Intellectual Property Office

The Patents Rules 2007 (as amended)

The Patents (Fees) Rules 2007 (as amended)

An unofficial consolidation produced by Legal Section

1 January 2021

Note to users

This is an unofficial consolidation of the Patents Rules 2007 (SI 2007/3291) and the Patents (Fees) Rules 2007 (SI 2007/3292), incorporating all amendments in force up to and including 1 January 2021. This consolidation does not contain prospective amendments that have not yet entered into force.

This unofficial consolidation includes the amendments to the Patents Rules 2007 made by:

- the Patents, Trade Marks and Designs (Address for Service) Rules 2009 (SI 2009/546)
- the Patents and Patents and Trade Marks (Fees) (Amendment) Rules 2010 (SI 2010/33)
- the Patents (Amendment) Rules 2011 (SI 2011/2052)
- the Patents (Amendment) Rules 2014 (SI 2014/578)
- the Patents (Amendment) (No. 2) Rules 2014 (SI 2014/2401)
- the Patents (Amendment) (No. 2) Rules 2016 (SI 2016/892)
- the Patents and Patents (Fees) (Amendment) Rules 2017 (SI 2017/1100)
- the Patents (Amendment) (EU Exit) Regulations 2019 (SI 2019/801)
- the Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (SI 2020/1050)
- the Patents, Trade Marks and Designs (Address for Service) (Amendment) (EU Exit) Rules 2020 (SI 2020/1317)
- the Supplementary Protection Certificates (Amendment) (EU Exit) Regulations 2020 (SI 2020/1471)

and the amendments to the Patents (Fees) Rules 2007 made by:

- the Trade Marks and Trade Marks and Patents (Fees) (Amendment) Rules 2009 (SI 2009/2089)
- the Patents and Patents and Trade Marks (Fees) (Amendment) Rules 2010 (SI 2010/33)
- the Patents and Patents (Fees) (Amendment) Rules 2017 (SI 2017/1100)
- the Patents, Trade Marks and Registered Designs (Fees) (Coronavirus) (Amendment) Rules 2020 (SI 2020/644)

Note that the following transitional provisions may apply:

> SI 2010/33 applies transitional provisions to the changes made to: rules 80(1)(aa), 80(1A) and 81A of the Patents Rules 2007 and Part 1 of Schedule 2 (Renewal Fees) to the Patents (Fees) Rules 2007.
> SI 2016/892 applies transitional provisions to the changes made to rule 12 of the Patents Rules 2007.
> SI 2017/1100 applies transitional provisions to the application of new rules 30A(1)(a) and 30A(1)(b) of the Patents Rules 2007 and new rules 3D(1)(a) and 3D(1)(b) of the Patents (Fees) Rules 2007.
> SI 2020/1050 applies transitional provisions to the application of new rule 116A(1) of the Patents Rules 2007.
> SI 2020/1317 applies transitional provisions to the changes made to rule 103(4) of the Patents Rules 2007.

While the greatest care has been taken in producing this unofficial text, the Office does not accept any responsibility for errors or omissions, nor for any consequences of such errors or omissions.

Legal Section
1 January 2021

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(as amended)

An unofficial consolidation of the Patents Rules 2007 (SI 2007/3291) incorporating the amendments made by:

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- the Patents, Trade Marks and Designs (Address for Service) (Amendment) (EU Exit) Rules 2020 (SI 2020/1317)

- the Supplementary Protection Certificate (Amendment) (EU Exit) Regulations 2020 (SI 2020/1471)

In the following list, provisions which have been amended by:

SI 2009/546 are marked *

SI 2010/33 are marked †

SI 2011/2052 are marked #

SI 2014/578 are marked $

SI 2014/2401 are marked +

SI 2016/892 are marked ^

SI 2017/1100 are marked ~

SI 2019/801 are marked ◊

SI 2020/1050 are marked ¤

SI 2020/1317 are marked °

SI 2020/1471 are marked §

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Transitional provisions and revocations

120. Transitional provisions and revocations

The Secretary of State makes the following Rules in exercise of the powers conferred upon him by sections 14(6), 25(5), 32, 74B, 77(9), 92, 123, 125A and 130(2) of the Patents Act 1977(**a**).

In accordance with section 8 of the Tribunals and Inquiries Act 1992(**b**), the Secretary of State has consulted the Administrative Justice and Tribunals Council.

PART 1

INTRODUCTORY

Citation and commencement

1. These Rules may be cited as the Patents Rules 2007 and shall come into force on 17th December 2007.

(**a**) 1977 c. 37; section 74B was inserted by the Patents Act 2004 (c.16); section 123 was amended by the Copyright, Designs and Patents Act 1988 (c. 48), Schedule 5, paragraph 29, and the Patents Act 2004 (c.16), Schedule 2, paragraph 26; section 125A was inserted by the Copyright, Designs and Patents Act 1988, Schedule 5, paragraph 30, and was amended by SI 2000/2037.

(**b**) 1992 c. 53; the definition of "Council" has been amended by the Tribunals, Courts and Enforcement Act 2007 (c.15), Schedule 8, paragraph 30.

General interpretation

2.—(1) In these Rules—

"the Act" means the Patents Act 1977 and "section", unless the contrary intention appears, means a section of the Act;

"application number" includes file number;

"compliance date" means the last day of the compliance period;

"compliance period" means the period prescribed by rule 30;

"declared priority date" has the meaning given to it by rule 3(1);

"initiation date" means the date on which a new application was initiated by documents, mentioned in section 15(1), being filed at the Patent Office;

"new application" means a new application filed under section 8(3), 12(6) or 37(4) or as mentioned in section 15(9);

"no declared priority date" has the meaning given to it by rule 3(2);

"Patents Form" has the meaning given to it by rule 4(1);

"priority application" means an earlier relevant application specified in a declaration for the purposes of section 5(2);

"sequence" and "sequence listing" have the same meaning as they have under the Patent Co-operation Treaty;

"start date" means, in relation to rules 106(6)(a) and 116 on supplementary protection certificates, the first day following the day on which the basic patent expires; and

"termination" has the meaning given by section 20B(7) and "terminated" shall be construed accordingly.

(2) Where a period of time has been altered under rules 20(4), 71(7), 81 or 107 to 111, any reference in these Rules to the period of time shall be construed as a reference to the period as altered.

(3) For the purposes of these Rules a document is available to the comptroller where—

(a) it is in electronic storage (whether in the Patent Office or elsewhere) and he can access it by using electronic communications; or

(b) it is kept at the Patent Office,

and he has been furnished with sufficient information to obtain a copy of the document.

(4) But a document may be treated as unavailable to the comptroller where—

(a) its accuracy cannot be verified to his satisfaction; or

(b) he has to pay to access it.

The declared priority date

3.—(1) For the purposes of these Rules the "declared priority date" is the date of filing of the earliest relevant application specified in a declaration made for the purposes of section 5(2) in, or in connection with, an application in suit.

(2) For the purposes of these Rules there is "no declared priority date" if—

(a) no declaration has been made for the purposes of section 5(2); or

(b) every declaration made has been withdrawn or disregarded before the end of the relevant period.

(3) For the purposes of paragraph (2)(b) the relevant period ends—

(a) in the case of an application which falls to be treated as an application for a patent under the Act by virtue of a direction under section 81, when that direction is given;

(b) in the case of an international application for a patent (UK), when the national phase of the application begins; or

(c) in any other case, when preparations for the application's publication have been completed by the Patent Office.

(4) In this rule references to declarations made for the purposes of section 5(2) include declarations treated as made for those purposes.

Forms and documents

4.—(1) The forms of which the use is required by these Rules are those set out in directions under section 123(2A) and are referred to in these Rules as Patents Forms.

(2) Such a requirement to use a form is satisfied by the use of a form which is acceptable to the comptroller and contains the information required by the form as so set out.

(3) Such directions must be published in accordance with rule 117(c).

(4) Unless the comptroller otherwise directs, to file any form or other document under the Act or these Rules only one side of each sheet of paper must be used and the other side must remain blank.

(5) But where the information is delivered in electronic form or using electronic communications—

(a) a requirement under these Rules to use a form; and

(b) the requirements in paragraph (4),

do not apply.

(6) Where any form or other document is delivered to the comptroller in electronic form or using electronic communications, any requirement in these Rules for multiple copies of that form or document to be filed does not apply.

PART 2

APPLICATIONS FOR PATENTS

International exhibitions

International exhibitions

5.—(1) The statement mentioned in section 2(4)(c) that an invention has been displayed at an international exhibition must be in writing.

(2) The prescribed period for the purposes of section 2(4)(c) is four months beginning immediately after the date of filing.

(3) But paragraphs (1) and (2) do not apply where rule 67(2) applies.

(4) The written evidence required by section 2(4)(c) must be in the form of—

(a) a certificate issued by the authority responsible for the international exhibition; and

(b) a statement, duly authenticated by that authority, identifying the invention as being the invention displayed at the exhibition.

(5) The certificate must include the opening date of the exhibition (or if later, the date on which the invention was first displayed).

(6) The comptroller may publish a statement in the journal that a particular exhibition falls within the definition of "international exhibition" in section 130(1) (interpretation).

Declarations of priority

Declaration of priority for the purposes of section 5(2) (priority date)

6.—(1) Subject to paragraph (2) and rule 7(9), a declaration for the purposes of section 5(2) must be made at the time of filing the application for a patent.

(2) Subject to rule 7(9), a declaration for the purposes of section 5(2) may be made after the date of filing provided that—

(a) it is made on Patents Form 3;

(b) it is made before the end of the period of sixteen months beginning immediately following the date of filing of the earlier relevant application (or if there is more than one, the earliest of them) specified in that, or any earlier, declaration; and

(c) the condition in paragraph (3) is met.

(3) The condition is that—

(a) the applicant has not made a request under section 16(1) for publication of the application during the period prescribed for the purposes of that section; or

(b) any request made was withdrawn before preparations for the application's publication have been completed by the Patent Office.

(4) A declaration for the purposes of section 5(2) must specify—

(a) the date of filing of each earlier relevant application; and

(b) the country it was filed in or in respect of.

(5) In the case of a new application filed as mentioned in section 15(9), no declaration shall be made which has not also been made in, or in connection with, the earlier application.

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

7.—(1) The period prescribed for the purposes of section 5(2A)(b) is two months.

(2) Subject to paragraph (4), a request under section 5(2B) must be—

(a) made on Patents Form 3; and

(b) supported by evidence of why the application in suit was not filed before the end of the period allowed under section 5(2A)(a).

(3) Where that evidence does not accompany the request, the comptroller must specify a period within which the evidence must be filed.

(4) In relation to a new application, a request under section 5(2B) may be made in writing, instead of on Patents Form 3, and no evidence shall accompany it.

(5) Subject to paragraph (6) and rule 66(3), a request under section 5(2B) may only be made before the end of the period allowed under section 5(2A)(b).

(6) Where a new application is filed after the end of the period allowed under section 5(2A)(b), a request under section 5(2B) may be made on the initiation date.

(7) A request under section 5(2B) may only be made where—

(a) the condition in paragraph (8) is met; or

(b) the request is made in relation to an international application for a patent (UK).

(8) The condition is that—

(a) the applicant has not made a request under section 16(1) for publication of the application during the period prescribed for the purposes of that section; or

(b) any request made was withdrawn before preparations for the application's publication have been completed by the Patent Office.

(9) Where an applicant makes a request under section 5(2B), he must make the declaration for the purposes of section 5(2) at the same time as making that request.

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

8.—(1) In respect of each priority application to which this paragraph applies the applicant must, before the end of the relevant period, furnish to the comptroller the application number of that application; otherwise the comptroller must disregard the declaration made for the purposes of section 5(2), in so far as it relates to the priority application.

(2) In respect of each priority application to which this paragraph applies the applicant must, before the end of the relevant period, furnish to the comptroller a copy of that application—

(a) duly certified by the authority with which it was filed; or

(b) otherwise verified to the satisfaction of the comptroller,

otherwise the comptroller must disregard the declaration made for the purposes of section 5(2), in so far as it relates to the priority application.

(3) Paragraph (1) applies to every priority application except where the application in suit is an international application for a patent (UK) and the application number of the priority application was indicated in compliance with the Patent Co-operation Treaty.

(4) Paragraph (2) applies to every priority application except where—

(a) the application in suit is an international application for a patent (UK) and a certified copy of the priority application was filed in compliance with the Patent Co-operation Treaty; or

(b) the priority application or a copy of the priority application is available to the comptroller.

(5) For the purposes of this rule the relevant period is sixteen months beginning immediately after the declared priority date, subject to rule 21.

Translation of priority documents

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

(a) a copy of the priority application has been—

(i) furnished in accordance with rule 8(2),

(ii) filed in compliance with the European Patent Convention,

(iii) filed in compliance with the Patent Co-operation Treaty, or

(iv) made by the comptroller in accordance with rule 112(2);

(b) that copy is in a language other than English or Welsh; and

(c) the matters disclosed in the priority application are relevant to the determination of whether or not an invention, to which the application in suit relates, is new or involves an inventive step.

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

(3) But the comptroller shall not specify a period that ends after the grant of the patent.

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

(a) an English translation of the priority application; or

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

otherwise the comptroller must disregard the declaration made for the purposes of section 5(2), in so far as it relates to the priority application.

Mention of the inventor

Mention of the inventor

10.—(1) An inventor or joint inventor of an invention, if not mentioned in any published application for a patent, or in any patent granted, for the invention, must be mentioned in an addendum or an erratum to the application or patent.

(2) A person who alleges that any person ought to have been mentioned as the inventor or joint inventor of an invention may apply to the comptroller for that person to be so mentioned—

(a) in any patent granted for the invention; and

(b) if possible in any published application for a patent for the invention,

and, if not so mentioned, in the manner prescribed by paragraph (1).

(3) Subject to rules 21, 58(4), 59(3) and 68(2), the period prescribed for the purposes of section 13(2) is sixteen months beginning immediately after—

(a) where there is no declared priority date, the date of filing of the application; or

(b) where there is a declared priority date, that date.

(4) A statement filed under section 13(2) must be made on Patents Form 7.

Waiving the right to be mentioned

11.—(1) The inventor may, before preparations for the application's publication have been completed by the Patent Office, apply to the comptroller in writing to waive his right—

(a) to have his name and address mentioned as those of the inventor; or

(b) to have his address mentioned as that of the inventor.

(2) An application by an inventor under paragraph (1)(a) must—

(a) include his reasons for making the application; and

(b) be accepted by the comptroller where the comptroller is satisfied by those reasons.

(3) An application by an inventor under paragraph (1)(b) must be accepted by the comptroller.

(4) Where the comptroller has accepted an inventor's application to make a waiver under this rule, the inventor may apply to the comptroller to end that waiver.

(5) The comptroller may, if he thinks fit, accept an application to end a waiver, and his acceptance may be made subject to such conditions as he may direct.

(6) An application under paragraph (1)(a) or (b) or under paragraph (4) may also be made by a person who is not the inventor, but who has been identified as such for the purposes of section 13(2).

(7) Where a person makes an application in reliance on paragraph (6), the reference in this rule to an application to waive his right to have his name and address (or his address) mentioned shall be construed as a reference to an application not to have his name and address (or his address) mentioned; and paragraphs (4) and (5) shall be construed accordingly.

Form and content of applications

Applications for the grant of patents under sections 14 and 15

12.—(1) A request for the grant of a patent must be made on Patents Form 1.

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

(3) Where the applicant has been so notified, he must, before the end of the period of two months beginning immediately after the date of the notification, file his name and address; otherwise the comptroller may refuse his application.

(4) The specification mentioned in section 14(2)(b) must be preceded by the title of the invention and must be set out in the following order—

(a) description;

(b) the claim or claims; and

(c) any drawing or photograph referred to in the description or any claim.

(5) But paragraph (4) does not apply where an application is delivered in electronic form or using electronic communications.

(6) The title of the invention must be short and indicate the matter to which the invention relates.

(6A) 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 and concisely defined in words, by a mathematical or chemical formula or by any other written means.

(7) Where the specification includes drawings or photographs, the description must include a list of drawings and photographs briefly describing each of them.

(8) Where—

(a) the documents filed at the Patent Office to initiate an application for a patent include something which is or appears to be a description of the invention in a language other than English or Welsh; and

(b) the applicant has not filed a translation into English or Welsh of that thing,

the comptroller shall notify the applicant that a translation is required.

(9) Where the applicant has been so notified, he must, before the end of the period of two months beginning immediately after the date of the notification, file a translation; otherwise the comptroller may refuse his application.

Biological material and sequence listings

13.—(1) The provisions of Schedule 1 prescribe the circumstances in which the specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(2) Where the specification of an application for a patent discloses a sequence, it must include a sequence listing.

(3) Where an applicant has not provided a sequence listing on filing the application, the comptroller may specify a period within which the applicant must provide the sequence listing; and if it is not provided within this period, the comptroller may refuse the application.

(4) Where a sequence listing is provided after the date of filing the application, the listing must be accompanied by a declaration that it does not contain matter extending beyond the sequence disclosed in the application.

(5) The sequence listing must comply with any requirements and standards adopted under the Patent Co-operation Treaty for the presentation of sequence listings in patent applications.

(6) A sequence listing shall, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications, even where the application for the patent is not delivered in electronic form or using electronic communications.

(7) A sequence listing may be set out either in the description or at the end of the application, but if set out at the end of the application rule 12(4) shall not apply.

Size and presentation of application

14.—(1) The contents of all documents (including annotations to drawings and photographs) contained in an application for a patent must be in English or Welsh.

(2) The requirements for the documents contained in an application for a patent (other than drawings and photographs) are set out in Parts 1 and 2 of Schedule 2.

(3) The requirements for a drawing and a photograph contained in an application are set out in Parts 1 and 3 of that Schedule.

(4) All documents contained in an application (including drawings and photographs) must comply with the requirements set out in Part 4 of that Schedule.

(5) Paragraphs (2) and (3) do not apply to an application, or a sequence listing contained in an application, which is delivered in electronic form or using electronic communications.

The abstract

15.—(1) The abstract must start with a title for the invention.

(2) The abstract must contain a concise summary of the matter contained in the specification.

(3) That summary must include—

(a) an indication of the technical field to which the invention belongs;

(b) a technical explanation of the invention;

(c) the principal use of the invention.

(4) Where the specification contains more than one drawing or photograph, the abstract must include an indication of the drawing or photograph which should accompany the abstract when it is published.

(5) Where it appears to the comptroller that a drawing or photograph included in the specification better characterises the invention he shall publish it with the abstract.

(6) Where a feature of the invention included in the abstract is illustrated in a drawing or photograph, the feature must be followed by the reference for that feature used in that drawing or photograph.

(7) The abstract must not contain any statement on the merits or value of the invention or its speculative application.

Single inventive concept

16.—(1) For the purposes of the Act, two or more inventions shall be treated as being so linked as to form a single inventive concept where there exists between those inventions a technical relationship which involves one or more of the same or corresponding special technical features.

(2) In paragraph (1) "special technical features" means those technical features which define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

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

17.—(1) A reference made under section 15(1)(c)(ii) must include—

(a) the date of filing of the earlier relevant application;

(b) its application number; and

(c) the country it was filed in or in respect of.

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

(a) be duly certified by the authority with which it was filed or otherwise verified to the satisfaction of the comptroller; and

(b) where it is in a language other than English or Welsh, be accompanied by—

(i) a translation into English of that application, or

(ii) a declaration that the description filed under sub-paragraph (i) of section 15(10)(b) is a complete and accurate translation into English of the description contained in the application provided under sub-paragraph (ii) of that provision.

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

Missing parts

18.—(1) The period prescribed for the purposes of section 15(5)(b) and (6) is the period beginning with the date of filing of the application for a patent and ending with the date of the preliminary examination.

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

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

(4) A request made under section 15(7)(b) must—

(a) be made in writing;

(b) include sufficient information to identify where in the priority application the contents of the document filed under section 15(5)(b) were included; and

(c) be made before the end of the period prescribed for the purpose of section 15(5)(b).

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

(a) the priority application does not contain every missing part filed under section 15(5); or

(b) the applicant fails, before the end of the relevant period, to furnish to the comptroller copies of all earlier relevant applications—

(i) duly certified by the authority with which they were filed, or

(ii) otherwise verified to the satisfaction of the comptroller.

(6) But paragraph (5)(b) does not apply in respect of an earlier relevant application where that application or a copy of the application is available to the comptroller.

(7) For the purposes of paragraph 5(b) the relevant period is—

(a) sixteen months beginning immediately after the declared priority date; or

(b) if it expires earlier, the period of four months beginning immediately after the date on which the request was made under section 15(7)(b).

New applications

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 application 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).

New applications under sections 8(3), 12(6) and 37(4)

20.—(1) The period prescribed for filing a new application under section 8(3) or section 12(6) is the relevant period.

(2) A new application for a patent may be filed under section 37(4) before the end of the relevant period.

(3) For the purposes of this rule the relevant period is—

(a) where the comptroller's decision to make an order under those provisions is not appealed, three months beginning immediately after the date on which the order was made; or

(b) where that decision is appealed, three months beginning immediately after the date on which the appeal was finally disposed of.

(4) But the comptroller may, if he thinks fit, shorten the relevant period after giving the parties such notice and subject to such conditions as the comptroller may direct.

Extensions for new applications

21.—(1) Where a new application is filed—

(a) the period prescribed for the purposes of section 13(2) is—

(i) two months beginning immediately after its initiation date, or

(ii) if it expires later, the period prescribed by rule 10(3); and

(b) the relevant period for the purposes of rule 8 is—

(i) two months beginning immediately after its initiation date, or

(ii) if it expires later, the period specified in rule 8(5),

and the reference in rule 10(3) to the date of filing of the application is a reference to the date of filing of the earlier application.

(2) But where the new application is filed less than six months before the compliance date—

(a) the period prescribed for the purposes of section 13(2) is the period ending with its initiation date; and

(b) the relevant period for the purposes of rule 8 is the period ending with its initiation date.

(3) The second requirement in Schedule 1 must be complied with—

(a) on the initiation date; or

(b) if it expires later, before the end of the relevant period specified in paragraph 3(3) of that Schedule.

Periods for filing contents of application

Periods prescribed for the purposes of sections 15(10) and 17(1)

22.—(1) The period prescribed for the purposes of section 15(10)(a) and (b)(i) is the relevant period.

(2) Subject to rules 58(4), 59(3) and 68(3), the period prescribed for the purposes of section 15(10)(c) and (d) and section 17(1) is the relevant period.

(3) The period prescribed for the purpose of section 15(10)(b)(ii) is four months beginning immediately after the date of filing of the application.

(4) But paragraphs (1) to (3) do not apply to a new application.

(5) In relation to a new application—

(a) the period prescribed for the purposes of section 15(10)(a), (b)(i), (c) and (d) and section 17(1) is—

(i) two months beginning immediately after its initiation date, or

(ii) if it expires later, the relevant period; and

(b) the period prescribed for the purposes of section 15(10)(b)(ii) is—

(i) two months beginning immediately after its initiation date, or

(ii) if it expires later, the period of four months beginning immediately after the date of filing of the earlier application,

and the reference in paragraph (7) to the date of filing of the application is a reference to the date of filing of the earlier application.

(6) But where the new application is filed less than six months before the compliance date, the period prescribed for the purposes of section 15(10)(a) to (d) and section 17(1) is the period ending with its initiation date.

(7) For the purposes of this rule the relevant period is—

(a) where there is no declared priority date, twelve months beginning immediately after the date of filing of the application; or

(b) where there is a declared priority date—

(i) twelve months beginning immediately after the declared priority date, or

(ii) if it expires later, the period of two months beginning immediately after the date of filing of the application.

Preliminary examination

Preliminary examination under section 15A

23.—(1) On the preliminary examination under section 15A of an application the examiner shall determine whether the application complies with the requirements of rules 6 to 9.

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

Correcting a declaration made for the purposes of section 5(2)

24.—(1) Where, on the preliminary examination under section 15A of an application, the examiner finds that a declaration made for the purposes of section 5(2) specifies a date of filing for an earlier relevant application—

(a) more than twelve months before the date of filing of the application in suit; or

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

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

(2) Where the comptroller has notified the applicant under paragraph (1), the applicant must, before the end of the period of two months beginning immediately after the date of that notification, provide the comptroller with a corrected date; otherwise the comptroller must disregard the declaration in so far as it relates to the earlier relevant application.

(3) In paragraph (2) "corrected date" means a date that would not have been reported by the examiner under paragraph (1).

Formal requirements

25.—(1) Subject to paragraphs (2) and (3), the requirements of the following provisions of these Rules are formal requirements—

(a) rule 12(1) (application for a patent on Patents Form 1);

(b) rule 14(1) (application in English or Welsh);

(c) rule 14(2) and (3) (form of documents and drawings).

(2) Where an application is delivered in electronic form or using electronic communications, only the requirements of rule 14(1) are formal requirements.

(3) Where an international application for a patent (UK) was filed in accordance with the provisions of the Patent Co-operation Treaty, the requirements mentioned in paragraph (1) shall be treated as complied with to the extent that the application complies with any corresponding provision of that Treaty.

Publication of application

Publication of application

26.—(1) The period prescribed for the purposes of section 16(1) is eighteen months beginning immediately after—

(a) where there is no declared priority date, the date of filing of the application; or

(b) where there is a declared priority date, that date.

(2) Where a person's application under rule 11(1)(a) or (b) has been accepted by the comptroller, the comptroller must ensure that the application for the patent as published does not mention that person's name and address as those of the person believed to be the inventor (or, as the case may be, that person's address as that of the person so believed).

Search under section 17

27.—(1) A request under section 17(1)(c)(i) for a search must be made on Patents Form 9A.

(2) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner's report made under section 17.

(3) Where an examiner conducts a search in relation to the first only of two or more inventions, in accordance with section 17(6), he must report this fact to the comptroller, and the comptroller must notify the applicant accordingly.

(4) The applicant must pay any search fee in relation to those inventions (other than the first) on or before the relevant date.

(5) The relevant date is the first day of the three month period ending with the compliance date of the application.

(6) The fee for a supplementary search under section 17(8), or a search under section 17(6), must be accompanied by Patents Form 9A.

Request for substantive examination under section 18

28.—(1) A request under section 18 for a substantive examination of an application must be made on Patents Form 10.

(2) Subject to paragraphs (3) and (4) and rules 60 and 68(4), the period prescribed for the purposes of section 18(1) is six months beginning immediately after the date the application was published.

(3) Where the comptroller has given directions under section 22(1) or (2) in relation to information contained in the application, the period prescribed for the purposes of section 18(1) is the relevant period.

(4) Paragraphs (2) and (3) do not apply to a new application.

(5) In relation to a new application, the period prescribed for the purposes of section 18(1) is—

(a) two months beginning immediately after its initiation date; or

(b) if it expires later, the relevant period,

and the reference in paragraph (7) to the date of filing of the application is a reference to the date of filing of the earlier application.

(6) But where the new application is filed less than six months before the compliance date, the period prescribed for the purposes of section 18(1) is the period ending with its initiation date.

(7) For the purposes of this rule the relevant period is two years beginning immediately after—

(a) where there is no declared priority date, the date of filing of the application; or

(b) where there is a declared priority date, that date.

Substantive examination reports

29.—(1) Whenever the examiner reports to the comptroller under either section 18(3) or (4) on whether the application complies with the requirements of the Act and these Rules, the comptroller must send a copy of that report to the applicant.

(2) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner's report.

(3) For the purposes of rules 30 and 31—

(a) "first substantive examination report" means the first report sent to the applicant under paragraph (1); and

(b) "first observations report" means a report sent to the applicant under paragraph (1) which meets the condition in paragraph (4).

(4) The condition is that—

(a) a person has made observations to the comptroller under section 21(1) on the question whether the invention is a patentable invention;

(b) the examiner has reported to the comptroller, as a consequence of those observations, that the invention does not comply with the requirements of the Act or these Rules; and

(c) the comptroller has not previously sent to the applicant a report, relating to those observations, under paragraph (1).

Period for putting application in order

30.—(1) The period prescribed for the purposes of sections 18(4) and 20(1) (failure of application) is the compliance period.

(2) For the purposes of paragraph (1), subject to paragraphs (3) and (4), the compliance period is—

(a) four years and six months beginning immediately after—

(i) where there is no declared priority date, the date of filing of the application, or

(ii) where there is a declared priority date, that date; or

(b) if it expires later, the period of twelve months beginning immediately after the date on which the first substantive examination report is sent to the applicant.

(3) Subject to paragraph (4), where a new application is filed the compliance period is—

(a) where it is filed under section 8(3), 12(6) or 37(4)—

(i) the period specified in paragraph (2) in relation to the earlier application, or

(ii) if it expires later, the period of eighteen months beginning immediately after the initiation date; and

(b) where it is filed as mentioned in section 15(9), the period specified in paragraph (2) in relation to the earlier application.

(4) Where the first observations report is sent to the applicant during the last three months of the period specified in paragraphs (2) or (3), the compliance period is three months beginning immediately after the date on which that report is sent.

Fee for the grant of a patent under section 18(4)

30A. —(1) Where at the date of notification by the comptroller to the applicant in accordance with section 18(4)—

(a) the number of claims contained in the application—

(i) exceeds twenty-five; and

(ii) is greater than the number of claims contained in the application as at the date when the applicant made a request for a search under section 17(1)(c); or

(b) the number of pages of the description contained in the application—

(i) exceeds thirty-five; and

(ii) is greater than the number of pages of the description contained in the application as at the date when the applicant made a request for a substantive examination under section 18(1);

the applicant must pay a fee for the grant of the patent under section 18(4).

(2) The fee for the grant must be accompanied by Patents Form 34 and the period prescribed for the purposes of section 18(4) is two months beginning immediately after the date of the notification referred to in paragraph (1).

Amendment of application before grant

31.—(1) A request to amend an application for a patent under section 19(1) must be made in writing.

(2) The conditions prescribed under section 19(1) are as follows.

(3) Subject to rule 66A 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 section 17(5) and ending with the date on which the comptroller sends him the first substantive examination report.

(4) But after the end of this period, the applicant may—

(a) where the first substantive examination report states that his application complies with the requirements of the Act and these Rules, amend his application once before the end of the period of two months beginning immediately after the date on which that report was sent; or

(b) where the first substantive examination report states that his application does not comply with the requirements of the Act and these Rules—

(i) amend his application once at the same time as he makes his first observations on, or amendments to, his application under section 18(3), and

(ii) if the first substantive examination report is sent before preparations for the application's publication have been completed by the Patent Office, amend his application prior to any further amendment he may make under sub-paragraph (b)(i).

(5) However, the conditions in paragraphs (3) and (4) do not apply—

(a) where the comptroller consents to the amendment; or

(b) to an amendment of a request for the grant of a patent.

(6) Where the comptroller's consent is required, or the applicant wishes to amend the request for the grant of a patent, the applicant must include the reasons for the amendment.

Reinstatement of applications under section 20A

32.—(1) A request under section 20A for the reinstatement of an application must be made before the end of the relevant period.

(2) For this purpose the relevant period is twelve months beginning immediately after the date on which the application was terminated.

(3) The request must be made on Patents Form 14.

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

(5) The applicant must file evidence in support of that request.

(6) Where that evidence does not accompany the request, the comptroller must specify a period within which the evidence must be filed.

(7) Where, on consideration of that evidence, the comptroller is not satisfied that a case for an order under section 20A has been made out, he must notify the applicant accordingly.

(8) The applicant may, before the end of the period of one month beginning immediately after the date of that notification, request to be heard by the comptroller.

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

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

Observations by third parties on patentability

33.—(1) The comptroller must send to the applicant a copy of any observations on patentability he receives under section 21.

(2) But paragraph (1) does not apply to any observation which, in the opinion of the comptroller, would—

(a) disparage any person in a way likely to damage such person; or

(b) be generally expected to encourage offensive, immoral or anti-social behaviour.

(3) The comptroller may, if he thinks fit, send to the applicant a copy of any document referred to in the observations.

(4) The comptroller must send to an examiner any observations on patentability.

(5) But paragraph (4) does not apply where the observations are received after the examiner has reported under section 18(4) that an application complies with the requirements of the Act and these Rules.

PART 3

GRANTED PATENTS

Certificate and amendment

Certificate of grant

34. The certificate of grant of a patent must be in a form which includes—

(a) the name of the proprietor;

(b) the date of filing of the application; and

(c) the number of the patent.

Amendment of specification after grant

35.—(1) An application by the proprietor of a patent for the specification of the patent to be amended must—

(a) be made in writing;

(b) identify the proposed amendment; and

(c) state the reason for making the amendment.

(2) The application must, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications.

(3) The comptroller may, if he thinks fit, direct the proprietor to file a copy of the specification with the amendment applied for marked on it.

(4) Where the specification of a European patent (UK) was published in a language other than English, the proprietor must file a translation into English of the part of the specification which he is applying to amend and a translation of the amendment.

(5) The comptroller may, if he thinks fit, direct the proprietor to file a translation into English of the specification as published.

(6) Where the court or the comptroller allows the proprietor of a patent to amend the specification of the patent, the comptroller may direct him to file an amended specification which complies with the requirements of Schedule 2.

Renewal

Renewal of patents: general

36.—(1) In this rule and in rules 37 to 41—

"renewal date" has the meaning given in rules 37(2) to (4) and 38(3);

"renewal fee" means the fee prescribed in respect of a renewal date;

"renewal period" means the period prescribed by rule 37 or 38 for the payment of a renewal fee unless a renewal fee is payable by virtue of section 77(5A), in which case in this rule and in rules 39 and 41 "renewal period" means the period in which the fee is payable under section 77(5A) and rule 41A.

(2) If the renewal fee is not paid before the end of the renewal period, the patent shall cease to have effect—

(a) where the renewal fee is payable by virtue of section 77(5A), at the end of the final day of the renewal period;

(b) in any other case, at the end of the renewal date.

(3) Patents Form 12 must be filed before the end of the renewal period.

(4) But where payment is made under section 25(4) or section 28(3), Patents Form 12 must accompany the renewal fee and the prescribed additional fee.

(5) On receipt of the renewal fee the comptroller must issue a certificate of payment.

Renewal of patents: first renewal

37.—(1) This rule prescribes the period for the payment of a renewal fee in respect of the first renewal date.

(2) Subject to paragraphs (3) and (4)—

(a) the first renewal date is the fourth anniversary of the date of filing; and

(b) the renewal period is three months ending with the last day of the month in which that renewal date falls.

(3) Where a patent is granted under the Act during the period of three months ending with the fourth anniversary of the date of filing, or at any time after that anniversary—

(a) the first renewal date is the last day of the period of three months beginning immediately after the date on which the patent was granted; and

(b) the renewal period begins with the date on which the patent was granted and ends with the last day of the month in which that renewal date falls.

(4) Where the grant of a patent is mentioned in the European Patent Bulletin during the period of three months ending with the fourth anniversary of the date of filing, or at any time after that anniversary—

(a) the first renewal date is the later of—

(i) the last day of the period of three months beginning immediately after the date on which the grant of the patent was mentioned in the European Patent Bulletin (case A), or

(ii) the next anniversary of the date of filing to fall after the date on which the grant of the patent was so mentioned (case B); and

(b) the renewal period is—

(i) in case A, the period beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin and ending with the last day of the month in which the first renewal date falls, or

(ii) in case B, three months ending with the last day of the month in which the first renewal date falls.

Renewal of patents: subsequent renewals

38.—(1) This rule prescribes the period for the payment of a renewal fee in respect of renewal dates subsequent to the first renewal date.

(2) The renewal period is three months ending with the last day of the month in which the renewal date falls.

(3) For those purposes—

(a) the second renewal date is the next anniversary of the date of filing to fall after the first renewal date; and

(b) each subsequent renewal date is the anniversary of the previous renewal date.

Renewal notice

39.—(1) This rule applies where the renewal fee has not been received by the end of the renewal period.

(2) If the renewal fee remains unpaid, the comptroller must send a renewal notice to the proprietor of the patent—

(a) where the renewal fee is payable by virtue of section 77(5A), before the end of the period of six weeks beginning immediately after the later of—

(i) the end of the renewal period, and

(ii) the date on which the comptroller receives notification of the restoration of the patent from the European Patent Office;

(b) in any other case, before the end of the period of six weeks beginning immediately after the end of the renewal period.

(3) The comptroller must send the renewal notice to—

(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

(b) where such an address has not been so specified or notified, the address for service entered in the register.

(4) The renewal notice must remind the proprietor of the patent—

(a) that payment is overdue; and

(b) of the consequences of non-payment.

Restoration of lapsed patents under section 28

40.—(1) An application under section 28 for restoration of a patent may be made at any time before the end of the period ending with the thirteenth month after the month in which the period specified in section 25(4) ends.

(2) The application must be made on Patents Form 16.

(3) The notice of the application must be published in the journal.

(4) The applicant must file evidence in support of the application.

(5) If that evidence does not accompany the application, the comptroller must specify a period within which the evidence shall be filed.

(6) If, on consideration of that evidence, the comptroller is not satisfied that a case for an order under section 28 has been made out, he must notify the applicant accordingly.

(7) The applicant may, before the end of the period of one month beginning immediately after the date of that notification, request to be heard by the comptroller.

(8) If the applicant requests a hearing, the comptroller must give the applicant an opportunity to be heard before he determines whether to grant or refuse the application under section 28.

(9) Where the comptroller grants the application he must advertise the fact in the journal.

Notification of lapsed patent

41.—(1) This rule applies where—

(a) a patent has ceased to have effect because a renewal fee has not been paid by the end of the renewal period; and

(b) the renewal fee and the prescribed additional fee have not been paid by the end of the period specified in section 25(4) ("the extended period").

(2) The comptroller must, before the end of the period of six weeks beginning immediately after the end of the extended period, send a notice to the proprietor of the patent—

(a) stating that the extended period has expired; and

(b) referring him to the provisions of section 28.

(3) The comptroller must send the notice to the address specified by rule 39(2).

Payment of fees under section 77(5A) following restoration of a European patent (UK)

41A. — The prescribed period for the purposes of section 77(5A) is two months.

Surrender and cancelling entry that licences available as of right

Surrender

42. The notice of an offer by a proprietor to surrender a patent must be in writing and include—

(a) a declaration that no action is pending before the court for infringement or revocation of the patent; or

(b) where such an action is pending, the particulars of the action.

Application for, and cancellation of, an entry that licences are available as of right

43.—(1) An application under section 46(1) must be made on Patents Form 28.

(2) Where an entry is made in the register to the effect that licences under a patent are to be available as of right, the comptroller must advertise the entry in the journal.

(3) An application under section 47(1) for the cancellation of an entry made under section 46 must be made on Patents Form 30.

(4) The period prescribed for the purposes of section 47(3) is two months beginning immediately after the date on which the entry was made under section 46.

PART 4

THE REGISTER AND OTHER INFORMATION

The register

Entries in the register

44.—(1) When an application for a patent is published, the comptroller must enter each of the following matters in the register—

(a) the name of the applicant;

(b) the name and address of the person identified as the inventor;

(c) the address of the applicant and his address for service;

(d) the title of the invention;

(e) the date of filing of the application for a patent;

(f) the application number;

(g) where a declaration has been made for the purposes of section 5(2)—

(i) the date of filing of each earlier relevant application specified in the declaration,

(ii) its application number, and

(iii) the country it was filed in or in respect of; and

(h) the date of the application's publication.

(2) But where a person's application under rule 11(1)(a) or (b) has been accepted by the comptroller, the comptroller may omit from the register his name and address (or, as the case may be, his address) as that of the person believed to be the inventor.

(3) Where an application for a patent has been published, the comptroller must enter each of the following matters in the register as soon as practicable after the event to which they relate—

(a) the date on which a request is made by an applicant for the substantive examination of his application;

(b) the date on which an application is terminated or withdrawn.

(4) When the patent is granted, the comptroller must enter each of the following matters in the register—

(a) the date on which the comptroller granted the patent;

(b) the name of the proprietor of the patent;

(c) where the address of the proprietor or his address for service was not entered in the register under paragraph (1), that address or address for service.

(5) In relation to a request for an opinion under section 74A, the comptroller must enter each of the following matters in the register as soon as practicable after the event to which they relate—

(a) a notice that a request under section 74A(1) has been received;

(b) a notice that such a request has been refused or withdrawn;

(c) a notice that an opinion has been issued.

(6) A notice of any transaction, instrument or event mentioned in section 32(2)(b) or 33(3) must be entered in the register as soon as practicable after it occurs (or, if later, when the application is published).

(7) The comptroller may, at any time, enter in the register such other particulars as he thinks fit.

Advertisement in relation to register

45. The comptroller may publish or advertise such things done under the Act or these Rules in relation to the register as he thinks fit.

Copies of entries in, or extracts from, the register and certified facts

46.—(1) An application under section 32(6) for a certified copy of an entry in the register, or a certified extract from the register, must be made on Patents Form 23.

(2) A person may apply on Patents Form 23 for an uncertified copy of an entry in the register or an uncertified extract from the register and, on payment of the prescribed fee, he shall be entitled to such a copy or extract.

(3) A person may apply on Patents Form 23 for a certificate which certifies that—

(a) an entry has or has not been made in the register; or

(b) something which the comptroller is authorised to do has or has not been done.

Registrations of transactions, instruments and events

47.—(1) An application to register (or in the case of an application for a patent which has not been published, to give notice of) any transaction, instrument or event mentioned in section 32(2)(b) or 33(3) must—

(a) be made on Patents Form 21; and

(b) include evidence establishing the transaction, instrument or event.

(2) The comptroller may direct that such evidence as he may require in connection with the application shall be sent to him within such period as he may specify.

Copies of documents and corrections in relation to the register

Copies of documents

48.—(1) A person may apply to the comptroller for a certified copy of any relevant document and, on payment of the prescribed fee, he shall be entitled to such a copy.

(2) A person may apply to the comptroller for an uncertified copy of any relevant document and, on payment of the prescribed fee, he shall be entitled to such a copy.

(3) But a person is not entitled to a copy of a relevant document where—

(a) it is not available for inspection under section 118; or

(b) making or providing such a copy would infringe copyright.

(4) For the purposes of this rule a relevant document is any of the following—

(a) an application for a patent which has been published;

(b) a specification of a patent;

(c) any other document, or extract from any such document, kept at the Patent Office.

(5) An application under paragraph (1) or (2) must be made on Patents Form 23.

Correction or change of name or address; correction of address for service

49.—(1) Any person may request that a correction be entered in the register or made to any application or other document filed at the Patent Office in respect of any of the following—

(a) his name;

(b) his address;

(c) his address for service.

(2) A request under paragraph (1)(a) to correct a name must be made on Patents Form 20.

(3) Any other request under paragraph (1) must be made in writing.

(4) If the comptroller has reasonable doubts about whether he should make the correction—

(a) he must inform the person making the request of the reason for his doubts; and

(b) he may require that person to file evidence in support of the request.

(5) If the comptroller has no doubts (or no longer has doubts) about whether he should make the correction, he must enter the correction in the register or make it to the application or document.

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

Request for correction of error

50.—(1) Subject to rule 49, any person may request the correction of an error in the register or in any document filed at the Patent Office in connection with registration.

(2) The request must be—

(a) made in writing; and

(b) accompanied by sufficient information to identify the nature of the error and the correction requested.

(3) If the comptroller has reasonable doubts about whether there is an error—

(a) he shall inform the person making the request of the reason for his doubts; and

(b) he may require that person to furnish a written explanation of the nature of the error or evidence in support of the request.

(4) If the comptroller has no doubts (or no longer has doubts) about whether an error has been made he shall make such correction as he may agree with the proprietor of the patent (or, as the case may be, the applicant).

Requests for information or documents

Restrictions on inspection of documents

51.—(1) For the purposes of section 118(1) the prescribed restrictions are those set out in paragraphs (2) and (3).

(2) No document may be inspected—

(a) where that document was prepared by the comptroller, an examiner or the Patent Office for internal use only;

(b) where the circumstances specified in section 118(4) exist, before the end of the period of 14 days beginning immediately after the date of the notification under rule 52(2);

(c) where that document is a request or application made under section 118 or rule 46(2), 48(2) or 54(1); or

(d) where that document includes matter—

(i) which in the comptroller's opinion disparages any person in a way likely to damage him, or

(ii) the inspection of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

(3) Unless in a particular case the comptroller otherwise directs, no document may be inspected—

(a) where that document was filed at the Patent Office in connection with an application under section 40(1) or (2) or 41(8);

(b) where that document is treated as a confidential document under rule 53;

(c) where—

(i) that document was prepared by the comptroller, an examiner or the Patent Office other than for internal use, and

(ii) it contains information which the comptroller considers should remain confidential;

(d) where that document relates to an international application for a patent and the International Bureau would not be permitted to allow access to that document under the Patent Co-operation Treaty; or

(e) where—

(i) the comptroller has accepted a person's application under rule 11(1)(a) or (b), and

(ii) that person's name and address can be identified from that document as those of the inventor or of the person believed to be the inventor (or, as the case may be, his address can be so identified).

(4) In this rule references to a document include part of a document.

Request for information where section 118(4) applies

52.—(1) Where the circumstances specified in section 118(4) exist, a request under section 118(1) must be accompanied by evidence verifying their existence.

(2) The comptroller must notify the applicant for the patent of any request.

(3) The notification must be accompanied by a copy of the request and the accompanying evidence.

(4) The applicant may, before the end of the period of 14 days beginning immediately after the date of the notification, inform the comptroller that the circumstances specified in section 118(4) do not exist; otherwise the comptroller may treat him as accepting that those circumstances exist.

Confidential documents

53.—(1) Where a person files a document at the Patent Office or sends it to an examiner or the comptroller, any person may request that the document be treated as a confidential document.

(2) The comptroller must refuse any request where it relates to—

(a) a Patents Form; or

(b) any document filed in connection with a request under section 74A.

(3) A request to treat a document as confidential must—

(a) be made before the end of the period of 14 days beginning immediately after the date on which the document was—

(i) filed at the Patent Office, or

(ii) received by the comptroller, an examiner or the Patent Office; and

(b) include reasons for the request.

(4) Where a request has been made under paragraph (1), the document must be treated as confidential until the comptroller refuses that request or gives a direction under paragraph (5).

(5) If it appears to the comptroller that there is good reason for the document to remain confidential, he may direct that the document shall be treated as a confidential document; otherwise he must refuse the request made under paragraph (1).

(6) But where the comptroller believes there is no longer a good reason for the direction under paragraph (5) to continue in force, he must revoke it.

(7) In this rule references to a document include part of a document.

Requests for certain information

54.—(1) Where a person requests to be notified of a relevant event, he must use Patents Form 49.

(2) Where a person has made such a request, the comptroller must notify him that the relevant event has occurred as soon as practicable after the event.

(3) But the comptroller shall not give him information or permit him to inspect a document unless he would be entitled to such information or to inspect such a document under section 118.

(4) A request on Patents Form 49 must be for information regarding a single relevant event only.

(5) For the purposes of paragraph (1), in relation to an application for a patent, each of the following is a relevant event—

(a) an applicant requesting, or failing to request, a substantive examination before the end of the period prescribed for the purposes of section 18(1);

(b) the application being published;

(c) the notice of grant of the patent being published under section 24;

(d) the application being terminated or withdrawn.

(6) For the purposes of paragraph (1), in relation to a patent, each of the following is a relevant event—

(a) a request for an opinion under section 74A;

(b) the patent ceasing to have effect by reason of section 25(3);

(c) the renewal fee and any additional fee being paid during the period specified in section 25(4);

(d) an application being made for the restoration of the patent which has ceased to have effect.

(7) For the purposes of paragraph (1), in relation to a patent or an application for a patent, each of the following is a relevant event—

(a) an entry being made in the register;

(b) a document becoming available for inspection under section 118 (by reason of a prescribed restriction no longer applying to the document);

(c) an application to register a transaction, instrument or event being made under rule 47;

(d) a matter being published in the journal.

Bibliographic information about an unpublished application

55. For the purposes of section 118(3)(b) the following bibliographic information is prescribed—

(a) the name of the applicant;

(b) the title of the invention;

(c) the number of the application;

(d) the date of filing of the application;

(e) where a declaration has been made for the purposes of section 5(2)—

(i) the date of filing of each earlier relevant application specified in the declaration,

(ii) its application number, and

(iii) the country it was filed in or in respect of;

(f) where an application has been terminated or withdrawn, that information; and

(g) where a transaction, instrument or event mentioned in section 32(2)(b) or 33(3) is notified to the comptroller, that information.

PART 5

EUROPEAN PATENTS (UK)

Translations

Translations of European patents (UK)

56.—(1) A translation into English of either—

(a) the specification of the European patent (UK), which is filed under section 77(6); or

(b) the claims of the specification of the application for a European patent (UK), which is filed under section 78(7),

must be accompanied by Patents Form 54.

(2) The translation must comply with the requirements set out in Parts 1 to 3 of Schedule 2.

(3) The translation and Patents Form 54 must be filed in duplicate.

(4) But paragraph (2) does not apply where a translation is delivered in electronic form or using electronic communications.

(5) Where the specification includes any drawings all annotations in French or German must be replaced with annotations in English.

(6) The period prescribed for the purposes of section 77(6)(a) is three months beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin.

(7) The period prescribed for the purposes of section 77(6)(b) is three months beginning with the date of publication, by the European Patent Office, of the specification as amended.

(8) No translation may be filed under section 77(6)(a) or (b) before the beginning of the period prescribed for the purposes of that provision.

(9) On a day appointed under section 77(9), section 77(6) and paragraphs (1)(a) and (5) to (8) of this rule shall cease to have effect.

(10) The day appointed for the purpose of paragraph (9) shall be the day of the coming into force of the Agreement on the application of Article 65 of the Convention on the Grant of European Patents made in London on 17th October 2000(**a**).

Corrected translations

57.—(1) A corrected translation filed under section 80(3) must be accompanied by Patents Form 54.

(2) The corrected translation must comply with the requirements set out in Parts 1 to 3 of Schedule 2.

(3) Where the corrected translation includes any drawings all annotations in French or German must be replaced with annotations in English.

(4) The corrected translation and Patents Form 54 must be filed in duplicate.

(5) But paragraph (2) does not apply where a translation is delivered in electronic form or using electronic communications.

(6) The period prescribed for the purposes of section 80(3) for payment of the prescribed fee is 14 days beginning immediately after the day the corrected translation is filed.

Conversion requests

Procedure for making a conversion request under section 81(2)(b)(i)

58.—(1) A request under section 81(2)(b)(i) must be—

(a) made in writing; and

(b) accompanied by a copy of the notification by the European Patent Office that the application has been deemed to be withdrawn.

(2) When making such a request, a person may also request the comptroller to send—

(a) a copy of his application for a European patent (UK); and

(b) a copy of the request,

to the central industrial property office of any contracting state designated in the application.

(3) The period prescribed for the purposes of section 81(2)(b)(i) is three months beginning immediately after the date of the notification mentioned in paragraph (1)(b).

(4) Where a request has been made under section 81(2)(b)(i), the period prescribed for the purposes of sections 13(2), 15(10)(d) and 81(2)(c) is two months beginning immediately after the date on which the comptroller received that request.

(5) In paragraph (2) "contracting state" means a country which is a party to the European Patent Convention.

Procedure for making a conversion request under section 81(2)(b)(ii)

59.—(1) The period prescribed for the purposes of section 81(2)(b)(ii) is twenty months beginning immediately after—

(a) where there is no declared priority date, the date of filing of the application; or

(b) where there is a declared priority date, that date.

(**a**) Cm 5247.

(2) Where a request, transmitted under section 81(2)(b)(ii), has been received by the comptroller, he must notify the applicant accordingly.

(3) Where a request has been transmitted under section 81(2)(b)(ii), the period prescribed for the purposes of sections 13(2), 15(10)(d) and 81(2)(c) is four months beginning immediately after the date of that notification.

Request for substantive examination following a direction under section 81

60. Where an application for a European patent (UK) falls to be treated as an application for a patent under the Act by virtue of a direction under section 81, the period prescribed for the purposes of section 18(1) is two years beginning immediately after—

(a) where there is no declared priority date, the date of filing of the application; or

(b) where there is a declared priority date, that date.

Obligations to other contracting parties to the European Patent Convention

Recognition of patent decision of competent authorities of other states

61.—(1) Where in proceedings before the comptroller a person seeks recognition of a relevant determination, he must furnish to the comptroller a copy of the determination duly certified by the relevant official of the competent authority.

(2) In paragraph (1) "relevant determination" means the determination of a question to which section 82 applies by the competent authority of a relevant contracting state other than the United Kingdom.

Procedure for obtaining evidence for proceedings under the European Patent Convention

62.—(1) An application to the comptroller for an order under the Evidence (Proceedings in Other Jurisdictions) Act 1975(**a**) as applied by section 92(1) must be—

(a) made in writing;

(b) supported by written evidence;

(c) accompanied by the request as a result of which the application is made, and where appropriate, a translation of the request into English; and

(d) accompanied by the prescribed fee.

(2) The application must be made without notice.

(3) The comptroller may permit an officer of the European Patent Office to attend the hearing and either—

(a) examine the witnesses; or

(b) request the comptroller to put specified questions to the witnesses.

Communication of information to the European Patent Office

63. The comptroller may authorise any information in the files of the Patent Office to be communicated to the European Patent Office or to a competent authority of any country which is a party to the European Patent Convention, except where that information cannot be communicated under section 118.

(**a**) 1975 c. 34.

PART 6

INTERNATIONAL APPLICATIONS

Interpretation

Interpretation relating to international applications

64. In this Part the following have the same meaning as they have in the Patent Co-operation Treaty—

"competent receiving Office";

"International Preliminary Examination Report";

"International Preliminary Report on Patentability";

"International Search Report";

"International Searching Authority";

"receiving Office".

Filing at the Patent Office

Filing of international applications at the Patent Office

65.—(1) An international application for a patent filed at the Patent Office as a competent receiving Office under the Patent Co-operation Treaty must be filed in English or Welsh.

(2) [repealed]

(3) Where the Patent Office was acting on behalf of the International Bureau as the receiving Office, the comptroller shall only transmit an international application for a patent filed at the Patent Office to the International Bureau and the International Searching Authority after the appropriate fee has been paid.

(4) A request under the Treaty for a certified copy of an international application for a patent (including any corrections to that application) filed at the Patent Office as the competent receiving Office must be filed on Patents Form 23.

Beginning the national phase, international exhibitions and altered prescribed periods

Beginning of national phase

66.—(1) The prescribed period for the purposes of section 89A(3)(a) and (5)(a) is thirty one months beginning immediately after—

(a) where there is no declared priority date, the date of filing of the application;

(b) where there is a declared priority date, that date.

(2) But where the applicant has been notified under rule 69(5), the period prescribed for the purposes of section 89A(3)(a) and (5)(a) is three months beginning immediately after the date of the notification.

(3) Where an international application for a patent (UK) has begun the national phase, a request for permission to make a late declaration may be made under section 5(2B) before the end of the period of one month beginning immediately after the date the national phase of the application begins.

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 under section 19(1) 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 the applicant 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 commence 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 the applicant the first substantive examination report.

International exhibitions

67.—(1) Paragraph (2) applies where an applicant, on filing an international application for a patent (UK), states in writing to the receiving office that the invention has been displayed at an international exhibition.

(2) The prescribed period for the purposes of section 2(4)(c) is two months beginning immediately after the date on which the national phase begins.

Altered prescribed periods

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

(2) The period prescribed for the purposes of section 13(2) is—

(a) the period prescribed by rule 10(3); or

(b) if it expires later, the period of two months beginning immediately after the date on which the national phase begins.

(3) The period prescribed for the purposes of sections 15(10)(c) and (d) and 17(1) is—

(a) the period prescribed by rule 22(2) and (7); or

(b) if it expires later, the period of two months beginning immediately after the date on which the national phase begins.

(4) The period prescribed for the purposes of section 18(1) is—

(a) thirty three months beginning immediately after—

(i) where there is no declared priority date, the date of filing of the application; or

(ii) where there is a declared priority date, that date; or

(b) if it expires later, the period of two months beginning immediately after the date on which the national phase begins.

Necessary translations under section 89A(3) and (5)

69.—(1) A translation is necessary for the purposes of section 89A(3) where any of the following are not in English—

(a) the international application for a patent (UK) as published in accordance with the Patent Co-operation Treaty;

(b) where the information mentioned in paragraph 3(2)(a) and (b) of Schedule 1 (biological material) has been provided, that information.

(2) Where the applicant expressly requests the comptroller to proceed with the national phase before the end of the period prescribed by rule 66(1), the translation must include the request and abstract.

(3) But paragraph (2) does not apply where a copy of the application, as published in accordance with the Patent Co-operation Treaty, is available to the comptroller.

(4) A translation of an amendment is necessary for the purposes of section 89A(5) where any amendment made to the application is not in English and has either been—

(a) published under the Patent Co-operation Treaty; or

(b) annexed to the International Preliminary Examination Report.

(5) At the end of the period prescribed by rule 66(1), the comptroller must notify the applicant that a necessary translation is missing if—

(a) a translation of the application has been filed, but a translation of the amendment has not been filed; or

(b) the information mentioned in paragraph 3(2)(a) and (b) of Schedule 1 (biological material) has been provided, but a translation of that information has not been filed,

and the prescribed fee has been paid.

Requirements of necessary translations

70.—(1) This rule applies to translations which are necessary for the purposes of section 89A(3) and (5).

(2) Such a translation is necessary for only that part of the application which is in a language other than English.

(3) Where the application includes a drawing which is annotated, the translation shall include either—

(a) a copy of the original drawing where the original annotations have been replaced by annotations in English; or

(b) a new drawing with the annotations in English.

(4) Where a title has been established for the application by the International Searching Authority, the translation must include that title (and not any title which was included in the application as it was originally filed).

(5) Where—

(a) the description of the invention includes a sequence listing; and

(b) the listing complies with the relevant requirements of the Patent Co-operation Treaty,

the translation of the application may exclude a translation of the sequence listing.

(6) This rule applies to translations of amendments as it applies to translations of applications and accordingly references to "application" shall be construed as references to "amendment".

Application deemed withdrawn or filing date refused under the Patent Co-operation Treaty

Directions under section 89(3) and (5)

71.—(1) The applicant may, before the end of the relevant period, make a written request to the comptroller to give a direction under section 89(5).

(2) The applicant may notify the comptroller that the circumstances mentioned in section 89(3) or rule 72 apply to his application.

(3) The request under paragraph (1) must be accompanied by—

(a) a statement of the reasons for the request; and

(b) the fee prescribed for the purposes of section 89A(3).

(4) The relevant period is two months beginning immediately after the date on which—

(a) the International Bureau; or

(b) the receiving Office,

notifies the applicant that his international application for a patent (UK) is refused a filing date under the Patent Co-operation Treaty.

(5) Where the applicant has made a request to the comptroller under paragraph (1), the comptroller may direct the applicant to furnish him with any document, information or evidence within such period as the comptroller may specify.

(6) Where the applicant fails, before the end of the period specified, to comply with a direction given under paragraph (5), the comptroller may treat him as having withdrawn his request.

(7) Where section 89(3) applies or a direction has been given under section 89(5) the comptroller may—

(a) alter any period of time (whether it has already expired or not) specified in the Act or listed in Parts 1 to 3 of Schedule 4; and

(b) amend any document kept at the Patent Office in relation to the application,

subject to such conditions as the comptroller may direct.

Circumstance prescribed for the purposes of section 89(3)

72. The other circumstance prescribed for the purposes of section 89(3) is where the comptroller determines that, in comparable circumstances in relation to an application under the Act (other than an international application for a patent (UK)), he would have exercised his powers under rule 107 or 108 to prevent the application being treated as withdrawn.

PART 7

PROCEEDINGS HEARD BEFORE THE COMPTROLLER

Introductory

Scope and interpretation

73.—(1) This Part applies to the following proceedings heard before the comptroller—

(a) applications, references and requests under the provisions mentioned in Part 1 of Schedule 3;

(b) oppositions under the provisions mentioned in Part 2 of that Schedule.

(2) The rules listed in Part 4 of that Schedule apply to any proceedings heard before the comptroller under the Act.

(3) In this Part—

"claimant" means a person who starts proceedings or is treated as starting proceedings under rule 76(1);

"defendant" means a person who files a counter-statement under rule 77(6) or (8);

"statement of case" means the statement of grounds or the counter-statement and references to a statement of case include part of the statement of case;

"statement of grounds" means a statement filed by the claimant;

"statement of truth" means a statement that the person making the statement believes that the facts stated in a particular document are true; and

"witness statement" means a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

Overriding objective

74.—(1) The rules in this Part set out a procedural code with the overriding objective of enabling the comptroller to deal with cases justly.

(2) Dealing with a case justly includes, so far as is practicable—

(a) ensuring that the parties are on an equal footing;

(b) saving expense;

(c) dealing with the case in ways which are proportionate—

(i) to the amount of money involved,

(ii) to the importance of the case,

(iii) to the complexity of the issues, and

(iv) to the financial position of each party;

(d) ensuring that it is dealt with expeditiously and fairly; and

(e) allotting to it an appropriate share of the resources available to the comptroller, while taking into account the need to allot resources to other cases.

(3) The comptroller shall seek to give effect to the overriding objective when he—

(a) exercises any power given to him by this Part; or

(b) interprets any rule in this Part.

(4) The parties are required to help the comptroller to further the overriding objective.

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.

Conduct of hearings

Starting proceedings

76.—(1) Proceedings are started when a person files in duplicate—

(a) the relevant form; and

(b) his statement of grounds.

(2) Any person may give notice of opposition—

(a) in the case of section 75(2), before the end of the period of two weeks beginning immediately after the date of the relevant notice; and

(b) in the case of any of the other provisions mentioned in Part 2 of Schedule 3, before the end of the period of four weeks beginning immediately after the date of the relevant notice.

(3) For the purposes of this rule and rule 77—

"relevant form" means—

(a) in relation to applications or requests under the provisions of the Medicinal Products Regulation or the Plant Protection Products Regulation mentioned in Part 1 of Schedule 3, Patents Form SP3;

(b) in relation to applications, references or requests under any other provision mentioned in Part 1 of that Schedule, Patents Form 2; and

(c) in relation to oppositions under the provisions mentioned in Part 2 of that Schedule, Patents Form 15; and

"relevant notice" means the advertisement in the journal mentioned in rule 75.

(4) A statement of grounds must—

(a) include a concise statement of the facts and grounds on which the claimant relies;

(b) in the case of rule 89(5), include the grounds of objection to the draft licence;

(c) where appropriate, include the period or terms of the licence which he believes are reasonable;

(d) specify the remedy which he seeks;

(e) where it accompanies an application under the Compulsory Licensing Regulation(**a**), include any information required by that Regulation;

(f) be verified by a statement of truth; and

(g) comply with the requirements of Part 1 of Schedule 2.

Notification of the parties

77.—(1) The comptroller must notify the applicant for, or proprietor of, the patent which is the subject matter of the case that proceedings have started.

(2) In addition, the comptroller may notify any persons who appear to him to be likely to have an interest in the case that proceedings have started.

(3) But where a person mentioned in paragraph (1) or (2)—

(a) is the claimant; or

(b) has indicated in writing to the comptroller that he supports the claimant's case,

the comptroller has no duty to notify him.

(**a**) OJ No L 157, 9.6.2006, p1.

(4) The comptroller must send the relevant form and the statement of grounds with the notification under paragraph (1) or (2).

(5) In that notification, the comptroller must specify a period within which the persons notified may file a counter-statement.

(6) Any counter-statement must be filed in duplicate before the end of the period specified under paragraph (5).

(7) But paragraphs (5) and (6) do not apply to an opposition under any of the provisions mentioned in Part 3 of Schedule 3.

(8) In such oppositions, any counter-statement must be filed in duplicate before the end of the period of four weeks beginning immediately after the date of the relevant notice.

(9) Where—

(a) a person was notified under paragraph (1) or (2); and

(b) that person fails to file a counter-statement under paragraph (6) or (8),

the comptroller shall treat him as supporting the claimant's case.

(10) The period prescribed for the purposes of giving notice to the comptroller under section 47(6) of opposition to cancellation of an entry made under section 46 that licences are available as of right is the period prescribed by paragraph (8).

The counter-statement

78.—(1) Any counter-statement filed by the defendant must—

(a) state which of the allegations in the statement of grounds he denies;

(b) state which of the allegations he is unable to admit or deny, but which he requires the claimant to prove;

(c) state which of the allegations he admits;

(d) be verified by a statement of truth; and

(e) comply with the requirements of Part 1 of Schedule 2.

(2) Where the defendant denies an allegation—

(a) he must state his reasons for doing so; and

(b) if he intends to put forward a different version of events from that given by the claimant, he must state his own version.

(3) A defendant who fails to deal with an allegation in a counter-statement shall be taken to admit that allegation.

(4) But a defendant who—

(a) fails to deal with an allegation; but

(b) has set out in his counter-statement the nature of his case in relation to the issue to which the allegation is relevant,

shall be taken to require the allegation to be proved.

Copies of documents

79.—(1) Where a relevant statement refers to any other document, a copy of that document must accompany the relevant statement.

(2) Where more than one copy of a relevant statement is filed, each copy of the statement must be accompanied by a copy of any document referred to in the statement.

(3) But paragraphs (1) and (2) do not apply where—

(a) the relevant statement is sent to the comptroller; and

(b) the document referred to in the relevant statement was published by the comptroller or is kept at the Patent Office.

(4) In this rule "relevant statement" means a witness statement, statement of case, affidavit or statutory declaration.

Evidence rounds and the hearing

80.—(1) When the defendant files a counter-statement, the comptroller must as soon as practicable—

(a) send the counter-statement to the claimant;

(aa) specify the period within which the claimant must file Patents Form 4; and

(b) specify the periods within which evidence may be filed by the claimant and the defendant.

(1A) If the claimant wishes to continue the proceedings following receipt of the counter-statement, the claimant must file Patents Form 4.

(2) The comptroller may, at any time he thinks fit, give leave to either party to file evidence upon such terms as he thinks fit.

(3) Under this rule, evidence shall only be considered to be filed when—

(a) it has been received by the comptroller; and

(b) it has been sent to all the other parties to the proceedings.

(4) The comptroller must then give the parties an opportunity to be heard.

(5) If any party requests to be heard, the comptroller must send to the parties notice of a date for the hearing.

(6) When the comptroller has decided the matter he must notify all the parties of his decision, including his reasons for making the decision.

Alteration of time limits

81.—(1) The comptroller may extend or shorten (or further extend or shorten) any period of time which has been specified under any provision of this Part.

(2) An extension may be granted under paragraph (1) notwithstanding the period of time specified has expired.

Failure to file Patents Form 4

81A. If the claimant fails to file Patents Form 4 within the period specified by the comptroller the claimant shall be deemed to have filed a request to withdraw from the proceedings.

General powers of the comptroller in relation to proceedings before him

82.—(1) Except where the Act or these Rules otherwise provide, the comptroller may give such directions as to the management of the proceedings as he thinks fit, and in particular he may—

(a) require a document, information or evidence to be filed;

(b) require a translation of a specification of a patent or application or any other document which is not in English;

(c) require a party or a party's legal representative to attend a hearing;

(d) hold a hearing and receive evidence by telephone or by using any other method of direct oral communication;

(e) allow a statement of case to be amended;

(f) stay the whole, or any part, of the proceedings either generally or until a specified date or event;

(g) consolidate proceedings;

(h) direct that part of any proceedings be dealt with as separate proceedings; and

(i) direct that the parties attend a case management conference or pre-hearing review.

(2) The comptroller may control the evidence by giving directions as to—

(a) the issues on which he requires evidence;

(b) the nature of the evidence which he requires to decide those issues; and

(c) the way in which the evidence is to be placed before him,

and the comptroller may use his power under this paragraph to exclude evidence which would otherwise be admissible.

(3) When the comptroller gives directions under any provision of this Part, he may—

(a) make them subject to conditions; and

(b) specify the consequence of failure to comply with the directions or a condition.

Striking out a statement of case and summary judgment

83.—(1) A party may apply to the comptroller for him to strike out a statement of case or to give summary judgment.

(2) If it appears to the comptroller that—

(a) the statement of case discloses no reasonable grounds for bringing or defending the claim;

(b) the statement of case is an abuse of process or is otherwise likely to obstruct the just disposal of the proceedings; or

(c) there has been a failure to comply with a section, a rule or a previous direction given by the comptroller,

he may strike out the statement of case.

(3) The comptroller may give summary judgment against a claimant or defendant on the whole of a case or on a particular issue if—

(a) he considers that—

(i) that claimant has no real prospect of succeeding on the case or issue, or

(ii) that defendant has no real prospect of successfully defending the case or issue; and

(b) there is no other compelling reason why the case or issue should be disposed of at a hearing.

Hearings in public

84.—(1) Subject to paragraphs (3) and (4), any hearing before the comptroller in proceedings relating to an application for a patent, or a patent, shall be held in public.

(2) Any party to the proceedings may apply to the comptroller for a hearing to be held in private.

(3) The comptroller may grant an application under paragraph (2) where—

(a) he considers there is good reason for the hearing to be held in private; and

(b) all the parties to the proceedings have had an opportunity to be heard on the matter,

and where the application is granted the hearing must be held in private.

(4) Any hearing—

(a) of an application under paragraph (2); or

(b) relating to an application for a patent which has not been published,

shall be held in private.

(5) For the purposes of this rule a reference to a hearing includes any part of a hearing.

Miscellaneous

Security for costs or expenses

85.—(1) The conditions prescribed for the purposes of making an order for security for costs under section 107(4) are that the party against whom the order is made—

(a) is resident outside the United Kingdom;

(b) is a company or other body (whether incorporated inside or outside the United Kingdom) and there is reason to believe that it will be unable to pay another party's costs if ordered to do so;

(c) has changed his address for service with a view to evading the consequences of the litigation;

(d) has furnished an incorrect address for service; or

(e) has taken steps in relation to his assets that would make it difficult to enforce an order for costs against him.

(2) In relation to proceedings in Scotland, references in this rule to costs are references to expenses.

Powers of comptroller to compel attendance of witnesses and production of documents

86. The comptroller shall have the powers of a judge of the High Court (in Scotland, the Court of Session) as regards—

(a) the attendance of witnesses; and

(b) the discovery and production of documents,

but he shall have no power to punish summarily for contempt.

Evidence in proceedings before the comptroller

87.—(1) Subject to paragraphs (2) to (5), evidence filed under this Part may be given—

(a) by witness statement, statement of case, affidavit, statutory declaration; or

(b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement or a statement of case may only be given in evidence if it includes a statement of truth.

(3) Evidence is to be by witness statement unless the comptroller directs or any enactment requires otherwise.

(4) A witness statement, affidavit or statutory declaration must comply with the requirements of Part 1 of Schedule 2, unless the comptroller otherwise directs.

(5) For the purposes of this Part a statement of truth must be dated and signed by—

(a) in the case of a witness statement, the person making the statement; and

(b) in any other case, the party or his legal representative.

Proceedings in Scotland

88.—(1) Where there is more than one party to proceedings, a party to the proceedings may apply to the comptroller to hold proceedings in Scotland.

(2) An application made under paragraph (1) must be granted—

(a) where all the parties consent to the proceedings being held in Scotland; or

(b) where the comptroller considers it appropriate.

(3) A refusal of an application made under paragraph (1) is excepted from the right of appeal conferred by section 97.

Proceedings started under section 46(3) by a person other than the proprietor

89.—(1) An application by a person other than the proprietor to the comptroller under section 46(3)(a) or (b) must be—

(a) made on Patents Form 2; and

(b) accompanied by two copies of the draft of the licence he proposes should be granted.

(2) The comptroller must notify the proprietor of the patent that an application has been made.

(3) The comptroller must send a copy of the draft licence with the notification.

(4) In the notification, the comptroller must specify a period within which the proprietor may file a statement of grounds.

(5) The proprietor must file a statement of grounds in accordance with rule 76(4); otherwise he shall be treated as supporting the applicant's case.

(6) Proceedings shall continue under this Part as if they had been started under rule 76(1) and for those purposes the proprietor shall be "the claimant" and the applicant shall be "the defendant".

Licences following entitlement proceedings

90.—(1) The period prescribed for the purposes of section 11(3) and (3A) shall be two months beginning immediately after—

(a) where section 11 is applied by section 12(5), the date on which the order under section 12(1) was made; and

(b) in any other case, the date on which the order under section 8 was made.

(2) The period prescribed for the purposes of section 38(3) shall be two months beginning immediately after the date on which the order mentioned in section 38(2) was made.

Period prescribed for applications by employee for compensation

91.—(1) The period prescribed for the purposes of section 40(1) and (2) shall be the period beginning with the date of grant of the patent and ending one year after the patent ceased to have effect.

(2) But if an application for restoration is made under section 28 and—

(a) the application is granted, the period prescribed under paragraph (1) shall continue as if the patent had remained continuously in effect; or

(b) the application is refused, the period prescribed for the purposes of section 40(1) and (2) shall be—

(i) the period prescribed under paragraph (1), or

(ii) if it expires later, the period of six months beginning immediately after the date on which the application was refused.

PART 8

OPINIONS

Interpretation

Interpretation

92. In this Part—

"request" means, unless the context otherwise requires, a request for an opinion under section 74A(**a**);

"requester" means the person who makes that request;

"patent in suit" means the patent to which that request relates;

"patent holder" means the proprietor of that patent and any exclusive licensee of the patent; and

"relevant proceedings" means proceedings (whether pending or concluded) before the comptroller, the court or the European Patent Office.

Request for opinion

Request for an opinion under section 74A

93.—(1) A request must be made on Patents Form 17 and must be accompanied by a copy and a statement setting out fully—

(a) the question upon which an opinion is sought;

(b) the requester's submissions on that question; and

(c) any matters of fact which are requested to be taken into account.

(2) The statement must be accompanied by—

(a) the name and address of any persons, of whom the requester is aware, having an interest in that question; and

(b) particulars of any relevant proceedings of which the requester is aware which relate to the patent in suit and which may be relevant to that question.

(3) However, where the requester is acting as an agent in making the request, the persons referred to in paragraph (2)(a) do not include the person for whom the requester is so acting.

(4) The statement shall be accompanied by a copy of any evidence or other document (except a document which has been published by the comptroller or is kept at the Patent Office) which is referred to in the statement.

(5) Each such statement, evidence or other document must be provided in duplicate.

(6) The prescribed matters for the purposes of section 74A(1) are as follows—

(a) whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;

(**a**) 1977 c.37; section 74A was inserted by the Patents Act 2004 (c.16), section 13.

(b) whether, or to what extent, an invention for which the patent has been granted is not a patentable invention;

(c) whether the specification of the patent discloses the invention clearly enough and completely enough for it to be performed by a person skilled in the art;

(d) whether the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed or, if the patent was granted on a new application, in the earlier application as filed;

(e) whether the protection conferred by the patent has been extended by an amendment which should not have been allowed;

(f) whether a supplementary protection certificate is invalid under Article 15 of the Medicinal Products Regulation; and

(g) whether a supplementary protection certificate is invalid under Article 15 of the Plant Protection Products Regulation.

Refusal or withdrawal of request

94.—(1) The comptroller shall not issue an opinion if—

(a) the request appears to him to be frivolous or vexatious; or

(b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.

(2) The comptroller shall not issue an opinion if the requester gives him notice in writing that the request is withdrawn.

(3) If the comptroller intends at any time—

(a) to refuse the request because the condition in paragraph (1)(a) or (b) is satisfied; or

(b) to refuse the request because, in accordance with section 74A(3)(b), he considers it inappropriate in all the circumstances to issue an opinion,

he shall notify the requester accordingly.

Notification and advertisement of request

95.—(1) The comptroller must notify each of the following persons of the request (except where the person concerned is the requester)—

(a) the patent holder;

(b) any holder of a licence or sub-licence under the patent in suit which has been registered under rule 47;

(c) any person who has made a request in respect of the patent in suit under rule 54 regarding an opinion being requested under rule 93;

(d) any person who is specified under rule 93(2)(a).

(2) In addition, the comptroller may notify of the request any persons who appear to him to be likely to have an interest in the question upon which the opinion is sought.

(3) The comptroller must send a copy of the form and statement filed under rule 93(1) to each person so notified, together with a copy of such other documents filed under rule 93 as he thinks fit.

(4) The comptroller must advertise a request in such manner as he thinks fit.

(5) However, if the request is refused or withdrawn before a notification has been made under paragraph (1)—

(a) the patent holder alone must be notified of the request (and of the fact that it has been refused or withdrawn); and

(b) paragraphs (3) and (4) do not apply.

Submission of observations and observations in reply

96.—(1) If the request has not been refused or withdrawn, any person may, before the end of the relevant period, file observations on any issue raised by the request.

(2) Such observations may include reasons why the comptroller should refuse the request.

(3) Any person who files observations under paragraph (1) must ensure that, before the end of the relevant period, a copy of those observations is received—

(a) where that person is not the patent holder, by the patent holder; and

(b) by the requester.

(4) A person to whom observations are sent under paragraph (3) may, during the period of two weeks beginning immediately after the end of the relevant period, file observations confined strictly to matters in reply.

(5) Any person who files observations under paragraph (4) must ensure that, within that period of two weeks, a copy of those observations is received—

(a) where that person is the requester, by the patent holder; and

(b) where that person is the patent holder, by the requester.

(6) If it is reasonably possible, the observations filed under this rule and the copies of such observations shall be delivered only in electronic form or using electronic communications.

(7) For the purposes of this rule, the relevant period is four weeks beginning immediately after the date of advertisement under rule 95(4).

Issue of the opinion

97.—(1) After the end of the procedure under rule 96, the comptroller must refer the request to an examiner for the preparation of the opinion.

(2) The comptroller must issue the opinion that has been prepared by sending a copy to—

(a) the requester;

(b) the patent holder; and

(c) any other person who filed observations under rule 96(1).

Review of opinion

Review of opinion

98.—(1) The patent holder may, before the end of the period of three months beginning immediately after the date on which the opinion is issued, apply to the comptroller for a review of the opinion.

(2) However, such proceedings for a review may not be brought (or if brought may not be continued) if the issue raised by the review has been decided in other relevant proceedings.

(3) The application must be made on Patents Form 2 and be accompanied by a copy and a statement in duplicate setting out the grounds on which the review is sought.

(4) The statement must contain particulars of any relevant proceedings of which the applicant is aware which may be relevant to the question whether the proceedings for a review may be brought or continued.

(5) The application may be made on the following grounds only—

(a) that the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent; or

(b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

Procedure on review

99.—(1) On receipt of the application, the comptroller must send a copy of the form and statement filed under rule 98 to—

(a) the requester (if different from the applicant); and

(b) any person who filed observations under rule 96.

(2) The comptroller must advertise the application in such manner as he thinks fit.

(3) Before the end of the relevant period, any person may file a statement in support of the application or a counter-statement contesting it (which in either case must be in duplicate), and on so doing shall become a party to the proceedings for a review.

(4) For the purposes of paragraph (3) the relevant period is—

(a) four weeks beginning immediately after the date on which the application is advertised under paragraph (2); or

(b) if it expires later, the period of two months beginning immediately after the date on which the opinion is issued under rule 97(2).

(5) The comptroller shall send to the other parties a copy of each statement or counter-statement filed under paragraph (3).

(6) The rules listed in Parts 4 and 5 of Schedule 3 shall apply to the proceedings for a review and for the purposes of rule 83(3)—

(a) a reference to "the claimant" is a reference to the applicant for a review; and

(b) a reference to "the defendant" is a reference to any other party.

Outcome of review

100.—(1) On completion of the proceedings under rule 99 the comptroller shall either—

(a) set aside the opinion in whole or in part; or

(b) decide that no reason has been shown for the opinion to be set aside.

(2) A decision under paragraph (1)(a) or (b) shall not estop any party to any proceedings from raising any issue regarding the validity or the infringement of the patent.

(3) No appeal under section 97 shall lie from a decision to set aside the opinion under paragraph (1)(a), except where the appeal relates to a part of the opinion that is not set aside.

PART 9

MISCELLANEOUS

Agents and advisers

Agents

101.—(1) Any act required or authorised by the Act or these Rules to be done by or to any person in connection with an application for a patent, or any procedure relating to a patent, may be done by or to an agent authorised by that person orally or in writing—

(a) where an agent is appointed when a person starts or joins any proceeding under the Act, once the comptroller has been notified of his appointment in writing; or

(b) where an agent is appointed after a person has started or joined any proceeding under the Act, once Patents Form 51 has been filed.

(2) Where an agent has been authorised under paragraph (1), the comptroller may, in any particular case, require the signature or presence of his principal.

Appointing advisers

102. The comptroller may appoint an adviser to assist him in any proceeding before him and shall settle any question or instructions to be given to the adviser.

Address for service

Address for service

103.—(1) For the purposes of any proceeding under the Act or these Rules, an address for service must be furnished by—

(a) an applicant for the grant of a patent;

(b) a person who makes any other application, reference or request or gives any notice of opposition under the Act; and

(c) any person opposing such an application, reference, request or notice.

(2) The proprietor of a patent, or any person who has registered any right in or under a patent or application, may furnish an address for service by notifying the comptroller.

(3) Where a person has furnished an address for service under paragraph (1) or (2), he may substitute a new address for service by notifying the comptroller.

(4) An address for service furnished under this Rule shall be an address in the United Kingdom, Gibraltar or the Channel Islands.

Failure to furnish an address for service

104.—(1) Where—

(a) a person has failed to furnish an address for service under rule 103(1); and

(b) the comptroller has sufficient information enabling him to contact that person,

the comptroller shall direct that person to furnish an address for service.

(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of two months beginning immediately after the date of the direction, furnish an address for service.

(3) Paragraph (4) applies where—

(a) a direction was given under paragraph (1) and the period prescribed by paragraph (2) has expired; or

(b) the comptroller had insufficient information to give a direction under paragraph (1),

and the person has failed to furnish an address for service.

(4) Where this paragraph applies—

(a) in the case of an applicant for the grant of a patent, the application shall be treated as withdrawn;

(b) in the case of a person mentioned in rule 103(1)(b), his application, reference, request or notice of opposition shall be treated as withdrawn; and

(c) in the case of a person mentioned in rule 103(1)(c), he shall be deemed to have withdrawn from the proceedings.

(5) In this rule an "address for service" means an address which complies with the requirements of rule 103(4).

Corrections and remission of fees

Correction of errors

105.—(1) A request to the comptroller to correct an error or mistake under section 117 must be made in writing and identify the proposed correction.

(2) The comptroller may, if he thinks fit, require the person requesting a correction to produce a copy of the document indicating the correction.

(3) Where the request is to correct a specification of a patent or application, the request shall not be granted unless the correction is obvious (meaning that it is immediately evident that nothing else could have been intended in the original specification).

(4) But paragraph (3) does not apply where the error in the specification of the patent or application is connected to the delivery of the application in electronic form or using electronic communications.

(5) Where the comptroller determines that no person could reasonably object to the correction no advertisement shall be published under rule 75.

(6) Where the comptroller is required to publish a notice under section 117(3), it must be published in the journal.

(7) This rule does not apply to a correction of a name, address or address for service (which may be corrected under rule 49).

Remission of fees

106.—(1) A person may apply to the comptroller for the remission of a fee.

(2) The comptroller may remit the whole or part of a search fee where—

(a) in relation to an international application for a patent (UK), a copy of the International Search Report (as defined in rule 64) for that application is available to the comptroller; or

(b) a new application for a patent is filed as mentioned in section 15(9) and, in connection with the earlier application, the applicant has already paid the search fee for the invention described in the new application.

(3) The comptroller may remit the whole or part of any fee where—

(a) a person has requested the comptroller or an examiner to do something in accordance with the Act or these Rules; and

(b) the request is withdrawn before it is carried out.

(4) The comptroller may remit the whole or part of the fee payable in respect of a request for an opinion under section 74A where he has refused the request.

(5) Where a supplementary protection certificate lapses or is declared invalid, the comptroller must remit any fee which has been paid in respect of the relevant period.

(6) In paragraph (5) "the relevant period" is the period—

(a) beginning with the next anniversary of the start date following the date the certificate lapsed or was declared invalid; and

(b) ending with the date the certificate would have expired but for its lapse or invalidity.

(7) Any decision of the comptroller under this rule is excepted from the right of appeal conferred by section 97.

Correction of irregularities

107.—(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

(2) Any rectification made under paragraph (1) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions,

as the comptroller may direct.

(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and

(b) it appears to the comptroller that the irregularity should be rectified.

Time limits and delays

Extension of time limits

108.—(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4.

(2) The comptroller shall extend, by a period of two months, any period of time prescribed by the provisions listed in Part 2 of Schedule 4 where—

(a) a request is filed on Patents Form 52;

(b) no previous request has been made under this paragraph; and

(c) that request is filed before the end of the period of two months beginning immediately after the date on which the relevant period of time expired.

(3) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by the rules listed in Part 2 of Schedule 4 where—

(a) a request is filed on Patents Form 52; and

(b) the person making the request has furnished evidence supporting the grounds of the request, except where the comptroller otherwise directs.

(4) Each request under paragraph (2) or (3) for a period of time to be extended must be made on a separate form unless—

(a) each of those requests relate to the same patent or application for a patent; and

(b) the grant of each of those requests would result in the expiry of all the extended periods of time on the same date,

in which case those requests may be combined and made on a single form.

(5) Any extension made under paragraph (1) or (3) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions,

as the comptroller may direct, except that a period of time prescribed by the rules listed in Part 3 of Schedule 4 may be extended (or further extended) for a period of two months only.

(6) An extension may be granted under paragraph (1) or (3) notwithstanding the period of time prescribed by the relevant rule has expired.

(7) But no extension may be granted in relation to the periods of time prescribed by the rules listed in Part 3 of Schedule 4 after the end of the period of two months beginning immediately after the period of time as prescribed (or previously extended) has expired.

Extension of time limits specified by comptroller

109.—(1) A request under section 117B(2) must be—

(a) made in writing; and

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

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

Interrupted days

110.—(1) The comptroller may certify any day as an interrupted day where—

(a) there is an event or circumstance causing an interruption in the normal operation of the Patent Office; or

(b) there is a general interruption or subsequent dislocation in the postal services of the United Kingdom.

(2) Any certificate of the comptroller given under paragraph (1) shall be displayed in the Patent Office and advertised in the journal.

(3) The comptroller shall, where the time for doing anything under the Act expires on an interrupted day, extend that time to the next following day not being an interrupted day (or an excluded day).

(4) In this rule—

"excluded day" means a day specified as an excluded day in directions given under section 120; and

"interrupted day" means a day which has been certified as such under paragraph (1).

Delays in communication services

111.—(1) The comptroller shall extend any period of time specified in the Act or these Rules where he is satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions,

as the comptroller may direct.

(3) In this rule "communication service" means a service by which documents may be sent and delivered and includes post, electronic communications, and courier.

Copies available to the comptroller

Copies available to the comptroller

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

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

Translations

113.—(1) Where any document filed at the Patent Office, or sent to the comptroller, is in a language other than English or Welsh it must be accompanied by a translation into English of that document.

(2) But paragraph (1) does not apply to the following documents—

(a) where the documents filed to initiate an application for a patent include something which is or appears to be a description of the invention, the document containing that thing;

(b) a priority application;

(c) a copy of an application provided under section 15(10)(b)(ii);

(d) a copy of a specification of a European patent (UK) filed in connection with an application by the proprietor to amend the specification;

(e) a copy of an application for a European patent (UK) provided under section 81(2)(b)(ii);

(f) an international application for a patent (UK), where a translation of the application or an amendment to it is a necessary translation;

(g) a document referred to in paragraph (5).

(3) Where more than one copy of the document mentioned in paragraph (1) is filed or sent, a corresponding number of translations shall accompany it.

(4) Where a document to which paragraph (1) applies is not accompanied by a translation, the comptroller may, if he thinks fit, take no further action in relation to that document.

(5) In relation to an international application for a patent (UK), where any document which is in a language other than English or Welsh is—

(a) referred to in an International Search Report or International Preliminary Report on Patentability; or

(b) cited in an International Preliminary Examination Report,

and the relevant report is filed at the Patent Office, the comptroller may direct that a translation into English of that document be filed.

(6) Where a direction is given under paragraph (5) a translation of that document must be filed before the end of the period of two months beginning immediately after the date on which the direction is given; otherwise the comptroller may, if he thinks fit, take no further action in relation to the application.

(7) Subject to rule 82(1)(b), where a patent application or any document related to such application is filed at the Patent Office or sent to the comptroller in Welsh, and is not accompanied by a translation into English, the comptroller must obtain such a translation.

(8) In this rule a reference to a document includes a reference to a part of a document; and in paragraph (5) "International Preliminary Examination Report", "International Preliminary Report on Patentability" and "International Search Report" and have the same meaning as in rule 64.

Translations in proceedings in relation to a European patent (UK)

114.—(1) Where—

(a) proceedings are started before the comptroller in relation to a European patent (UK); and

(b) the specification of that patent was published in French or German,

the person who starts those proceedings shall file at the Patent Office a translation into English of the specification.

(2) But paragraph (1) shall not apply where—

(a) a translation into English of the specification has been filed under section 77(6); or

(b) the comptroller directs that a translation is unnecessary.

(3) Where, in the course of such proceedings, leave is given to amend the specification of the patent, the proprietor shall file at the Patent Office a translation of the amendment into the language in which the specification of the patent was published.

(4) This rule applies to making a request for an opinion under section 74A as it applies to proceedings started before the comptroller.

Establishing the accuracy of translations

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

(a) he shall notify that person of the reasons for his doubts; and

(b) he may require that person to furnish evidence to establish that the translation is accurate,

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

Supplementary Protection Certificates

Supplementary protection certificates

116.—(1) An application for—

(a) a supplementary protection certificate shall be made on Patents Form SP1; and

(b) an extension of the duration of a supplementary protection certificate under Article 8 of the Medicinal Products Regulation shall be made on Patents Form SP4.

(2) The period prescribed for the purposes of paragraph 5(a) of Schedule 4A to the Act is—

(a) three months ending with the start date; or

(b) where the certificate is granted after the beginning of that period, three months beginning immediately after the date the supplementary protection certificate is granted.

(3) The comptroller must send a notice to the applicant for the certificate—

(a) before the beginning of the period of two months immediately preceding the start date; or

(b) where the certificate is granted as mentioned in paragraph (2)(b), on the date the certificate is granted.

(4) The notice must notify the applicant for the certificate of—

(a) the fact that payment is required for the certificate to take effect;

(b) the prescribed fee due;

(c) the date before which payment must be made; and

(d) the start date.

(5) The prescribed fee must be accompanied by Patents Form SP2; and once the certificate has taken effect no further fee may be paid to extend the term of the certificate unless an application for an extension of the duration of the certificate is made under the Medicinal Products Regulation.

(6) Where the prescribed fee is not paid before the end of the period prescribed for the purposes of paragraph 5(a) of Schedule 4A to the Act, the comptroller shall, before the end of the period of six weeks beginning immediately after the end of that prescribed period, and if the fee remains unpaid, send a notice to the applicant for the certificate.

(7) The notice shall remind the applicant for the certificate—

(a) that payment is overdue; and

(b) of the consequences of non-payment.

(8) The comptroller must send the notices under this rule to—

(a) the applicant's address for service; and

(b) the address to which a renewal notice would be sent to the proprietor of the basic patent under rule 39(2).

Notifications relating to supplementary protection certificates

116A.—(1) Notifications under Article 5(2)(b) and (c) of the Medicinal Products Regulation must be made on Patents Form SP5.

(2) Notifications under Article 13A of Regulation (EC) 1610/96 and Article 13A of Regulation (EC) 469/2009 must be made on Patents Form SP6.

Publications

The journal

117. The comptroller must publish a journal containing—

(a) particulars of applications for and grants of patents and of other proceedings under the Act;

(b) any directions given under section 120(1) specifying hours of business or excluded days;

(c) any directions under section 123(2A) setting out forms; and

(d) any other information that the comptroller considers to be generally useful or important.

Reports of cases

118. The comptroller must make arrangements for the publication of—

(a) reports of cases relating to patents, trade marks, registered designs or design right decided by him; and

(b) reports of cases relating to patents (whether under the Act or otherwise), trade marks, registered designs, copyright and design right decided by any court or body (whether in the United Kingdom or elsewhere).

Publication and sale of documents

119. The comptroller may arrange for the publication and sale of copies of documents (in particular, specifications of patents and applications for patents) in the Patent Office.

Transitional provisions and revocations

120.—(1) Schedule 5 (transitional provisions) shall have effect.

(2) The instruments set out in Schedule 6 (revocations) shall be revoked to the extent specified.

SCHEDULE 1

Rule 13(1)

BIOLOGICAL MATERIAL

Introductory

1. In this Schedule—

"authorisation certificate" means a certificate issued by the comptroller authorising a depositary institution to make available a sample of biological material;

"Budapest Treaty" means the Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure signed at Budapest on 28th April 1977, as amended on 26th September 1980, and includes references to the regulations made under that Treaty;

"depositary institution" means an institution which—

(a) carries out the functions of receiving, accepting and storing biological material and the furnishing of samples of such biological material (whether generally or of a specific type); and

(b) conducts its affairs, in so far as they relate to the carrying out of those functions, in an objective and impartial manner;

"expert" means independent expert;

"first requirement" means the first requirement in paragraph 3;

"international depositary authority" means a depositary institution which has acquired the status of international depositary authority as provided in the Budapest Treaty; and

"second requirement" means the second requirement in paragraph 3.

Specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material

2.—(1) This paragraph applies where the specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material does not disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(2) Where this paragraph applies, the specification is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art, if—

(a) the first requirement and the second requirement are satisfied; and

(b) the specification of the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material.

The first and second requirements

3.—(1) The first requirement is that—

(a) on or before the date of filing of the application, the biological material has been deposited in a depositary institution; and

(b) that institution will be able to furnish subsequently a sample of the biological material.

(2) The second requirement is that before the end of the relevant period—

(a) the name of the depositary institution and the accession number of the deposit are included in the specification; and

(b) where the biological material was deposited by a person other than the applicant ("the depositor")—

(i) a statement is filed which identifies the name and address of the depositor, and

(ii) a statement by the depositor has been filed, which authorises the applicant to refer to the biological material in his application and irrevocably authorises the making available to the public of the biological material in accordance with this Schedule.

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

(a) the period of sixteen months—

(i) where there is no declared priority date, beginning immediately after the date of filing of the application; or

(ii) where there is a declared priority date, beginning immediately after that date;

(b) where the applicant has made a request under section 16(1) to publish the application during the period prescribed for the purposes of that section, the period ending with the date of the request; or

(c) where the applicant was notified under rule 52(2), the period of one month beginning immediately after the date of the notification.

(4) Where—

(a) the application is filed with the European Patent Office and documents have been filed under the provisions of the European Patent Convention corresponding to sub-paragraph (2); or

(b) the application in suit is an international application for a patent (UK) and documents have been filed in accordance with the Patent Co-operation Treaty under the provisions of the Treaty corresponding to sub-paragraph (2),

the second requirement shall be treated as having been met.

(5) In this paragraph—

"accession number" means the number given to the deposit by a depositary institution;

"specification" means the specification of an application for a patent.

A request by a person for biological material to be made available

4.—(1) This paragraph applies when paragraph 7 does not apply.

(2) Where an application for a patent has been published, any person may request the comptroller to issue an authorisation certificate.

(3) Where the application has not been published, a person who has been notified in accordance with section 118(4) may request the comptroller to issue an authorisation certificate.

(4) A request must be made on Patents Form 8.

(5) Where the biological material has been deposited at an international depositary authority, the request must be accompanied by the relevant form required by the Budapest Treaty.

(6) Where the comptroller grants the request, he must send copies of the request and the certificate (and any form required by the Budapest Treaty) to—

(a) the applicant for, or the proprietor of, the patent;

(b) the depositary institution; and

(c) the person making the request.

The undertaking

5.—(1) A request made under paragraph 4 or 7 shall include an undertaking by the person making the request—

(a) not to make the biological material, or any material derived from it, available to any other person; and

(b) not to use the biological material, or any material derived from it, except for experimental purposes relating to the subject matter of the invention,

subject to the following sub-paragraphs.

(2) The applicant for, or the proprietor of, a patent may agree to limit the effect of the undertaking in a particular case.

(3) The undertaking shall cease to have effect—

(a) when the application for a patent is terminated or withdrawn (but it will continue to have effect if the application is reinstated or resuscitated); or

(b) when the patent ceases to have effect.

(4) Where a request is made—

(a) by a government department or any person authorised in writing by a government department; and

(b) for the purposes of using the patented invention for the services of the Crown,

no undertaking is required and any undertaking by the government department or the person so authorised shall not have effect.

(5) Where—

(a) a licence under the patent to which the undertaking relates is available as of right; or

(b) a compulsory licence in respect of the patent to which the undertaking relates has been granted,

any undertaking made shall have no effect to the extent necessary to give effect to any such licence.

Restriction of availability of biological material to experts

6.—(1) Where the first or the second condition is met (except in relation to Crown use), paragraph 7 applies until the end of the relevant period.

(2) The first condition is—

(a) the applicant requests on Patents Form 8A that a sample of the biological material should only be made available to an expert; and

(b) that request is made before the preparations for the application's publication have been completed by the Patent Office.

(3) The second condition is that, in relation to an international application for a patent (UK), the applicant made a reference to the deposited biological material in accordance with the Patent Co-operation Treaty.

(4) Where the first condition is met, the comptroller shall, when he publishes the application, include a notice that the provisions of paragraph 7 apply.

(5) In paragraph 6(1) "the relevant period" is—

(a) where the patent is granted, the period ending with the date on which the patent was granted; and

(b) where the application is terminated or withdrawn, twenty years beginning immediately after the date of filing.

(6) Nothing in this or the following paragraph affects the rights under section 55 of any government department or any person authorised in writing by a government department.

Request for a sample to be made available to expert

7.—(1) A request for a sample to be made available to an expert must be made on Patents Form 8 and must include details of the expert.

(2) Where the biological material has been deposited at an international depositary authority, the request must be accompanied by any form required by the Budapest Treaty.

(3) The comptroller must send a copy of Patents Form 8 to the applicant for the patent.

(4) Before the end of the period of one month beginning immediately after the date on which a copy of Patents Form 8 is sent by the comptroller, the applicant may give notice of his objection to the particular expert, and where he objects the comptroller shall determine the matter.

(5) Where—

(a) the applicant does not object to the sample being made available; or

(b) following an objection, the comptroller decides that the sample should be made available to the particular expert,

the comptroller must issue a certificate authorising the release of a sample to the expert.

(6) A copy of Patents Form 8 (and any form required by the Budapest Treaty) and any certificate issued under sub-paragraph (5) must be sent to—

(a) the applicant for the patent;

(b) the depository institution where the sample of the biological material is stored;

(c) the expert; and

(d) the person who made the request.

New deposits

8.—(1) This paragraph applies where the first, second or third circumstance occurs.

(2) The first circumstance is that the biological material ceases to be available at the depositary institution because it is no longer viable.

(3) The second circumstance is that—

(a) the depositary institution is, for any other reason, unable to supply the biological material; or

(b) the place where the biological material is deposited is no longer a depositary institution for that type of material (whether temporarily or permanently).

(4) The third circumstance is that the biological material is transferred to a different depositary institution.

(5) The first requirement and the second requirement shall be treated as having been complied with throughout the relevant period, if and only if—

(a) where the first or second circumstance occurs—

(i) a new deposit of biological material is made at the relevant depositary before the end of the relevant period, and

(ii) that deposit is accompanied by a statement, signed by the person making the deposit, that the biological material deposited is the same as that originally deposited; and

(b) in all circumstances, the applicant or proprietor, before the end of the relevant period, applies to the comptroller to amend the specification of the application for the patent, or the patent, so that it meets the second requirement.

(6) For the purposes of paragraph (5) "the relevant period" is the period beginning when the first, second or third circumstance occurs and ending—

(a) three months after the date on which the depositor is notified by the depositary institution that the first, second or third circumstance occurred; or

(b) where it expires later, three months after the date on which that circumstance is advertised in the journal.

(7) The relevant depositary is—

(a) where only the first circumstance occurs, the depositary institution where the original deposit was made; or

(b) in any other case, any depositary institution.

SCHEDULE 2

Rule 14

FORMAL AND OTHER REQUIREMENTS

PART 1

REQUIREMENTS: ALL DOCUMENTS

1. A4 matt white paper must be used.

2. A document in paper form must be free from tears, folds or similar damage and its contents must be suitable for reproduction.

3. Frames (lines surrounding matter) must not be used.

PART 2

REQUIREMENTS: DOCUMENTS (OTHER THAN DRAWINGS AND PHOTOGRAPHS)

4. The pages of the description and claims must be numbered consecutively in a single series.

5. But where a sequence listing is set out at the end of the application, it must be numbered consecutively in a separate series.

6. Page numbers must be located at the top or bottom of the page (but not in the margin) in the centre.

7. The minimum margins in any document must be 20mm.

8. Each of the following—

(a) the request for the grant of a patent;

(b) the description;

(c) the claims;

(d) the abstract,

must begin on a new sheet of paper.

9. The abstract, description and claims must use at least 1.5 line spacing, except where they form part of a translation or a sequence listing.

10. The capital letters in any typeface or font used must be more than 2mm high.

PART 3

REQUIREMENTS: DRAWINGS AND PHOTOGRAPHS

11. There must be a margin around any drawing or photograph which must be at least—

(a) at the top and left side, 20mm;

(b) at the right side, 15mm; and

(c) at the bottom, 10mm.

12. All drawings or photographs must be numbered consecutively in a single series.

13. The drawings or photographs must begin on a new sheet of paper.

14. The pages containing the drawings or photographs must be numbered consecutively in a single series.

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.

16. Drawings may include cross-hatching to illustrate the cross-sections of a thing.

17. Any scale or other reference for making measurement must be represented diagrammatically.

18. Any drawing or photograph must be produced in such manner that it would still be clear if it were reduced by linear reduction to two thirds of its original size.

19. A drawing or photograph must not be included in the description, the claims, the abstract or the request for the grant of a patent.

20. The capital letters in any typeface or font used in any drawing or photograph must be more than 3mm high.

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

PART 4

OTHER REQUIREMENTS

21. References must only be included in the drawing or photograph where they are mentioned in either the description or the claims.

22. Tables of information may only be included in the claims if the comptroller agrees.

23. The terminology and any references used must be consistent throughout the application for a patent.

24. Where units of measurement used in the application are not standard international units of measurement, the equivalent standard international units of measurement must be provided, and where no international standard exists, units must be used which are generally accepted in the field.

25. Only technical terms, signs and symbols which are generally accepted in the field may be used.

SCHEDULE 3

Rule 73

PROCEEDINGS HEARD BEFORE THE COMPTROLLER

PART 1

APPLICATIONS, REFERENCES AND REQUESTS

Patents Act 1977

section 8(1) (reference regarding entitlement in relation to a patent under the Act)

section 10 (request for directions for handling a joint application)

section 11(5) (reference regarding entitlement to a licence to continue working after transfer of application)

section 12(1) (reference regarding entitlement in relation to a foreign or convention patent)

section 12(4) (reference involving joint applications on entitlement in relation to a foreign or convention patent)

section 13(3) (application to comptroller to remove person mentioned as inventor)

section 37(1) (determination of right to patent after grant)

section 38(5) (reference regarding entitlement to a licence to continue working after transfer of patent)

section 40 (application for compensation by an employee)

section 41(8) (application to vary order for compensation for certain inventions)

section 46(3) (application to settle terms of licence available as of right)

section 47(3) (application to cancel licence available as of right)

section 48(1) (application for a compulsory licence)

section 50A(2) (application following merger and market investigation)

section 51(1) (application by Minister following report of Competition Commission)

section 52(2)(a) (application to cancel compulsory licence)

section 61(3) (reference on question of infringement before the comptroller)

section 71 (declaration of non-infringement)

section 72 (application to revoke patent)

Patents Rules 2007

rule 10(2) (application to be mentioned as inventor)

rule 88(1) (application to hold proceedings in Scotland)

paragraph 7(4) of Schedule 1 (notice of objection to expert)

Compulsory Licensing Regulation

Article 5(c) of the Compulsory Licensing Regulation (application to terminate compulsory pharmaceutical licence)

Article 6(1) of that Regulation (application for a compulsory pharmaceutical licence)

Article 10(8) of that Regulation (application to access books and records)

Article 16(1), second paragraph, of that Regulation (application for a review of a compulsory pharmaceutical licence)

Article 16(4) of that Regulation (application for modification of a compulsory pharmaceutical licence)

Medicinal Products Regulation and Plant Protection Products Regulation

Article 14(d) of the Medicinal Products Regulation and the Plant Protection Products Regulation (request to review lapse of supplementary protection certificate)

Article 15 of those Regulations (application for declaration of invalidity of supplementary protection certificate)

Article 15a of the Medicinal Products Regulation (application for revocation of an extension of the duration of a supplementary protection certificate)

PART 2

OPPOSITIONS WHICH START PROCEEDINGS

Patents Act 1977

section 27(5) (opposition to amendment of specification after grant)

section 29(2) (opposition to surrender of patent)

section 47(6) (opposition to cancellation of licence available as of right), where the application was made by the proprietor of the patent

section 75(2) (opposition to amendment during infringement or revocation proceedings)

section 117(2) (opposition to correction of error in patents and applications)

PART 3

OPPOSITIONS AFTER PROCEEDINGS HAVE STARTED

Patents Act 1977

section 47(6) (opposition to cancellation of licence available as of right), where the application was made by a person other than the proprietor of the patent

section 52(1) (opposition to an application for compulsory licence or under section 50A or 51)

section 52(2)(b) (opposition to an application to cancel a compulsory licence)

PART 4

RULES WHICH APPLY TO ANY PROCEEDINGS HEARD BEFORE THE COMPTROLLER

Patents Rules 2007

rule 74 (overriding objective)

rule 79 (copies of documents)

rule 80(2) to (6) (evidence and the hearing)

rule 81 (alteration of time limits)

rule 82 (general powers of the comptroller in relation to proceedings before him)

rule 84 (hearings in public)

rule 87 (evidence in proceedings before the comptroller)

PART 5

RULES WHICH APPLY TO A REVIEW OF AN OPINION

Patents Rules 2007

rule 83 (striking out a statement of case and summary judgment)

rule 85 (security for costs or expenses)

rule 86 (powers of comptroller to compel attendance of witness and production of documents)

rule 88 (proceedings in Scotland)

SCHEDULE 4

Rule 108

EXTENSION OF TIME LIMITS

PART 1

PERIODS OF TIME THAT CANNOT BE EXTENDED

rule 6(2)(b) (declaration of priority for the purposes of section 5(2) made after the date of filing)

rule 7(1) (period for making a request to the comptroller for permission to make a late declaration of priority)

rule 32(1) (application to reinstate a terminated application)

rule 37 and 38 (renewal of patents)

rule 40(1) (application to restore a lapsed patent)

rule 41A (payment of fees under section 77(5A) following restoration of a European patent (UK)

rule 43(4) (application to cancel entry that licence available as of right)

rule 58(3) (request for a direction under section 81)

rule 59(1) (request from a foreign industrial property office for a direction under section 81)

rule 66(3) (period for making a request to the comptroller for permission to make a late declaration of priority in respect of an international application for a patent (UK))

rule 76(2) (notice of opposition), except in relation to an opposition under section 27(5) where there are pending before the court or the comptroller proceedings in which the validity of the patent is put in issue

rule 77(8) and (10) (opposition periods)

rule 109 (extension of time limits specified by comptroller)

rule 116(2) (fee for supplementary protection certificate)

paragraph 8(5) of Schedule 1 (new deposits of biological material)

PART 2

PERIODS OF TIME THAT MAY BE EXTENDED UNDER RULE 108(2) OR 108(3)

rule 8(1) and (2) (filing of information and priority documents)

rule 10(3) (filing of statement of inventorship and the right to be granted a patent)

rule 18(1) (missing parts)

rule 21 (extensions for new applications)

rule 22(1), (2) and (5) (periods prescribed for the purposes of sections 15(10) and 17(1))

rule 28(2), (3) and (5) (request for substantive examination)

rule 30 (period for putting an application in order)

rule 30A (fee for the grant of a patent under section 18(4))

rule 56(6) and (7) (filing of a translation of European patent (UK) specifications)

rule 58(4) (request under section 81(2)(b)(i))

rule 59(3) (request under section 81(2)(b)(ii))

rule 60 (request for substantive examination following a direction under section 81)

rule 66(1) and (2) (international applications for patents: entry into national phase)

rule 68 (international applications for patents: altered prescribed periods)

rule 104(2) (period for filing an address for service), in relation to an application for a patent

paragraph 3(2) of Schedule 1 (filing of information in relation to the deposit of biological matter)

PART 3

PERIODS OF TIME TO WHICH RULE 108(5) AND 108(7) RELATE

rule 10(3) (filing of statement of inventorship and the right to be granted a patent)

rule 12(3) and (9) (filing of name and address and translations)

rule 19 (new applications filed as mentioned in section 15(9))

rule 21(1)(a) and (2)(a) (extensions for new applications)

rule 22 (periods prescribed for the purposes of sections 15(10) and 17(1))

rule 28 (request for substantive examination)

rule 30 (period for putting application in order)

rule 30A (fee for the grant of a patent under section 18(4))

rule 58(4) (request under section 81(2)(b)(i))

rule 59(3) (request under section 81(2)(b)(ii))

rule 60 (request for substantive examination following a direction under section 81)

rule 66(1) and (2) (international applications for patents: entry into national phase)

rule 68 (international applications for patents: altered prescribed periods)

rule 104(2) (period for filing an address for service), in relation to an application for a patent

SCHEDULE 5

Rule 120(1)

TRANSITIONAL PROVISIONS

Interpretation

1. In this Schedule, the "1995 Rules" means the Patents Rules 1995(**a**) as they had effect immediately prior to their revocation by these Rules.

Periods of time

2. Where, in relation to any proceedings under the Act, a period of time prescribed by the 1995 Rules for the purposes of a particular provision of the Act has not expired before the date on which these Rules come into force, that period continues to apply.

Proceedings before the comptroller

3. Proceedings before the comptroller which commenced before these Rules came into force shall continue in accordance with Part 7 of these Rules, subject to paragraph 2 of this Schedule.

Service by post

4. Any document sent to the comptroller by posting it in the United Kingdom before the day these Rules come into force shall be deemed to have been filed at the time when it would be delivered in the ordinary course of post.

Applications to which certain amendments made to the Act by the Regulatory Reform (Patents) Order 2004 do not apply.

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

(2) Any reference in these Rules to—

(a) section 15(9) of the Act is a reference to section 15(4) of the unamended Act;

(b) section 15(10)(a) of the Act is a reference to section 15(5)(a) of the unamended Act;

(c) section 15(10)(b) or (c) of the Act shall be disregarded;

(d) section 15(10)(d) of the Act is a reference to section 15(5)(b) of the unamended Act;

(e) section 15A of the Act is a reference to section 17(1) of the unamended Act;

(f) section 17(1)(c)(i) of the Act is a reference to section 17(1)(a) of the unamended Act; and

(g) Patents Form 9A is a reference to Patents Form 9.

(3) The following provisions do not apply—

rule 6(2) and (3) (declaration of priority made after date of filing);

rule 7 (permission to make late declaration under section 5(2B));

rule 12(2), (3), (8) and (9) (notifications of deficiencies in application);

rule 17 (references under section 15(1)(c)(ii));

rule 18 (missing parts);

(**a**) SI 1995/2093; as amended by SI 1999/1092, 1999/1899, 1999/3197, 2001/1412, 2002/529, 2003/513, 2004/2177 (C. 94), 2004/2358, 2004/3205 (C. 140), 2005/2496, 2006/760 and 2007/677.

(**b**) SI 2004/2357.

rule 22(3) (prescribed period for the purpose of section 15(10)(b)(ii)).

(4) In this paragraph "unamended Act" means the Act as it had effect immediately before the Regulatory Reform (Patents) Order 2004 came into effect.

Security for costs

6. Rule 85 does not apply in respect of proceedings started before 1st October 2005.

Patent applications filed before 7th January 1991

7.—(1) This paragraph applies to an application for a patent filed before 7th January 1991(**a**) and to a patent granted in pursuance of such application.

(2) Schedule 1 has effect with the following modifications.

(3) In paragraph 2, for the words "involves the use of or concerns biological material" substitute the words "requires for its performance the use of a micro-organism".

(4) In paragraph 5(3)(b), insert at the beginning the words "in the case of an undertaking given in accordance with paragraph 1(a)," and insert at the end the word "or" followed by:

"(c) in the case of an undertaking given in accordance with paragraph (1)(b), when the patent is granted.".

(5) Any reference to "biological material"—

(a) in paragraphs 3(1)(a), 4, 5 and 8 is a reference to "culture of the micro-organism"; and

(b) other than in those provisions, is a reference to "micro-organism".

(6) For the purposes of paragraph 3(2) the relevant period is the period of two months beginning immediately after the date of filing of the application for a patent.

(7) The following provisions do not have effect—

paragraph 3(3) (defining relevant period);

paragraph 6 (restriction of availability of biological material to experts);

paragraph 7 (request for sample to be made available to expert).

Patent applications filed between 7th January 1991 and 27th July 2000

8.—(1) This paragraph applies to an application for a patent filed during the period beginning with 7th January 1991 and ending with 27th July 2000(**b**) and to a patent granted in pursuance of such application.

(2) Schedule 1 to these Rules has effect with the following modifications.

(3) In paragraph 2, for the words "involves the use of or concerns biological material" substitute the words "requires for its performance the use of a micro-organism".

(4) In paragraph 5(3)(b), insert at the beginning the words "in the case of an undertaking given in accordance with paragraph 1(a)," and insert at the end the word "or" followed by:

"(c) in the case of an undertaking given in accordance with paragraph (1)(b), when the patent is granted.".

(5) Any reference to "biological material"—

(**a**) The date that section 125A of the Patents Act 1977 came into effect (see paragraph 30 of Schedule 5 to the Copyright, Designs and Patents Act 1988 (c. 48)) and SI 1990/2168.

(**b**) The date that SI 2000/2037 came into force. Regulation 9 of that SI limits the amendments to applications made after the provision came into force.

(a) in paragraphs 3(1)(a), 4, 5, 6(3), 7(2) and 8 is a reference to "culture of the micro-organism"; and

(b) other than in those provisions, is a reference to "micro-organism".

(6) Paragraph 2(2)(b) (requirement that application contains relevant information) does not have effect.

(7) In paragraph 6(5)(b), for the words from "the period of 20 years" to the end of that provision substitute "the period ending with the date on which the application was terminated or withdrawn".

(8) The specification of an application for a patent, or of a patent, must mention any international agreement under which the micro-organism is deposited.

Continued application of Patents Rules 1968 to existing patents

9.—(1) This paragraph and paragraph 10 apply to existing patents and applications.

(2) Rules 4, 58 and 59 of the Patents Rules 1968(**a**) continue to apply.

Application of these Rules to existing patents and applications

10.—(1) Rules 4, 10(2), 44 to 50, 73 to 88, 101, 103 to 105 and 107 apply to existing patents and applications.

(2) In those provisions as they apply by virtue of this paragraph, a reference to a specified provision of these Rules other than one of those provisions is a reference to the corresponding provision of the Patents Rules 1968 (any provision of those Rules being treated as corresponding to a provision of these Rules if it was made for purposes which are the same as or similar to that provision of these Rules).

Application of the 1995 Rules to sections 8 and 12

11. If before 1st January 2005 a question has been referred to the comptroller under section 8 or 12, in relation to that reference, sections 8, 11 and 12 have effect as if the amendments to those sections by the Patents Act 2004(**b**) had not been made and rules 9 and 13 of the 1995 Rules have effect as in force immediately before 1st January 2005.

(**a**) SI 1968/1389.
(**b**) 2004 (c.16).

SCHEDULE 6

Rule 120(2)

REVOCATIONS

Title and number	*Extent of revocation*
The Patents Rules 1978 (SI 1978/216)	Rule 124.
The Patents Rules 1995 (SI 1995/2093)	The whole rules.
The Patents (Supplementary Protection Certificates) Rules 1997 (SI 1997/64)	The whole rules.
The Patents (Fees) Rules 1998 (SI 1998/1778)	The whole rules.
The Patents and Trade Marks (World Trade Organisation) Regulations 1999 (SI 1999/1899)	Regulations 9 to 12.
The Patents (Amendment) Rules 1999 (SI 1999/1092)	The whole rules.
The Patents (Fees) (Amendment) Rules 1999 (1999/1093)	The whole rules.
The Patents (Amendment) (No. 2) Rules 1999 (SI 1999/3197)	The whole rules.
The Patents (Amendment) Rules 2001 (SI 2001/1412)	The whole rules.
The Patents (Amendment) Rules 2002 (SI 2002/529)	The whole rules.
The Patents (Electronic Communications) (Amendment) Rules 2003 (SI 2003/513)	The whole rules.
The Patents Act 2004 (Commencement No. 1 and Consequential and Transitional Provisions) Order 2004 (SI 2004/2177) (C.94)	Articles 3 to 5.
The Patents (Amendment) Rules 2004 (SI 2004/2358)	The whole rules.
The Patents Act 2004 (Commencement No. 2 and Consequential, etc. and Transitional Provisions) Order 2004 (SI 2004/3205) (C.140)	Articles 3 to 8. Article 9(2).
The Patents (Translations) Rules 2005 (SI 2005/687)	The whole rules.
The Patents (Amendment) Rules 2005 (SI 2005/2496)	The whole rules.
The Patents, Trade Marks and Designs (Address For Service and Time Limits, etc) Rules 2006 (SI 2006/760)	Rules 4 to 9.
The Patents (Amendment) Rules 2007 (SI 2007/677)	The whole rules.

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules are made under the Patents Act 1977 (c. 37) ("the Act"). They regulate applications for patents and other procedures before the Patent Office in relation to patents. These Rules make substantial changes to both the drafting and effect of the Patents Rules 1995 (SI 1995/2093) which are revoked together with the other instruments listed in *Schedule 6* to these Rules.

Part 1 of these Rules includes the commencement and general interpretation provisions.

Part 2 of these Rules includes the provisions relating to applications for patents. In particular, Part 2 includes provisions on international exhibitions (the Convention on International Exhibitions signed in Paris on 22nd November 1928 is published in Cmnd 3776 Treaty Series 9/1931 and is available on the website of the Foreign and Commonwealth Office), declarations of priority, mention of the inventor, the form and content of applications, publication of the application, preliminary examination, search and substantive examination. It also includes special provisions on new applications filed under section 8(3), 12(6) or 37(4) or as mentioned in section 15(9) of the Act.

Part 3 of these Rules includes the provisions relating to granted patents. In particular, this Part includes the provisions on the certificate of grant, renewal of the patent and surrender.

Part 4 of these Rules includes the provisions relating to the register and other information. In particular, it sets out the information which must appear on the register and the conditions for inspecting documents under section 118 of the Act. Also *rule 54* makes provision for persons to be notified of certain relevant events.

Part 5 of these Rules includes the provisions relating to European patents (UK). In particular, it includes the translation requirements, the procedure for making a conversion request and certain rules relating to the United Kingdom's obligations under the European Patent Convention made in Munich on 5th October 1973 (published in Cmnd 8510 Treaty Series 16/1982 and also available on the website of the European Patent Organisation).

In particular, *rule 56(9) and (10)* implement Article 1(1) of the Agreement on the application of Article 65 of the Convention on the Grant of European Patents made in London on 17th October 2000. This is known as the London Agreement and is published in Cm 5247 Miscellaneous Series No. 9 (2001) and the day the Agreement comes into force will be published by the Patent Office. *Rule 56(9) and (10)* replaces the Patents (Translations) Rules 2005 (SI 2005/687).

Part 6 of these Rules includes the provisions relating to international applications for a patent (UK). These are made under the Patent Co-operation Treaty signed at Washington on 19th June 1970 (published in Cmnd 7340 Treaty Series 78/1978 and also available on the website of the World Intellectual Property Organisation (WIPO)). *Part 6* of these Rules makes provisions for translations and beginning the national phase, and (for the purposes of these applications) alters periods prescribed elsewhere in the Rules.

Part 7 of these Rules includes provisions governing proceedings heard before the comptroller. In particular *rule 74* creates an overriding objective for such proceedings. *Rule 76* sets out how a person starts proceedings, and *rules 77 and 78* govern how other persons may join those proceedings. Subsequent rules set out requirements for, and powers of the comptroller in relation to, the giving of evidence and the management of proceedings.

Part 8 of these Rules includes provisions on opinions on validity or infringement under section 74A of the 1977 Act. It also sets out the procedure for reviewing such opinions.

Part 9 of these Rules includes miscellaneous provisions, including those on agents, corrections, address for service, translations, extension of periods of time, supplementary protection certificates and publication of documents.

Schedule 1 makes provision for the deposit of biological material. This gives effect to the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of

Patent Procedure signed at Budapest on 28th April 1977, as amended on 26th September 1980 (published in Cmnd 8136 Treaty Series 5/1981 and available on the WIPO website).

Schedule 2 contains formal and other requirements.

Schedule 3 contains a list of applications, references, requests and oppositions to which Part 7 applies. It also lists those rules in Part 7 which apply to any proceedings before the comptroller and those rules in Part 7 which apply to proceedings for a review of an opinion.

Part 1 of Schedule 3 includes applications that may be under Community legislation in relation to EU compulsory licences and supplementary protection certificates. The European Parliament and Council adopted Regulation (EC) No 816/2006 of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (OJ No L 157, 9.6.2006, p1). The European Parliament and Council also adopted Regulation (EC) No 1901/2006 of 12 December 2006 on medicinal products for paediatric use (OJ No L 378, 27.12.2006, p1). This amends, among other Community instruments, Council Regulation (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products (OJ No L 182, 2.7.92, p1). Provision is also made in relation to Regulation (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products (OJ No L 198, 8.8.96, p30).

Schedule 4 relates to the extension of time limits.

Schedule 5 contains transitional provisions.

An impact assessment has been prepared and copies placed in the libraries of both Houses of Parliament. Copies are also available from Patents Legal Section, Concept House, Cardiff Road, Newport NP10 8QQ.

The Patents (Fees) Rules 2007
(as amended)

An unofficial consolidation of the Patents (Fees) Rules 2007 (SI 2007/3292) incorporating the amendments made by:

- the Trade Marks and Trade Marks and Patents (Fees) (Amendment) Rules 2009 (SI 2009/2089)

- the Patents and Patents and Trade Marks (Fees) (Amendment) Rules 2010 (SI 2010/33)

- the Patents and Patents (Fees) (Amendment) Rules 2017 (SI 2017/1100)

- the Patents, Trade Marks and Registered Designs (Fees) (Coronavirus) (Amendment) Rules 2020 (SI 2020/644)

Citation, commencement and interpretation

1.—(1) These Rules may be cited as the Patents (Fees) Rules 2007 and they shall come into force on 17th December 2007.

(2) In these Rules—

(a) "the Act" means the Patents Act 1977 and references to a section are references to a section of the Act;

(b) "the 2007 Rules" means the Patents Rules 2007(**a**); and

(c) "the fee reduction period" means the period beginning on 30th July 2020 and ending on 31st March 2021.

Use of a form

2.—(1) Except where any of rules 3 to 8 apply, the fees to be paid in respect of any matters arising under the Act are those specified in Schedule 1.

(2) Where a form—

(a) is required to be used by the 2007 Rules; and

(b) is specified in Schedule 1 as the corresponding form in relation to any matter,

that form must be accompanied by the fee specified in respect of that matter.

(3) But where any provision of the 2007 Rules permits payment to be made before or after the form has been filed, the fee may be paid accordingly.

Application fee and the fee to begin the national phase

3.—(1) The application fee is—

(a) in respect of an international application for a patent (UK), nil;

(b) except as provided in paragraph (3), in respect of any other application for a patent, including an application treated as an application under the Act following a direction under section 81 (conversion of European patent applications)—

(**a**) SI 2007/3291.

(i) which is filed in electronic form or using electronic communications in accordance with directions given under section 124A, specified in Table 1; and

(ii) which is filed otherwise than in the form referred to in subparagraph (i), specified in Table 2

Table 1 *(Electronic filing)*

Where the filing of the application is accompanied by the application fee	£60
Where the filing of the application is not accompanied by the application fee	£75

Table 2 *(Non-electronic filing)*

Where the filing of the application is accompanied by the application fee	£90
Where the filing of the application is not accompanied by the application fee	£112.50

(2) The prescribed fee to begin the national phase of an international application for a patent (UK) is £30.

(3) During the fee reduction period, where the filing of the application is not accompanied by the application fee, the application fee—

(a) in Table 1, is £60;

(b) in Table 2, is £90.

Electronic filing fee reduction

3A.—Where Form 9A or 10 is filed in electronic form or using electronic communications in accordance with directions given under section 124A, the fee specified in Schedule 1 in respect of a request for search in accordance with rule 27 of the 2007 Rules or a request for a substantive examination in accordance with rule 28 of the 2007 Rules shall in each case be reduced by £30.

Excess claims fee

3B.—The fee specified in Schedule 1 in respect of a request for a search under section 17(1) in accordance with rule 27 of the 2007 Rules shall increase by £20 for the 26th and each subsequent claim contained in the application.

Excess pages fee

3C.—The fee specified in Schedule 1 in respect of a request for a substantive examination of an application under section 18(1) in accordance with rule 28 of the 2007 Rules shall increase by £10 for the 36th and each subsequent page of the description contained in the application.

Fee for the grant of a patent

3D.—(1) Where rule 30A(1) of the 2007 Rules applies, the fee for the grant of a patent is the sum of the following amounts—

(a) £20 for each qualifying claim, and

(b) £10 for each qualifying page.

(2) For the purposes of this rule—

(a) a "qualifying claim" means any of the 26th or subsequent claims contained in the application which exceed the number of claims contained in the application as at the date when the applicant made a request for a search under section 17(1)(c) as referred to in rule 30A(1)(a)(ii) of the 2007 Rules; and

(b) a "qualifying page" means any of the 36th or subsequent pages of the description contained in the application which exceed the number of pages of the description contained in the application as at the date when the applicant made a request for a substantive examination under section 18(1) as referred to in rule 30A(1)(b)(ii) of the 2007 Rules.

Renewal fees

4.—(1) Subject to paragraphs (2) and (3), the fee to be paid to keep a patent in force after a renewal date which falls on the anniversary indicated in the first column of the table in Part 1 of Schedule 2 is the amount specified in relation to that anniversary in the second column.

(2) Where rule 37(3) of the 2007 Rules applies, the fee to be paid to keep a patent in force after the first renewal date is the sum of the following amounts—

(a) the amount specified in relation to the relevant anniversary; and

(b) the amounts specified in relation to all previous anniversaries.

(3) Where rule 37(4) of the 2007 Rules applies, the fee to be paid to keep a patent in force after the first renewal date is the amount specified in relation to the relevant anniversary.

(4) For the purposes of paragraphs (2) and (3), the relevant anniversary is the last anniversary to fall on or before the first renewal date.

Additional fees for late renewal

5.—(1) Except as provided in paragraph (3), the additional fees prescribed for late payment under section 25(4) are specified in Part 2 of Schedule 2.

(2) Where payment is made before the end of the month indicated in the first column of that table, the fee to be paid is the amount specified in the second column.

(3) During the fee reduction period, the additional fees referred to in paragraph (1) are nil.

Supplementary protection certificates

6.—(1) The prescribed fee payable for a supplementary protection certificate to take effect is set in accordance with paragraph (2).

(2) Where the certificate expires during the period of one year beginning with—

(a) the start date, the fee is £600;

(b) the first anniversary of the start date, the fee is £1,300;

(c) the second anniversary of the start date, the fee is £2,100;

(d) the third anniversary of the start date, the fee is £3,000; or

(e) the fourth anniversary of the start date, the fee is £4,000.

(3) The period in paragraph (2) shall be calculated without reference to any extension of the duration of a supplementary protection certificate under Article 13(3) of the Medicinal Products Regulation(**a**).

(**a**) Council Regulation (EEC) No 1768/92 (OJ No L 182, 2.7.92, p1) as amended by Regulation (EC) 1901/2006 (OJ No L 378, 27.12.2006, p1).

(4) Except as provided in paragraph (6), the additional fee prescribed for the purposes of paragraph 5(b) of Schedule 4A to the Act (supplementary protection certificates) shall be half the prescribed fee.

(5) In this rule "start date" is the first day following the day on which the basic patent expires.

(6) During the fee reduction period, the additional fee referred to in paragraph (4) is nil.

Other fees

7.—(1) The prescribed fee to publish a translation filed at the Patent Office under section 89A(3) or (5) (international and national phases of application) is £12.

(2) The prescribed fee for an application to the comptroller for an order under the Evidence (Proceedings in Other Jurisdictions) Act 1975(**a**) as applied by section 92(1) (obtaining evidence for proceedings under the European Patent Convention) is nil.

(3) The fee to transmit an international application for a patent filed at the Patent Office to the International Bureau and the International Searching Authority is £75.

(3A)The fee to request restoration of the right of priority of an international application for a patent filed at the Patent Office in accordance with the Patent Co-operation Treaty(**b**) is £150.

(4) In paragraph (3) "International Searching Authority" has the same meaning as in the Patent Co-operation Treaty.

Temporary fee reduction

8.—(1) This rule applies to the fees ("the relevant fees") specified in Schedule 1 identified in paragraph (3).

(2) During the fee reduction period, the relevant fees are nil.

(3) The relevant fees referred to in paragraph (1) are—

(a) the fee of £135 which must accompany Form 52,

(b) the fee of £150 which must accompany Form 3 on a request for permission to make a late declaration of priority under section 5(2B),

(c) the fee of £150 which must accompany Form 14, and

(d) the fee of £135 which must accompany Form 16.

(**a**) 1975 c. 34.
(**b**) Cmnd 7340 Treaty series 78/1978.

SCHEDULE 1

Rule 2

USE OF FORMS

Patents Form Number	*Item*	*Amount (£)*
1	On request for the grant of a patent in accordance with rule 12(1) of the 2007 Rules	—
2	On starting proceedings in relation to applications, references or requests in accordance with rule 76(1) of, and the provisions mentioned in Part 1 of Schedule 3 to, the 2007 Rules (except those started on Form SP3)	50
	On applying for the review of an opinion in accordance with rule 98(3) of the 2007 Rules	50
3	On making a declaration for the purposes of section 5(2), in relation to an earlier relevant application filed during the period allowed by section 5(2A)(a), in accordance with rule 6 of the 2007 Rules	40
	On request for permission to make a late declaration of priority under section 5(2B) in accordance with rule 7 of the 2007 Rules	150
4	On continuing proceedings following receipt of a counter-statement in accordance with rule 80(1A) of the 2007 Rules	350
7	On making a statement identifying the inventor and indicating the derivation of the right to the grant of a patent under section 13(2) in accordance with rule 10(4) of the 2007 Rules	—
8	On request for a certificate authorising the release of a sample of biological material in accordance with rule 13(1) of, and paragraph 4 or 7 of Schedule 1 to, the 2007 Rules	—
8A	On request that a sample of the biological material should only be made available to an expert in accordance with rule 13(1) of, and paragraph 6 of Schedule 1 to, the 2007 Rules	—
9	On request for a further search under section 17(6) or payment for a supplementary search under section 17(8) (in relation to applications initiated before 1st January 2005) in accordance with paragraph 5 of Schedule 5 to the 2007 Rules	100
9A	On request for a search under section 17(1) in accordance with rule 27 of the 2007 Rules—	
	(a) in respect of an international application for a patent (UK), which has already been the subject of a search by the International Searching Authority;	150
	(b) in respect of any other application.	180

	On request for a further search under section 17(6) or payment for a supplementary search under section 17(8) in accordance with rule 27 of the 2007 Rules	180
10	On request for a substantive examination of an application in accordance with rule 28 of the 2007 Rules	130
12	(See Schedule 2)	
14	On request under section 20A for reinstatement of an application in accordance with rule 32 of the 2007 Rules	150
15	On giving notice of opposition in accordance with rule 76 of, and the provisions mentioned in Part 2 of Schedule 3 to, the 2007 Rules	50
16	On application under section 28 for restoration of a patent in accordance with rule 40 of the 2007 Rules	135
17	On request for an opinion under section 74A in accordance with rule 93 of the 2007 Rules	200
20	On request to correct a name in accordance with rule 49 of the 2007 Rules	—
21	On application to register (or to give notice of) any transaction, instrument or event mentioned in section 32(2)(b) or 33(3) in accordance with rule 47 of the 2007 Rules	50
23	On application for a certified copy of an entry in the register, or a certified extract from the register, or of a relevant document in accordance with rule 46(1) or 48(5) of the 2007 Rules	20
	On application for an uncertified copy of an entry in the register, or an uncertified extract from the register, or of a relevant document in accordance with rule 46(2) or 48(5) of the 2007 Rules	5
	On request for a certified copy of an international application filed at the Patent Office as the competent receiving Office in accordance with rule 65(4) of the 2007 Rules	20
	On application for a certificate in accordance with rule 46(3) of the 2007 Rules	20
28	On application under section 46(1) for an entry to be made on the register that a licence is available as of right in accordance with rule 43(1) of the 2007 Rules	—
30	On application under section 47(1) for the cancellation of an entry made under section 46 in accordance with rule 43(3) of the 2007 Rules	—
49	On request to be notified of a relevant event in accordance with rule 54 of the 2007 Rules	25
51	On appointment of an agent in accordance with rule 101 of the 2007 Rules	—

52	On request for extension of a period of time in accordance with rule 108(2) and (3) of the 2007 Rules	135
54	On filing a translation of the specification of a European patent (UK) in accordance with rule 56 of the 2007 Rules	—
	On filing a translation of the claims of the specification of an application for a European patent (UK) in accordance with rule 56 of the 2007 Rules	—
	On filing a corrected translation under section 80(3) in accordance with rule 57 of the 2007 Rules	—
SP1	On application for a supplementary protection certificate under Article 8 of the Medicinal Products or Plant Protection Products Regulations(**a**)in accordance with rule 116 of the 2007 Rules	250
SP2	(see rule 0)	
SP3	On application to review lapse or for a declaration of invalidity under Articles 14 or 15 of the Medicinal Products or Plant Protection Products Regulations or for revocation of an extension of the duration of a supplementary protection certificate under Article 15a of the Medicinal Products Regulation in accordance with rule 76 of the 2007 Rules	50
SP4	On application for an extension of the duration of a supplementary protection certificate under Article 8 of the Medicinal Products Regulation in accordance with rule 116 of the 2007 Rules	200

(**a**) Regulation (EC) No 1610/96 (OJ No L 198, 8.8.96, p30).

SCHEDULE 2

Rules 4 and 5

RENEWAL FEES

PART 1

RENEWAL FEE

Anniversary of date of filing	*Amount (£)*
4th	70
5th	90
6th	110
7th	130
8th	150
9th	170
10th	190
11th	220
12th	260
13th	300
14th	360
15th	420
16th	470
17th	520
18th	570
19th	610

PART 2

ADDITIONAL FEE

Month beginning after the expiry of the period for payment of the renewal fee	*Amount of additional renewal fee (£)*
1st	0
2nd	24
3rd	48
4th	72
5th	96
6th	120

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules prescribe fees in relation to matters arising under the Patents Act 1977 and the Patents Rules 2007 (SI 2007/3291). These Rules take into account the Patents Rules 2007 and the revocation by those Rules of the Patents (Fees) Rules 1998 (SI 1998/1778) as last amended by the Patents (Amendment) Rules 2005 (SI 2005/2496). There have been no fee increases.

Where a form is specified in Schedule 1 in relation to any matter, that form must be sent to the comptroller together with the relevant fee for that matter, unless the Patents Rules 2007 specify otherwise (rule 2).

The application fees for a national (UK) patent application and for an international application for a patent (UK) are set out in rule 3(1) and the fee for an international application for a patent (UK) to enter the UK national phase is set out in rule 3(2).

Fees for renewal of a patent, including late renewal, are set out in Schedule 2 (rules 4 and 5).

Provision is also made for fees in respect of supplementary protection certificates for medicinal and plant protection products. These relate to matters arising under the provisions of Council Regulation (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products (OJ No L 182, 2.7.92, p1) as amended by Regulation (EC) 1902/2006 of the European Parliament and of the Council of 12 December 2006 on medicinal products for paediatric use (OJ No L 378, 27.12.2006, p1). As regards plant protection products, the fees relate to Regulation (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products (OJ No L 198, 8.8.96, p. 30).

The Patents (Supplementary Protection Certificates) Rules 1997 (SI 1997/64), which formerly made provision for fees in respect of supplementary protection certificates for medicinal and plant protection products, have been revoked by the Patents Rules 2007. Schedule 1 sets out certain fees relating to supplementary protection certificates, and rule 6 sets out the fees payable for a supplementary protection certificate to take effect.

Rule 7 sets out other fees relating to publication of translations of international applications and applications to the comptroller for orders to assist in obtaining evidence for proceedings under the European Patent Convention made in Munich on 5th October 1973 (published in Cmnd 8510 Treaty Series 16/1982 and also available on the website of the European Patent Organisation), and the transmission of an international application for a patent from the Patent Office to the International Bureau and the International Searching Authority under the Patent Co-operation Treaty signed at Washington on 19th June 1970 (published in Cmnd 7340 Treaty series 78/1978 and also available on the website of the World Intellectual Property Organisation).

An impact assessment has been prepared and copies placed in the libraries of both Houses of Parliament. Copies are also available from Patents Legal Section, Concept House, Cardiff Road, Newport NP10 8QQ.