
STATUTORY INSTRUMENTS

1995 No. 2093

The Patents Rules 1995

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 4 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⁽¹⁾; 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.

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⁽²⁾ as

⁽¹⁾ 1971 c. 80.

⁽²⁾ S.I.1968/1389, as amended by S.I. 1970/955, 1971/1917, 1973/66, 1975/891,1021 and 1262, and revoked with savings by S.I. 1978/216.

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 a case governed by Chapter II of the Patent Co-operation Treaty, the comptroller may remit the whole or part of the fee for the substantive examination of the international application where its preliminary examination has been carried out by the Patent Office acting as the International Preliminary Examining Authority under Article 32 of the said Treaty.

(3) 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.

(4) 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 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 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.

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.

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(1), 81(1), 82(1) and 91(4) and paragraph 4(2) of Schedule 2.

(3) A time or period prescribed in rules 6(2) and (6) (including the period therein prescribed as substituted by rule 85(3)(c) and (d)), 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.—(1) The comptroller shall publish a journal containing particulars of applications for patents and other proceedings under the Act and any other information that he may deem to be generally useful or important.

- (2) The journal shall be entitled “The Official Journal (Patents)”.
- (3) Unless the comptroller otherwise directs, the Journal shall be published weekly.

Reports of cases

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.