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## STATUTORY INSTRUMENTS

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### PATENTS

#### **An unofficial consolidation of the Patents Rules 1995**

incorporating the amendments made by:  
The Patents (Amendment) Rules 1999 (SI 1999 No. 1092)  
The Patents and Trade Marks (World Trade Organisation) Regulations 1999 (SI 1999 No. 1899)  
The Patents (Amendment) (No.2) Rules 1999 (SI 1999 No. 3197)  
The Patents (Amendment) Rules 2001 (SI 2001 No. 1412)  
The Patents (Amendment) Rules 2002 (SI 2002 No. 529)  
The Patents (Electronic Communications) (Amendment) Rules 2003 (SI 2003 No. 513)

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In the following list, rules which have been amended:

by SI 1999 No. 1092 are marked \*  
by SI 1999 No. 1899 are marked #  
by SI 1999 No. 3197 are marked †  
by SI 2001 No. 1412 are marked ‡  
by SI 2002 No. 529 are marked §  
by SI 2003 No. 513 are marked &

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The Secretary of State, in exercise of the powers conferred upon him by sections 5(2), 8(3), 12(6), 13(1) and (3), 14(1) and (6), 15(2), (3) and (5), 16(1), 17(1), (2) and (8), 18(1) and (4), 19(1), 20(1), 21(1), 24(2), 25(3) and (5), 28(1), (1A) and (2A), 32(2), (5), (6) and (7), 40(1) and (2), 47(3) and (6), 52(1), 77(6), 78(4), 80(3), 81(2)(b) and (2)(c), 89, 89A, 92(3) and (4), 97(1)(d), 118(1) and (3)(b), 120(1), 123(1) to (3A), (6) and (7), 124, 125A(1), (2) and (3), 127(6) and 130(2) of, and paragraph 4A(5) of Schedule 1 and paragraph 14 of Schedule 4 to, the Patents Act 1977 after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992, hereby makes the following Rules:-

## PRELIMINARY

### Citation and commencement

1. These Rules may be cited as the Patents Rules 1995 and shall come into force on 4th September 1995.

### Interpretation

2. In these Rules -

"the Act" means the Patents Act 1977;

"the 1949 Act" means the Patents Act 1949;

"declared priority date" means-

(a) the date of filing of the earliest relevant application specified in a declaration made for the purposes of section 5 where the priority date claimed in the declaration has not been lost or abandoned and where the declaration has not been withdrawn before preparations for the publication of the application in suit have been completed by the Patent Office in accordance with section 16;

(b) the date of filing of any such application for a patent as is referred to in section 127(4) which is specified in a declaration made for the purposes of that section;

(c) where an application for a European patent (UK) is, by virtue of section 81(1), to be treated as an application for a patent under the Act, the date of filing of the earliest previous application mentioned in the declaration of priority filed by the applicant in respect of the application for a European patent (UK) under Article 88(1) of the European Patent Convention where the priority date claimed in the declaration has not been lost or abandoned and where the declaration has not been withdrawn before the comptroller directs that the application for a European patent (UK) shall be so treated; or

(d) where an international application for a patent (UK) is to be treated as an application for a patent under the Act, the date of filing of the earliest application filed in or for a State which is a party to the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 the priority of which is claimed in a declaration filed for the purposes of Article 8 of the Patent Co-operation Treaty, provided that such priority claim has not been lost or abandoned under the provisions of that Treaty;

"Journal" means the journal published in accordance with rule 115.

### Construction

3. In these Rules, save where otherwise indicated-

- (a) references to a section are references to that section of the Act;
- (b) references to a rule are references to that rule in these Rules;
- (c) references to a Schedule are references to that Schedule to these Rules;
- (d) references to a form are references to that form as set out in Schedule 1;

and references to the filing of a form or other document are references to filing it at the Patent Office.

### **Forms**

4.-(1) The forms of which the use is required by these Rules (except the forms mentioned in rule 121(1)) are those set out in Schedule 1.

(2) A requirement under these Rules to use such a form is satisfied by the use either of a replica of that form or of a form which is acceptable to the comptroller and contains the information required by the form set out in that Schedule.

(3) A requirement under these Rules to use a form shall not apply if the comptroller, in directions made under section 124A, directs that the information required may be presented in some other manner.

### **Multiple copies**

4A. Where a document is delivered to the comptroller in electronic form or using electronic communications, a requirement in these Rules for the document to be delivered to the comptroller with a copy or copies of that document or in duplicate or triplicate shall not apply if the requirement is removed or varied by the comptroller in directions made under section 124A.

### **International exhibitions**

5.-(1) An applicant for a patent who wishes the disclosure of matter constituting an invention to be disregarded in accordance with section 2(4)(c) shall, at the time of filing the application for the patent, inform the comptroller in writing that the invention has been displayed at an international exhibition.

(2) The applicant shall, within four months of filing the application, file a certificate, issued at the exhibition by the authority responsible for the exhibition, stating that the invention was in fact exhibited there. The certificate shall also state the opening date of the exhibition and, where the first disclosure of the invention did not take place on the opening date, the date of the first disclosure. The certificate shall be accompanied by an identification of the invention, duly authenticated by the authority.

(3) For the purposes of section 130(2) a statement may be published in the Journal that an exhibition described in the statement falls within the definition of international exhibition in subsection (1) of that section.

(4) In the case of an international application for a patent (UK), the application of this rule shall be subject to the provisions of rule 85(3).

### **Declaration of priority for the purposes of section 5**

6.-(1) A declaration for the purposes of section 5 shall be made at the time of filing the application for a patent ("the application in suit") and shall state the date of filing of any application specified in the declaration and the country in or for which it was made. In the case of a new application filed under section 15(4), no declaration shall be made which has not also been made in the earlier application.

(2) Subject to the provisions of rule 26 and paragraphs (3), (4) and (5) below, where the application in suit is for a patent under the Act, the applicant shall, within the period of 16 months after the declared priority date, furnish to the Patent Office in respect of every application specified in the declaration-

(a) its file number; and

(b) except where paragraph (3) below has effect, a copy of that application duly certified by the authority with which it was filed or otherwise verified to the satisfaction of the comptroller.

(3) Where an application specified in the declaration is an application for a patent under the Act, an international application for a patent which is filed at the Patent Office, or any other application of which a copy is filed pursuant to a declaration of priority under paragraph (1) in respect of another application under the Act,-

(a) if the application is filed under section 15(4), the applicant shall, at the time of filing the application, file-

(i) a request that a copy of the application specified in the declaration be prepared for use in the Patent Office; and

(ii) Patents Form 23/77 requesting the comptroller to certify the same; or

(b) if the application is filed otherwise than under section 15(4), the applicant shall file that request and that form in compliance with any request made by the comptroller.

(4) Where the application in suit is an application for a European patent (UK) which, by virtue of section 81, is to be treated as an application for a patent under the Act, the requirements of paragraphs (1) and (2) above shall be treated as having been complied with to the extent that the requirements of rule 38(1) to (3) of the Implementing Regulations to the European Patent Convention have been fulfilled.

(5) Where the application in suit is an international application for a patent (UK) which is to be treated as an application for a patent under the Act, the requirements of paragraphs (1) and (2) above shall be treated as having been complied with to the extent that the requirements of rule 4.10(a) and (b), subject to rules 26bis.1 and 26bis.2(b), and of rule 17.1 of the Regulations made under the Patent Co-operation Treaty have been fulfilled.

(6) Where a copy of an application is filed or treated as having been filed under paragraph (2)(b), (3), (4) or (5) above and that application is in a language other than English:

(a) a translation thereof into English verified to the satisfaction of the comptroller as corresponding to the original text ("verified translation"); or

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

shall be filed before the patent is granted or within such other period as the comptroller may specify in a particular case.

Provided that where the comptroller considers the filing of a declaration under subparagraph (b) to be inappropriate in a particular case, the comptroller may require the applicant to file a verified translation.

## RIGHT TO APPLY FOR AND OBTAIN A PATENT

### References under section 8(1)(a) or 12(1)(a)

7.-(1) A reference under section 8(1)(a) or 12(1)(a) shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the nature of the question, the facts upon which the person making the reference relies and the order or other relief which he is seeking.

(2) The comptroller shall send a copy of the reference and statement to-

(a) any person (other than the person referred to in paragraph (1) above) alleged in the reference to be entitled to be granted a patent for the invention;

(b) any person, not being a party to the reference, who is shown in the register as having a right in or under the patent application;

(c) where the application for the patent has not been published, any person (not being a party to the reference) who is an applicant for the patent or has given notice to the comptroller of a relevant transaction, instrument or event; and

(d) every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention

other than any person who has consented in writing to the reference.

(3) If any person who is sent a copy of the reference and statement under paragraph (2) above wishes to oppose the making of the order or the granting of the relief sought, he ("the opponent") shall, within the period of six weeks beginning on the date the copies are sent to him, file in duplicate a counter-statement setting out fully the grounds of his opposition and the comptroller shall send a copy of the counter-statement to the person making the reference and to those recipients of the copy of the reference and statement who are not party to the counter-statement.

(4) The person making the reference or any such recipient may, within the period of six weeks beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence,-

(a) in any case, to the opponent; and

(b) in the case of evidence filed by such a recipient, to the person making the reference.

(5) Within the period of six weeks beginning on the date when the copy of such evidence is sent to him or, if no such evidence is filed, within six weeks of the expiration of the time within which it might have been filed, the opponent may file evidence in support of his case and shall send a copy of the evidence so filed to the person making the reference and those recipients; and within the period of six weeks beginning on the date when the copy of the opponent's evidence is sent to him, that person or any of those recipients may file further evidence confined to matters strictly in reply and shall send a copy of it to the persons mentioned in subparagraphs (a) and (b) of paragraph (4) above.

(6) No further evidence shall be filed except by leave or direction of the comptroller.

(7) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.



**References by co-proprietors under section 8(1)(b) or 12(1)(b)**

8.-(1) A reference under section 8(1)(b) or 12(1)(b) shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the nature of the question, the facts relied upon by the co-proprietor making the reference and the order which he is seeking.

(2) The comptroller shall send a copy of the reference and statement to-

- (a) each co-proprietor who is not a party to the reference and who has not otherwise indicated his consent to the making of the order sought;
- (b) any person to whom it is alleged in the reference that any right in or under an application for a patent should be transferred or granted;
- (c) any person, not being a party to the reference, who is shown in the register as having a right in or under the patent application;
- (d) where the application for the patent has not been published, any person (not being a party to the reference) who has given notice to the comptroller of a relevant transaction, instrument or event; and
- (e) every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention

other than the co-proprietor making the reference under section 8(1)(b) or 12(1)(b)

(3) Any person who receives a copy of the reference and statement and who wishes to oppose the order sought may, within the period of six weeks beginning on the date when the copies are sent to him, file a counter-statement in duplicate setting out fully the grounds of his opposition.

(4) The comptroller shall, as appropriate, send a copy of any counter-statement to-

- (a) each co-proprietor who is a party to the reference; and
- (b) any person to whom a copy of the reference and statement were sent pursuant to paragraph (2) above.

(5) Any person who receives a copy of the counter-statement may, within the period of six weeks beginning on the date when the copy is sent to him, file evidence in support of his case and shall send a copy of the evidence so filed to the co-proprietor making the reference and to each person who has filed a counter-statement.

(6) Any person entitled to receive a copy of the evidence filed under paragraph (5) above may, within the period of six weeks beginning on the date when the copy is sent to him or, if no such evidence is filed, within six weeks of the expiration of the period within which it might have been filed, file evidence in support of his case and shall send a copy of the evidence so filed to each of the other parties listed in paragraph (4) above.

(7) Any person who receives a copy of the evidence filed under paragraph (6) above may, within the period of six weeks of the date when the copy is sent to him, file further evidence confined to matters strictly in reply and shall as appropriate send a copy of the evidence so filed to the parties listed in paragraph (4) above.

(8) No further evidence shall be filed by any party except by leave or direction of the comptroller.

(9) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

### **Orders under section 8 or 12**

9.-(1) Where an order is made under section 8 or section 12 that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant, the comptroller shall notify all original applicants and their licensees of whom he is aware of the making of the order.

(2) A person notified under paragraph (1) above may make a request under section 11(3) or under that section as applied by section 12(5),-

(a) in the case of a request by the original applicant or any of the original applicants, within the period of two months beginning on the date when the notification is sent to him; or

(b) in the case of a request by a licensee, within the period of four months beginning on the date when the notification is sent to him.

### **Prescribed period for new applications under section 8(3) or 12(6)**

10. The prescribed period for the purposes of sections 8(3) and 12(6) shall be three months calculated from the day on which the time for appealing from an order made under either of those subsections expires without an appeal being brought or, where an appeal is brought, from the day on which it is finally disposed of.

### **Authorisation under section 8(5)**

11.-(1) An application under section 8(5) for authority to do anything on behalf of a person to whom directions have been given under section 8(2)(d) or (4) shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts upon which the applicant relies and the nature of the authorisation sought.

(2) The comptroller shall send a copy of the application and statement to the person alleged to have failed to comply with the directions.

(3) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

### **Request by joint applicant under section 10 or 12(4)**

12.-(1) A request under section 10 or section 12(4) by a joint applicant shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts upon which he relies and the directions which he seeks.

(2) The comptroller shall send a copy of the request and statement to each other joint applicant who shall, if he wishes to oppose the request, within the period of six weeks beginning on the date when such copies are sent to him, file in duplicate a counter-statement setting out fully the grounds of his opposition; and the comptroller shall send a copy of the counter-statement to the person making the request and to each other joint applicant who is not party to the counter-statement.

(3) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

### **Reference to the comptroller under section 11(5)**

13.-(1) Where, following the making of such an order as is mentioned in section 11(2), a question is referred to the comptroller under subsection (5) of section 11 or that subsection as applied by section 12(5) as to whether any person is entitled to be granted a licence or whether the period or terms of a licence are reasonable, the reference shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof

and a statement in duplicate setting out fully the question referred, the facts upon which the person making the reference relies and the period or terms of the licence which he is prepared to accept or grant.

(2) The comptroller shall send a copy of the reference and statement to every person in whose name the application is to proceed or, as the case may be, every person claiming to be entitled to be granted a licence, in either case not being the person who makes the reference, and if any recipient does not agree to grant or accept a licence for such period and upon such terms, he shall, within the period of six weeks beginning on the date when the copies are sent to him, file a counter-statement in duplicate setting out fully the grounds of his objection and the comptroller shall send a copy of the counter-statement to the person making the reference.

(3) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

## INVENTORS

### **Mention of inventor under section 13**

14.-(1) An application to the comptroller under section 13(1) or (3) by any person who alleges-

(a) that any person ought to have been mentioned as the inventor or joint inventor of an invention in any patent granted or published application for a patent for the invention; or

(b) that any person mentioned as sole or joint inventor in any patent granted or published application for a patent for the invention ought not to have been so mentioned,

shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts relied upon.

(2) The comptroller shall send a copy of any such application and statement to-

(a) every person registered as proprietor of, or applicant for, the patent;

(b) every person who has been identified in the patent application or a statement filed under section 13(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention; and

(c) every other person whose interests the comptroller considers may be affected by the application;

other than the applicant under section 13(1) or (3) and any person who has consented in writing to the application.

(3) Any recipient of such a copy of an application and statement who wishes to oppose the application shall, within the period of six weeks beginning on the date when the copies are sent to him, file a counter-statement in duplicate setting out fully the grounds of his objection and the comptroller shall send a copy of the counter-statement to each of the persons described in this rule other than any person who is party to the counter-statement.

(4) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

(5) The document prescribed for the purposes of section 13(1) shall be an addendum or erratum.

(6) This procedure shall not apply where the question of inventorship by the inventor or joint inventor is put in issue by a reference under section 8 or 37.

### **Procedure where applicant is not the inventor or sole inventor**

15.-(1) Subject to the provisions of rules 26, 81(3), 82(3), 85(7)(a) and 85(7A)(a), if the applicant or applicants are not the inventor or inventors, a statement under section 13(2) identifying the inventor or inventors and, where required by section 13(2)(b), the derivation of the right of the applicant or applicants to be granted the patent shall be made on Patents Form 7/77, within the period of sixteen months after the declared priority date or, where there is no declared priority date, the date of filing the application.

(2) Where the applicant is not the sole inventor or the applicants are not the joint inventors of the invention the subject of the application and the application does not contain a declared priority date which relates to an earlier relevant application as defined in section 5(5)(b), a sufficient number of copies of Patents Form 7/77 shall be filed by the applicant or applicants within the said period to enable the comptroller to send one to each inventor who is not one of the applicants.

(3) Where the application is an application for a European patent (UK) which by virtue of section 81 is to be treated as an application for a patent under the Act, the requirements of paragraphs (1) and (2) above shall be treated as having been complied with to the extent that the requirements of rule 17 of the Implementing Regulations to the European Patent Convention have been fulfilled.

(4) Where the application is an international application for a patent (UK), the requirements of paragraphs (1) and (2) above shall be treated as having been complied with if the provisions of rules 4.1(a)(v) and 4.6 of the Regulations made under the Patent Co-operation Treaty have been complied with, whether or not there was any requirement that they be complied with.

### **APPLICATIONS FOR PATENTS**

#### **Applications for the grant of patents under sections 14 and 15**

16.-(1) A request for the grant of a patent shall be made on Patents Form 1/77.

(2) The specification contained in an application for a patent made under section 14 shall state the title of the invention and continue with the description and the claim or claims and drawings, if any, in that order, but, where the application is delivered in electronic form or using electronic communications, that order shall not apply to the extent that it has been removed or varied by the comptroller in directions made under section 124A and the specification shall comply with such directions.

(3) The title shall be short and indicate the matter to which the invention relates.

(4) The description shall include a list briefly describing the figures in the drawings, if any.

#### **Biological material**

17. Schedule 2 shall have effect in relation to certain applications for patents, and patents, for inventions which involve the use of or concern biological material.

#### **Drawings**

18.-(1) Drawings forming part of an application for a patent made under section 14 shall be on sheets the usable surface area of which shall not exceed 26.2 cm by 17 cm. The sheets shall not contain frames round the usable or used surface. The minimum margins shall be as follows-

top	2.5 cm
left side	2.5 cm
right side	1.5 cm
bottom	1.0 cm

(2) Drawings shall be executed as follows -

(a) without colouring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;

(b) cross-sections shall be indicated by hatching which does not impede the clear reading of the reference signs and leading lines;

(c) the scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty. If, as an exception, the scale is given on a drawing, it shall be represented graphically;

(d) all numbers, letters, and reference signs, appearing on the drawings shall be simple and clear and brackets, circles and inverted commas shall not be used in association with numbers and letters;

(e) elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;

(f) the height of the numbers and letters shall not be less than 0.32 cm and for the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used;

(g) the same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures. The different figures shall be arranged without wasting space, clearly separated from one another. The different figures shall be numbered consecutively in arabic numerals, independently of the numbering of the sheets;

(h) reference signs not mentioned in the description or claims shall not appear in the drawings, and vice versa. The same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs;

(i) the drawings shall not contain textual matter, except, when required for the understanding of the drawings, a single word or words such as "water", "steam", "open", "closed", "section on AA", and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords; and

(j) the sheets of the drawings shall be numbered in accordance with rule 20(9).

(3) Flow sheets and diagrams shall be considered to be drawings for the purposes of these Rules.

(4) Where the application for a patent is delivered in electronic form or using electronic communications, paragraphs (1) and (2) shall not apply to the extent that they have been removed or varied by the comptroller in directions made under section 124A and drawings forming part of that application shall comply with such directions.

### **The abstract**

19.-(1) The abstract shall commence with a title for the invention.

(2) The abstract shall contain a concise summary of the matter contained in the specification. The summary shall indicate the technical field to which the invention belongs and be drafted in a way which allows a clear understanding of the technical problem to which the invention relates, the gist of the solution to that problem through the invention and the principal use or uses of the invention. Where appropriate, the

abstract shall also contain the chemical formula which, among those contained in the specification, best characterises the invention. It shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(3) The abstract shall normally not contain more than 150 words.

(4) If the specification contains any drawings, the applicant shall indicate on the abstract the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when published. The comptroller may decide to publish one or more other figures if he considers that they better characterise the invention. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.

(5) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.

### **Size and presentation of documents**

20.-(1) All documents (including drawings) making up an application for a patent or replacing such documents shall be in the English language.

(2) The specification, abstract and any replacement sheet thereof shall be filed in duplicate.

(3) All documents referred to in paragraph (1) above shall be so presented as to permit of direct reproduction by photography, electrostatic processes, photo offset and micro-filming, in an unlimited number of copies. All sheets shall be free from cracks, creases and folds. Only one side of the sheet shall be used, except in the case of a request for the grant of a patent.

(4) All documents referred to in paragraph (1) above shall be on A4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable. Each sheet (other than drawings) shall be used with its short sides at the top and bottom (upright position).

(5) The request for the grant of a patent and the description, claims, drawings and abstract shall each commence on a new sheet. The sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.

(6) Subject to rule 18(1), the minimum margins shall be as follows:

top	2.0 cm
left side	2.5 cm
right side	2.0 cm
bottom	2.0 cm

(7) The margins of the documents making up the application and of any replacement documents must be completely blank.

(8) In the application, except in the drawings-

(a) all sheets in the request shall be numbered consecutively; and

(b) all other sheets shall be numbered consecutively as a separate series,

and all such numbering shall be in arabic numerals placed at the top of the sheet, in the middle, but not in the top margin.

(9) All sheets of drawings contained in the application shall be numbered consecutively as a separate series. Such numbering shall be in arabic numerals placed at the top of the sheet, in the middle, but not in the top margin.

(10) Every document (other than drawings) referred to in paragraph (1) above shall be typed or printed in a dark, indelible colour in at least 1½ line spacing and in characters of which the capital letters are not less than 0.21 cm high:

Provided that Patents Form 1/77 may be completed in writing, and that graphic symbols and characters and chemical and mathematical formulae may be written or drawn, in a dark indelible colour.

(11) The request for the grant of a patent, the description, the claims and the abstract shall not contain drawings. The description, the claims and the abstract may contain chemical or mathematical formulae. The description and the abstract may contain tables. The claims may contain tables only if their subject-matter makes the use of tables desirable.

(12) In all documents referred to in paragraph (1) above units of weight and measures shall be expressed in terms of the metric system. If a different system is used they shall also be expressed in terms of the metric system. Temperatures shall be expressed in degrees Celsius. For the other physical values, the units recognised in international practice shall be used, for mathematical formulae the symbols in general use, and for chemical formulae the symbols, atomic weights and molecular formulae in general use shall be employed. In general, use should be made of technical terms, signs and symbols generally accepted in the field in question.

(13) If a formula or symbol is used in the specification a copy thereof, prepared in the same manner as drawings, shall be furnished if the comptroller so directs.

(14) The terminology and the signs shall be consistent throughout the application.

(15) All documents referred to in paragraph (1) above shall be reasonably free from deletions and other alterations, overwritings and interlineations and shall, in any event, be legible.

(16) Where the application for a patent is delivered in electronic form or using electronic communications, paragraphs (2) to (10), (13) and (15) shall not apply to the extent that they have been removed or varied by the comptroller in directions made under section 124A and the application shall comply with such directions.

#### **Form of statements, counter-statements and evidence**

21. Any statement, counter-statement or evidence filed shall, unless the comptroller otherwise directs, comply with the requirements of rule 20(1) and (4) and, except that both sides of the sheet may be used in the case of statutory declarations and affidavits, with the requirements of rule 20(3).

#### **Unity of invention**

22.-(1) Without prejudice to the generality of section 14(5)(d), where two or more inventions are claimed (whether in a single claim or in separate claims), and there exists between or among those inventions a technical relationship which involves one or more of the same or corresponding special technical features, then those inventions shall be treated as being so linked as to form a single inventive concept for the purposes of the Act.

(2) In this rule, "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.

### **Late filed drawings**

23. The period prescribed for the purposes of section 15(2) and (3) shall be one month calculated from the date on which the comptroller sends out notification to the applicant that the drawing has been filed later than the date which is, by virtue of section 15(1), to be treated as the date of filing the application or, as the case may be, that it has not been filed.

### **New applications under section 15(4)**

24.-(1) Subject to paragraph (2) below, a new application for a patent, which includes a request that it shall be treated as having as its date of filing the date of filing of an earlier application, may be filed in accordance with section 15(4) not later than the beginning of the third month before the end of the period ascertained under rule 34 in relation to the earlier application as altered, if that be the case, under rule 100 or rule 110 ("the rule 34 period"):

Provided that, where the first report of the examiner under section 18 is made under subsection (4) and the comptroller notifies the applicant that the earlier application complies with the requirements of the Act and these Rules, notwithstanding the foregoing provisions of this paragraph but subject to paragraph (2) below, a new application may be filed not later than the expiry of the period of two months beginning on the day that the notification is sent.

(2) Where any of the following dates falls before the date ascertained under paragraph (1) above, a new application may only be filed before that date instead of the date so ascertained-

- (a) the date when the earlier application is refused, is withdrawn, is treated as having been withdrawn or is taken to be withdrawn;
- (b) the expiry of the rule 34 period ascertained in relation to the earlier application; and
- (c) the date when a patent is granted on the earlier application.

### **Periods prescribed under section 15(5)(a) and (b) and 17(1) for filing claims, abstract and request for preliminary examination and search**

25.-(1) The period prescribed for the purposes of section 15(5)(a) shall be,-

- (a) if the application contains no declared priority date, the period of twelve months calculated from its date of filing; or
- (b) if the application does contain a declared priority date, the last to expire of the period of twelve months calculated from the declared priority date and the period of one month calculated from the date of filing the application.

(2) Subject to the provisions of rules 81(3), 82(3), 85(7) and 85(7A)(b), the period prescribed for the purposes of sections 15(5)(b) and 17(1) shall be-

- (a) if the application contains no declared priority date, the period of twelve months calculated from its date of filing; or
- (b) if the application does contain a declared priority date, the period of twelve months calculated from the declared priority date.

(3) Where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) after the end of the period prescribed in paragraph (1) or (2) above, as the case may be, the period prescribed for the purposes of



sections 15(5) and 17(1) shall be the period which expires at the end of two months from the actual date of filing of the new application.

(4) In a case where the new application is filed under section 8(3), 12(6), 15(4) or 37(4) after the beginning of the sixth month before the end of any period prescribed in rule 34 (period for putting application in order) in relation to the earlier application, as altered, if that be the case, under rule 100 or rule 110, the period prescribed for the purposes of sections 15(5) and 17(1) shall be the period which expires on the actual date of filing of the new application.

#### **Extensions for new applications**

26.-(1) Where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) after the period of sixteen months prescribed in either rule 6 or rule 15, then, subject to the following provisions of this rule,-

- (a) the requirements of those rules shall be complied with at the time of filing the new application; and
- (b) the requirements of paragraph 1(2)(a)(ii), 1(2)(a)(iii) and (3) of Schedule 2, in a case to which they apply, shall be complied with not later than the later of the time ascertained under the said paragraph 1(3) and the time of filing the new application.

(2) Where a new application to which the requirement in paragraph (6) of rule 6 applies is filed under section 8(3), 12(6), 15(4) or 37(4), that requirement shall be met-

- (a) within the period prescribed by that paragraph; or
- (b) where the earlier application is an international application, within the period prescribed by rule 6(6) as it has effect under rule 85(3) in respect of the earlier application; or
- (c) if the new application is filed after the periods prescribed by subparagraphs (a) or (b), at the time of filing.

(3) Where a new application is filed under section 15(4) after-

- (a) the period of sixteen months prescribed in rule 6(2) or rule 15(1); or
- (b) where the earlier application is an international application, the period prescribed by rule 6(6) as it has effect under rule 85(3) in respect of the earlier application;

but within an extension of that period under rule 110(3) or (4) in respect of the earlier application, the requirements of rule 6(2) and (3), rule 6(6) or rule 15, as the case may be, shall be complied with before the end of the extended period.

#### **Period for publication of application**

27. The period prescribed for the purposes of section 16 shall be the period of eighteen months calculated from the declared priority date or, where there is no declared priority date, the date of filing the application.

#### **EXAMINATION AND SEARCH**

##### **Preliminary examination and search under section 17**

28.-(1) A request under section 17(1)(a) for a preliminary examination and search shall be made on Patents Form 9/77.

(2) On a preliminary examination the examiner shall determine, not only whether the application ("the application in suit") complies with those requirements of the Act and these Rules which are designated by rule 31 as formal requirements for the purposes of the Act, but also whether the requirements of rules 6(1) and (2) and 15(1) and the provisions of section 15(3) have been complied with.

(3) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part thereof) referred to in the examiner's report under section 17(5).

#### **Procedure where earlier application made**

29. Where the preliminary examination under rule 28 reveals that an earlier relevant application declared for the purposes of section 5 has been stated in the application in suit to have a date of filing more than twelve months before the date of filing of the application in suit, the Patent Office shall notify the applicant that the earlier relevant application will be disregarded unless, within one month, he supplies the Patent Office with a corrected date, being one which falls within those twelve months.

#### **Address for service**

30.-(1) There shall be furnished to the comptroller-

(a) by every applicant for the grant of a patent, an address for service in the United Kingdom for the purpose of his application, and

(b) notwithstanding the provisions of paragraphs (2) to (4) below, by every person (including the applicant for, or the proprietor of, a patent, as the case may be) concerned in any proceedings to which any of these Rules relate, an address for service in the United Kingdom,

and the address so furnished or, where another address (being an address in the United Kingdom) has been furnished in place thereof, that address shall be treated for the purposes of that application or those proceedings, as appropriate, as the address of that applicant or, as the case may be, of that person.

(2) Upon grant of an application for a patent (not being an application for a European patent (UK)), the applicant's address for service as shown in the register shall be treated as the address for service of the proprietor of the patent unless an alternative address is furnished.

(3) As from publication of the mention of the grant of every European patent (UK) in the European Patent Bulletin, the address for service of the proprietor shall be the address for service notified to the comptroller by or on behalf of the proprietor, whether before or after the said mention of the grant, and in the absence of any such notification the proprietor's address on the register shall be treated as the address for service.

(4) An address for service for an applicant for, or a proprietor of, a patent may be withdrawn by the applicant or the proprietor or the person providing the address for service, as the case may be, by notice to the comptroller; and upon such notification the comptroller may treat the address of the applicant or the proprietor previously notified to him, or the address shown in the register, as the address for service until such time as an alternative address is furnished.

#### **Formal requirements**

31.-(1) The requirements of rules 16(1), 18(1) and (2) (other than those contained in paragraph (2)(h)), 20 (other than those contained in the last sentence of paragraph (11) and in paragraphs (12) and (14)) and 30(1)(a) shall be formal requirements for the purposes of the Act.

(1A) Where any of the requirements referred to in paragraph (1) do not apply by virtue of rule 18(4) or rule 20(16), the formal requirements for the purposes of the Act shall include the requirements of so much of any directions given by the comptroller under section 124A as replace those requirements.

(2) Where the application is -

- (a) an application for a European patent (UK); or
- (b) an international application for a patent (UK)

which, by virtue of section 81 or 89, as the case may be, is to be treated as an application for a patent under the Act, the said requirements of rules 16(1), 18(1) and (2) and 20 shall be treated as having been complied with to the extent that the requirements of the corresponding provisions of the Implementing Regulations to the European Patent Convention or, as the case may be, of the Regulations made under the Patent Co-operation Treaty, have been fulfilled.

#### **Searches under section 17(6) and (8)**

32.-(1) Where an examiner conducts a search under section 17(6) in relation to the first only of two or more inventions specified in the claims of an application, the Patent Office shall notify the applicant of that fact.

(2) If the applicant desires a search to be conducted under section 17(6) in relation to a second or subsequent invention specified in the claims, he shall, not later than the beginning of the third month before the end of the period prescribed under rule 34, as altered, if that be the case, under rule 100 or rule 110, request the Patent Office on Patents Form 9/77 to conduct such a search and pay the search fee for each invention in respect of which the search is to be made.

(3) The fee for a supplementary search under section 17(8) shall be accompanied by Patents Form 9/77.

(4) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part thereof) referred to in the examiner's report under section 17 pursuant to subsection (6) or (8) thereof.

#### **Request for substantive examination under section 18**

33.-(1) A request for a substantive examination of an application for a patent shall be made on Patents Form 10/77.

(2) Subject to the provisions of rules 83(1), 85(7), 85(7A)(c) and paragraphs (3) and (5) below, the request shall be made and the fee for the examination paid within six months of the date of publication of the application in accordance with section 16.

(3) Where an application is subject to directions under section 22(1) or (2), the request shall be made and the fee paid within two years of the declared priority date or, where there is no declared priority date, from the date of filing the application except in the case of a new application made under section 8(3), 12(6) or 15(4) after the expiry of the said two years, when the request shall be made and the fee paid at the time of filing the new application.

(4) When he gives the applicant the opportunity under section 18(3) to make observations on the examiner's report under subsection (2) of that section, the comptroller may, if he thinks fit, send to the applicant a copy of any document (or part thereof) referred to in the report.

(5) Where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) then,-

- (a) if the new application is filed within two years calculated from the declared priority date or, where there is no declared priority date, from the date treated as its date of filing, the request shall be made and the fee for the examination paid within those two years; and
- (b) if the new application is filed after the expiration of those two years, the request shall be made and the fee for the examination paid at the time of filing the new application.

### **Period for putting application in order**

34.-(1) Subject to the provisions of paragraph (2) below and of rule 83(3), for the purposes of sections 18(4) and 20(1), the period within which an application for a patent shall comply with the Act and these Rules-

(a) subject to subparagraphs (b) and (c) hereof and paragraph (1A) below, shall be-

- (i) the period of four years and six months calculated from its declared priority date or, where there is no declared priority date, from the date of filing of the application; or
- (ii) the period of twelve months calculated from the date the first report under section 18 in respect of that application is sent to the applicant,

whichever expires the later;

(b) in the case of a new application for a patent arising from and made in accordance with an order of the comptroller under section 8(3), 12(6) or 37(4), shall be-

- (i) the period of four years and six months calculated from the declared priority date for the earlier application or, where there is no such declared priority date, the date of filing of the earlier application; or
- (ii) the period of eighteen months calculated from the actual date of filing of the application, whichever expires the later;

(c) in the case of a new application under section 15(4), shall be the period determined in accordance with subparagraph (a) above in respect of the earlier application whose date of filing is to be treated under section 15(4) as the date of filing of the new application.

(1A) Where the first report under section 18 is not sent to the applicant before the expiry of the period prescribed by subparagraph (a)(i) of paragraph (1) above, that period shall be extended to such date as that report is sent to the applicant and the period specified by subparagraph (a)(ii) of paragraph (1) shall then apply.

(2) In a case where,-

- (a) a third party makes observations under section 21 on an application;
- (b) the examiner, for the first time in a report under section 18(3), relies upon the substance of those observations to report that the patentability requirements of the Act are not met; and
- (c) following that report, and within the last three months of the period ascertained under paragraph (1) above (including any alteration thereof under rule 100 or rule 110) the comptroller gives the applicant the opportunity under section 18(3) to make observations on the report and to amend the application,

the period within which an application for a patent shall comply with the Act and these Rules shall expire at the end of the period of three months beginning on the date when the comptroller sends notification to the applicant of that opportunity.

### **Amendment of request for grant**

35. Subject to rule 45(3), an application for amendment of the request for the grant of a patent shall-

- (a) be made on Patents Form 11/77;

(b) clearly identify the proposed amendment; and

(c) state the reasons for it.

#### **Amendment of application before grant**

36.-(1) An applicant may not amend the description, claims and drawings contained in his application except in accordance with the following provisions of this rule.

(2) Unless the comptroller so requires or consents, the applicant may not so amend before the comptroller sends to the applicant the examiner's report under section 17(5).

(3) After the comptroller has sent to the applicant the examiner's report under section 17(5) and before he sends to the applicant the first report of the examiner under section 18, the applicant may so amend of his own volition.

(4) After the comptroller has sent to the applicant the examiner's first report under section 18, the applicant may so amend once of his own volition provided that-

(a) where the report is made under-

(i) section 18(3), the amendment is filed at the same time as the applicant replies to that report, or

(ii) section 18(4), the amendment is filed within two months of that report being sent to the applicant,

except that -

(b) where the report referred to in subparagraph (a)(i) is made before preparations for publication of the application have been completed, the applicant may, in addition and prior to the amendment which may be made in accordance with that subparagraph, amend of his own volition the description, claims or drawings.

(5) The right to amend set out in paragraph (4) is in addition to an applicant's right under section 18(3) to amend the application so as to comply with the requirements of the Act and these Rules.

(6) Any further amendment to the description, claims or drawings which the applicant desires to make of his own volition may be made only with the consent of the comptroller following the filing of Patents Form 11/77 clearly identifying the proposed amendment and stating the reasons for it.

#### **Observations on patentability under section 21**

37.-(1) Subject to paragraph (2) below, the comptroller shall send to the applicant a copy of-

(a) any document containing observations which he receives under section 21 in connection with the application; and

(b) any document referred to in any such observations being a document which he receives from the person making them.

(2) Nothing in paragraph (1) above shall impose any duty on the comptroller in relation to any document-

(a) a copy of which it appears to the comptroller is readily available for retention by the applicant; or

(b) which in his opinion is not suitable for photocopying, whether on account of size or for any other reason.

(3) If the period ascertained under rule 34 (as altered, if that be the case, under rule 100 or rule 110) has not expired and the comptroller has not sent to the applicant notice in accordance with section 18(4) that the application complies with the requirements of the Act and these Rules, the observations shall be referred to the examiner conducting a substantive examination of the application under section 18; and the examiner shall consider and comment upon them as he thinks fit in his report under that section.

## **GRANT, AMENDMENT AND CONTINUATION OF PATENT**

### **Certificates of grant**

38. A certificate that a patent has been granted shall be in a form which includes the name of the proprietor of the patent and the date of filing of the application.

### **Renewal of patents**

39.-(1) If, except in the case of a European patent (UK), it is desired to keep a patent in force for a further year after the expiration of the fourth or any succeeding year from the date of filing an application for that patent as determined in accordance with section 15, Patents Form 12/77, in respect of the next succeeding year, shall be filed and the prescribed renewal fee paid in the three months ending with the fourth or, as the case may be, succeeding anniversary of the date of filing:

Provided that, where a patent is granted in the three months ending with the fourth or any succeeding anniversary as so determined or at any time thereafter, Patents Form 12/77, in respect of the fifth or succeeding year may be filed and the prescribed renewal fee paid not more than three months before the expiration of the fourth or relevant succeeding year but before the expiration of three months from the date on which the patent is granted.

(2) If it is desired, at the expiration of the fourth or any succeeding year from the date of filing an application for a European patent (UK), as determined in accordance with Article 80 of the European Patent Convention, and provided that mention of the grant of the patent is, or has been, published in the European Patent Bulletin, to keep the patent in force, Patents Form 12/77 shall be filed and the prescribed renewal fee paid in the three months ending with the fourth or, as the case may be, succeeding anniversary of the date of filing as so determined.

Provided that, where any renewal fee is due on, or within the period of three months after, the date of publication in the European Patent Bulletin of the mention of the grant of the patent, that renewal fee may be paid within those three months.

(3) On receipt of the prescribed renewal fee, the comptroller shall (if the patent has been granted) issue a certificate of payment.

(4) Where the period for payment of a renewal fee pursuant to paragraph (1) or (2) above has expired, the comptroller shall, not later than six weeks after the last date for payment under that paragraph and if the fee still remains unpaid, send to the proprietor of the patent a notice reminding him that payment is overdue and of the consequences of non-payment.

(5) The comptroller shall send a notice under paragraph (4) above to-

(a) the address specified by the proprietor on payment of the last renewal fee; or

(b) where another address has been notified to him for that purpose by the proprietor since the last renewal, that address,

and, in any other case, the address for service entered in the register.

(6) A request for extending the period for payment of a renewal fee shall be made on Patents Form 12/77 and shall be accompanied by the prescribed renewal fee and the prescribed additional fee for late payment.

#### **Amendment of specification after grant**

40.-(1) An application to the comptroller for leave to amend the specification of a patent shall-

(a) be made on Patents Form 11/77, and

(b) clearly identify the proposed amendment and state the reasons for it.

(1A) If it is reasonably possible, the proposed amendment and the reasons for it shall also be set out and delivered to the comptroller in electronic form or using electronic communications.

(1B) The comptroller shall advertise in the Journal notice that an application has been made to amend the specification of a patent, and the advertisement shall state that any person may apply to the comptroller for a copy of the proposed amendment and the reasons given for it.

(2) At any time within two months from the date of the advertisement in the Journal, any person may give notice to the comptroller of opposition to the application to amend on Patents Form 15/77.

(3) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and of the statement to the applicant.

(4) Within the period of six weeks beginning on the date when such copies are sent to him, the applicant shall, if he wishes to continue with the application, file a counter-statement in duplicate setting out fully the grounds upon which the opposition is resisted; and the comptroller shall send a copy of the counter-statement to the opponent.

(5) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

(6) An application under this rule shall be accompanied by -

(a) if the specification as published is not in English, a document containing a translation into English of the part of the specification proposed to be amended and a translation into English of the part as proposed to be amended verified to the satisfaction of the comptroller as corresponding to the original text; and

(b) in the case of an application for amendment of a European patent (UK), a copy of the specification for that patent as published,

and, if the specification as published is not in English, the applicant shall, if the comptroller so requests, supply a translation thereof into English verified to his satisfaction as corresponding to the original text.

(7) The comptroller may, if he thinks fit, require that the amendment be shown on a copy of the specification of which amendment is sought.

(8) Where leave to amend a specification is given, the applicant shall, if the comptroller so requires, and within a time to be fixed by him, file a new specification as amended, which shall be prepared in accordance with rules 16, 18 and 20.

### **Restoration of lapsed patents under section 28**

41.-(1) An application under section 28 for the restoration of a patent-

(a) may be made at any time within the period of nineteen months beginning on the day on which it ceased to have effect; and

(b) shall be made on Patents Form 16/77 supported by evidence of the statements made in it;

and the comptroller shall publish in the Journal notice of the making of the application.

(2) If, upon consideration of the evidence, the comptroller is not satisfied that a case for an order under section 28 has been made out, he shall notify the applicant accordingly and, unless within one month the applicant requests to be heard in the matter, the comptroller shall refuse the application.

(3) If the applicant requests a hearing within the time allowed, the comptroller shall, after giving the applicant an opportunity of being heard, determine whether the application shall be allowed or refused.

(4) If the comptroller decides to allow the application, he shall notify the applicant accordingly and require him, within two months after the notification is sent to him, to file Patents Form 53/77, together with Patents Form 12/77, duly completed, and the amount of any unpaid renewal fee, upon receipt of which the comptroller shall order the restoration of the patent and advertise the fact in the Journal.

### **Notification of lapsed patent**

42. Where a patent has ceased to have effect because a renewal fee has not been paid within the period prescribed in rule 39(1) or (2) and the extended period specified in section 25(4) has expired without the renewal fee and prescribed additional fee having been paid, the comptroller shall, within six weeks after the expiration of the extended period, notify the proprietor of the patent of the fact and draw his attention to the provisions of section 28.

### **Surrender of patents**

43.-(1) A notice of an offer by a proprietor of a patent under section 29 to surrender his patent shall be-

(a) given in writing accompanied by:

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

(ii) if an action before the court is pending full particulars of the action in writing;

and

(b) advertised by the comptroller in the Journal.

(2) At any time within two months from the advertisement any person may give notice of opposition to the surrender to the comptroller on Patents Form 15/77.

(3) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and of the statement to the proprietor of the patent.

(4) Within the period of six weeks beginning on the date when such copies are sent to him, the proprietor of the patent shall, if he wishes to continue with the surrender, file a counter-statement in duplicate setting out fully the grounds upon which the opposition is resisted; and the comptroller shall send a copy of the counter-statement to the opponent.



(5) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

## REGISTRATION

### **Entries in the register**

44.-(1) No entry shall be made in the register in respect of any application for a patent before the application has been published in accordance with section 16.

(2) Upon such publication, the comptroller shall cause to be entered in the register-

- (a) the name and address of the applicant or applicants;
- (b) the name and address of the person or persons stated by the applicant or applicants to be believed to be the inventor or inventors;
- (c) the title of the invention;
- (d) the date of filing and the file number of the application for the patent;
- (e) the date of filing and the file number of any application declared for the purposes of section 5(2) or 127(4) and the country in or for which the application was made;
- (f) the date on which the application was published; and
- (g) the address for service of the applicant or applicants.

Provided that the comptroller may omit from the register the address of the person or persons stated by the applicant or applicants to be believed to be the inventor or inventors, if so requested by the applicant or applicants.

(3) The comptroller shall also cause to be entered in the register-

- (a) the date of filing of the request for substantive examination;
- (b) the date on which the application is withdrawn, taken to be withdrawn, treated as having been withdrawn, refused or treated as having been refused;
- (c) the date on which the patent is granted;
- (d) the name and address of the person or persons to whom the patent is granted if different to the entries made in accordance with paragraph (2)(a) above;
- (e) the address for service if different to the entry made in accordance with paragraph (2)(g) above; and
- (f) notice of any transaction, instrument or event referred to in section 33(3).

(4) The comptroller may at any time enter in the register such other particulars as he may think fit.

### **Alteration of name or address**

45.-(1) A request by any person, upon the alteration of his name, for that alteration to be entered in the register or on any application or other document filed at the Patent Office shall be made on Patents Form 20/77.

(2) Before acting on a request to alter a name, the comptroller may require such proof of the alteration as he thinks fit.

(3) A request by any person for the alteration or correction of his address or address for service entered in the register or on any application or other document filed at the Patent Office shall, if not made on a form filed under any provision of these Rules, be made in writing and shall identify any relevant application or patent.

(4) If the comptroller is satisfied that a request to alter a name or to alter or correct an address or address for service may be allowed, he shall cause the register, application or other document to be altered accordingly.

### **Registrations under section 33**

46.-(1) An application to register, or to give notice to the comptroller of, any transaction, instrument or event to which section 33 applies shall be made on Patents Form 21/77.

(2) An application under paragraph (1) above shall-

(a) where it relates to an assignment or assignation referred to in section 33(3)(a) or (c), be signed by or on behalf of the parties thereto or the assignor only;

(b) where it relates to a mortgage or the granting of a licence or sub-licence or security referred to in section 33(3)(b) or (c), be signed by or on behalf of the mortgagor or the grantor of the licence or security, as the case may be;

or be accompanied by such documentary evidence as suffices to establish the transaction, instrument or event.

(3) 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.

### **Request for correction of error**

47.-(1) Without prejudice to rule 45(3), a request for the correction of an error in the register or in any document filed at the Patent Office in connection with registration shall be made on Patents Form 11/77; and the correction shall be clearly identified on a document annexed to the form or, if not, on the form itself.

(2) The comptroller may call for such written explanation of the reasons for the request or evidence in support of it as he may require in order to satisfy himself that there is an error and, upon being so satisfied, shall make such correction as may be agreed between the proprietor of the patent or applicant and the comptroller.

### **Request as to payment of renewal fee**

48. A request for information about the date of payment of any renewal fee shall be accompanied by the prescribed fee, if any, but a copy of an entry in or extract from the register shall be requested only in accordance with rule 52.

### **Inspection of register**

49.-(1) The register or entries or reproductions of entries in it shall be made available for inspection by the public between the hours of 9 am and 5 pm on weekdays, other than Saturdays and days which are specified as excluded days for the purposes of section 120.

(2) A request to be allowed to inspect the register shall be accompanied by the prescribed fee, if any, but a copy of an entry in or extract from the register shall be requested only in accordance with rule 52.

#### **Advertisements in relation to register**

50. The comptroller may arrange for the publication and advertisement of such things done under the Act or these Rules in relation to the register as he may think fit.

#### **Entries relating to sections 8(1), 12(1) and 37(1)**

51. On the reference to the comptroller of a question under section 8(1), 12(1) or 37(1), he shall, subject to rule 44(1), cause an entry to be made in the register of the fact and of such other information relating to the reference as he may think fit.

#### **Certificates and copies supplied by comptroller**

52.-(1) Upon request made on Patents Form 23/77 and payment of the appropriate fee, but subject to paragraph (3) below, the comptroller shall supply -

- (a) a certified copy or certified extract falling within section 32(11);
- (b) a copy of an entry in or an extract from the register or a copy of or an extract from anything referred to in section 32(11)(b), certified by the impression of a rubber stamp;
- (c) a certificate for the purposes of section 32(10).

(2) Upon request made on Patents Form 23/77 and payment of the prescribed fee, if any, but subject to paragraph (3) below, the comptroller shall supply an uncertified copy of an entry in or an uncertified extract from the register or an uncertified copy of or an uncertified extract from anything referred to in section 32(11)(b).

(3) The restrictions on making documents available for inspection contained in rule 93(4) shall apply equally to the supply by the comptroller under this rule of copies of or extracts from such documents or requests as are referred to in rule 93(4); and nothing in this rule shall be construed as imposing upon the comptroller the duty of supplying copies of or extracts from any document or file of a description referred to in rule 93(5).

#### **Order or direction by court**

53. Where any order or direction has been made or given by the court-

- (a) transferring a patent or application or any right in or under it to any person;
- (b) that an application should proceed in the name of any person;
- (c) allowing the proprietor of a patent to amend the specification; or
- (d) revoking a patent;

the person in whose favour the order is made or the direction is given-

- (i) shall send to the comptroller written notice thereof accompanied by an office copy of the order or direction; and

(ii) if the comptroller so requires and before a time fixed by him, shall file a specification as amended (prepared in accordance with rules 16, 18 and 20),

and thereupon the specification shall be amended or the register rectified or altered, as the case may require.

#### ENTITLEMENT TO PATENT

##### **Reference of question to the comptroller under section 37(1)**

54.-(1) A reference under section 37(1) shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the nature of the question, the facts upon which the person making the reference relies and the order which he is seeking.

(2) The comptroller shall send a copy of the reference and statement to every person who is not a party to the reference being-

(a) a person who is shown on the register as having any right in or under the patent; or

(b) a person who is alleged in the reference to be entitled to a right in or under the patent

other than the person making the reference under section 37(1) or any person who has consented in writing to the reference.

(3) If any person who is sent a copy of the reference and statement under paragraph (2) above wishes to oppose the making of the order sought ("the opponent"), he shall, within the period of six weeks beginning on the date when such copies are sent to him, file in duplicate a counter-statement setting out fully the grounds of his opposition and the comptroller shall send a copy of the counter-statement to the person making the reference and to those recipients of the copy of the reference and statement who are not party to the counter-statement.

(4) The person making the reference or any such recipient may, within the period of six weeks beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence,-

(a) in any case, to the opponent; and

(b) in the case of evidence filed by such a recipient, to the person making the reference.

(5) Within the period of six weeks after the copy of such evidence is sent to him or, if no such evidence is filed, within six weeks of the expiration of the time within which it might have been filed, the opponent may file evidence in support of his case and shall send a copy of that evidence to the person making the reference and to those recipients; and within the period of six weeks after the copy of the opponent's evidence is sent to him, that person or any of those recipients may file further evidence confined to matters strictly in reply and shall send a copy of it to the persons mentioned in subparagraphs (a) and (b) of paragraph (4) above.

(6) No further evidence shall be filed by any party except by leave or direction of the comptroller.

(7) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

##### **Applications under section 37(3)**

55.-(1) An application under section 37(3) for authority to do anything on behalf of a person to whom directions have been given under section 37(2)(d) shall be made on Patents Form 2/77 and shall be

accompanied by a copy thereof and a statement in duplicate setting out fully the facts upon which the applicant relies and the nature of the authorisation sought.

(2) The comptroller shall send a copy of the application and statement to the person alleged to have failed to comply with the directions.

(3) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

#### **Time limit for new application**

56. Where the comptroller orders that a new application may be made under section 37(4), it shall be made within three months calculated from the day on which the time for appealing from that order expires without an appeal being brought or, where an appeal is brought, from the day on which it is finally disposed of.

#### **Request under section 38(3)**

57.-(1) Where an order is made under section 37 that a patent shall be transferred to one or more persons none of whom was an old proprietor of it or that a person other than an old proprietor may make a new application for a patent, a request under section 38(3) for the grant of a licence to continue working or, as the case may be, to work the invention shall, in the case of any of the old proprietors, be made within two months, and in the case of a licensee, four months, of his being notified by the comptroller of the making of the order.

(2) Where such an order is made, the comptroller shall notify the old proprietor or proprietors, and their licensees of whom he is aware, of the making of the order.

#### **Reference to comptroller under section 38(5)**

58.-(1) Where a question is referred to the comptroller under section 38(5) as to whether any person is entitled to be granted a licence or whether the period or terms of a licence are reasonable, the reference shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the question referred, the facts upon which the person making the reference relies and the terms of the licence which he is prepared to accept or grant.

(2) The comptroller shall send a copy of the reference and statement to the new proprietor or proprietors and every person claiming to be entitled to be granted a licence, in either case not being the person who makes the reference, and if any recipient does not agree to grant or accept a licence for such period and upon such terms, he shall, within the period of six weeks beginning on the date when such copies are sent to him, file a counter-statement in duplicate setting out fully the ground of his objection and the comptroller shall send a copy of the counter-statement to the person making the reference.

(3) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

### **EMPLOYEES' INVENTIONS**

#### **Application under section 40 for compensation**

59.-(1) An application to the comptroller under section 40 for an award of compensation shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts relied upon.

(2) The prescribed period for the purposes of section 40(1) and (2) shall, in relation to proceedings before the comptroller, be that period which begins when the relevant patent is granted and which expires one year after it has ceased to have effect:

Provided that, where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the period prescribed for the payment thereof and an application for restoration is made to the comptroller under section 28, the said period shall, -

- (a) if restoration is ordered, continue as if the patent had remained continuously in effect; or
  - (b) if restoration is refused, be treated as expiring one year after the patent ceased to have effect or six months after the refusal, whichever is the later.
- (3) The comptroller shall send a copy of the application and statement to the employer who, if he wishes to contest the application, shall within the period of six weeks beginning on the date when such copies are sent to him, file a counter-statement in duplicate setting out fully the grounds on which he disputes the employee's right to the award sought, and the comptroller shall send a copy of the counter-statement to the employee.
- (4) The employee may, within the period of six weeks beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence to the employer.
- (5) Within the period of six weeks beginning on the date when the copy of the employee's evidence is sent to him or, if the employee does not file any evidence, within six weeks of the expiration of the time within which the employee's evidence might have been filed, the employer may file evidence in support of his case and shall send a copy of the evidence to the employee; and within the period of six weeks beginning on the date when the copy of the employer's evidence is sent to him, the employee may file evidence confined to matters strictly in reply and shall send a copy of that evidence to the employer.
- (6) No further evidence shall be filed by either party except by leave or direction of the comptroller.
- (7) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

#### **Application under section 41(8) to vary etc awards of compensation**

60.-(1) Where an award of compensation has been made to an employee under section 40(1) or (2) an application under section 41(8) to vary, discharge, suspend or revive any provision of the order shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the facts relied upon and the relief which is sought.

(2) Thereafter the provisions of rule 59(3) to (7) shall apply to an application made under section 41(8) by an employee as they apply to an application referred to in that rule and to an application made under section 41(8) by an employer as if references in those paragraphs to the employee were references to the employer and references to the employer were references to the employee.

#### **LICENCES OF RIGHT**

##### **Application under section 46(1) for entry in the register**

61.-(1) An application under section 46(1) shall be made on Patents Form 28/77.

(2) Every entry made in the register consequent upon such an application shall be published in the Journal.

##### **Application under section 46(3) to settle licences of right**

62.-(1) An application under section 46(3)(a) or (b) shall be made on Patents Form 2/77 which shall be filed in duplicate together with,-

(a) in the case of an application under section 46(3)(a) by the proprietor of the patent, two copies of a draft of the licence he proposes and of a statement of the facts he relies on; or

(b) in the case of an application under section 46(3)(a) by any other person, two copies of a draft of the licence he seeks; and

(c) where that other person is also an applicant for an order under section 46(3)(b) for the exchange of a licence, two copies of the licence sought to be exchanged.

(2) The comptroller shall, -

(a) in the case of an application by the proprietor, send a copy of Patents Form 2/77 and a copy of the documents filed under subparagraph (a) of paragraph (1) above to the person to whom the proprietor proposes to grant the licence; and

(b) in the case of an application by any other person, send a copy of Patents Form 2/77 and a copy of any documents filed under subparagraphs (b) or (c) of that paragraph to the proprietor.

(3) Within the period of six weeks beginning on the date when the documents are sent to him under paragraph (2) above, -

(a) in the case of an application by the proprietor, the person referred to in paragraph (2)(a) above may file a counter-statement setting out fully the grounds of his objection; and

(b) in the case of an application by any other person, the proprietor may file a statement setting out fully the grounds of his objection,

and, if he does so, at the same time shall send a copy of the statement or counter-statement, as the case may be, to the other party.

(4) Within the period of six weeks beginning on the date when a statement under paragraph (3)(b) above is sent to him, the person therein referred to may file a counter-statement; and, if he does so, he shall at the same time send a copy of the counter-statement to the proprietor.

(5) No further statement or counter-statement shall be served by either party without the leave or direction of the comptroller.

(6) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

#### **Application by proprietor under section 47(1) for cancellation of entry**

63. An application under section 47(1) shall be -

(a) made on Patents Form 30/77;

(b) accompanied by fees to the amount of the balance of all renewal fees which would have been payable if the entry had not been made; and

(c) advertised by the comptroller in the Journal.

#### **Application under section 47(3)**

64.-(1) An application under section 47(3) shall be -

- (a) made on Patents Form 2/77 within two months after the making of the relevant entry;
- (b) accompanied by a copy of the application supported by a statement in duplicate setting out fully the nature of the claimant's interest and the facts upon which he relies; and
- (c) advertised by the comptroller in the Journal.

(2) The comptroller shall send a copy of the application and statement to the proprietor of the patent.

#### **Opposition to cancellation of entry under section 47**

65.-(1) Within two months of the date of the advertisement in the Journal of an application under rule 63(c) or 64(1)(c), a person entitled to do so under section 47(6), may give notice to the comptroller of opposition to the application on Patents Form 15/77.

(2) The notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks.

(3) The comptroller shall send a copy of the notice and statement to the applicant for cancellation of the entry who, if he desires to proceed with the application, shall, within the period of two months beginning on the date when such copies are sent to him, file a counter-statement in duplicate setting out fully the grounds on which the opposition is contested and the comptroller shall send a copy of the counter-statement to the opponent.

(4) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

#### **Procedure after cancellation of entry pursuant to section 47(3)**

66. Where the comptroller cancels an entry in the register pursuant to section 47(3), he shall inform the proprietor of the patent who shall, within such period as the comptroller specifies, pay fees to the amount of the balance of all renewal fees which would have been payable if the entry had not been made.

#### **Declaration under paragraph 4A of Schedule 1 to the Act**

67.-(1) A declaration under paragraph 4A of Schedule 1 to the Act shall be made on Patents Form 58/77.

(2) The comptroller shall cause to be entered in the register notice of any declaration filed under the said paragraph 4A and the entry in the register shall be published in the Journal.

#### **COMPULSORY LICENCES**

##### **Application for compulsory licence under section 48(1), or revocation or cancellation under section 52(2)(a)**

68. An application under section 48(1) or 52(2)(a) shall be made on Patents Form 2/77 and shall be accompanied by a statement in duplicate of the facts upon which the applicant relies and evidence in duplicate verifying the statement.

##### **Application by Minister under section 51**

69. An application under section 51(1) for an order or entry under section 51(3) shall be made on Patents Form 2/77 and shall be accompanied by a statement in duplicate of the facts upon which the applicant relies and evidence in duplicate verifying the statement.



### **Procedure on receipt of application under section 48, 51 or 52**

70.-(1) If upon consideration of the evidence submitted under rule 68 (application for compulsory licence under section 48(1), or revocation or cancellation under section 52(2)(a)) or rule 69 (application by Minister under section 51), the comptroller is not satisfied that a prima facie case is made out for-

- (a) the making of an order or an entry, or
- (b) the revocation of an order or cancellation of an entry,

as the case may be, he shall notify the applicant accordingly, and unless, within one month of making such notification, the applicant requests to be heard in the matter, the comptroller shall refuse the application.

(2) Where the applicant requests a hearing within the time allowed, the comptroller, after giving the applicant the opportunity of being heard, shall determine whether the application may proceed or whether it shall be refused.

(3) If upon consideration of the evidence the comptroller is satisfied that a prima facie case has been made out for-

- (a) the making of an order or an entry, or
- (b) the revocation of an order or cancellation of an entry,

as the case may be, or if, after hearing the applicant, he so determines, he shall direct that the application shall be advertised in the Journal, and shall send a copy of the application, the statement and the evidence filed in support thereof-

- (c) where the application is under subparagraph (a), to the proprietor of the patent and to any other person shown on the register as having any right in or under the patent; or
- (d) where the application is under subparagraph (b), to any person shown on the register as having any right in or under the patent.

### **Opposition under section 52**

71.-(1) Within two months of the date of the advertisement in the Journal of an application under rule 70(3), any person may give notice to the comptroller of opposition under section 52(1) or 52(2)(b), as the case may be, to the application on Patents Form 15/77.

(2) The notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies, and the relief which he seeks, and evidence in duplicate verifying the statement.

(3) The comptroller shall send a copy of the notice, the statement and the evidence to the applicant who, if he desires to proceed with his application, shall within the period of six weeks beginning on the date when such copies are sent to him, file evidence in duplicate confined to matters strictly in reply and the comptroller shall send a copy thereof to the opponent.

(4) No further evidence shall be filed by either party except by leave or direction of the comptroller.

(5) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

## INFRINGEMENT PROCEEDINGS BEFORE COMPTROLLER

### **Procedure on reference to comptroller under section 61(3)**

72.-(1) A reference to the comptroller under section 61(3) shall be made by the parties to it on Patents Form 2/77, accompanied by a joint statement giving full particulars of the matters which are in dispute and of those on which they are in agreement, and the capacity in which each is a party to the reference.

(2) The procedure set out in paragraphs (3) to (9) of this rule shall apply unless the only matter stated in the reference to be in dispute is the validity of any patent or part of a patent.

(3) The party to the dispute who is the proprietor of the patent or an exclusive licensee of the patent (such party being referred to in this and the next following rule as the plaintiff) shall within 14 days of making the reference file a statement in duplicate giving full particulars of his case on the matters in dispute and the relief which he seeks.

(4) The comptroller shall send a copy of the plaintiff's statement to the other party to the dispute (referred to in this and the next following rule as the defendant), who shall, within the period of six weeks beginning on the date when such copy is sent to him, file a counter-statement in duplicate setting out fully the grounds on which he contests the plaintiff's case and the comptroller shall send a copy of the counter-statement to the plaintiff.

(5) If the defendant alleges in his counter-statement that the patent or any part of it alleged by the plaintiff to have been infringed is not valid, the plaintiff shall, within the period of six weeks beginning on the date when the counter-statement is sent to him, file a further statement in duplicate setting out fully the grounds on which he contests the defendant's allegation; and the comptroller shall send a copy of the further statement to the defendant.

(6) Subject to such directions as the comptroller may give, the plaintiff may, within the period of six weeks beginning on the date when the counter-statement is sent to him, or, if he has filed a further statement under paragraph (5) above, within the period of six weeks thereof, file evidence in support of his case and shall send a copy thereof direct to the defendant.

(7) Within the period of six weeks beginning on the date when the copy of the plaintiff's evidence is sent to him or, if the plaintiff does not file any evidence, within six weeks of the expiration of the time within which such evidence might have been filed, the defendant may file evidence in support of his case and shall send a copy of it to the plaintiff; and, within the period of six weeks beginning on the date when the copy of the defendant's evidence is sent to him, the plaintiff may file further evidence confined to matters strictly in reply and shall send a copy of it direct to the defendant.

(8) No further evidence shall be filed by either party except by leave or direction of the comptroller.

(9) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

### **Procedure where validity of patent in dispute**

73.-(1) Where the only matter stated in the reference made under section 61(3) to be in dispute is the validity of any patent or part of a patent the procedure set out in paragraphs (2) to (7) of this rule shall apply.

(2) The defendant shall, within 14 days of making the reference, file a statement in duplicate giving full particulars of the grounds on which he alleges that the patent or part of the patent is invalid and the relief which he seeks.

(3) The comptroller shall send a copy of the defendant's statement to the plaintiff, who shall, within the period of six weeks beginning on the date when the copy is sent to him, file a counter-statement in duplicate giving full particulars of the grounds on which he contests the defendant's allegations, and the comptroller shall send a copy of it to the defendant.

(4) Subject to such directions as the comptroller may think fit to give, the defendant may, within the period of six weeks beginning on the date when the copy of the plaintiff's counter-statement is sent to him, file evidence in support of his case, and shall send a copy of it to the plaintiff.

(5) Within the period of six weeks beginning on the date when the copy of the defendant's evidence is sent to him or, if the defendant does not file any evidence within six weeks of the expiration of the time within which such evidence might have been filed, the plaintiff may file evidence in support of his case and shall send a copy of it to the defendant; and, within the period of six weeks beginning on the date when the copy of the plaintiff's evidence is sent to him, the defendant may file further evidence confined to matters strictly in reply and shall send a copy of it to the plaintiff.

(6) No further evidence shall be filed by either party except by leave or direction of the comptroller.

(7) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

#### **Procedure on application under section 71**

74.-(1) An application to the comptroller under section 71 for a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate, setting out fully the facts upon which the applicant relies as showing that subparagraphs (a) and (b) of section 71(1) have been complied with and the relief which he seeks.

(2) The comptroller shall send a copy of the statement to the proprietor of the patent who shall, if he wishes to contest the application, within the period of six weeks beginning on the date when the copy is sent to him, file a counter-statement in duplicate setting out fully the ground on which he contests the applicant's case; and the comptroller shall send a copy thereof to the applicant.

(3) Subject to such directions as the comptroller may think fit to give, the applicant may, within the period of six weeks beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his application and shall send a copy thereof to the proprietor of the patent.

(4) Within the period of six weeks beginning on the date when the copy of the applicant's evidence is sent to him or, if the applicant does not file any evidence, within six weeks of the expiration of the time within which such evidence might have been filed, the proprietor of the patent may file evidence in support of his case and shall send a copy of that evidence to the applicant; and, within the period of six weeks beginning on the date when the copy of the proprietor's evidence is sent to him, the applicant may file further evidence confined to matters strictly in reply and shall send a copy of it to the proprietor.

(5) No further evidence shall be filed by either party except by leave or direction of the comptroller.

(6) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

#### **REVOCATION OF PATENTS**

#### **Procedure on application for revocation under section 72**

75.-(1) An application to the comptroller for the revocation of a patent shall be made on Patents Form 2/77 and shall be accompanied by a copy thereof and a statement in duplicate setting out fully the grounds of revocation, the facts upon which the applicant relies and the relief which he seeks.

- (2) The comptroller shall send a copy of the application and statement to the proprietor of the patent.
- (3) Within the period of six weeks beginning on the date when such copies are sent to him, the proprietor of the patent shall, if he wishes to contest the application, file a counter-statement in duplicate setting out fully the grounds upon which the application is contested; and the comptroller shall send a copy of the counter-statement to the applicant.
- (4) The applicant may, within the period of six weeks beginning on the date when the copy of the counter-statement is sent to him, file evidence in support of his case and shall send a copy of the evidence to the proprietor.
- (5) Within the period of six weeks beginning on the date when the copy of the applicant's evidence is sent to him or, if the applicant does not file any evidence, within six weeks of the expiration of the time within which such evidence might have been filed, the proprietor of the patent may file evidence in support of his case and shall send a copy of that evidence to the applicant; and, within the period of six weeks beginning on the date when the copy of the proprietor's evidence is sent to him, the applicant may file further evidence confined to matters strictly in reply and shall send a copy of it to the proprietor.
- (6) No further evidence shall be filed by either party except by leave or direction of the comptroller.
- (7) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

#### **Award of costs**

76. If, in proceedings before the comptroller under section 72, the proprietor of a patent offers to surrender it under section 29, the comptroller shall, in deciding whether costs should be awarded to the applicant for revocation, consider whether proceedings might have been avoided if the applicant had given reasonable notice to the proprietor before the application was filed.

#### **Revocation and amendment of patents under section 73**

77.-(1) The opportunity to be given by the comptroller under subsection (1) or (2) of section 73 to the proprietor of a patent to make observations and to amend the specification of the patent shall be given by the comptroller sending to the proprietor notice informing him that he may make the observations and amend the specification and that, if he wishes to do so, he must do so within three months after the notice is sent to him.

(2) Where the comptroller gives leave under section 73 for the specification of the patent to be amended, he may, before the specification is amended, require the applicant to file a new specification as amended, prepared in accordance with rules 16, 18 and 20.

#### **AMENDMENT OF PATENTS IN INFRINGEMENT OR REVOCATION PROCEEDINGS**

##### **Amendment of patent under section 75**

78.-(1) Where in any proceedings before the comptroller a proposed amendment to the specification of a patent made under section 75 is to be delivered to the comptroller it shall, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications.

(1A) If the comptroller requires it, notice that a proposal has been made to amend the specification of a patent shall be advertised in the Journal and the advertisement shall state that any person may apply to the comptroller for a copy of the proposed amendment.

(2) Within two months of the date of the advertisement in the Journal, any person may give the comptroller notice of opposition to the proposed amendment on Patents Form 15/77.

(3) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and statement to the proprietor of the patent and any other party to the proceedings before the comptroller.

(4) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

(5) Where the comptroller gives leave under section 75 for the specification of the patent to be amended, he may, before the specification is amended, require the applicant to file a new specification as amended, prepared in accordance with rules 16, 18 and 20.

## EUROPEAN PATENTS AND PATENT APPLICATIONS AND NATIONAL PROCESSING OF INTERNATIONAL APPLICATIONS

### Entries in the register

79. [Omitted by the Patents (Amendment) Rules 1999 (SI 1999 No. 1092).]

### European patents and applications (UK): translations

80. Schedule 4 shall have effect in cases where translations are required by the Act to be filed in connection with applications for, and with, European patents (UK).

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

81.-(1) The request referred to in section 81(2)(b)(i) shall be made in writing within three months of the date on which the applicant is notified by the European Patent Office that his application for a European patent (UK) has been deemed to be withdrawn and shall be accompanied by the said notification and by the prescribed fee, if any.

(2) At the same time as making the request referred to in paragraph (1) above, the applicant may also request that a copy of the European patent application, together with a copy of the above request, be sent by the comptroller in accordance with relevant provisions of the European Patent Convention to the central industrial property office of any specified Contracting State designated in the application.

(3) The applicant shall pay the filing fee referred to in section 81(2)(c) for the purposes of section 81(2)(b)(i) within two months of the date on which the comptroller receives the request mentioned in paragraph (1) above.

(4) The applicant shall also, within the period referred to in paragraph (3) above, for the purposes of section 15(5)(b), file Patents Form 9/77, and, for the purposes of section 13(2), file Patents Form 7/77.

### Procedure where section 81(2)(b)(ii) applies

82.-(1) Where section 81(2)(b)(ii) applies, the period within which a request may be transmitted to the comptroller shall be the twenty months calculated from the declared priority date or, where there is no declared priority date, the date of filing of the application for the European patent (UK).

(2) Upon receipt of the request, the comptroller shall notify the applicant thereof.

(3) The applicant shall pay the filing fee and file any necessary translation referred to in section 81(2)(c) for the purpose of section 81(2)(b)(ii) within four months of the date of the notification referred to in paragraph (2).

(4) The applicant shall also, within the period referred to in paragraph (3) above, for the purposes of section 15(5)(b), file Patents Form 9/77 and, for the purposes of section 13(2), file Patents Form 7/77.

#### **Procedure for making request for substantive examination where section 81(2) applies**

83.-(1) The period within which a request may be made to the comptroller for substantive examination of any application for a patent to which section 81(2) applies shall be two years from the declared priority date or, where there is no declared priority date, the date of filing of the application for the European patent (UK).

(2) The request shall be made on Patents Form 10/77.

(3) The periods prescribed for the purposes of sections 18(4) and 20(1) by paragraphs (1)(a), (1A) (insofar as paragraph (1A) applies to paragraph (1)(a)) and (2) of rule 34 above shall also apply to an application for a European patent (UK) which is to be treated as an application for a patent under the Act, except that any reference to the date of filing of the application in paragraph (1)(a) of the said rule 34 shall be taken to refer to the date of filing of the application for the European patent (UK).

#### **Recognition of determinations in proceedings before comptroller**

84. Any person seeking recognition in proceedings before the comptroller of a determination by a competent authority of a relevant contracting state other than the United Kingdom of a question to which section 82 applies shall furnish the comptroller with a copy thereof certified as a true copy by an official of the said authority.

#### **International applications for patents: sections 89 and 89A**

85.-(1) Subject to the provisions of this rule, in relation to an international application for a patent (UK) which is, under section 89, to be treated as an application for a patent under the Act, the prescribed period for the purposes of section 89A(3) and (5) is thirty one months calculated from the date which, by virtue of section 89B(1)(b), is to be treated as the declared priority date or, where there is no declared priority date, the date of filing of the international application for a patent (UK).

(2) Where, in accordance with paragraph 1 of Schedule 2, the information specified in subparagraphs (2)(a)(ii) and (iii) of that paragraph is added to an international application for a patent (UK) after the international filing date, rule 113(1) shall not apply in respect of that information; and where the translation of the information, the filing of which is required to satisfy the relevant conditions of section 89A(3), has not been filed at the Patent Office before the end of the period referred to in paragraph (1) above,-

(a) the comptroller shall give notice to the applicant at the address furnished by the applicant in accordance with rule 30 requiring the applicant to file the translation within the period of three months commencing on the day on which the notice is sent; and

(b) the period referred to in paragraph (1) above shall be treated in respect of the translation as not expiring until the end of the period specified in the notice given under subparagraph (a) above.

(3) In the case of an international application for a patent (UK),-

(a) rule 5(1) shall not apply if the applicant, on filing the application, states in writing to the receiving office that the invention has been displayed at an international exhibition;

(b) an applicant may comply with rule 5(2) at any time before the end of the period of thirty-two months after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK); and

- (c) where a translation into English of a document or part of a document is required by the Act or these Rules to be filed before the end of the period referred to in paragraph (1) above, verification of the translation, as required by rule 113(1), may be given to the comptroller at any time before the end of the period of thirty-two months after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK).
- (4) Where the period referred to in paragraph (1) above has been extended under paragraph (5A) below, rule 100 or rule 110 so as to expire later than one month before the end of a period prescribed by paragraph (3) above or (7) below, paragraphs (3) above and (7) below shall have effect with the substitution for the period so prescribed of a period ending one month later than the period referred to in paragraph (1) above as so extended.
- (5) For the purposes of section 89A(3) and (5), to the extent that the application and any amendment as published under the Patent Co-operation Treaty and any amendment annexed to the international preliminary examination report under Chapter II of the Treaty are not in English, a translation into English of the application as originally filed or, as the case may be, of the application as originally filed and of the amendment is necessary; however, the translation-
- (a) shall exclude the request and abstract unless-
    - (i) the applicant expressly requests the comptroller to proceed earlier than the expiry of the period prescribed in paragraph (1) above; and
    - (ii) a copy of the application published by the International Bureau has not yet been sent to the Patent Office in accordance with the Treaty; and
  - (b) shall include any textual matter in the drawings in a form which complies with rule 49.5(d) of the Patent Co-operation Treaty; and,
  - (c) where a title has been established by the International Searching Authority under rule 37.2 of the Regulations under the Patent Co-operation Treaty which differs from the title included in the application as originally filed, shall include the former title in place of the latter; and
  - (d) may exclude any textual matter contained in a sequence listing forming part of the description if such textual matter complies with Rule 12.1(d) of the said Regulations and the description complies with Rule 5.2(b) of the said Regulations.
- (5A) Where an applicant is required to file a translation into English both of an application as originally filed and of the amendment to it, in accordance with paragraph (5) above, in order to satisfy the relevant conditions of section 89A(3) and (5) and at the expiry of the period referred to in paragraph (1) above the prescribed fee has been paid and one but not both of the necessary translations has been filed-
- (a) the comptroller shall give notice to the applicant at the address furnished by the applicant in accordance with rule 30 requiring the applicant to file the required translation within the period of three months commencing on the day on which the notice is sent; and
  - (b) the period referred to in paragraph (1) above shall be treated in respect of that translation as not expiring until the end of the period specified in the notice given under subparagraph (a) above.
- (6) Payment of the fee prescribed under section 89A(6) shall be accompanied by a request in writing by the applicant for publication under that subsection.
- (7) In the case of an international application for a patent (UK) in respect of which the conditions specified in section 89A(3)(a) are satisfied, the period prescribed for the purposes of sections 13(2), 15(5)(b), 17(1) and 18(1) shall be the period which expires thirty two months after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK).

(7A) In the case of an international application for a patent (UK) in respect of which the conditions specified in section 89(A)(3)(b) are satisfied, the period prescribed-

(a) for the purposes of section 13(2), shall be the period prescribed by rule 15(1) or two months from the date on which the said conditions are satisfied, whichever expires the later;

(b) for the purposes of sections 15(5)(b) and 17(1), shall be the period prescribed by rule 25(2) or two months from the date on which the said conditions are satisfied, whichever expires the later; and

(c) for the purposes of section 18(1), shall be the period prescribed by paragraph (7) above.

(8) Where, in relation to an international application for a patent (UK), the applicant desires that section 89(1) shall not cease to apply to the application by virtue of the operation of section 89(3), application in writing to that effect shall be made to the comptroller including a statement of the facts upon which the applicant relies, accompanied by the prescribed fee, if any.

(9) An international application for a patent (UK) shall not be treated as withdrawn under the Act if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Patent Co-operation Treaty where, in the same or comparable circumstances in relation to an application under the Act (other than an international application)-

(a) the comptroller could have directed that an irregularity be rectified under rule 100, or could have granted a dispensation for the doing of any act or thing, or the production or filing of any document under rule 101, or could have granted an extension of time under rule 110, or could have extended the time or determined the times or periods under rule 111; and

(b) the comptroller determines that the application would not have been treated as withdrawn under the Act.

(10) Where under section 89(3) an application is not to be treated as withdrawn and the applicant wishes to proceed-

(a) the comptroller may amend any document received by the Patent Office from the receiving office or the International Bureau and alter any period or time which is specified in the Act or these Rules upon such terms (including payment of any appropriate prescribed fee) as he may direct; and

(b) the fee prescribed under section 89A(3) shall not be payable.

(11) Where the applicant satisfies the comptroller that,-

(a) because of an error made by the receiving office, an international application for a patent (UK) has been accorded a date of filing which is not correct; or

(b) the priority claim made under Article 8(1) of the Patent Co-operation Treaty has been considered not to have been made by the receiving office or the International Bureau because of an error made by the office or the Bureau,

the comptroller may amend any document received by the Patent Office from the receiving office or the International Bureau or alter any period or time which is specified in the Act or these Rules as if the error were an error on the part of the Patent Office.

(12) Where-

(a) an international application for a patent (UK) purports to designate the United Kingdom; and



(b) the applicant alleges that he has been refused a filing date under the said Treaty on account of an error or omission in any institution having functions under the said Treaty,

the applicant may apply in writing to the comptroller for the international application to be treated as an application under the Act by filing a statement of the facts upon which he relies accompanied by the prescribed fee, if any; and the comptroller may amend any document filed by the applicant and alter any period or time which is specified in the Act or these Rules upon such terms as he may direct.

(13) In this rule "receiving office" has the same meaning as in the Patent Co-operation Treaty.

### **Obtaining evidence for proceedings under European Patent Convention**

86.-(1) An application to the comptroller under section 1 of the Evidence (Proceedings in Other Jurisdictions) Act 1975, as applied by section 92 of the Act, for an order for evidence to be obtained in the United Kingdom shall be made ex parte in writing and shall be accompanied by-

(a) an affidavit made by a person duly authorised in that behalf by the relevant convention court, evidencing that the request is made in pursuance of a request issued by or on behalf of that court and that the evidence to which the application relates is to be obtained for the purposes of civil proceedings before it; and

(b) the prescribed fee, if any.

(2) After such an application as is mentioned in paragraph (1) above has been made, an ex parte application for a further order or directions in relation to the same matter may be made to the comptroller in writing.

(3) The comptroller may allow an officer of the European Patent Office to attend the hearing of such an application as is mentioned in paragraph (1) above and examine the witnesses or request the comptroller to put specified questions to them.

### **Communication of information to European Patent Office**

87. The comptroller may authorise the communication to the European Patent Office or the competent authority of any country which is party to the European Patent Convention of such information in the files of the Patent Office as may be disclosed in accordance with section 118 and rule 93.

## **HEARINGS, AGENTS AND CORRECTION OF ERRORS**

### **Comptroller's discretionary powers**

88.-(1) Before exercising any discretionary power vested in him by or under the Act adversely to any party to a proceeding before him, the comptroller shall, unless he considers a different period is appropriate, give that party at least fourteen days' notice of the time when he may be heard.

(1A) At any stage of any proceedings before the comptroller, he may direct that the party or parties to the proceedings attend a case management conference at which he may give such directions as he may think fit with regard to the management of the proceedings. The comptroller shall give the party or parties at least fourteen days notice of the date of the case management conference.

(1B) Before hearing any party or parties that desire to be heard in any proceedings before him, the comptroller may direct that the party or parties attend a pre-hearing review at which he may give such directions as he may think fit with regard to the management of the hearing. The comptroller shall give the party or parties at least fourteen days notice of the date of the pre-hearing review.

(2) If, in any proceedings, a party desires to be heard, he shall give notice in writing to the comptroller, and the comptroller may refuse to hear any party who has not given such notice before the day appointed for the hearing.

(3) In any proceedings, any party who intends to refer at the hearing to any document (other than a report of a decision of any court or of the comptroller) not already mentioned in the proceedings shall, unless the comptroller consents and the other party agrees, give at least fourteen days' notice of his intention with details of, or a copy of, the document to the comptroller and the other party.

(4) After hearing the party or parties desiring to be heard or, if no party so desires, without a hearing, the comptroller shall decide the matter and shall notify all parties of his decision and, if any party so desires, shall give his reasons for the decision.

#### **Admittance to hearings before comptroller**

89.-(1) Subject to the following provisions of this rule, where a hearing before the comptroller of any dispute between two or more parties relating to any matter in connection with a patent or an application for a patent takes place after the publication of the application under section 16, the hearing of the dispute shall be in public.

(2) After consulting those parties to the dispute who appear in person or are represented at a hearing to which paragraph (1) above applies, the comptroller may direct that the hearing be not held in public, but without prejudice to paragraph (3) below.

(3) A member of the Council on Tribunals or of its Scottish Committee may, in his capacity as such, attend such a hearing or any other hearing before the comptroller under these Rules.

#### **Agents**

90.-(1) Unless the comptroller otherwise directs in any particular case-

(a) all attendances upon him may be made by or through an agent; and

(b) every notice, application or other document filed under the Act may be signed by an agent.

(2) Where after a person has become a party to proceedings before the comptroller he appoints -

(a) an agent for the first time, the newly appointed agent shall file Patents Form 51/77 on or before the first occasion when he acts as agent; or

(b) one agent in substitution for another, the newly appointed agent shall file in duplicate Patents Form 51/77 on or before the first occasion when he acts as agent and the comptroller shall send one copy of the form to the previously appointed agent.

#### **Correction of errors in patents and applications**

91.-(1) Except where rule 45(3) or paragraph 4 of Schedule 4 has effect, a request for the correction of an error of translation or transcription or of a clerical error or mistake in any specification of a patent, in an application for a patent or in any document filed in connection with a patent or such an application shall be made on Patents Form 11/77 clearly identifying the proposed correction; and the comptroller may, if he thinks fit, require that the correction be shown on a copy of the document of which correction is sought.

(2) Where such a request relates to a specification, no correction shall be made therein unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

(3) Where the comptroller requires notice of the proposed correction to be advertised, he shall advertise the request and the nature of the proposed correction in the Journal.

(4) At any time within two months after the date of the advertisement, any person may give notice to the comptroller of opposition to the request on Patents Form 15/77.

(5) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts on which the opponent relies and the relief which he seeks.

(6) The comptroller shall send a copy of the notice and the statement to the person making the request who, if he desires to proceed with the request, shall within the period of two months beginning on the date when the copies are sent to him, file a counter-statement in duplicate setting out fully the grounds on which he contests the opposition and the comptroller shall send a copy of the counter-statement to the opponent.

(7) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

## INFORMATION AND INSPECTION

### **Request for information under section 118**

92.-(1) A request under section 118 for information relating to any patent or application for a patent may be made-

(a) as to when a request for substantive examination has been filed or the prescribed period for doing so has expired without the request having been filed;

(b) as to when the specification of a patent or application for a patent has been published;

(c) as to when an application for a patent has been withdrawn, has been taken to be withdrawn, has been treated as having been withdrawn, has been refused or has been treated as having been refused;

(d) as to when a renewal fee has not been paid within the period prescribed for the purposes of section 25(3);

(e) as to when a renewal fee has been paid within the period of six months referred to in section 25(4);

(f) as to when a patent has ceased to have effect and/or an application for restoration of a patent has been filed;

(g) as to when an entry has been made in the register or an application has been made for the making of such entry;

(h) as to when any application or request is made or action taken involving an entry in the register or advertisement in the Journal, if the nature of the application, request or action is specified in the request; and

(i) as to when any document may be inspected in accordance with the provisions of rule 93 or 94.

(2) As regards information relating to any existing patent or existing application for a patent, a request may also be made-

(a) as to when a complete specification following a provisional specification has been filed or when the period of fifteen months from the date of the application has expired and a complete specification has not been filed;

(b) as to when a complete specification is or will be published, or when an application for a patent has become void, and

(c) as to when a patent has been sealed or when the time for requesting sealing has expired.

(3) Any such request shall be made on Patents Form 49/77 and a separate form shall be used in respect of each item of information required.

(4) In this rule, "existing patent" means a patent mentioned in section 127(2)(a) and (c) and "existing application" means an application mentioned in section 127(2)(b).

### **Inspection of documents under section 118**

93.-(1) Subject to paragraph (5) below, and to the restrictions prescribed in paragraph (4) below, after the date of publication of an application for a patent in accordance with section 16, the comptroller shall, upon request and payment of the prescribed fee, if any, permit all documents filed or kept at the Patent Office in relation to the application or any patent granted in pursuance of it, to be inspected at the Patent Office.

(2) Subject to the same restrictions and to rule 96, where the circumstances specified in section 118(4) or (5) exist, the comptroller shall, upon request and payment of the prescribed fee, if any, permit inspection of such documents before the publication in accordance with section 16.

(3) Where a declaration has been made in accordance with section 5(2) or 127(4), inspection of any application referred to therein and of any translation thereof shall be permitted upon request under paragraph (1) or (2) above without payment of any fee.

(4) The restrictions referred to in paragraph (1) above are-

(a) that no document shall be open to inspection until fourteen days after it has been filed at the Patent Office;

(b) that documents prepared in the Patent Office solely for use therein shall not be open to inspection;

(c) that any document sent to the Patent Office, at its request or otherwise, for inspection and subsequent return to the sender, shall not be open to inspection;

(d) that no document filed at the Patent Office in connection with an application under section 40(1) or (2) or section 41(8) shall be open to inspection unless the comptroller otherwise directs;

(e) that no request made under rule 48, 49(2), 52(2) or 92 or this rule shall be open to inspection;

(f) that documents in respect of which the comptroller issues directions under rule 94 that they are to be treated as confidential shall not be open to inspection, save as permitted in accordance with that rule; and

(g) that any documents issued by the Patent Office which the comptroller considers should be treated as confidential shall not be open to inspection unless the comptroller otherwise directs.

(5) Nothing in this rule shall be construed as imposing on the comptroller any duty of making available for public inspection-

(a) any document or any part of a document-

(i) which in his opinion disparages any person in a way likely to damage him; or

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

(b) the file (but not the report) of the international preliminary examination of an international application under the Patent Co-operation Treaty; or

(c) any document filed with or sent to or by the Patent Office before 1st June 1978.

(6) No appeal shall lie from a decision of the comptroller under paragraph (5)(a) above not to make a document or part of a document available for public inspection.

### **Confidential documents**

94.-(1) A person filing at, or sending to, the Patent Office, a document other than a Patents Form, or any party to any proceedings to which the document relates, may, within fourteen days of the filing or sending of the document, request the comptroller (giving reasons for the request) to direct that the document or any part of it specified by him be treated as confidential, and the comptroller may, at his discretion, so direct; and while the request is being considered by the comptroller, that document or part thereof (hereinafter referred to as the relevant document) shall not be open to public inspection.

(2) Where such a direction has been given and not withdrawn, nothing in this rule shall be taken to authorise or require any person to be allowed to inspect the relevant document to which the direction relates except by leave of the comptroller.

(3) The comptroller shall not withdraw any direction given under this rule nor shall he give leave for any person to inspect any relevant document to which a direction which has not been withdrawn relates without prior consultation with the person at whose request the direction was given, unless the comptroller is satisfied that such prior consultation is not reasonably practicable.

(4) Where such a direction is given or withdrawn a record of the fact shall be filed with the relevant document to which it relates.

(5) Where the period referred to in paragraph (1) above is extended under rule 110, the relevant document shall not be, or, if the period is extended after it has expired, shall cease to be, open to public inspection until the expiry of the extended period, and if a request for a direction is made the relevant document shall not be open to public inspection while the matter is being determined by the comptroller.

### **Bibliographic data for purposes of section 118(3)(b)**

95. The following bibliographic data is prescribed for the purposes of section 118(3)(b)-

(a) the number of the application;

(b) the date of filing of the application and, where a declaration has been made under section 5(2) or 127(4), the filing date, country and file number when available of each application referred to in that declaration;

(c) the name of the applicant or applicants;

(d) the title of the invention; and

(e) if the application has been withdrawn, has been taken to be withdrawn, has been treated as having been withdrawn, has been refused or is treated as having been refused, that fact.

**Request for information where section 118(4) applies**

96.-(1) Where the circumstances specified in section 118(4) exist, a request under section 118(1) shall be accompanied by a statutory declaration verifying their existence and such documentary evidence (if any) supporting the request as the comptroller may require.

(2) The comptroller shall send a copy of the request, the declaration and the evidence (if any) to the applicant for the patent and shall not comply with the request until the expiry of fourteen days thereafter.

**MISCELLANEOUS****Service by post**

97. Any notice, application or other document sent to the Patent Office by posting it in the United Kingdom shall be deemed to have been given, made or filed at the time when the letter containing it would be delivered in the ordinary course of post.

**Hours of business**

98. The Patent Office shall be deemed to be closed at the following hours for the transaction of business of the classes specified-

(a) on weekdays other than Saturdays, at midnight for the filing of applications, forms and other documents, and at 5 pm for all other business; and

(b) on Saturdays, at 1 pm for the filing of new applications for patents in respect of which no declaration for the purposes of section 5(2) or 127(4) is made.

**Excluded days**

99.-(1) The following shall be excluded days for all purposes under the Act-

(a) all Sundays;

(b) Good Friday and Christmas Day;

(c) any day specified as or proclaimed to be a bank holiday in England in or under section 1 of the Banking and Financial Dealings Act 1971; and

(d) any Saturday immediately preceded by one of the above.

(2) Saturdays not falling within paragraph (1) above shall be excluded days for all purposes except the filing of applications in respect of which no declaration for the purposes of section 5(2) is made.

(3) Tuesday 4th January 2000 shall be an excluded day for all purposes under the Act.

**Correction of irregularities**

100.-(1) Subject to paragraph (2) below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct.

(2) In the case of an irregularity or prospective irregularity-

(a) which consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968 as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;

(b) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and

(c) which it appears to the comptroller should be rectified,

the comptroller may direct that the time or period in question shall be altered but not otherwise.

(3) Paragraph (2) above is without prejudice to the comptroller's power to extend any times or periods under rule 110 or 111.

### **Dispensation by comptroller**

101. Where, under these Rules, any person is required to do any act or thing, or any document or evidence is required to be produced or filed, and it is shown to the satisfaction of the comptroller that from any reasonable cause that person is unable to do that act or thing, or that document or evidence cannot be produced or filed, the comptroller may, upon the production of such evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing, or the production or filing of such document or evidence.

### **Remission of fees**

102.-(1) The comptroller may remit the whole or part of a search fee in the following cases-

(a) where an international application for a patent (UK) which has already been the subject of a search by the International Searching Authority in accordance with the Patent Co-operation Treaty falls to be treated as an application for a patent under the Act; and

(b) where a new application is filed in accordance with section 15(4) for a patent for an invention in relation to which the applicant has previously paid the search fee in connection with the earlier application referred to in that subsection.

(2) In cases falling within paragraph (1)(b) above a request for remission of the whole or part of the fee shall be made in writing by the applicant to the comptroller.

(3) No appeal shall lie from any decision of the comptroller under this rule.

### **Evidence**

103.-(1) Where under these Rules evidence may be filed, it shall be by statutory declaration, witness statement or affidavit.

(2) The comptroller may if he thinks fit in any particular case take oral evidence in lieu of or in addition to such evidence and shall allow any witness to be cross-examined on his affidavit, witness statement or declaration, unless he directs otherwise.

(3) In England and Wales, the comptroller shall, in relation to the giving of evidence (including evidence on oath), the attendance of witnesses and the discovery and production of documents, have all the powers of a judge of the High Court, other than the power to punish summarily for contempt of court.

(4) In Scotland, the comptroller shall, in relation to the giving of evidence (including evidence on oath), have all the powers which a Lord Ordinary of the Court of Session has in an action before him, other than the power to punish summarily for contempt of court, and, in relation to the attendance of witnesses and the recovery and production of documents, have all the powers of the Court of Session.

(5) The comptroller may give a direction as he thinks fit in any particular case that evidence shall be given by affidavit or statutory declaration instead of or in addition to a witness statement.

(6) Where in proceedings before the comptroller, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the comptroller may, if he thinks fit, permit any other party to the proceedings to call that person as a witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.

### **Statutory declarations and affidavits**

104. Any statutory declaration or affidavit filed under the Act or these Rules shall be made and subscribed as follows-

(a) in the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceedings;

(b) in any other part of Her Majesty's dominions or in the Republic of Ireland, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of any legal proceedings; and

(c) elsewhere, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or before a notary public, judge or magistrate.

### **Witness Statements**

104A. Any witness statement filed under these Rules shall-

(a) be a written statement signed and dated by a person which contains the evidence which the person signing it would be allowed to give orally; and

(b) include a statement by the intended witness that he believes the facts in it are true.

### **Admission of documents**

105. Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by the last foregoing rule to take a declaration, in testimony that the declaration was made and subscribed before him, may be admitted by the comptroller without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

### **Directions as to the furnishing of documents etc**

106. At any stage of any proceedings before the comptroller he may direct that such documents, information or evidence as he may require shall be furnished within such period as he may fix.



### **Supporting statements or evidence**

107.-(1) Where by virtue of any of the rules mentioned in paragraph (2) of this rule, any notice or application is required to be supported by a statement or evidence, such a statement or evidence shall be filed on, or within fourteen days after, the date on which the notice is given or the application is made.

(2) The rules referred to in paragraph (1) above are rules 40(3), 41(1), 43(3), 64(1)(b), 65(2), 71(2), 78(3) and 91(5).

### **Proceedings in Scotland**

108.-(1) Where there is more than one party to the proceedings under section 8, 12, 37, 40(1) or (2), 41(8), 61(3), 71 or 72, any party thereto may request the comptroller to direct that the hearing or hearings, if any, in such proceedings shall be held in Scotland and-

(a) the comptroller shall so direct in the following cases -

- (i) where one party resides in Scotland and all parties to the proceedings agree to the hearing or hearings, if any, being held there; or
- (ii) where all the parties to the proceedings reside in Scotland and one of them requests the hearing or hearings, if any, to be held there and the comptroller is satisfied that it would not be unduly burdensome to any other party to hold the hearing or hearings there; and

(b) the comptroller may direct that the hearing or hearings, if any, be held in Scotland (even where none of the parties resides in Scotland) where one party to the proceedings requests it and he is satisfied that the balance of convenience is in favour of holding the hearing or hearings there.

(2) A request under paragraph (1) above shall be made in duplicate and shall-

(a) be in writing;

(b) be accompanied by a statement of facts in duplicate setting out the grounds upon which the request is made; and

(c) be filed at any time before the comptroller issues notification to the parties that the hearing or hearings have been appointed, or, with the leave of the comptroller, within fourteen days thereafter.

(3) The comptroller, upon a request being made under paragraph (1) above, shall send a copy of the request and the statement to any party to the proceedings who has not indicated that he consents to the request.

(4) Any party or parties to the proceedings having objection to a request made under paragraph (1) above may, within one month after notification of the request is sent to him, file at the Patent Office a counter-statement in duplicate setting out the grounds upon which objection is taken, and the comptroller shall send a copy of the counter-statement to any person who is not party to it.

(5) The comptroller may give such directions as he may think fit with regard to the subsequent procedure.

(6) No appeal shall lie from any decision of the comptroller under this rule.

### **Appointment of advisers**

109. The comptroller may appoint an adviser to assist him in any proceeding before the comptroller and shall settle the question or instructions to be submitted or given to such adviser.

### **Alteration of time limits**

110.-(1) The times or periods prescribed by these Rules for doing any act or taking any proceeding thereunder, other than times or periods prescribed in the provisions mentioned in paragraph (2) below, and subject to paragraphs (3) and (4) below, may be extended by the comptroller if he thinks fit, upon such notice to the parties and upon such terms as he may direct; and such extension may be granted notwithstanding that the time or period for doing such act or taking such proceeding has expired.

(2) The provisions referred to in paragraph (1) above are rules 6(1), 26 (so far as it relates to rule 6(1)), 39(1) and (2), 40(2), 41(1), 43(2), 59(2), 64(1), 65(1), 71(1), 78(2), 81(1), 82(1) and 91(4) and paragraphs 5(2) and 5(4) of Schedule 2.

(2A) A time or period prescribed in rules 7(3), (4) and (5), 8(3), (5), (6) and (7), 9(2), 12(2), 13(2), 14(3), 40(4), 43(4), 54(3), (4) and (5), 56, 57(1), 58(2), 59(3), (4) and (5), 62(3) and (4), 70(1), 71(3), 72(3), (4), (5), (6) and (7), 73(3), (4) and (5), 74(2), (3) and (4), 75(3), (4) and (5), 77(1), 88(1) and (3), 88(1A) and (1B) for doing any act or taking any proceeding thereunder, may be shortened by the comptroller if he thinks fit, upon such notice to the parties and upon such terms as he may direct.

(3) A time or period prescribed in rules 6(2), 15(1), 23, 25(2) and (3) (except so far as it relates to the filing of claims for the purposes of the application and filing of the abstract), 26 (except so far as it relates to rule 6(1)), 33(2), (3) and (5), 34, 41(4), 81(3) and (4), 82(3) and (4), 83(3) and 85(1), (5A), (7) and (7A), paragraph 1(3) of Schedule 2 and paragraph 2 of Schedule 4 shall, if not previously extended, be extended for one month upon filing Patents Form 52/77 before the end of that month; and where in any proceedings more than one such time or period expires on the same day (but not otherwise), those times or periods may be extended upon the filing of a single such form.

(4) Without prejudice to paragraph (3) above, a time or period prescribed in the rules referred to in that paragraph may, upon request made on Patents Form 52/77, be extended or further extended if the comptroller thinks fit, whether or not the time or period (including any extension obtained under paragraph (3) above) has expired; and the comptroller may allow an extension, or further extension, under this paragraph on such terms as he may direct and subject, unless he otherwise directs, to the furnishing of a statutory declaration or affidavit verifying the grounds for the request.

(5) A single request may be made under paragraph (4) above for the extension of more than one time or period in the same proceedings if the extensions are to be made to a common date (but not otherwise).

(6) If on consideration of a request under paragraph (4) above the comptroller decides that the extension requested (or, in a case falling within paragraph (5) above, any or all of the extensions requested) may be granted he shall notify the applicant accordingly and invite him, within two months after the notification is sent to him, to file Patents Form 53/77, upon receipt of which the comptroller shall effect the extension or extensions in accordance with the decision.

(7) Where the period within which any party to a dispute may file evidence under these Rules is to begin after the expiry of any period in which any other party may file evidence under these Rules and that other party notifies the comptroller that he does not wish to file any, or any further, evidence, the comptroller may direct that the period within which the first-mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

### **Calculation of times or periods**

111.-(1) Where, on any day, there is -

- (a) a general interruption or subsequent dislocation in the postal services of the United Kingdom; or
- (b) an event or circumstances causing an interruption in the normal operation of the Patent Office,

the comptroller may certify the day as being one on which there is an "interruption" and, where any period of time specified in the Act or these Rules for the giving, making or filing of any notice, application or other document expires on a day so certified the period shall be extended to the first day next following (not being an excluded day) which is not so certified.

(2) Any certificate of the comptroller given pursuant to this rule shall be posted in the Patent Office.

(3) Where, in or in connection with an application for a patent ("the application in suit"), it is desired to make a declaration specifying for the purposes of section 5(2) an earlier relevant application and the period of twelve months immediately following the date of filing the earlier relevant application ends on a day which is an excluded day for the purposes of section 120, such period shall, if the declaration is made on the first following day on which the Patent Office is open for the transaction of such business, be altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration is made in or in connection with the application in suit.

(4) Where it is desired to make such a declaration and the said period of twelve months immediately following the date of filing the earlier relevant application ends on a day certified under paragraph (1) above as being one on which there is an interruption, the period shall, if the declaration is made on the first day following the end of the interruption, be altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration is made in or in connection with the application in suit.

(5) Where an application for a patent is filed upon the day immediately following a day which is certified under paragraph (1) above as being one on which there is an interruption or which is an excluded day for the purposes of section 120, the period of six months specified in section 2(4) shall be computed from the day following the next preceding day which is neither so certified nor so excluded.

(6) If in any particular case the comptroller is satisfied that the failure to give, make or file any notice, application or other document within-

(a) any period of time specified in the Act or these Rules for such giving, making or filing;

(b) the period of six months following a disclosure of matter constituting an invention falling within paragraph (a), (b) or (c) of section 2(4); or

(c) the period of twelve months referred to in paragraph (3) above,

was wholly or mainly attributable to a failure or undue delay in the postal services in the United Kingdom, the comptroller may, if he thinks fit-

(i) extend the period of time for the giving, making or filing so that it ends on the day of the receipt by the addressee of the notice, application or other document (or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day);

(ii) determine that the period of six months referred to in subparagraph (b) above shall be altered so that it begins on the day of the disclosure and ends on the day of receipt by the Patent Office of the application for the patent (or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day); or

(iii) determine that the period of twelve months referred to in paragraph (3) above shall be altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration specifying that application is received by the Patent Office (or, if the day of such receipt is an excluded day, the first following day which is not an excluded day),

as the case may be, in each case upon such notice to other parties and upon such terms as he may direct.

### **Copies of documents**

112. Where a document, other than a published United Kingdom specification or application, is referred to in any reference, notice, statement, counter-statement or evidence required by the Act or these Rules to be filed at the Patent Office or sent to the comptroller, copies of the document shall be furnished to the Patent Office within the same period as the reference, notice, statement, counter-statement or evidence in which they are first referred to may be filed and in the following number-

(a) where the document in which they were so referred to had to be filed or sent in duplicate or the original document had to be accompanied by a copy thereof, in duplicate; and

(b) in all other cases, one:

Provided that where a copy of any evidence is required by the Act or these Rules to be sent direct to any person, a copy of any document referred to in that document shall also be sent direct to that person.

### **Translations**

113.-(1) Subject to the provisions of rules 6, 40, 81, 82 and 85, paragraph (3) below and paragraph 5 of Schedule 4, where any document or part of a document which is in a language other than English is filed at the Patent Office or sent to the comptroller in pursuance of the Act or these Rules, it shall be accompanied by a translation into English of the document or that part, verified to the satisfaction of the comptroller as corresponding to the original text. Where the document is or forms part of an application for a patent, the Patent Office shall not, in the absence of such a translation, take any further action in relation to that document, unless the comptroller otherwise directs.

(2) Where more than one copy of that document is required to be so filed or sent, a corresponding number of copies of the translation shall accompany it.

(3) Where any document which, or any part of which, is in a language other than English-

(a) is referred to in a search report drawn up under Article 18 of the Patent Co-operation Treaty; or

(b) is cited in the statement contained in an international preliminary examination report established under Article 35 of that Treaty,

and any such report is filed at the Patent Office in relation to the provisions of section 89A, a translation into English of that document or part verified to the satisfaction of the comptroller as corresponding to the original text thereof shall, if the comptroller so directs, be filed within two months of the date on which such direction is given.

(4) Where proceedings are instituted before the comptroller in relation to a European patent (UK) the specification of which was published in French or German, the party who institutes those proceedings shall furnish to the Patent Office a translation into English of the specification of the patent verified to the satisfaction of the comptroller as corresponding to the original text thereof unless-

(a) such a translation has already been filed under section 77(6); or

(b) the comptroller determines that it is not necessary.

(5) If, in the course of such proceedings, leave is given for the amendment of the specification of the European patent (UK), the party given leave to amend shall furnish to the Patent Office a translation of the amendment into the language in which the specification of the patent was published, verified to the satisfaction of the comptroller as corresponding to the original text thereof.

(6) The comptroller may refuse to accept any translation which is in his opinion inaccurate and thereupon another translation of the document in question verified as aforesaid shall be furnished, together with the appropriate number of copies thereof.

#### **Publication and sale of documents**

114. The comptroller may arrange for the publication and sale of copies of specifications and other documents in the Patent Office and of indexes to, and abridgements or abstracts of, such documents.

#### **The Journal**

115. The comptroller shall publish a journal containing particulars of applications for patents and other proceedings under the Act and any other information he may deem to be generally useful or important.

#### **Reports of cases**

116. The comptroller shall from time to time publish reports of

(a) cases relating to patents, trade marks, registered designs and design right decided by him; and

(b) 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),

being cases which he considers to be generally useful or important.

### **INTERNATIONAL APPLICATIONS**

#### **Filing of applications**

117.-(1) Where the Patent Office is the competent receiving Office under the Patent Co-operation Treaty, an international application shall be filed at it in English in triplicate.

(2) If less than three copies of the international application are so filed, upon preparation by the Patent Office of the number of copies of it required to bring the total to three, the applicant shall on demand pay to the Patent Office the appropriate charge.

#### **Transmittal and late payment fees**

118.-(1) Subject to paragraph (3) below, payment of a prescribed transmittal fee referred to in rule 14.1 of the Regulations under the Patent Co-operation Treaty shall be made to the Patent Office as the competent receiving Office under the said Treaty.

(2) Where in accordance with Rule 19.4(a) of the said Regulations, an international application is considered to have been received by the Patent Office on behalf of the International Bureau as receiving Office, the transmittal of the application by the Patent Office shall be subject to the payment of a fee as provided by Rule 19.4(b) of the said Regulations.

(3) Where the Patent Office as the competent receiving Office under the said Treaty issues an invitation pursuant to rule 16 bis.1(a) or rule 16 bis.1(b) of the said Regulations, that invitation shall require the applicant to pay to the Patent Office a late payment fee as provided by Rule 16 bis.2 of the said Regulations.

### **Certified copies**

119. A request under rule 17.1 or rule 20.9 of the said Regulations for a certified copy of an international application as filed with the Patent Office as receiving office and of any corrections thereto shall be made on Patents Form 23/77 and shall be accompanied by the appropriate fee.

### **Fees to be paid in sterling**

120. All fees payable to the Patent Office under the said Treaty in respect of international applications shall be paid in sterling.

### **Transitional provisions and revocations**

121.-(1) The reference to Schedule 2 to the Patents Rules 1968 in paragraph (a) of the proviso to rule 124 of the Patents Rules 1978 shall be construed as a reference to that Schedule with the substitution for forms 7, 9, 14 to 21, 23, 32 to 36, 38, 39, 43, 44, 46, 53 to 55, 63 to 65 and 69 of the correspondingly numbered forms in Schedule 5.

(2) In rule 124 of the Patents Rules 1978-

(a) for the words "the Patents Rules 1982" in each place where they occur, there shall be substituted the words "the Patents Rules 1995";

(b) for paragraph (d) of the proviso to paragraph (1), there shall be substituted-

"(d) subject to sub-rule (3) below, rules 30, 39(1) and (3) to (6), 41 to 50, 52, 61 to 66, 68 to 74, 76, 88(1), 90, 92 to 95, 97 to 101, 103 to 108, and 114 to 116 of the Patents Rules 1995 shall apply.",

and

(c) for the words "in rule 39(1)" in paragraph (4) there shall be substituted the words "in rule 39(1) of the Patents Rules 1995".

(3) The rules described in column 1 of Schedule 6 are hereby revoked to the extent specified in column 3 thereof.

(4) Where,-

(a) immediately before these Rules come into force, any time or period prescribed by the Rules hereby revoked has effect in relation to any act or proceeding and has not expired; and

(b) the corresponding time or period prescribed by these Rules would have expired or would expire earlier,

the time or period prescribed by those Rules and not by these Rules shall apply to that act or proceeding.

*Richard Page*  
Minister for Small Business,  
Department of Trade and Industry

3rd August 1995

## SCHEDULE 1

Rule 4(1)

### GENERAL FORMS

[The Patents Forms are not reproduced here, but can be downloaded in pdf format from the our website at <http://www.patent.gov.uk/patent/forms/ukpatsupp.htm> ]

## SCHEDULE 2

Rule 17

### BIOLOGICAL MATERIAL

#### **Applications**

**1.**-(1) The specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material:

- (a) which is not available to the public at the date of filing the application; and
- (b) which cannot be described in the specification in such a manner as to enable the invention to be performed by a person skilled in the art,

shall, in relation to the biological material itself, be treated for the purposes of the Act as disclosing the invention in such a manner only if one of the conditions set out in subparagraph (2) below is satisfied and the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material.

(2) The conditions referred to in subparagraph (1) above are -

- (a) a condition that, -
  - (i) not later than the date of filing of the application, the biological material has been deposited in a depositary institution which is able to furnish a sample of the biological material; and
  - (ii) the name of the depositary institution and the accession number of the deposit are given in the specification of the application; and
  - (iii) where the biological material has been deposited by a person other than the applicant, the name and address of the depositor are stated in the application and a document is filed satisfying the comptroller that the depositor has authorised the applicant to refer to the deposited material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with this Schedule; and
- (b) a condition, in the case of a European patent (UK), an application for a European patent (UK) or an international application for a patent (UK) which is treated, by virtue of section 77, 81, or 89 as a patent under the Act, or, as the case may be, an application for a patent under the Act, that the corresponding provisions of the Implementing Regulations to the European Patent Convention or, as the case may require, the Patent Co-operation Treaty have been complied with,

and, where paragraph 5 below applies, a further condition that a new deposit has been made in accordance with that paragraph and the applicant or proprietor has made the request referred to in subparagraph (2)(b) of that paragraph within the period referred to in subparagraph (2) or, if applicable, (4) of that paragraph.

(3) Where the information specified in subparagraph (2)(a)(ii) or (iii) above is not contained in an application for a patent as filed, it shall be added to the application—

- (a) before the end of the period of 16 months after the declared priority date or, where there is no declared priority date, the date of filing of the application;
- (b) where a request is made by the applicant to the comptroller to publish the application before the end of the period prescribed for the purposes of section 16(1), on or before the date of that request; or
- (c) where the comptroller sends notification to the applicant that, in accordance with subsection (4) of section 118, he has received a request by any person for information and inspection of documents under subsection (1) of that section, before the end of one month after his sending to the applicant notification of his receipt of the request,

whichever is the earliest.

(4) The giving of the information specified in subparagraph (2)(a)(ii) above shall constitute the unreserved and irrevocable consent of the applicant to the depositary institution with which biological material (including a deposit which is to be treated as having always been available by virtue of paragraph 5(2) below) is from time to time deposited making the biological material available on receipt of the comptroller's certificate authorising the release to the person who is named therein as a person to whom the biological material may be made available and who makes a valid request therefor to the institution.

#### **General availability of biological material**

**2.-(1)** Save where paragraph 3 below has effect, a request may be made to the comptroller to issue a certificate authorising a depositary institution to make available a sample of biological material—

- (a) before publication of the application for a patent, to a person who has made a request under section 118(1) in the circumstances mentioned in paragraph 1(3)(c) above; and
- (b) at any later time, to any person (notwithstanding revocation or cancellation of the patent).

(2) A request under subparagraph (1) above shall be made on Patents Form 8/77 (which shall be filed in duplicate together, in the case of biological material which is deposited under the Budapest Treaty with an international depositary authority, with the form provided for by the Regulations under that Treaty).

(3) On receipt of a valid request under subparagraph (1) above, the comptroller shall send copies of the form or forms lodged with him under subparagraph (2) above and of his certificate authorising the release of the sample—

- (a) to the applicant for, or proprietor of, the patent;
- (b) to the depositary institution; and
- (c) to the person making the request.

(4) A request under subparagraph (1) above shall comprise, on the part of the person to whom the request relates, undertakings for the benefit of the applicant for, or proprietor of, the patent—



- (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, otherwise than for experimental purposes relating to the subject matter of the invention,

and both undertakings shall have effect-

- (i) during any period before the application for a patent has been withdrawn, has been taken to be withdrawn, has been treated as having been withdrawn, has been refused or is treated as having been refused (including any further period allowed under rule 100 or rule 110(1) or (4) but excluding, where an application is reinstated under either of those rules, the period before it is reinstated);
- (ii) if a patent is granted on the application, during any period for which the patent is in force and during the period of six months referred to in section 25(4).

(5) For the purposes of enabling any act specified in section 55 to be done in relation to the biological material for the services of the Crown, the undertakings specified in subparagraph (4) above-

- (a) shall not be required from any government department or person authorised in writing by a government department for the purposes of this paragraph; and
- (b) shall not have effect in relation to any such person who has already given them.

(6) An undertaking given pursuant to subparagraph (4) above may be varied by way of derogation by agreement between the applicant or proprietor and the person by whom it is given.

(7) Where, in respect of a patent to which an undertaking given pursuant to subparagraph (4) above has effect,

- (a) an entry is made in the register under section 46 to the effect that licences are to be available as of right; or
- (b) a compulsory licence is granted under section 48,

that undertaking shall not have effect to the extent necessary for effect to be given to any such licence.

(8) In subparagraph (4) above, references to material derived from deposited biological material are references to material so derived which exhibits those characteristics of the deposited biological material essential for the performance of the invention.

### **Restriction of availability of biological material to experts**

**3.-(1)** Subject to subparagraph (3) below, where before the preparations for publication under section 16 of an application for a patent have been completed, the applicant gives notice to the comptroller on Patents Form 8A/77 of his intention that a sample of the biological material should be made available only to an independent expert, the provisions of this paragraph shall have effect.

(2) The comptroller-

- (a) shall publish, with the application, notice that the provisions of this paragraph have effect; and
- (b) notwithstanding paragraph 2 above, shall not:

- (i) until the grant of the patent; or, where applicable,
- (ii) for 20 years from the date on which the patent application was filed if the application for the patent has been withdrawn, has been taken to be withdrawn, has been treated as having been withdrawn, has been refused or is treated as having been refused,

issue any certificate authorising release of a sample otherwise than under paragraph 4 below.

(3) Where an applicant for an international application for a patent (UK) gives notice in writing to the International Bureau under rule 13bis.3 of the Regulations under the Patent Co-operation Treaty before the technical preparations for international publication of the application are complete of his intention that a sample of the biological material should be made available only to an expert, he shall be treated by the comptroller for the purposes of this paragraph as having complied with the conditions in subparagraph (1) above and subparagraph (2)(a) above shall not apply.

#### **Request for a sample to be made available to an expert**

**4.-(1)** Where the availability of samples is restricted to independent experts by paragraph 3 above, any person wishing to have a sample of the biological material made available ("the requester")-

- (a) shall apply to the comptroller on Patents Form 8/77 (which shall be filed in duplicate together, in the case of biological material which is deposited under the Budapest Treaty with an international depositary authority, with the form provided for by the Regulations under that Treaty) nominating the person ("the expert") to whom he wishes the sample to be made available; and
- (b) shall at the same time file undertakings by the expert as set out in subparagraph (4) of paragraph 2 above and the provisions of that paragraph relating to undertakings shall also apply to the undertakings given by the expert.

(2) The comptroller shall send a copy of Patents Form 8/77 filed under subparagraph (1) above to the applicant for the patent and shall specify the period within which the applicant may object, in accordance with subparagraph (3) below, to a sample of the biological material being made available to the expert.

(3) Unless, within the period specified by the comptroller under subparagraph (2) above (or within such longer period as the comptroller may, on application made to him within that period, allow), the applicant for the patent sends notice in writing to the comptroller that he objects to a sample of the biological material being made available to the expert and gives his reasons for his objection, the comptroller shall send a copy of any form lodged with him under subparagraph (1)(a) above and of his certificate authorising the release of the sample-

- (a) to the applicant for the patent,
- (b) to the depositary institution concerned,
- (c) to the requester, and
- (d) to the expert.

(4) Where, in accordance with subparagraph (3) above, the applicant for the patent sends notice to the comptroller of his objection to the issue of a certificate in favour of the expert, the comptroller-

- (a) shall decide, having regard to the knowledge, experience, independence and technical qualifications of the expert and to any other factors he considers relevant, whether to issue his certificate in favour of the expert; and

- (b) if he decides to authorise the release of the sample to the expert, shall send to the persons referred to in subparagraph (3) above a copy of any form lodged with him under subparagraph (1)(a) above and of his certificate authorising the release of the sample to the expert.

(5) Before making a decision in accordance with subparagraph (4) above, the comptroller shall afford the applicant and the requester the opportunity of being heard.

(6) If the comptroller decides under subparagraph (4) above not to issue his certificate in favour of the expert, the requester may, by notice in writing to the comptroller and the applicant, nominate another person as the expert for the purposes of this paragraph; and the comptroller shall give such directions as he shall think fit with regard to the subsequent procedure.

(7) Nothing in this paragraph or paragraph 3 above shall affect the rights under section 55 of any government department or any person authorised in writing by a government department.

### **New deposits**

**5.-(1)** This paragraph applies where-

(a) biological material ceases to be available from the institution with which it was deposited because-

- (i) the biological material is no longer viable, or
- (ii) for any other reason the institution is unable to supply samples, or

(b) the depositary institution-

- (i) ceases to be a depositary institution for the purposes of this Schedule, either entirely or for the kind of biological material to which the deposited sample belongs, or
- (ii) discontinues, temporarily or permanently, the performance of its functions as regards deposited biological material,

and no sample of the biological material has been transferred to another depositary institution, from which it continues to be available.

(2) An interruption in availability of the biological material shall be deemed not to have occurred if within a period of three months from the date on which the depositor was notified of the interruption by the depositary institution-

- (a) the depositor (or applicant or proprietor if different) makes a new deposit of a sample of that biological material; and
- (b) the applicant or proprietor makes a request for amendment of the specification under section 19 or section 27, as the case may be, so as to indicate the accession number of the new deposit and, where applicable, the name of the depositary institution with which the deposit was made.

(3) In the case provided for in subparagraph (1)(a)(i) above, the new deposit shall be made with the depositary institution with which the original deposit was made; in the cases provided for in subparagraphs 1(a)(ii) and 1(b), it may be made with another depositary institution.

(4) Where, in a case to which subparagraph (1)(b) applies, no notification of the interruption of availability of the biological material from the depositary institution is received by the depositor within six months from the date of such event, the three-month period referred to in subparagraph (2) shall begin on the date on which this event is announced in the Journal.

(5) Any new deposit shall be accompanied by a statement signed by the person making the deposit certifying that the sample of biological material newly deposited is of the same biological material as was the sample originally deposited.

#### **Transitional Provisions**

6.-(1) In relation to an application for a patent filed before 7th January 1991, rule 17 of the Patents Rules 1982 shall continue to have effect notwithstanding its revocation by rule 123(3) of the Patents Rules 1990.

#### **Interpretation of Schedule**

7.-(1) In this Schedule—

"the Budapest Treaty" means the Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure done at Budapest in 1977; and  
"international depositary authority" means a depositary institution which has acquired the status of international depositary authority as provided in Article 7 of the Budapest Treaty.

(2) For the purposes of this Schedule, a "depositary institution" is an institution which, at all relevant times,

- (a) carries out the functions of receiving, accepting and storing biological material and the furnishing of samples thereof; and
- (b) conducts its affairs in so far as they relate to the carrying out of those functions in an objective and impartial manner.

### **SCHEDULE 3**

Rule 38

#### **FORM OF CERTIFICATE OF GRANT OF PATENT**

[Omitted by the Patents (Amendment) (No.2) Rules 1999 (SI 1999 No. 3197).]

### **SCHEDULE 4**

Rule 80

#### **EUROPEAN PATENTS AND APPLICATIONS (UK): TRANSLATIONS**

##### **Translations of European Patents (UK) filed under section 77(6)**

1.-(1) A translation filed under section 77(6)(a) or (b) shall be filed in duplicate and shall be accompanied by Patents Form 54/77 in duplicate.

(2) A translation filed under section 77(6) shall comprise a translation of the entirety of the published specification of the patent (including the claims), irrespective of whether a translation of all or any part of the claims contained in the specification has previously been filed under section 78(7) but subject to subparagraph (5) below, and shall include any drawings in the specification, irrespective of whether the drawings contain textual matter.

(3) A translation filed under section 77(6) shall comply with the following requirements as to presentation, subject to subparagraph (4) below in the case of any drawings-

(a) it shall permit of direct reproduction by photography, electrostatic processes, photo-offset and micro-filming, in an unlimited number of copies;

(b) it shall be on A4 paper (29.7 cm x 21cm) which shall be pliable, strong, white, smooth, matt and durable;

(c) each sheet of paper shall be free from cracks, creases and folds and used on one side only;

(d) each sheet shall be used with its short sides at the top and bottom (upright position);

(e) the minimum margins shall be-

top	2.0 cm
left side	2.5 cm
right side	2.0 cm
bottom	2.0 cm;

(f) the margins of the sheets shall be completely blank;

(g) the translation shall be typed or printed in single-line spacing (unless the comptroller otherwise permits), in a dark, indelible colour and in characters of which the capital letters are not less than 0.21 cm high, save that graphic symbols and characters and chemical and mathematical formulae may, instead of being typed or printed, be written or drawn;

(h) the translation shall be reasonably free from extraneous matter and also from deletions and other alterations, overwritings and interlineations and shall, in any event, be legible; and

(i) each sheet (other than a sheet of drawings) shall be numbered consecutively in arabic numerals.

(4) Where a translation including any drawings is filed, the sheets of drawings shall correspond exactly in content and presentation to the sheets of drawings which were published by the European Patent Office, except that -

(a) each sheet shall be numbered consecutively in arabic numerals, as a separate series from that used for the other sheets of the translation, if not so numbered when published by the European Patent Office; and

(b) any textual matter contained in the published drawings shall be replaced with a translation into English.

(4A) Where the translation filed under section 77(6) is delivered in electronic form or using electronic communications, subparagraphs (3) and (4) shall not apply to the extent that they have been removed or varied by the comptroller in directions made under section 124A and the presentation of the translation shall comply with such directions.

(5) For the purposes of subparagraph (2) above, the published specification of the patent shall be taken not to include-

(a) anything which does not consist of, or form part of, the description of the invention, the claims or the drawings referred to in the description or the claims;

(b) any claim not having effect in the United Kingdom; or

(c) anything published in a language other than the language of the proceedings (within the meaning of Article 14 of the European Patent Convention).

**Periods prescribed under section 77(6)**

2.-(1) The period prescribed under section 77(6)(a) for filing a translation of the specification of a European patent (UK) and paying the prescribed fee shall be three months from the date of publication of the mention of the grant of the patent in the European Patent Bulletin.

(2) The period prescribed under section 77(6)(b) for filing a translation of the specification as amended of a European patent (UK) and paying the prescribed fee shall be three months from the date of publication by the European Patent Office of the specification of the patent as amended.

**Translations of claims of applications for European patents (UK) filed under section 78(7)**

3.-(1) A translation of the claims of an application for a European Patent (UK)-

(a) in the case of an application which has been published by the European Patent Office, may be filed under subsection (7) of section 78 after the application has been so published; and

(b) in the case of an application which has not been so published but which is the subject of proceedings before the European Patent Office by virtue of Article 150 of the European Patent Convention, may be filed under that subsection after the application has been published under Article 21 of the Patent Co-operation Treaty.

(2) A translation filed by virtue of subparagraph (1) above shall be filed in duplicate and shall be accompanied by Patents Form 54/77, also filed in duplicate.

(3) Subject to paragraph 1(4A) the translation shall comply with the requirements contained in paragraph 1(3) above.

**Corrected translations filed under section 80(3)**

4.-(1) A corrected translation filed under section 80(3) shall be filed in duplicate.

(2) Subject to paragraph 1(4A) the corrected translation shall comply with the requirements contained in paragraph 1(3) and (4) above.

(3) Publication of the corrected translation shall be requested on Patents Form 54/77, which shall be filed in duplicate.

(4) The period prescribed under section 80(3) for payment of the prescribed fee shall be fourteen days from the day on which the corrected translation is filed.

**Verification of translation**

5. A translation shall be verified to the satisfaction of the comptroller as corresponding to the original text of -

(a) the specification, in the case of a translation filed under section 77(6)(a);

(b) the specification as amended, in the case of a translation filed under section 77(6)(b);

(c) the claims of the specification of the application, in the case of a translation filed under section 78(7); or

(d) the specification of the patent or the claims of the application, as the case may be, in the case of a translation filed under section 80(3),

and if such verification does not accompany the translation when filed it shall be filed within one month of the sending by the comptroller of a written request for such verification.

#### SCHEDULE 5

Rule 121(1)

#### PATENTS ACT 1949 FORMS

[These forms have not been reproduced here, but are reproduced in paper copies of the Patents Rules 1995 (SI 1995 No. 2093).]

#### SCHEDULE 6

Rule 121(3)

#### REVOCATIONS

(1) <i>Rules revoked</i>	(2) <i>References</i>	(3) <i>Extent of revocation</i>
The Patents Rules 1990	SI 1990 No. 2384	The whole rules.
The Patents (Amendment) Rules 1992	SI 1992 No. 1142	The whole rules.
The Patents (Amendment) Rules 1993	SI 1993 No. 2423	The whole rules.

#### [Additional notes:

1. Rule 17 of the Patents Rules 1982 (SI 1982 No. 717) still applies in relation to patent applications relating to micro-organisms filed before 7th January 1991 – see Schedule 2 paragraph 6(1).
2. Rule 4 of the Patents (Amendment) Rules 1987 (SI 1987 No. 288) still applies to European (UK) patents mention of whose grant was published by the EPO before 1<sup>st</sup> September 1987.
3. Rule 5 of the Patents (Amendment) Rules 1987 (SI 1987 No. 288) still applies to European (UK) patent applications which were published by the EPO before 1<sup>st</sup> September 1987.

Legal Section  
Patents Directorate  
The Patent Office  
2<sup>nd</sup> April 2002 ]