

2003 No. 513

PATENTS

**The Patents (Electronic Communications) (Amendment)
Rules 2003**

<i>Made - - - -</i>	<i>6th March 2003</i>
<i>Laid before Parliament</i>	<i>7th March 2003</i>
<i>Coming into force</i>	<i>1st April 2003</i>

The Secretary of State, in exercise of the powers conferred upon her by sections 14(1), 17(2) and 123 of the Patents Act 1977(a), and after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992(b), hereby makes the following Rules—

Citation and commencement

1. These Rules may be cited as the Patents (Electronic Communications) (Amendment) Rules 2003 and shall come into force on 1st April 2003.

Amendment of the Patents Rules 1995

2. The Patents Rules 1995(c) shall be amended as follows.
3. After paragraph (2) of rule 4 (forms) there shall be inserted—

“(3) A requirement under these Rules to use a form shall not apply if the comptroller, in directions made under section 124A(d), directs that the information required may be presented in some other manner.”.
4. After rule 4 there shall be inserted—

“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.”.
5. At the end of paragraph (2) of rule 16 (applications for the grant of patents under sections 14 and 15) there shall be inserted—

“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.”.

(a) 1977 c.37.

(b) 1992 c.53.

(c) S.I. 1995/2093; relevant amending instrument is S.I. 1999/1092.

(d) Section 124A of the Patents Act 1977 was inserted by the Patents Act (Electronic Communications) Order 2003 (S.I. 2003/512).

6. After paragraph (3) of rule 18 (drawings) there shall be inserted—
 - “(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.”.
7. After paragraph (15) of rule 20 (size and presentation of documents) there shall be inserted—
 - “(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.”.
8. After paragraph (1) of rule 31 (formal requirements) there shall be inserted—
 - “(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.”.
9. In rule 40—
 - (a) for paragraph (1) there shall be substituted—
 - “(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.”;
 - (b) after paragraph (1) there shall be inserted—
 - “(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.”.
10. In rule 78—
 - (a) for paragraph (1) there shall be substituted—
 - “(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.”;
 - (b) for paragraph (2) there shall be substituted—
 - “(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.”.
11. In Schedule 1 (general forms), Patents Form 11/77 is replaced by Patents Form 11/77 in the Schedule to these Rules.
12. In Schedule 4 (translations of European Patents (UK) filed under section 77(6))—
 - (a) after paragraph 1(4) there shall be inserted—
 - “(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.”.

- (b) in paragraph 3(3), for the word “The” at the beginning there shall be substituted “Subject to paragraph 1(4A) the”.
- (c) in paragraph 4(2), for the word “The” at the beginning there shall be substituted “Subject to paragraph 1(4A) the”.

6th March 2003

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

Patents Form 11/77

Patents Act 1977
(Rules 35, 36, 40, 47 & 91)



**Request to make an amendment
or correction**

(See the notes on the back of this form)

The Patent Office

Cardiff Road
Newport
South Wales
NP10 8QQ

1. Your reference

2. Patent application or patent number

3. Full name of the or of each patent applicant or proprietor

4. What kind of amendment or correction listed at note (d) do you want to make?
(Answer by writing (i), (ii), (iii) or (iv))

5. What is the amendment or correction you want to make? *(continue on a separate sheet of paper if necessary)*
(see notes (e) & (f))

6. If you have requested an amendment by answering (i) or (ii) in part 4 above, what is the reason for the request?
(continue on a separate sheet of paper if necessary)
(see note (f))

7. Name of your agent *(if you have one)*

“Address for service” in the United Kingdom to which all correspondence should be sent
(including the postcode)

Patents ADP number *(if you know it)*

8.	Signature	Date
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9. Name and daytime telephone number of person to contact in the United Kingdom

Patents Form 11/77

Patents Form 11/77

Notes

- a) *If you need help to fill in this form or you have any questions, please contact the Patent Office on 08459 500505*
- b) *Write your answers in capital letters using black ink or you may type them.*
- c) *If only the name or address of an applicant or proprietor has changed use Patents Form 20/77 instead.*
- d) *You can use this form to ask for:*
 - i) *Amendment of an application before a patent is granted (rules 35 & 36 apply);*
 - ii) *Amendment of a specification after a patent is granted (rule 40 applies);*
 - iii) *Correction of an error in the Register or any connected document (rule 47 applies); or*
 - iv) *Correction of any other error or mistake (rule 91 applies).**If you are asking for amendment or correction under more than one of the different categories (i) to (iv), you should use a separate form for each category.*
- e) *If any applicant or proprietor that is added or changed by the amendment or correction is a corporate body, give the country and, if appropriate, the state of incorporation of that body.*
- f) *If there is not enough space for all the relevant details on any part of this form, please use a separate sheet of paper and write "see continuation sheet" in the relevant part(s). Any continuation sheet should be attached to this form.*
- g) *Once you have filled in the form you must remember to sign and date it.*
- h) *For details of fees and ways to pay, please contact the Patent Office.*
- i) *If you are requesting an amendment after a patent is granted, you should (if reasonably possible) also deliver the proposed amendment and the reasons for it to the Comptroller electronically. For details, please see the Patent Office's website at www.patent.gov.uk or contact the Patent Office, Litigation Section on 01633 814376.*

Patents Form 11/77

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the Patents Rules 1995 (S.I. 1995/2093 as amended). They refer to directions which may be made by the Comptroller-General of Patents, Designs and Trade Marks (“the comptroller”) under section 124A of the Patents Act 1977, which section is inserted into the Patents Act by the Patents Act 1977 (Electronic Communications) Order 2003 (S.I. 2003/512). The main provisions of these Rules are set out below.

In the event that information is delivered to the Patent Office in electronic form or using electronic communications:

—Rule 3 provides that a requirement in the rules to use a form does not apply if the comptroller has directed under section 124A that the information may be presented in some other manner;

—Rule 4 provides that requirements in the rules for documents to be delivered with a copy or in multiple form do not apply if the requirement is removed or varied by the comptroller in directions;

—Rule 5 provides that the order of presentation of material included in the specification contained in an application for a patent required in the rules shall not apply to the extent that it is removed or varied by the comptroller in directions, which directions should then be complied with;

—Rules 6, 7 and 12 provide that specified paper-based requirements in the rules for drawings and other documents shall not apply to the extent that they are removed or varied by the comptroller in directions, which directions should then be complied with;

—Rule 8 provides that where certain formal requirements for a patent application in the rules do not apply because they have been removed or varied by the comptroller in directions then the formal requirements include the requirements in the directions that replace them.

Rule 9 prescribes how an application to the comptroller for leave to amend the specification of a patent shall be made and how it shall be advertised.

Rule 10 prescribes how a proposal made under section 75 of the Patents Act 1977 to amend the specification of a patent shall be made, if it is advertised then how it shall be advertised, and the timing and manner of raising an opposition to the proposed amendment.

Rule 11 replaces Patents Form 11/77 with a new Form 11/77, which is set out in the Schedule.

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

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Rules 2003**

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