

1990 No. 1697

PATENTS

The Patents (Fees) Rules 1990

Made - - - - - 16th August 1990

Laid before Parliament 20th August 1990

Coming into force 10th September 1990

The Secretary of State, in exercise of the powers conferred upon him by section 123(1), (2) and (3) of, and paragraph 14 of Schedule 4 to, the Patents Act 1977(a), of the power conferred upon him by the Department of Trade and Industry (Fees) Order 1988(b), and of all other powers enabling him in that behalf, after consultation with the Council on Tribunals pursuant to section 10(1) of the Tribunals and Inquiries Act 1971(c) and with the consent of the Treasury pursuant to subsection (4) of the said section 123, hereby makes the following Rules:-

1.—(1) These Rules may be cited as the Patents (Fees) Rules 1990 and shall come into force on 10th September 1990.

(2) The Patents (Fees) Rules 1989(d) are hereby revoked.

2. These Rules shall be construed as one with the Patent Rules 1982(e) and, to the extent that they continue to apply in relation to existing patents and existing applications, to the Patents Rules 1968(f).

3. The fees to be paid in respect of any matters arising under the Patents Act 1949(g) or the Patents Act 1977 shall be those specified in the Schedule to these Rules; and in any case where a form specified in the Schedule as the corresponding form in relation to any matter is required by the Patents Rules 1968 or the Patents Rules 1982 to be used, that form shall be accompanied by the fee specified in respect of that matter or, where payment may be made within a prescribed period of time after the form has been filed, the fee so specified shall be paid within that period.

13th August 1990

Douglas Hogg
Department of Trade and Industry

We consent to the making of these Rules.

Michael Fallon
Kenneth Carlisle
Two of the Lords Commissioners
of Her Majesty's Treasury

16th August 1990

(a) 1977 c.37.

(b) S.I. 1988/93, as amended by S.I. 1990/1473, which was made under section 102 of the Finance (No. 2) Act 1987 (c.51). The relevant provisions of that Order are article 7 and Part IV of Schedule 1.

(c) 1971 c.62.

(d) S.I. 1989/899.

(e) S.I. 1982/717; relevant amending instruments are S.I. 1985/1166, 1987/288, 1988/2089.

(f) S.I. 1968/1389, revoked with savings by S.I. 1978/216.

(g) 1949 c.87.

SCHEDULE
FEEs PAYABLE

Rule 3

PART A

(In this Part of this Schedule, any reference to a section is a reference to that section of the Patents Act 1977 and any reference to a rule is a reference to that rule of the Patents Rules 1982.)

| <i>Number of corresponding Patents Form</i> | <i>Item</i> | <i>Amount</i> |
|---|--|---------------|
| | | £ |
| 1/77 | On request for the grant of a patent (the filing fee) | 15 |
| 2/77 | On reference under section 8(1), 12(1) or 37(1) | 32 |
| 3/77 | On application under section 8(5) or 37(3) for authorisation by comptroller | 32 |
| 4/77 | On request for directions under section 10 or 12(4) | 32 |
| 5/77 | On reference under section 11(5) or 38(5) to determine the question of a licence | 32 |
| 6/77 | On application to comptroller under section 13(1) and/or 13(3) | 24 |
| 7/77 | Statement of inventorship and of right to the grant of a patent | — |
| 8/77 | On request for comptroller's certificate authorising the release of a sample from a culture collection | 11 |
| 9/77 | On request for preliminary examination and search or request for further search | 105 |
| 10/77 | On request for substantive examination | 120 |
| 11/77 | On request to amend application before grant | 27 |
| 12/77 | *On payment of renewal fee— | |
| | Before the expiration of the 4th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 5th year | 94 |
| | Before the expiration of the 5th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 6th year | 100 |
| | Before the expiration of the 6th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 7th year | 108 |
| | Before the expiration of the 7th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 8th year | 120 |
| | Before the expiration of the 8th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 9th year | 130 |
| | Before the expiration of the 9th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 10th year | 142 |
| | Before the expiration of the 10th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 11th year | 158 |
| | Before the expiration of the 11th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 12th year | 172 |

PART A (continued)

| <i>Number of corresponding Patents Form</i> | <i>Item</i> | <i>Amount</i> |
|---|---|---------------|
| | | £ |
| | Before the expiration of the 12th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 13th year | 194 |
| | Before the expiration of the 13th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 14th year | 214 |
| | Before the expiration of the 14th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 15th year | 238 |
| | Before the expiration of the 15th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 16th year | 262 |
| | Before the expiration of the 16th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 17th year | 286 |
| | Before the expiration of the 17th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 18th year | 308 |
| | Before the expiration of the 18th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 19th year | 342 |
| | Before the expiration of the 19th year from the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent and in respect of the 20th year | 378 |
| 13/77 | On extension of the period for payment of a renewal fee under section 25(4)– | |
| | Not exceeding one month | 20 |
| | Each succeeding month | 20 |
| | (but not exceeding six months) | |
| 14/77 | On application to amend specification after grant | 56 |
| 15/77 | On notice of opposition to amendment of specification after grant | 24 |
| 16/77 | On application for the restoration of a patent | 114 |
| 17/77 | Additional fee on the application for restoration of a patent | 114 |
| 18/77 | On offer to surrender a patent | — |
| 19/77 | On notice of opposition to offer to surrender a patent | 24 |
| 20/77 | On request for alteration of name, address or address for service in the register, for each patent or application | 3 |
| 21/77 | On application to register or to give notice of a transaction, instrument or event affecting the rights in a patent or application for a patent | 24 |
| | On each application covering more than one patent or application for a patent, the devolution of title being the same as in the first patent or application for a patent. For each additional request | 3 |
| 22/77 | On request for the correction of an error in the register or in any connected document | 17 |
| 23/77 | On request for miscellaneous information | Each 3 |
| 24/77 | On request for certificate of the comptroller– | |
| | (a) by impressed stamp | 3 |
| | (b) sealed and attached to documents | 12 |

PART A (continued)

| <i>Number of corresponding Patents Form</i> | <i>Item</i> | <i>Amount</i> |
|---|---|---------------|
| | | £ |
| 25/77 | On application for entry of order of court in the register | — |
| 26/77 | On application for compensation by employee | 32 |
| 27/77 | On application under section 41(8) in connection with an order made under section 40(1) or 40(2) | 32 |
| 28/77 | On application by proprietor for entry to be made in the register to the effect that licences under the patent are to be available as of right. | 13 |
| 29/77 | On application for settlement of terms of licence of right | 56 |
| 30/77 | On application by proprietor under section 47(1) for cancellation of entry in the register | 24 |
| 31/77 | On application under section 47(3) by person interested for cancellation of entry in the register | 24 |
| 32/77 | On notice of opposition to an application under section 47(1) or 47(3) for cancellation of entry in the register | 24 |
| 33/77 | On application under section 48(1) for a compulsory licence or entry in the register | 56 |
| 34/77 | On application by Crown in case of monopoly or merger | 56 |
| 35/77 | On notice of opposition to application made under section 48 or 51 .. | 24 |
| 36/77 | On reference to the comptroller of a dispute as to infringement | 56 |
| 37/77 | On application for declaration of non-infringement | 56 |
| 38/77 | On application for the revocation of a patent | 24 |
| 39/77 | On application to register copy of entry made in European Register of Patents | 10 |
| 40/77 | On payment of filing fee upon conversion of European patent application to an application under the Act | 15 |
| 41/77 | On request for conversion of European patent application | 15 |
| 43/77 | On payment of prescribed fee and request for publication of translation | 10 |
| 44/77 | On application to the comptroller for an international application to be treated as an application under the Act | 15 |
| 45/77 | On application for order for evidence to be obtained in the United Kingdom | 32 |
| 46/77 | On notice that hearing before the comptroller will be attended | — |
| 47/77 | On request for the correction of an error of translation or transcription, clerical error or mistake | 34 |
| 48/77 | On notice of opposition to the correction of an error, clerical error or mistake | 24 |
| 49/77 | On request for information relating to a patent or an application for a patent | 8 |
| 50/77 | On request for extension of time or period under rule 110(3) .. Each | 114 |
| 51/77 | On declaration of authorisation where agent appointed during progress of application or in substitution for another | — |
| 52/77 | On request for extension of time or period under rule 110(3A) | 114 |
| 53/77 | Additional fee for extension of time or period under rule 110(3C) | 114 |

PART A (continued)

| <i>Number of corresponding Patents Form</i> | <i>Item</i> | <i>Amount</i> |
|---|---|---------------|
| | | £ |
| 54/77 | On filing of translation of European Patent (UK) under section 77(6)(a) | 28 |
| 55/77 | On filing of translation of amendment of European Patent (UK) under section 77(6)(b) | 28 |
| 56/77 | On request for publication of translation of claims of application for European Patent (UK) filed under section 78(7) | 28 |
| 57/77 | On request for publication of a corrected translation filed under section 80(3) | 28 |
| 58/77 | On declaration that licences of right shall not extend to excepted uses | — |
| — | National fee (rule 85(1)) | 15 |
| | As Receiving Office or International Preliminary Examining Authority under the Patent Co-operation Treaty— | |
| — | Transmittal fee (rule 118(1)) | 15 |
| — | Preliminary examination fee (rule 120) | 55 |
| — | Additional fee (rule 121) | Maximum 55 |

*One half of these fees if entry in the register "Licences of Right".

PART B

(In this Part of this Schedule—

(1) any reference to a section is a reference to that section of the Patents Act 1949: and

(2) any reference to a rule is a reference to that rule of the Patents Rules 1968, as it continues to apply by virtue of rule 124 of the Patents Rules 1978(a) .)

| <i>Number of corresponding Patents Form</i> | <i>Item</i> | <i>Amount</i> |
|---|--|---------------|
| | | £ |
| 1 Add | Application for grant of patent of addition in lieu of independent patent | 29 |
| 7 | For extension of time under rule 30, 33 or 50— | |
| | Not exceeding one month | 16 |
| | Each succeeding month | 16 |
| 8 | On application for result of search made under section 7 and 8 | 3 |
| 9 | On application under section 9(2) for deletion of reference | — |
| 13 | On notice that hearing before the comptroller will be attended | — |
| 14 | On request under section 16(3) | 8 |
| 15 | On claim under section 16(4) | 8 |
| 16 | On application for extension of the period under section 16(5) | 11 |
| 17 | On application for a certificate under section 16(8) | 21 |
| 18 | On claim under section 17(1) for application to proceed in name of claimants | 24 |
| 19 | On application for directions under section 17(5) | 29 |

(a) S.I. 1978/216, to which there are amendments not relevant to these Rules.

PART A (continued)

| <i>Number of corresponding Patents Form</i> | <i>Item</i> | <i>Amount</i> |
|---|--|---------------|
| | | £ |
| 20 | On request for sealing of a patent | 20 |
| 21 | On application for extension of the period for requesting the sealing of a patent under section 19(3)— | |
| | Not exceeding one month | 16 |
| | Each succeeding month | 16 |
| 22 | On application for extension of the period for requesting the sealing of a patent under section 19(4)— | |
| | Not exceeding one month | 16 |
| | Each succeeding month | 16 |
| 23 | On application under section 20 for amendment of a patent | 56 |
| 32 | On application under section 28 for sealing of a patent | 29 |
| 33 | On opposition to application under section 28 | 24 |
| 34 | Additional fee for sealing under section 28 | 74 |
| 35 | On application to amend specification after acceptance | 48 |
| 36 | On notice of opposition to amendment | 24 |
| 37 | On application to amend specification not yet accepted | 24 |
| 38 | On application to amend an application for a patent | 24 |
| 39 | On application for revocation of a patent under section 33 | 24 |
| 43 | On application for settlement of terms of licence under patent endorsed "Licences of Right" | 56 |
| 44 | On application by patentee for cancellation of endorsement of patent "Licences of Right" | 56 |
| 45 | On application for cancellation of endorsement "Licences of Right" . | 56 |
| 46 | On notice of opposition to cancellation of endorsement of patent "Licences of Right" | 56 |
| 53 | On application under section 55(1) for directions of comptroller | 56 |
| 54 | On application under section 55(2) for directions of comptroller | 56 |
| 55 | On application under section 56(1) to determine dispute | 56 |
| 63 | On application for entry in the register of claim to a licence under a patent extended under section 23, 24 or 25 | — |
| 64 | On request to comptroller to correct a clerical error | 34 |
| 65 | On notice of opposition to the correction of a clerical error | 24 |
| 68 | For duplicate of patent | 24 |
| 69 | On application for entry of order of court in the register | — |

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules revoke and replace the Patents (Fees) Rules 1989. All fees payable under the Patents Act 1977 with the exception of those on forms 1/77, 20/77, 40/77, 41/77, 44/77, 49/77 and, under the Patents Act 1949 on forms 8, 23, 33, 36, 39, 43, 44, 45, 46, 53, 54, 55, 64, 65 and 68 and in respect of certain forms dealing with international applications are increased with effect from 10th September 1990. It is estimated that the total amount of fees collected per annum at the new levels will be 8 per cent greater than the amount collected per annum at the existing levels.