

---

STATUTORY INSTRUMENTS

---

**2004 No. 2358**

**PATENTS**

**The Patents (Amendment) Rules 2004**

|                               |         |                            |
|-------------------------------|---------|----------------------------|
|                               |         | <i>22nd September</i>      |
| <i>Made</i>                   | - - - - | <i>2004</i>                |
| <i>Laid before Parliament</i> |         | <i>24th September 2004</i> |
| <i>Coming into force</i>      | - -     | <i>1st January 2005</i>    |

The Secretary of State, in exercise of the powers conferred upon her by section 123 of the Patents Act 1977(1), and having had regard to the matters specified by article 7 of the Department of Trade and Industry (Fees) Order 1988(2), hereby makes the following Rules—

**Citation and commencement**

1.—(1) These Rules may be cited as the Patents (Amendment) Rules 2004.

(2) These Rules shall come into force on 1st January 2005 immediately after the Regulatory Reform (Patents) Order 2004(3) has come into force.

**Amendment of the Patents Rules 1995**

2. The Patents Rules 1995(4) shall be amended as follows.

3. For rule 6 there shall be substituted—

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

6.—(1) Subject to paragraph (2) and rule 6A(4), a declaration for the purposes of section 5(2) shall be made at the time of filing the application for a patent.

(2) Subject to rule 6A(4), a declaration for the purposes of section 5(2) may be made after the date of filing provided that—

(a) it is made on Patents Form 3/77;

---

(1) 1977 c. 37; amendments of the Act relevant to these Rules are made by the Regulatory Reform (Patents) Order 2004 (SI 2004/2357), and by paragraph 26(4) of Schedule 2 to the Patents Act 2004 (c. 16) which was brought into force on 22nd September 2004 by SI 2004/2177 (C. 94).

(2) SI 1988/93, as amended by SI 1990/1473, which was made under section 102 of the Finance (No. 2) Act 1987 (c. 51). See the matters specified in Part IV of Schedule 1 and Parts I and II of Schedule 2 to that Order.

(3) SI 2004/2357.

(4) SI 1995/2093, as amended by SI 1999/1092, 1999/1899, 1999/3197, 2001/1412, 2002/529, 2003/513 and 2004/2177 (C. 94).

- (b) it is made before the end of the period of sixteen months starting immediately following the date of filing of the earlier relevant application (or if there is more than one, the earliest of them) specified in that declaration; and
  - (c) the condition in paragraph (3) is met.
- (3) The condition is that—
- (a) the applicant has not made a request under section 16(1) to publish the application during the period prescribed for the purposes of that section; or
  - (b) any request made was withdrawn before the preparations for the publication of the application by the Patent Office had been completed.
- (4) A declaration for the purposes of section 5(2) shall specify—
- (a) the date of filing of each earlier relevant application; and
  - (b) the country in or for which it was made.
- (5) In the case of a new application to which section 15(9) applies, no declaration shall be made which has not also been made in or in connection with the earlier application.
- (6) For the purposes of rules 6B and 6C, “priority application” means an earlier relevant application specified in the declaration.

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

- 6A.**—(1) The period prescribed for the purposes of section 5(2A)(b) shall be the period of two months.
- (2) A request under section 5(2B) may only be made where—
- (a) it is made on Form 3/77;
  - (b) it is made before the end of the period allowed under section 5(2A)(b);
  - (c) it is supported by evidence of why the application in suit was not filed before the end of the period allowed under section 5(2A)(a); and
  - (d) the condition in paragraph (3) is met.
- (3) The condition is that—
- (a) the applicant has not made a request under section 16(1) to publish the application during the period prescribed for the purposes of that section; or
  - (b) any request made was withdrawn before the preparations for the publication of the application by the Patent Office had been completed.
- (4) Where an applicant makes a request under section 5(2B), he shall make the declaration for the purposes of section 5(2) at the same time as making that request.

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

- 6B.**—(1) In respect of each priority application to which this paragraph applies the applicant shall, before the end of the period of sixteen months starting on the declared priority date, furnish to the Patent Office the file number of that application; otherwise the declaration made for the purposes of section 5(2), in so far as it relates to the priority application, shall be disregarded.
- (2) In respect of each priority application to which this paragraph applies the applicant shall, before the end of the period of sixteen months starting on the declared priority date, furnish to the Patent Office a copy of that application duly certified by the authority with which it was filed or otherwise verified to the satisfaction of the comptroller; otherwise

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

- (3) Paragraph (1) applies to every priority application except where—
  - (a) the application in suit is treated as an application for a patent under the Act, by reason of a direction given under section 81, and the file number of the priority application was indicated in compliance with rule 38(2) of the Implementing Regulations to the European Patent Convention; or
  - (b) the application in suit is an international application for a patent (UK) and the file number of the priority application was indicated in compliance with rule 4.10(a) and (b) of the Regulations made under the Patent Co-operation Treaty.
- (4) Paragraph (2) applies to every priority application except where—
  - (a) the application in suit is treated as an application for a patent under the Act, by reason of a direction given under section 81, and a certified copy of the priority application was filed in compliance with rule 38(3) of the Implementing Regulations to the European Patent Convention;
  - (b) the application in suit is an international application for a patent (UK) and a certified copy of the priority application was filed in compliance with rule 17.1 of the Regulations made under the Patent Co-operation Treaty; or
  - (c) the priority application or a copy of the priority application is kept at the Patent Office.

#### **Translation of priority documents**

**6C.**—(1) The comptroller may direct the applicant to comply with the requirements of paragraph (4), if—

- (a) a copy of the priority application—
  - (i) was furnished in accordance with rule 6B(2);
  - (ii) was filed in compliance with rule 38(3) of the Implementing Regulations to the European Patent Convention;
  - (iii) was filed in compliance with rule 17.1 of the Regulations made under the Patent Co-operation Treaty; or
  - (iv) has been made by the comptroller in accordance with rule 112A(2);
- (b) that copy is in a language other than English; and
- (c) the matters disclosed in the priority application are relevant to the determination of whether or not an invention, to which the application in suit relates, involves an inventive step.

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

(3) The comptroller shall not specify a period under paragraph (2) that ends after the grant of the patent.

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

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

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

4. Rule 15 (procedure where applicant is not the inventor or sole inventor) shall be amended as follows.

(1) For paragraph (1) there shall be substituted—

“(1) Subject to rules 26, 81(3), 82(3), 85(7) and 85(7A)(a), the period prescribed for the purposes of section 13(2) shall be—

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

(1A) A statement filed under section 13(2) shall be made on Patents Form 7/77.”.

(2) Paragraphs (3) and (4) shall be omitted.

5.—(1) Rule 16 (applications for the grant of patents under sections 14 and 15) shall be amended as follows.

(2) After paragraph (1) there shall be inserted—

“(1A) Where the documents filed at the Patent Office to initiate an application for a patent did not include the applicant’s name and address, the comptroller shall notify the applicant that his name and address are required.

(1B) Where the applicant has been notified under paragraph (1A), he shall, before the end of the period of two months starting on the date of the notification, file his name and address; otherwise the comptroller may refuse his application.”.

(3) After paragraph (4) there shall be inserted—

“(5) Where—

- (a) the documents filed at the Patent Office to initiate an application for a patent include something which is or appears to be a description of the invention in a language other than English; and
- (b) the applicant has not filed—
  - (i) a translation into English of that thing; or
  - (ii) a description of the invention in English, with a declaration that it is a complete and accurate translation into English of that thing,

the comptroller shall notify the applicant that a translation or a description with a declaration is required.

(6) Where the applicant has been notified under paragraph (5), he shall, before the end of the period of two months starting on the date of the notification, file either a translation or a description with a declaration; otherwise the comptroller may refuse his application.”.

6. After rule 22 there shall be inserted—

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

**22A.**—(1) A reference made under section 15(1)(c)(ii) shall include—

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

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

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

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

7. For rule 23 there shall be substituted—

**“Missing parts**

**23.**—(1) Subject to paragraph (2), the period prescribed for the purposes of section 15(5)(b) and (6) shall be the period starting on the date of filing of the application for a patent and ending on the date of the preliminary examination.

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

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

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

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

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

- (a) the earlier relevant application or applications do not contain every missing part filed under section 15(5);
- (b) the applicant fails to furnish to the Patent Office copies of all earlier relevant applications, duly certified by the authority with which they were filed, before the end of the relevant period.

(6) Paragraph (5)(b) does not apply in respect of an earlier relevant application where that application or a copy of the application is kept at the Patent Office.

(7) The relevant period is the first to expire of—

- (a) the period of sixteen months starting on the declared priority date; or
- (b) the period of four months starting on the date the request was made under section 15(7)(b).”.

8.—(1) For rules 25 and 26 there shall be substituted—

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

**25.**—(1) Subject to paragraph (4), the period prescribed for the purposes of section 15(10) (a) and (b)(i) shall be the relevant period.

(2) Subject to paragraph (4) and rules 81(3), 82(3), 85(7) and 85(7A)(b), the period prescribed for the purposes of section 15(10)(c) and (d) and section 17(1) shall be the relevant period.

(3) Subject to paragraph (4), the period prescribed for the purpose of section 15(10)(b)(ii) shall be the period of four months starting on the date of filing.

(4) Where a new application is filed under section 8(3), 12(6), 15(9) or 37(4) after the relevant period has expired—

- (a) subject to sub-paragraph (b), the period prescribed for the purposes of section 15(10) (a) to (d) and section 17(1) shall be the period of two months starting on the initiation date; or
- (b) where it is filed less than six months before the period prescribed by rule 34 is due to expire (including the expiry of any extension of that period), the period prescribed for the purposes of section 15(10) (a) to (d) and section 17(1) shall end on the initiation date.

(5) The relevant period is—

- (a) where there is no declared priority date, the period of twelve months starting on the date of filing of the application; or
- (b) where there is a declared priority date, the last to expire of—
  - (i) the period of twelve months starting on the declared priority date; or
  - (ii) the period of two months starting on the date of filing of the application.

**Extensions for new applications**

**26.** Where a new application is filed under section 8(3), 12(6), 15(9) or 37(4) after the expiry of the periods prescribed by rule 6B or rule 15(1) (or after the expiry of any extensions of those periods)—

- (a) the requirements of rules 6 to 6B and rule 15 shall be complied with on the initiation date;
- (b) the requirements of paragraph 1(2)(a)(ii), (2)(a)(iii) and (3) of Schedule 2 shall be complied with on the initiation date (or, if later, before the end of the relevant period ascertained under paragraph 1(3) of that Schedule).”.

**9.** For rules 28 and 29 there shall be substituted—

**“Preliminary examination under section 15A**

**28.**—(1) On a preliminary examination the examiner shall determine whether the application complies with the requirements of rules 6 to 6C.

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

**Search under section 17**

**28A.**—(1) A request under section 17(1)(c)(i) for a search shall be made on Patents Form 9A/77.

(2) 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 made under section 17(5).

**Procedure where earlier application made**

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

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

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

(2) Where the comptroller has notified the applicant under paragraph (1), the applicant shall, before the end of the relevant period, provide the comptroller with a corrected date; otherwise the declaration, in so far as it relates to the earlier relevant application, shall be disregarded.

(3) The relevant period is the period of two months starting on the date of the notification under paragraph (2).

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

**10.** After rule 36 there shall be inserted—

**“Reinstatement of applications under section 20A**

**36A.**—(1) Any request under section 20A for the reinstatement of an application shall be made before the end of the relevant period.

(2) The relevant period is the first to expire of—

- (a) the period of twelve months starting on the date on which the application was terminated; or
- (b) the period of two months starting on the date on which the removal of the cause of non-compliance occurred.

(3) The request shall be made on Patents Form 14/77 supported by evidence of the statements made in it.

(4) Where the comptroller is required to publish a notice under section 20A(5), it shall be published in the Journal.

(5) Where, upon consideration of the evidence provided in accordance with paragraph (3), the comptroller is not satisfied that a case for an order under section 20A has been made out, he shall notify the applicant accordingly.

(6) Where the comptroller has notified the applicant under paragraph (5), the applicant may, before the end of the period of one month starting on the date of the notification, request to be heard by the comptroller.

(7) Where the applicant requests a hearing under paragraph (6), the comptroller shall give the applicant an opportunity to be heard, after which he shall determine whether the request under section 20A shall be allowed or refused.

(8) Where the comptroller reinstates the application after a notice was published under paragraph (4), he shall advertise in the Journal the fact that he has reinstated the application.

(9) In determining the date on which the removal of the cause of non-compliance occurred, the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.”.

11. In rule 45 (alteration of name), for paragraph (2) there shall be substituted—

“(2) Where the comptroller has doubts about whether he should make the alteration to a name—

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

12.—(1) Rule 46 (registrations under section 33) shall be amended as follows.

(2) In paragraph (2) for the words from “such documentary” to “establish” there shall be substituted “documentation establishing”.

(3) In paragraph (3) for the word “evidence” there shall be substituted “documentation”.

13. In rule 47 (request for correction of error), for paragraph (2) there shall be substituted—

“(2) Where the comptroller has doubts about whether there is an error—

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

(3) Where the comptroller is satisfied that an error has been made he shall make such correction as he may agree with the proprietor of the patent (or, as the case may be, the applicant).”.

14.—(1) For rule 110 there shall be substituted—

**“Alteration of time limits**

**110.**—(1) The comptroller may, if he thinks fit, extend (or further extend) any period of time prescribed by these Rules except a period prescribed by the rules listed in Parts 1 and 3 of Schedule 4A.

(2) The comptroller may, if he thinks fit, shorten any period of time prescribed by the rules listed in Part 2 of Schedule 4A.

(3) The comptroller shall extend, by a period of two months, any period of time prescribed by the rules listed in Part 3 of Schedule 4A where—

- (a) a request is filed on Patents Form 52/77;
- (b) no previous request has been made under this paragraph;
- (c) that request is filed before the end of the period of two months starting on the date the relevant period of time expired.

(4) The comptroller may, if he thinks fit, extend (or further extend) any period of time prescribed by the rules listed in Part 3 of Schedule 4A where—

- (a) a request is filed on Patents Form 52/77; and
- (b) unless the comptroller otherwise directs, the person making the request has furnished evidence supporting the grounds of the request.

(5) Where the request under paragraph (4) has been granted the comptroller shall notify the person who made the request accordingly.



(6) Where a person is notified under paragraph (5) that his request has been granted, he shall, before the end of the period of two months starting on the date of the notification, file Patents Form 53/77; otherwise the extension granted under paragraph (4) shall have no effect.

(7) A request under paragraph (3) or (4) for more than one period of time to be altered may only be made on single form where, if the request were granted, all the altered periods of time would expire on the same date.

(8) Any alteration made under paragraphs (1), (2) or (4) shall be made—

(a) after giving the parties such notice, and

(b) subject to such conditions,

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

(9) Subject to paragraph (10), an extension may be granted under paragraph (1) or (4) notwithstanding the period of time prescribed by the relevant rule has expired.

(10) No extension may be granted in relation to the periods of time prescribed by the rules listed in Part 4 of Schedule 4A after the expiry of the period of two months starting immediately after the period of time as prescribed (or previously extended) has expired.

(11) Where—

(a) 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

(b) 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 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.”.

(2) After Schedule 4 there shall be inserted, as Schedule 4A, the Schedule which is set out in Schedule 1 to these Rules (new Schedule 4A to the Patents Rules 1995).

15. After rule 110 there shall be inserted—

**“Extension of time limits specified by comptroller**

**110A.**—(1) A request made under section 117B(2) shall be—

(a) in writing; and

(b) made before the end of the period prescribed by paragraph (2).

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

(3) A request made to the comptroller under section 117B(4)(b) to further extend a period shall be in writing.”.

16. After rule 112 there shall be inserted—

**“Copies kept at the Patent Office**

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

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

17. After rule 113 there shall be inserted—

**“Establishing the accuracy of translations**

**113A.** If the comptroller has reasonable doubts about the accuracy of any translation of a document that has been filed at the Patent Office by any person in accordance with the Act or these Rules—

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

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

**Consequential amendments**

18. Schedule 2 to these Rules (consequential amendments) shall have effect.

**Amendments to the Patents (Fees) Rules 1998**

19. Schedule 3 to these Rules (amendments to the Patents (Fees) Rules 1998) shall have effect.

**Transitional provision**

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

(2) Rules 3, 5 to 9 of these Rules and paragraphs 4, 6, 7 and 9 of Schedule 2 to these Rules shall not apply in respect of any application to which this rule applies.

(3) Where this rule applies to an application, amended rule 110 of the Patents Rules 1995 applies to that application with the following modification—

- (a) any reference to Part 1 of Schedule 4A shall be construed as a reference to the rules listed in paragraph (2) of unamended rule 110;
- (b) any reference to Part 2 of Schedule 4A shall be construed as a reference to the rules listed in paragraph (2A) of unamended rule 110;
- (c) any reference to Part 3 of Schedule 4A shall be construed as a reference to the rules listed in paragraph (3) of unamended rule 110;
- (d) any reference to Part 4 of Schedule 4A shall be construed as a reference to the following rules— 15(1), 24, 25, 26 (so far as it relates to section 15(1)), 33, 34, 81(3), 82 (3), 83(1), 85(1), (2)(a), (5A), (7) and (7A).

and any reference in unamended rule 110 or in sub-paragraph (d) to a rule shall be construed as a reference to that rule as it applies to the application.

(4) In paragraph (3)—

“amended rule 110” means rule 110 of the Patents Rules 1995 in the form it is immediately after these Rules have come into force;

“unamended rule 110” means rule 110 of the Patents Rules 1995 in the form it was immediately prior to these Rules coming into force.

22nd September 2004

*Sainsbury of Turville,*  
Parliamentary Under-Secretary of State for  
Science and Innovation,,  
Department of Trade and Industry

*Status: This is the original version (as it was originally made). This item of legislation is currently only available in its original format.*

SCHEDULE 1

Rule 14(2)

NEW SCHEDULE 4A TO THE PATENTS RULES 1995

“SCHEDULE 4A

Rule 110

ALTERATION OF TIME LIMITS

PART 1

Periods of time that cannot be altered

- rule 6(2)(b) (declaration of priority for the purposes of section 5(2) made after the date of filing)
- rule 6A(1) (period for making a request to the comptroller for permission to make a late declaration of priority)
- rule 26 (extensions for new applications), so far as it relates to rules 6 and 6A
- rule 36A(1) (application to reinstate a terminated application)
- rule 39(1) and (2) (renewal of patents)
- rule 40(2) (notice of opposition to application to amend the specification after grant)
- rule 41(1) (application to restore a lapsed patent)
- rule 43(2) (notice of opposition to the surrender of a patent)
- rule 59(2) (application for compensation of employees for certain inventions)
- rule 64(1) (application to cancel entry that patent licence is available as of right)
- rule 65(1) (opposition to cancellation of entry that patent licence is available as of right)
- rule 71(1) (opposition to a compulsory licence)
- rule 78(2) (opposition to an amendment of patent under section 75)
- rule 81(1) (request for a direction under section 81)
- rule 82(1) (request from a foreign industrial property office for a direction under section 81)
- rule 91(4) (opposition to the correction of an error in a patent or application)
- rule 110A (extension of time limits specified by comptroller)
- paragraph 5(2) and (4) of Schedule 2 (new deposits of biological material)

PART 2

Periods of time that may be shortened under rule 110(2)

- rule 7(3) to (5) (entitlement to grant of a patent)
- rule 8(3), (5), (6) and (7) (entitlement to right under the application)
- rule 9(2) (request for a licence to work an invention after transfer)
- rule 12(2) (service of counter-statement in relation to a request under section 10 or 12(4))
- rule 13(2) (objection to licence terms)
- rule 14(3) (service of counter-statement in relation to the mentioning of an inventor)
- rule 40(4) (service of counter-statement in amendment proceedings)
- rule 43(4) (service of counter-statement in surrender proceedings)

rule 54(3) to (5) (determination of right to patent after grant)  
rule 56 (new applications)  
rule 57(1) (request for licence after transfer of a patent)  
rule 58(2) (service of counter-statement after reference under section 38(5))  
rule 59(3) to (5) (application for compensation of employees)  
rule 62(3) and (4) (proceedings involving licenses of right)  
rule 70(1) (request to be heard in respect of an application under section 48, 51 or 52)  
rule 71(3) (service of counter-statement in opposition in proceedings relating to compulsory licences)  
rule 72(3) to (7) (infringement proceedings before the comptroller)  
rule 73(3) to (5) (validity in infringement proceedings before the comptroller)  
rule 74(2) to (4) (procedure for a declaration of non-infringement)  
rule 75(3) to (5) (procedure on application for revocation under section 72)  
rule 77(1) (observations and opportunity to amend on revocation under section 73)  
rule 88(1), (1A), (1B) and (3) (comptroller's discretionary powers)

### PART 3

Periods of time that may be extended under rules 110(3) or 110(4)

rule 6B(1) and (2) (filing of information and priority documents)  
rule 15(1) (filing of statement of inventorship and the right to be granted a patent)  
rule 23 (missing parts)  
rule 25(1), (2) and (4)(a) (periods prescribed for the purposes of section 15(10) and 17(1))  
rule 26 (extensions for new applications), except so far as it relates to rule 6 and 6A  
rule 33(2), (3) and (5) (request for substantive examination)  
rule 34 (period for putting an application in order)  
rule 41(4) (payment of unpaid renewal fee after restoration)  
rule 81(3) (filing of a request and fee to convert an application for European patent (UK))  
rule 82(3) (filing a request and fee to convert an application from another convention country)  
rule 83(3) (request for substantive examination when section 81(2) applies)  
rule 85(1), (5A), (7) and (7A) (international applications for patents)  
paragraph 1(3) of Schedule 2 (filing of information in relation to the deposit of biological matter)  
paragraph 2 of Schedule 4 (filing of a translation of European patent (UK) specifications)

### PART 4

Periods of time to which rule 110(8) and (10) relate

rule 15(1) (filing of statement of inventorship)  
rule 16(1B) and (6) (filing of name and address and translations)  
rule 24 (new applications under section 15(9))

*Status: This is the original version (as it was originally made). This item of legislation is currently only available in its original format.*

- rule 25 (periods prescribed for the purposes of section 15(10) and 17(1))
- rule 26 (extensions for new applications), so far as it relates to rule 15(1)
- rule 33 (request for substantive examination under section 18)
- rule 34 (period for putting application in order)
- rule 81(3) (request under section 81(2)(b)(i))
- rule 82(3) (request under section 81(2)(b)(ii))
- rule 83(1) (request for substantive examination when section 81(2) applies)
- rule 85(1), (2)(a), (5A), (7), (7A)(a) to (c) (international applications for patents)”

## SCHEDULE 2

Rule 18

### CONSEQUENTIAL AMENDMENTS

1. The Patents Rules 1995 shall be amended as follows.
2. In rule 2 (interpretation), in the appropriate places there shall be inserted—
  - ““the initiation date” shall be the date the new application was initiated by documents, containing the information mentioned in any of paragraphs (a) to (c) of section 15(1), being filed at the Patent Office;”;
  - ““termination” has the meaning given by section 20B(7) and “terminated” shall be construed accordingly.”.
3. In each of the following provisions—
  - (a) the heading of rule 24;
  - (b) rule 24(1);
  - (c) rule 33(3);
  - (d) rule 33(5);
  - (e) rule 34(1)(c);
  - (f) rule 102(1)(b);for the figure “15(4)”, wherever it appears, there shall be substituted “15(9)”.
4. In rule 32 (searches under section 17(6) and (8)), in paragraph (3) for the words “Form 9/77” there shall be substituted “Form 9A/77”.
- 5.—(1) Rule 40(6) (amendment of specifications after grant) shall be amended as follows.
  - (2) In sub-paragraph (a) the words from “verified to the” to “original text” (where it first appears) shall be omitted.
  - (3) The words from “verified to his” to “original text” shall be omitted.
6. In rule 81 (procedure for making request under section 81(2)(b)(i)), for paragraphs (3) and (4) there shall be substituted—
  - “(3) Where a request has been made under section 81(2)(b)(i), the period prescribed for the purposes of sections 13(2), 15(10)(d) and 81(2)(c) shall be the period of two months starting on the date the comptroller received the request mentioned in paragraph (1).”.
7. In rule 82 (procedure where section 81(2)(b)(ii) applies), for paragraphs (3) and (4) there shall be substituted—

“(3) Where a request has been transmitted under section 81(2)(b)(ii), the period prescribed for the purposes of sections 13(2), 15(10)(d) and 81(2)(c) shall be the period of four months starting on the date of the notification under paragraph (2).”.

**8.**—(1) Rule 85 (international applications for patents) shall be amended as follows.

(2) Paragraph (3)(c) and the word “and” immediately preceding it shall be omitted.

(3) In paragraph (7) for the words “thirty two months” there shall be substituted “thirty three months”.

**9.** In both of the following provisions—

(a) rule 85(7); and

(b) rule 85(7A)(b);

for the figure “15(5)(b)” there shall be substituted “15(10)(c) and (d)”.

**10.** In rule 91 (correction of errors in patents and applications), after paragraph (3) there shall be inserted—

“(3A) Where the comptroller is required to publish a notice under section 117(3), it shall be published in the Journal.”.

**11.** In rule 107(2) (supporting statements or evidence) after the words “are rules” there shall be inserted “ 36A,”.

**12.**—(1) Rule 113 (translations) shall be amended as follows.

(2) In paragraph (1)—

(a) for the words “rules 6,” to “Schedule 4” there shall be substituted “rules 6 to 6C, 16, 22A, 40, 81, 82 and 85 and paragraph (3)”;

(b) the words from “, verified” to “directs” shall be omitted.

(3) In both paragraphs (3) and (4) the words from “verified” to “original text thereof” shall be omitted.

(4) In paragraph (5) the words from “, verified” to “original text thereof” shall be omitted.

(5) Paragraph (6) shall be omitted.

**13.** Paragraph 5 of Schedule 4 (verification of translation) shall be omitted.

### SCHEDULE 3

Rule 19

#### AMENDMENTS TO THE PATENTS (FEES) RULES 1998

**1.** Part A of the Schedule to the Patents (Fees) Rules 1998(5) shall be amended as follows.

**2.** The entry for Patents Form 1/77 shall be omitted.

**3.** Before the entry for Patents Form 7/77 there shall be inserted—

---

3/77

On making a declaration for the purposes of section 5(2), after the date of filing, in relation to an earlier

40

**Status:** This is the original version (as it was originally made). This item of legislation is currently only available in its original format.

relevant application filed during the period allowed by section 5(2A)(a) (rule 6(2))

On request for permission to make a late declaration of priority under section 5(2B) (rule 6A) 150

**4.** In the entry for Patents Form 9/77(6), for the equivalent entry, there shall be substituted—

On request for a further search under section 17(6) or payment for a supplementary search under section 17(8) 100

**5.** After the entry for Patents Form 9/77 there shall be inserted—

9A/77(7)

On request for a search under section 17(1)—

- (a) (a) in respect of an international application for a patent (UK) which is treated as an application for a patent under the Act and which has already been the subject of a search by the International Searching Authority in accordance with the Patent Co-operation Treaty. 80

- (b) (b) in respect of any other application 100

On request for a further search under section 17(6) or payment for a supplementary search under section 17(8) 100

**6.** Before the entry for Patents Form 15/77 there shall be inserted—

(6) Patents Form 9/77 is only used in relation to applications to which articles 20 to 22 of the Regulatory Reform (Patents) Order 2004 apply.  
 (7) Patents Form 9A/77 is only used in relation to applications to which articles 20 to 22 of the Regulatory Reform (Patents) Order 2004 do not apply.



|  |  |                   |
|--|--|-------------------|
| 14/77  | On making a request for reinstatement of a terminated application  | 150               |
| 7.—(1) For the entry for Patents Form 58/77 to the end of Part A there shall be substituted— |  |                   |
| 58/77  | On declaration that licences of right shall not extend to excepted uses<br>The application fee—<br>(a) (a) in respect of an international application for a patent (UK) which is treated as an application for a patent under the Act<br>(b) (b) in respect of any other application (including an application treated as an application under the Act following a direction under section 81) | —<br>—<br>—<br>30 |
|  | On request for information about date of payment of any renewal fee under rule 48 or to inspect the register under rule 49   | —                 |
|  | On request to inspect documents filed or kept at the Patent Office, under rule 93  | —                 |
|  | On entry of an international application for a patent (UK) into the national phase (section 89A(3))  | 30                |
|  | On application for entry of order or direction of court in the register under rule 53  | —                 |
|  | On application to register copy of entry made in European Register of Patents under rule 79(2)   | —                 |
|  | On request for conversion of European patent application under rule 81   | —                 |

**Status:** This is the original version (as it was originally made). This item of legislation is currently only available in its original format.

|   |    |
|---|----|
| On request for publication or translation under rule 85(6)  | 12 |
| On application to the comptroller under rule 85(8) or 85(12) for an international application to be treated as an application under the Act | —  |
| On application for order for evidence to be obtained in the United Kingdom under rule 86  | —  |
| Transmittal fee to Receiving Office under the Patent Co-operation Treaty rule 118   | 55 |

---



---

## EXPLANATORY NOTE

*(This note is not part of the Rules)*

These Rules amend the Patents Rules 1995 (SI 1995/2093, as amended) (“the 1995 Rules”) and the Patents (Fees) Rules 1998 (SI 1998/1778, as amended) (“the Fees Rules”). The amendments made enable the 1995 Rules to be administered in conformity with the Patent Law Treaty and the Regulations Under the Patent Law Treaty (both of which were adopted at Geneva on 1<sup>st</sup> June 2000). The amendments required to the Patents Act 1977 (c. 37) (“the Act”) to conform with that Treaty were made by the Regulatory Reform (Patents) Order 2004 (SI 2004/2357) (“the 2004 Order”).

These Rules prescribe time periods and other requirements for the purposes of sections 5, 13, 15, 17, 18, 20A, 81 and 117, 117B of the Act, and fix fees in connection with various matters under the Act.

Rule 3 substitutes new rules 6 to 6C for rule 6 in the 1995 Rules. The new rules 6 to 6C reflect changes made by the 2004 Order to section 5 of the Act. In particular, the new rule 6A enables a declaration of priority to be made more than twelve months after the priority date. The new rule 6C means in future an applicant will only have to provide a translation of a priority application when the comptroller directs him to do so.

Rule 4 amends rule 15 of the 1995 Rules. This amendment is consequential on other amendments made to the Rules.

Rule 5 amends rule 16 of the 1995 Rules. This amendment relates to the more liberal filing requirements of section 15 of the Act (as substituted by the 2004 Order). Where an applicant does not file his name and address or where a suitable translation of the description has not been filed the comptroller will notify the applicant accordingly.

Rule 6 inserts a new rule 22A into the 1995 Rules. The new rule is a consequence of the applicant now being permitted to file a reference to an earlier relevant application to obtain a date of filing.

Rule 7 substitutes a new rule 23 for rule 23 in the 1995 Rules. This new rule is a consequence of allowing an applicant to file missing parts (missing drawings and missing parts of descriptions) rather than just missing drawings.

Rule 8 substitutes new rules 25 and 26 for rules 25 and 26 in the 1995 Rules. The new rule 25 sets out the periods within which the applicant must carry out certain actions. New rule 26 sets out certain modifications to time periods where a new application is filed.

Rule 9 substitutes new rules 28, 28A and 29 for rules 28 and 29 in the 1995 Rules. The new rules 28 and 28A set out the procedure for the new preliminary examination under section 15A of the Act (inserted by the 2004 Order). Rule 29 sets out a new procedure for correcting erroneous declarations under section 5.

Rule 10 inserts a new rule 36A into the 1995 Rules. This rule prescribes the procedure for applying for reinstatement of an application under section 20A of the Act (inserted by the 2004 Order).

Rules 11 to 13 amend respectively rules 45, 46 and 47 of the 1995 Rules. These amendments limit the obligation on applicants to provide evidence to those situations where the comptroller has doubts about the relevant issue.

Rule 14 substitutes a new rule 110 for rule 110 in the 1995 Rules and inserts a new Schedule 4A (found in Schedule 1 to these Rules) into the 1995 Rules. This amendment is intended to clarify when a period of time can be altered and when the applicant has to apply for reinstatement of his application under section 20A of the Act (inserted by the 2004 Order).

Rule 15 inserts a new rule 110A into the 1995 Rules. This amendment sets out the limitations of when a request can be made under section 117B of the Act (inserted by the 2004 Order).

Rule 16 inserts a new rule 112A into the 1995 Rules. This rule creates an obligation on the comptroller to make copies of an application in certain circumstances.

Rule 17 inserts a new rule 113A into the 1995 Rules. This amendment sets out the circumstances when the comptroller can require an applicant to establish that a translation of a document is accurate.

Rule 20 provides a transitional provision.

Schedule 2 includes a number of amendments that are consequential upon the changes made by the 2004 Order and these Rules.

Schedule 3 amends the Fees Rules. The effect of those amendments is as follows—

- (a) A new Patents Form 3/77 has been introduced. An applicant will have to pay a fee of £40 when they use this form to make a declaration for the purposes of section 5(2) of the Act after the date of filing, in relation to an earlier relevant application filed during the period allowed by section 5(2A) of the Act. Further, an applicant who asks permission to make a late declaration of priority under section 5(2B) of the Act will have to pay a fee of £150;
- (b) The fee for a further or supplementary search in respect of an application to which articles 20 to 22 of the 2004 Order applies will be reduced to £100. All other fees attached to Patents Form 9/77 remain unchanged. This Form will only be used in respect of an application to which those articles apply;
- (c) Any application in respect of which articles 20 to 22 of the 2004 Order do not apply (a new application) will have to pay the fees attached to new Patents Form 9A/77. The fees for that new Form are reduced to reflect the introduction of the application fee. Patents Form 9A/77 will only be used in respect of applications to which those articles do not apply;
- (d) A new Patents Form 14/77 has been introduced for the reinstatement of an application under section 20A of the Act (which was inserted by the 2004 Order). A fee of £150 will have to be paid to make such an application;
- (e) The filing fee (which was set at zero) has been abolished; there is now an application fee in its place. The application fee of £30 represents the proportion of the old search fee that covered preliminary examination.

A Regulatory Impact Assessment is available; this assessment relates to both these Rules and the 2004 Order. Copies of the assessment have been placed in the libraries of both Houses of Parliament

**Status:** *This is the original version (as it was originally made). This item of legislation is currently only available in its original format.*

and are also available from the Patents Directorate, The Patent Office, Concept House, Cardiff Road, Newport NP10 8QQ.