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STATUTORY INSTRUMENTS

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**2002 No. 529**

**PATENTS**

**The Patents (Amendment) Rules 2002**

<i>Made</i>	- - - -	<i>7th March 2002</i>
<i>Laid before Parliament</i>		<i>8th March 2002</i>
<i>Coming into force</i>	- -	<i>1st April 2002</i>

The Secretary of State, in exercise of powers conferred on her by section 123 of the Patents Act 1977(1), after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992(2), hereby makes the following Rules:—

**Citation and commencement**

1.—(1) These Rules may be cited as the Patents (Amendment) Rules 2002 and shall come into force on 1st April 2002.

(2) These Rules shall apply to an international application for a patent (UK) in respect of which—

- (a) the national phase of the application has yet to begin in accordance with section 89A(3) of the Patents Act 1977 (international and national phases of application); and
- (b) the prescribed period in relation to that application for the purposes of that section immediately before these Rules come into force has yet to expire when these Rules come into force.

**Amendment of the Patents Rules 1995**

2. The Patents Rules 1995(3) shall be amended as follows.

3. In rule 25(2), for the figure “85(7)(a)” there shall be substituted “85(7)”.

4. In rule 33(2), for the figure “85(7)(b)” there shall be substituted “85(7)”.

5.—(1) Rule 85 shall be amended as follows.

(2) For paragraph (1) there shall be substituted—

“(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

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(1) 1977 c. 37.

(2) 1992 c. 53.

(3) S.I. 1995/2093; relevant amending instruments are S.I. 1999/1092, S.I. 1999/3197 and S.I. 2001/1412.

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).”.

- (3) In paragraph (2), for the words “relevant period”—
- (a) in the first place where they appear, there shall be substituted “period”; and
  - (b) in subparagraph (b), there shall be substituted “period referred to in paragraph (1) above”.
- (4) In paragraph (3), for subparagraphs (b) to (e) there shall be substituted—
- “(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).”.
- (5) In paragraph (4), for the words “relevant period”, in both places where they appear, there shall be substituted “period”.
- (6) In paragraph (5A), for the words “relevant period”—
- (a) in the first place where they appear, there shall be substituted “period”; and
  - (b) in subparagraph (b), there shall be substituted “period referred to in paragraph (1) above”.
- (7) For paragraph (7), there shall be substituted—
- “(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).”.
- (8) In paragraph 7A, for subparagraph (c) there shall be substituted—
- “(c) for the purposes of section 18(1), shall be the period prescribed by paragraph (7) above.”.

*Melanie Johnson*  
Parliamentary Under-Secretary of State for  
Competition, Consumers and Markets  
Department of Trade and Industry

7th March 2002

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## EXPLANATORY NOTE

*(This note does not form part of the Rules)*

These Rules amend the Patents Rules 1995 (S.I.1995/2093 as amended) to implement a modification, adopted on 3rd October 2001 (Cm 5457), to Article 22 of the Patent Cooperation Treaty of 19 June 1970 (Treaty Series No. 78 (1978) Cmnd. 7340) as amended.

An applicant may apply for a patent to protect his invention under the international system established by the Patent Cooperation Treaty. When filing his international application, the applicant may designate the countries in which patent protection is sought. Article 22 of the Patent Cooperation Treaty provided for a minimum period of 20 months, except in certain circumstances, within which an applicant had to provide certain documents and fees to the national patent offices in the countries in which he wished to protect his patent. The modification extends this minimum period to 30 months.

These Rules amend in particular rule 85 of the Patents Rules 1995 by extending, from 21 to 31 months, the period within which an applicant must provide certain documents and fees to the Patent Office before his international application can enter the national phase and proceed to grant of a patent in the United Kingdom (rule 5(2)).

A regulatory impact assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment are also available from the Intellectual Property Policy Directorate of the Patent Office, Room 3B38, Concept House, Cardiff Road, Newport NP10 8QQ.