
EXPLANATORY NOTE

(This note is not part of the Order)

This Order amends the Patents Act 1977 (c. 37) (“the Act”) to enable it to be administered in conformity with the Patent Law Treaty (which was adopted at Geneva on 1st June 2000).

Article 3 amends section 5 of the Act so that declarations can, when certain conditions are met, be made in respect of an application filed more than twelve months after the date of filing of the earlier specified relevant application, or if there is more than one, of the earliest of them.

Article 4 amends section 14 of the Act and removes the requirement to pay a filing fee, but replaces it with a requirement to pay an application fee. It also makes it clear that section 117 applies to correction of errors in withdrawals of applications.

Article 5 substitutes a new section 15 and inserts a new section 15A into the Act. The new section 15 includes a number of changes, the most significant of these are more relaxed conditions for obtaining a date of filing, permitting missing parts of the description and drawings to be filed late and removing the need to request a preliminary examination.

The new section 15A sets out the requirements of preliminary examination, which unlike its predecessor under section 17, will include further duties on the examiner to determine whether the requirements under section 13(2) and the new section 15(10) are met. Further if the examiner finds that a drawing or part of the description is missing from the application this will be included in his report. After the examination, the examiner will have to make a report to the Comptroller, who in turn must give the applicant an opportunity to rectify any deficiencies.

Article 6 amends section 17 of the Act. In particular, a new subsection (1) is inserted and subsections (2) and (3) are repealed. These amendments are made in consequence of the requirements of preliminary examination being moved to the new section 15A.

Article 7 makes consequential amendments to section 18 of the Act.

Article 8 inserts a new section 20A and 20B into the Act. These new sections allow an application to be re-instated where it has been refused or treated as refused or withdrawn as a direct consequence of the applicant failing to comply with a requirement of the Act or any rules within the applicable time limit. The new section 20B provides similar protection to those persons affected by a reinstatement under section 20A as is presently provided by section 28A in the case of a restoration of a lapsed patent under section 28.

Article 9 amends section 28 of the Act. This amendment will mean that an applicant will only have to show that their failure to pay the renewal fee on time was unintentional, instead of having to prove that they exercised reasonable care to see that the renewal fee was paid on time.

Article 10 amends section 30 of the Act so that in future only assignors or mortgagors will need to sign relevant transactions, such as assignments and mortgages of patents.

Article 11 amends section 60 of the Act. This amendment is part of the granting of third party rights by sections 20B and 117A of the Act (inserted respectively by article 8 and 22 of this Order).

Article 12 makes a consequential amendment to section 72 of the Act.

Article 13 amends section 76 of the Act, so that where a reference to an earlier application is filed in place of something that appears to be a description of an invention under section 15(1) (as inserted by this Order), the description that is filed under section 15(10) must not include new matter that is not contained in the referred to application. There are also some consequential changes made to rest of section 76.

Status: This is the original version (as it was originally made). This item of legislation is currently only available in its original format.

Articles 14 to 16 make consequential amendments to sections 78, 81 and 89B of the Act.

Articles 17 and 18 amend section 117 of the Act and insert new sections 117A and 117B into the Act. These changes will allow the comptroller to correct the mistaken withdrawal of an application. Similar protection is provided under section 117A as that provided under the new section 20B.

The new section 117B will enable the comptroller to extend certain time limits he has previously specified.

Article 19 makes a consequential amendment to section 130.

Articles 20 to 23 provides transitional provisions, which detail how any pending application will be affected by the changes to the Act.

A Regulatory Impact Assessment together with a more detailed explanation of the changes made by this Order, in particular the impact of the changes have on certain burdens, on any necessary protection and on the maintenance of rights and freedoms, is available either from the Patent Office website (www.patent.gov.uk) or by contacting the Patents Directorate, The Patent Office, Concept House, Cardiff Road, Newport, NP10 8QQ.