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STATUTORY INSTRUMENTS

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**2007 No. 3291**

**The Patents Rules 2007**

**PART 2**

**APPLICATIONS FOR PATENTS**

*Declarations of priority*

**Declaration of priority for the purposes of section 5(2) (priority date)**

**6.—**(1) Subject to paragraph (2) and rule 7(9), a declaration for the purposes of section 5(2) must be made at the time of filing the application for a patent.

(2) Subject to rule 7(9), a declaration for the purposes of section 5(2) may be made after the date of filing provided that—

- (a) it is made on Patents Form 3;
- (b) it is made before the end of the period of sixteen months beginning immediately following the date of filing of the earlier relevant application (or if there is more than one, the earliest of them) specified in that, or any earlier, declaration; and
- (c) the condition in paragraph (3) is met.

(3) The condition is that—

- (a) the applicant has not made a request under section 16(1) for publication of the application during the period prescribed for the purposes of that section; or
- (b) any request made was withdrawn before preparations for the application's publication have been completed by the Patent Office.

(4) A declaration for the purposes of section 5(2) must specify—

- (a) the date of filing of each earlier relevant application; and
- (b) the country it was filed in or in respect of.

(5) In the case of a new application filed as mentioned in section 15(9), no declaration shall be made which has not also been made in, or in connection with, the earlier application.

**Request to the comptroller for permission to make a late declaration under section 5(2B)**

**7.—**(1) The period prescribed for the purposes of section 5(2A)(b) is two months.

(2) Subject to paragraph (4), a request under section 5(2B) must be—

- (a) made on Patents Form 3; and
- (b) supported by evidence of why the application in suit was not filed before the end of the period allowed under section 5(2A)(a).

(3) Where that evidence does not accompany the request, the comptroller must specify a period within which the evidence must be filed.

(4) In relation to a new application, a request under section 5(2B) may be made in writing, instead of on Patents Form 3, and no evidence shall accompany it.

(5) Subject to paragraph (6) and rule 66(3), a request under section 5(2B) may only be made before the end of the period allowed under section 5(2A)(b).

(6) Where a new application is filed after the end of the period allowed under section 5(2A)(b), a request under section 5(2B) may be made on the initiation date.

(7) A request under section 5(2B) may only be made where—

- (a) the condition in paragraph (8) is met; or
- (b) the request is made in relation to an international application for a patent (UK).

(8) The condition is that—

- (a) the applicant has not made a request under section 16(1) for publication of the application during the period prescribed for the purposes of that section; or
- (b) any request made was withdrawn before preparations for the application's publication have been completed by the Patent Office.

(9) Where an applicant makes a request under section 5(2B), he must make the declaration for the purposes of section 5(2) at the same time as making that request.

### **Filing of priority documents to support a declaration under section 5(2)**

**8.—**(1) In respect of each priority application to which this paragraph applies the applicant must, before the end of the relevant period, furnish to the comptroller the application number of that application; otherwise the comptroller must disregard the declaration made for the purposes of section 5(2), in so far as it relates to the priority application.

(2) In respect of each priority application to which this paragraph applies the applicant must, before the end of the relevant period, furnish to the comptroller a copy of that application—

- (a) duly certified by the authority with which it was filed; or
- (b) otherwise verified to the satisfaction of the comptroller,

otherwise the comptroller must disregard the declaration made for the purposes of section 5(2), in so far as it relates to the priority application.

(3) Paragraph (1) applies to every priority application except where the application in suit is an international application for a patent (UK) and the application number of the priority application was indicated in compliance with the Patent Co-operation Treaty.

(4) Paragraph (2) applies to every priority application except where—

- (a) the application in suit is an international application for a patent (UK) and a certified copy of the priority application was filed in compliance with the Patent Co-operation Treaty; or
- (b) the priority application or a copy of the priority application is available to the comptroller.

(5) For the purposes of this rule the relevant period is sixteen months beginning with the declared priority date, subject to rule 21.

### **Translation of priority documents**

**9.—**(1) The comptroller may direct the applicant to comply with the requirements of paragraph (4), if—

- (a) a copy of the priority application has been—
  - (i) furnished in accordance with rule 8(2),
  - (ii) filed in compliance with the European Patent Convention,

- (iii) filed in compliance with the Patent Co-operation Treaty, or
  - (iv) made by the comptroller in accordance with rule 112(2);
  - (b) that copy is in a language other than English or Welsh; and
  - (c) the matters disclosed in the priority application are relevant to the determination of whether or not an invention, to which the application in suit relates, is new or involves an inventive step.
- (2) In his direction under paragraph (1), the comptroller shall specify a period within which the applicant must comply with the requirements of paragraph (4).
- (3) But the comptroller shall not specify a period that ends after the grant of the patent.
- (4) Where the comptroller has given a direction under paragraph (1), the applicant must, before the end of the period specified by the comptroller, file—
- (a) an English translation of the priority application; or
  - (b) a declaration that the application in suit is a complete translation into English of the priority application,
- otherwise the comptroller must disregard the declaration made for the purposes of section 5(2), in so far as it relates to the priority application.