
 STATUTORY INSTRUMENTS

1985 No. 1166**PATENTS****The Patents (Amendment No. 2) Rules 1985**

<i>Made - - - -</i>	<i>25th July 1985</i>
<i>Laid before Parliament</i>	<i>2nd August 1985</i>
<i>Coming into Operation</i>	<i>1st September 1985</i>

The Secretary of State, in exercise of the powers conferred upon him by sections 32(2) and 123(1), (2) and (3) of and paragraph 14 of Schedule 4 to the Patents Act 1977 (a) and of all other powers enabling him in that behalf, and as to rules 5(1)(d), 10 and 13(b) with the consent of the Treasury pursuant to subsection (4) of the said section 123, hereby makes the following Rules:—

1.—(1) These Rules may be cited as the Patents (Amendment No. 2) Rules 1985.

(2) Except for rules 14(a) and 15, these Rules shall come into operation on 1st September 1985.

(3) Rules 14(a) and 15 shall come into operation on 23rd September 1985.

(4) The Patents Rules 1982 (b) (“the principal Rules”) shall be amended in accordance with Rules 2 to 14 below.

2. The following paragraph shall be inserted at the end of rule 5 of the principal Rules:—

“(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(2A) below.”.

3. In the proviso to rule 6(6) of the principal Rules, for the words “twenty-six months” there shall be substituted the words “thirty-one months”.

4. In rule 15(4) of the principal Rules there shall be substituted for all the words after “complied with” the words, “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.”

5.—(1) The following amendments shall be made to paragraph (1) of rule 85 of the principal Rules:—

(a) at the beginning there shall be inserted the words, “Subject to the provisions of paragraph (1A) below,”;

(b) in subparagraph (a), all the words after “international application for a patent (UK) or” shall be left out;

(c) in subparagraph (b), for the words “twenty-five months” in both places in which they occur there shall be substituted the words “thirty months”;

(a) 1977 c.37.

(b) S.I. 1982/717; the relevant amending instrument is S.I. 1985/785.

- (d) for the words "Patents Form No. 42/77, duly completed, is filed" there shall be substituted the words "the national fee specified in Schedule 1 hereto (being the fee referred to in section 89(4)(a)) is paid to the Patent Office"; and
- (e) the following proviso shall be inserted at the end:
- "Provided that where the relevant conditions of section 89(4) are not satisfied before the end of the relevant period because, for any reason outside the control of the applicant or any person acting on his behalf, the Patent Office has not received the communication provided for in Article 20 of the Patent Co-operation Treaty, the relevant period shall be extended until actual receipt by the Patent Office of the said communication or until the expiry of a further period of two months commencing on the date on which the comptroller sends to the applicant notice that the Patent Office has not received the said communication, whichever is the sooner."
- (2) The following paragraph shall be inserted after the said paragraph (1):
- "(1A) Where, in accordance with rule 17 above, the information specified in paragraph (1)(a)(iii) of that rule is added to an international application for a patent (UK), rule 113(1) below shall not apply in respect of that information; and where the translation of that information the filing of which is required to satisfy the relevant conditions of section 89(4) has not been filed at the Patent Office before the end of the relevant 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 above requiring the applicant to file the translation within the period of two months commencing on the day on which the letter containing the notice is sent, and
- (b) the relevant period 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) The following paragraph shall be inserted after rule 85(2) of the principal Rules:
- "(2A) In the case of an international application for a patent (UK)—
- (a) rule 5(1) above 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) rule 5(2) above may be complied with at any time before the end of the period of two months commencing with the expiry of the relevant period referred to in paragraph (1) above; and
- (c) verification of translation as required by rule 113(1) below may be given to the comptroller at any time before the end of the said period of two months when the translation is of a document or part of a document required by the Act or these rules to be filed at the Patent Office before the end of the relevant period referred to in paragraph (1) above."
- (4) In paragraph (a) of rule 85(3) of the principal Rules there shall be substituted for the word "at" the words "two months after".
- (5) The following subparagraph shall be substituted for subparagraph (b) of the said rule 85(3):
- "(b) for the purposes of section 18(1) shall, except in a case in which the

relevant period is extended in accordance with the proviso to paragraph (1) above, be—

- (i) where subparagraph (a) of paragraph (1) applies, the period which expires two years 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
- (ii) where subparagraph (b) of paragraph (1) applies, the period of thirty-three months calculated from 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, in a case in which the relevant period is so extended, be the period mentioned in subparagraph (i) or (ii) above, as the case may be, or the period which expires three months after the end of the relevant period as so extended, whichever may expire the later; and”.

(6) The following paragraph shall be inserted after rule 85(4) of the principal Rules:

“(4A) Where, 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 where the declaration made under Article 8(1) of the Patent Co-operation Treaty has been cancelled or corrected by the receiving office or by 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 of time which is specified in the Act or these Rules as if the error were an error on the part of the Patent Office.”

(7) The following paragraph shall be inserted at the end of rule 85 of the principal Rules:

“(6) In this rule, “receiving office” has the same meaning as in the Patent Co-operation Treaty.”

6. The following subparagraph shall be inserted at the end of rule 95 of the principal Rules:

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

7.—(1) Subparagraph (a) of rule 102(1) of the principal Rules shall be left out.

(2) In paragraph (3) of rule 102 of the principal Rules, for the words “In every such case” there shall be substituted the words “In cases falling within paragraph (1)(c) above”.

8. In paragraph (1) of rule 113 of the principal Rules, for the words “81 and 82” there shall be substituted the words “81, 82 and 85”.

9. In paragraph (1) of rule 117 of the principal Rules, all the words after “in triplicate” shall be left out.

10. The following paragraphs shall be substituted for paragraph (1) of rule 118 of the principal Rules:

“(1) Payment of the transmittal fee specified in Schedule 1 hereto and the basic fee referred to in rule 15.1(i) of the Regulations under the Patent Co-operation Treaty shall be made to the Patent Office not later than one month after the date on which the application to which they relate is filed at the Patent Office.

(1A) Payment of designation fees referred to in rule 15.1(ii) of the said Regulations shall be made to the Patent Office in the amount provided for in rule 15.2(b) thereof not later than—

- (a) one year after the date on which the application to which they relate is filed at the Patent Office in a case in which there is no date to be treated, by virtue of section 89(1)(c), as the declared priority date, or
- (b) one month after that date or, if later, one year after the date to be treated, by virtue of section 89(1)(c), as the declared priority date in any other case.”

11. In rule 122 of the principal Rules, for the number “117” there shall be substituted the number “118”.

12. Rule 123 of the principal Rules shall be left out.

13. In Part A of Schedule 1 to the principal Rules—

- (a) the entry relating to Patents Form No. 42/77 shall be left out,
- (b) after the entry relating to Patents Form No. 51/77 the following entry shall be inserted:
 - “— | National fee (Rule 85(1)) | 10”, and
- (c) in the entry relating to the Transmittal Fee, for the words “Rule 117(1)” there shall be substituted the words “Rule 118(1)”.

14. In Schedule 2 to the principal Rules—

- (a) in note 10 to Patents Form No. 1/77, for the word “received” there shall be substituted the word “revoked”, and
- (b) Patents Form No. 42/77 shall be left out.

15. In Patents Form No. 1 Add set out in Schedule 2 to the Patents Rules 1968 (a) there shall be inserted at the end of side-note (b) the following sentence:

“Attention is directed to Rules 90 and 106 of the Patents Rules 1982.”

Geoffrey Pattie,
Minister of State,
Department of Trade and Industry.

19th July 1985

We consent to the making of rules 5(1)(d), 10 and 13(b) of these Rules.

Donald Thompson,
Ian B. Lang,
Two of the Lords Commissioners
of Her Majesty’s Treasury.

25th July 1985

(a) S.I. 1968/1389; the relevant amending instrument is S.I. 1985/785. S.I. 1968/1389 was revoked with savings by S.I. 1978/216 (rule 124).

EXPLANATORY NOTE

(This Note is not part of the Rules.)

These Rules, by amending the Patents Rules 1982, give effect to certain modifications to the Patent Co-operation Treaty (Cmnd. 7340) and certain amendments to the Regulations under that Treaty. The modifications and amendments are set in Cmnd. 9313. (Previous amendments to the Regulations are set out in Cmnd. 7783, 8078 and 8502.)

Other amendments to the Patents Rules 1982 are also made, and a minor amendment is made to a form under the Patents Rules 1968.

The principal changes relating to applications under the Patent Co-operation Treaty are—

- (a) in the case where the United Kingdom has been elected in accordance with Chapter II of the Treaty, the periods prescribed for complying with the conditions in section 89(4) of the Patents Act 1977 for entering the “national phase” (i.e. for being dealt with under the Act), for filing a translation of a priority document or for filing Patents Form No. 10/77 are increased (rules 3, 5(1)(c) and (5) and 8);
- (b) it will no longer be necessary to file Patents Form No. 42/77 in order to enter the “national phase”, although payment of a fee will still be required (rules 5(1)(d), 13(a) and (b) and 14(b));
- (c) the period of complying with the conditions for entering the “national phase” is extended if the Patent Office does not receive a copy of the application from the International Bureau (rule 5(1)(e));
- (d) the period for complying with the conditions for entering the “national phase” will not be affected by the inability of the International Searching Authority to produce a search report (rule 5(1)(b));
- (e) the periods prescribed for paying the basic fee, the designation fee and the transmittal fee, for filing Patents Form No. 7/77 or Patents Form No. 9/77, for verifying translations or for filing a translation of information about a deposit in a culture collection are increased (rules 5(1)(a), (2), (3) and (4), 8, 9, 10, 11 and 13(c));
- (f) any appropriate remission of the search fee or the substantive examination fee need no longer be requested in writing (rule 7); and
- (g) amendments are made in the provisions relating to identification of the inventor, prior disclosure of the invention at an exhibition and correction of the consequences of errors made by the receiving office in relation to the date of filing or the declaration of priority (rules 2, 4 and 5(3) and (6)).

The other principal change is that the fact that an application has been terminated is added to the bibliographic information which may be published about unpublished applications (rule 6).

Rules 14(a) and 15 effect minor amendments to forms.

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