
STATUTORY INSTRUMENTS

1990 No. 2384

The Patents Rules 1990

PRELIMINARY

Citation and commencement

1. These Rules may be cited as the Patents Rules 1990 and shall come into force on 7th January 1991.

Interpretation

2. In these Rules—

“the Act” means the Patents Act 1977;

“the 1949 Act” means the Patents Act 1949(1);

“declared priority date” means—

- (a) the date of filing of the earliest relevant application specified in a declaration made for the purposes of section 5 where the priority date claimed in the declaration has not been lost or abandoned and where the declaration has not been withdrawn before preparations for the publication of the application in suit have been completed by the Patent Office in accordance with section 16;
- (b) the date of filing of any such application for a patent as is referred to in section 127(4) which is specified in a declaration made for the purposes of that section;
- (c) where an application for a European patent (UK) is, by virtue of section 81(1), to be treated as an application for a patent under the Act, the date of filing of the earliest previous application mentioned in the declaration of for a European patent (UK) under Article 88(1) of the European Patent Convention where the priority date claimed in the declaration has not been lost or abandoned and where the declaration has not been withdrawn before the comptroller directs that the application for a European patent (UK) shall be so treated; or
- (d) where an international application for a patent (UK) is to be treated as an application for a patent under the Act, the date of filing of the earliest application filed in or for a State which is a party to the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 the priority of which is claimed in a declaration filed for the purposes of Article 8 of the Patent Co-operation Treaty, provided that such priority claim has not been lost or abandoned under the provisions of that Treaty;

“Journal” means the Official Journal (Patents) published in accordance with rule 115.

Construction

3. In these Rules, save where otherwise indicated—

- (a) references to a section are references to that section of the Act;

(1) 1949 c. 87.

- (b) references to a rule are references to that rule in these Rules;
- (c) references to a Schedule are references to that Schedule to these Rules;
- (d) references to a form are references to that form as set out in Schedule 1;

and references to the filing of a form or other document are references to filing it at the Patent Office.

Forms

4.—(1) The forms of which the use is required by these Rules (except the forms mentioned in rule 123(1)) are those set out in Schedule 1.

(2) A requirement under these Rules to use such a form is satisfied by the use either of a replica of that form or of a form which is acceptable to the comptroller and contains the information required by the form set out in that Schedule.

International exhibitions

5.—(1) An applicant for a patent who wishes the disclosure of matter constituting an invention to be disregarded in accordance with section 2(4)(c) shall, at the time of filing the application for the patent, inform the comptroller in writing that the invention has been displayed at an international exhibition.

(2) The applicant shall, within four months of filing the application, file a certificate, issued at the exhibition by the authority responsible for the exhibition, stating that the invention was in fact exhibited there. The certificate shall also state the opening date of the exhibition and, where the first disclosure of the invention did not take place on the opening date, the date of the first disclosure. The certificate shall be accompanied by an identification of the invention, duly authenticated by the authority.

(3) For the purposes of section 130(2) a statement may be published in the Journal that an exhibition described in the statement falls within the definition of international exhibition in subsection (1) of that section.

(4) In the case of an international application for a patent (UK), the application of this rule shall be subject to the provisions of rule 85(3).

Declaration of priority for the purposes of section 5

6.—(1) A declaration for the purposes of section 5 shall be made at the time of filing the application for a patent (“the application in suit”) and shall state the date of filing of any application specified in the declaration and the country in or for which it was made.

(2) Subject to the provisions of rule 26 and paragraphs (3), (4) and (5) below, where the application in suit is for a patent under the Act, the applicant shall, within the period of sixteen months after the declared priority date, furnish to the Patent Office in respect of every application specified in the declaration—

- (a) its file number; and
- (b) except where paragraph (3) below has effect, a copy of that application duly certified by the authority with which it was filed or otherwise verified to the satisfaction of the comptroller.

(3) Where an application specified in the declaration is an application for a patent under the Act or an international application for a patent which is filed at the Patent Office,—

- (a) if the application is filed under section 15(4), the applicant shall, at the time of filing the application, file—

- (i) a request that a copy of the application specified in the declaration be prepared for use in the Patent Office; and
 - (ii) Patents Form 24/77 requesting the comptroller to certify the same; or
- (b) if the application is filed otherwise than under section 15(4), the applicant shall file that request and that form in compliance with any request made by the comptroller.
- (4) Where the application in suit is an application for a European patent (UK) which, by virtue of section 81, is to be treated as an application for a patent under the Act, the requirements of paragraphs (1) and (2) above shall be treated as having been complied with to the extent that the requirements of rule 38(1) to (3) of the Implementing Regulations to the European Patent Convention have been fulfilled.
- (5) Where the application in suit is an international application for a patent (UK) which is to be treated as an application for a patent under the Act, the requirements of paragraphs (1) and (2) above shall be treated as having been complied with to the extent that the requirements of rules 4.10(a) and (c) and 17.1(a) or (b) of the Regulations made under the Patent Co-operation Treaty have been fulfilled.
- (6) Where a copy of an application is filed or treated as having been filed under paragraph (2) (b), (3), (4) or (5) above and that application is in a language other than English, subject to rule 85(3)(c) and (d), a translation thereof into English verified to the satisfaction of the comptroller as corresponding to the original text shall be filed within the period of twenty-one months after the declared priority date.
- (7) In the case of an international application for a patent (UK), the application of paragraph (6) above shall be subject to the provisions of rule 85(3)(c) and (d).

RIGHT TO APPLY FOR AND OBTAIN A PATENT

References under section 8(1)(a) or 12(1)(a)

7.—(1) A reference under section 8(1)(a) or 12(1)(a) shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the nature of the question, the facts upon which the person making the reference relies and the order or other relief which he is seeking.

- (2) The comptroller shall send a copy of the reference and statement to—
- (a) any person (other than the person referred to in paragraph (1) above) alleged in the reference to be entitled to be granted a patent for the invention;
 - (b) any person, not being a party to the reference, who is shown in the register as having a right in or under the patent application;
 - (c) where the application for the patent has not been published, any person (not being a party to the reference) who is an applicant for the patent or has given notice to the comptroller of a relevant transaction, instrument or event; and
 - (d) every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention.

(3) If any person who is sent a copy of the reference and statement under paragraph (2) above wishes to oppose the making of the order or the granting of the relief sought, he (“the opponent”) shall, within the period of two months beginning on the date the copies are sent to him, file in duplicate a counter-statement setting out fully the grounds of his opposition and the comptroller shall send a copy of the counter-statement to the person making the reference and to those recipients of the copy of the reference and statement who are not party to the counter-statement.

(4) The person making the reference or any such recipient may, within the period of two months beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence,—

- (a) in any case, to the opponent; and
- (b) in the case of evidence filed by such a recipient, to the person making the reference.

(5) Within the period of two months beginning on the date when the copy of such evidence is sent to him or, if no such evidence is filed, within two months of the expiration of the time within which it might have been filed, the opponent may file evidence in support of his case and shall send a copy of the evidence so filed to the person making the reference and those recipients; and within the period of two months beginning on the date when the copy of the opponent's evidence is sent to him, that person or any of those recipients may file further evidence confined to matters strictly in reply and shall send a copy of it to the persons mentioned in subparagraphs (a) and (b) of paragraph (4) above.

(6) No further evidence shall be filed except by leave or direction of the comptroller.

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

References by co-proprietors under section 8(1)(b) or 12(1)(b)

8.—(1) A reference under section 8(1)(b) or 12(1)(b) shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the nature of the question, the facts relied upon by the co-proprietor making the reference and the order which he is seeking.

(2) The comptroller shall send a copy of the reference and statement to—

- (a) each co-proprietor who is not a party to the reference and who has not otherwise indicated his consent to the making of the order sought;
- (b) any person to whom it is alleged in the reference that any right in or under an application for a patent should be transferred or granted;
- (c) any person, not being a party to the reference, who is shown in the register as having a right in or under the patent application;
- (d) where the application for the patent has not been published, any person (not being a party to the reference) who has given notice to the comptroller of a relevant transaction, instrument or event; and
- (e) every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention.

(3) Any person who receives a copy of the reference and statement and who wishes to oppose the order sought may, within the period of two months beginning on the date when the copies are sent to him, file a counter-statement in duplicate setting out fully the grounds of his opposition.

(4) The comptroller shall, as appropriate, send a copy of any counter-statement to—

- (a) each co-proprietor who is a party to the reference; and
- (b) any person to whom a copy of the reference and statement were sent pursuant to paragraph (2) above.

(5) Any person who receives a copy of the counter-statement may, within the period of two months beginning on the date when the copy is sent to him, file evidence in support of his case and shall send a copy of the evidence so filed to the co-proprietor making the reference and to each person who has filed a counter-statement.

(6) Any person entitled to receive a copy of the evidence filed under paragraph (5) above may, within the period of two months beginning on the date when the copy is sent to him or, if no such evidence is filed, within two months of the expiration of the period within which it might have been filed, file evidence in support of his case and shall send a copy of the evidence so filed to each of the other parties listed in paragraph (4) above.

(7) Any person who receives a copy of the evidence filed under paragraph (6) above may, within the period of two months of the date when the copy is sent to him, file further evidence confined to matters strictly in reply and shall as appropriate send a copy of the evidence so filed to the parties listed in paragraph (4) above.

(8) No further evidence shall be filed by any party except by leave or direction of the comptroller.

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

Orders under section 8 or 12

9.—(1) Where an order is made under section 8 or section 12 that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant, the comptroller shall notify all original applicants and their licensees of whom he is aware of the making of the order.

(2) A person notified under paragraph (1) above may make a request under section 11(3) or under that section as applied by section 12(5),—

- (a) in the case of a request by the original applicant or any of the original applicants, within the period of two months beginning on the date when the notification is sent to him; or
- (b) in the case of a request by a licensee, within the period of four months beginning on the date when the notification is sent to him.

Prescribed period for new applications under section 8(3) or 12(6)

10. The prescribed period for the purposes of sections 8(3) and 12(6) shall be three months calculated from the day on which the time for appealing from an order made under either of those subsections expires without an appeal being brought or, where an appeal is brought, from the day on which it is finally disposed of.

Authorisation under section 8(5)

11.—(1) An application under section 8(5) for authority to do anything on behalf of a person to whom directions have been given under section 8(2)(d) or (4) shall be made on Patents Form 3/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts upon which the applicant relies and the nature of the authorisation sought.

(2) The comptroller shall send a copy of the application and statement to the person alleged to have failed to comply with the directions.

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

Request by joint applicant under section 10 or 12(4)

12.—(1) A request under section 10 or section 12(4) by a joint applicant shall be made on Patents Form 4/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts upon which he relies and the directions which he seeks.

(2) The comptroller shall send a copy of the request and statement to each other joint applicant who shall, if he wishes to oppose the request, within the period of two months beginning on the date

when such copies are sent to him, file in duplicate a counter-statement setting out fully the grounds of his opposition; and the comptroller shall send a copy of the counter-statement to the person making the request and to each other joint applicant who is not party to the counter-statement.

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

Referral to the comptroller under section 11(5)

13.—(1) Where, following the making of such an order as is mentioned in section 11(2), a question is referred to the comptroller under subsection (5) of section 11 or that subsection as applied by section 12(5) as to whether any person is entitled to be granted a licence or whether the period or terms of a licence are reasonable, the reference shall be made on Patents Form 5/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts upon which the person making the reference relies and the terms of the licence which he is prepared to accept or grant.

(2) The comptroller shall send a copy of the reference and statement to every person in whose name the application is to proceed or, as the case may be, every person claiming to be entitled to be granted a licence, in either case not being the person who makes the reference, and if any recipient does not agree to grant or accept a licence for such period and upon such terms, he shall, within the period of two months beginning on the date when the copies are sent to him, file a counter-statement in duplicate setting out fully the grounds of his objection and the comptroller shall send a copy of the counter-statement to the person making the reference.

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

INVENTORS

Mention of inventor under section 13

14.—(1) An application to the comptroller under section 13(1) or (3) by any person who alleges—

- (a) that he ought to have been mentioned as the inventor or joint inventor of an invention in any patent granted or published application for a patent for the invention; or
- (b) that any person mentioned as sole or joint inventor in any patent granted or published application for the invention ought not to have been so mentioned,

shall be made on Patents Form 6/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts relied upon.

(2) The comptroller shall send a copy of any such application and statement to—

- (a) every person registered as proprietor of, or applicant for, the patent (other than the applicant under section 13 himself);
- (b) every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention; and
- (c) every other person whose interests the comptroller considers may be affected by the application.

(3) Any recipient of such a copy of an application and statement who wishes to oppose the application shall, within the period of two months beginning on the date when the copies are sent to him, file a counter-statement in duplicate setting out fully the grounds of his objection and the comptroller shall send a copy of the counter-statement to each of the persons described in this rule other than any person who is party to the counter-statement.

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

(5) The document prescribed for the purposes of section 13(1) shall be an addendum or erratum slip.

Procedure where applicant is not the inventor or sole inventor

15.—(1) Subject to the provisions of rules 26, 81(3), 82(3) and 85(7)(a), if the applicant or applicants are not the inventor or inventors, a statement under section 13(2) identifying the inventor or inventors and, where required by section 13(2)(b), the derivation of the right of the applicant or applicants to be granted the patent shall be made on Patents Form 7/77, within the period of sixteen months after the declared priority date or, where there is no declared priority date, the date of filing the application.

(2) Where the applicant is not the sole inventor or the applicants are not the joint inventors of the invention the subject of the application and the application does not contain a declared priority date which relates to an earlier relevant application as defined in section 5(5)(b), a sufficient number of copies of Patents Form 7/77 shall be filed by the applicant or applicants within the said period to enable the comptroller to send one to each inventor who is not one of the applicants.

(3) Where the application is an application for a European patent (UK) which by virtue of section 81 is to be treated as an application for a patent under the Act, the requirements of paragraphs (1) and (2) above shall be treated as having been complied with to the extent that the requirements of rule 17 of the Implementing Regulations to the European Patent Convention have been fulfilled.

(4) Where the application is an international application for a patent (UK), the requirements of paragraphs (1) and (2) above shall be treated as having been complied with if the provisions of rules 4.1(a)(v) and 4.6 of the Regulations made under the Patent Co-operation Treaty have been complied with, whether or not there was any requirement that they be complied with.

APPLICATIONS FOR PATENTS

Applications for the grant of patents under sections 14 and 15

16.—(1) A request for the grant of a patent shall be made on Patents Form 1/77.

(2) The specification contained in an application for a patent made under section 14 shall state the title of the invention and continue with the description and the claim or claims and drawings, if any, in that order.

(3) The title shall be short and indicate the matter to which the invention relates.

(4) The description shall include a list briefly describing the figures in the drawings, if any.

Micro-organisms

17. Schedule 2 shall have effect in relation to certain applications for patents, and patents, for inventions which require for their performance the use of micro-organisms.

Drawings

18.—(1) Drawings forming part of an application for a patent made under section 14 shall be on sheets the usable surface area of which shall not exceed 26.2 cm by 17 cm. The sheets shall not contain frames round the usable or used surface. The minimum margins shall be as follows—

top	2.5 cm
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left side	2.5 cm
right side	1.5 cm
bottom	1.0 cm

- (2) Drawings shall be executed as follows—
- (a) without colouring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;
 - (b) cross-sections shall be indicated by hatching which does not impede the clear reading of the reference signs and leading lines;
 - (c) the scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty. If, as an exception, the scale is given on a drawing, it shall be represented graphically;
 - (d) all numbers, letters, and reference signs, appearing on the drawings shall be simple and clear and brackets, circles and inverted commas shall not be used in association with numbers and letters;
 - (e) elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;
 - (f) the height of the numbers and letters shall not be less than 0.32 cm and for the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used;
 - (g) the same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures. The different figures shall be arranged without wasting space, clearly separated from one another. The different figures shall be numbered consecutively in arabic numerals, independently of the numbering of the sheets;
 - (h) reference signs not mentioned in the description or claims shall not appear in the drawings, and vice versa. The same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs;
 - (i) the drawings shall not contain textual matter, except, when required for the understanding of the drawings, a single word or words such as “water”, “steam”, “open”, “closed”, “section on AA”, and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords; and
 - (j) the sheets of the drawings shall be numbered in accordance with rule 20(9).
- (3) Flow sheets and diagrams shall be considered to be drawings for the purposes of these Rules.

The abstract

19.—(1) The abstract shall commence with a title for the invention.

(2) The abstract shall contain a concise summary of the matter contained in the specification. The summary shall indicate the technical field to which the invention belongs and be drafted in a way which allows a clear understanding of the technical problem to which the invention relates, the gist of the solution to that problem through the invention and the principal use or uses of the invention. Where appropriate, the abstract shall also contain the chemical formula which, among those contained in the specification, best characterises the invention. It shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(3) The abstract shall normally not contain more than 150 words.

(4) If the specification contains any drawings, the applicant shall indicate on the abstract the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when published. The comptroller may decide to publish one or more other figures if he considers that they better characterise the invention. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.

(5) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.

Size and presentation of documents

20.—(1) All documents (including drawings) making up an application for a patent or replacing such documents shall be in the English language.

(2) The specification, abstract and any replacement sheet thereof shall be filed in duplicate.

(3) All documents referred to in paragraph (1) above shall be so presented as to permit of direct reproduction by photography, electrostatic processes, photo offset and micro-filming, in an unlimited number of copies. All sheets shall be free from cracks, creases and folds. Only one side of the sheet shall be used, except in the case of a request for the grant of a patent.

(4) All documents referred to in paragraph (1) above shall be on A4 paper (29.7 cm × 721 cm) which shall be pliable, strong, white, smooth, matt and durable. Each sheet (other than drawings) shall be used with its short sides at the top and bottom (upright position).

(5) The request for the grant of a patent and the description, claims, drawings and abstract shall each commence on a new sheet. The sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.

(6) Subject to rule 18(1), the minimum margins shall be as follows:

top	2.0 cm
left side	2.5 cm
right side	2.0 cm
bottom	2.0 cm

(7) The margins of the documents making up the application and of any replacement documents must be completely blank.

(8) In the application, except in the drawings—

(a) all sheets in the request shall be numbered consecutively; and

(b) all other sheets shall be numbered consecutively as a separate series,

and all such numbering shall be in arabic numerals placed at the top of the sheet, in the middle, but not in the top margin.

(9) All sheets of drawings contained in the application shall be numbered consecutively as a separate series. Such numbering shall be in arabic numerals placed at the top of the sheet, in the middle, but not in the top margin.

(10) Every document (other than drawings) referred to in paragraph (1) above shall be typed or printed in a dark, indelible colour in at least 1 1/2 line spacing and in characters of which the capital letters are not less than 0.21 cm high: Provided that Patents Form 1/77 may be completed in writing, and that graphic symbols and characters and chemical and mathematical formulae may be written or drawn, in a dark indelible colour.

(11) The request for the grant of a patent, the description, the claims and the abstract shall not contain drawings. The description, the claims and the abstract may contain chemical or mathematical formulae. The description and the abstract may contain tables. The claims may contain tables only if their subject-matter makes the use of tables desirable.

(12) In all documents referred to in paragraph (1) above units of weight and measures shall be expressed in terms of the metric system. If a different system is used they shall also be expressed in terms of the metric system. Temperatures shall be expressed in degrees Celsius. For the other physical values, the units recognised in international practice shall be used, for mathematical formulae the symbols in general use, and for chemical formulae the symbols, atomic weights and molecular formulae in general use shall be employed. In general, use should be made of technical terms, signs and symbols generally accepted in the field in question.

(13) If a formula or symbol is used in the specification a copy thereof, prepared in the same manner as drawings, shall be furnished if the comptroller so directs.

(14) The terminology and the signs shall be consistent throughout the application.

(15) All documents referred to in paragraph (1) above shall be reasonably free from deletions and other alterations, overwritings and interlineations and shall, in any event, be legible.

Form of statements, counter-statements and evidence

21. Any statement, counter-statement or evidence filed shall, unless the comptroller otherwise directs, comply with the requirements of rule 20(1) and (4) and, except that both sides of the sheet may be used in the case of statutory declarations and affidavits, with the requirements of rule 20(3).

Claims in different categories

22. Without prejudice to the generality of section 14(5)(d), an application for a patent which includes,—

- (a) in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for a use of the product;
- (b) in addition to an independent claim for a process, an independent claim for an apparatus or means specifically designed for carrying out the process; or
- (c) in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for an apparatus or means specifically designed for carrying out the process,

shall be treated as relating to a group of inventions which are so linked as to form a single inventive concept.

Late filed drawings

23. The period prescribed for the purposes of section 15(2) and (3) shall be one month calculated from the date on which the comptroller sends out notification to the applicant that the drawing has been filed later than the date which is, by virtue of section 15(1), to be treated as the date of filing the application or, as the case may be, that it has not been filed.

New applications under section 15(4)

24.—(1) Subject to paragraph (2) below, a new application for a patent, which includes a request that it shall be treated as having as its date of filing the date of filing of an earlier application, may be filed in accordance with section 15(4) not later than the latest of—

- (a) the beginning of the sixth month before the end of the period ascertained under rule 34 in relation to the earlier application as altered, if that be the case, under rule 100 or rule 110 (“the rule 34 period”);
- (b) where the earlier application is amended as provided by section 18(3) so as to comply with section 14(5)(d), the expiry of the period of two months beginning on the day that the amendment is filed; and
- (c) where the first report of the examiner under section 18 is made under subsection (3), the expiry of the period specified for reply to that report:

Provided that, where the first report of the examiner under section 18 is made under subsection (4) and the comptroller notifies the applicant that the earlier application complies with the requirements of the Act and these Rules, notwithstanding the foregoing provisions of this paragraph but subject to paragraph (2) below, a new application may be filed not later than the expiry of the period of two months beginning on the day that the notification is sent.

(2) Where any of the following dates falls before the date ascertained under paragraph (1) above, a new application may only be filed before that date instead of the date so ascertained—

- (a) the date when the earlier application is refused, is withdrawn, is treated as having been withdrawn or is taken to be withdrawn;
- (b) the expiry of the rule 34 period ascertained in relation to the earlier application; and
- (c) the date when a patent is granted on the earlier application.

(3) Where possible, the description and drawings of the earlier application and the new application shall respectively relate only to the matter for which protection is sought by that application. However, when it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a reference by number to that other application and shall indicate the matter for which protection is claimed in the other application.

Periods prescribed under section 15(5)(a) and (b) and 17(1) for filing claims, abstract and request for preliminary examination and search

25.—(1) The period prescribed for the purposes of section 15(5)(a) shall be,—

- (a) if the application contains no declared priority date, the period of twelve months calculated from its date of filing; or
- (b) if the application does contain a declared priority date, the last to expire of the period of twelve months calculated from the declared priority date and the period of one month calculated from the date of filing the application.

(2) Subject to the provisions of rules 81(3), 82(3) and 85(7)(a), the period prescribed for the purposes of sections 15(5)(b) and 17(1) shall be,—

- (a) if the application contains no declared priority date, the period of twelve months calculated from its date of filing; or
- (b) if the application does contain a declared priority date, the period of twelve months calculated from the declared priority date.

(3) Where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) after the end of the period prescribed in paragraph (1) or (2) above, as the case may be, the period prescribed for the purposes of sections 15(5) and 17(1) shall be the period which expires on the actual date of filing of the new application.

Extensions for new applications

26.—(1) Where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) after the period of sixteen months prescribed in either rule 6 or rule 15, then, subject to the following provisions of this rule,—

- (a) the requirements of those rules shall be complied with at the time of filing the new application; and
 - (b) the requirements of paragraph 1(2)(a)(ii) and (3) of Schedule 2, in a case to which they apply, shall be complied with not later than the later of the time ascertained under the said paragraph 1(3) and the time of filing the new application.
- (2) Where a new application is filed under any of those sections—
- (a) within the period prescribed in paragraph (6) of rule 6 as modified, in the case of an international application, by rule 85(3), the requirement of that paragraph shall have effect as provided therein; or
 - (b) after that period, the requirements of that paragraph shall be complied with at the time of filing,

subject, in either case, to paragraph (3) below.

- (3) Where a new application is filed under section 15(4) after—
- (a) the period of sixteen months prescribed in rule 6(2) or rule 15(1); or
 - (b) the period prescribed in rule 6(6) as modified, in the case of an international application, by rule 85(3),

but within an extension of that period under rule 110(3) or (4) in respect of the earlier application, the requirements of rule 6(2) and (3), rule 6(6) or rule 15, as the case may be, shall be complied with before the end of the extended period.

Period for publication of application

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

EXAMINATION AND SEARCH

Preliminary examination and search under section 17

28.—(1) A request under section 17(1)(a) for a preliminary examination and search shall be made on Patents Form 9/77.

(2) On a preliminary examination the examiner shall determine, not only whether the application (“the application in suit”) complies with those requirements of the Act and these Rules which are designated by rule 31 as formal requirements for the purposes of the Act, but also whether the requirements of rules 6(1) and (2) and 15(1) and the provisions of section 15(3) have been complied with.

(3) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part thereof) referred to in the examiner’s report under section 17(5).

Procedure where earlier application made

29. Where the preliminary examination under rule 28 reveals that an earlier relevant application declared for the purposes of section 5 has been stated in the application in suit to have a date of filing

more than twelve months before the date of filing of the application in suit, the Patent Office shall notify the applicant that the earlier relevant application will be disregarded unless, within one month, he supplies the Patent Office with a corrected date, being one which falls within those twelve months.

Address for service

30. Every person concerned in any proceedings to which these Rules relate and every proprietor of a patent shall furnish to the comptroller an address for service in the United Kingdom; and that address may be treated for all purposes connected with such proceedings or patent (as appropriate) as the address of the person concerned in the proceedings or of the proprietor of the patent.

Formal requirements

31.—(1) The requirements of rules 16(1), 18(1) and (2) (other than those contained in paragraph (2)(h)), 20 (other than those contained in the last sentence of paragraph (11) and in paragraphs (12) and (14)) and 30 shall be formal requirements for the purposes of the Act.

(2) Where the application is—

- (a) an application for a European patent (UK); or
- (b) an international application for a patent (UK)

which, by virtue of section 81 or 89, as the case may be, is to be treated as an application for a patent under the Act, the said requirements of rules 16(1), 18(1) and (2) and 20 shall be treated as having been complied with to the extent that the requirements of the corresponding provisions of the Implementing Regulations to the European Patent Convention or, as the case may be, of the Regulations made under the Patent Co-operation Treaty, have been fulfilled.

Searches under section 17(6) and (8)

32.—(1) Where an examiner conducts a search under section 17(6) in relation to the first only of two or more inventions specified in the claims of an application, the Patent Office shall notify the applicant of that fact.

(2) If the applicant desires a search to be conducted under section 17(6) in relation to a second or subsequent invention specified in the claims, he shall, before the expiry of the period specified for the making of observations on the report made under section 18(3), request the Patent Office on Patents Form 9/77 to conduct such a search and pay the search fee for each invention in respect of which the search is to be made.

(3) The fee for a supplementary search under section 17(8) shall be accompanied by Patents Form 9/77.

(4) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part thereof) referred to in the examiner's report under section 17 pursuant to subsection (6) or (8) thereof.

Request for substantive examination under section 18

33.—(1) A request for a substantive examination of an application for a patent shall be made on Patents Form 10/77.

(2) Subject to the provisions of rules 83(1), 85(7)(b) and paragraphs (3) and (4) below, the request shall be made and the fee for the examination paid within six months of the date of publication of the application in accordance with section 16.

(3) Where an application is subject to directions under section 22(1) or (2), the request shall be made and the fee paid within two years of the declared priority date or, where there is no declared priority date, from the date of filing the application except in the case of a new application made

under section 8(3), 12(6) or 15(4) after the expiry of the said two years, when the request shall be made and the fee paid at the time of filing the new application.

(4) When he gives the applicant the opportunity under section 18(3) to make observations on the examiner's report under subsection (2) of that section, the comptroller may, if he thinks fit, send to the applicant a copy of any document (or part thereof) referred to in the report.

(5) Where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) then,—

- (a) if the new application is filed within two years calculated from the declared priority date or, where there is no declared priority date, from the date treated as its date of filing, the request shall be made and the fee for the examination paid within those two years; and
- (b) if the new application is filed after the expiration of those two years, the request shall be made and the fee for the examination paid at the time of filing the new application.

Period for putting application in order

34.—(1) Subject to the provisions of paragraph (2) below and of rule 83(3), for the purposes of sections 18(4) and 20(1), the period within which an application for a patent shall comply with the Act and these Rules,—

- (a) subject to the following provisions of this paragraph, shall be the period of four years and six months calculated from its declared priority date or, where there is no declared priority date, from the date of filing of the application; and
- (b) in the case of an application under section 8(3), 12(6) or 37(4), shall be—
 - (i) the period of four years and six months calculated from the declared priority date for the earlier application or, where there is no such declared priority date, the date of filing of the earlier application; or
 - (ii) the period of eighteen months calculated from the actual date of filing of the application,
 whichever expires the later.

(2) In a case where,—

- (a) before or after these Rules come into force, a third party makes observations under section 21 on an application;
- (b) the examiner, for the first time in a report under section 18(3), relies upon the substance of those observations to report that the patentability requirements of the Act are not met; and
- (b) following that report, and within the last three months of the period ascertained under paragraph (1) above (including any alteration thereof under rule 100 or rule 110 or an alteration thereof previously made under this paragraph) but after these Rules come into force, the comptroller gives the applicant the opportunity under section 18(3) to make observations on the report and to amend the application,

the period within which an application for a patent shall comply with the Act and these Rules shall expire at the end of the period of three months beginning on the date when the comptroller sends notification to the applicant of that opportunity.

Amendment of request for grant

35. Subject to rule 45(3), an application for amendment of the request for the grant of a patent shall be made on Patents Form 11/77 and shall be accompanied by a document clearly identifying the proposed amendment.

Amendment of application before grant

36.—(1) Unless the comptroller so requires, the applicant may not amend the description, claims and drawings contained in his application before the comptroller sends to the applicant the examiner's report under section 17(5).

(2) An applicant may of his own volition amend his application in accordance with the following provisions of this rule but not otherwise.

(3) After the comptroller has sent to the applicant the examiner's report under section 17(5) and before he sends to the applicant the first report of the examiner under section 18, the applicant may of his own volition amend the description, claims and drawings contained in his application.

(4) After the applicant has been sent the first report of the examiner under section 18, in addition to his right under section 18(3) to amend the application so as to comply with the requirements of the Act and these Rules, the applicant may of his own volition amend once the description, claims or drawings of the application: provided that, if the examiner's first report is made under section 18(3), the amendment shall be filed at the same time as the applicant replies to that report or, if the examiner's first report is made under section 18(4), the amendment shall be filed within two months of that report being sent to the applicant.

(5) Any further amendment to the description, claims or drawings which the applicant desires to make of his own volition may only be made with the consent of the comptroller following the filing of Patents Form 11/77 accompanied by a document clearly identifying the proposed amendment.

Observations on patentability under section 21

37.—(1) Subject to paragraph (2) below, the comptroller shall send to the applicant a copy of—

- (a) any document containing observations which he receives under section 21 in connection with the application; and
- (b) any document referred to in any such observations being a document which he receives from the person making them.

(2) Nothing in paragraph (1) above shall impose any duty on the comptroller in relation to any document—

- (a) a copy of which it appears to the comptroller is readily available for retention by the applicant; or
- (b) which in his opinion is not suitable for photocopying, whether on account of size or for any other reason.

(3) If the period ascertained under rule 34 (as altered, if that be the case, under rule 100 or rule 110) has not expired and the comptroller has not sent to the applicant notice in accordance with section 18(4) that the application complies with the requirements of the Act and these Rules, the observations shall be referred to the examiner conducting a substantive examination of the application under section 18; and the examiner shall consider and comment upon them as he thinks fit in his report under that section.

GRANT, AMENDMENT AND CONTINUATION OF PATENT

Certificates of grant

38. A certificate that a patent has been granted shall be in the form set out in Schedule 3.

Renewal of patents

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

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

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

Provided that, where any renewal fee is due on, or within the period of three months after, the date of publication in the European Patent Bulletin of the mention of the grant of the patent, being a date on or after that on which these Rules come into force, that renewal fee may be paid within those three months; but, where the date of such publication is before that on which these Rules come into force, the proviso to rule 39(2) of the Patents Rules 1982(2) shall continue to apply.

(3) On receipt of the prescribed renewal fee accompanied by Patents Form 12/77 duly completed, the comptroller shall (if the patent has been granted) issue a certificate of payment on the appropriate portion of that form.

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

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

- (a) the address in the United Kingdom specified by the proprietor on payment of the last renewal fee; or
- (b) where another address in the United Kingdom has been notified to him for that purpose by the proprietor since the last renewal, that address,

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

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

Amendment of specification after grant

40.—(1) An application to the comptroller for leave to amend the specification of a patent shall be made on Patents Form 14/77 and shall be advertised by publication of the Journal and in such other manner, if any, as the comptroller may direct.

(2) Any person wishing to oppose the application to amend shall, within two months from the date of the advertisement in the Journal, give notice to the comptroller on Patents Form 15/77.

(2) [S.I. 1982/717](#) to which there are no relevant amendments.

(3) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and of the statement to the applicant.

(4) Within the period of two months beginning on the date when such copies are sent to him, the applicant shall, if he wishes to continue with the application, file a counter-statement in duplicate setting out fully the grounds upon which the opposition is resisted; and the comptroller shall send a copy of the counter-statement to the opponent.

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

(6) An application under this rule shall be accompanied by—

- (a) a copy of the specification as published on which the proposed amendment is clearly identified;
- (b) if the specification as published is not in English, a document containing a translation into English of the part of the specification proposed to be amended and a translation into English of the part as proposed to be amended verified to the satisfaction of the comptroller as corresponding to the original text; and
- (c) in the case of an application for amendment of a European patent (UK), a copy of the specification for that patent as published,

and, if the specification as published is not in English, the applicant shall, if the comptroller so requests, supply a translation thereof into English verified to his satisfaction as corresponding to the original text.

(7) Where leave to amend a specification is given, the applicant shall, if the comptroller so requires, and within a time to be fixed by him, file a new specification as amended, which shall be prepared in accordance with rules 16, 18 and 20.

Restoration of lapsed patents under section 28

41.—(1) An application under section 28 for the restoration of a patent, including an application for restoration of a patent which lapsed not more than twelve months before these Rules came into force (being in any case a patent which has lapsed by reason of a failure to pay any renewal fee),—

- (a) may be made at any time within the period of nineteen months beginning on the day on which it ceased to have effect; and
- (b) shall be made on Patents Form 16/77 supported by evidence of the statements made in it;

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

(2) If, upon consideration of the evidence, the comptroller is not satisfied that a case for an order under section 28 has been made out, he shall notify the applicant accordingly and, unless within one month the applicant requests to be heard in the matter, the comptroller shall refuse the application.

(3) If the applicant requests a hearing within the time allowed, the comptroller shall, after giving the applicant an opportunity of being heard, determine whether the application shall be allowed or refused.

(4) If the comptroller decides to allow the application, he shall notify the applicant accordingly and require him, within two months after the notification is sent to him, to file Patents Form 17/77, together with Patents Form 12/77, duly completed, and the amount of any unpaid renewal fee, upon receipt of which the comptroller shall order the restoration of the patent and advertise the fact in the Journal:

Provided that, in a case where a notification under this paragraph is sent to the applicant before these Rules come into force, this paragraph shall have effect as if the words “within two months after the notification is sent to him” were omitted.

Notification of lapsed patent

42. Where a patent has ceased to have effect because a renewal fee has not been paid within the period prescribed in rule 39(1) or (2) and the extended period specified in section 25(4) has expired without the renewal fee and prescribed additional fee having been paid, the comptroller shall, within six weeks after the expiration of the extended period, notify the proprietor of the patent of the fact and draw his attention to the provisions of section 28.

Surrender of patents

43.—(1) A notice of an offer by a proprietor of a patent under section 29 to surrender his patent shall be given on Patents Form 18/77 and shall be advertised by the comptroller in the Journal.

(2) At any time within two months from the advertisement any person may give notice of opposition to the surrender to the comptroller on Patents Form 19/77.

(3) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and of the statement to the proprietor of the patent.

(4) Within the period of two months beginning on the date when such copies are sent to him, the proprietor of the patent shall, if he wishes to continue with the surrender, file a counter-statement in duplicate setting out fully the grounds upon which the opposition is resisted; and the comptroller shall send a copy of the counter-statement to the opponent.

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

REGISTRATION

Entries in the register

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

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

- (a) the name and address of the applicant or applicants;
- (b) the name and address of the person or persons stated by the applicant or applicants to be believed to be the inventor or inventors;
- (c) the title of the invention;
- (d) the date of filing and the file number of the application for the patent;
- (e) the date of filing and the file number of any application declared for the purposes of section 5(2) or 127(4) and the country in or for which the application was made;
- (f) the date on which the application was published; and
- (g) the address for service of the applicant or applicants.

(3) The comptroller shall also cause to be entered in the register—

- (a) the date of filing of the request for substantive examination;
- (b) the date on which the application is withdrawn, taken to be withdrawn, treated as having been withdrawn, refused or treated as having been refused;
- (c) the date on which the patent is granted;
- (d) the name and address of the person or persons to whom the patent is granted if different to the entries made in accordance with paragraph (2)(a) above;

- (e) the address for service if different to the entry made in accordance with paragraph (2)(g) above; and
 - (f) notice of any transaction, instrument or event referred to in section 33(3).
- (4) The comptroller may at any time enter in the register such other particulars as he may think fit.

Alteration of name or address

45.—(1) A request by any person, upon the alteration of his name, for that alteration to be entered in the register or on any application or other document filed at the Patent Office shall be made on Patents Form 20/77.

(2) Before acting on a request to alter a name, the comptroller may require such proof of the alteration as he thinks fit.

(3) A request by any person for the alteration or correction of his address or address for service entered in the register or on any application or other document filed at the Patent Office shall, if not made on a form filed under any provision of these Rules, be made in writing and shall identify any relevant application or patent.

(4) If the comptroller is satisfied that a request to alter a name or to alter or correct an address or address for service may be allowed, he shall cause the register, application or other document to be altered accordingly.

Registrations under section 33

46.—(1) An application to register, or to give notice to the comptroller of, any transaction, instrument or event to which section 33 applies shall be made on Patents Form 21/77.

(2) Unless the comptroller otherwise directs, an application under paragraph (1) above shall be accompanied by—

- (a) a certified copy of any document which establishes the transaction, instrument or event; or
- (b) a certified copy of such extracts from such document as suffice to establish the transaction, instrument or event.

Request for correction of error

47.—(1) Without prejudice to rule 45(3), a request for the correction of an error in the register or in any document filed at the Patent Office in connection with registration shall be made on Patents Form 22/77; and the correction shall be clearly identified on a document annexed to the form or, if not, on the form itself.

(2) The comptroller may call for such written explanation of the reasons for the request or evidence in support of it as he may require in order to satisfy himself that there is an error and, upon being so satisfied, shall make such correction as may be agreed between the proprietor of the patent or applicant and the comptroller.

Request as to payment of renewal fee

48. A request for information about the date of payment of any renewal fee shall be made on Patents Form 23/77 and shall be accompanied by the appropriate fee.

Inspection of register

49.—(1) The register or entries or reproductions of entries in it shall be made available for inspection by the public on payment of the prescribed fee between the hours of 10.00 am and 4.00 pm

on weekdays, other than Saturdays and days which are specified as excluded days for the purposes of section 120.

(2) A request to be allowed to inspect the register shall be made on Patents Form 23/77 and shall be accompanied by the appropriate fee.

Advertisements in relation to register

50. The comptroller may arrange for the publication and advertisement of such things done under the Act or these Rules in relation to the register as he may think fit.

Entries relating to sections 8(1), 12(1) and 37(1)

51. On the reference to the comptroller of a question under section 8(1), 12(1) or 37(1), he shall, subject to rule 44(1), cause an entry to be made in the register of the fact and of such other information relating to the reference as he may think fit.

Certificates and copies supplied by comptroller

52.—(1) Upon request made on Patents Form 24/77 and payment of the appropriate fee, but subject to paragraph (3) below, the comptroller shall supply—

- (a) a certified copy or certified extract falling within section 32(11);
- (b) a copy of an entry in or an extract from the register or a copy of or an extract from anything referred to in section 32(11)(b), certified by the impression of a rubber stamp;
- (c) a certificate for the purposes of section 32(10).

(2) Upon request made on Patents Form 23/77 and payment of the appropriate fee, but subject to paragraph (3) below, the comptroller shall supply an uncertified copy of an entry in or an uncertified extract from the register or an uncertified copy of or an uncertified extract from anything referred to in section 32(11)(b).

(3) The restrictions on making documents available for inspection contained in rule 93(4) shall apply equally to the supply by the comptroller under this rule of copies of or extracts from such documents or requests as are referred to in rule 93(4); and nothing in this rule shall be construed as imposing upon the comptroller the duty of supplying copies of or extracts from any document or file of a description referred to in rule 93(5).

Order or direction by court

53. Where any order or direction has been made or given by the court—

- (a) transferring a patent or application or any right in or under it to any person;
- (b) that an application should proceed in the name of any person;
- (c) allowing the proprietor of a patent to amend the specification; or
- (d) revoking a patent;

the person in whose favour the order is made or the direction is given—

- (i) shall file Patents Form 25/77 accompanied by an office copy of the order or direction; and
- (ii) if the comptroller so requires and before a time fixed by him, shall file a specification as amended (prepared in accordance with rules 16, 18 and 20),

and thereupon the specification shall be amended or the register rectified or altered, as the case may require.

ENTITLEMENT TO PATENT

Reference of question to the comptroller under section 37(1)

54.—(1) A reference under section 37(1) shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the nature of the question, the facts upon which the person making the reference relies and the order which he is seeking.

(2) The comptroller shall send a copy of the reference and statement to every person who is not a party to the reference being—

- (a) a person who is shown on the register as having any right in or under the patent; or
- (b) a person who is alleged in the reference to be entitled to a right in or under the patent.

(3) If any person who is sent a copy of the reference and statement under paragraph (2) above wishes to oppose the making of the order sought (“the opponent”), he shall, within the period of two months beginning on the date when such copies are sent to him, file in duplicate a counter-statement setting out fully the grounds of his opposition and the comptroller shall send a copy of the counter-statement to the person making the reference and to those recipients of the copy of the reference and statement who are not party to the counter-statement.

(4) The person making the reference or any such recipient may, within the period of two months beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence,—

- (a) in any case, to the opponent; and
- (b) in the case of evidence filed by such a recipient, to the person making the reference.

(5) Within the period of two months after the copy of such evidence is sent to him or, if no such evidence is filed, within two months of the expiration of the time within which it might have been filed, the opponent may file evidence in support of his case and shall send a copy of that evidence to the person making the reference and to those recipients; and within the period of two months after the copy of the opponent’s evidence is sent to him, that person or any of those recipients may file further evidence confined to matters strictly in reply and shall send a copy of it to the persons mentioned in sub-paragraphs (a) and (b) of paragraph (4) above.

(6) No further evidence shall be filed by any party except by leave or direction of the comptroller.

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

Applications under section 37(3)

55.—(1) An application under section 37(3) for authority to do anything on behalf of a person to whom directions have been given under section 37(2)(d) shall be made on Patents Form 3/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts upon which the applicant relies and the nature of the authorisation sought.

(2) The comptroller shall send a copy of the application and statement to the person alleged to have failed to comply with the directions.

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

Time limit for new application

56. Where the comptroller orders that a new application may be made under section 37(4), it shall be made within three months calculated from the day on which the time for appealing from

that order expires without an appeal being brought or, where an appeal is brought, from the day on which it is finally disposed of.

Request under section 38(3)

57.—(1) Where an order is made under section 37 that a patent shall be transferred to one or more persons none of whom was an old proprietor of it or that a person other than an old proprietor may make a new application for a patent, a request under section 38(3) for the grant of a licence to continue working or, as the case may be, to work the invention shall, in the case of any of the old proprietors, be made within two months, and in the case of a licensee, four months, of his being notified by the comptroller of the making of the order.

(2) Where such an order is made, the comptroller shall notify the old proprietor or proprietors, and their licensees of whom he is aware, of the making of the order.

Reference to comptroller under section 38(5)

58.—(1) Where a question is referred to the comptroller under section 38(5) as to whether any person is entitled to be granted a licence or whether the period or terms of a licence are reasonable, the reference shall be made on Patents Form 5/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts upon which the person making the reference relies and the terms of the licence which he is prepared to accept or grant.

(2) The comptroller shall send a copy of the reference and statement to the new proprietor or proprietors and every person claiming to be entitled to be granted a licence, in either case not being the person who makes the reference, and if any recipient does not agree to grant or accept a licence for such period and upon such terms, he shall, within the period of two months beginning on the date when such copies are sent to him, file a counter-statement in duplicate setting out fully the ground of his objection and the comptroller shall send a copy of the counter-statement to the person making the reference.

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

EMPLOYEES' INVENTIONS

Application under section 40 for compensation

59.—(1) An application to the comptroller under section 40 for an award of compensation shall be made on Patents Form 26/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts relied upon.

(2) The prescribed period for the purposes of section 40(1) and (2) shall, in relation to proceedings before the comptroller, be that period which begins when the relevant patent is granted and which expires one year after it has ceased to have effect:

Provided that, where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the period prescribed for the payment thereof and an application for restoration is made to the comptroller under section 28, the said period shall,—

- (a) if restoration is ordered, continue as if the patent has remained continuously in effect; or
- (b) if restoration is refused, be treated as expiring one year after the patent ceased to have effect or six months after the refusal, whichever is the later.

(3) The comptroller shall send a copy of the application and statement to the employer who, if he wishes to contest the application, shall within the period of two months beginning on the date when such copies are sent to him, file a counter-statement in duplicate setting out fully the grounds on

which he disputes the employee's right to the award sought, and the comptroller shall send a copy of the counter-statement to the employee.

(4) The employee may, within the period of two months beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence to the employer.

(5) Within the period of two months beginning on the date when the copy of the employee's evidence is sent to him or, if the employee does not file any evidence, within two months of the expiration of the time within which the employee's evidence might have been filed, the employer may file evidence in support of his case and shall send a copy of the evidence to the employee; and within the period of two months beginning on the date when the copy of the employer's evidence is sent to him, the employee may file evidence confined to matters strictly in reply and shall send a copy of that evidence to the employer.

(6) No further evidence shall be filed by either party except by leave or direction of the comptroller.

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

Application under section 41(8) to vary etc awards of compensation

60.—(1) Where an award of compensation has been made to an employee under section 40(1) or (2) an application under section 41(8) to vary, discharge, suspend or revive any provision of the order shall be made on Patents Form 27/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts relied upon and the relief which is sought.

(2) Thereafter the provisions of rule 59(3) to (7) shall apply to an application made under section 41(8) by an employee as they apply to an application referred to in that rule and to an application made under section 41(8) by an employer as if references in those paragraphs to the employee were references to the employer and references to the employer were references to the employee.

LICENCES OF RIGHT

Application under section 46(1) for entry in the register

61.—(1) An application under section 46(1) shall be made on Patents Form 28/77.

(2) Every entry made in the register consequent upon such an application shall be published in the Journal and in such other manner (if any) as the comptroller thinks necessary.

Application under section 46(3) to settle licences of right

62.—(1) An application under section 46(3)(a) or (b) (made on or after the date on which these Rules come into force) shall be made on Patents Form 29/77 which shall be filed in duplicate together with,—

- (a) in the case of an application by the proprietor of the patent, two copies of a draft of the licence he proposes and of a statement of the facts he relies on; and
- (b) in the case of an application by any other person, two copies of a draft of the licence he seeks.

(2) The comptroller shall,—

- (a) in the case of an application by the proprietor, send a copy of Patents Form 29/77 and a copy of the documents filed under subparagraph (a) of paragraph (1) above to the person to whom the proprietor proposes to grant the licence; and
 - (b) in the case of an application by any other person, send a copy of Patents Form 29/77 and a copy of the documents filed under subparagraph (b) of that paragraph to the proprietor.
- (3) Within the period of two months beginning on the date when the documents are sent to him under paragraph (2) above,—
- (a) in the case of an application by the proprietor, the person referred to in paragraph (2)(a) above may file a counter-statement setting out fully the grounds of his objection; and
 - (b) in the case of an application by any other person, the proprietor may file a statement setting out fully the grounds of his objection,
- and, if he does so, at the same time shall send a copy of the statement or counter-statement, as the case may be, to the other party.
- (4) Within the period of two months beginning on the date when a statement under paragraph (3) (b) above is sent to him, the person therein referred to may file a counter-statement; and, if he does so, he shall at the same time send a copy of the counter-statement to the proprietor.
- (5) No further statement or counter-statement shall be served by either party without the leave or direction of the comptroller.
- (6) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.
- (7) Notwithstanding its repeal by rule 123(3), rule 63 of the Patents Rules 1982(3) shall continue to apply to an application made under it before these Rules come into force.

Application by proprietor under section 47(1) for cancellation of entry

63. An application under section 47(1) shall be made on Patents Form 30/77 and shall be accompanied by Patents Form 12/77 and fees to the amount of the balance of all renewal fees which would have been payable if the entry had not been made.

Application under section 47(3)

64.—(1) An application under section 47(3) shall be made on Patents Form 31/77 within two months after the making of the relevant entry and shall be accompanied by a copy of the application supported by a statement in duplicate setting out fully the nature of the claimant's interest and the facts upon which he relies.

(2) The comptroller shall send a copy of the application and statement to the proprietor of the patent.

Procedure on receipt of application made under section 47

65.—(1) Every application under section 47(1) or (3) shall be advertised in the Journal and the period within which notice of opposition to the cancellation of an entry may be given under section 47(6) shall be two months after the advertisement.

(2) Such notice shall be given on Patents Form 32/77 and shall be accompanied by a copy thereof and supported by a statement in duplicate setting out fully the facts upon which the opponent relies.

(3) The comptroller shall send a copy of the notice and statement to the applicant for cancellation of the entry who, if he desires to proceed with the application, shall, within the period of two months

(3) [S.I. 1982/717](#) to which there are no relevant amendments.

beginning on the date when such copies are sent to him, file a counter-statement in duplicate setting out fully the grounds on which the opposition is contested and the comptroller shall send a copy of the counter-statement to the opponent.

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

Procedure after cancellation of entry pursuant to section 47(3)

66. Where the comptroller cancels an entry in the register pursuant to section 47(3), he shall inform the proprietor of the patent who shall, within such period as the comptroller specifies, file Patents Form 12/77, accompanied by fees to the amount of the balance of all renewal fees which would have been payable if the entry had not been made.

Declaration under paragraph 4A of Schedule 1 to the Act

67.—(1) A declaration under paragraph 4A of Schedule 1 to the Act shall be made on Patents Form 58/77.

(2) The comptroller shall cause to be entered in the register notice of any declaration filed under the said paragraph 4A and the entry in the register shall be published in the Journal and in such other manner (if any) as the comptroller thinks necessary.

COMPULSORY LICENCES

Application under section 48(1) for compulsory licence

68. An application under section 48(1) shall be made on Patents Form 33/77 and shall be accompanied by a statement in duplicate of the facts upon which the applicant relies and evidence in duplicate verifying the statement.

Application by Crown under section 51

69. An application under section 51(1) for an order or entry under section 51(3) shall be made on Patents Form 34/77 and shall be accompanied by a statement of the facts upon which the applicant relies and evidence verifying the statement.

Procedure on receipt of application under section 48 or 51

70.—(1) If upon consideration of the evidence submitted with Patents Form 33/77 or 34/77, the comptroller is not satisfied that a prima facie case has been made out for the making of an order or entry, he shall notify the applicant accordingly, and unless, within one month of such notification, the applicant requests to be heard in the matter, the comptroller shall refuse the application.

(2) Where the applicant requests a hearing within the time allowed, the comptroller, after giving the applicant an opportunity of being heard, shall determine whether the application may proceed or whether it shall be refused.

(3) If upon consideration of the evidence the comptroller is satisfied that a prima facie case has been made out for the making of the order or entry, or if, after hearing the applicant, he so determines, he shall direct that the application shall be advertised in the Journal and shall send a copy of the application, the statement and the evidence filed in support thereof to the proprietor of the patent and any other person shown on the register as having any right in or under the patent.

Opposition under section 52(1)

71.—(1) The time within which notice of opposition under section 52(1) may be given shall be two months after the advertisement of the application in accordance with rule 70.

(2) Such notice shall be given on Patents Form 35/77 and shall be accompanied by a copy thereof and supported by a statement in duplicate setting out fully the facts upon which the opponent relies and evidence in duplicate verifying the statement.

(3) The comptroller shall send a copy of the notice, the statement and the evidence to the applicant who, if he desires to proceed with his application, shall within the period of two months beginning on the date when such copies are sent to him, file evidence in duplicate confined to matters strictly in reply and the comptroller shall send a copy thereof to the opponent.

(4) No further evidence shall be filed by either party except by leave or direction of the comptroller.

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

INFRINGEMENT PROCEEDINGS BEFORE COMPTROLLER

Procedure on reference to comptroller under section 61(3)

72.—(1) Where a reference is made to the comptroller under section 61(3), the parties thereto shall make it on Patents Form 36/77, accompanied by a joint statement giving full particulars of the matters which are in dispute and of those on which they are in agreement.

(2) The procedure set out in this rule shall apply unless the only matter stated in the reference to be in dispute is the validity of any patent or part of a patent.

(3) The party to the dispute who is the proprietor of the patent or an exclusive licensee of the patent (such party being referred to in this and the next following rule as the plaintiff) shall within fourteen days of making the reference file a statement in duplicate giving full particulars of his case on the matters in dispute.

(4) The comptroller shall send a copy of the plaintiff's statement to the other party to the dispute (referred to in this and the next following rule as the defendant), who shall, within the period of two months beginning on the date when such copy is sent to him, file a counter-statement in duplicate setting out fully the grounds on which he contests the plaintiff's case and the comptroller shall send a copy of the counter-statement to the plaintiff.

(5) If the defendant alleges in his counter-statement that the patent or any part of it alleged by the plaintiff to have been infringed is not valid, the plaintiff shall, within the period of two months beginning on the date when the counter-statement is sent to him, file a further statement in duplicate setting out fully the grounds on which he contests the defendant's allegation; and the comptroller shall send a copy of the further statement to the defendant.

(6) Subject to such directions as the comptroller may give, the plaintiff may, within the period of two months beginning on the date when the counter-statement is sent to him, or, if he has filed a further statement under paragraph (5) above, within the period of two months thereof, file evidence in support of his case and shall send a copy thereof direct to the defendant.

(7) Within the period of two months beginning on the date when the copy of the plaintiff's evidence is sent to him or, if the plaintiff does not file any evidence, within two months of the expiration of the time within which such evidence might have been filed, the defendant may file evidence in support of his case and shall send a copy of it to the plaintiff; and, within the period of two months beginning on the date when the copy of the defendant's evidence is sent to him, the plaintiff may file further evidence confined to matters strictly in reply and shall send a copy of it direct to the defendant.

(8) No further evidence shall be filed by either party except by leave or direction of the comptroller.

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

Procedure where validity of patent in dispute

73.—(1) Where the only matter stated in the reference made under section 61(3) to be in dispute is the validity of any patent or part of a patent, the procedure set out in this rule shall apply.

(2) The defendant shall, within fourteen days of making the reference, file a statement in duplicate giving full particulars of the grounds on which he alleges that the patent or part of the patent is invalid.

(3) The comptroller shall send a copy of the defendant's statement to the plaintiff, who shall, within the period of two months beginning on the date when the copy is sent to him, file a counter-statement in duplicate giving full particulars of the grounds on which he contests the defendant's allegations, and the comptroller shall send a copy of it to the defendant.

(4) Subject to such directions as the comptroller may think fit to give, the defendant may, within the period of two months beginning on the date when the copy of the plaintiff's counter-statement is sent to him, file evidence in support of his case, and shall send a copy of it to the plaintiff.

(5) Within the period of two months beginning on the date when the copy of the defendant's evidence is sent to him or, if the defendant does not file any evidence within two months of the expiration of the time within which such evidence might have been filed, the plaintiff may file evidence in support of his case and shall send a copy of it to the defendant; and, within the period of two months beginning on the date when the copy of the plaintiff's evidence is sent to him, the defendant may file further evidence confined to matters strictly in reply and shall send a copy of it to the plaintiff.

(6) No further evidence shall be filed by either party except by leave or direction of the comptroller.

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

Procedure on application under section 71

74.—(1) An application to the comptroller under section 71 for a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent shall be made on Patents Form 37/77 and shall be accompanied by a copy thereof and a statement in duplicate, setting out fully the facts upon which the applicant relies as showing that subparagraphs (a) and (b) of section 71(1) have been complied with and the relief which he seeks.

(2) The comptroller shall send a copy of the statement to the proprietor of the patent who shall, if he wishes to contest the application, within the period of two months beginning on the date when the copy is sent to him, file a counter-statement in duplicate setting out fully the grounds on which he contests the applicant's case; and the comptroller shall send a copy thereof to the applicant.

(3) Subject to such directions as the comptroller may think fit to give, the applicant may, within the period of two months beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his application and shall send a copy thereof to the proprietor of the patent.

(4) Within the period of two months beginning on the date when the copy of the applicant's evidence is sent to him or, if the applicant does not file any evidence, within two months of the expiration of the time within which such evidence might have been filed, the proprietor of the patent may file evidence in support of his case and shall send a copy of that evidence to the applicant; and, within the period of two months beginning on the date when the copy of the proprietor's evidence

is sent to him, the applicant may file further evidence confined to matters strictly in reply and shall send a copy of it to the proprietor.

(5) No further evidence shall be filed by either party except by leave or direction of the comptroller.

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

REVOCATION OF PATENTS

Procedure on application for revocation under section 72

75.—(1) An application to the comptroller for the revocation of a patent shall be made on Patents Form 38/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the grounds of revocation, the facts upon which the applicant relies and the relief which he seeks.

(2) The comptroller shall send a copy of the application and statement to the proprietor of the patent.

(3) Within the period of two months beginning on the date when such copies are sent to him, the proprietor of the patent shall, if he wishes to contest the application, file a counter-statement in duplicate setting out fully the grounds upon which the application is contested; and the comptroller shall send a copy of the counter-statement to the applicant.

(4) The applicant may, within the period of two months beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence to the proprietor.

(5) Within the period of two months beginning on the date when the copy of the applicant's evidence is sent to him or, if the applicant does not file any evidence, within two months of the expiration of the time within which such evidence might have been filed, the proprietor of the patent may file evidence in support of his case and shall send a copy of that evidence to the applicant; and, within the period of two months beginning on the date when the copy of the proprietor's evidence is sent to him, the applicant may file further evidence confined to matters strictly in reply and shall send a copy of it to the proprietor.

(6) No further evidence shall be filed by either party except by leave or direction of the comptroller.

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

Award of costs

76. If, in proceedings before the comptroller under section 72, the proprietor of a patent offers to surrender it under section 29, the comptroller shall, in deciding whether costs should be awarded to the applicant for revocation, consider whether proceedings might have been avoided if the applicant had given reasonable notice to the proprietor before the application was filed.

Revocation and amendment of patents under section 73

77.—(1) The opportunity to be given by the comptroller under subsection (1) or (2) of section 73, to the proprietor of a patent to make observations and to amend the specification of the patent shall be given by the comptroller sending to the proprietor notice informing him that he may make the observations and amend the specification and that, if he wishes to do so, he must do so within three months after the notice is sent to him.

(2) Where the comptroller gives leave under section 73 for the specification of the patent to be amended, he may, before the specification is amended, require the applicant to file a new specification as amended, prepared in accordance with rules 16, 18 and 20.

AMENDMENT OF PATENTS IN INFRINGEMENT OR REVOCATION PROCEEDINGS

Amendment of patent under section 75

78.—(1) Where in proceedings before the comptroller a proposed amendment under section 75 is advertised, notice of opposition to such an amendment shall, within the period of two months from the date of advertisement in the Journal, be filed on Patents Form 15/77.

(2) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and statement to the proprietor of the patent and any other party to the proceedings before the comptroller.

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

(4) Where the comptroller gives leave under section 75 for the specification of the patent to be amended, he may, before the specification is amended, require the applicant to file a new specification as amended, prepared in accordance with rules 16, 18 and 20.

EUROPEAN PATENTS AND PATENT APPLICATIONS AND NATIONAL PROCESSING OF INTERNATIONAL APPLICATIONS

Entries in the register

79.—(1) Upon publication of an application for a European patent (UK) under Article 93 of the European Patent Convention, the comptroller shall cause to be entered in the register a copy of every entry which, at the date of such publication, has been made in the Register of European Patents kept under Article 127 of that Convention in respect of that application.

(2) The comptroller shall also cause to be entered in the register in respect of an application for a European patent (UK) which has been published under Article 93 of the Convention copies of any entry made in the Register of European Patents following such publication, provided that an application to that effect is made to the comptroller on Patents Form 39/77, accompanied by a copy of the relevant entry in the Register duly certified to the satisfaction of the comptroller.

European Patents and applications (UK): translations

80. Schedule 4 shall have effect in cases where translations are required by the Act to be filed in connection with applications for, and with, European patents (UK).

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

81.—(1) A request referred to in section 81(2)(b)(i) shall be made on Patents Form 41/77 and the period within which such a request may be made shall be three months from the date on which the applicant is notified by the European Patent Office that his application for a European patent (UK) has been deemed to be withdrawn.

(2) In such a case, the applicant shall file Patents Form 40/77, and, where necessary, a translation in duplicate into English of the application, within a period of two months from the date on which the comptroller receives the request mentioned in paragraph (1) above.

(3) The applicant shall also, within the period referred to in paragraph (2) above, for the purposes of section 15(5)(b), file Patents Form 9/77, and, for the purposes of section 13(2), file Patents Form 7/77.

Procedure where section 81(2)(b)(ii) applies

82.—(1) Where section 81(2)(b)(ii) applies, the period within which a request may be transmitted to the comptroller shall be the twenty months calculated from the declared priority date or, where there is no declared priority date, the date of filing of the application for the European patent (UK).

(2) Upon receipt of the request, the comptroller shall notify the applicant thereof and Patents Form 40/77 and, where necessary, a translation in duplicate into English of the application shall be filed by the applicant within the period of four months calculated from the date of the notification.

(3) The applicant shall also, within the period referred to in paragraph (2) above, for the purposes of section 15(5)(b), file Patents Form 9/77 and, for the purposes of section 13(2), file Patents Form 7/77.

Procedure for making request for substantive examination where section 81(2) applies

83.—(1) The period within which a request may be made to the comptroller for substantive examination of any application for a patent to which section 81(2) applies shall be two years from the declared priority date or, where there is no declared priority date, the date of filing of the application for the European patent (UK).

(2) The request shall be made on Patents Form 10/77.

(3) Where an application for a European patent (UK) is to be treated as an application for a patent under the Act, the period prescribed for the purposes of sections 18(4) and 20(1) shall be the period which expires four years and six months after the declared priority date, or where there is no declared priority date, the date of filing of the application for the European patent (UK).

Recognition of determinations in proceedings before comptroller

84. Any person seeking recognition in proceedings before the comptroller of a determination by a competent authority of a relevant contracting state other than the United Kingdom of a question to which section 82 applies shall furnish the comptroller with a copy thereof certified as a true copy by an official of the said authority.

International applications for patents: section 89

85.—(1) Subject to the provisions of this rule, in relation to an international application for a patent (UK) which is, under section 89, to be treated as an application for a patent under the Act, the prescribed periods for the purposes of section 89A(3) and (5) are—

- (a) the period of twenty months calculated from the date which, by virtue of section 89B(1)(b), is to be treated as the declared priority date or, where there is no declared priority date, the date of filing of the international application for a patent (UK); or
- (b) in a case where the United Kingdom has been elected in accordance with Chapter II of the Patent Co-operation Treaty—
 - (i) before the expiry of nineteen months calculated from the declared priority date, the period of thirty months calculated from the declared priority date; or
 - (ii) where there is no declared priority date and the United Kingdom has been so elected before the expiry of nineteen months calculated from the date of filing of the international application for a patent (UK), the period of thirty months calculated from the date of filing of that international application.

(2) Where, in accordance with paragraph 1 of Schedule 2, the information specified in subparagraph (2)(a)(ii) of that paragraph is added to an international application for a patent (UK), rule 113(1) shall not apply in respect of that information; and where the translation of the information, the filing of which is required to satisfy the relevant conditions of section 89A(3), has not been filed at the Patent Office before the end of the relevant period referred to in paragraph (1) above,—

- (a) the comptroller shall give notice to the applicant at the address furnished by the applicant in accordance with rule 30 requiring the applicant to file the translation within the period of two months commencing on the day on which the notice is sent; and
- (b) the relevant period shall be treated in respect of the translation as not expiring until the end of the period specified in the notice given under subparagraph (a) above.

(3) In the case of an international application for a patent (UK),—

- (a) rule 5(1) shall not apply if the applicant, on filing the application, states in writing to the receiving office that the invention has been displayed at an international exhibition;
- (b) rule 5(2) may be complied with—
 - (i) where subparagraph (a) of paragraph (1) above applies, at any time before the end of the period of twenty-two months, or
 - (ii) where subparagraph (b) of paragraph (1) above applies, at any time before the end of the period of thirty-two months,

after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK);

- (c) rule 6(6) shall have effect with the substitution, for the reference to the period of twenty-one months after the declared priority date, of a reference to the period of twenty-two months after that date;
- (d) where the United Kingdom has been elected in accordance with Chapter II of the Patent Co-operation Treaty before the expiry of the nineteenth month after the declared priority date, rule 6(6) shall have effect with the substitution, for the reference to the period of twenty-one months after the declared priority date, of a reference to the period of thirty-two months after that date; and
- (e) where a translation into English of a document or part of a document is required by the Act or these Rules to be filed—
 - (i) before the end of the relevant period referred to in paragraph (1)(a) above, verification of the translation, as required by rule 113(1), may be given to the comptroller at any time before the end of the period of twenty-two months, or
 - (ii) before the end of the relevant period referred to in paragraph (1)(b) above, verification of the translation, as required by rule 113(1), may be given to the comptroller at any time before the end of the period of thirty-two months,

after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK).

(4) Where the relevant period referred to in paragraph (1) above has been extended under rule 100 or rule 110 so as to expire later than one month before the end of a period prescribed by paragraph (3) above or (7) below, paragraphs (3) above and (7) below shall have effect with the substitution for the period so prescribed of a period ending one month later than the relevant period referred to in paragraph (1) above as so extended.

(5) For the purposes of section 89A(3) and (5), to the extent that the application and any amendment as published under the Patent Co-operation Treaty and any amendment annexed to the international preliminary examination report under Chapter II of the Treaty are not in English, a

translation into English of the application as originally filed or, as the case may be, of the application as originally filed and of the amendment is necessary; however, the translation—

- (a) shall exclude the request and abstract unless—
 - (i) the applicant expressly requests the comptroller to proceed earlier than the expiry of the period prescribed in paragraph (1) above; and
 - (ii) a copy of the application published by the International Bureau has not yet been sent to the Patent Office in accordance with the Treaty; and
- (b) shall include any textual matter in the drawings in a form which complies with rule 49.5(d) of the Patent Co-operation Treaty.

(6) The comptroller shall publish any translation supplied in accordance with section 89A(3) or (5) following the filing of Patents Form 43/77 and payment of the prescribed fee.

(7) In the case of an international application for a patent (UK) in respect of which the conditions specified in section 89A(3)(a) are satisfied, the period prescribed—

- (a) for the purposes of sections 13(2), 15(5)(b) and 17(1),—
 - (i) where subparagraph (a) of paragraph (1) above has effect, shall be the period which expires twenty-two months; or
 - (ii) where subparagraph (b) of paragraph (1) above, has effect, shall be the period which expires thirty-two months; and
- (b) for the purposes of section 18(1),—
 - (i) where subparagraph (a) of paragraph (1) above applies, shall be the period which expires two years; or
 - (ii) where subparagraph (b) of paragraph (1) above applies, shall be the period which expires thirty-two months,

after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK).

(8) Where, in relation to an international application for a patent (UK), the applicant desires that section 89(1) shall not cease to apply to the application by virtue of the operation of section 89(3), application shall be made to the comptroller on Patents Form 44/77, accompanied by a statement of the facts upon which the applicant relies.

(9) An international application for a patent (UK) shall not be treated as withdrawn under the Act if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Patent Co-operation Treaty where, in the same or comparable circumstances in relation to an application under the Act (other than an international application)—

- (a) the comptroller could have directed that an irregularity be rectified under rule 100 or that an extension be granted under rule 110; and
- (b) the comptroller determines that the application would not have been treated as withdrawn under the Act.

(10) Where under section 89(3) an application is not to be treated as withdrawn and the applicant wishes to proceed—

- (a) the comptroller may amend any document received by the Patent Office from the receiving office or the International Bureau and alter any period or time which is specified in the Act or these Rules upon such terms (including payment of any appropriate prescribed fee) as he may direct; and
- (b) the fee prescribed under section 89A(3) shall not be payable.

(11) Where the applicant satisfies the comptroller that,—

- (a) because of an error made by the receiving office, an international application for a patent (UK) has been accorded a date of filing which is not correct; or
- (b) the declaration made under Article 8(1) of the Patent Co-operation Treaty has been cancelled or corrected by the receiving office or the International Bureau because of an error made by the office or the Bureau,

the comptroller may amend any document received by the Patent Office from the receiving office or the International Bureau or alter any period or time which is specified in the Act or these Rules as if the error were an error on the part of the Patent Office.

(12) Where—

- (a) an international application for a patent (UK) purports to designate the United Kingdom; and
- (b) the applicant alleges that he has been refused a filing date under the said Treaty on account of an error or omission in any institution having functions under the said Treaty,

the applicant may apply to the comptroller for it to be treated as an application under the Act by filing Patents Form 44/77, accompanied by a statement of the facts upon which he relies; and the comptroller may amend any document filed by the applicant and alter any period or time which is specified in the Act or these Rules upon such terms as he may direct.

(13) In this rule “receiving office” has the same meaning as in the Patent Co-operation Treaty.

Obtaining evidence for proceedings under European Patent Convention

86.—(1) An application to the comptroller under section 1 of the Evidence (Proceedings in Other Jurisdictions) Act 1975(4), as applied by section 92 of the Act, for an order for evidence to be obtained in the United Kingdom shall be made *ex parte* on Patents Form 45/77 and shall be accompanied by an affidavit made by a person duly authorised in that behalf by the relevant convention court, evidencing that the request is made in pursuance of a request issued by or on behalf of that court and that the evidence to which the application relates is to be obtained for the purposes of civil proceedings before it.

(2) After such an application as is mentioned in paragraph (1) above has been made, an *ex parte* application for a further order or directions in relation to the same matter may be made to the comptroller in writing.

(3) The comptroller may allow an officer of the European Patent Office to attend the hearing of such an application as is mentioned in paragraph (1) above and examine the witnesses or request the comptroller to put specified questions to them.

Communication of information to European Patent Office

87. The comptroller may authorise the communication to the European Patent Office or the competent authority of any country which is party to the European Patent Convention of such information in the files of the Patent Office as may be disclosed in accordance with section 118 and rule 93.

HEARINGS, AGENTS AND CORRECTION OF ERRORS

Comptroller's discretionary powers

88.—(1) Before exercising any discretionary power vested in him by or under the Act adversely to any party to a proceeding before him, the comptroller shall, unless the party concerned consents to shorter notice, give that party at least fourteen days' notice of the time when he may be heard.

(2) If, in *inter partes* proceedings, a party desires to be heard, he shall give notice in writing to the comptroller; and the comptroller may refuse to hear any party who has not given such notice before the day appointed for the hearing.

(3) In *inter partes* proceedings, any party who intends to refer at the hearing to any document (other than a report of a decision of any court or of the comptroller) not already mentioned in the proceedings shall, unless the comptroller consents and the other party agrees, give at least fourteen days' notice of his intention with details of, or a copy of, the document to the comptroller and the other party.

(4) After hearing the party or parties desiring to be heard or, if no party so desires, without a hearing, the comptroller shall decide the matter and shall notify all parties of his decision and, if any party so desires, shall give his reasons for the decision.

Admittance to hearings before comptroller

89.—(1) Subject to the following provisions of this rule, where a hearing before the comptroller of any dispute between two or more parties relating to any matter in connection with a patent or an application for a patent takes place after the publication of the application under section 16, the hearing of the dispute shall be in public.

(2) After consulting those parties to the dispute who appear in person or are represented at a hearing to which paragraph (1) above applies, the comptroller may direct that the hearing be not held in public, but without prejudice to paragraph (3) below.

(3) A member of the Council on Tribunals or of its Scottish Committee may, in his capacity as such, attend such a hearing or any other hearing before the comptroller under these Rules.

Agents

90.—(1) Unless the comptroller otherwise directs in any particular case—

- (a) all attendances upon him may be made by or through an agent; and
- (b) every notice, application or other document filed under the Act may be signed by an agent.

(2) Where after a person has become a party to proceedings before the comptroller he appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent shall file Patents Form 51/77 in duplicate on or before the first occasion when he acts as agent.

Correction of errors in patents and applications

91.—(1) Except where rule 45(3) or paragraph 4 of Schedule 4 has effect, a request for the correction of an error of translation or transcription or of a clerical error or mistake in any specification of a patent, in an application for a patent or in any document filed in connection with a patent or such an application shall be made on Patents Form 47/77 and shall be accompanied by a document clearly identifying the proposed correction; and the comptroller may, if he thinks fit, require that the correction be shown on a copy of the document of which correction is sought.

(2) Where such a request relates to a specification, no correction shall be made therein unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

(3) Where the comptroller requires notice of the proposed correction to be advertised, the advertisement shall be made by publication of the request and the nature of the proposed correction in the Journal and in such other manner (if any) as the comptroller may direct.

(4) Any person may, at any time within two months after the date of the advertisement, give notice to the comptroller of opposition to the request on Patents Form 48/77.

(5) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts on which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and the statement to the person making the request who, if he desires to proceed with the request, shall within the period of two months beginning on the date when the copies are sent to him, file a counter-statement in duplicate setting out fully the grounds on which he contests the opposition and the comptroller shall send a copy of the counter-statement to the opponent.

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

INFORMATION AND INSPECTION

Request for information under section 118

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

- (a) as to when a request for substantive examination has been filed or the prescribed period for doing so has expired without the request having been filed;
- (b) as to when the specification of a patent or application for a patent has been published;
- (c) as to when an application for a patent has been withdrawn, has been taken to be withdrawn, has been treated as having been withdrawn, has been refused or has been treated as having been refused;
- (d) as to when a renewal fee has not been paid within the period prescribed for the purposes of section 25(3);
- (e) as to when a renewal fee has been paid within the period of six months referred to in section 25(4);
- (f) as to when a patent has ceased to have effect and/or an application for restoration of a patent has been filed;
- (g) as to when an entry has been made in the register or an application has been made for the making of such entry;
- (h) as to when any application or request is made or action taken involving an entry in the register or advertisement in the Journal, if the nature of the application, request or action is specified in the request; and
- (i) as to when any document may be inspected in accordance with the provisions of rule 93 or 94.

(2) As regards information relating to any existing patent or existing application for a patent, a request may also be made—

- (a) as to when a complete specification following a provisional specification has been filed or when the period of fifteen months from the date of the application has expired and a complete specification has not been filed;
 - (b) as to when a complete specification is or will be published, or when an application for a patent has become void; and
 - (c) as to when a patent has been sealed or when the time for requesting sealing has expired.
- (3) Any such request shall be made on Patents Form 49/77 and a separate form shall be used in respect of each item of information required.
- (4) In this rule, “existing patent” means a patent mentioned in section 127(2)(a) and (c) and “existing application” means an application mentioned in section 127(2)(b).

Inspection of documents under section 118

93.—(1) Subject to paragraph (5) below, and to the restrictions prescribed in paragraph (4) below, after the date of publication of an application for a patent in accordance with section 16, the comptroller shall, upon request made on Patents Form 23/77 and payment of the appropriate prescribed fee, permit all documents filed or kept at the Patent Office in relation to the application or any patent granted in pursuance of it, to be inspected at the Patent Office.

(2) Subject to the same restrictions and to rule 96, where the circumstances specified in section 118(4) or (5) exist, the comptroller shall, upon request made on Patents Form 23/77, and payment of the appropriate fee, permit inspection of such documents before the publication in accordance with section 16.

(3) Where a declaration has been made in accordance with section 5(2) or 127(4), inspection of any application referred to therein and of any translation thereof shall be permitted upon request under paragraph (1) or (2) above without payment of any fee.

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

- (a) that no document shall be open to inspection until fourteen days after it has been filed at the Patent Office;
- (b) that documents prepared in the Patent Office solely for use therein shall not be open to inspection;
- (c) that any document sent to the Patent Office, at its request or otherwise, for inspection and subsequent return to the sender, shall not be open to inspection;
- (d) that no document filed at the Patent Office in connection with an application under section 40(1) or (2) or section 41(8) shall be open to inspection unless the comptroller otherwise directs;
- (e) that no request made under rule 48, 49(2), 52(2) or 92 or this rule shall be open to inspection; and
- (f) that documents in respect of which the comptroller issues directions under rule 94 that they are to be treated as confidential shall not be open to inspection, save as permitted in accordance with that rule.

(5) Nothing in this rule shall be construed as imposing on the comptroller any duty of making available for public inspection—

- (a) any document or any part of a document—
 - (i) which in his opinion disparages any person in a way likely to damage him; or
 - (ii) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour; or

- (b) the file (but not the report) of the international preliminary examination of an international application under the Patent Co-operation Treaty; or
 - (c) any document filed with or sent to the Patent Office before 1st June 1978.
- (6) No appeal shall lie from a decision of the comptroller under paragraph (5)(a) above not to make a document or part of a document available for public inspection.

Confidential documents

94.—(1) Where a document other than a Patents Form is filed at, or sent to, the Patent Office, and the person filing or sending it or any party to the proceedings to which the document relates so requests, giving his reasons, within fourteen days of the filing or sending of the document, the comptroller may direct that it be treated as confidential, and the document shall not be open to public inspection while the matter is being determined by the comptroller.

(2) Where such a direction has been given and not withdrawn, nothing in this rule shall be taken to authorise or require any person to be allowed to inspect the document to which the direction relates except by leave of the comptroller.

(3) The comptroller shall not withdraw any direction given under this rule nor shall he give leave for any person to inspect any document to which a direction which has not been withdrawn relates without prior consultation with the person at whose request the direction was given, unless the comptroller is satisfied that such prior consultation is not reasonably practicable.

(4) Where such a direction is given or withdrawn a record of the fact shall be filed with the document to which it relates.

(5) Where the period referred to in paragraph (1) above is extended under rule 110, the relevant document shall not be, or, if the period is extended after it has expired, shall cease to be, open to public inspection until the expiry of the extended period, and if a request for a direction is made the document shall not be open to public inspection while the matter is being determined by the comptroller.

Bibliographic data for purposes of section 118(3)(b)

95. The following bibliographic data is prescribed for the purposes of section 118(3)(b)—

- (a) the number of the application;
- (b) the date of filing of the application and, where a declaration has been made under section 5(2) or 127(4), the filing date, country and file number when available of each application referred to in that declaration;
- (c) the name of the applicant or applicants;
- (d) the title of the invention; and
- (e) if the application has been withdrawn, has been taken to be withdrawn, has been treated as having been withdrawn, has been refused or is treated as having been refused, that fact.

Request for information where section 118(4) applies

96.—(1) Where the circumstances specified in section 118(4) exist, a request under section 118(1) shall be accompanied by a statutory declaration verifying their existence and such documentary evidence (if any) supporting the request as the comptroller may require.

(2) The comptroller shall send a copy of the request, the declaration and the evidence (if any) to the applicant for the patent and shall not comply with the request until the expiry of fourteen days thereafter.

MISCELLANEOUS

Service by post

97. Any notice, application or other document sent to the Patent Office by posting it in the United Kingdom shall be deemed to have been given, made or filed at the time when the letter containing it would be delivered in the ordinary course of post.

Hours of business

98. The Patent Office shall be deemed to be closed at the following hours for the transaction of business of the classes specified—

- (a) on weekdays other than Saturdays, at midnight for the filing of applications, forms and other documents, and at 4 pm for all other business; and
- (b) on Saturdays, at 1 pm for the filing of new applications for patents in respect of which no declaration for the purposes of section 5(2) or 127(4) is made.

Excluded days

99.—(1) The following shall be excluded days for all purposes under the Act—

- (a) all Sundays;
- (b) Good Friday and Christmas Day;
- (c) any day specified as or proclaimed to be a bank holiday in England in or under section 1 of the Banking and Financial Dealings Act 1971⁽⁵⁾; and
- (d) any Saturday immediately preceded by one of the above.

(2) Saturdays not falling within paragraph (1) above shall be excluded days for all purposes except the filing of applications in respect of which no declaration for the purposes of section 5(2) is made.

Correction of irregularities

100.—(1) Subject to paragraph (2) below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct.

(2) In the case of an irregularity or prospective irregularity—

- (a) which consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968⁽⁶⁾ as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;
- (b) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and
- (c) which it appears to the comptroller should be rectified,

the comptroller may direct that the time or period in question shall be altered but not otherwise.

(3) Paragraph (2) above is without prejudice to the comptroller's power to extend any times or periods under rule 110 or 111.

⁽⁵⁾ 1971 c. 80.

⁽⁶⁾ S.I. 1968/1389, amended by S.I. 1970/955, 1971/1917, 1973/66, 1975/891, 1021 and 1262 and revoked with savings by S.I. 1978/216.

Dispensation by comptroller

101. Where, under these Rules, any person is required to do any act or thing, or any document or evidence is required to be produced or filed, and it is shown to the satisfaction of the comptroller that from any reasonable cause that person is unable to do that act or thing, or that document or evidence cannot be produced or filed, the comptroller may, upon the production of such evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing, or the production or filing of such document or evidence.

Remission of fees

102.—(1) The comptroller may remit the whole or part of a search fee in the following cases—

- (a) where an international application for a patent (UK) which has already been the subject of a search by the International Searching Authority in accordance with the Patent Co-operation Treaty falls to be treated as an application for a patent under the Act; and
- (b) where a new application is filed in accordance with section 15(4) for a patent for an invention in relation to which the applicant has previously paid the search fee in connection with the earlier application referred to in that subsection.

(2) In a case governed by Chapter II of the Patent Co-operation Treaty, the comptroller may remit the whole or part of the fee for the substantive examination of the international application where its preliminary examination has been carried out by the Patent Office acting as the International Preliminary Examining Authority under Article 32 of the said Treaty.

(3) In cases falling within paragraph (1)(b) above the request for remission of the whole or part of the fee shall be made in writing.

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

Evidence

103.—(1) Where under these Rules evidence may be filed, it shall be by statutory declaration or affidavit.

(2) The comptroller may if he thinks fit in any particular case take oral evidence in lieu of or in addition to such evidence and shall allow any witness to be cross-examined on his affidavit or declaration, unless he directs otherwise.

(3) In England and Wales, the comptroller shall, in relation to the giving of evidence (including evidence on oath), the attendance of witnesses and the discovery and production of documents, have all the powers of a judge of the High Court, other than the power to punish summarily for contempt of court.

(4) In Scotland, the comptroller shall, in relation to the giving of evidence (including evidence on oath), have all the powers which a Lord Ordinary of the Court of Session has in an action before him, other than the power to punish summarily for contempt of court, and, in relation to the attendance of witnesses and the recovery and production of documents, have all the powers of the Court of Session.

Statutory declarations and affidavits

104. Any statutory declaration or affidavit filed under the Act or these Rules shall be made and subscribed as follows,—

- (a) in the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceedings;

- (b) in any other part of Her Majesty's dominions or in the Republic of Ireland, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of any legal proceedings; and
- (c) elsewhere, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or before a notary public, judge or magistrate.

Admission of documents

105. Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by the last foregoing rule to take a declaration, in testimony that the declaration was made and subscribed before him, may be admitted by the comptroller without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

Directions as to the furnishing of documents etc

106. At any stage of any proceedings before the comptroller he may direct that such documents, information or evidence as he may require shall be furnished within such period as he may fix.

Supporting statements or evidence

107.—(1) Where by virtue of any of the rules mentioned in paragraph (2) of this rule, any notice or application is required to be supported by a statement or evidence, such a statement or evidence shall be filed on, or within fourteen days after, the date on which the notice is given or the application is made.

(2) The rules referred to in paragraph (1) above are rules 40(3), 41(1), 43(3), 64(1), 65(2), 71(2), 78(2) and 91(5).

Proceedings in Scotland

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

- (a) the comptroller shall so direct in the following cases—
 - (i) where one party resides in Scotland and all parties to the proceedings agree to a hearing being held there; or
 - (ii) where all the parties to the proceedings reside in Scotland and one of them requests a hearing there, unless it is shown to the comptroller's satisfaction that it would be unduly burdensome to any other party to hold the hearing there; and
 - (b) the comptroller may direct that a hearing be held in Scotland (even where none of the parties resides in Scotland) where one party to the proceedings requests it and the balance of convenience is in favour of holding the hearing there.
- (2) A request under paragraph (1) above shall be made in duplicate and shall—
- (a) be in writing;
 - (b) be accompanied by a statement of facts in duplicate setting out the grounds upon which the request is made; and
 - (c) be filed at any time before the comptroller issues notification to the parties that a hearing has been appointed, or, with the leave of the comptroller, within fourteen days thereafter.

(3) The comptroller, upon a request being made under paragraph (1) above, shall send a copy of the request and the statement to any party to the proceedings who has not indicated that he consents to the request.

(4) Any party or parties to the proceedings having objection to a request made under paragraph (1) above may, within two months after notification of the request is sent to him, file at the Patent Office a counter-statement in duplicate setting out the grounds upon which objection is taken, and the comptroller shall send a copy of the counter-statement to any person who is not party to it.

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

(6) Where the comptroller, after consideration of a request made under paragraph (1)(a)(ii) or (b) above, is satisfied that any hearing thereon should be held in Scotland, he shall grant the request and issue such directions as shall seem to him appropriate.

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

Appointment of advisers

109. The comptroller may appoint an adviser to assist him in any proceeding before the comptroller and shall settle the question or instructions to be submitted or given to such adviser.

Alteration of time limits

110.—(1) The times or periods prescribed by these Rules for doing any act or taking any proceeding thereunder, other than times or periods prescribed in the provisions mentioned in paragraph (2) below, and subject to paragraphs (3) and (4) below, may be extended by the comptroller if he thinks fit, upon such notice to the parties and upon such terms as he may direct; and such extension may be granted notwithstanding that the time or period for doing such act or taking such proceeding has expired.

(2) The provisions referred to in paragraph (1) above are rules 6(1), 26 (so far as it relates to rule 6(1)), 39(1) and (2), 40(2), 41(1), 43(2), 59(2), 64(1), 65(1), 71(1), 78(1), 81(1), 82(1) and 91(4) and paragraph 4(2) of Schedule 2.

(3) A time or period prescribed in rules 6(2) and (6) (including the period therein prescribed as substituted by rule 85(3)(c) and (d)), 15(1), 23, 25(2) and (3) (except so far as it relates to the filing of claims for the purposes of the application and filing of the abstract), 26 (except so far as it relates to rule 6(1)), 33(2), (3) and (5), 34, 41(4), 81(2) and (3), 82(2) and (3), 83(3) and 85(1) and (7), paragraph (6) below, paragraph 1(3) of Schedule 2 and paragraph 2 of Schedule 4 shall, if not previously extended, be extended for one month upon filing Patents Form 50/77 before the end of that month; and where in any proceedings more than one such time or period expires on the same day (but not otherwise), those times or periods may be extended upon the filing of a single such form.

(4) Without prejudice to paragraph (3) above, a time or period (other than any time or period expiring before 24th March 1987) prescribed in the rules referred to in that paragraph may, upon request made on Patents Form 52/77, be extended or further extended if the comptroller thinks fit, whether or not the time or period (including any extension obtained under paragraph (3) above) has expired; and the comptroller may allow an extension, or further extension, under this paragraph on such terms as he may direct and subject, unless he otherwise directs, to the furnishing of a statutory declaration or affidavit verifying the grounds for the request.

(5) A single request may be made under paragraph (4) above for the extension of more than one time or period in the same proceedings if the extensions are to be made to a common date (but not otherwise).

(6) If on consideration of a request under paragraph (4) above the comptroller decides that the extension requested (or, in a case falling within paragraph (5) above, any or all of the extensions

requested) may be granted he shall notify the applicant accordingly and invite him, within two months after the notification is sent to him, to file Patents Form 53/77, upon receipt of which the comptroller shall effect the extension or extensions in accordance with the decision:

Provided that, in a case where a notification under this paragraph is sent to the applicant before these Rules come into force, this paragraph shall have effect as if the words “within two months after the notification is sent to him” were omitted.

(7) Where the period within which any party to a dispute may file evidence under these Rules is to begin after the expiry of any period in which any other party may file evidence under these Rules and that other party notifies the comptroller that he does not wish to file any, or any further, evidence, the comptroller may direct that the period within which the first-mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

Calculation of times or periods

111.—(1) Where, on any day, there is—

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

the comptroller may certify the day as being one on which there is an “interruption” and, where any period of time specified in the Act or these Rules for the giving, making or filing of any notice, application or other document expires on a day so certified the period shall be extended to the first day next following (not being an excluded day) which is not so certified.

(2) Any certificate of the comptroller given pursuant to this rule shall be posted in the Patent Office.

(3) Where, in or in connection with an application for a patent (“the application in suit”), it is desired to make a declaration specifying for the purposes of section 5(2) an earlier relevant application and the period of twelve months immediately following the date of filing the earlier relevant application ends on a day which is an excluded day for the purposes of section 120, such period shall, if the declaration is made on the first following day on which the Patent Office is open for the transaction of such business, be altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration is made in or in connection with the application in suit.

(4) Where it is desired to make such a declaration and the said period of twelve months immediately following the date of filing the earlier relevant application ends on a day certified under paragraph (1) above as being one on which there is an interruption, the period shall, if the declaration is made on the first day following the end of the interruption, be altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration is made in or in connection with the application in suit.

(5) Where an application for a patent is filed upon the day immediately following a day which is certified under paragraph (1) above as being one on which there is an interruption or which is an excluded day for the purposes of section 120, the period of six months specified in section 2(4) shall be computed from the day following the next preceding day which is neither so certified nor so excluded.

(6) If in any particular case the comptroller is satisfied that the failure to give, make or file any notice, application or other document within—

- (a) any period of time specified in the Act or these Rules for such giving, making or filing;

(b) the period of six months following a disclosure of matter constituting an invention falling within paragraph (a), (b) or (c) of section 2(4); or

(c) the period of twelve months referred to in paragraph (3) above,

was wholly or mainly attributable to a failure or undue delay in the postal services in the United Kingdom, the comptroller may, if he thinks fit—

- (i) extend the period of time for the giving, making or filing so that it ends on the day of the receipt by the addressee of the notice, application or other document (or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day);
- (ii) determine that the period of six months referred to in subparagraph (b) above shall be altered so that it begins on the day of the disclosure and ends on the day of receipt by the Patent Office of the application for the patent (or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day); or
- (iii) determine that the period of twelve months referred to in paragraph (3) above shall be altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration specifying that application is received by the Patent Office (or, if the day of such receipt is an excluded day, the first following day which is not an excluded day),

as the case may be, in each case upon such notice to other parties and upon such terms as he may direct.

Copies of documents

112. Where a document, other than a published United Kingdom specification or application, is referred to in any reference, notice, statement, counter-statement or evidence required by the Act or these Rules to be filed at the Patent Office or sent to the comptroller, copies of the document shall be furnished to the Patent Office within the same period as the reference, notice, statement, counter-statement or evidence in which they are first referred to may be filed and in the following number,—

- (a) where the document in which they were so referred to had to be filed or sent in duplicate or the original document had to be accompanied by a copy thereof, in duplicate; and
- (b) in all other cases, one:

Provided that where a copy of any evidence is required by the Act or these Rules to be sent direct to any person, a copy of any document referred to in that document shall also be sent direct to that person.

Translations

113.—(1) Subject to the provisions of rules 6, 40, 81, 82 and 85, paragraph (3) below and paragraph 5 of Schedule 4, where any document or part of a document which is in a language other than English is filed at the Patent Office or sent to the comptroller in pursuance of the Act or these Rules, it shall be accompanied by a translation into English of the document or that part, verified to the satisfaction of the comptroller as corresponding to the original text. Where the document is or forms part of an application for a patent, the Patent Office shall not, in the absence of such a translation, take any further action in relation to that document, unless the comptroller otherwise directs.

(2) Where more than one copy of that document is required to be so filed or sent, a corresponding number of copies of the translation shall accompany it.

- (3) Where any document which, or any part of which, is in a language other than English—
 - (a) is referred to in a search report drawn up under Article 18 of the Patent Co-operation Treaty; or

(b) is cited in the statement contained in an international preliminary examination report established under Article 35 of that Treaty, and any such report is filed at the Patent Office in relation to the provisions of section 89A, a translation into English of that document or part verified to the satisfaction of the comptroller as corresponding to the original text thereof shall, if the comptroller so directs, be filed within two months of the date on which such direction is given.

(4) Where proceedings are instituted before the comptroller in relation to a European patent (UK) the specification of which was published in French or German, the party who institutes those proceedings shall furnish to the Patent Office a translation into English of the specification of the patent verified to the satisfaction of the comptroller as corresponding to the original text thereof unless—

- (a) such a translation has already been filed under section 77(6); or
- (b) the comptroller determines that it is not necessary.

(5) If, in the course of such proceedings, leave is given for the amendment of the specification of the European patent (UK), the party given leave to amend shall furnish to the Patent Office a translation of the amendment into the language in which the specification of the patent was published, verified to the satisfaction of the comptroller as corresponding to the original text thereof.

(6) The comptroller may refuse to accept any translation which is in his opinion inaccurate and thereupon another translation of the document in question verified as aforesaid shall be furnished, together with the appropriate number of copies thereof.

Publication and sale of documents

114. The comptroller may arrange for the publication and sale of copies of specifications and other documents in the Patent Office and of indexes to, and abridgements or abstracts of, such documents.

The Journal

115.—(1) The comptroller shall publish a journal containing particulars of applications for patents and other proceedings under the Act and any other information that he may deem to be generally useful or important.

- (2) The journal shall be entitled “The Official Journal (Patents)”.
- (3) Unless the comptroller otherwise directs, the Journal shall be published weekly.

Reports of cases

116. The comptroller shall from time to time publish reports of—

- (a) cases relating to patents, trade marks, registered designs and design right decided by him; and
- (b) cases relating to patents (whether under the Act or otherwise), trade marks, registered designs, copyright and design right decided by any court or body (whether in the United Kingdom or elsewhere),

being cases which he considers to be generally useful or important.

INTERNATIONAL APPLICATIONS

Filing of applications

117.—(1) Where the Patent Office is the competent receiving office under the Patent Co-operation Treaty, an international application shall be filed at it in English in triplicate.

(2) If less than three copies of the international application are so filed, upon preparation by the Patent Office of the number of copies of it required to bring the total to three, the applicant shall on demand pay to the Patent Office the appropriate charge.

Transmittal, international and search fees

118.—(1) Payment of the prescribed transmittal fee and the basic fee referred to in rule 15.1(i) of the Regulations under the Patent Co-operation Treaty shall be made to the Patent Office not later than one month after the date on which the application to which they relate is filed at the Patent Office.

(2) Payment of designation fees referred to in rule 15.1(ii) of the said Regulations shall be made to the Patent Office in the amount provided for in rule 15.2(b) thereof not later than—

- (a) one year after the date on which the application to which they relate is filed at the Patent Office in a case in which there is no date to be treated by virtue of section 89B(1)(b) as the declared priority date; and
- (b) one month after that date or, if later, one year after the date to be treated by virtue of section 89B(1)(b) as the declared priority date in any other case.

(3) Payment of the search fee referred to in rule 16.1 of the said Regulations shall be made to the Patent Office in the amount fixed by the Administrative Council of the European Patent Organisation and published in the Journal.

Certified copies

119. A request under rule 20.9 of those Regulations for a certified copy of an international application as filed with the Patent Office as receiving office and of any corrections thereto shall be made on Patents Form 24/77 and shall be accompanied by the appropriate fee.

Fees for international preliminary examination

120. Where an applicant makes a demand to the Patent Office, as International Preliminary Examining Authority, for international preliminary examination under Article 31 of the said Treaty, he shall—

- (a) in accordance with rule 58 of those Regulations, pay the appropriate prescribed preliminary examination fee;
- (b) in accordance with rule 57 of those Regulations, pay the handling fee therein referred to; and
- (c) upon request by the Patent Office, pay to it an amount which is the equivalent in sterling of the search fee referred to in rule 118(3).

Additional fees for further inventions

121. Where under rule 68.2 of those Regulations the Patent Office, as International Preliminary Examining Authority, reports to the applicant that the requirement of unity of invention is not complied with and the applicant decides to pay an additional fee in respect of each invention other than the main invention, the additional fee payable to the Patent Office in respect of each invention shall not exceed the appropriate prescribed preliminary examination fee.

Fees to be paid in sterling

122. The fees referred to in rules 118 to 121 shall be paid in sterling.

Transitional provisions and revocations

123.—(1) The reference to Schedule 2 to the Patents Rules 1968(7) in paragraph (a) of the proviso to rule 124 of the Patents Rules 1978(8) shall be construed as a reference to that Schedule with the substitution for forms 7, 9, 14 to 21, 23, 32 to 36, 38, 39, 43, 44, 46, 53 to 55, 63 to 65 and 69 of the correspondingly numbered forms in Schedule 5.

(2) In rule 124 of the Patents Rules 1978—

(a) for the words “the Patents Rules 1982” in each place where they occur, there shall be substituted the words “the Patents Rules 1990”;

(b) for paragraph (d) of the proviso to paragraph (1), there shall be substituted—

“(d) subject to sub-rule (3) below, rules 30, 39(1) and (3) to (6), 41 to 50, 52, 61 to 66, 68 to 74, 76, 88(1), 90, 92 to 95, 97 to 101, 103 to 108, and 114 to 116 of the Patents Rules 1990 shall apply.”,

and

(c) for the words “in rule 39(1)” in paragraph (4) there shall be substituted the words “in rule 39(1) of the Patents Rules 1990”.

(3) The rules described in column 1 of Schedule 6 are hereby revoked to the extent specified in column 3 thereof.

(4) Where—

(a) immediately before these Rules come into force, any time or period prescribed by the Rules hereby revoked has effect in relation to any act or proceeding and has not expired; and

(b) the corresponding time or period prescribed by these Rules would have expired or would expire earlier,

the time or period prescribed by those Rules and not by these Rules shall apply to that act or proceeding.

29th November 1990

Hesketh
Minister of State,
Department of Trade and Industry

(7) S.I. 1968/1389, amended by S.I. 1970/955, 1971/1917, 1973/66, 1975/891, 1021 and 1262 and revoked with savings by S.I. 1978/216.

(8) S.I. 1978/216.