
STATUTORY INSTRUMENTS

1998 No. 1778

PATENTS

The Patents (Fees) Rules 1998

<i>Made</i>	- - - -	<i>16th July 1998</i>
<i>Laid before Parliament</i>		<i>22nd July 1998</i>
<i>Coming into force</i>	- -	<i>1st October 1998</i>

The Secretary of State, in exercise of powers conferred upon her by section 123(1), (2) and (3) of, and paragraph 14 of Schedule 4 to, the Patents Act 1977(1), of the power conferred upon her by the Department of Trade and Industry (Fees) Order 1988(2), and of all other powers enabling her in that behalf, after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992(3), 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 1998 and shall come into force on 1st October 1998.

(2) The Patents (Fees) Rules 1996(4) are hereby revoked.

2. These Rules shall be construed as one with the Patents Rules 1995(5) and, to the extent that they continue to apply in relation to existing patents and existing applications, with the Patents Rules 1968(6).

3. The fees to be paid in respect of any matters arising under the Patents Act 1977 or arising under the Patents Act 1949(7) shall be those specified in Parts A and B of the Schedule to these Rules; and in any case where a form specified in Part A or Part B of the Schedule as the corresponding form in relation to any matter is required by the Patents Rules 1995 or, as the case may be, the Patents Rules 1968 to be used, that form shall be accompanied by the fee, if any, 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.

(1) 1977 c. 37.

(2) 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.

(3) 1992 c. 53.

(4) S.I. 1996/2972.

(5) S.I. 1995/2093.

(6) S.I. 1968/1389, which was revoked by, except as provided for by rule 124 of, S.I. 1978/216, which was itself revoked, except for rule 124 and Schedule 4 (savings), by S.I. 1982/717. The latter instrument was revoked by rule 123 of S.I. 1990/2384, which was itself revoked by rule 121 of S.I. 1995/2093, which also amends rule 124 of S.I. 1978/216.

(7) 1949 c. 87.

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9th July 1998

Ian McCartney
Minister of State,
Department of Trade and Industry

We consent to the making of these Rules.

16th July 1998

Graham Allen
Bob Ainsworth
Two of the Lords Commissioners of Her
Majesty's Treasury

SCHEDULE

Rule 3

FEES PAYABLE

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 1995.)

<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)	—
2/77	On reference under section 8(1), 12(1) or 37(1)	50
	On application under section 8(5) or 37(3) for authorisation by comptroller	50
	On request for directions under section 10 or 12(4)	50
	On reference under section 11(5) or 38(5) to determine the question of a licence	50
	On application to comptroller under section 13(1) and/or 13(3)	50
	On offer to surrender a patent	—
	On application for compensation by employee	50
	On application under section 41(8)	50
	On application for settlement of terms of licence of right	50
	On application under section 47(3) by person interested for cancellation of entry in the register	50
	On application under section 48(1) for a compulsory licence or entry in the register	50
	On application by Minister in case of monopoly or merger	50
	On reference to the comptroller of a dispute as to infringement	50

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<i>Number of corresponding Patents Form</i>	<i>Item</i>	<i>Amount £</i>
	On application for declaration for non-infringement	50
	On application for the revocation of a patent	50
7/77	Statement of inventorship and of right to grant of a patent	—
8/77	On request for a certificate authorising the release of a micro-organism sample	—
8A/77	On notice of intention to restrict the availability of micro-organism samples to experts	—
9/77	On request for preliminary examination and search, request for further search under section 17(6) or payment for a supplementary search under section 17(8)	130
10/77	On request for substantive examination	70
11/77	On request to amend application before grant	40
	On application to amend specification after grant of a patent	40
	On request for the correction of an error in the register or in any connected document	40
	On request for correction of error or mistake	40
12/77	On payment of renewal fee ⁽⁸⁾ (and additional fee for late payment)—	
	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	50
	Before the expiration of the 5th year from the date of filing of	70

⁽⁸⁾ One half of these fees if entry in the register “Licences of Right”.

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12/77	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	
	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	90
	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	110
	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	150
	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	170
	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	190
	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	210

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	patent and in respect of the 13th year	
	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	230
	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	250
	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	270
	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	300
	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	330
	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	360
	Before the expiration of the 19th year from the date of filing of the application for	400

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	the patent or, in the case of an existing patent, the date of the patent and in respect of the 20th year	
	Additional fee for late payment of a renewal fee under section 25(4)—	
	Not exceeding one month	—
	Each succeeding month (but not exceeding six months)	24
15/77	On notice of opposition to amendment of specification after grant	50
	On notice of opposition to offer to surrender a patent	50
	On notice of opposition to an application under section 47(1) or 47(3) for cancellation of entry in the register	50
	On notice of opposition to application made under section 48 or 51	50
	On opposition to request for correction of error or mistake	50
16/77	On application to restore a patent	135
20/77	On request to alter a name, for each patent application	—
21/77	On application to register or to give notice of rights acquired in a patent or in an application for a patent	—
23/77	On request for certificate of the comptroller or certified copy from a file or the register—	
	(a) rubber stamp impression	16
	(b) signed and sealed certificate	22
	On request for uncertified copy from a file or the register	5
28/77	On application by proprietor for entry to be made in the register to the effect that	—

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	licences under the patent are to be available as of right	
30/77	On application by proprietor under section 47(1) for cancellation of entry in the register	—
49/77	On request to be informed of future events relating to a patent or application for a patent (caveat)	25
51/77	On appointment or change of agent	—
52/77	On request for extension of time or period under rule 110(3) (each)	135
	On request for extension of time or period under rule 110(4)	135
53/77	Additional fee for extension of time or period under rule 110(6)	135
	Additional fee on restoration of a patent under rule 41(4)	135
54/77	On filing of translation of European Patent (UK) under section 77(6)(a)	—
	On filing of translation of an amended European Patent (UK) under section 77(6)(b)	—
	On request for publication of translation of claims of application for European Patent (UK) filed under section 78(7)	—
	On request for publication of corrected translation of European Patent (UK) or application for European Patent (UK) filed under section 80(3)	—
58/77	On declaration that licences of right shall not extend to excepted uses	—

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<i>Number of corresponding Patents Form</i>	<i>Item</i>	<i>Amount £</i>
	On request for information about date of payment of any renewal fee under rule 48 and/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))	—
	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	—
	Filing fee upon conversion of European patent application to an application under the Act	—
	On request for publication of 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

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

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(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(9).)

<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	—
7	For extension of time under rule 30, 33 or 50—	
	Not exceeding one month	—
	Each succeeding month	—
8	On application for result of search made under sections 7 and 8	—
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)	—
15	On claim under section 16(4)	—
16	On application for extension of the period under section 16(5)	12
17	On application for a certificate under section 16(8)	—
18	On claim under section 17(1) for application to proceed in name of claimants	—
19	On application for directions under section 17(5)	—
20	On request for sealing of a patent	—
21	On application for extension of the period for requesting the sealing of a patent under section 19(3)—	
	Not exceeding one month	17
	Each succeeding month	17
22	On application for extension of the period for requesting	

(9) S.I. 1978/216; rule 124 is amended by rule 121 of S.I. 1995/2093.

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	the sealing of a patent under section 19(4)—	
	Not exceeding one month	17
	Each succeeding month	17
23	On application under section 20 for amendment of a patent	—
32	On application under section 28 for sealing of a patent	31
33	On opposition to application under section 28	—
34	Additional fee for sealing under section 28	80
35	On application to amend specification after acceptance	52
36	On notice of opposition to amendment	—
38	On application to amend an application for a patent	26
39	On application for revocation of a patent under section 33	—
43	On application for settlement of terms of licence under patent endorsed “Licences of Right”	—
44	On application by patentee for cancellation of endorsement of patent “Licences of Right”	—
46	On notice of opposition to cancellation of endorsement of patent “Licences of Right”	—
53	On application under section 55(1) for directions of comptroller	—
54	On application under section 55(2) for directions of comptroller	—
55	On application under section 56(1) to determine dispute	—

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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	40
65	On notice of opposition to the correction of a clerical error	—
68	For duplicate of patent	—
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 1996 (S.I.1996/2972).

They also provide for the removal of fees in some instances and a substantial reduction in a number of others. The most significant are in respect of—

- (a) the filing fee, which is reduced from £25 to no fee (Form 1/77);
- (b) renewal fees are reduced on average by approximately 18%; the reductions are greatest in respect of the early renewal years. For example, renewals for the fifth, sixth and seventh year have been reduced from, respectively, £110 to £50, £120 to £70 and £130 to £90 (Form 12/77);
- (c) the fee for applications to register or to give notice of rights acquired in a patent or in an application for a patent is reduced from £50 to no fee (Form 21/77);
- (d) the fee for filing translations of European Patents (UK) is reduced from £35 to no fee (Form 54/77).

A compliance cost assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies are available also from the Legal Division, Patents and Designs Directorate, the Patent Office, Newport, Gwent, NP9 1RH.