



Intellectual
Property
Office

Proposed Amendments to the Patents Rules: Government Response



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Executive summary

The government published a consultation on 29 February 2016, seeking views on a package of proposed changes to the Patents Rules 2007. The consultation closed on 22 April 2016. Ten responses to the consultation were received, including responses from representative organisations, patent attorney firms, and businesses. A list of respondents is provided in Annex A.

Following careful consideration of the responses received, the government intends to take forward all of the proposed changes – with some minor adjustments in light of comments made by consultation respondents. This document summarises the responses received, and outlines the government's next steps.

Background

The government published a consultation on 29 February 2016, seeking views on a package of proposed amendments to the Patents Rules 2007. The package includes eleven individual proposals which seek to simplify detailed aspects of the patents legislation, to provide greater clarity, and to reduce burdens on business including by taking account of modern ways of working. The consultation closed on 22 April 2016.

Summary of responses

The government received ten responses to the consultation, including responses from representative organisations, patent attorney firms, and businesses. A list of respondents is provided in Annex A.

A summary of the responses received in relation to each of the eleven individual proposals can be found below. Some respondents did not comment on all of the proposals, and so the summaries below reflect the comments of those who commented on each.

Full details of each proposal can be found in the [consultation document](#).

Proposal i)

Introducing a notification of intention of grant, thereby removing the need for applicants to foreshadow divisional applications.

This proposal will allow the IPO to give more information to customers about when their patent application will be granted, with the intention of giving applicants a clearer picture of the time left for them to do certain actions (such as file a divisional patent application). Issuing a notification of intention to grant will end the practice of foreshadowing divisional applications, as applicants will be guaranteed a period in which they can file such applications prior to grant.

All respondents were in favour of this proposal, as it will bring greater clarity and legal certainty to the grant process. Respondents also favoured the introduction of a hard deadline for filing divisional applications, commenting that it will make it easier for applicants and attorneys to consider the filing of divisional applications.

One respondent commented that it would lead to less rushed, higher quality divisional applications.

However, consultation responses consistently indicated that the proposed two weeks' notice of grant would be too short. 4 weeks or 1 month were instead suggested to allow applicants time to consider and prepare any divisional applications. When suggesting such a period, no respondents expressed any concerns whatsoever about delaying grant of all patent applications by this length of time.

Having considered the suggestion, we agree that allowing a longer period of 4 weeks or 1 month would be appropriate. In particular, whilst we do not wish to delay grant of all patent applications any longer than necessary, we believe that such a delay is unlikely to be of detriment to either the applicant or third parties since the intention to grant notification will be visible to all via IPSUM. We also believe that the risk of a new piece of prior art, third party observations, or another new objection arising during this period (in relation to which the IPO will not be able to take any action¹) is small.

Respondents also made some detailed procedural comments, see Annex B.

In light of the overwhelmingly positive response, the government plans to proceed with this proposal, adjusted to allow 4 weeks or 1 month notice of grant.

Proposal ii)

Prohibiting the use of omnibus claims except where absolutely essential.

This proposal will limit the use of omnibus claims to only those instances where the technical features of the invention cannot be clearly defined in words, by a mathematical or chemical formula or by any other written means.

Responses to this proposal were mixed. Six respondents expressed support for the proposal, valuing alignment with other major jurisdictions. One respondent commented that omnibus claims leave third parties unclear of claim scope and the sooner they are banned the better. However a representative organisation and another respondent were not in favour of the proposal, seeing no compelling reason to ban omnibus claims. Detailed reasons for their view include: (1) that omnibus claims can prove useful for obtaining claims of a narrow scope that protect the commercial embodiment of an invention, (2) omnibus claims are generally only included if there is deemed merit in doing so, and are perceived to be a final fall-back position, and (3) this proposal will lead to an increase in disagreements with examiners over the inclusion of omnibus claims where absolutely essential.

Some detailed drafting points were also raised, which are set out in Annex B.

In response to the specific questions asked in the consultation, one business indicated they would see no loss of competitive advantage and no benefits as a result of omnibus claims being banned from competitors' patents. No other respondent provided economic evidence.

We have carefully considered the points raised by all respondents who commented on this proposal, together with the small amount of economic evidence provided. We have also taken into account the fact that since 2011 not a single request has been received to amend a European Patent (UK) under section 27 of the Patents Act to add an omnibus claim, even though that option is available for free. More than 60,000

¹ See paragraph 18.88 of the [Manual of Patent Practice](#)

European Patents (UK) are granted each year, accounting for 6 out of 7 of the patents in force in the UK. Our analysis shows that 1 to 5 European Patents (UK) per year includes an omnibus claim (i.e. 0.01% or less of the European Patents (UK) granted per year). Domestic UK patents are identical in effect to granted European Patents (UK), and we therefore have no reason to expect anything different to occur in relation to domestic UK applications. It therefore seems unlikely that there will be a large number of disagreements with examiners over whether or not an omnibus claim can be included.

Having weighed up all these points, the government plans to proceed with this proposal and will consider the detailed points set out in Annex B.

Proposal iii)

Simplifying the period in which reinstatement of a patent application can be requested.

Two options were set out in the consultation document: an administrative option (requiring users to declare the date on which the cause of non-compliance was removed) and a legislative option (adjusting the deadline for requesting reinstatement so that it is always 12 months after the application was terminated).

The majority of consultation respondents favoured the legislative option, explaining that it would provide greater clarity and legal certainty than the administrative option. Respondents confirmed that the measure will not lead to any additional uncertainty for third parties (pointing out that third parties tend to allow 12 months under the current system before working the invention anyway) and mentioned that a similar provision works well in Canada.

However two respondents preferred the administrative option because they felt that it seems fairer for the patentee. Since the proposed legislative option will always provide 12 months for the patentee to request reinstatement (which is the longest period available under the current legislation), it will always be at least as generous to the patentee as the administrative option. In many cases the patentee will have a longer period in which to request reinstatement than they have under the current legislation.

Having considered the above points, the government intends to proceed with the legislative option as set out in paragraphs 29-32 of the consultation document.

Proposal iv)

Allowing extensions to the period for filing an address for service.

This proposal will give patent applicants more flexibility over when they can provide a legal address for service, by giving them the ability to request two additional months. Any request would need to be made on Patents Form 52 accompanied by the relevant fee (currently £135). All respondents except for one welcomed this proposal. The respondent who did not welcome it felt that allowing extensions was unnecessary as two months should be long enough to provide an address for service.

The government therefore intends to proceed with this measure. Doing this will remove an unnecessarily strict requirement, leading to fewer patent applications being refused for a minor administrative issue. This will be fairer for patent applicants.

Proposal v)

Relaxing the formal requirements for drawings to allow applicants to provide shaded drawings and photographs.

This proposal will bring the rules into line with current IPO practice, under which black and white photographs and shaded drawings are allowed provided they are clear and reproducible.

All respondents welcomed this proposal. Some commented that it would simplify the preparation of compliant drawings, and should therefore reduce costs for applicants. One respondent emphasised that the IPO must continue to ensure all representations remain clearly reproducible and reject those that are not, mentioning costly legal proceedings that have arisen at the USPTO in relation to this. Some detailed comments were raised, which are set out in Annex B.

In light of the overwhelmingly positive response, the government intends to proceed with this proposal.

Proposal vi)

Removing the requirement for patent holders to notify the IPO each year of the address they wish to use to receive renewal reminders.

Currently, the proprietor must notify the IPO each year of the address they wish to use to receive renewal reminders, even if it is the same address as the previous year. Under this proposal the IPO will continue to use the address which has previously been provided as the address for receipt of the renewal reminder, until informed otherwise.

All respondents welcomed this proposal. The government therefore intends to proceed with this measure.

Proposal vii)

Clarifying when applicants can make amendments to international patent applications entering the UK national phase.

Under this proposal a new rule 66A will be introduced to clarify when PCT applications can be amended upon entry to the national phase.

All respondents welcomed this proposal. The government therefore plans to proceed with this measure. In addition, one respondent gave a drafting suggestion which we will consider fully.

Proposal viii)

Clarifying the requirements concerning changes of names and addresses.

Under this proposal rule 49 will be amended to make clear that it covers both corrections and changes of names, addresses, and addresses for service. Patents Form 20 will also be updated to provide a tick box for the user to specify whether they wish to correct an error or to update the information held by the IPO to reflect a change in circumstances.

All respondents welcomed this proposal. The government therefore plans to proceed with this measure. In addition, one respondent gave a drafting suggestion which we will consider fully.

Proposal ix)

Correcting the drafting of the rule concerning advertising amendments made during infringement and revocation proceedings.

Rule 75 requires the IPO to advertise all amendments proposed during infringement or revocation proceedings before the Office. However this requirement is not consistent with the requirements of the primary legislation - section 75(1) of the Act provides the IPO with discretion over whether or not to advertise. It is therefore intended to amend the Rules to remove this discrepancy between the primary and secondary legislation.

The majority of respondents welcomed this proposal. However two respondents expressed concerns.

One respondent felt that the proposed change seems unnecessary and may lead to an apparent lack of transparency over amendments that are open to opposition. They point out that such amendments are not numerous and make up only a small section of the Journal. Whilst the government accepts the sentiment that it is advantageous to third parties for all amendments to be advertised, it is necessary to amend the rules as they are currently inconsistent with s.75(1) of the Patents Act 1977 (primary legislation) which provides the comptroller with discretion over whether to advertise.

In a similar vein, a business expressed concern about the criteria used to decide whether to advertise or not, and the importance of ensuring that important amendments continue to be advertised. As the consultation document explained, where the amendments to the patent in question are being proposed to avoid revocation it is very unlikely that they will be insignificant; it therefore follows that these amendments will be advertised. It is expected that in practice the only amendments which would not be advertised would be those which are so insignificant that no-one could be expected to want to oppose them. The IPO makes similar decisions in relation to whether or not to advertise the correction of errors under section 117: no advertisement is published if the comptroller determines that no person could reasonably object to the correction, in accordance with rule 105(5).

In light of the above comments, the government intends to proceed with this measure. Guidance such as the Manual of Patent Practice will set out the factors the IPO will consider before deciding whether to advertise or not.

Proposal x)

Removing the requirement for triplicate copies of international applications when filed with the IPO in its function as a receiving office for PCT applications.

All respondents welcomed this proposal, so the government intends to proceed with this measure.

Proposal xi)

Removing the requirement for duplicate copies of Patents Form 51.

All respondents welcomed this proposal, so the government intends to proceed with this measure.

Other proposals

The consultation document also sought comments on other potential changes or clarifications to the Patents Rules.

One representative organisation queried the IPO's recent change in practice in relation to rule 111, which relates to delays in communication services. They commented that this practice change needs further thought, including consideration of whether any change is needed to the wording of the rule to make explicitly clear how it should be interpreted (and that further consultation might be needed). The government will consider the clarity of rule 111, what it does and does not cover, and how best to clarify this.

One respondent requested the ability to file all patents forms electronically and requested the introduction of an optional facility for the IPO to issue all communications electronically via a mailbox. The IPO will consider this point as part of ongoing work to provide improved digital services for patents customers.²

Conclusion

The government welcomes the time that respondents took to participate in this consultation.

Following careful consideration of the responses received, the government intends to take forward all of the proposed changes – with some adjustments to the detail in light of points raised by respondents, as discussed above. The government will therefore take steps to amend the Patents Rules 2007 at the next suitable opportunity.

Regulatory impact

The Impact Assessment for this package of changes can be found alongside this response document at www.gov.uk/government/consultations/proposed-changes-to-the-patents-rules. The Regulatory Policy Committee has validated this impact assessment.

² See page 22 of [the UK Intellectual Property Office's Corporate Plan 2016-2019](#) in relation to Transforming the IPO Digitally (Tripod)

Annex A: List of respondents

ARM

B&S Group

CIPA Patents Committee

Dyson

FICPI-UK

Flexmort

Gill, Jennings & Every LLP

IP Federation

JA Kemp

Parminder Lilly

Annex B: Detailed comments

Where respondents provided detailed comments on the wording of the draft legislation or offered other insights or comments, these are set out below, together with the government's response.

Proposal	Comments	Response
(i)	A representative organisation queried what remedies would be available to an applicant wishing to file a divisional application if the IPO indicated an incorrect grant date or grant takes place earlier than indicated.	The IPO will ensure that a robust system is put in place to avoid such errors. If an error of this sort were to occur, the remedies would remain as they are currently in the rare event of erroneous grant: under the terms of rule 107 the IPO may rescind grant where there has been an irregularity in Office procedure. This is a cumbersome process and so it is in the IPO's and the applicant's interest to ensure such errors are avoided.
(i)	Two respondents thought that the drafting of proposed Rule 19 could be improved, and one suggested alternative wording.	The government will consider the drafting suggestion.
(i)	One of those respondents also requested more explanation as to why each of the deletions compared to current Rule 19 have been made.	Guidance for business will explain the changes made.
(i)	One respondent queried the relationship between the compliance date, the new notification of intention to grant letter, and the letter confirming grant has taken place.	The new notification of intention to grant letter will be issued under section 18(4) of the Patents Act and will only be issued where the application meets all requirements of the Act and Rules by the compliance date.
(i)	A business requested a practice notice or equivalent be issued to provide reassurance that the notifications of intention to grant will continue to be issued.	Since users will rely on such notifications to be issued, we agree that suitable guidance will be necessary to confirm the IPO's practice.
(ii)	A representative organisation queried whether the test is to be whether an omnibus claim is "absolutely essential" and explained that is not clear how it will be determined whether an omnibus claim is absolutely essential.	We agree that the test for whether an omnibus claim is allowable should be clear from the wording of the rule. It should be noted that the proposed rule set out in paragraph 21 of the consultation document does not include the phrase "absolutely essential".

(ii)	A representative organisation explained that the proposed drafting goes further than the equivalent rule at the EPO and would prevent the claims from referring to the description for reasons of conciseness.	This is not our intention and so we will consider how best to alter the proposed rule in order to address the point raised. We are grateful to the representative organisation for pointing this out to us.
(ii)	In relation to the transitional arrangements proposed in paragraph 22, a representative organisation queried whether it is appropriate to delay grant if the existence of an omnibus claim is the only objection.	We have considered the points raised and agree that there are advantages and disadvantages with each of the proposed transitional arrangements. To avoid several years of two different practices running in parallel, the new rule will apply to all new and pending applications and to granted patents from the date it comes into force, as set out in paragraph 22 of the consultation document.
(iii)	A representative organisation queried whether such drawings will be reproducible in online databases such as espacenet.	The IPO will continue to reject drawings and photographs if they are not suitable for publication.
(iii)	Two respondents encouraged moves towards the acceptance of colour drawings and photographs.	The IPO continues to work to develop such functionality.
(vii)	One respondent provided a drafting suggestion.	The government will consider the drafting suggestion.
(viii)	A representative organisation provided a drafting suggestion.	The government will consider the drafting suggestion.

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