
STATUTORY INSTRUMENTS

1992 No. 1142

PATENTS

The Patents (Amendment) Rules 1992

<i>Made</i> - - - -	<i>11th May 1992</i>
<i>Laid before Parliament</i>	<i>11th May 1992</i>
<i>Coming into force</i>	
<i>For all purposes other than rules 10 and 14</i>	<i>1st June 1992</i>
<i>For the purposes of rules 10 and 14</i>	<i>1st July 1992</i>

The Secretary of State, in exercise of powers conferred upon him by sections 14(6), 18(1) and (4), 20(1), 25(3), 32(5), (6) and (7), 89, 89A(3) and (5), 123(1) to (3A), 124 and 125A(3) of the Patents Act 1977(1), after consultation with the Council on Tribunals pursuant to section 10(1) of the Tribunals and Inquiries Act 1971(2), hereby makes the following Rules:—

Citation and commencement

1. These Rules may be cited as the Patents (Amendment) Rules 1992 and shall come into force as respects rules 1 to 9, 11, 12, 13 and 15 on 1st June 1992, and as respects rules 10 and 14 on 1st July 1992.
2. The Patents Rules 1990(3) are amended as set out in rules 3 to 15 below.
3. For rule 22 there shall be substituted the following—

“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.

(1) 1977 c. 37; section 89 was replaced and section 89A was inserted by the Copyright, Designs and Patents Act 1988 (c. 48), section 295 and Schedule 5, paragraph 25; section 123 was amended by the said Act of 1988, section 295 and Schedule 5, paragraph 29; section 125A was inserted by the said Act of 1988, section 295 and Schedule 5, paragraph 30.
(2) 1971 c. 62.
(3) S.I. 1990/2384.

(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.”.

4. In paragraph (2) of rule 33, there shall be substituted for the words “and paragraphs (3) and (4) below” the words “and paragraphs (3) and (5) below”.

5. For paragraph (1) of rule 34, there shall be substituted the following paragraphs—

“(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 sub-paragraphs (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) subject to paragraph (1A) below, in the case of a new application under section 15(4), 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 earlier application; or

(ii) the period of twelve months calculated from the date the first report under section 18 in respect of the earlier application is sent to the applicant,

whichever expires the later.

(1A) Where the first report under section 18 is not sent to the applicant before the expiry of the periods prescribed by sub-paragraphs (a)(i) and (c)(i) of paragraph (1) above, those periods shall be extended to the date that report is sent to the applicant and the periods specified by sub-paragraphs (a)(ii) and (c)(ii) of paragraph (1) shall then apply.”.

6. In rule 48, there shall be substituted for the words “the appropriate fee” the words “the prescribed fee, if any”.

7. In rule 49, there shall be inserted in paragraph (1) after the words “the prescribed fee” the words “, if any,” and in paragraph (2) there shall be substituted for the words “the appropriate fee” the words “the prescribed fee, if any”.

8. In paragraph (2) of rule 52, there shall be substituted for the words “the appropriate fee” the words “the prescribed fee, if any”.

9. For paragraph (3) of rule 83, there shall be substituted the following paragraph—

“(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).”.

10. In rule 85—

- (a) in paragraph (4) the words “paragraph (5A) below,” shall be inserted between the words “under” and “rule 100”;
- (b) in paragraph (5) the following shall be inserted after sub-paragraph (b)—
 - “; and,
 - (c) where a title has been established by the International Searching Authority under rule 37.2 of the Regulations under the Patent Cooperation Treaty which differs from the title included in the application as originally filed, shall include the former title in place of the latter.”;
- (c) the following paragraph shall be inserted after paragraph (5)—
 - “(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 relevant 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 one month commencing on the day on which the notice is sent; and
 - (b) the relevant period shall be treated in respect of that translation as not expiring until the end of the period specified in the notice given under sub-paragraph (a) above.”.

11. In rule 93, there shall be substituted in each case for the words “the appropriate prescribed fee” in paragraph (1) and for the words “the appropriate fee” in paragraph (2), the words “the prescribed fee, if any”.

12. In paragraph (4) of rule 108 there shall be substituted for the words “within two months” the words “within one month”.

13. In paragraph (3) of rule 110—

- (a) the reference to rule 85(1) and (7) shall be replaced by a reference to rule 85(1), (5A) and (7);
- (b) the words “paragraph (6) below,” shall be omitted.

14. In rule 118—

- (a) the word “Payment” at the beginning of each of paragraphs (1), (2) and (3) shall be replaced with—
 - “Subject to paragraph (4) below, payment”;
- (b) in paragraph (2) the following words shall be inserted after the word “Regulations”—
 - “in respect of designations made under rule 4.9(a) thereof”;
- (c) the following paragraph shall be inserted after paragraph (2)—

“(2A) Payment of designation fees and of confirmation fees referred to in rule 15.5(a) in respect of designations made under rule 4.9(b) of the said Regulations shall be made to the Patent Office in the respective amounts provided for in rule 15.2(b) and rule 15.5(a) thereof not later than 15 months after the date to be treated by virtue of section 89B(1)(b) as the declared priority date, or, where there is no declared priority date, the date on which the application to which they relate is filed at the Patent Office.”;

(d) the following paragraph shall be inserted after paragraph (3)—

“(4) Where payment of a fee pursuant to paragraphs (1), (2) and (3) above has not been made to the Patent Office, in the case of transmittal, basic and designation fees, within the periods prescribed by paragraphs (1) and (2) above, and in the case of search fees, within the period referred to in rule 16.1(f) of the said Regulations (“the specified period”)—

- (a) the Patent Office shall give notice to the applicant requiring the applicant to pay the Patent Office the outstanding fee and a late payment fee calculated in accordance with rule 16bis.2 of the said Regulations within the period of one month commencing on the date on which the notice is sent to the applicant; and
- (b) the specified period shall be treated in respect of the outstanding fee as not expiring until the end of the one month period referred to in sub-paragraph (a) above.”

15. In Schedule 2—

(a) the word “Where,” at the beginning of paragraph 3(1) shall be replaced with—

“Subject to sub-paragraph (2A) below, where,”;

(b) the following sub-paragraph shall be inserted after sub-paragraph (2)—

“(2A) Where, for the purpose set out in sub-paragraph (1) above, 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 Cooperation Treaty before the technical preparations for international publication of the application are complete of his intention that a sample of the micro-organism 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 sub-paragraph (1) above and sub-paragraph (2)(a) above shall not apply.”.

11th May 1992

T. Sainsbury
Minister for Industry,
Department of Trade and Industry

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules make the following amendments of substance to the Patents Rules 1990 (S.I.1990/2384):

- (a) to give effect to provisions of the Patent Cooperation Treaty which—
 - (i) modify provisions permitting two or more inventions to be treated as linked to form a single inventive concept (rule 3);
 - (ii) permit an extension of the time-limit for the provision of translations of an application as originally filed and any amendment to it (rule 10);
 - (iii) provide the time-limits applicable for payment of certain designation fees (rule 14);
 - (iv) introduce a requirement for an additional late payment fee in respect of late payment of transmittal, basic, designation and search fees (rule 14);
- (b) to make changes in certain circumstances to the period within which an application for a patent is to comply with the Act (rule 5 and rule 9);
- (c) to shorten the period within which objections may be made to a request that a hearing be held in Scotland (rule 12);
- (d) to modify the application of the rule on alteration of time-limits to certain requests for extensions of time (rule 13);
- (e) to make provision for notification to the International Bureau of the intention to limit availability of a micro-organism to an expert to be treated as notification to the comptroller for the same purpose (rule 15).