



Intellectual
Property
Office

Proposed changes to the Patents Rules





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Minister's Foreword



The Government is committed to making the UK the best place in Europe to innovate, patent new ideas and set up and expand a business. To do this we must ensure our IP system continues to be clear and widely accessible.

We are working to make sure that the procedures which must be followed when applying for a patent or maintaining a granted patent are as straight-forward and intuitive as possible. In some cases this requires legislative change, to ensure we have the right legal framework and to remove out-dated legislative requirements that cause unnecessary burdens for business.

The proposals set out in this document are technical. However, they will simplify detailed aspects of the patents legislation, reduce burdens on business, and take account of modern ways of working.

I hope they will improve the patent system for the benefit of those who use it and look forward to hearing your views on this consultation.

A handwritten signature in black ink that reads "Lucy Neville-Rolfe". The signature is written in a cursive, flowing style.

Baroness Neville-Rolfe, DBE, CMG
Minister for Intellectual Property



Introduction

1. The Intellectual Property Office (IPO) is responsible for the patent system in the UK. This includes examination of patent applications and the grant of patents for those applications which comply with the requirements of the Patents Act 1977 (“the Act”) and the Patents Rules 2007 (“the Rules”). The Rules set out the procedural and administrative requirements which apply to patents and patent applications.
2. This document sets out a number of proposed amendments to the Rules, which have arisen from customer suggestions and an IPO review of the Rules. The proposed amendments seek to simplify the law, to provide greater clarity, and to reduce burdens on applicants including by taking account of increasingly electronic ways of working. None of the proposed amendments affect the Unitary Patent.
3. Full details of each of the proposed amendments to the Rules are discussed in this document. The proposals are likely to affect anyone who applies for or owns patents and anyone who has an interest in other people’s patents and patent applications. We are keen to get responses from as wide a cross-section as possible of our actual and potential customers, and any other affected parties, before we decide how to proceed.
4. We would particularly like to know whether the proposals would offer benefits to businesses and individuals making use of the patent system in the UK and we welcome your views on the overall bundle of measures, together with any comments you have on the specific proposals. We would be particularly grateful for any evidence you can provide about the impact of the proposed measures on you as an applicant, patent holder, patent agent or competitor of a business that owns a patent. Please include any such evidence in your response.



Overview of the proposals

5. This consultation sets out eleven proposals relating to practice under the Rules:
 - i. Introducing a notification of intention to grant, thereby removing the need for applicants to foreshadow divisional applications (see page 4).
 - ii. Prohibiting the use of omnibus claims except where absolutely essential (see page 6).
 - iii. Clarifying the period for making a request for reinstatement of a patent application (see page 8).
 - iv. Allowing extensions to the period for filing an address for service (see page 9).
 - v. Relaxing the formal requirements for drawings to allow applicants to provide shaded drawings and photographs (see page 10).
 - vi. Removing the requirement for patent proprietors to notify the IPO each year of the address for receipt of the renewal reminder (see page 11).
 - vii. Clarifying the period for making amendments to international applications upon their entry to the UK national phase (see page 12).
 - viii. Clarifying the requirements concerning changes of names and addresses (see page 13).
 - ix. Correcting the drafting of the rule concerning advertising amendments made during infringement and revocation proceedings (see page 14).
 - x. Removing the requirement for triplicate copies of international applications to be filed when using the IPO as a receiving office for such applications (see page 15).
 - xi. Removing the requirement for duplicate copies of Patents Form 51 to be filed when notifying the IPO of the appointment or change of agent (see page 15).

Proposals in detail

Proposal i)

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

6. During the process of applying for a patent, it may become clear that the patent application in fact covers two or more inventions which would be best protected by individual patents. In this situation the applicant may file what are known as “divisional” applications. These are new patent applications split out (or ‘divided’) from an earlier application. Such divisional applications must be filed before the earlier application is granted. Currently, applicants cannot tell when the earlier application will be granted as they are not aware of the IPO’s intention to grant until they receive the letter confirming that grant has taken place. This causes considerable uncertainty for applicants who are considering whether to file a divisional application.
7. Consequently, the practice of “foreshadowing” a divisional application has developed - when submitting a response to an examiner’s report, applicants state that they (may) intend to file a divisional application and request that the examiner postpone grant until they have been given an opportunity to file it. The examiner must then issue additional correspondence seeking confirmation of whether a divisional application will be filed, thereby delaying grant. This practice brings with it the risk that the IPO will miss the foreshadowing. Indeed, in a number of cases, grant has had to be rescinded because the foreshadowing of a divisional application had not been identified and acted upon by the IPO. In addition, the practice can lead to protracted correspondence with applicants about whether particular acts or words have amounted to foreshadowing.
8. The IPO therefore proposes to introduce a practice of issuing a notification of the date on which a patent will be granted. The notification would be sent on all applications which have met the requirements for grant. It would be issued as part of a report under s.18(4) of the Patents Act 1977 indicating that there are no outstanding objections and that the application will be sent for grant on or after a certain date. No further action would be required from the applicant in relation to the application in question. They would merely be informed of when grant is expected to take place, so that they can take any other action they wish (such as filing a divisional application) prior to grant.
9. Removing the need for applicants to foreshadow the filing of a divisional application will provide a clearer and more robust system for applicants and will mean it is no longer necessary for IPO examiners to spot foreshadowing within correspondence. This will free up examiner time and resources, thereby improving the efficiency of the application process.
10. Issuing a notification of grant on all applications will ensure consistency and will prevent the issues which arise when foreshadowing is missed or when it is not clear that foreshadowing has taken place, thereby increasing certainty for third parties.

11. Such a notification may have additional benefits beyond those linked to the foreshadowing and filing of divisional applications. It could for example help applicants plan the next steps for commercialisation of the patented product, or influence decisions about other patent applications, whether in the UK or elsewhere. Issuing a notification before grant will also bring UK practice more closely into line with the practice in other jurisdictions, including the European Patent Office (EPO).
12. In most cases we propose allowing only a short window (such as two weeks) as we do not wish to delay grant of all patent applications any longer than necessary. No extension to this date would be available under s.117B and rule 109 as the IPO would not be specifying a period in which some action must be taken. However, the window would be longer where the notification is made as part of a first examination report which finds that there are no objections to the application. In these circumstances, applicants currently have two months to file a divisional application and this practice would be maintained – not least because rule 31 will continue to require that the applicant is given a two-month period in which to make voluntary amendments.
13. In order to introduce this change, r.19 must be amended as it currently prohibits the filing of divisional applications once a report has been issued stating that the earlier application meets all of the requirements for grant of a patent (a “s.18(4) notification”), even if the earlier application has not yet been granted.¹
14. The requirement that divisional applications must be filed at least three months prior to the compliance date will be retained and would apply to all divisional applications.
15. We propose to replace current rule 19 with the following:

New applications filed as mentioned in section 15(9)

19.—(1) For the purposes of section 15(9), a new application may only be filed in accordance with this rule.

(2) A new application may be filed as mentioned in section 15(9) if—

(a) the earlier application² has not been terminated or withdrawn; and

(b) the period ending three months before the compliance date of the earlier application has not expired.

(3) A new application must include a statement that it is filed as mentioned in section 15(9).

16. We have given some thought to the transitional arrangements that should apply when introducing this change. Our intention is that the new rule would apply to all applications whether filed before or after the date that it comes into force.

Q1

Do you have any comments about the proposal to introduce a notification of the date on which a patent will be granted? Please give details of the reasons behind your view, providing an indication of any costs and benefits to your business if possible.

Q2

Do you have any comments on the proposed drafting to implement the measure allowing divisional applications to be filed after receipt of a report under s.18(4)?

¹ Unless the s.18(4) notification is the first examination report under s.18, in which case the applicant may file a divisional application within two months of that report.

² See section 15(9) of the Patents Act 1977 for the meaning of “earlier application”.

Proposal ii)

Prohibiting the use of omnibus claims except where absolutely essential

17. Patent claims define the scope of the monopoly provided by the patent. Sometimes claims are drafted in such manner as to refer generally to the description or drawings included in the patent application. Such claims do not state the technical features of the invention claimed and are known as “omnibus claims”. Understanding these claims can be difficult and can lead to a lack of clarity about the scope of protection provided by the patent. Their lack of clarity has been noted by the UK courts.³ At the same time, we are only aware of a handful of patents that have ever actually relied on an omnibus claim for protection against a competitor. Furthermore, UK practice in freely allowing such claims is inconsistent with practice under the European Patent Convention (EPC) and the international Patent Cooperation Treaty (PCT).
18. We therefore propose to amend the Rules to limit the use of omnibus claims to only those instances where they are absolutely essential. We believe this will increase patent clarity and provide legal certainty, especially for third parties looking to determine whether they can operate in a particular technology area. Bringing this aspect of UK patent law into line with the EPC and PCT will also make the global patent framework more consistent, for the benefit of business.
19. Omnibus claims, in part due to their lack of clarity, can require additional work during the patent application process. Examiner time is spent analysing such claims and additional correspondence may be required between the examiner and the applicant, requiring additional examiner and applicant resources, with an associated cost to business. We believe that these claims take time which is disproportional to their minimal value. Our statistics show that omnibus claims are currently included in approximately 30% of UK patent applications, and so limiting their use will lead to a slight increase in the efficiency of the IPO’s patent-granting operations.
20. The vast majority of patents in force in the UK (86% of UK patents renewed in 2014/15) are EP(UK) patents granted by the European Patent Office (EPO) under the EPC and so do not contain omnibus claims except where absolutely necessary. It is interesting to note that although it is possible to amend EP(UK) patents at the IPO after grant to insert an omnibus claim, requests to do so are very rare. (In fact, the last time a request was made to amend a patent in this way was in 2011). It could be inferred from this that omnibus claims do not add significant useful protection to most patents.
21. We propose to introduce a rule (as part of rule 12 governing the content of applications) worded as follows:

“The claim or claims must not rely in respect of the technical features of the invention on references to the description or any drawing or photograph unless the feature cannot otherwise be clearly defined in words, by a mathematical or chemical formula or by any other written means.”

³ See for example *Daikin Kogyo’s (Shingu’s) Application* [1974] RPC 559 CA, where Lawton LJ described the omnibus claim present (which had wording typical of these claims) as being “so obscure as to its meaning that it is incapable of being “a claim defining the scope of the invention claimed””; and *Environmental Recycling Technologies Plc v Upcycle Holdings Ltd* [2013] EWPCC 4, where Judge Birss remarked “If I may say so, the UK IPO might like to consider whether omnibus claims serve any useful purpose today save in exceptional circumstances. I question whether they can really be said to satisfy the requirement of clarity”.

22. We have given some thought to the transitional arrangements that should apply when introducing this change. Our intention is that this new rule would apply to all new and pending applications and to granted patents from the date that it comes into force. If a pending application includes an omnibus claim it will be possible to amend the application during the examination process to remove the omnibus claim, and to supply replacement claims where desired. The existence of an omnibus claim would not be a ground for revocation, and so existing granted patents including such claims would remain valid. However, it would not be possible to amend a granted patent to include an omnibus claim after the new rule comes into force.
23. An alternative option would be to apply this rule only to applications filed on or after the date the new rule comes into force. However this option is not our preference, as it is more complicated to apply a dual system in practice and would mean that for a number of years some patents would be granted including omnibus claims whilst it would not be permitted to include them in others filed after the coming into force of the rule.

- Q3** Do you believe your business (or the business(es) you represent) will experience any loss of competitive advantage as a result of no longer being able to include omnibus claims in UK patent applications (except where their inclusion is absolutely essential)? If yes, please provide an indication of the likely impact this will have. For example, please provide details of how frequently your business (or a business you represent) has relied on an omnibus claim for protection against a competitor.
- Q4** Do you believe your business (or the business(es) you represent) will see any benefits, such as legal certainty or increased market opportunity, as a result of omnibus claims no longer being included in the vast majority of competitors' UK patents? For example, has a competitor's omnibus claim ever caused an issue for you? Did you have to seek legal advice? If so, approximately how much did this cost your business?
- Q5** What will the impact of this measure be on how you draft patent applications and the time spent doing so? Please provide an estimate of the likely costs and benefits to your business if possible. For example, are we correct in our belief that the time currently spent considering whether to include an omnibus claim is minimal in the context of the whole application?
- Q6** Do you have any comments about the drafting of the proposed secondary legislation in relation to omnibus claims, and the proposed transitional arrangements set out in paragraph 22?

Proposal iii)

Clarifying the period for making a request for reinstatement of a patent application


24. Where an application for a patent is terminated because an applicant has failed to comply with a requirement of the Act or Rules, it is possible for them to request that their application be reinstated under s.20A. A request for reinstatement must be made before the end of the period set out in r.32(2). That is either:
 - a. two months beginning immediately after the date on which the removal of the cause of non-compliance occurred (r.32(2)(a)); or
 - b. if it expires earlier, the period of twelve months beginning immediately after the date on which the application was terminated (r.32(2)(b)).
25. The time period set out in part (a) of r.32(2) can be confusing, particularly for unrepresented applicants. It is also difficult to apply, because determining the exact date on which the cause for non-compliance was removed can be subjective. This can lead to prolonged exchanges of correspondence between the IPO and the applicant. In a number of cases, hearings before a senior officer are necessary simply to determine whether a request for reinstatement was made within the time period set out in r.32(2).
26. The IPO proposes two alternative mechanisms by which this aspect of the patent application process could be made simpler and clearer for both users and the Office. We are keen to hear user views on which of the mechanisms is preferable.

Administrative option

27. One option for clarifying the process would be to alter Patents Form 14 (the form used to request reinstatement) so that it asks users to declare the date on which the cause of non-compliance was removed. The IPO would then rely on this date unless the evidence provided with the reinstatement request indicates that the declared date is incorrect. Doing this would help unrepresented applicants calculate the deadline and give all applicants greater confidence about whether or not their reinstatement request is being made on time. It would also make it easier for the IPO to determine the date on which the cause of non-compliance was removed, leading to more efficient processing of reinstatement requests.
28. A draft of the updated form is provided in Annex 1.

Legislative option

29. An alternative option would be to amend r.32(2) so that requests for reinstatement must simply be made within 12 months of the application being terminated. Simplifying the time period in this way would provide clarity for applicants, the IPO and third parties, and would reduce a burden by providing a much simpler and also more generous timescale in which to request reinstatement.
30. This would be achieved by replacing rule 32(2) with *“For this purpose the relevant period is twelve months beginning immediately after the date on which the application was terminated.”* Rule 32(11) would also be deleted.

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- 31. Such a change is not expected to significantly increase uncertainty for third parties, for two reasons. Firstly, a 12 month back-stop already exists in the current rule. Secondly, it is already possible for the IPO to impose third-party terms to allow anyone who has proceeded to make or use the invention on the basis of the application being terminated to continue to use the invention. It follows that it is in the applicant's interest to request reinstatement as soon as possible (once the application is reinstated it will no longer be possible for third parties to qualify for such terms).
 - 32. We propose that such a change could be introduced with no transitional arrangements. This would mean that any patent application which was terminated in the 12 months prior to the new rule coming into force could benefit from the simplified 12-month period for requesting reinstatement. Third party terms would remain available as currently (see paragraph 31).

Q7 Has the current period for reinstatement caused any problems for you as an applicant or a patent agent?

Q8 Do you have any comments about the options proposed in relation to clarifying the period for requesting reinstatement, and which is your preferred option?

Proposal iv)

Allowing extensions to the period for filing an address for service

- 33. All patent applicants must provide an address for service in the European Economic Area (EEA) or Channel Islands so that the Office or third parties can contact them and serve documents if necessary. Unrepresented applicants almost always use their own address as the address for service (as long as it is within the EEA or Channel Islands), whilst applicants represented by a patent agent normally use their representative's address. The vast majority of applicants provide an address for service in the EEA or Channel Islands at the same time as filing their application, or very shortly thereafter. If an address is not provided, the IPO will direct the applicant to provide an address within two months. This time period is listed in Part 1 of Schedule 4 to the Rules and is therefore not extendable.
- 34. The lack of an extension for this time period is inconsistent with other time periods for providing information about an application and is unnecessarily strict, in that patent applications are refused for a minor administrative issue without there being any opportunity to ask for more time.
- 35. We therefore propose to make this period extendable. We propose to remove the reference to r.104(2) (period for filing an address for service) from Part 1 of Schedule 4 and instead list this period under Parts 2 and 3 of that Schedule. This will give applicants the ability to request two additional months to provide an appropriate address for service and will consequently decrease the number of applications which are refused for a minor administrative issue. Any request for an extension to this period will need to be made on Patents Form 52 accompanied by the relevant fee (currently £135). The request for an extension must be made no more than two months after the period has expired.
- 36. We have given some thought to the transitional arrangements that should apply when introducing this change. Our intention is that it will be possible to request an extension to the period for providing an address for service on or after this date, even if the period for providing an address for service expired before this date, as long as the request is made no more than two months after expiry of the period.

37. It is expected that the proposed change will be of most benefit to applicants from outside the EEA, as they may find they need extra time to find an agent based in the EEA or to make arrangements for some other means of providing an EEA address (such as a post office box address).

Q9

Q9 - Do you have any comments about the proposed changes to secondary legislation which will make the period for filing an address for service extendable?

Proposal v) Relaxing the formal requirements for drawings to allow applicants to provide shaded drawings and photographs

38. Drawings are often filed as part of a patent application to help describe the invention for which protection is sought. Part 3 of Schedule 2 to the Rules sets out the formal requirements for these drawings, which are relatively strict – for example, shading and photographs are not permitted. Feedback from our customers however indicates that in many technology areas (biotechnology, heat mapping and others) it is increasingly difficult, if not impossible, to represent an invention using a traditional line drawing. For pragmatic reasons we therefore do not usually object to shaded drawings and photographs provided that they are clear and reproducible.
39. It is proposed to update the requirements of Schedule 2 so that they are consistent with our practice, and to adjust rules 12, 14 and 15 to refer to photographs as well as drawings. We propose the following amendments to Schedule 2:

(1) Schedule 2 is amended as follows.

(2) In Parts 2 and 3, in the heading after “Drawings” insert “and Photographs”.

(3) In Part 3 —

(a) in paragraphs (11), (18), (19) and (20) after “drawing” insert “or photograph”,

(b) in paragraphs (12), (13) and (14) after “drawings” insert “and photographs”,

(c) omit paragraph (15) and substitute —

“15. Drawings must comprise black lines and may be shaded where the shading assists in representing the shape of a thing provided that it does not obscure other elements of the drawing.”, and

(d) after paragraph (20) insert —

“20A. Photographs must be black and white, clear and capable of direct reproduction.”.

(4) In Part 4, paragraph (21) after “drawing” insert “or photograph”

Q10

Do you have any comments about the proposed secondary legislation in relation to relaxing the formal requirements for drawings and allowing photographs?

Proposal vi)

Removing the requirement for patent proprietors to notify the IPO each year of the address for receipt of the renewal reminder

40. In order to maintain a granted patent, the proprietor must pay a renewal fee each year (up to a maximum of 20 years). Where a renewal fee has not been paid, the IPO sends a renewal reminder to the proprietor. By default this is sent to the address for service. However, many patent proprietors choose to specify an address for receipt of this reminder which is different to the address for service that they use for other purposes. For example, although the proprietor may have an address for service which is their patent attorney, the address given for the renewal reminder may be that of a renewals payment service or the proprietor's own business or personal address. Many proprietors continue to use the same address for renewal reminders for multiple years; however rule 39(3) requires the proprietor to notify the IPO of the address for the renewal reminder with the payment of each year's renewal fee. In other words, the proprietor must tell us again each year which address should be used for the reminder, even if it remains the same.
41. Statistics show that customers who specify an address for receipt of the renewal reminder on average inform the IPO three times of the same address. By changing the requirements, two of these notifications could be avoided, reducing the burden on our customers as well as the IPO. We therefore propose to amend rule 39 so that 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.
42. Removing the need to notify the IPO of the renewal reminder address each year will also provide patent proprietors with an increased opportunity to use our online renewal services. These services are not available if an address is being notified at the same time as payment of the renewal fee.
43. We propose to replace rule 39(3)(a) with:

“(a) the last address specified by the proprietor on payment of a renewal fee (or to another address that has since been notified to him for that purpose by the proprietor); or”
44. Patents Form 12 will be adjusted (at section 6) to reflect this change. A draft of the amended form is provided in Annex 2.

Q11

Do you have any comments about the proposed secondary legislation and amended Patents Form 12 in relation to removing the requirement to notify the IPO each year of the address for receipt of the renewal reminder?

Proposal vii)

Clarifying the period for making amendments to international applications upon their entry to the UK national phase

45. The Patent Cooperation Treaty (PCT) makes it possible to seek patent protection in a large number of countries via a single “international” patent application (or “PCT application”), which can be initiated at the International Bureau of the World Intellectual Property Organization or at a national or regional patent office acting as a PCT receiving office. This single application process saves costs and duplication of effort where patent protection is sought in multiple different territories. Later in the process the applicant can choose to continue the patent application process in particular jurisdictions. This part of the process is called the “national phase”.
46. Article 41 of the PCT requires national (or regional) patent offices to give applicants an opportunity to amend the application on entry into the national phase. Rule 78.1 of the Regulations under the PCT provides further details of the minimum time period offices should provide for such amendments.
47. In order to meet the requirements set out in the PCT, when an applicant chooses to enter the UK national phase, the IPO allows them to amend their PCT application. For example, they may wish to make amendments in light of the reports made by the international authorities. Allowing such amendments removes the need for UK examiners to repeat work done internationally and makes the application process more efficient.
48. The time limits for amending UK patent applications are set out in rule 31 of the Rules. There is no separate rule relating to the amendment of PCT applications when they enter the national phase. Rule 31(3) states that “*the applicant may amend his application only within the period beginning with the date on which the applicant is informed of the examiner’s report under s.17(5) and ending with the date on which the comptroller sends him the first substantive examination report*”. Amendments are also allowed in other circumstances, as set out in the remainder of rule 31.
49. However, for most PCT applications no report is ever sent under s.17(5) because the IPO uses the results of the search performed by the International Search Authority (ISA). Consequently it is unclear from the Rules whether it is possible to amend PCT applications at the time of, or after, entry into the national phase and prior to examination of the application in the UK.
50. The following new rule is therefore proposed, to clarify when PCT applications can be amended upon entry to the national phase.

“Amendment of international application before grant”

66A.—(1) This rule applies to an international application for a patent (UK) which has begun the national phase of the application.

(2) The period within which an applicant may amend his application is as follows.

(3) Where during the international phase of the application, the International Searching Authority has sent to the applicant the International Search Report relating to the invention, the period within which the applicant may amend his application is the period beginning with the date on which the national phase of the application begins and ending with the date on which the comptroller sends him the first substantive examination report.

(4) Where during the international phase of the application, the International Searching Authority has not sent to the applicant the International Search Report relating to the invention, the period during which the applicant may amend his application is the first to occur of—

(a) the period prescribed by rule 31(3); and

(b) the period beginning with the date on which the International Searching Authority sends the International Search Report to the applicant and ending with the date on which the comptroller sends him the first substantive examination report.”

51. Where a PCT application enters the national phase early and a full search is performed by a UK examiner, a search report under s.17(5) will be issued. In these circumstances, the existing provisions of r.31(3) will apply, meaning that the applicant can amend their application once the search report has issued and before the first examination report is issued.
52. In all cases, it will remain possible to amend an application (whether originating from a PCT filing or a national application) once the examination report has issued, in line with r.31(4), and at other times with the IPO's permission, as set out in r.31(5).



Do you have any comments about the proposed secondary legislation relating to the amendment of PCT applications upon entry into the national phase?

Proposal viii)

Clarifying the requirements concerning changes of names and addresses

53. Rule 49 governs the correction of names, addresses, and addresses for service relating to patents and patent applications (i.e. where there was an error in the information recorded on the register). The rule also covers changes of name, address and address for service (i.e. where the information was correct but there is then a change in situation, such as a house move). However, the existing rule only explicitly refers to “corrections” and does not mention “changes”. The rule therefore understandably causes confusion for some customers, who are unclear whether the rule applies to both situations. Consequently, we propose to amend the rule to make clear that it covers both situations. We propose replacing rule 49(6) with:

“(6) For the purposes of this rule a request for a correction includes-

(a) a correction made for the purposes of section 117; and

b) a change to any of the matters listed in paragraph (1) in respect of an entry recorded in the register or made to any application or other document filed at the Patent Office.”

54. We also propose to update Patents Form 20. This form must be used to request corrections and changes to a name, and is frequently also used to request corrections and changes to an address or address for service. We propose 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.
55. A draft of the amended form is provided in Annex 3.

56. The current lack of distinction between the two possible types of alteration being requested can lead to a lack of clarity about the date on which the alteration takes effect, since when erroneous details are corrected they are treated as always having been that way, whereas other changes take effect when the change is requested. We believe the proposed amendment to rule 49, along with the improved Form 20, will make it easier for customers to request the appropriate type of alteration and will make the date on which the alteration takes effect more readily apparent. In turn the IPO will be able to handle requests for corrections and changes to names and addresses more efficiently.

Q13

Do you have any comments about the proposed secondary legislation and amended Patents Form 20 in relation to corrections and changes of name, address and address for service?

Proposal ix)

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

57. Where the validity of a patent is put in issue during infringement or revocation proceedings, the patent proprietor may request to amend the patent in order to avoid revocation. Rule 75 requires the IPO to advertise all amendments proposed during infringement or revocation proceedings before the Office. Advertisement allows interested parties to see the proposed amendment and start opposition proceedings if they have reason to object to the amendment.
58. The requirement in the Rules that amendments proposed during such proceedings should always be advertised 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. We propose that rule 75 be amended to read:

“Publication of notices

75.—(1) Subject to paragraph (2) and rule 105(5) the comptroller must advertise in the journal any event to which it is possible to object under any of the provisions mentioned in Part 2 or 3 of Schedule 3.

(2) Where an amendment to the specification of a patent is proposed by the proprietor under section 75(1) the comptroller may, if he thinks fit, advertise in the journal the proposed amendment.”

59. Changing the secondary legislation to give the IPO discretion over whether to advertise is not expected to have a noticeable impact on third parties. Since the amendments in question are being proposed to avoid revocation it is very unlikely that they will be insignificant (a minor amendment is unlikely to change the patent sufficiently to prevent revocation), and so the IPO would require them to 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.

Q14

Do you have any comments about the proposed secondary legislation in relation to advertising amendments during infringement and revocation proceedings?

Proposal x)

Removing the requirement for triplicate copies of international applications

60. International applications can be filed at the IPO in its capacity as a receiving office under the PCT. The IPO transfers any such applications to the International Bureau (IB) and the European Patent Office (EPO)⁴ for processing. Rule 65(1)(b) of the Rules requires three copies of such international applications to be provided. This requirement only applies to applications filed in paper form as rule 4(6) states that the requirement for multiple copies does not apply when applications are filed electronically. This requirement originally existed to allow one copy to be kept by the IPO, one copy to be sent to the IB, and one copy to be sent to the EPO.
61. As the IPO now transfers all international applications to the IB and EPO electronically, there is no longer any need for three copies to be filed (whether the application is filed with the IPO on paper or electronically). We therefore propose to remove the requirement to provide triplicate copies of international applications from the Rules, by amending rule 65 as follows:

In rule 65—

- (a) in paragraph (1), for the words from “be filed” to the end, substitute “be filed in English or Welsh.”; and
- (b) omit paragraph (2).

Q15

Do you have any comments about the proposed secondary legislation in relation to removing the requirement for filing multiple copies of PCT applications?

Proposal xi)

Removing the requirement for duplicate copies of Patents Form 51

62. When an applicant appoints an agent to act on their behalf or appoints a new agent to replace an existing one, rule 101(1)(b) requires that two copies of Patents Form 51 are filed at the IPO. This requirement originally existed as one copy of the form would be retained by the office and the second copy would be sent to the outgoing agent. Since the introduction of electronic case files at the IPO, we now scan all such forms received onto the electronic system. A copy of the form is still sent to the outgoing agent, however this copy is printed from the IPO’s electronic system. There is therefore no longer any requirement that this form is filed in duplicate.
63. We therefore propose to delete the words “in duplicate” from rule 101(1)(b), thereby removing the requirement to provide duplicate copies of Patents Form 51.

Q16

Do you have any comments about the proposed secondary legislation in relation to removing the requirement for filing multiple copies of Form 51?

⁴ The EPO acts as the International Searching Authority for PCT applications filed at the IPO.

Other Proposals

Q17

Do you have any other specific proposals for ways in which the Patents Rules could be changed or clarified? For example, the IPO's Manual of Patent Practice has recently been amended to clarify practice under rule 111 (see [MoPP 123.47.1](#) which states that "Extensions of time under rule 111 may not be used to 'un-terminate' an application or extend a time period which has already expired"). Do you think any changes should be made to rule 111?

Next steps

We will consider all responses made to this consultation and adjust the proposals accordingly. Any legislative changes will be made at the next available opportunity.

Responding to the consultation

The Government welcomes responses to the issues raised in this consultation document from any individual, organisation or company. Responses to the specific questions which are raised in this document are particularly welcomed, together with any other comments you may have. It is not necessary to respond to all the questions – you are welcome to provide answers only to those issues of most interest or relevance to you.

While the Government will do its best to note responses that are outside the scope of this consultation, it may not be in a position to respond to those points alongside the issues we are asking about.

Please email your responses to: consultation@ipo.gov.uk. Alternatively, please use the following postal address:

Sarah Barker
Intellectual Property Office
Room 1R33
Concept House
Cardiff Road
Newport
NP10 8QQ

Tel: 01633 814807
Fax: 01633 814491

Please let us have your comments by the end of **22 April 2016**.



Confidentiality and data protection

This is a public consultation, the results and conclusions of which may be published. As such, your response may be made public. If you do not want all or part of your response or name made public, please state this clearly in the response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in (for example) your email response or fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.

Information provided in response to this consultation, including personal information, may be subject to publication or disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want other information that you provide to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals with, amongst other things, obligations of confidence.

In view of this, it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. The IPO will process your personal data in accordance with the DPA and in the majority of circumstances this will mean that your personal data will not be disclosed to third parties.



Comments or complaints

Any comments or complaints about the way this consultation has been conducted should be sent to:

Angela Rabess
Consultation Coordinator
Better Regulations Team
Department for Business, Innovation and Skills
1 Victoria Street
London
SW1H 0ET

Email: angela.rabess@bis.gsi.gov.uk

Tel: 0207 2151661



Intellectual
Property
Office

Patents Form 14

Patents Act 1977 (Rule 32)

Request to reinstate a patent application*(See the notes on the back of this form)*

Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

1. Your reference

2. Patent application number

3. Full name of the applicant or of
each application

Patents ADP number
(if you know it)

4. **The patent application was terminated because
you failed to meet a legal requirement by the
given deadline.**

Why did you fail to meet this requirement?
(Continue on a separate sheet if necessary)

(See note c)

**On what date did you become able to meet
this requirement?**

(see note d)

5. I/We request the above application be reinstated

Signature

Date

6. Name, e-mail address, telephone, fax and/or
mobile number, if any, of a contact point for the
applicant

Notes

- a) *If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000.*
- b) *Write your answers in capital letters using black ink or you may type them.*
- c) *You should provide supporting evidence with this form. If you do not, the Office will set a deadline for submitting the evidence.*
- d) *This date is important, because your request to reinstate the patent application can only be made within a limited time period. The request must be made by the earlier of:*
 - i) *2 months from the date on which it became possible for you to meet the legal requirement that had previously been missed (and which resulted in the termination of the patent application), or*
 - ii) *12 months from the date of termination of the patent application.*

In other words, as soon as the reason for not meeting the deadline has been removed, you have 2 months in which to request reinstatement, but only up to a maximum period of 12 months from the date of termination.

Example: An application was terminated because the applicant failed to file a particular form by the relevant deadline. The reason this happened was because the applicant's automated reminder system failed. The applicant later realises what has happened, and that the form should have been filed. They can file a request for reinstatement within 2 months of realising the problem – so long as it is no more than 12 months from the date of termination of the patent application.

- e) *Once you have filled in this form remember to sign and date it.*
- f) *For details of the fee and ways to pay, please contact the Office.*



Intellectual Property Office

Patents Form 12

Patents Act 1977 (Rule 36)

Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Payment of renewal fee (and additional fee for late payment)

(See the notes on the back of this form)

1 Your reference

2 Patent number

3 Which year are you paying for?
(In terms of the life of the patent e.g. 6th)

4 Amount of renewal fee

Amount of late payment fee

Total amount paid

5 Name, address and postcode of the person
paying the fee

Patents ADP number (if you know it)

6 If your next renewal is overdue, the Office will send a reminder to your chosen address. If you have previously provided an Address for Service or a specific address for the renewal reminder, and it remains unchanged, you can leave this space blank. However, if you wish to change your chosen address, please provide the details here and sign and date it.
(See note c for further details)

Signature

(Permanent changes of the address for service should be notified by a separate letter)

Date

7 Name, e-mail address, telephone, fax and/or mobile number, if any, of a contact point for the applicant

Notes

- a) *If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000.*
- b) *Write your answers in capital letters using black ink or you may type them.*
- c) *Where a renewal fee has not been paid, the IPO sends a renewal reminder to the proprietor. The renewal reminder will be sent to the address provided for this purpose. If no such address has been provided, it will be sent to the Address for Service. Use part 6 of this form if you would like to change the address to which the Office sends the renewal reminder.*
- d) *If you have filled in part 6 of the form remember to sign and date it.*
- e) *For details of fees and ways to pay, please contact the Office on 0300 300 2000.*



Intellectual Property Office

Patents Form 20

Patents Act 1977 (Rule 49)

Request to correct **or update** a name or address **held by us**

(See the notes on the back of this form)

Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

1 Your reference

2 Patent application or patent number(s)
(see notes (d) & (e))

3 Full name and address of the or of each patent
applicant or proprietor
(as currently on the register or application(s))

Patents ADP number (if you know it)

4 Tick the appropriate box. I wish to:

i) Correct an error in a name or address; or ☐

ii) Update a name or address ☐
(see note (c))

5 Name and/or address to be corrected **or updated**
(i.e. as it currently looks in our records)

Patents ADP number (if you know it)

6 **Correct or** new name and/or address
(i.e. as you want it to look)

Patents ADP number (if you know it)

7 Name of your agent (if you have one)

“Address for service” in the European Economic
Area or Channel Islands to which all
correspondence should be sent
(including postcode) (see note (g))

Patents ADP number (if you know it)

8	Signature	Date
9	Name, e-mail address, telephone, fax and/or mobile number, if any, of a contact point for the applicant	

Notes

a) *If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000.*

b) *Write your answers in capital letters using black ink or you may type them.*

c) *You can use this form to request:*

(i) *A correction under s.117 of an error in a name or address (such as a typographical error); or*

(ii) *An update to a name, address or address for service (such as a change in the applicant's name or when the applicant has moved addresses).*

You can correct or update a name and/or address held in the register, or as found in any document filed at the Office.

You should use a separate form for each category if you are making more than one request.

d) *You may use this form for more than one application or patent if the same request is involved.*

e) *If there is not enough space for all the relevant details on any part of this form, please continue on a separate sheet of paper and write "see continuation sheet" in the relevant part(s) of the form. Any continuation sheets should be attached to this form.*

f) *Once you have filled in this form remember to sign and date it.*

g) *Although you may have an address for service in the Channel Islands, any agent you appoint to act for you must reside in or have a place of business in the European Economic Area or Isle of Man.*

Concept House
Cardiff Road
Newport
NP10 8QQ

Tel: 0300 300 2000
Fax: 01633 817 777

www.gov.uk/ipo

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Revised: Feb 2016
WS003334



INVESTORS
IN PEOPLE

