

PATENTS RULES 2007 – CONCORDANCE

Introduction

This Concordance provides a detailed guide to the Patents Rules 2007 (SI 2007/3291), which came into force on 17 December 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 in the 2007 Rules.

Where can I get more information?

The Patents Rules 2007 and the accompanying explanatory information laid before Parliament are available from the OPSI website at www.opsi.gov.uk/si/si200732.htm

Status of this guidance

This guidance has been prepared by the UK Intellectual Property Office. It gives the Office's view of the changes made by the Patents Rules 2007 and as such it has no legal force.

Rule number in 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) contains a number of definitions used throughout the new Rules, and includes a new definition for "application number" and "new application", as well as definitions for such terms as "compliance date", "compliance period", "sequence" and "sequence listing". The definition of "initiation date" has been simplified from that in rule 2 of the 1995 Rules. This definition, like the rest of the Rules, refers to the "Patent Office" rather than the "UK Intellectual Property Office" since the former remains the legally correct name for the Office in legislation.</p> <p>New paragraph (2) 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 (3) 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 (4) 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>
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 Office moving to wholly electronic case-files (with paper</p>

		<p>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 has given directions under section 124A as to the requirements which do apply.</p> <p>Note that, throughout the Rules, the “/77” has been dropped from all Form numbering.</p> <p>Paragraph (6) waives any requirement in rules for duplicate or triplicate copies of documents to be filed, if those documents are supplied electronically.</p>
PART 2 – APPLICATIONS FOR PATENTS		
5	5	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 . Other than this, the rule is intended to have the same effect as rule 5 of the 1995 Rules .
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 [i.e. 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>In paragraph (2)(b), it has been clarified that the date of filing of any earlier relevant application may have been specified in an earlier declaration, and not in the late declaration that is being made under that paragraph.</p> <p>The definition of “priority application” now applies throughout the entire rules.</p>
7	6A inserted by SI 2004/2358 amended by SI 2007/677	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>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 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.</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 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	6C inserted by SI 2004/2358	<p>The following minor changes have been made to the wording of 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</p> <p>r 15: amended by SI 2004/2358</p>	<p>Paragraph (1) 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 (2) 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 existed only by implication. This provision sets out that right expressly.</p> <p>Paragraph (3) represents rule 15(1) of the 1995 Rules.</p> <p>Paragraph (4) represents rule 15(1A) of the 1995 Rules.</p> <p>Rule 15(2) of the 1995 Rules has not been replicated, so there is no longer a requirement to file multiple copies of a Form 7.</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 (6) replaces rule 16(3) of the 1995 Rules.</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 1977 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</p>

		filed in Welsh no translation is required.
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 (7) are new. They make certain special provisions for “sequence listings”.</p> <p>Paragraph (2) mandates that where an application discloses a sequence it shall also include a sequence listing.</p> <p>Where such an application as filed does not include a sequence listing, the comptroller may, under paragraph (3), specify a period within which the applicant must supply the listing. If one is not provided, the application may be refused. Paragraph (4) requires the applicant to supply any such listing with a declaration that it does not add matter to the application.</p> <p>Paragraph (5) requires any 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 (6) requires a sequence listing, where reasonably possible, to be sent in electronic form. This applies whether or not the application as a whole is sent electronically.</p> <p>Paragraph (7) allows sequence listings to be included at the end of the application, rather than in the description, thereby giving greater flexibility to applicants.</p>
14 and Schedule 2	18 and 20 rr 18 and 20: amended by SI 2003/513 r 20: amended by SI 2007/677	<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, and disapplies the formal requirements in respect of electronically-filed applications. However, the comptroller</p>

		has given directions under section 124A as to the requirements which do apply.
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> <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 in that provision.</p>
16	22 amended by SI 1999/1092	<p>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.</p> <p>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.</p>
17	22A inserted by SI 2004/2358	<p>There are some minor changes from rule 22A of the 1995 Rules.</p> <p>First, the requirements to provide an English translation where the original application is in Welsh have been</p>

		<p>removed.</p> <p>Secondly, the wording of paragraph (1)(c) has been modified to reflect the wording of section 5(3).</p> <p>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.</p> <p>Fourthly, it will be possible for an application to be verified to the comptroller’s satisfaction instead of it being formally certified.</p>
18	23 substituted by SI 2004/2358	<p>This rule essentially replicates, and has the same effect as, rule 23 of the 1995 Rules.</p> <p>Note however 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.</p>
19	24 amended by SI 1999/1092, 1999/3197 and 2004/2358	<p>The drafting of this Rule has been modernised. It is intended to have the same effect as rule 24 of the 1995 Rules.</p> <p>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 wording is used, rather than “under section 15(9)” as in the 1995 Rules, to follow the wording of the 1977 Act).</p> <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(2).</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</p>

		<p>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 began either when the time limit for bringing an appeal expired (presently 28 days: CPR PD 52 paragraphs 17.1-17.3) or when the appeal was 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 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. Thus rule 108 makes no reference to the shortening of time periods.</p>
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</p>

		<p>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”). For such applications, the Form 7 and priority documents must be provided on filing the application.</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 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	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>Paragraph (2) sets out what constitutes the formal requirements for electronically-filed applications for the purposes of the Rules, although the comptroller may, in directions under section 124A, set out any further requirements for the filing of such 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	<p>28A and 32</p> <p>r 28A: inserted by SI 2004/2358</p> <p>r 32: amended by SI 1999/3197 and 2004/2358</p>	<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 position 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 1977 Act and the 1995 Rules, but it is now set out formally.</p> <p>Paragraph (2) replaces 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 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) introduces the concept of the “compliance period” in order to avoid repetition of the phrase “period prescribed for the purposes of section 18(4) and 20” throughout the rule and elsewhere.</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>It should be noted that the rule forms the basis for the definition, in rule 2, of the new term “compliance date”. This 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”. It starts when the search report is issued under section 17(5) (this represents rule 36(2) of the 1995 Rules) and it ends when the first substantive examination report is sent (representing rule 36(3) of the 1995 Rules)</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 1977 Act and Rules (this represents rule 36(4)(a)(ii) of the 1995 Rules).</p> <p>Sub-paragraph (b)(i) 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 18(3) (this represents rule 36(4)(a)(i) of the 1995 Rules).</p> <p>Sub-paragraph (b)(ii) also allows amendment up to the point that any amendment is made under sub-paragraph (b)(i), in the circumstances where the first examination report is sent out early e.g. at the same time as the search report, in response to a request for “Combined Search and Examination”. (This represents rule 36(4)(b) of the 1995</p>

		<p>Rules).</p> <p>Paragraphs (5)(a) and (6) allow the conditions on amendment to be waived with the comptroller's consent, and this represents rule 36(6) of the 1995 Rules.</p> <p>Paragraphs (5)(b) and (6) represent rule 35 of the 1995 Rules, and so disapply 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>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, and allows the comptroller not to send any particular observation where it is 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> <p>Paragraphs (4) and (5) replace rule 37(3) of the 1995 Rules.</p>
PART 3 – GRANTED PATENTS		
34	38 amended by SI 1999/3197	<p>There is a new requirement that the certificate of grant must include the number of the patent (which reflects long-standing practice).</p>
35	40 amended by SI 1999/3197, 2003/513 and	<p>Paragraph (1) represents rule 40(1) of the 1995 Rules (amendments made under section 27) but also applies to amendments made under section 75. However, in both cases the requirement for Patents Form 11/77 has been abolished</p>

	<p>2004/2358</p> <p>53(c) 53(ii)</p> <p>77(2)</p> <p>78(1)</p>	<p>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) and rule 78(1) 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>Rule 40(1B) to (5) of the 1995 Rules, which concerned opposition to an amendment under section 27, 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> <p>Rule 78(1A) of the 1995 Rules has not been retained, since it imposed no obligation on either the comptroller or the patent proprietor. Practice will remain unaltered.</p> <p>Rule 78(2) to (5) of the 1995 Rules, which concerned opposition to an amendment under section 75, are now dealt with in Part 7.</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 was confusing).
37	39A inserted by SI 2005/2496	No changes (except that mentioned in relation to rule 36).

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, which concerns opposition to surrender, is dealt with in Part 7.</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 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 Office will be freely open for inspection at all convenient times (see section 32(5)). (The Register is also always available on the Office’s website).</p>
45	50	Only very minor drafting changes have been made.
46	52	Paragraph (1) replaces rule 52(1)(a) of the 1995 Rules , insofar as it relates to the register.

		<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 was almost never requested.</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, mortgagor, etc 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 proceedings) 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 new restriction (which was implicit before), namely that a copy cannot be made where to make or provide that copy</p>

		<p>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). However, 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) r 93 amended by SI 2005/2496	<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>

	and SI 2007/677	<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) ensures all references in the rule to a document apply to any part of a document.</p> <p>Rule 93(4)(c) of the 1995 Rules has not been retained. However, documents accidentally sent to the 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 made to rule 93 of the 1995 Rules by the Patents (Amendment) Rules 2007 on 1 April 2007 is carried across into rule 51. Thus a document may generally 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	This rule has been modernised substantially from rule 94 of

	<p>amended by SI 2005/2496 and SI 2007/677</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.</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, since it was removed by the Patents (Amendment) Rules 2007 on 1 April 2007.</p>
54	92 amended by SI 2005/2496	<p>This rule replaces the ‘caveat’ system 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 was not clear from the drafting of rule 92 of the 1995 Rules and did 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 (the only remaining ones being 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	<p>Paragraphs 1 to 3 of Schedule 4</p> <p>amended by SI 2003/513</p> <p>The Patents (Translation) Rules 2005 (SI 2005/687)</p>	<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. It should be noted that this requirement is disapplied where a translation is filed electronically, by virtue of rule 4(6).</p> <p>Paragraph (4) replaces paragraph 1(4A) of Schedule 4 to the 1995 Rules. As elsewhere, the provision disapplies the formal requirements of paragraph (2), but the comptroller can 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 1995 Rules.</p>
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		<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> <p>Paragraphs (9) and (10) replace and expand upon the Patents (Translation) Rules 2005 (SI 2005/687). They ensure that section 77(6) of the Act, rule 56(1)(a) and rule 56(5) to (8) all cease to have effect on the day that the London Agreement takes effect.</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. It should be noted that this requirement is disapplied where a translation is filed electronically, by virtue of rule 4(6).</p> <p>Paragraph (5) is new. Similarly to rule 56(4), 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 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 drafting has been simplified as the precise provisions of the Conventions/Treaties are not set out in the Rules.</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, are set out to the extent necessary in the Patents (Fees) Rules 2007 (SI 2007/3292).</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 2007/677</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 1977 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 2 months 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</p>

		<p>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 have been 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 applied 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 1977 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</p>

		can be achieved by virtue of either section 117 of the 1977 Act or rule 108 (which replaces rule 110 of the 1995 Rules).
72	85(9)	This rule replaces rule 85(9) of the 1995 Rules . The drafting 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> . This rule also defines various terms which appear in Part 7. A number of the definitions reflect those terms as defined in the Civil Procedure Rules (“ CPR ”).
74		<p>This new rule sets out the comptroller’s overriding objective. The drafting of paragraphs (1) and (2) reflects CPR r. 1.1.</p> <p>Paragraph (3) reflects CPR r. 1.2.</p> <p>Paragraph (4) reflects CPR r. 1.3.</p>

75		<p>This rule requires the comptroller to publish a notice in the journal respect of any action to which a person can object under Part 2 or 3 of Schedule 3.</p>
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 featured 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>
79	112 amended by SI 2007/677	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 being 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

		<p>the comptroller to strike out a claim or statement of case, or 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.</p> <p>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>Rule 89(3) of the 1995 Rules has not been replicated, as it is not necessary under the Tribunals, Courts and Enforcement Act 2007 (c.15).</p>
85	89A inserted by SI 2005/2496	No changes ..
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</p>

		<p>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 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>
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, although the wording is adjusted to be in closer conformity with section 97 of the 1977 Act.</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</p>

		cases.
91	59(2)	<p>Paragraph (1) replaces rule 59(2) of the 1995 Rules.</p> <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	New paragraph (6) makes 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. Other than that, the only change is that set out in relation to rule 92.
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	Paragraph (1) replaces rule 90(1) and (2) of the 1995 Rules . However, the new provision distinguishes between the appointment of an agent at the start of proceedings as opposed to later on, whereas the old provision distinguished

		<p>between appointment of an agent for the first time as opposed to substitution of an agent.</p> <p>Paragraph (2) is a new requirement. It is based on rule 52(1) of the Trade Marks Rules 2000.</p>
102	109	Aside from minor adjustments, the new rule is unchanged from rule 109 of the 1995 Rules .
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. There is no transitional provision in respect of this paragraph, so it applies from 17 December 2007 to all pending patent applications and granted patents, as well as to any applications filed after the new Rules take effect.</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	<p>rule 102 of the 1995 Rules</p> <p>rule 6 of the 1997 SPC Rules</p>	<p>Paragraph (1) gives a person a right to apply to the 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) and (6) replace rule 6 of the 1997 SPC Rules. It should be noted that rule 2 contains the definition of “start date”.</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 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. This rule was generally thought to be 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 now 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.	<p>No changes.</p> <p>Note that rule 97 of the 1995 Rules is not replicated. Under the new Rules, the Office will no longer be able to treat post as having been received earlier than it actually was. The previous “postal deeming” arrangement does not apply to any document posted to the Office in connection with a</p>

		patent or patent application, where that document was posted on or after 17 December.
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(3).
113	113 (1) to (3) amended by SI 2004/2358	<p>Paragraph (1) reflects most of rule 113(1) of the 1995 Rules.</p> <p>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.</p> <p>Paragraph (3) replaces rule 113(2) of the 1995 Rules.</p> <p>Paragraph (4) is new. It sets out explicitly the sanction that is applied where no translation is filed.</p> <p>Paragraphs (5) and (6) replace rule 113(3) of the 1995 Rules and again include an explicit sanction for failure to file a translation of the relevant document.</p> <p>Paragraph (7) is new, and makes clear that the obligation is on the comptroller to obtain a translation into English of any document related to a patent application which is filed in Welsh. This obligation does not, however, extend to documents filed in proceedings before the comptroller – to which rule 82(1)(b) applies.</p> <p>Paragraph (8) clarifies various references made in the new rule.</p>
114	113(4), (5) and (5A) amended by SI 2004/2358 and 2005/2496	<p>Paragraph (1) and (2) replace rule 113(4) of the 1995 Rules.</p> <p>Paragraph (3) replaces rule 113(5) of the 1995 Rules.</p> <p>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.</p>
115	113A inserted by SI 2004/2358	No changes.
116	r 3(2) and r 5 of	Paragraph (1)(a) states that an SPC is applied for on a Form

	the 1997 SPC Rules	<p>SP1. It replaces rule 3(2) of the 1997 SPC Rules.</p> <p>Paragraph (1)(b) states that a paediatric extension to an SPC is applied for on a new Form SP4. The fee that will accompany the form is £200.</p> <p>Paragraphs (2) to (8) replace rule 5 of the 1997 SPC Rules and so set out the regime and procedure for paying the SPC fees. The drafting has been modernised and some more details are now contained in rule 6 of the Patents (Fees) Rules 2007, but no change in practice is intended. It should be noted that rule 2 contains the definition of “start date”.</p> <p>References to “Schedule 4A to the Act” are to the new Schedule concerning SPCs which has been inserted into the 1977 Act by the Patents (Compulsory Licensing and Supplementary Protection Certificates) Regulations 2007 (SI 2007/3293).</p> <p>Rule 3(1) of the 1997 SPC Rules is thought unnecessary in light of the provisions now contained in the Patents (Fees) Rules 2007, 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 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 transitional provisions in Schedule 5 and the revocations in Schedule 6.

SCHEDULE 1 – BIOLOGICAL MATERIAL

1	<p>Para 7 of Schedule 2</p> <p>Substituted by SI 2001/1412</p>	<p>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>It also 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>Para 1(1) of Schedule 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>Para 1(2) to (4) of Schedule 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 1977 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> <p>No provision equivalent to paragraph 1(4) of Schedule 2 to</p>

		<p>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.</p>
4	<p>Para 2(1) to (3) of Schedule 2</p> <p>Substituted by SI 2001/1412</p>	<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	<p>Para 2(4) to (8) of Schedule 2</p> <p>Substituted by SI 2001/1412</p>	<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	<p>Para 3 of Schedule 2</p> <p>Substituted by SI 2001/1412</p>	<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> <p>Sub-paragraph (6) replaces paragraph 4(7) of Schedule 1 to the 1995 Rules.</p>
7	<p>Para 4 of Schedule 2</p> <p>Substituted by SI 2001/1412</p>	<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). 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	<p>Para 5 of Schedule 2</p> <p>Substituted by SI 2001/1412</p>	<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</p>

		<p>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>
<p>SCHEDULE 2 – FORMAL AND OTHER REQUIREMENTS</p>		
1	18(1) and 20(4)	Documents 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	20(9)	This represents the first sentence of rule 20(9) of the 1995 Rules.
5	-	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.
6	20(9)	This represents the second sentence of rule 20(9) of the 1995 Rules.

7	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.
8	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.
9	20(10)	This represents the middle part of rule 20(10) of the 1995 Rules .
10	20(10)	This represents the last part of rule 20(10) of the 1995 Rules .
11	18(1)	This represents the second part of rule 18(1) of the 1995 Rules . The borders have been changed slightly as well.
12	18(2)(g)	This represents the last sentence of rule 18(2)(g) of the 1995 Rules . The rest of this provision is unnecessary.
13	20(5)	This replaces rule 20(5) of the 1995 Rules insofar as it relates to drawings.
14	18(2)(j)	This replaces rule 18(2)(j) of the 1995 Rules .
15	18(2)(a)	This replaces and simplifies rule 18(2)(a) of the 1995 Rules .
16	18(2)(b)	This replaces rule 18(2)(b) of the 1995 Rules .
17	18(2)(c)	This replaces the last sentence of rule 18(2)(c) of the 1995 Rules .
18	18(2)(c)	This provision replaces the first part of rule 18(2)(c) of the 1995 Rules .
19	20(11)	This replaces the first sentence of rule 20(11) of the 1995 Rules .
20	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.
21	18(2)(h)	This replaces the first part of rule 18(2)(h) of the 1995 Rules .

22	20(11)	This replaces the last sentence in rule 20(11) of the 1995 Rules .
23	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 .
24	20(12)	This replaces and simplifies the first part of rule 20(12) of the 1995 Rules . As with the previous provision, it does not rule out the presence of non-standard units, provided equivalent standard international units of measurement are provided.
25	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, references and requests 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(7) and (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(2)).
Part 5		This sets out those further provisions in Part 7 which apply to proceedings for a review of an opinion (see rule 99(6)).
SCHEDULE 4 – EXTENSION OF TIME LIMITS		
Part 1		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) where there are pending proceedings concerning validity elsewhere. As noted under rule 108, rule 110(2) of, and Part 2 of

		Schedule 4A to, the 1995 Rules are now redundant.
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 – TRANSITIONAL PROVISIONS		
1	-	None.
2	121(4)	This is a similar provision to that found in rule 121(4) of the 1995 Rules . Any time period set under the 1995 Rules continues to run its course after the 2007 Rules have taken effect.
3	-	Proceedings before the comptroller were launched under the 1995 Rules, and which are pending at the time the 2007 Rules take effect, are deemed (subject to paragraph 2) to continue in accordance with Part 7.
4	-	The effect of rule 97 of the 1995 Rules (“postal deeming”) is maintained for any document posted in the UK to the Office before 17 December 2007.
5	r. 20 Patents (Amendment) Rules 2004	This provision replaces transitional arrangements set out in rule 20 of the Patents (Amendment) Rules 2004 (SI 2004/2358)
6	r. 25 Patents (Amendment) Rules 2005	This provision replaces transitional arrangements set out in rule 25 of the Patents (Amendment) Rules 2005 (SI 2005/2496)
7	Para 6 of Schedule 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 and 10	r. 124 Patents Rules 1978	These provisions replaces part of rule 124 of the Patents Rules 1978 and cater (to the extent now necessary) for patents and applications under the Patents Act 1949.
11		This provision sets out transitional arrangements relating to rules 9 and 13 of the 1995 Rules and which were previously set out in Article 9(2) of the Patents Act 2004 (Commencement No. 2 and Consequential, etc and Transitional Provisions) Order 2004 (SI 2004/3205).

<i>Rule number in 1995 Rules</i>	<i>Corresponding provision in 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

<i>Rule number in 1995 Rules</i>	<i>Corresponding provision in 2007 Rules</i>
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

<i>Rule number in 1995 Rules</i>	<i>Corresponding provision in 2007 Rules</i>
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

<i>Rule number in 1995 Rules</i>	<i>Corresponding provision in 2007 Rules</i>
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	35 and Part 7
79	Revoked

<i>Rule number in 1995 Rules</i>	<i>Corresponding provision in 2007 Rules</i>
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

<i>Rule number in 1995 Rules</i>	<i>Corresponding provision in 2007 Rules</i>
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

<i>Rule number in 1995 Rules</i>	<i>Corresponding provision in 2007 Rules</i>
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 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