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STATUTORY INSTRUMENTS

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**2007 No. 3291**

The Patents Rules 2007

**PART 3**

GRANTED PATENTS

*Certificate and amendment*

**Certificate of grant**

- 34.** The certificate of grant of a patent must be in a form which includes—
- (a) the name of the proprietor;
  - (b) the date of filing of the application; and
  - (c) the number of the patent.

**Amendment of specification after grant**

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

- (a) be made in writing;
  - (b) identify the proposed amendment; and
  - (c) state the reason for making the amendment.
- (2) The application must, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications.
- (3) The comptroller may, if he thinks fit, direct the proprietor to file a copy of the specification with the amendment applied for marked on it.
- (4) Where the specification of a European patent (UK) was published in a language other than English, the proprietor must file a translation into English of the part of the specification which he is applying to amend and a translation of the amendment.
- (5) The comptroller may, if he thinks fit, direct the proprietor to file a translation into English of the specification as published.
- (6) Where the court or the comptroller allows the proprietor of a patent to amend the specification of the patent, the comptroller may direct him to file an amended specification which complies with the requirements of Schedule 2.

*Renewal*

**Renewal of patents: general**

- 36.—(1)** In this rule and in rules 37 to 41—
- “renewal date” has the meaning given in rules 37(2) to (4) and 38(3);
- “renewal fee” means the fee prescribed in respect of a renewal date;

“renewal period” means the period prescribed by rule 37 or 38 for the payment of a renewal fee [<sup>F1</sup>unless a renewal fee is payable by virtue of section 77(5A), in which case in this rule and in rules 39 and 41 “renewal period” means the period in which the fee is payable under section 77(5A) and rule 41A].

(2) If the renewal fee is not paid before the end of the renewal period, the patent shall cease to have [<sup>F2</sup>effect—

(a) where the renewal fee is payable by virtue of section 77(5A), at the end of the final day of the renewal period;

(b) in any other case, at the end of the renewal date.]

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

(4) But where payment is made under section 25(4) or section 28(3), Patents Form 12 must accompany the renewal fee and the prescribed additional fee.

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

#### Textual Amendments

**F1** Words in rule 36(1) inserted (1.10.2014) by [The Patents \(Amendment\) \(No. 2\) Rules 2014 \(S.I. 2014/2401\)](#), rules 1, 4

**F2** Words in rule 36(2) substituted (1.10.2014) by [The Patents \(Amendment\) \(No. 2\) Rules 2014 \(S.I. 2014/2401\)](#), rules 1, 5

#### Renewal of patents: first renewal

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

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

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

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

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

(a) the first renewal date is the last day of the period of three months [<sup>F3</sup>beginning immediately after] the date on which the patent was granted; and

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

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

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

(i) the last day of the period of three months [<sup>F4</sup>beginning immediately after] the date on which the grant of the patent was mentioned in the European Patent Bulletin (case A), or

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

(b) the renewal period is—

- (i) in case A, the period beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin and ending with the last day of the month in which the first renewal date falls, or
- (ii) in case B, three months ending with the last day of the month in which the first renewal date falls.

#### **Textual Amendments**

- F3** Words in rule 37(3)(a) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with rule 4)
- F4** Words in rule 37(4)(a)(i) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with rule 4)

#### **Renewal of patents: subsequent renewals**

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

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

(3) For those purposes—

- (a) the second renewal date is the next anniversary of the date of filing to fall after the first renewal date; and
- (b) each subsequent renewal date is the anniversary of the previous renewal date.

#### **Renewal notice**

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

[<sup>F5</sup>(2) If the renewal fee remains unpaid, the comptroller must send a renewal notice to the proprietor of the patent—

- (a) where the renewal fee is payable by virtue of section 77(5A), before the end of the period of six weeks beginning immediately after the later of—
  - (i) the end of the renewal period, and
  - (ii) the date on which the comptroller receives notification of the restoration of the patent from the European Patent Office;
- (b) in any other case, before the end of the period of six weeks beginning immediately after the end of the renewal period.]

(3) The comptroller must send the renewal notice to—

- [<sup>F6</sup>(a) the last address specified by the proprietor on payment of a renewal fee (or to another address that has since been notified to him for that purpose by the proprietor); or]
  - (b) where such an address has not been so specified or notified, the address for service entered in the register.
- (4) The renewal notice must remind the proprietor of the patent—
- (a) that payment is overdue; and
  - (b) of the consequences of non-payment.

#### Textual Amendments

- F5** Rule 39(2) substituted (1.10.2014) by [The Patents \(Amendment\) \(No. 2\) Rules 2014 \(S.I. 2014/2401\)](#), rules 1, **6**
- F6** Rule 39(3)(a) substituted (6.4.2017) by [The Patents \(Amendment\) \(No. 2\) Rules 2016 \(S.I. 2016/892\)](#), rules 1(2), **9**

### Restoration of lapsed patents under section 28

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

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

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

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

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

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

(7) The applicant may, before the end of the period of one month [<sup>F7</sup>beginning immediately after] the date of that notification, request to be heard by the comptroller.

(8) If the applicant requests a hearing, the comptroller must give the applicant an opportunity to be heard before he determines whether to grant or refuse the application under section 28.

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

#### Textual Amendments

- F7** Words in [rule 40\(7\)](#) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with [rule 4](#))

### Notification of lapsed patent

**41.**—(1) This rule applies where—

(a) a patent has ceased to have effect because a renewal fee has not been paid by the end of the renewal period; and

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

(2) The comptroller must, before the end of the period of six weeks beginning immediately after the end of the extended period, send a notice to the proprietor of the patent—

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

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

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

### [<sup>F8</sup>Payment of fees under section 77(5A) following restoration of a European patent (UK)

**41A.** The prescribed period for the purposes of section 77(5A) is two months.]

**Textual Amendments**

**F8** Rule 41A inserted (1.10.2014) by [The Patents \(Amendment\) \(No. 2\) Rules 2014 \(S.I. 2014/2401\)](#), rules 1, 7

*Surrender and cancelling entry that licences available as of right*

**Surrender**

- 42.** The notice of an offer by a proprietor to surrender a patent must be in writing and include—
- (a) a declaration that no action is pending before the court for infringement or revocation of the patent; or
  - (b) where such an action is pending, the particulars of the action.

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

- 43.—**(1) An application under section 46(1) must be made on Patents Form 28.
- (2) Where an entry is made in the register to the effect that licences under a patent are to be available as of right, the comptroller must advertise the entry in the journal.
- (3) An application under section 47(1) for the cancellation of an entry made under section 46 must be made on Patents Form 30.
- (4) The period prescribed for the purposes of section 47(3) is two months [<sup>F9</sup>beginning immediately after] the date on which the entry was made under section 46.

**Textual Amendments**

**F9** Words in [rule 43\(4\)](#) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with [rule 4](#))

**Changes to legislation:**

There are currently no known outstanding effects for the The Patents Rules 2007, PART 3.