

## CHAPTER 4

### DESCRIPTION, CLAIMS & ABSTRACT

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## **Introduction**

- 4.01 The description, claims and abstract comprise the statutory part of the patent specification (drawings form an optional part). It is the responsibility of the Formalities Examiner to ensure that the description, claims and abstract meet the formal requirements as defined by Rule14 and Schedule 2 parts 1, 2 and 4 of the Patent Rules 2007(see Annex 4D).

## **Agent Cases - Non PCT Applications**

- 4.02 On receipt of the Application Fee, the Formalities Examiner should undertake the Preliminary Examination. The Application Fee may be paid at the same time as the application is filed, if this is the case the fee will be placed on the F1. Alternatively, the fee may be filed with the request for search and the fee will then be placed on the F9A. The Formalities Examiner should check both F1 and F9A and identify if the Application Fee has been paid on these forms. The fee will not be present on e-filed or web-filed applications; however the fee details for these cases will be shown on the fee sheet. The fee may also be filed independently of these forms. If this is the case the fee may be found on form AF1 either one submitted by the applicant or one made up in the office. As part of the Preliminary Examination, the description and claims should be examined in order to establish that the requirements of r.14 and Sch.2 have been complied with. If one or more of the pages is found not to comply, the applicant should be informed via the Preliminary Examination Report.

## **Agent Cases - PCT Applications**

- 4.03 Where the specification is an English language translation of the WIPO foreign language pamphlet, r.14 and sch.2 are to be applied in the same way as for non - PCT applications. Where the specification is the English language copy supplied by WIPO the pages will already comply and no objection should be raised.

## **Private Applicant Cases**

- 4.04 If at the Preliminary Examination of a Private Applicant case it is established that the specification fails to comply with r.14 and Sch.2, the procedure as set out at 4.02 should be undertaken. If no response is received to the request for replacement pages and that is the only outstanding formal requirement, the case should be referred to the Formalities Manager for approval of retyping action.
- 4.05 Upon approval being given for the retyping action, the Formalities Examiner should retype the pages using Word and import them into the

dossier. A suitable printer's instruction should be added to Optics. The applicant should be advised, in writing using the letter entitled 'Description re-type' at Annex 4A and enclosing a copy of the typed pages, that the action has been carried out and that the application will now proceed to "A" publication. The applicant should be given one month (extendable under r. 109) to set out, in writing, any objection to the above action.

## **General Points**

- 4.06 The description should be headed with the title of the invention which should be short (r12(6)) and in agreement with the title given on F1. It is acceptable for the title to appear on a page of its own provided that the page is numbered, i.e. 1. Where no title has been given to the description, a minute should be referred to the Patent Examiner.
- 4.07 The claims should be suitably headed, e.g. "Claims" or "What we claim is". There is no requirement in the legislation as to the manner in which the claim(s) shall be headed, providing the heading clearly identifies the commencement of the claim(s).
- 4.08 Where a discrepancy is discovered between the title on the description and that given on the F1, or, where a written request is made under s117 to correct the title, the Patent Examiner should be informed.
- 4.09 The description claims and abstract must be typewritten or printed on white, matt A4 size paper. Manuscript documents (i.e. cursive script as opposed to hand-printed capital lettering) are not acceptable and should be objected to. Pages should be free from tears, folds and other damage and be suitable for reproduction.
- 4.09a If any document or part of a document is illegible because the originally filed document was illegible the Formalities Examiner should seek advice from the Patent Examiner or PD Legal. Illegible documents will not normally be entitled to a filing date.
- 4.09b The quality of the images on PECS should be checked and a re-scan requested if any are unacceptable. Images should not be set as handled unless and until the Formalities Examiner is satisfied that the quality of the image is acceptable.

## **Replacement Pages**

- 4.10 When replacement pages are filed in response to an official objection, the Formalities Examiner must check that the replacement pages are word for word copies of the pages as originally filed and that they comply with the

formal requirements. If acceptable, the pages should be copied or the assembler should be used to create a Formal copy which should be suitably annotated. The Formalities Examiner should ensure that Footnote 4 of the Printer's Instruction is added to OPTICS.

- 4.11 If the Formalities Examiner is unable to decide whether a replacement page is identical to the page as originally filed (eg if text is illegible), the matter should be referred to the Patent Examiner. The Patent Examiner should then instruct Formalities regarding the incorporation of acceptable pages and the addition of any relevant printer's instructions.
- 4.12 Replacement pages may be filed outside the period specified in the Preliminary Examination Report as an automatic extension of two months to this period is available under r.109. Requests to extend the specified period under r.109 should be made in writing or e-mailed to [PATEOT@ipo.gov.uk](mailto:PATEOT@ipo.gov.uk), before the end of the period as extended. If replacement pages are filed outside this extended period a further extension of time may be allowed at the Comptroller's discretion.

### **Computer Programs and other bulky material**

- 4.13 Where pages of the specification contain computer programs or other lengthy material, these pages will not normally be printed when the application is 'A' published. A report to the Patent Examiner should be made as follows:
- "Pages ..... of the specification appear to be a computer program and in accordance with paragraph 16.27 of MoPP should not be printed unless you decide otherwise".
- 4.14 If the Patent Examiner does not require the pages to be printed, he/she will ask the Formalities Examiner to arrange for the appropriate notice to be added to the front page of the 'A' document. However it is still the responsibility of the Formalities Examiner to ensure that the pages in question meet the formal requirements.
- 4.15 If the Patent Examiner decides that the program is to be printed and the pages are not formally acceptable, he/she will arrange for any objection to be communicated to the applicant, usually when the Search Report is issued. The new pages when received will be treated as in 4.10.
- 4.16 The Patent Examiner may decide that a computer program is not required on the 'A' print but is necessary in the 'B' print. In these circumstances, if the pages do not meet the formal requirements, he/she will arrange for the objection to be issued with the substantive examination report.

## Sequence Listings

- 4.17 A sequence listing means, in respect of a biotechnology invention, the part of the description of the application which gives a detailed disclosure of the nucleotide and/or amino acid sequences referred to in the application.
- 4.18 The Patent Rules 2007 introduced specific provisions for the filing of sequence listings which are set out in Rule 13 and Schedule 2 paragraphs 5 and 9.
- Any application which discloses a sequence must include a sequence listing.
  - If a sequence listing is not provided at filing the comptroller may specify a period within which it must be filed. If it is not filed the application may be refused.
  - A sequence listing provided after filing must be accompanied by a declaration that it does not contain matter beyond that disclosed in the specification.
  - A sequence listing shall, if reasonably possible, be delivered in electronic form even where the patent application is not filed electronically.
  - A sequence listing may be set out either in the description or at the end of the application. If it is at the end of the application it must be numbered consecutively in a separate series. The 1.5 minimum line spacing requirement does not apply to a sequence listing.
- 4.19 Applications containing sequence listings will generally be allocated to a heading covering
- Proteins, enzymes and nucleic acid  
Chemical analysis testing, specific complementary binding  
Microbiology  
Pharmaceutical preparations.
- 4.20 The majority of these applications will be dealt with in the examining group responsible for biotechnology. These applications will typically have claims or references in the specification to nucleic acid or peptide sequences of SEQ ID NO: 1, 2 etc. which would suggest that there should be sequences present in the application.

- 4.21 The sequences if present are typically presented as separate pages, with the sequences spelt out e.g. Nucleic acid sequence : atgcacctt atgggtcaa, Protein/peptide sequence : MAVASLILGNM. Alternatively there may be just tables listing the sequences by their publicly available accession numbers e.g. a database (such as GenBank) accession number ACC 1234. If there is any doubt the heading examiner will advise.
- 4.22 If an application is identified as one which should contain a sequence listing then the Formalities Examiner should confirm at the Preliminary Examination that one has been filed and if so, that it meets the requirements. If it does not then any objection should be made as part of the Preliminary Examination report. Any sequence listings filed separately on DVD are then stored by the relevant Formalities group.
- 4.23 If no sequence listing is present the Formalities Examiner should notify the applicant using the paragraph set out below specifying a period of 2 months from the notification for the sequence listing and a declaration to be filed, and set a diary entry.
- 4.24 If no sequence listing has been filed and the 2 month period has expired the case should be referred to the heading examiner for advice.
- 4.25 The following paragraph is suggested for use in notifying an applicant who has not provided a sequence listing at filing.

“Your application discloses a - *{nucleotide/amino acid/protein/peptide}* sequence - but you have not provided a sequence listing as required under Rule 13 of the Patent Rules 2007. Please provide a sequence listing, in electronic form if possible by *{2 months from date of letter}*. You should also provide a declaration that the sequence listing does not contain any matter beyond that which is disclosed in your application. If you do not provide a sequence listing within the time specified above your application may be refused”.

## **Claims and Abstracts**

- 4.26 One or more claims and an abstract should be filed within 12 months of the earliest date of the application or within 2 months of the date of filing of the application, whichever is longer (s.15(10) and r.22(1)). The claims and abstract do not have to be filed together. An application must have one or more claims before the Patent Examiner can proceed with the search.
- 4.27 Where the Application Fee has been paid but no claims have been filed, the Preliminary Examination Report should request claims be filed within the prescribed period. If a request for search (F9A) has been made but no

claims have been filed and no Application Fee paid, the agent should be contacted by letter and advised of the discrepancy. Where the application has been filed without the services of an agent and no Application Fee has been paid, the case should be forwarded to the Deputy Director for advice on whether the standard letter can issue or whether any additions need to be made. On return the Formalities Examiner should issue the letter as advised by the Deputy Director. The application should then be diarised for a suitable period to await filing of the claims.

4.28 Where claims and the abstract have been filed after the initial filing date of the application, but within the prescribed period, a report to the Patent Examiner should be made explaining that the claims were filed after the initial filing date. The Formalities Examiner should ensure that Footnote 3 of the printer's instructions is recorded on Optics.

4.29 The period prescribed by r.22(1) for the filing of claims and the abstract is either:

12 months from the filing date, where there is no claim to priority  
or

where there is a priority claim, whichever is the later to expire of  
12 months from the priority date or 2 months from the filing  
date.(r.22(7))

4.30 To extend the prescribed period for filing the claims and abstract an automatic 2 month extension period is allowed under the provisions of r.108(2) (see 10.24 -25). A further extension to the prescribed period may be available under Rule 108(3) if the period has previously been extended under rule 108(2) but not otherwise (see 10.37 – 41). The applicant/agent may apply for re-instatement (see 10.42 -62) if an extension of time is no longer available.

4.31 If amended and/or new claims are filed at any time before the date of completion of preparations for early publication, they will be included in the ' A ' specification. A report to the Patent Examiner that amended and/or new claims have been filed should be made. If the new claims comply with r.14 and Sch 2, the Formalities Examiner should create a set of amended claims. The new claims should be headed “Amended Claims” and re-numbered accordingly using the enhancer. The Amended Claims should be annotated “Working Copy” and the action log updated.

4.32 If the amended and/or new claims are filed as part of a full response to a Combined Search and Examination report, the procedure as in 4.21 should take place. The case should then be forwarded to the Patent Examiner in order that he may consider any suggested amendment to the application.

- 4.33 In the event that the amended and/or new pages of claims do not comply with r.14 and Sch 2 the applicant/agent should be informed by telephone and a confirmatory report issued. Publication should not be delayed to await any response. The Formalities Examiner should consult or refer the dossier to the Search Examiner for advice when necessary.
- 4.34 If acceptable pages have been received after preparations for publication are complete, the amended and/or new claims will not be included in the 'A' specification but will be published by inclusion in the documents laid open to public inspection.
- 4.35 Where only the abstract is absent this does not prevent the application from proceeding to search if both the request for search (F9A) has been filed and the Application Fee has been paid. Where the Application Fee has been paid and the search has been requested, the lack of an abstract should be reported in the Preliminary Examination Report. Where the search has been requested but no Application Fee has been paid the application cannot proceed to search and the agent should be contacted by telephone and advised of the deficiency. Where the period for filing the abstract as extended by r.108(2) has expired, any request to file the abstract must be accompanied by a request for re-instatement, see 4.23.
- 4.36 Where no claims and/or an abstract have been filed within the prescribed period and the automatic 2 month extension allowed by r108(2) has expired the application should be referred to the Formalities Manager for issue of the WR4 letter.

### **Failure to Comply with Formal Requirement(s)**

- 4.37 Compliance of the description claims and abstract with r.14 and Sch 2 is a formal requirement and failure to comply will result in refusal of the application by the Comptroller under s.15A. If an objection has not been met and the period for response (as extendable by two months under r.109) has expired an FL48 letter should be issued to the applicant/agent and the case diarised for a suitable period.
- 4.38 If no response is received to the above requests the application should be refused and a decision should be prepared by the Formalities Examiner. The decision should then be passed through the Formalities Manager to the (Assistant) Head of Administration for approval and signature.

## **Formal requirements – electronically filed applications**

4.39 Applications and sequence listings which are filed electronically are exempt from many of the formal and other requirements for drawings and documents. This allows unrestricted transmission of applications by electronic means.

4.40 Directions issued under section 124A govern how the Office will deal with applications after they have been delivered electronically. The latest directions are at: [www.ipo.gov.uk/pro-types/pro-patent/p-law/p-legislation/p-direction/p-direction-electronic-1207.htm](http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-legislation/p-direction/p-direction-electronic-1207.htm)

4.41 Paragraphs 16 and 17 of the Directions set out the formal requirements for description, claims and abstract in an electronically delivered application as below:

*Where an electronic application includes a description of the invention, rule 12(4) of the Rules shall apply to the extent that the description shall be preceded by the title of the invention.*

*The following provisions of the Rules shall apply to electronic applications and shall be formal requirements: Schedule 2 Part 1 paragraph 3, Schedule 2 Part 2 paragraphs 4-7, 9 and 10.....*

4.42 Once the application has been filed all the formal requirements will apply except those which relate specifically to paper filed applications (paragraphs 1, 2 and 8.)

Part 4 of Schedule 2 applies to all applications.

## **Reference to earlier application/Later filed Description**

4.43 Under s.15(1)(c) the applicant is not obliged to submit a description at the time of filing in order to secure a filing date; instead he may supply a reference to a previous application although this must be substantiated (by filing a copy of the application referred to and a description) in order for the filing date to stand.

As such cases cannot be security cleared on the basis of their description they will be identified, actioned and retained in Security Section until sufficient documentation is on file to allow security clearance to take place. If an Application Fee has been paid Security Section will perform the preliminary examination.

- 4.44 The reference to a previous application must include
- i) the filing date of the earlier application (r.17(1)(a))
  - ii) the application number (r.17(1)(b))
  - iii) the country where it was filed (r.17(1)(c))
- 4.45 If the applicant has made correct use of this provision the Formalities Examiner should check that all the above information has been provided in part 9 of F1. If any of the information is missing or unclear, the case should be referred to the Head of Administration for advice on how to proceed.
- 4.46 If it is clear that the applicant has misunderstood the provision and/or has provided something other than a bona fide reference to an earlier application then the procedure in 15.15 should be followed to make the application a ‘no case’. If there is any doubt as to whether the application can continue the case should be referred to the Formalities Manager.

### **Copy of earlier application**

- 4.47 In all cases where a reference to an earlier application has been made, there is a requirement to file a copy of the application referred to within 4 months of the filing date. This must be either a certified copy or a copy otherwise verified to satisfy the Office if a certified copy cannot be obtained. If the copy is in a language other than English or Welsh then a translation (or declaration) must also be filed. (r.17(2)(b))

However, if the application referred to is an earlier **GB application**, or an application which is otherwise available (ie via the internet) to the Comptroller then the requirement to file a copy will be treated as met. (r17(3)).

- 4.48 If the Application Fee has been paid, the Formalities Examiner should request the certified or verified copy of the referenced application (and translation or declaration, if required) in the Preliminary Examination Report. If the Application Fee has not been paid and a copy of the referenced application is required then the letter at Annex 4B should be issued. A diary date should be set to monitor the filing of the requested documents since without these the application will be treated as a ‘no case’.
- 4.49 The prescribed period for filing the certified copy (plus translation or declaration if needed) is 4 months from the filing date.

- 4.50 It is possible that the application also claims priority from the same application which is used as the referenced application. In this case only one certified copy of the document is required to meet both requirements.
- 4.51 If the applicant files the certified copy outside the prescribed period, or enquires about doing so, they should be advised of the r.108 procedure if they are within the prescribed period plus two months. **No automatic extension of time is available** but a discretionary extension to the prescribed period may be available under r.108(1) although this will be restricted by r108(5) and (7) (see 10.37 -41) Re-instatement will apply if an extension of time is no longer available.
- 4.52 Failure to file the certified copy (and translation or declaration if required) within the prescribed period will lead to the application being treated as if it had never been made (i.e. as a ‘no case’) and the case should be referred to the Formalities Manager who will take the necessary action.

## Description

- 4.53 In every case where a reference to an earlier application has been made a description must be filed within 12 months of the filing date
- 4.54 If the Application Fee has been paid, the Formalities Examiner should request the description in the Preliminary Examination Report. A diary date should be set to monitor the filing of a the description since without it the application will be treated as withdrawn
- 4.55 The prescribed period for filing the description is either:
- 12 months from the filing date, where there is no claim to priority  
or  
where there is a priority claim, 12 months from the priority date or 2 months from the filing date, whichever is the later.
- 4.56 When the description, (which should be taken to be the description for the application) is filed the diary entry should be cancelled. The following free text footnote should be added on Optics:
- The application was filed with a reference to an earlier application under Section 15(1)(c)(ii) of the Patents Act 1977; the description was filed later than the filing date but within the period prescribed by Rule 22(1) of the Patents Rules 2007.*
- 4.57 The description when filed should comprise only the description of the invention and any drawings referred to in that description. The copy of the description should not include any claims or an abstract. The requirements

for filing these on any application are as outlined in 4.26-4.36 above. Except in the clearest of cases (e.g. when the description is obviously a complete photocopy of part or all of the certified copy) the document should be referred to the Patent Examiner to make the comparison.

- 4.58 Failure to file the description will lead to the withdrawal of the application and the application should be forwarded to the Formalities Manager who will withdraw the application. An automatic extension under rule 108(2) is available for filing the description therefore withdrawal should not be effected until the 2 month extension period has passed.

### **The “As Filed” State of the Application**

- 4.59 In some circumstances it may be difficult to establish which documents are to form the state of the application in accordance with s.130(4) when an application is filed. Apart from the reference to an earlier application outlined in 4.32 – 4.45 above the following situations may also give rise to uncertainty:

- a) Documents forming the application may be filed at different times on the same day.
- b) Amendments may be filed with the application on the application's date of filing.
- c) Two specifications are filed with the application on the application's date of filing.
- d) Two different specifications are filed with the application on the application's date of filing.

Cases of difficulty not falling within any of these categories should be referred to the (Assistant) Head of Administration via the Formalities Manager for consideration by the Deputy Director.

- 4.60 Where a document is not filed with the application at the time the application is filed but is filed in the Office on the same day, this will be treated as completing the application. Therefore all the documents filed on the date accorded to the application will form the state of the application “as filed”.

- 4.61 If amendments or modifications are filed on the filing date of the application, they should only be incorporated into the specification if it is clear that it is the applicant's intention that the amendments are intended to form part of the application ‘as filed’. If this is the case then:

- a) if the amendments are in the form of new pages they should be incorporated into the specification since they will form part of the application 'as filed'.
  - b) if the amendments are indicated in an accompanying letter they should be referred to the search examiner for consideration.
- 4.62 When the instructions contained in the Agent's letter are not clear the case should be referred to the Patent Examiner.
- 4.63 Where two copies (i.e. formal/informal) of the same document are filed with the application and it can be established that they are the same document then the formal copy should form the application 'as filed', and the informal version should be annotated "spare."
- 4.64 Where two versions of the same document are filed which are obviously different (e.g. auxiliary claims) and where the applicant makes his intention clear, the application should be re-constituted as indicated by the applicant. All copies of the surplus documents resulting from the re-constitution should be annotated "surplus" in the dossier's TOC. A letter informing the applicant of the action taken should be issued.
- 4.65 Where two versions of the same document are filed which are obviously different and where the applicant's instructions are unclear as to which documents should form the "as filed" specification, the case should be referred to the Deputy Director. If after consideration, the Deputy Director is unable to indicate the constitution of the application, the applicant should be informed by letter giving a period of one month in which to inform the Office which document(s) are to form the application "as filed". After the applicant has informed the Office of his intentions the procedure as set out in 4.46 above should be followed.

### **Documents Filed in a Language other than English or Welsh**

- 4.66 S.15(2) allows for the description to be filed in any language for the purpose of securing a date of filing.
- On receipt of an application filed in a language other than English or Welsh, Index & Scanning Section should process it in the normal manner and forward it to Security Section.
- 4.67 The applicant has 2 months from notification in which to supply an English or Welsh translation (r12(8) & (9)) and Security Section should promptly issue an appropriate letter advising the applicant of this and set a

suitable diary. If the translation is received within the 2 month period, the translation will form the description and the application will be processed in the normal manner.

- 4.68 If, on the other hand, a reply is not received within the two months specified in the letter Security Section should issue a further letter. If no reply is received within the two weeks specified in that second letter, the application should be refused. If the applicant replies to the second letter asking to be heard, the matter should be referred to the Hearing Clerk in Litigation Section who will appoint a hearing.
- 4.69 Any enquiries concerning the above procedures should be directed to Security Section.

### **Missing Pages of Description**

#### **Filed by the applicant**

- 4.70 Where any page has been omitted from the description the agent/applicant can elect to file these missing pages at any time between the filing date and the date of Preliminary Examination (r.18(1)). The application will then be automatically re-dated to the date of filing the missing pages unless the provisions set out below apply.
- 4.71 a) If the applicant is to avoid re-dating of the application he must withdraw the missing page(s) in writing. If the applicant asks to withdraw the missing page(s) under s.15(6)(b) it will not be included in the printed 'A' document, however, in the absence of a direction under r.53, it will become open for public inspection following s.16 publication.
- b) Alternatively, he must request that re-dating does not take place because the provisions of s.15(7)(b) apply.
- 4.72 The provisions of s.15(7)(b) will only apply when there is a priority claim and the applicant can show that the missing pages were included in the priority document. It is the applicant's responsibility to provide enough information to determine where in the priority document the missing pages appear.
- 4.73 Every missing part must be included in the priority document if the earlier filing date is to be retained. If there is any doubt as to whether subject matter is being added then the Patent Examiner should be consulted.
- 4.74 Unless a copy of the document is already held in the office a certified copy of the priority document containing the missing parts must be filed within

16 months of the priority date or within 4 months of the request to retain the original filing date if that is earlier.

- 4.75 When missing pages are filed by applicant/agent of his own accord the letter at Annex 4C should be issued explaining the options if automatic re-dating is not to take place and specifying a time for response.
- 4.76 If the applicant files missing pages and requests that the application is NOT re-dated the Formalities Examiner should refer the case to the Formalities Manager to determine if all the conditions set out above have been satisfied. If there is any doubt as to whether all the missing parts are contained in the earlier application the case should be referred to the Patent Examiner for advice.

### **Notified at Preliminary Examination**

- 4.77 During the Preliminary Examination, the Formalities Examiner must ensure that there are no missing pages of description. If it is discovered that a page or pages are missing, the Formalities Examiner should carry out one of the following actions in accordance with s.15A(4) & 15A(9)(b)
- a) where the application makes no claim to priority issue the appropriate paragraph inviting the applicant to file the missing pages. The standard paragraph gives the applicant 2 months in which he can file the missing page(s) and have the application re-dated to the date they are filed. If he does not file them then the application will proceed in the 'as filed' state.
- or
- b) where the application claims priority from an earlier application the missing pages may be contained in this priority application and s.15(7)(b) may apply (see 4.59 -61) This possibility should be made available to the applicant by including the appropriate paragraph in the Preliminary Examination report.
- 4.78 In either case the Formalities Examiner should complete the Preliminary Examination. The case should be diarised for a suitable period and a minute included for the Examiner that this issue is still outstanding and the application may be re-dated.
- 4.79 Where an application contains a claim to priority under s.5(2), the Formalities Examiner should consider whether the possibility of re-dating would render such a priority claim invalid. If any priority claim would become invalid as a result of re-dating, the following paragraph should be

inserted into the standard paragraph of the Preliminary Examination report:

*"It should be noted that the application claims the earlier date of {DATE} under Section 5(2) of the Patents Act 1977. Therefore, the filing of the missing page(s) and the consequent re-dating of the application would render the claim to priority invalid."*

- 4.80 If, in response to the Preliminary Examination Report, the applicant files the omitted page(s) and requests that the application is NOT re-dated the Formalities Examiner should refer the case to the Formalities Manager to determine if all the conditions set out in 4.59 – 61 above have been satisfied. If there is any doubt as to whether all the missing parts are contained in the earlier application the case should be referred to the Patent Examiner for advice. If the provisions of s15(7)(b) outlined previously in 4.59- 61 do not apply the application must be re-dated.

### **Re-dating**

- 4.81 In order to re-date an application, the Formalities Examiner should carry out the following actions:

- a) place a minute on the dossier indicating the date to which the application is to be re-dated. Where the application contains a claim to priority that will be rendered invalid by the re-dating action, the minute should also request the cancellation of the priority details.
- b) send a message to the Formalities Manager.

- 4.82 The Formalities Manager will carry out the following actions:

- a) approve the re-dating, print the F1 and where appropriate delete the declared priority date on F1. The corrected F1 should be sent to Index & Scanning.
- b) create a message to the relevant sections to effect the re-dating - ie Document Reception for issue of a new filing receipt, Index and Scanning to re-date all documents on file to the date of filing of the omitted pages and if appropriate, place a notice in the Patents Journal.

- 4.83 When the action is completed, the Formalities Examiner should carry out the following actions:

- a) check the page(s) to ensure that they meet the requirements of r.14 and Sch 2
- b) advise the applicant, in writing, that the application has been re-dated, and where appropriate, that the claim to priority has been lost;
- c) prepare a minute on the dossier advising the Examiner that the application has been re-dated, and where appropriate, that the claim to priority has been lost.

4.84 If the applicant does not respond or when replying elects to have references to the missing pages withdrawn under s.15(6)(b), the Formalities Examiner should carry out the following actions:

- a) using the first non-standard text on the printers instruction and entering the relevant page number(s), record the information on Optics.
- b) prepare a minute advising the Patent Examiner that the references to the missing page(s) are to be treated as withdrawn and that the printer's notice has been completed.
- c) send a message to the relevant examining group.

### **Correction of Errors**

4.85 If the Applicant/Agent has made an error in any of the pages of description, claims or abstract (including omitting a page) then they may request that this be treated as a clerical error under s.117(1). If the Patent Examiner indicates that *prima facie* a correction is allowable, a written request identifying the proposed correction will be required to effect the correction. Where the Patent Examiner is not prepared to allow the correction as a clerical error he/she will inform the applicant/agent

4.86 If a request to correct the description claims or abstract is received, the case should be referred to the Patent Examiner for consideration. The Examiner will advise Formalities regarding the allowability or otherwise. If substitute pages are required, provided the formal requirements are complied with, they should be inserted in the specification after the correction has been allowed using the assembler. It should be noted that any subsequent COC must be issued with the appropriate certificate.

4.87 The Formalities Examiner should update the printer's instruction on Optics using box 6. A letter informing the applicant of the allowance should be issued. If the request is not allowed, the description, claims and abstract

should remain as filed. Where the unallowable correction concerns a late filed page, any late filed page will have to be treated as an amendment and will be dealt with by the Patent Examiner at the appropriate time.

### **Request for an Annex to be Printed under S.16**

- 4.88 Any case which requires that a specification or any associated document filed with the application be printed at the "A" print stage as an annex to the description, must be referred to the search examiner with the following minute:

*Please see Agent's letter dated ..... for action in accordance with paragraph 16.27 of MoPP.*

- 4.89 Any subject matter not to be included in the "A" specification will be removed by the Patent Examiner from the copy of the specification to be printed and he/she will provide a printer's instruction to be recorded on Optics.

### **Voluntary Amendment of the Description**

- 4.90 Where an applicant submits pages by way of amendment to the description before the date of completion of preparations for early publication, the dossier should be referred to the Patent Examiner for consideration.
- 4.91 Amendments filed before the date of issue of the search report are treated as having been filed on that date. The Formalities Examiner must not incorporate these pages into the description until after publication, but should confirm that they meet formal requirements.
- 4.92 When the request for substantive examination is filed the new pages should be incorporated into the description. The checklist should be updated as a reminder to Formalities that there are amended pages on the dossier which should be incorporated prior to substantive examination.

### **Replacement Pages at Substantive Examination**

- 4.93 Where replacement pages are filed after publication for consideration at substantive examination, providing they meet the formal requirements, they should be incorporated into the specification. If a complete set of pages are filed the clone function may be used; the assembler function

should be used if a full set of pages has not been filed. The amended description and/or claims should be annotated "Working Copy."

- 4.94 Where replacement pages fail to meet the formal requirements, the following report to the Patent Examiner should be made :

*"Please see the Agent's letter dated ..... The replacement pages do not comply with formal requirements but have been incorporated into the specification to assist your examination. Please inform the Agent in your next report that formal, word for word copies are required"*

- 4.95 The Patent Examiner may defer issuing the request to file replacement pages which meet the formal requirements when he issues his report, (to enable further amendments to be made before replacement pages are requested), it will then be his responsibility to include the request for compliance with formal requirements. If no report is to be issued by the Patent Examiner, the matter will be referred back to the Formalities Examiner to pursue.

### **Amendment After the Application is in Order for Grant**

- 4.96 A written request to amend the pages of the application may be filed after an application has been placed in order for grant and may be allowed with the Comptroller's consent. The request for amendment must be received before the issue of the "B" letter. If the case has entered the publication cycle, the matter should be referred to the Divisional Publication Liaison Officer without delay. The request will then need to be referred to the Patent Examiner for his/her consideration (MPP 19.20-22). If the request is allowed and new pages are necessary the Formalities Examiner will incorporate the new pages.
- 4.97 If a request for amendment is received after the issue of the 'B' letter, the matter should be referred to the Divisional Publication Liaison Officer without delay. The applicant should then be informed that it is too late to make the amendment before grant but that the request will be considered after grant, (i.e. the date of publication in the Patents & Designs Journal). Any request to amend the application after grant will be the responsibility of Litigation Section.

### **Replacement Pages on PCT Application**

- 4.98 Replacement pages filed on a PCT application in the national phase should be actioned as in 4.80. Such pages may come attached to the IPER or directly from the agent. The new pages are not to be incorporated until

after re-publication and will then be used for the substantive examination and for the "B" print.

A. N. Other  
Any Street  
Any Town  
Any Place  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
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NP10 8QQ  
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**Direct line:** 01633 81\*\*\*\*  
**†E-mail:** \*\*\*\*\*@ipo.gov.uk  
**Switchboard:** 01633 814000  
**Minicom:** 08459 222250  
**Fax:** 01633 814444  
DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: XXX**  
**Application number: GB \*\*\*\*\*.\***

Date

Dear

**Patents Act 1977: Patent Rules 2007  
Presentation of description**

The Office has prepared a typed version of your description, as filed, which will be used as the published version of your application. Any previous objections issued regarding the quality of the pages of your application have now been waived.

Enclosed is a copy of the typed application which you should refer to if you intend to file any amended pages at a later date.

Any comments concerning the above action should be made in writing by DD/MM/YYYY.

Yours sincerely

Formalities Examiner

September 2011

A. N. Other  
Any Street  
Any Town  
Any Place  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
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DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: xxx**  
**Application number: GB \*\*\*\*\*.\***

Date

Dear Mr Other

**Patents Act 1977: Patent Rules 2007  
Request for further details**

Thank you for your patent application filed on DD/MM/YYYY and for which a priority date of DD/MM/YYYY has been declared. It has been given the number GB \*\*\*\*\*.\*. Please quote this number whenever you contact the office.

Please provide us with the following information by the required dates so that your application may proceed:

The applicants' full names and addresses by DD/MM/YYYY.

A certified copy of the earlier application referred to at Part 9 of Form 1 and if applicable, a translation of that document or a declaration to the effect that the copy in suit is a complete translation into English or Welsh of the earlier application, by DD/MM/YYYY.

Please note that there may well be other outstanding formal requirements which will be reported on when you file the application fee and the preliminary examination has been performed.

Yours sincerely

Formalities Examiner

September 2011

A. N. Other  
c/o An Agent  
Any Street  
Any Town  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
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**Minicom:** 08459 222250  
**Fax:** 01633 814444  
DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: xxx**

**Application number: GB \*\*\*\*\*.\***

Date

Dear Sirs

**Patents Act 1977: Patent Rules 2007  
Report under Section 15(5) - late filed page(s)**

On DD/MM/YYYY you filed at this office all the missing pages which should have been included when the application was filed.

The pages will be included in your application and the application filing date will be changed to DD/MM/YYYY.

If you wish to retain the earlier filing date you must either withdraw the missing pages in writing by DD/MM/YYYY or show that all the missing pages were present in an earlier application from which you claim priority.

If we do not hear from you by DD/MM/YYYY the application will be re-dated to DD/MM/YYYY.

Yours faithfully

Formalities Examiner

September 2011

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†Use of E-mail: Please note that e-mail should be used for correspondence only.

## Description, Claims and Abstract

### Rule 14 and Schedule2

<b><u>Rule 14</u></b>	
(1)	All documents must be filed in English or Welsh
(5)	Schedule 2 parts 1 and 2 do not apply to electronically or web filed applications
<b><u>Schedule 2</u></b>	
<b><u>Part 1*</u></b>	<b>ALL DOCUMENTS</b>
(1)	A4 matt white paper must be used
(2)	Paper must be free from tears, folds or similar damage Contents must be suitable for reproduction
(3)	Frames must not be used
<b><u>Part 2*</u></b>	<b>DOCUMENTS OTHER THAN DRAWINGS</b>
(4)	Pages of description and claims must be consecutively numbered in one series
(5)	Pages of sequence listings should be placed at the end of the application They must be consecutively numbered in a separate series
(6)	Pages should be numbered in the centre at the top or bottom
(7)	Margins must measure at least 20mm
(8)	F1, description, claims and abstract must each begin on a new sheet
(9)	Description, claims and abstract (except for translations and sequence listings) must use at least 1.5 line spacing
(10)	Capital letters must be more than 2mm high
<b><u>Part 4</u></b>	<b>OTHER REQUIREMENTS</b>
(22)	Tables can only be included in claims if examiner agrees
(23)	Terminology and references must be consistent throughout the application
(24 &25)	Standard units of measurement should be used or equivalent standard international units of measurement should be provided. Only technical terms, signs and symbols which are generally accepted in the field may be used.

\* Parts 1 and 2 do not apply to electronically or web filed applications