

The Patents, Trade Marks and Designs (Address For Service and Time Limits, etc) Rules 2006

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Statutory Instrument 2006 No. 760

The Patents, Trade Marks and Designs (Address For Service and Time Limits, etc) Rules 2006

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STATUTORY INSTRUMENTS

2006 No. 760

INTELLECTUAL PROPERTY

The Patents, Trade Marks and Designs (Address For Service and Time Limits, etc) Rules
2006

Made 14th March 2006

Laid before Parliament 15th March 2006

Coming into force 6th April 2006

The Secretary of State, in exercise of the powers conferred by sections 123 of the Patents Act 1977 ¹, section 78 of the Trade Marks Act 1994 ², section 36 of the Registered Designs Act 1949 ³ and section 250 of the Copyright, Designs and Patents Act 1988 ⁴ makes the following Rules:

Citation and commencement ➡

1. These Rules may be cited as the Patents, Trade Marks and Designs (Address For Service and Time Limits, etc) Rules 2006 and shall come into force on 6th April 2006.

Amendment of the Design Right (Proceedings Before Comptroller) Rules 1989 ➡

2. The Design Right (Proceedings Before Comptroller) Rules 1989 ⁵ shall be amended as follows.

3. —

1. Rule 23 (service and translation of documents) shall be amended as follows.
2. In paragraph (1) the words "in the United Kingdom" shall be omitted.
3. After paragraph (1) there shall be inserted—

" (1A) The address for service shall be an address in the United Kingdom, unless in a particular case the comptroller otherwise directs."

Amendment of the Patents Rules 1995 ➡

4. The Patents Rules 1995 ⁶ shall be amended as follows.

5. In rule 2 (interpretation) after the entry for "declared priority date" there shall be inserted—

"EEA State" means a member State, Iceland, Liechtenstein or Norway;"

6. For rule 30 there shall be substituted—

" Address for service

30. —

1. For the purposes of any proceeding under the Act or these Rules, an address for service shall be filed by—
 - a. an applicant for the grant of a patent;
 - b. a person who makes any other application or reference, or gives any notice of opposition, under the Act;
 - c. any person opposing such an application, notice or reference.
2. The proprietor of a patent, or any person who has registered any right in or under a patent or application, may file an address for service by notifying the comptroller.
3. Where a person has provided 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 filed under paragraph (1)(a) or (2) shall be an address in the United Kingdom, another EEA State or the Channel Islands.
5. An address for service filed under paragraph (1)(b) or (c) shall be an address in the United Kingdom, unless in a particular case the comptroller otherwise directs.

Failure to provide an address for service

30A. —

1. Where—
 - a. a person has failed to file an address for service under rule 30(1); and
 - b. the comptroller has sufficient information enabling him to contact that person, the comptroller shall direct that person to file an address for service.
2. Where a direction has been issued under paragraph (1), the person directed shall, before the end of the period of 2 months beginning with the date of the direction, file 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 provide 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; and
- b. in the case of a person mentioned in rule 30(1)(b), his application, reference or notice of opposition shall be withdrawn; and
- c. in the case of a person mentioned in rule 30(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 30(4) or (5)."

7. In rule 31 (formal requirements), in paragraph (1) the words "and 30(1)(a)" shall be omitted.

8. For rule 111 there shall be substituted—

" Interrupted Days

111. —

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. The comptroller shall, where the time for doing anything under the Act or these Rules expires on an interrupted day, extend that time to the next following day not being an interrupted day (or an excluded day).
3. Any certificate of the comptroller given under paragraph (1) shall be posted in the Patent Office and advertised in the Journal.
4. In this rule—

"excluded day" means a day specified as an excluded day in directions given under section 120⁷; and

"interrupted day" means a day which has been certified as such under paragraph (1).

Delays in communication services

111A. —

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—
 - a. made 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, facsimile, email and courier."

9. In Schedule 4A (alteration of time limits), in Part 4 after the entry for rule 26 there shall be inserted—

" rule 30A(2) (period for filing an address for service), in relation to an application for a patent".

Amendment of the Registered Designs Rules 1995 ➔

10. The Registered Designs Rules 1995⁸ shall be amended as follows.

11. In rule 2 (interpretation) after the entry for "convention application" there shall be inserted—

" "EEA State" means a member State, Iceland, Liechtenstein or Norway;".

12. For rules 8 and 9 there shall be substituted—

" Address for service

8. —

1. For the purposes of any proceedings under the Act or these Rules, an address for service shall be filed by—
 - a. an applicant for the registration of a design;
 - b. a person who makes an application under section 11ZB for a declaration of invalidity of a registered design;

- c. the registered proprietor of the design who opposes such an application.
2. The proprietor of a registered design, or any person who has registered any interest in a registered design, may file an address for service on Designs Form 1A.
3. Where a person has provided an address for service under paragraph (1) or (2), he may substitute a new address for service by notifying the registrar on Designs Form 1A.
4. An address for service filed under paragraph (1)(a) or (2) shall be an address in the United Kingdom, another EEA State or the Channel Islands.
5. An address for service filed under paragraph (1)(b) or (c) shall be an address in the United Kingdom, unless in a particular case the comptroller otherwise directs.

Failure to provide an address for service

9. —

1. Where—
 - a. a person has failed to file an address for service under rule 8(1); and
 - b. the registrar has sufficient information enabling him to contact that person, the registrar shall direct that person to file 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 2 months beginning with the date of the direction, file 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 registrar had insufficient information to give a direction under paragraph (1), and the person has failed to provide an address for service.
4. Where this paragraph applies—
 - a. in the case of an applicant for the registration of a design, the application shall be treated as withdrawn;
 - b. in the case of a person applying under section 11ZB for a declaration of invalidity, his application shall be treated as withdrawn; and
 - c. in the case of the proprietor who is opposing such an application, 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 8(4) or (5).".

13. —

1. For rule 42 there shall be substituted—

" Registration of interests

42. —

1. The following matters are prescribed for the purposes of section 17(1)(c)—
- a. the registered proprietor's address for service;
 - b. the grant or cancellation of a licence under a registered design;
 - c. the granting or cancelling of a security interest (whether fixed or floating) over a registered design or any right in or under it;
 - d. an order of a court or other competent authority transferring a registered design or any right in or under it.
2. An application to the registrar to enter in the register a matter not mentioned in paragraph (1) or section 17(1)(a) or (b) shall be made in writing.
3. An application under section 19(1) or (2) shall be made on Designs Form 12A.
4. Where the registrar has doubts about whether he should enter a matter in the register—
- a. he shall inform the person making the application of the reasons for his doubts; and
 - b. he may require that person to furnish evidence in support of the application.".

2. Rules 43 to 45 shall be omitted.

14. For rule 76 there shall be substituted—

" Interrupted Days

76. —

1. The registrar 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 registrar made under paragraph (1) shall be posted in the Patent Office and advertised in the Journal.
 3. The registrar shall, where the time for doing anything under these Rules 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—

"interrupted day" means a day which has been certified as such under paragraph (1);
and

"excluded day" means a day specified as such by rule 75.

Delays in communication services

76A. —

1. The registrar shall extend any time or period in these Rules where he is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service.
2. Any extension under paragraph (1) shall be—
 - a. made after giving the parties such notice, and
 - b. subject to such conditions, as the registrar may direct.
3. In this rule "communication service" means a service by which documents may be sent and delivered and includes post, facsimile, email and courier."

Amendment of the Trade Marks Rules 2000 ➔

15. —

1. The Trade Marks Rules 2000[9] shall be amended as follows.
2. In rule 2 (interpretation) after the entry for "the Act" there shall be inserted—

" "EEA State" means a member State, Iceland, Liechtenstein or Norway;".

16. For rule 10 there shall be substituted—

" Address for service

10. —

1. For the purposes of any proceedings under the Act or these Rules, an address for service shall be filed by—
 - a. an applicant for the registration of a trade mark;
 - b. any person who opposes the registration of a trade mark in opposition proceedings;
 - c. any person who applies for revocation, a declaration of invalidity or rectification under the Act;
 - d. the proprietor of the registered trade mark who opposes such an application.
2. The proprietor of a registered trade mark, or any person who has registered an interest in a registered trade mark, may file an address for service on Form TM33.
3. Where a person has provided an address for service under paragraph (1) or (2), he may substitute a new address for service by notifying the registrar on Form TM33.
4. An address for service filed under paragraph (1)(a) or (2) shall be an address in the United Kingdom, another EEA State or the Channel Islands.
5. An address for service filed under paragraph (1)(b) to (d) shall be an address in the United Kingdom, unless in a particular case the comptroller otherwise directs.

Failure to provide an address for service

10A. —

1. Where—
 - a. a person has failed to file an address for service under rule 10(1); and
 - b. the registrar has sufficient information enabling her to contact that person, the registrar shall direct that person to file 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 2 months beginning with the date of the direction, file 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 registrar had insufficient information to give a direction under paragraph (1), and the person has failed to provide an address for service.
4. Where this paragraph applies—
- a. in the case of an applicant for registration of a trade mark, the application shall be treated as withdrawn;
 - b. in the case of a person opposing the registration of a trade mark, his opposition shall be treated as withdrawn;
 - c. in the case of a person applying for revocation, a declaration of invalidity or rectification, his application shall be treated as withdrawn; and
 - d. in the case of the proprietor opposing such an application, 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 10(4) or (5)."

17. In rule 44 (request for change of name or address), paragraph (2) shall be omitted.

18. For rule 67 there shall be substituted—

" Interrupted Days

67. —

1. The registrar 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 registrar made under paragraph (1) shall be posted in the Patent Office and advertised in the Journal.
3. The registrar shall, where the time for doing anything under these Rules 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—

"interrupted day" means a day which has been certified as such under paragraph (1);
and

"excluded day" means a day which is not a business day as specified in a direction
given by the registrar under section 80.

Delays in communication services

67A. —

1. The registrar shall extend any time limit in these Rules where he is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service.
2. Any extension under paragraph (1) shall be—
 - a. made after giving the parties such notice, and
 - b. subject to such conditions, as the registrar may direct.
3. In this rule "communication service" means a service by which documents may be sent and delivered and includes post, facsimile, email and courier."

19. In rule 68 (alteration of time limits), in paragraph (3) for the words "rule 10(6)" there shall be substituted "rule 10A(2)".

20. After rule 69, there shall be inserted—

" Electronic communications

69A. —

1. The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.
2. In this rule "electronic communication" has the same meaning as in the Electronic Communications Act 2000."

Sainsbury of Turville

14th March 2006

EXPLANATORY NOTE ➔

(This note is not part of the Rules)

These Rules amend the Design Right (Proceedings Before Comptroller Rules) 1989 (SI 1989/1130, as amended), the Patents Rules 1995 (SI 1995/2093, as amended), the Registered Designs Rules 1995 (SI 1995/2192, as amended) and the Trade Marks Rules 2000 (SI 2000/136, as amended).

The requirements in each of those Rules to provide an address for service are liberalised. The amendments made by these Rules will allow applicants for registered rights (patents, trade marks and registered designs) to provide an address for service in the United Kingdom, the Channel Islands, another EEA State or the Channel Islands. Although, during any proceedings before the comptroller or registrar an address for service in the United Kingdom will be required unless the comptroller or registrar otherwise directs.

These Rules also liberalise the provisions in the Patents Rules 1995, the Registered Designs Rules 1995 and the Trade Marks Rules 2000 relating to any delays caused by "interrupted days" (which are days where there are disruptions at the Patent Office or in the postal system).

These Rules also amend provisions in the Registered Designs Rules 1995 relating to the registration of interests and insert a provision into the Trade Marks Rules 2000 which facilitates electronic communications by the registrar.

A Regulatory Impact Assessment has been prepared and is available from the Patent Office, Intellectual Property and Innovation Directorate, Concept House, Newport NP10 8QQ.

1:

1977 c. 37; to which there are amendment not relevant to these Rules.

➡

2:

1994 c.26.back

➡

3:

1949 c. 88; section 36(1A) was inserted by section 272 of, and paragraph 26(1) of Schedule 3 to, the Copyright, Designs and Patents Act 1988 (c. 48), there are other amendments but none is relevant.

➡

4:

1988 c. 48; to which there are amendment not relevant to these Rules.

➡

5:

SI 1989/1130; to which there are amendments not relevant to these Rules.

➡

6:

SI 1995/2093; to which there are amendments not relevant to these Rules.

➡

7:

Section 120 was amended by section 16(1) of, and paragraph 24 of Schedule 2 to, the Patents Act 2004 (c. 16)

➡

8:

SI 1995/2912; to which there are amendments not relevant to these Rules.

➡

9:

SI 2000/136; to which there are amendments not relevant to these Rules.

➡
