sufficient evidence to establish the transaction (it should be noted that the strict evidential requirements set out in rule 103 of the 1995 Rules now only apply to Part 7) and so would fall within the broad requirement of rule 47(1)(b).</p> <p>Paragraph (2) replaces rule 46(3) of the 1995 Rules.</p> <p>Most of rule 53 of the 1995 Rules has not been replicated as it will normally be in one party's interests to notify the comptroller of the event, or it may be part of the court order. In any case, CPR PD 63, paragraph 15.1 says "Where any order of the court affects the validity of an entry in the register, the court and the party in whose favour the order is made, must serve a copy of such order on the Comptroller within 14 days". However, as noted earlier rule 53(c) and 53(ii) of the 1995 Rules has been replicated in rule 35(6).</p>
48	52	<p>Paragraph (1) replaces rule 52(1)(a) of the 1995 Rules insofar as it relates to documents other than register entries.</p> <p>Paragraph (2) replaces rule 52(2) of the 1995 Rules insofar as it relates to documents other than register entries.</p> <p>Again note that the "rubber stamp" option of rule 52(1)(b) of the 1995 Rules has been removed.</p> <p>Paragraph (3) includes the restriction in rule 52(3) of the 1995 Rules, restated in a simpler form. It also includes a</p>

		<p>new restriction (which was implicit before), namely that a copy cannot be made where to make or provide that copy would infringe copyright.</p> <p>Paragraph (4) sets out the definition of relevant document. This approach replaces that in rule 52 of the 1995 Rules, where the term “anything referred to in section 32(11)(b)” was used.</p>
49	45 amended by SI 2004/2358	<p>This rule now refers to “corrections” rather than alterations. This is because the rule is made (except in relation to paragraph (6)) under section 32(2)(d). There is, subject to what is set out below, intended to be no change of practice.</p> <p>Paragraph (1) replaces part of rule 45(1) and (3) of the 1995 Rules. Paragraph (2) retains the requirement in rule 45(1) of the 1995 Rules to use a Form 20 when requesting correction of a change of name. Paragraph (3) retains the ability to request correction of an address in writing, currently in rule 45(3) of the 1995 Rules.</p> <p>Paragraph (4) replaces rule 45(2) of the 1995 Rules, however it now applies the same test to names, addresses and addresses for service.</p> <p>Paragraph (5) replaces rule 45(4) of the 1995 Rules, but it is now drafted to fit more closely with the new test in paragraph (4).</p> <p>Paragraph (6) makes it clear that this rule also applies to the correction of a name or address under section 117 (and rule 105 does not apply).</p>
50	47 amended by SI 2004/2358	<p>Paragraph (1) sets out the right to request a correction.</p> <p>Paragraph (2) replaces (and updates) rule 47(1) of the 1995 Rules. However, Patents Form 11/77 has been abolished and therefore a request to correct an error will be made in writing.</p> <p>Paragraph (3) replaces rule 47(2) of the 1995 Rules.</p> <p>Paragraph (4) replaces rule 47(3) of the 1995 Rules.</p> <p>Provisions are redrafted in minor ways to bring consistency, where appropriate, between rules 49 and 50.</p>
51	93 and 96(2)	<p>This rule has been modernised substantially from rule 93 of the 1995 Rules. However, there is not intended to be any significant change of practice.</p>

	<p>r 93 amended by SI 2005/2496 and SI 2007/XXXX</p>	<p>Paragraph (1) sets out the purpose of the rule explicitly (this is only implicit in rule 93 of the 1995 Rules).</p> <p>Paragraph (2) provides an absolute bar on certain disclosures. Sub-paragraph (a) replaces rule 93(4)(b) of the 1995 Rules, although the term “internal use” has been added to avoid any possible ambiguity; sub-paragraph (b) replaces the effect of rule 96(2) of the 1995 Rules; sub-paragraph (c) replaces rule 93(4)(e) of the 1995 Rules; sub-paragraph (d) replaces rule 93(5)(a) of the 1995 Rules.</p> <p>Paragraph (3) bars certain disclosures “unless in a particular case the comptroller otherwise directs”. Sub-paragraph (a) replaces rule 93(4)(d) of the 1995 Rules; sub-paragraph (b) replaces rule 93(4)(f) of the 1995 Rules; sub-paragraph (c) replaces rule 93(4)(g) of the 1995 Rules; sub-paragraph (d) replaces rule 93(5)(b) of the 1995 Rules, although the emphasis has changed so that it cannot be disclosed without the comptroller directing, rather than there simply being no duty to disclose; sub-paragraph (e) replaces rule 93(4)(h) of the 1995 Rules.</p> <p>Paragraph (4) is self-explanatory.</p> <p>Rule 93(4)(c) of the 1995 Rules has not been retained. However, documents accidentally sent to the Patent Office are not copied and would (as now) be sent back without being put on the relevant file.</p> <p>The restriction on appealing a decision of the comptroller, in rule 93(6) of the 1995 Rules, is no longer thought to be appropriate and so has not been maintained.</p> <p>The change being made to rule 93 of the 1995 Rules by the Patents (Amendment) Rules 2007 on 1 April 2007 is carried across into draft rule 51. Thus a document may be inspected as soon as it has arrived at the Office.</p>
52	96	<p>Paragraph (1) reflects rule 96(1) of the 1995 Rules but with a broader evidential requirement.</p> <p>Paragraphs (2) and (3) reflect the first part of rule 96(2) of the 1995 Rules (the latter part of that rule being covered by rule 51(2)(c)).</p> <p>Paragraph (4) sets out more clearly what happens when the applicant is notified and objects.</p>
53	94	<p>This rule has been modernised substantially from rule 94 of</p>

	<p>amended by SI 2005/2496 and SI 2007/XXXX</p>	<p>the 1995 Rules. However, there is not intended to be any significant change of practice.</p> <p>Paragraph (1) replaces the middle part of rule 94(1) of the 1995 Rules.</p> <p>Paragraph (2) replaces the limitation imposed in rule 94(1) of the 1995 Rules.</p> <p>Paragraph (3) includes much of the rest of rule 94(1) of the 1995 Rules.</p> <p>Paragraph (4) covers the final part of rule 94(1) of the 1995 Rules and makes it clear that until a decision is made the document shall be treated as confidential. The new approach, combined with rule 2(3), makes redundant the last part of rule 94(5) of the 1995 Rules.</p> <p>Paragraph (5) requires the comptroller to make a decision either to treat the document as confidential or to reject the request.</p> <p>Rule 94(2) of the 1995 Rules is no longer needed as the requirement of the comptroller’s permission is already part of rule 51(3).</p> <p>Rule 94(3) of the 1995 Rules has not been retained, since it simply left the comptroller to determine what was “reasonably practicable”. In practice, however, the comptroller will continue to consult the person who made the request (where possible) before revoking any direction.</p> <p>Rule 94(4) of the 1995 Rules is no longer thought necessary, as it simply sets out good practice in respect of record-keeping.</p> <p>Rule 94(5) of the 1995 Rules has not been reproduced and is in any case to be removed by the Patents (Amendment) Rules 2007 on 1 April 2007.</p>
54	92 amended by SI 2005/2496	<p>This rule replaces the ‘caveats’ system currently in rule 92 of the 1995 Rules. The practice is intended to remain unchanged and the rule has been redrafted to more closely reflect the current practice.</p> <p>Paragraphs (1) and (4) replace rule 92(3) of the 1995 Rules.</p> <p>Paragraph (2) imposes an obligation on the comptroller to notify the person making the request of the “relevant event” occurring. This obligation is not clear from the present</p>

		<p>drafting of rule 92 of the 1995 Rules and it does not clearly flow from section 118.</p> <p>Paragraph (3) makes it clear that no information can be released under this rule unless that information could be seen under section 118.</p> <p>Paragraph (5) sets out the relevant events in relation to applications for patents. Sub-paragraph (a) replaces rule 92(1)(a) of the 1995 Rules. Sub-paragraph (b) and (c) replace rule 92(1)(b) of the 1995 Rules. Sub-paragraph (d) replaces rule 92(1)(c) of the 1995 Rules.</p> <p>Paragraph (6) sets out the relevant events in relation to patents. Sub-paragraph (a) replaces rule 92(1)(ff) of the 1995 Rules. Sub-paragraph (b) replaces rule 92(1)(d) and the first part of rule 92(1)(f) of the 1995 Rules. Sub-paragraph (c) replaces rule 92(1)(e) of the 1995 Rules. Sub-paragraph (d) replaces the second part of rule 92(1)(f) of the 1995 Rules.</p> <p>Paragraph (7) sets out the relevant events which relate to both patents and applications. Sub-paragraphs (a) and (c) replace rule 92(1)(g) of the 1995 Rules. Sub-paragraph (b) replaces rule 92(1)(i) of the 1995 Rules. Sub-paragraph (d) replaces a part of rule 92(1)(h) of the 1995 Rules (the other part being redundant in the light of the other provisions).</p> <p>Rule 92(2) and (4) of the 1995 Rules are now spent as there are no longer any “existing patents” where information is not already available (except those which are kept secret for national security reasons).</p>
55	95	<p>The term “bibliographic data” has been changed to “bibliographic information” as that is the term used in section 118(3)(b).</p> <p>The order of the bibliographic information has been altered and the drafting has been updated. However, the only substantive change is the inclusion of paragraph (g), which allows details of transactions to be published as bibliographic information (for example, addition of an exclusive licensee). This change is prompted by users’ comments that having no information on such transactions before publication leaves third parties who may wish to acquire rights in the patent application without key information, and also may prejudice the exclusive licensees themselves.</p>

PART 5 – EUROPEAN PATENTS (UK)

56	1 to 3 (Sch 4) amended by SI 2003/513	<p>Paragraph (1) replaces paragraph 1(1) and a part of paragraph 3(1) of Schedule 4 to the 1995 Rules (except the requirement to file in duplicate).</p> <p>The provision in paragraph 3(1)(a) of Schedule 4 to the 1995 Rules is unnecessary in the light of the wording of section 78(7), which is in any case restricted to EP applications which have been published.</p> <p>The provision in paragraph 3(1)(b) of Schedule 4 to the 1995 Rules is now also thought unnecessary. If the Euro-PCT application is published under the PCT in French or German, section 78(7) as modified by section 79(1) would seem to allow provisional protection to be activated by filing English claims after PCT publication. So there is no need for a rule to restate this. If the Euro-PCT application is published under the PCT in a language other than English, French or German, the operation of section 79(3) means that provisional protection is not available until the Euro-PCT application enters the regional phase and is republished in English, French or German. (This also tallies with Article 158(3) EPC). If it is republished in French or German, section 78(7) then applies, and provisional protection may be obtained at that point by filing English claims. But it seems that such protection cannot be activated earlier than this – and so a rule is again unnecessary.</p> <p>Paragraph (2) replaces the requirements of paragraph 1(3) and (4)(a) and 3(3) of Schedule 4 to the 1995 Rules.</p> <p>Paragraph (3) replaces the requirement to file in duplicate in paragraph 1(1) and paragraph 3(2) of Schedule 4 to the 1995 Rules.</p> <p>Paragraph (4) replaces paragraph 1(4A) of Schedule 4 to the 1995 Rules. As elsewhere, the provision disapplies the requirements of paragraphs (2) and (3), but the comptroller will then give directions under section 124A as to any requirements which do apply.</p> <p>Paragraph (5) replaces the requirements of paragraph 1(4)(b) of Schedule 4 to the 1995 Rules.</p> <p>Paragraph (6) replaces paragraph 2(1) of Schedule 4 to the 1995 Rules.</p> <p>Paragraph (7) replaces paragraph 2(2) of Schedule 4 to the</p>
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		<p>1995 Rules.</p> <p>Paragraph (8) is intended to ensure that a translation filed under section 77(6) cannot be a translation of the description which is married with a translation of the claims filed under section 78(7). Thus a translation of the whole specification as granted must be filed. This has a similar effect to paragraph 1(2) of Schedule 4 to the 1995 Rules.</p>
57	4 (Sch 4) amended by SI 2003/513	<p>Paragraph (1) replaces the requirement to use Form 54/77 found in paragraph 4(3) of Schedule 4 to the 1995 Rules.</p> <p>Paragraphs (2) and (3) replace paragraph 4(2) of Schedule 4 to the 1995 Rules.</p> <p>Paragraph (4) replaces the part of paragraph 4(3) of Schedule 4 to the 1995 Rules requiring the form to be filed in duplicate.</p> <p>Paragraph (5) is new. Similarly to rule 56(5), formal requirements are disapplied where a translation is filed electronically, but requirements may be imposed by direction under section 124A.</p> <p>Paragraph (6) replaces paragraph 4(4) of Schedule 4 to the 1995 Rules.</p>
58	81 amended by SI 2004/2358	<p>Paragraph (1) replaces all of rule 81(1) of the 1995 Rules, except that part prescribing the period.</p> <p>Paragraph (2) replaces rule 81(2) of the 1995 Rules.</p> <p>Paragraph (3) replaces the remainder of rule 81(1) of the 1995 Rules.</p> <p>Paragraph (4) replaces rule 81(3) of the 1995 Rules.</p> <p>Paragraph (5) provides a definition of “contracting state” which is based on the definition found in section 82(9).</p>
59	82 amended by SI 2004/2358	<p>Paragraph (1) replaces rule 82(1) of the 1995 Rules.</p> <p>Paragraph (2) replaces rule 82(2) of the 1995 Rules.</p> <p>Paragraph (3) replaces rule 82(3) of the 1995 Rules.</p> <p>This rule reflects rule 82 of the 1995 Rules, with some minor drafting changes.</p>

60	83	<p>This rule replaces rule 83(1) of the 1995 Rules.</p> <p>Rule 83(2) of the 1995 Rules is not needed as this requirement is imposed by rule 28(1).</p> <p>Rule 83(3) of the 1995 Rules is not needed. It is clear from section 81(3)(a) and (c), and rule 30, that the compliance date of a converted application is calculated from its date of filing or priority.</p>
61	84	<p>This rule reflects rule 84 of the 1995 Rules, with some minor drafting changes.</p>
62	86	<p>Paragraph (1) replaces rule 86(1) of the 1995 Rules. However, it follows the drafting of CPR r 34.17(a) rather than the drafting of rule 86(1) of the 1995 Rules.</p> <p>Paragraph (2) reflects CPR r 34.17(b).</p> <p>Paragraph (3) replaces rule 86(3) of the 1995 Rules.</p> <p>Rule 86(2) of the 1995 Rules has not been replicated as it appears to be self-evident that once one order has been made another can be made. If the second application relates to matters arising from the first then there is no need to start a new application.</p>
63	87	<p>This rule replaces rule 87 of the 1995 Rules with minor drafting changes.</p> <p>The equivalent provision to rule 93 of the 1995 Rules is not mentioned as the new drafting of rule 51 makes this unnecessary.</p>
PART 6 – INTERNATIONAL APPLICATIONS		
64	-	<p>This rule sets out certain definitions (from the Patent Cooperation Treaty) which are used in the Rules (most, but not all are used only in Part 6).</p>
65	117 to 119 r 118: amended by SI 1999/1092	<p>Paragraph (1) replaces rule 117(1) of the 1995 Rules. However, it provides that such an application can be filed in Welsh as well as in English.</p> <p>Paragraph (2) replaces rule 117(2) of the 1995 Rules, although the drafting has been simplified.</p> <p>Paragraph (3) replaces rule 118 of the 1995 Rules. The</p>

		<p>drafting has been simplified as the precise provisions of the Conventions/Treaties are not being set out in the Rules any more.</p> <p>Paragraph (4) replaces rule 119 of the 1995 Rules.</p> <p>Provisions concerning the transmittal fee and late payment fee, currently in rule 118(1) and (3) of the 1995 Rules respectively, will to the extent necessary be replicated in the Patents (Fees) Rules.</p>
66	<p>85(1), (3A) and (5A)</p> <p>r 85(1) substituted by SI 2002/529</p> <p>r 85(3A) inserted by SI 2007/XXXX</p> <p>r 85(5A) amended by SI 1999/3197 and SI 2002/529</p>	<p>Paragraph (1) represents the general position currently set out in rule 85(1) of the 1995 Rules. Throughout Part 6 there are no references to dates being treated by virtue of the Act as priority dates or dates of filing as they are thought to be unnecessary.</p> <p>Paragraph (2) represents the modifications presently made by rule 85(5A)(a) and (b) of the 1995 Rules. This rule does not, however, apply when a translation of an amendment has been filed but a translation of the application has not been filed (see also rule 69(5)).</p> <p>Paragraph (3) represents the obligation imposed by rule 49ter.2 PCT from 1st April 2007, allowing for a request for a late declaration of priority to be made within 1 month of entering the national phase. It reflects rule 85(3A) of the 1995 Rules, added by the Patents (Amendment) Rules 2007 on 1 April 2007.</p>
67	<p>85(3) amended by SI 2002/529 and 2004/2358</p>	<p>This rule replaces rule 85(3) of the 1995 Rules.</p> <p>The period of time now being 1 month beginning with the date the national phase begins means that rule 85(4) of the 1995 Rules (insofar as it relates to rule 85(3) of the 1995 Rules) is no longer necessary.</p>
68	<p>85(7) and (7A) amended by SI 2002/529 and SI 2004/2358</p>	<p>This rule has rationalised the time limits for PCT applications. Under rule 85(7) of the 1995 Rules, the time period was 33 months from the priority date, or the date of filing. However, that rule only applied if the application entered the national phase at the end of the period prescribed by rule 85(1) of the 1995 Rules (i.e. 31 months). In other words, the time limit is in fact always 2 months from the date the application begins the national phase – except for the period prescribed for the purposes of section 18(1). This means that rule 85(4) of the 1995 Rules (insofar as it relates to rule 85(7) of the 1995 Rules) is no longer necessary.</p> <p>This means that rule 85(7) and (7A) of the 1995 Rules can</p>

		<p>be merged.</p> <p>Paragraph (2) replaces rule 85(7) and (7A)(a) of the 1995 Rules. In relation to applications which entered the national phase at the end of the prescribed period, the period prescribed by rule 10(1) will always have expired and so the period prescribed will be the period of 2 months beginning with the date the national phase begins (or 33 months from the priority date, or date of filing). This means that the new rule is functionally the same as the old.</p> <p>Paragraph (3) replaces rule 85(7) and (7A)(b) of the 1995 Rules. And the comments above equally apply in relation to rule 22(2).</p> <p>Paragraph (4) replaces rule 85(7) and (7A)(c) of the 1995 Rules.</p>
69	<p>85(2) and (5)</p> <p>Par (2): amended by SI 1999/3197, 2001/1412, 2002/529</p> <p>Par (5): amended by SI 1999/1092</p>	<p>Paragraph (1) represents the rule 85(2) and the opening part of rule 85(5) of the 1995 Rules.</p> <p>Paragraph (2) replaces rule 85(5)(a)(i) of the 1995 Rules.</p> <p>Paragraph (3) replaces rule 85(5)(a)(ii) of the 1995 Rules.</p> <p>Paragraph (4) includes the part of the opening paragraph of rule 85(5) of the 1995 Rules.</p> <p>Paragraph (5) includes a clearer notification requirement where certain translations are missing, but in effect it replaces rule 85(5A) of the 1995 Rules.</p>
70	<p>85(5)</p> <p>amended by SI 1999/1092</p>	<p>Paragraph (1) sets the scope of the rule.</p> <p>Paragraph (2) sets out the extent of the translation required. This was previously set out in the opening part of rule 85(5) of the 1995 Rules.</p> <p>Paragraph (3) replaces rule 85(5)(b) of the 1995 Rules. The drafting of the rule not only removes references to the PCT, it also uses the word “annotation” instead of “textual matter” for consistency elsewhere.</p> <p>Paragraph (4) replaces rule 85(5)(c) of the 1995 Rules. Following the general practice of the new rules, the relevant provisions of the PCT are not spelt out.</p> <p>Paragraph (5) replaces rule 85(5)(d) of the 1995 Rules. Once more the relevant provisions of the PCT are not spelt out.</p>

		<p>Paragraph (6) makes it clear that the requirement to provide translations applies equally to translations of amendments. This is to avoid having separate provisions.</p>
71	<p>85(10) to (12)</p> <p>Par (11) amended by SI 1999/1092</p>	<p>The procedure in relation to section 89(3) and directions under section 89(5) has been redrafted. This procedure was previously contained in rules 85(8) to (12) of the 1995 Rules. However there was considerable overlap and the procedure was not particularly clear.</p> <p>Paragraph (1) allows for the applicant to make a request to the comptroller to give a direction under section 89(5). Insofar as rule 85(12) of the 1995 Rules applies to section 89(5) this provision replaces it.</p> <p>Paragraph (2) says the applicant may notify the comptroller that the circumstances mentioned in or prescribed for the purposes of section 89(3) apply to his application. This provision does not take the form of an application or request because where the comptroller is aware of the circumstances he has no discretion over whether or not to treat the application as under the Act. This replaces some of the effect of rule 85(8) and (12) of the 1995 Rules.</p> <p>Paragraph (3) sets out the requirements of the request under paragraph (1).</p> <p>Paragraph (4) sets out when a request under paragraph (1) may be made.</p> <p>Paragraph (5) enables the comptroller to require documents be given to him enable the request to be determined.</p> <p>Paragraph (6) states that where the documents are not provided the request may be treated as withdrawn. Note that the specified period may be extended under section 117B.</p> <p>Paragraph (7) replaces the various powers to alter time periods and amend documents. In relation to time periods, this new rule applies only in relation to the normally non-extendable periods. Other periods of time will be extended under rule 108 (which replaces rule 110 of the 1995 Rules).</p> <p>This rule does not have a provision equivalent to rule 85(11) of the 1995 Rules. It is thought that the effect of that rule can be achieved by virtue of either section 117 of the 1977 Act or rule 108 (which replaces rule 110 of the 1995 Rules).</p>
72	85(9)	<p>This rule replaces rule 85(9) of the 1995 Rules. The drafting</p>

		of this rule has changed to reflect the wording of section 89(3), in particular the specific power to prescribe other circumstances.
PART 7 – PROCEEDINGS HEARD BEFORE THE COMPTROLLER		
<p>This Part covers proceedings which were formerly conducted under the following provisions of the 1995 Rules or the 1997 SPC Rules:</p> <p><i>Entitlement rules 7-9, 11, 13, 54, 55, 57 and 58 of the 1995 Rules.</i> <i>Disputes between co-applicants: rule 12 of the 1995 Rules.</i> <i>Inventorship: rule 14 of the 1995 Rules</i> (but see rule 10). <i>Opposition to amendment: rule 40 of the 1995 Rules</i> (but see rule 35). <i>Opposition to surrender: rule 43 of the 1995 Rules</i> (but see rule 42). <i>Opposition to correction: rule 91 of the 1995 Rules</i> (but see rule 105). <i>Employee compensation: rule 59 and 60 of the 1995 Rules</i> (also see rule 91). <i>Licensing: rules 62, 64, 65, 68-71 of the 1995 Rules</i> (also see rule 89). <i>Infringement: rules 72 and 73 of the 1995 Rules.</i> <i>Declaration of non-infringement: rule 74 of the 1995 Rules.</i> <i>Revocation: rule 75 of the 1995 Rules.</i> <i>Declaration of lapse or invalidity of SPC: rule 7 of the 1997 SPC Rules.</i></p> <p>It also covers new proceedings in relation to revocation of a paediatric extension to an SPC. Such extensions, and their revocation, are provided for by the EC Paediatric Medicines Regulation (EC No. 1901/2006).</p> <p>It also covers new proceedings which are available under certain provisions of the EC Compulsory Licensing Regulation (EC No. 826/2006) in relation to applying for, terminating, modifying or reviewing a compulsory licence granted under the terms of that Regulation.</p>		
73		This rule, along with Schedule 3, sets out the scope of the new Part. As well as applying to the <i>inter partes</i> proceedings listed above, some rules within Part 7 apply to all proceedings before the comptroller – whether <i>ex parte</i> or <i>inter partes</i> .
74		This new rule sets out the comptroller’s overriding objective. The drafting of paragraphs (1) and (2) reflects CPR r 1.1 . Paragraph (3) reflects CPR r. 1.2 . Paragraph (4) reflects CPR r. 1.3 .
75		This rule requires the comptroller to publish a notice in the journal respect of any action to which a person can object. It also defines the “relevant notice” for the purposes of rule 76. This enables an “opposition” period to be set from the date of publication of that notice.

76		<p>This rule sets out how proceedings are started.</p> <p>Paragraph (3) defines the term “relevant form”. In practice the form needed to start proceedings will be the same as under the 1995 Rules or 1997 SPC Rules.</p> <p>Thus the proceedings listed in Part 1 of Schedule 3 are started by filing a Form 2 (or, in relation to supplementary protection certificates, Form SP3). Note that proceedings in respect of compulsory licences under sections 48, 50A, 51 and 52 of the 1977 Act are included here. This means they are started just like any other proceedings, and the <i>prima facie</i> consideration stage, which features in rule 70 of the 1995 Rules, has been abolished. Note also that applications made under section 8(5) or section 37(3) are not considered to be the start of fresh proceedings, and so are not listed as separate proceedings in Part 1 of Schedule 3. Thus rule 11 and rule 55 of the 1995 Rules have not been replicated.</p> <p>Proceedings listed in Part 2 of that Schedule are opposition proceedings which are started by filing a Form 15. Under paragraph (2), the opposition period is 4 weeks, except for post-grant amendment under section 75, where the 2 week period reflects that available in proceedings before the court.</p> <p>The rule requires a statement of grounds to be filed when proceedings are started, and paragraph (4) sets out what such a statement shall contain. Thus rule 107 of the 1995 Rules has not been replicated.</p>
77		<p>This rule requires the comptroller to notify interested parties, and send them a copy of the form and statement. It also sets the period for such parties to file a counter-statement.</p> <p>It makes different provision for those oppositions under Part 3 of Schedule 3 (these are oppositions which follow when proceedings under Part 1 of that Schedule are already underway). In such cases, the person opposing must file a counter-statement within the 4-week period, and becomes the defendant.</p>
78		<p>This rule sets out the general position in respect of counter-statements.</p> <p>Paragraph (1) reflects CPR r. 16.5(1), although certain minor drafting changes have been made for consistency.</p> <p>Paragraph (2) reflects CPR r. 16.5(2).</p>

		<p>Paragraph (3) reflects CPR r. 16.5(5).</p> <p>Paragraph (4) reflects CPR r. 16.5(3).</p> <p>Paragraph (5) reflects part of rule 21 of the 1995 Rules.</p>
79	112 amended by SI 2007/XXXX	This rule is an updated version of rule 112 of the 1995 Rules , as applied to proceedings before the comptroller.
80		<p>This rule deals with the evidence rounds and the hearing (if any).</p> <p>Paragraph (1) requires the comptroller to send a counter-statement and to specify the periods within which evidence must be filed.</p> <p>Paragraph (2) gives the comptroller the general power to allow evidence to be filed at his discretion. This provision operates in conjunction with rule 82(2).</p> <p>Paragraph (3) dictates that evidence shall only be considered filed where it has been received by the comptroller and where it has also been sent to the other party (this would be done by the party filing it).</p> <p>Paragraph (4) requires the comptroller to give the parties an opportunity to be heard.</p> <p>Paragraph (5) sets out that the comptroller should set a date for the hearing and notify the parties.</p> <p>Paragraph (6) requires the comptroller to notify the parties of his decision and to provide the reasons for it.</p>
81		This rule gives the comptroller the power to extend or shorten a time limit specified in accordance with Part 7. Such time limits are excluded from section 117B by reason of section 117B(5).
82		<p>This rule sets out the comptroller's case management powers.</p> <p>Paragraph (1) is partially based on CPR r. 3.1(2).</p> <p>Paragraph (2) is based on CPR r. 32.1.</p> <p>Paragraph (3) is based on CPR r. 3.1(3).</p>
83		Paragraph (1) of this rule provides that a party may apply for the comptroller to strike out a claim or statement of case, or

		<p>give summary judgment.</p> <p>Paragraph (2) is based on CPR r. 3.4(2).</p> <p>Paragraph (3) is based on CPR r. 24.2.</p>
84	89	<p>This rule concerns the hearing of matters in public. Paragraph (1) imposes a general requirement that all hearings should be in public.</p> <p>Paragraph (2) gives the parties a right to apply for a hearing to be held in private. There is no requirement that such an application need be in writing or made in advance of the hearing. So it will remain possible for the hearing officer to direct that the hearing, or part of it, is kept private if (for example) the matter is raised at or just before the hearing itself – provided paragraph (3) is complied with.</p> <p>Paragraph (3) sets out the conditions when the hearing should be held in private.</p> <p>Paragraph (4) provides a narrow exception, in that any hearing regarding an unpublished patent application is in private (in accordance with section 118(2)) and any hearing of an application to hear a matter in private is also private. Note that this would include a hearing on a PCT application before it enters the national phase (see section 89B(2)).</p> <p>Paragraph (6) reflects rule 89(3) of the 1995 Rules.</p>
85	89A inserted by SI 2005/2496	None (the rule is unchanged).
86	103(3) and (4)	<p>This rule reflects rule 103(3) and (4) of the 1995 Rules.</p> <p>The drafting has been updated but the effect (when taken in conjunction with rules 82 and 87) is meant to be the same.</p>
87	103(1), (2), (5) and (6) amended by SI 1999/3197	<p>This rule deals in general with the form of evidence before the comptroller.</p> <p>Paragraph (1) is based, in part, on rule 103(1) of the 1995 Rules. However, it is more liberal in that it allows any evidence that would be admissible before a court to be admitted. The effect of this paragraph, in conjunction with rule 82(2), is also to continue to allow cross-examination as provided for in rule 103(2) and (6) of the 1995 Rules.</p> <p>Paragraph (2) provides that a witness statement or a</p>

		<p>statement of case may only be given in evidence where it includes a statement of truth.</p> <p>Paragraph (3) makes it clear that the general rule is that evidence will be given by witness statement. This is based on CPR r. 32.6(1).</p> <p>Paragraph (4) requires certain formal requirements to be satisfied in relation to witness statements, etc (unless the comptroller otherwise directs – for example if the evidence is filed electronically). See rule 21 of the 1995 Rules.</p> <p>Paragraph (5) is based on CPR r. 22.1. Sub-paragraph (a) is based on CPR 22.1(4)(b) and sub-paragraph (b) on CPR 22.1(6).</p> <p>Paragraph (6) is based on CPR r. 32.4(1).</p>
88	108	<p>This rule allows any application to be made to hear any proceedings in Scotland, and not just those listed in section 123(2)(f). Once the application has been lodged it shall be conducted as normal proceedings under Part 7.</p> <p>Paragraph (3) replaces rule 108(6) of the 1995 Rules.</p>
89	62 (in so far as the rule applies to applications made by a person other than the proprietor)	<p>This rule sets up a slightly modified procedure for starting proceedings under section 46(3)(a) or (b) in relation to a licence of right, where the application is made by a person other than the proprietor. There is an extra, initial stage in which the third party files a Form 2 and the draft licence that he proposes should be granted. If the proprietor does not accept this, he must file a statement and then proceedings continue under Part 7 as if the proprietor were the claimant and the applicant for the licence were the defendant.</p> <p>Proceedings under section 46(3)(a) or (b) where the application is made by the proprietor are swept up in the general Part 7 procedure and so those parts of rule 62 of the 1995 Rules which apply to such applications have not been replicated.</p>
90	9 and 57 r 9 was substituted by SI 2004/3205	<p>Paragraph (1) replaces rule 9 of the 1995 Rules.</p> <p>Paragraph (2) replaces rule 57 of the 1995 Rules.</p> <p>For simplicity, a period of two months now applies in all cases.</p>
91	59(2)	Paragraph (1) replaces rule 59(2) of the 1995 Rules .

		<p>Paragraph (2) replaces the proviso to rule 59(2) of the 1995 Rules.</p> <p>The rest of rule 59 of the 1995 Rules is swept up in the general Part 7 provisions.</p>
PART 8 - OPINIONS		
92	77A	This provision replicates rule 77A of the 1995 Rules . However, the phrase “patent” has been replaced with “patent in suit” to avoid using a word which is defined differently in the 1977 Act; similarly “proceedings” has been replaced with “relevant proceedings”.
93	77B	No changes (except those set out in relation to rule 92)
94	77D	No changes (except those set out in relation to rule 92)
95	77E	No changes (except those set out in relation to rule 92)
96	77F	No changes, except a redefinition of the 2 week time period (for consistency throughout the Rules), and those set out in relation to rule 92.
97	77G	No changes (except those set out in relation to rule 92)
98	77H	No changes (except those set out in relation to rule 92)
99	77I	<p>New paragraphs (6) and (7) make clear which of the general provisions on proceedings in Part 7 apply to review proceedings. Doing this makes rule 77I(6) of the 1995 Rules redundant.</p> <p>Other than that, the only change is that set out in relation to rule 92.</p>
100	77J and 77K	This rule merges rules 77J and 77K of the 1995 Rules . Other than that, the only change is that set out in relation to rule 92.
PART 9 - MISCELLANEOUS		
101	90	<p>Paragraph (1) replaces rule 90(1) of the 1995 Rules (the drafting of the provision, however, is based on section 82 of the Trade Marks Act 1994).</p> <p>Paragraph (2) replaces rule 90(2) of the 1995 Rules. However, the new provision distinguishes between the</p>

		<p>appointment of an agent at the start of proceedings as opposed to later on, whereas the old provision distinguished between appointment of an agent for the first time as opposed to substitution of an agent.</p> <p>Paragraph (3) is a new requirement. It is based on rule 52(1) of the Trade Marks Rules 2000.</p>
102	109	Rule 109 of the 1995 Rules has been split into two paragraphs and altered very slightly. However, the effect is the same.
103	30 substituted by: SI 2006/760.	The only change is that the address for service is now consistently “furnished” rather than “filed” or “provided”.
104	30A inserted by: SI 2006/760.	Once more “furnished” replaces “filed” and “provided”. A minor inconsistency of wording has been corrected in rule 104(4)(b).
105	91	<p>Paragraph (1) replaces most of rule 91(1) of the 1995 Rules. However, Patents Form 11/77 has been abolished and therefore the request for a correction can be made in writing.</p> <p>Paragraph (2) reflects the words after the semi-colon in rule 91(1) of the 1995 Rules.</p> <p>Paragraph (3) replaces rule 91(2) of the 1995 Rules.</p> <p>Paragraph (4) is new and it permits a correction to the specification to be made where the error was caused by the conversion from one electronic format to another.</p> <p>Paragraph (5) is intended to permit the comptroller to waive the requirement to advertise a correction where nobody could object. This reflects the effect of rule 91(3) of the 1995 Rules.</p> <p>Paragraph (6) replaces rule 91(3A) of the 1995 Rules.</p> <p>Paragraph (7) makes it clear that a correction of a name or address is dealt with under rule 49. This is the same approach (in respect of addresses) as that in the 1995 Rules.</p> <p>The remaining provisions of rule 91 of the 1995 Rules are swept up in Part 7.</p>
106	r 102 of the	Paragraph (1) gives a person a right to apply to the

	<p>1995 Rules</p> <p>rule 6 of the 1997 SPC Rules</p>	<p>comptroller to remit a fee. There is no longer a requirement to apply in writing.</p> <p>Paragraph (2) replaces rule 102(1)(a) and (b) of the 1995 Rules.</p> <p>Paragraph (3) is new and it enables the comptroller to remit all or some of the fee where a person makes a request, but then withdraws that request before any work is carried out.</p> <p>Paragraph (4) replaces rule 102(1A) of the 1995 Rules.</p> <p>Paragraphs (5), (6) and (8) replace rule 6 of the 1997 SPC Rules.</p> <p>Paragraph (7) replaces rule 102(3) of the 1995 Rules, but is redrafted to more closely follow the wording of section 97(1).</p>
107	100	<p>Paragraph (1) replaces rule 100(1) of the 1995 Rules. However it is limited only to correcting irregularities of procedure (to be in accord with section 123(2)(b)). Where the correction of a document does not amount to the correction of an irregularity, that correction will be effected under section 117.</p> <p>Paragraph (2) replaces the last few words of rule 100(1) of the 1995 Rules, but is drafted to be consistent with other provisions in the Rules.</p> <p>Paragraph (3) replaces rule 100(2) of the 1995 Rules. The approach adopted means that any extension of time which is allowed after such a default will be effected under rule 108 where possible. Where a time limit is listed in Parts 1 to 3 of Schedule 4 (and so cannot always be extended under rule 108) it can, where the Patent Office (the comptroller or an examiner) has been in default, be extended under this rule.</p> <p>It should be noted that rule 101 of the 1995 Rules is not reproduced. Our view is that this rule is rendered impotent by the rule of statutory construction that a general provision shall not over-ride a specific one of different effect.</p>
108	110	<p>This rule represents rule 110 of the 1995 Rules.</p> <p>Paragraph (1) replaces rule 110(1) of the 1995 Rules.</p> <p>Paragraph (2) replaces rule 110(3) of the 1995 Rules.</p> <p>Paragraph (3) replaces rule 110(4) of the 1995 Rules.</p>

		<p>Paragraph (4) replaces rule 110(7) of the 1995 Rules. However, a request to extend multiple time limits on a single form may now only be made where they all relate to the same patent or patent application.</p> <p>Paragraph (5) replaces rule 110(8) of the 1995 Rules.</p> <p>Paragraph (6) replaces rule 110(9) of the 1995 Rules.</p> <p>Paragraph (7) replaces rule 110(10) of the 1995 Rules.</p> <p>Rule 110(2) of the 1995 Rules has not been maintained. Instead all time periods in proceedings before the comptroller are specified (under Part 7) and so may be extended or shortened under rule 81. The only time period outside of Part 7 which may be shortened by the comptroller is in rule 20.</p> <p>Rule 110(5) and (6) of the 1995 Rules have not been maintained as the requirement to file Form 53/77 has been abolished.</p> <p>The modified powers set out in Part 7 also mean that rule 110(11) of the 1995 Rules is no longer necessary.</p> <p>Finally, now that the rule only deals with extensions of periods of time (and not shortening of periods of time) references to “alteration” have been changed to “extension”.</p>
109	110A	The only change is that rule 110A(3) of the 1995 Rules has not been included. Therefore requests for further extensions under section 117B(4)(b) no longer need be in writing (although this may continue to be required in certain cases).
110	111 substituted by: SI 2006/760.	The reference to “under the Act or these Rules” has been modified as “under the Act” includes anything done “under the Rules” (as the Rules are made under the Act).
111	111A inserted by: SI 2006/760.	No changes. Note that rule 97 of the 1995 Rules is not replicated, following the recent amendments made to rules 111 and 111A of the 1995 Rules . This reflects the government’s conclusions following the “Consultation on the Liberalisation of Address for Service Requirements for Patents, Trade Marks and Registered Designs, and Consequential Changes to Postal Service Regulations”, held from October 2003 to January 2004. (The consultation and

		government’s conclusions remain available on the Patent Office website).
112	112A inserted by SI 2004/2358	This rule has been updated to refer to “copies available to the comptroller” rather than the more restrictive “copies kept at the Patent Office”. See comments in respect of rule 2(4)
113	113 (1) to (3) amended by SI 2004/2358	Paragraph (1) reflects most of rule 113(1) of the 1995 Rules . Paragraph (2) sets out the documents that do not require translations to be provided under this rule. This replaces the phrase “subject to” at the beginning of rule 113(1) of the 1995 Rules . It is thought that the new approach is much clearer for users. Paragraph (3) replaces rule 113(2) of the 1995 Rules . Paragraph (4) is new. It sets out explicitly the sanction that is applied where no translation is filed. Paragraphs (5) and (6) replace rule 113(3) of the 1995 Rules . They also refer to the new “International Preliminary Report on Patentability” and again include an explicit sanction for failure to file a translation of the relevant document.
114	113(4), (5) and (5A) amended by SI 2004/2358 and 2005/2496	Paragraph (1) and (2) replace rule 113(4) of the 1995 Rules . Paragraph (3) replaces rule 113(5) of the 1995 Rules . Paragraph (4) replaces rule 113(5A) of the 1995 Rules , although avoids the fiction of deeming opinion requests to be “proceedings” when they are not.
115	113A inserted by SI 2004/2358	No changes.
116	r 3(2) and r 5 of the 1997 SPC Rules	Paragraph (1)(a) states that an SPC is applied for on a Form SP1. It replaces rule 3(2) of the 1997 SPC Rules . Paragraph (1)(b) states that a paediatric extension to an SPC is applied for on a new Form SP4. The proposed fee that will accompany the form is £200. Paragraphs (2) to (9) replace rule 5 of the 1997 SPC Rules and so set out the regime and procedure for paying the SPC

		<p>fees. The drafting has been modernised and some more details are now contained in rule 6 of the draft Fees Rules, but no change in practice is intended.</p> <p>References to a “section 125B” may be seen in some paragraphs, and these arise for the following reason. The Patents (Supplementary Protection Certificate for Medicinal Products) Regulations 1992 (SI 1992/3091) and the Patents (Supplementary Protection Certificate for Plant Protection Products) Regulations (SI 1996/3120) are short instruments which apply the provisions of the Patents Act 1977 to SPCs (in a very non-specific way). We propose to replace these Regulations with a specific new provision within the Act itself (section 125B) which will state clearly which provisions in the Act apply to SPCs and which do not. It will also contain a few specific provisions in relation to SPCs, including to provide for the annual fee, and thus provide a clearer basis for the SPC provisions in the Rules. The draft section 125B will be made public once drafting has been completed.</p> <p>Rule 3(1) of the 1997 SPC Rules is thought unnecessary in light of the draft Fees Rules, and rule 4 of the 1997 SPC Rules is also not necessary, given that patent grant certificates have not been prescribed for a number of years. Rule 5(4)(b) of the 1997 SPC Rules is not replicated, since it is now thought that transitional provisions dealing with any fee changes should be set out in the relevant instrument, not in the body of generally-applicable Rules. Finally, rule 8 of the 1997 SPC Rules is not replicated, since any necessary notification can be done without authority from rules, and a period for reply can be specified.</p>
117	115	This rule represents rule 115 of the 1995 Rules , but minor drafting changes have been made.
118	116 amended by SI 1999/1092 and 2004/2177	This rule represents rule 116 of the 1995 Rules . but minor drafting changes have been made.
119	114	This rule represents rule 114 of the 1995 Rules with some minor drafting changes to better follow the wording of section 123(2)(1).
120	-	This provision gives effect to the index in Schedule 5.
121	-	This provision gives effect to the transitional provisions in Schedule 6 and the revocations in Schedule 7.

SCHEDULE 1 – BIOLOGICAL MATERIAL

1	<p>7 (Sch 2)</p> <p>Substituted by SI 2001/1412</p>	<p>Sub-paragraph (1) includes the two definitions in paragraph 7(1) of Schedule 2 to the 1995 Rules. The specific provisions of the Budapest treaty have been omitted. Further, two new definitions have been added: “expert” and “authorisation certificate”.</p> <p>Sub-paragraph (2) replaces the definition found in paragraph 7(2) of Schedule 2 to the 1995 Rules. However, the words “at all relevant times” has been removed to make the provisions relating to new deposits clearer. In addition, the words “whether generally or of a specific type” have been added.</p>
2	<p>1(1) (Sch 2)</p> <p>Substituted by SI 2001/1412</p>	<p>Sub-paragraph (1) replaces part of paragraph 1(1) of Schedule 2 to the 1995 Rules. The wording, however, has been amended to be more closely in accord with section 125A.</p> <p>Sub-paragraph (2) replaces the remainder of paragraph 1(1) of Schedule 2 to the 1995 Rules. Paragraph (b) copies out the operative parts of Article 13(1)(b) of the Biotechnology Patents Directive (Directive 98/44/EC) (“the Directive”).</p>
3	<p>1(2) to (4) (Sch 2)</p> <p>Substituted by SI 2001/1412</p>	<p>The first requirement is based on paragraph 1(2)(i) of Schedule 2 to the 1995 Rules.</p> <p>Paragraph (a) of sub-paragraph (2) (the second requirement) is based on paragraph 1(2)(ii) of Schedule 2 to the 1995 Rules. The wording has been changed to reflect the terminology in the Act, rather than that in Article 13(1)(a) of the Directive.</p> <p>Paragraph (b) of sub-paragraph (2) is based on paragraph 1(2)(iii) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (3) defines the “relevant period”, which replaces the timing provisions in paragraph 1(3) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (4) replaces paragraph 1(2)(b) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (5) includes two definitions. The first “accession number” was not included in the old rules, although the phrase was used. Its inclusion in these rules is to remove any possible ambiguity.</p>

		No provision equivalent to paragraph 1(4) of Schedule 2 to the 1995 Rules has been included because it must be assumed, by the act of depositing and applying for a patent, that the applicant consents to the biological material being made available.
4	2(1) to (3) (Sch 2) Substituted by SI 2001/1412	<p>Sub-paragraph (1) makes it clear that the paragraph only applies where access is not limited to experts.</p> <p>Sub-paragraphs (2) and (3) replace paragraph 2(1) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraphs (4) and (5) replace paragraph 2(2) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraphs (6) replaces paragraph 2(3) of Schedule 2 to the 1995 Rules.</p>
5	2(4) to (8) (Sch 2) Substituted by SI 2001/1412	<p>Sub-paragraph (1) replaces paragraph 2(4)(a) and (b) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (2) replaces paragraph 2(6) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (3) replaces the remainder of paragraph 2(4) of Schedule 2 to the 1995 Rules.</p> <p>Paragraph (a) of sub-paragraph (3) replaces paragraph 2(4)(i) of Schedule 2 to the 1995 Rules. It sets out that the undertaking ceases to have effect when an application is withdrawn or terminated. It makes it clear that it will continue to have effect if such an application is reinstated (under section 20A) or resuscitated (under section 117 and 117A).</p> <p>Paragraph (b) of sub-paragraph (3) makes it clear that the undertaking ends when the patent ceases to have effect. The wording at the end of paragraph 2(4)(ii) of Schedule 2 to the 1995 Rules is not necessary as this effect is more or less achieved by section 25(4). Further, Article 13(3) of the Directive suggests that the undertaking can only have effect when the “patent is in force”. Thus, if a patent lapses and is not renewed the undertaking should cease when it ceases to have effect and not six months later.</p> <p>Sub-paragraph (4) replaces paragraph 2(5) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (5) replaces paragraph 2(7) of Schedule 2 to the 1995 Rules.</p>

		Paragraph 2(8) of Schedule 2 to the 1995 Rules has not been replicated as it is not mentioned in the Directive.
6	3 (Sch 2) Substituted by SI 2001/1412	<p>The first condition reflects paragraph 3(1) of Schedule 2 to the 1995 Rules.</p> <p>The second condition reflects paragraph 3(3) of Schedule 2 to the 1995 Rules. The new provision does not include references to the specific provisions of the PCT. The new provision also avoids the “deeming” approach of the present one.</p> <p>Sub-paragraph (4) replaces paragraph 3(2)(a) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (5) replaces paragraph 3(2)(b) of Schedule 2 to the 1995 Rules.</p>
7	4 (Sch 2) Substituted by SI 2001/1412	<p>Paragraphs (1) and (2) replace paragraph 4(1)(a) of Schedule 2 to the 1995 Rules.</p> <p>Paragraph 4(1)(b) of Schedule 2 to the 1995 Rules is no longer necessary, by reason of paragraph 5(1) of Schedule 1.</p> <p>Paragraph (3) replaces paragraph 4(2) of Schedule 2 to the 1995 Rules.</p> <p>Paragraph (4) provides that the applicant may object to an expert inspecting the material within one month. The period is prescribed for consistency with other “opposition” periods (see rule 76) and so that it is not subject to an automatic two month extension under section 117B. It is, however, extendable at the comptroller’s discretion under rule 108(1).</p> <p>Paragraph (5) replaces paragraph 4(4) of Schedule 2 to the 1995 Rules. However, the provision is now more straightforward.</p> <p>Paragraph (6) replaces paragraph 4(3) of Schedule 2 to the 1995 Rules.</p>
8	5 (Sch 2) Substituted by SI 2001/1412	<p>This provision replaces paragraph 5 of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (1) sets out the scope of the provision.</p> <p>Sub-paragraph (2), which sets out the first circumstance, replaces paragraph 5(1)(a)(i) of Schedule 2 to the 1995 Rules.</p>

		<p>Sub-paragraph (3), which sets out the second circumstance, replaces paragraph 5(1)(a)(ii) and (b) of Schedule 2 to the 1995 Rules</p> <p>Sub-paragraph (4), which sets out the third circumstance, is based on the tailpiece of paragraph 5(1)(b) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (5) replaces paragraph 5(2) of Schedule 2 to the 1995 Rules. Paragraph (a)(ii) replaces paragraph 5(5) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (6) defines the relevant period. Where this period expires the patent may be revoked for inadequate disclosure. The three month period in paragraph (b) of sub-paragraph (6) is taken from paragraph 5(4) of Schedule 2 to the 1995 Rules.</p> <p>Sub-paragraph (7) replaces paragraph 5(3) of Schedule 2 to the 1995 Rules.</p>
SCHEDULE 2 – FORMAL AND OTHER REQUIREMENTS		
1	18(1) and 20(4)	Drawings are to be provided on A4 paper, rather than paper not exceeding 26.2cm x 17cm as in rule 18(1) of the 1995 Rules .
2	20(3)	This provision replaces rule 20(3) of the 1995 Rules . The requirement for the documents to be compatible with various methods of reproduction has been replaced by the simple requirement that they must be suitable for reproduction.
3	-	This replaces the references to frames and interlineations in rules 18(1) and 20(15) of the 1995 Rules .
4	-	This is a liberalisation of the first part of rule 20(10) of the 1995 Rules .
5	20(9)	This represents the first sentence of rule 20(9) of the 1995 Rules .
6	-	This provision is new. It is to ensure that where a sequence listing is set out at the end of the application it shall be numbered in a separate series.
7	20(9)	This represents the second sentence of rule 20(9) of the 1995 Rules .

8	20(6)	This replaces rule 20(6) of the 1995 Rules but the borders have been modified slightly. The requirement of rule 20(7) of the 1995 Rules , for margins to be completely blank, has not been reproduced.
9	20(5)	This represents rule 20(5) of the 1995 Rules . However, no mention is made of the method of binding the paper and the requirement for drawings is now in paragraph 14.
10	20(10)	This represents the middle part of rule 20(10) of the 1995 Rules .
11	20(10)	This represents the last part of rule 20(10) of the 1995 Rules .
12	18(1)	This represents the second part of rule 18(1) of the 1995 Rules . The borders have been changed slightly as well.
13	18(2)(g)	This represents the last sentence of rule 18(2)(g) of the 1995 Rules . The rest of this provision is unnecessary.
14	20(5)	This replaces rule 20(5) of the 1995 Rules insofar as it relates to drawings.
15	18(2)(j)	This replaces rule 18(2)(j) of the 1995 Rules .
16	18(2)(a)	This replaces and simplifies rule 18(2)(a) of the 1995 Rules .
17	18(2)(b)	This replaces rule 18(2)(b) of the 1995 Rules .
18	18(2)(c)	This replaces the last sentence of rule 18(2)(c) of the 1995 Rules .
19	18(2)(c)	This provision replaces the first part of rule 18(2)(c) of the 1995 Rules .
20	20(11)	This replaces the first sentence of rule 20(11) of the 1995 Rules .
21	18(2)(f)	This replaces the height requirement in rule 18(2)(f) of the 1995 Rules . The remaining requirements of that rule should be continued merely by good practice.
22	18(2)(h)	This replaces the first part of rule 18(2)(h) of the 1995 Rules .

23	20(11)	This replaces the last sentence in rule 20(11) of the 1995 Rules .
24	18(2)(h) and 20(14)	This replaces rule 20(14) of the 1995 Rules . It also replaces the effect of rule 18(2)(h) of the 1995 Rules .
25	20(12)	This replaces and simplifies the first part of rule 20(12) of the 1995 Rules .
26	20(12)	This replaces the last sentence of rule 20(12) of the 1995 Rules .
SCHEDULE 3 – PROCEEDINGS HEARD BEFORE THE COMPTROLLER		
Part 1		This sets out those applications and references that are proceedings carried out under Part 7 and are started by filing a Form 2 or Form SP3 (see rule 76(3)(a) and (b)).
Part 2		This sets out those oppositions that are proceedings carried out under Part 7 and are started by filing a Form 15 (see rule 76(3)(c)).
Part 3		This sets out those oppositions which are filed under Part 7, but are in response to proceedings that have already started under Part 7 at the time of the opposition (see rule 77(6)-(8)).
Part 4		This sets out those provisions in Part 7 which apply to any proceedings (whether <i>ex parte</i> or <i>inter partes</i>) heard before the comptroller (see rule 73).
Part 5		This sets out those further provisions in Part 7 which apply to proceedings for a review of an opinion (see rule 99).
SCHEDULE 4 – EXTENSION OF TIME LIMITS		
Part 1		<p>This represents Part 1 of Schedule 4A to the 1995 Rules. The changes made by Part 7 of the Rules means that the various time periods for opposition are rolled up into one provision: rule 76(2). However, there is now some flexibility over extension of the time period for opposition under section 27(5) and there are pending proceedings concerning validity elsewhere.</p> <p>As noted under rule 108, rule 110(2) of, and Part 2 of Schedule 4A to, the 1995 Rules are now redundant.</p>

Part 2		This represents Part 3 of Schedule 4A to the 1995 Rules.
Part 3		This represents Part 4 of Schedule 4A to the 1995 Rules.
SCHEDULE 5 – INDEX		
This Schedule includes the index of defined expressions.		
SCHEDULE 6 – TRANSITIONAL PROVISIONS		
1	-	None.
2	121(4)	This is a similar provision to that found in rule 121(4) of the 1995 Rules.
3	r. 20 P(A) Rules 2004	This provision replaces rule 20 of the Patent (Amendment) Rules 2004
4	-	This provision is intended to give effect to the Patents (Translation) Rules 2005 automatically. Therefore, when the London Agreement comes into force the requirements for translations of European Patents will cease.
5	-	This provision means that proceedings started under the 1995 Rules are grafted on to new Part 7.
6	r. 25 P(A) Rules 2005	This provision replaces rule 25 of the Patent (Amendment) Rules 2005
7	Par 6 Sch 2	This provision replaces paragraph 6 of Schedule 2 to the 1995 Rules (although it avoids relying on the old Rules' continued existence).
8	-	This provision caters for the changes made by the implementation of the Directive.
9	r. 124 PR 1978	This rule replaces part of rule 124 of the Patents Rules 1978.
10	r. 124 PR 1978	This rule replaces part of rule 124 of the Patents Rules 1978.

<i>Rule number in 1995 Rules</i>	<i>Corresponding provision in draft 2007 Rules</i>
1	1
2	2 and 3
3	2
4	4
4A	Not included
5	5
6	6
6A	7
6B	8
6C	9
7	Part 7
8	Part 7
9	90(1)
10	20
11	Part 7
12	Part 7
13	Part 7
14	10 and Part 7
15	10
15A	11
16	12
17	13(1)
18	14 and Parts 1, 3 and 4 of Schedule 2
19	15
20	14 and Parts 1, 2 and 4 of Schedule 2
21	78(5) and 87(4)

22	16
22A	17
23	18
24	19
25	22
26	21
27	26
28	23
28A	27
29	24
30	103
30A	104
31	25
32	27
33	28 and 29
34	30
35	31(7)
36	31
36A	32
37	33
38	34
39	36
39A	37
39B	38
39C	39
40	35 and Part 7
41	40
42	41

43	42
44	44
45	49
46	47
47	50
48	Not included
49	Not included
50	45
51	44
52	46 and 48
53(i)	Not included
53(ii)	35(6)
54	Part 7
55	Part 7
56	20
57	90
58	Part 7
59	Part 7 and 91
60	Part 7
61	43
62	Part 7 and 89
63	43
64	43 and Part 7
65	Part 7
66	Not included
67	Spent
68	Part 7
69	Part 7

70(1) to (3)(b)	Not included
70(3)(c), (d)	Part 7
71	Part 7
72	Part 7
73	Part 7
74	Part 7
75	Part 7
76	Not included
77(1)	Not included
77(2)	35(6)
77A	92
77B	93
77C	44
77D	94
77E	95
77F	96
77G	97
77H	98
77I	99
77J	100
77K	100
78	Part 7
79	Revoked
80	Not included
81	58
82	59
83	60
84	61

85	64, 66 to 72
86	62
87	63
88	80 and 82
89	84
89A	85
90	101
91	105
92	54
93	51
94	53
95	55
96	52
97	Not included
98	Revoked
99	Revoked
100	107
101	Not included
102	106
103	86 and 87
104	Not included
104A	87
105	Not included
106	82(1)(a)
107	Not included
108	88
109	102
110	108

110A	109
111	110
111A	111
112	Not included
112A	112
113	113 and 114
113A	115
114	119
115	117
116	118
117	65
118	65
119	65
120	Not included
121	Sch 6 and Sch 7
Sch 1	Revoked
Par 1, Sch 2	Par 2 and 3, Sch 1
Par 2, Sch 2	Par 4 and 5, Sch 1
Par 3, Sch 2	Par 6, Sch 1
Par 4, Sch 2	Par 7, Sch 1
Par 5, Sch 2	Par 8, Sch 1
Par 6, Sch 2	Par 7 and 8, Sch 6
Par 7, Sch 2	Par 1, Sch 1
Sch 3	Revoked
Par 1, Sch 4	56
Par 2, Sch 4	56
Par 3, Sch 4	56
Par 4, Sch 4	57

Pt 1, Sch 4A	Pt 1, Sch 4
Pt 2, Sch 4A	20(4) and 81
Pt 3, Sch 4A	Pt 2, Sch 4
Pt 4, Sch 4A	Pt 3, Sch 4
Sch 5	Spent
Sch 6	Spent
<i>Rule number in 1997 SPC Rules</i>	<i>Corresponding provision in draft 2007 Rules</i>
1, 2, 3(1)	Not included
3(2)	116(1)
4	Not included
5	116
6	106(5), (6), (8)
7	Part 7
8	Not included
9	4
10	44(7)
11, 12	Not included

ANNEX C

DRAFT REGULATORY IMPACT ASSESSMENT

Consultation on the draft Patents Rules 2007

1 Introduction

This Regulatory Impact Assessment (“RIA”) supports and is being issued with the consultation paper on the proposed modernisation and consolidation of the Patents Rules. The RIA is produced in accordance with Cabinet Office RIA Guidelines. Interested parties are asked to comment on the proposals and on the alternative options identified. The consultation paper, including the RIA, is available in paper form by contacting:

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2 Purpose and Intended Effect

2.1 The proposed new Rules package has the objectives of:

producing a set of Rules which includes all changes which have been made to the Patents Rules since they were previously revised and consolidated in 1995;

drafting the Rules in a clear, modern and consistent way throughout;

revising the rules about litigation to provide generic, flexible rules governing procedures and providing the Office with proper case-management powers – in particular to allow for effective operation of litigation in the Office which is in line with the Civil Procedure Rules;

removing some requirements for the filing of fees and forms, and simplifying and updating some requirements relating to formalities, sequence listings and divisional applications;

removing obscure and inconsistent rules relating to the Patent Co-operation Treaty (“PCT”);

amending the rules relating to certified copies to reflect current time scales and demand;

removing the provision for treating post sent in the UK as if it had been received when it would have been delivered in the ordinary course of post – rule 97. This is often referred to as the “postal deeming” provision;

allowing the Office to implement a Welsh language scheme and for patent applications to be filed and prosecuted in Welsh; and

producing a set of Rules which incorporates relevant provisions in respect of supplementary protection certificates, and which implements the Paediatric Medicine Regulation.

2.2 The proposed changes will cover the whole of the UK and also (with the exception of some of the provisions in respect of EC legislation) the Isle of Man.

3 Background

3.1 The Patent Rules were last comprehensively amended in 1995. Since then they have been significantly amended by the following Statutory Instruments:

The Patents (Amendment) Rules 1999 (SI 1999 No.1092)
The Patents and Trade Marks (World Trade Organisation) Regulations 1999 (SI 1999 No.1899)
The Patents (Amendment)(No.2) Rules 1999 (SI 1999 No.3197)
The Patents (Amendment) Rules 2001 (SI 2001 No.1412)
The Patents (Amendment) Rules 2002 (SI 2002 No.529)
The Patents (Electronic Communications) (Amendment) Rules 2003 (SI 2003 No. 513)
The Patents Act 2004 (Commencement No. 1 and Consequential and Transitional Provisions) Order 2004 (SI 2004 No. 2177)
The Patents (Amendment) Rules 2004 (SI 2004 No. 2358)
The Patents Act 2004 (Commencement No. 2 and Consequential, etc. and Transitional Provisions) Order 2004 (SI 2004 No. 3205)
The Patents (Amendment) Rules 2005 (SI 2005 No. 2496)
The Patents, Trade Marks and Designs (Address For Service and Time Limits, etc) Rules 2006 (SI 2006 No. 760).

3.2 These changes mean that the Rules as originally published are very different from those currently in force. Consequently, the Office has produced a variety of unofficial consolidations, the latest of which is available via our website at www.patent.gov.uk/patentrules1995.pdf

3.3 The 1995 Rules largely took the drafting style of previous Rules packages, and included some rules taken verbatim from the 1978 Rules, and a few taken from rules made under the Patents Act 1949. Each of the subsequent amendments has also been written in the drafting style prevalent at the time of writing. This means that there is now a wide range of styles in the Rules, as well as some inconsistencies. The proposed modernisation and consolidation will result in a clear, consistent set of rules written in the modern style. The basic approach taken to drafting is that:

the wording in the Act should not be repeated in the Rules;

each individual rule or paragraph is shorter, with generally only one concept per provision;

more detail, such as formalities requirements, lists of proceedings and time limits is placed in Schedules;

rules reflect current working practices such as e-filing, electronic case-files and internet availability of documents;

terms such as “without prejudice to”, “hereunder” and “aforementioned” are avoided unless necessary;

there is an index of defined terms;

forms have been renumbered to drop the “/77” part, as have other matters which flowed from the continued existence of rules covering 1949 Act cases e.g. Rule 67 and Form 58/77.

3.4 There are other substantive difficulties with the current Rules. The large number of rules relating to litigation (current rules 7-14, 40, 43, 54-60, 62, 64-66, 68-76, 78, 88, 89 and 91) go into great details about what must or must not be done in particular circumstances. The rules, while rigid and detailed, are not always consistent for all types of proceedings; they differ in details and in the extent to which they prescribe procedures or leave them to the comptroller’s discretion. These rigid requirements often cause unnecessary difficulties for applicants and the Office. The Rules are also largely silent on some matters – including case management, which is increasingly used to simplify and accelerate proceedings and reduce their cost.

3.5 We propose to replace the existing specific rules with a generic and flexible set, which will govern procedures and provide appropriate case management powers to the comptroller to assist in achieving the goal of achieving justice swiftly, at minimal cost, dealing with cases in ways proportionate to the circumstances, and with all parties on an equal footing. Many of the proposed rules are based on the Civil Procedure Rules. The Rules will be supplemented by Practice Directions or other official guidance setting out how the comptroller will manage cases under the Rules.

3.6 The proposals also include provisions to update some rules to reflect current circumstances such as the growth of e-business and levels of demand for Office services. For example, we propose to remove the requirement to file a form and fee when requesting an amendment or correction, or when a restoration or extension of time has been agreed. We also propose to remove the option of requesting rubber-stamped certified copies of documents because the demand for these has fallen and we will continue to offer uncertified or fully certified copies. Current rules require all documents making up a patent application to be in English, whereas the proposed Rules would allow applications to be filed and prosecuted in Welsh. Rules relating to international applications under the PCT are complicated and confusing. We propose to separate the complicated and (in parts) obscure rule 85 into separate provisions to make these easier to follow and to bring all the rules relating to such applications into a single part. These are the sort of changes which have previously been made piecemeal by individual Statutory Instruments.

3.7 These changes are set out in more detail in the Consultation Document available on the Patent Office’s website at:
www.patent.gov.uk/about/about-consult/about-formal/about-formal-current.htm

4 Rationale for Intervention

4.1 If we do nothing, the Rules will continue to evolve piecemeal. Based on the rate of change since the 1995 Rules were introduced, we would expect the Rules to be amended about once a year, with each amendment making it more difficult for users to identify which rule is in force and adding to the range of drafting styles.

4.2 Leaving the litigation rules unchanged would leave in place Rules which have worked adequately, but which continue to impose unnecessary, inconsistent and outdated restrictions on the Office and on parties to litigation. The number of patent applications which become subject to some form of litigation is very small, but the cases will be of great importance to those involved.

4.3 Failing to make changes such as those to formalities requirements will leave customers having to comply with outdated rules which are more complicated than they need to be. This would mean customers having to do more work than they would under the proposed changes. Similarly, leaving some PCT-related rules and those relating to time periods for divisional applications unamended would leave obscure and inconsistent provisions in place. The current Rules also require users to file a form and fee when requesting an amendment or correction, or when a restoration or extension of time has been agreed, but the proposed changes would remove these requirements.

4.4 The proposal to remove the postal deeming provision reflects its uncomfortable role in introducing a legal fiction – that some post was received earlier than it really was. Surveys indicate that while the provision requires Office resources to apply it, it is very seldom of any benefit to users, and most of those to whom it is applied are unaware of the fact. The abolition of the provision is also balanced out by the extension of the provisions for extending time limits which were introduced by the Patents, Trade Marks and Designs (Address For Service and Time Limits, etc) Rules 2006 (SI 2006 No. 760).

4.5 The modernisation and consolidation proposed addresses all the problems above, and will lead to a clear and consistent set of Rules and associated directions which allow flexibility where appropriate and which remove outdated, obscure and inconsistent provisions.

5 Consultation

5.1 An informal consultation “Modernisation and consolidation of the Patent Rules” was held from 14 October to 30 November 2005 (copy available on the Office’s website at www.patent.gov.uk/consult-patentrules.pdf). This included an overview of the proposed new rules structure, together with more detailed background on the proposed changes to the rules relating to patent litigation, and draft litigation rules. The informal consultation was held to test whether users broadly agreed with the structure of the proposed new rules, and to find out views on the more extensive changes proposed to the litigation rules.

5.2 Responses were limited to a few representative bodies and organisations. These represent the groups most likely to have highly developed procedures for dealing with patent applications, and hence those most likely to be significantly affected by changes to the content or structure of the Rules. Their responses were that they approved of the general thrust to modernise and consolidate and to modernise litigation rules in particular, but would wait to comment more fully once more detailed proposals were available.

5.3 A separate formal consultation was held from October 2003 to January 2004 about the proposal to abolish the postal deeming provision as part of the wider consultation “Consultation on the Liberalisation of Address for Service Requirements for Patents, Trade Marks and Registered Designs, and Consequential Changes to Postal Service Regulations”. In light of this (and thus the reasons set out in 9.4 and 9.5 below) we propose to abolish the postal deeming provision.

5.4 A public consultation on all the proposed changes to the Rules is taking place during early 2007. It contains an explanation of all the changes, including a detailed concordance between existing and proposed rules. It also contains the draft Statutory Instrument.

6 Options

Do nothing

6.1 The current Rules work acceptably for most applications and granted patents most of the time. However, as noted at 3.1 – 3.6 above, if we do nothing they will retain the following undesirable features:

- a variety of writing styles,
- users needing to check carefully to see what rules are currently in force,
- lengthy, unnecessarily complex and rigid litigation rules,
- no provision for accepting applications in Welsh,
- inconsistent and obscure provisions relating to the PCT and to time limits for divisional applications,
- formalities requirements which are unnecessarily complicated,
- a requirement to file forms and fees when requesting an amendment or correction, or when a restoration or extension of time has been agreed.

The first two of these problems will get more serious as time passes and as additional changes to the Rules lead to more drafting styles and an increasing difficulty in working out which of the 1995 Rules is still in force. For these reasons, and the others set out in this RIA, we believe that doing nothing is not in the best interests of the Office or its users.

Continue to make incremental changes

6.2 It would be possible to continue to make incremental changes to individual rules or groups of rules on the lines of the changes listed at 3.1 above. For example, one or more statutory instruments could be used to provide for applications in Welsh; to improve provisions relating to the PCT, divisional applications and formalities; and to remove the need to file a form and fee when requesting an amendment or correction or when an extension of time or a restoration has been agreed. However, making these desirable changes would increase the problems caused by different drafting styles and further widen the gap between the 1995 Rules as originally made and those which would be in force. Over time, there would come to be fewer and fewer of the 1995 Rules which were actually in force and so users would have to rely increasingly on unofficial consolidations or cross-referencing the 1995 Rules against all the subsequent changes. For these reasons we consider that continuing to make changes to individual rules or groups of rules will lead to increasing confusion and is not in the best interests of the Office or its users.

Modernisation and consolidation

6.3 This is our preferred option. It involves the most changes to the Rules, both to content and to presentation, but will result in a consistent set of Rules written in a consistent modern style and including all the substantive amendments which are currently desirable. These proposed consolidated Rules would almost inevitably themselves be amended in future but the impact of any such changes will be clearer as they would be made to consolidated Rules rather than to the 1995 Rules as already amended on multiple occasions. In any case, we would hope that

amendments to the new consolidation would not be necessary for some considerable time.

6.4 The proposed new structure of the Rules is:

Part 1: Introductory – setting out definitions and any matters of interpretation

Part 2: Applications for patents – containing rules which govern the procedure for making and prosecuting a patent application, including rules on claiming priority, formal requirements, missing parts, search and examination, amendment before grant, reinstatement and other related matters. It will not contain rules on pre-grant entitlement or inventorship disputes. As a rough guide, most of this material is currently in rules 5 to 6C and 15 to 37.

Part 3: Granted patents – containing rules which govern post-grant non-contentious matters. Rules on post-grant amendment (but not opposition), renewal fees and restoration, and surrender will appear here. This largely corresponds to current rules 38 to 43.

Part 4: The Register and other information – containing rules which apply to the Register of patents, including inspection and correction. At present, these are in rules 44 to 53. It will also contain rules regarding access to information generally – such as the rules on caveat requests, inspection of documents, confidentiality requests and bibliographic information. These matters are currently set out in rules 92 to 96.

Part 5: European patents (UK) – containing rules which relate to the translation of European patents (UK) and the conversion of applications for a European patent (UK). It will therefore cover what is currently in rules 80 to 84, 86 and 87 and some of Schedule 4.

Part 6: International applications – containing rules relating to international applications in the national phase (currently rule 85) and to the Office's role as a receiving office (currently rules 117 to 120).

Part 7: Proceedings heard before the comptroller – containing a new set of generic rules which relate to proceedings before the comptroller in respect of patents and supplementary protection certificates.

Part 8: Patent Office opinions – containing the rules introduced on 1 October 2005 to regulate the new procedures, under section 74A of the 1977 Act, in relation to non-binding opinions on patent validity and infringement.

Part 9: Miscellaneous – sweeping up miscellaneous rules, including those dealing with address for service, making corrections, remission of fees, extensions of time limits, interrupted days, official publications, supplementary protection certificates, and other matters.

Schedules – containing detailed provisions on biological material deposits and the alteration of time limits. We also propose two new Schedules, one concerning the details of formal requirements that apply to a patent application or European translation, and another setting out the different classes of proceedings before the comptroller under Part 7 of the Rules. Transitional provisions and repeals will also be contained in a Schedule.

Costs and Benefits

7 Sectors and groups affected

7.1 Individuals or organisations of any size, in any part of the UK or beyond, and in any area of economic activity (including not-for-profit organisations) may apply for a patent or become parties to patent litigation. We believe that a consolidated and modern set of rules will benefit all such patent users.

7.2 As an indication of the numbers affected by the proposed changes, the number of patent applications received by the Patent Office is around 28,000 annually. Around 13,000 of these are published, and 8-9,000 patents are granted as a result. The Office also expects to receive some 4,000 PCT applications during 2006/2007. The numbers of cases which are involved in litigation is very small in comparison, probably fewer than 2,000 a year in relation to matters including ownership, licences, revocation, amendments, restoration, surrender or declaration of non-infringement. Nevertheless, as noted above, anyone involved in patent litigation is no doubt involved in a matter which is of significant importance to them or their business.

7.3 Introducing provisions to allow applications to be made and prosecuted in Welsh would be most likely to benefit those primarily Welsh-speaking individuals or organisations based in Wales.

8 Benefits

8.1 A modernised and consolidated Rules will provide a clear statement of the rules currently in effect, avoiding the need to cross-reference the 1995 Rules against subsequent amendments. A clear and consistent drafting style will also make for easier understanding of what is intended.

8.2 Changes to the litigation rules will remove unnecessary procedures which cause users and the Office additional work and delay the decision making process. Generic provisions, supported by Practice Directions or other guidance setting out case management practices, will provide greater flexibility and consistency, leading to simpler procedures and improved access to justice. As noted above, the number of such cases is probably fewer than 2,000 a year, but the proposed changes should have a significant impact on those that do end up in litigation at the Office.

8.3 Specific changes to the Rules are intended to remove unnecessary procedures, such as the filing of certain forms (with fees). For example, users requesting an amendment or correction will benefit from no longer having to file a Form 11/77 and £40 fee. Similarly, those whose application for restoration or for an extension of time has been agreed, will no longer have to file a Form 53/77 and £135 fee. We expect about 700 users a year to benefit from the abolition of the Form 11/77 and some 250 a year to benefit from the abolition of the Form 53/77. Other users will benefit from not having to supply a document if it is available to the Office already, including available over the internet.

8.4 The proposed new rules would encourage the electronic filing of sequence listings (for amino acid and gene sequences) while retaining the option of paper listing for those for whom e-filing is not reasonably possible. This is likely to be of significant benefit to those (admittedly fairly small number of) users involved in drafting and prosecuting patent applications which involve sequence listings, and will

also be of benefit to the Office in increasing efficiency (the e-filed sequence listings being machine readable).

8.5 Users will be able file and prosecute applications in Welsh. It will not be necessary for users to provide translations of documents originally filed in Welsh. Some users may therefore avoid the costs of translating documents from Welsh to English to allow them to be filed. We do not know what, if any, use will be made of this option.

9 Costs

9.1 Most of the costs associated with the proposed changes would appear to arise because patent attorneys and others familiar with the existing Rules will need to become acquainted with the changes, and accustomed to the renumbering of individual rules. This will be a more substantial change than if we continued to introduce changes to individual rules on a piecemeal basis. However, as noted above, the informal consultation received a positive response from the patent attorneys and groups representing regular users, who recognised the value of a comprehensive redrafting. The Office will issue guidance explaining the changes, and has been liaising with the Chartered Institute of Patent Attorneys (CIPA), so that the new Rules feature in a timely fashion in their comprehensive textbook on patent law and practice "The CIPA Guide to the Patents Acts".

9.2 Users requesting certified copies of documents will no longer have the option of a rubber stamped copy. The current provision is for uncertified copies at £5, rubber stamped at £16 and sealed certified copies at £22, all available by filing a Form 23/77. Use of the stamped copies is very low, with some 200 provided in 2005/6, compared with 18,400 sealed copies and some 1,900 uncertified copies.

9.3 E-filed sequence listings will have to conform to World Intellectual Property Organisation (WIPO) standard ST.25 ("Standard For The Presentation Of Nucleotide And Amino Acid Sequence Listings In International Patent Applications Under The PCT" - www.wipo.int/scit/en/standards/pdf/03-25-01.pdf) and so there may be a cost in presenting sequence listings in this format. However, the software to allow this will be freely available from the Office's website and will benefit users by providing a uniform and easily readable standard both for those filing applications and those wishing to view sequences filed by others.

9.4 The abolition of rule 97 (the postal deeming rule) might mean that applicants were accorded later filing dates than with the provision intact. This might mean that an application was given a later filing date than another application for the same invention or, more likely, that a time limit was missed. However, as set out in paragraphs 13 to 16 of the "Proposal to Liberalise Address for Service Requirements for Patents, Trade Marks and Registered Designs, and Consequential Changes to Postal Service Regulations - The Government's Conclusions" the evidence is that rule 97 only made a difference to 1 of the 466 documents to which it was applied in the three weeks surveyed. In this one case, postal deeming meant that a time limit was met which would have been missed if the actual date of receipt had been used as the filing date. But in that case, the time limit which would otherwise have been missed would have been subject to an as-of-right extension on completion of Form 52/77 and payment of the £135 fee. It would also have been open to the applicant to request that the time limit be extended under rule 111(6).

9.5 In short, while postal deeming imposes an administrative burden on the Office, which has to check each first class envelope received for any documents

which might be subject to postal deeming, and compare date of receipt and post mark where this is legible, it was of known benefit to only one applicant or proprietor in the weeks surveyed, and that proprietor had other means of meeting the time limit. We have no evidence that rule 97 has ever resulted in an application being given an earlier filing date than another application for the same invention. Finally, the provisions which provide remedies for delays in means of communication with the Office have been further extended since that survey was done – by the Patents, Trade Marks and Designs (Address For Service and Time Limits, etc) Rules 2006 (SI 2006 No. 760).

10 Small firms impact test

10.1 The Office does not have information from users on the size of organisation they belong to. However, it is able to identify patent applicants or proprietors who are not represented by an agent of any kind and refers to these as private applicants (“PAs”). While any size or type of organisation may be unrepresented, we believe that most PAs are SMEs or individuals working alone. Conversely, many SMEs or private individuals may employ agents and so fall outside our PA category. Nonetheless, information about PAs is the best approximation we have to SMEs.

10.2 Our figures suggest that about a quarter of patent applications are filed by PAs, but only about 10% of search requests are from PAs. PA cases are proportionately less likely than others to be pursued to grant, and to be renewed after grant. Consequently, PAs are proportionately less likely to be affected by either costs or benefits of the proposed changes.

10.3 As noted above, we believe that most of the costs arising from the proposed changes will fall on patent attorneys and experienced users of the patent system. While some SMEs are regular users of the patent system, they and PAs are less likely to have established a developed understanding of patent procedures, and so will not need to expend effort understanding many of the more detailed or technical changes. In any case, the Office provides extra help and guidance to PAs (including a dedicated support unit and a central enquiry unit), and takes particular care to explain the legal requirements and procedures involved in obtaining patent protection. This will of course continue to apply to the procedures under the proposed Rules.

10.4 We have no evidence that previous redrafts or amendments to the Rules have caused any increase in agents’ fees. Thus SMEs who do choose to use a patent attorney or other agent are not likely to be affected in this way.

10.5 Overall, we conclude that the proposals will not have any significant adverse impact on SMEs. Indeed, SMEs will benefit along with other users from rules which are up-to-date and easier to understand, and from improved litigation procedures and other changes proposed to specific rules.

11 Competition Assessment

11.1 Patents may be applied for or owned by any individual or by any organisation of any size, based in the UK or abroad, and in any economic sector or market. The same applies to those who are not patent applicants or owners but who become involved in legal proceedings concerning patents.

11.2 We believe that no firm has more than 10% market share in the broad market for intellectual property rights and no three firms together have 50% of the market share.

11.3 The proposed changes will affect firms which file large numbers of applications for patents, or maintain those rights when they have been granted, more than organisations which do not. However, the proposals are intended to update and simplify the Patents Rules and so we do not believe that they affect some firms substantially more than others.

11.4 There is no evidence that the proposals would affect market structures, or change the number or size of firms.

11.5 The proposed rules changes would apply equally to new or established firms, and so there would not be higher set-up or ongoing costs for new or potential firms that existing firms did not have to meet.

11.6 Intellectual property rights are all concerned with innovation, so there will be some sectors affected which are characterised by rapid technological change. However, the proposals do not affect the nature or scope of any of those rights.

11.7 The proposals will not in any way restrict the ability of firms to choose the price, quality, range or location of their products. The nature and extent of patent rights will remain exactly the same under the proposals as under the existing regime.

12 Enforcement, sanctions and monitoring

12.1 Nobody has to apply for any form of intellectual property and so the proposals will not be enforced. Applicants who wish to obtain patents or to maintain their rights once granted will have to comply with the new Rules as they would with the current Rules, and in many cases the requirements are either reduced or are the same but more clearly worded. The only sanction is that if applicants or proprietors do not comply with the Rules, then their applications will not be processed or their granted rights will cease. Monitoring compliance will be on a case-by-case basis, ensuring that the Rules are complied with as they apply to the individual case. The proposals do not change any existing enforcement, sanctions or monitoring regimes.

12.2 The Office will assess the effects of the proposals. There are well established mechanisms for customers to comment about any aspect of Office services (including a feedback form at www.patent.gov.uk/about/about-ourperform/about-quality.htm and a dedicated e-mail account at customer.feedback@patent.gov.uk) which will remain in place. Feedback of all types is regularly collated and checked to ensure that individual complaints are dealt with and any underlying problems are identified and addressed. The Office recognises that external circumstances will change and that there will almost inevitably be further changes to the Rules in the future to meet or anticipate such changes.

Declaration and publication

I have read the Regulatory Impact Assessment and I am satisfied that the benefits justify the costs

Signed

Date

[Minister's name, title, department]

Contact point for enquiries and comments:

James Porter
The Patent Office
Concept House
Cardiff Road
Newport NP10 8QQ

Tel: 01633 814521

E-mail:

ANNEX D

DRAFT PATENTS (FEES) RULES 2007

STATUTORY INSTRUMENTS

2007 No.

PATENTS

The Patents (Fees) Rules 2007

<i>Made</i> - - - -	***
<i>Laid before Parliament</i>	***
<i>Coming into force</i> - -	***

The Secretary of State makes the following Rules in exercise of the powers conferred upon him by section 123 of the Patents Act 1977(a).

In accordance with article 7 of the Department of Trade and Industry (Fees) Order 1988(b), he has taken into account the functions and matters specified in Part 4 of Schedule 1 and Parts 1 and 2 of Schedule 2 to that Order.

Citation, commencement and interpretation

1.—(1) These Rules may be cited as the Patents (Fees) Rules 2007 and they shall come into force on [].

(2) In these Rules—

- (a) “the Act” means the Patents Act 1977 and references to a section are references to a section of the Act; and
- (b) “2007 Rules” means the Patents Rules 2007(c).

Use of a form

2.—(1) Except where any of rules 3 to 7 apply, the fees to be paid in respect of any matters arising under the Act are those specified in Schedule 1.

(2) Where a form—

- (a) is required to be used by the 2007 Rules; and
- (b) is specified in Schedule 1 as the corresponding form in relation to any matter,

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

(a) 1977 c. 37.

(b) SI 1988/93, amended by SI 1990/1473, which were made under section 102 of the Finance (No 2) Act 1987 (c. 51).

(c) SI 2007/[].

(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.

Application fee and the fee to begin the national phase

3.—(1) The application fee is—

- (a) in respect of an international application for a patent (UK), £0;
- (b) in respect of any other application (including an application treated as an application under the Act following a direction under section 81), £30.

(2) The prescribed fee to begin the national phase of an international application for a patent (UK) is £30.

Renewal fees

4.—(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 table in Part 1 of Schedule 2 is the amount specified in relation to that anniversary in the second column.

(2) Where [rule 37(3)] of the 2007 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 37(4)] of the 2007 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.

Additional fees for late renewal

5.—(1) The additional fees prescribed for late payment under section 25(4) of the Act are specified in Part 2 of Schedule 2.

(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.

Supplementary protection certificates

6.—(1) — The prescribed fee payable for a supplementary protection certificate to take effect is set in accordance with paragraph (2).

(2) Where the certificate expires during the period of 1 year beginning with —

- (a) the start date, the fee is £600;
- (b) the first anniversary of the start date, the fee is £1,300;
- (c) the second anniversary of the start date, the fee is £2,100;
- (d) the third anniversary of the start date, the fee is £3,000; or
- (e) the fourth anniversary of the start date, the fee is £4,000.

(3) The period in paragraph (2) shall be calculated without reference to any extension of the duration of a supplementary protection certificate under Article 13(3) of the Medicinal Regulation.

(4) The additional fee prescribed for the purposes of section 125B(5) shall be half the prescribed fee.

(5) The start date is the first day following the day on which the basic patent expires.

Other fees

7.—(1) The prescribed fee to publish a translation filed at the Patent Office under section 89A(3) or (5) is £12;

(2) The prescribed fee for an application to the comptroller for an order under the Evidence (Proceedings in Other Jurisdictions) Act 1975(a) as applied by section 92(1) is £0.

(3) The fee to transmit an international application for a patent filed at the Patent Office to the International Bureau and the International Searching Authority is £55.

(4) In paragraph (3), “International Searching Authority” has the same meaning as in the Patent Co-operation Treaty.

Address
Date

Name
Parliamentary Under Secretary of State
Department

(a) 1975 c. 34.

SCHEDULE 1

rule 2

USE OF FORMS

<i>Patents Form Number</i>	<i>Item</i>	<i>Amount (£)</i>
1	On request for the grant of a patent	—
2	On starting proceedings in relation to applications, references or requests under the provisions mentioned in Part 1 of Schedule 3 to the 2007 Rules (except those started on Form SP3)	50
	On applying for the review of an opinion	50
3	On making a declaration for the purposes of section 5(2), in relation to an earlier relevant application filed during the period allowed by section 5(2A)(a)	40
	On request for permission to make a late declaration of priority under section 5(2B)	150
7	Statement identifying the inventor and of right to the grant of a patent	—
8	On request for a certificate authorising the release of a sample of biological material	—
8A	On request that a sample of the biological material should only be made available to an expert	—
9	On request for a further search under section 17(6) or payment for a supplementary search under section 17(8) (in relation to applications initiated before 1st January 2005)	100
9A	On request for a search under section 17(1)	
	(a) in respect of an international application for a patent (UK), which has already been the subject of a search by the International Search Authority;	80
	(b) in respect of any other application.	100
	On request for a further search under section 17(6) or payment for a supplementary search under section 17(8)	100
10	On request for a substantive examination of an application	70
12	(See Schedule 2)	

14	On request under section 20A for reinstatement of an application	150
15	On giving notice of opposition under the provisions mentioned in Part 2 of Schedule 3 to the 2007 Rules	50
16	On application under section 28 for restoration of a patent	135
17	On request for an opinion under section 74A	200
20	On request to correct a name under rule [49] of the 2007 Rules	—
21	On application to register (or to give notice of) any transaction, instrument or event mentioned in section 33(3)	—
23	On application for a certified copy of an entry in the register, or a certified extract from the register, or of a relevant document	20
	On application for an uncertified copy of an entry in the register, or an uncertified extract from the register, or of a relevant document	5
	On request for a certified copy of an international application filed at the Patent Office as the competent receiving Office	20
	On application for a certificate under rule [46(3)] of the 2007 Rules	20
28	On application under section 46(1) for an entry to be made on the register that a licence is available as of right	—
30	On application under section 47(1) for the cancellation of an entry made under section 46	—
49	On request to be notified of a relevant event under rule [54] of the 2007 Rules	25
51	On appointment of an agent	—
52	On request for extension of a period of time under [rule 108(2) and (3)] of the 2007 Rules	135
54	On filing a translation of the specification of a European patent (UK)	—
	On filing a translation of the claims of the specification of an application for a European patent (UK)	—
	On filing a corrected translation under section 80(3)	—
SP1	On application for a supplementary protection certificate under Article 8 of the Medicinal or Plant Protection Regulations	250
SP2	(see rule 6)	

SP3	On application to review lapse or for a declaration of invalidity under Articles 14 or 15 of the Medicinal or Plant Protection Regulations or for revocation of an extension of the duration of a supplementary protection certificate under Article 15a of the Medicinal Regulation	50
SP4	On application for an extension of the duration of a supplementary protection certificate under Article 8 of the Medicinal Regulation	200

SCHEDULE 2

rules 4 and 5

RENEWAL FEES

PART 1

RENEWAL FEE

<i>Anniversary of date of filing</i>	<i>Amount (£)</i>
4th	50
5th	70
6th	90
7th	110
8th	130
9th	150
10th	170
11th	190
12th	210
13th	230
14th	250
15th	270
16th	300
17th	330
18th	360
19th	400

PART 2

ADDITIONAL FEE

<i>Month beginning after the expiry of the period for payment of the renewal fee</i>	<i>Amount of additional renewal fee (£)</i>
1st	0
2nd	24
3rd	48
4th	72
5th	96
6th	120

ANNEX E

CONSULTATION CODE OF PRACTICE

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.

Comments about the consultation process

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

Maria Ciavatta
The Patent Office
Concept House
Cardiff Road
Newport NP10 8QQ

Tel: 01633 814796
Fax: 01633 814509
E-mail: consultation@patent.gov.uk

ANNEX F

WHERE COPIES OF THIS CONSULTATION HAVE BEEN SENT

Agricultural Engineers Association
Alliance against IP theft
Allvoice
Anti Copying In Design
Anti-Counterfeiting Group
Arnander Irvine & Zietman
Ashurst Morris Crisp
Association for University Research & Industry Links
Association of British Insurers
Association of the British Pharmaceutical Industry
Babcock International Ltd
Baker & McKenzie
Bar Council
Beresford & Co
Berwin Leighton
Bharat Electronics Ltd
Biotechnology and BSRC
Boulton Wade Tennant
BPI
BPP Leeds IP Group
Bristows
British Association of Picture Libraries and Agencies
British Brands Group
British Generics Manufacturers Association Ltd
British Library
British Pharmaceutical Group Ltd
British Poultry & Meat Federation
British Retail Consortium
Cardiff Law School
Chartered Institute of Patent Attorneys
Chemical Industries Association
CIMMYT
Competition Law Association
Confederation of British Industry
Consumer Electronics Association
Consumers' Association Ltd
Cranfield University
Crop Protection Association
Davenport Lyons
Deloitte & Touche
Department of Trade and Industry
Educational Recording Agency
Eureka Manufacturing Co. Ltd
Europe Analytica
Federation of the Electronics Industry
FICPI
Frank B Dehn
Freshfields
Gallafent & Co
Gibbs Technologies Limited
Gill Jennings & Every
GlaxoSmithKline
Gowers Review Team
Greenpeace
Harbottle & Lewis
Howrey Simon Arnold & White
Incorporated Society of British Advertisers
Institute of Trademark Attorneys
Intellectual Property Law Advisors
International Chambers of Commerce
Inventorslink Inc
Jones Day
Lancaster University
LES Britain & Ireland – EC Laws Committee
Linklaters & Paines
Lodestar Translations
Lovells
Magister Ltd
Marketforce Communications
Marks & Clerk
Mewburn Ellis
Microsoft Ltd
Milbank Tweed Hadley & McCloy
Ministry of Defence
Mishcon de Reya
Norton Rose
Office of Government Commerce
Olswang
Pfizer Limited
Pillsbury Winthrop Shaw Pittman
PJB Publications
Practical Law Company
Preventative Medicines Tech Inc.
Queen Mary IP Research Institute
RWS Group
S. J. Berwin LLP
Sagittarius Intellectual Property Consultants Ltd
SCRIPT
SIBLE University of Sheffield
Simmons & Simmons
State Patent Bureau of the Republic of Lithuania
Tarlo Lyons
Taylor & Meyer
The Law Society
The Law Society of Scotland
The Patent Judges
Thompsons Solicitors
Trade Marks Patents and Designs Federation
Treasury Solicitors
University of Alicante
University of Cambridge
University of Hull
University of London Queen Mary & Westfield College
University of Oxford
University of Plymouth
University of Reading
University of Strathclyde
Urquhart-Dykes & Lord
Vereenigde
Visteon Global Technologies
Wedlake Bell
Wyatt & Wang Ltd