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STATUTORY INSTRUMENTS

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**2007 No. 3291**

**The Patents Rules 2007**

**PART 6**

**INTERNATIONAL APPLICATIONS**

*Interpretation*

**Interpretation relating to international applications**

**64.** In this Part the following have the same meaning as they have in the Patent Co-operation Treaty—

- “competent receiving Office”;
- “International Preliminary Examination Report”;
- “International Preliminary Report on Patentability”;
- “International Search Report”;
- “International Searching Authority”;
- “receiving Office”.

*Filing at the Patent Office*

**Filing of international applications at the Patent Office**

**65.**—(1) An international application for a patent filed at the Patent Office as a competent receiving Office under the Patent Co-operation Treaty must [<sup>F1</sup>be filed in English or Welsh.]

<sup>F2</sup>(2) .....

(3) Where the Patent Office was acting on behalf of the International Bureau as the receiving Office, the comptroller shall only transmit an international application for a patent filed at the Patent Office to the International Bureau and the International Searching Authority after the appropriate fee has been paid.

(4) A request under the Treaty for a certified copy of an international application for a patent (including any corrections to that application) filed at the Patent Office as the competent receiving Office must be filed on Patents Form 23.

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**Textual Amendments**

- F1** Words in rule 65(1) substituted (1.10.2016) by [The Patents \(Amendment\) \(No. 2\) Rules 2016 \(S.I. 2016/892\)](#), rules 1(2), **11(a)**
- F2** Rule 65(2) omitted (1.10.2016) by virtue of [The Patents \(Amendment\) \(No. 2\) Rules 2016 \(S.I. 2016/892\)](#), rules 1(2), **11(b)**

*Beginning the national phase, international exhibitions and altered prescribed periods*

**Beginning of national phase**

**66.**—(1) The prescribed period for the purposes of section 89A(3)(a) and (5)(a) is thirty one months [<sup>F3</sup>beginning immediately after]—

- (a) where there is no declared priority date, the date of filing of the application;
- (b) where there is a declared priority date, that date.

(2) But where the applicant has been notified under rule 69(5), the period prescribed for the purposes of section 89A(3)(a) and (5)(a) is three months [<sup>F4</sup>beginning immediately after] the date of the notification.

(3) Where an international application for a patent (UK) has begun the national phase, a request for permission to make a late declaration may be made under section 5(2B) before the end of the period of one month [<sup>F5</sup>beginning immediately after] the date the national phase of the application begins.

**Textual Amendments**

- F3** Words in [rule 66\(1\)](#) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), [rules 1, 3, Sch.](#) (with [rule 4](#))
- F4** Words in [rule 66\(2\)](#) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), [rules 1, 3, Sch.](#) (with [rule 4](#))
- F5** Words in [rule 66\(3\)](#) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), [rules 1, 3, Sch.](#) (with [rule 4](#))

**[<sup>F6</sup>Amendment of international application before grant**

**66A.**—(1) This rule applies to an international application for a patent (UK) which has begun the national phase of the application.

(2) The period within which an applicant may amend his application under section 19(1) is as follows.

(3) Where during the international phase of the application, the International Searching Authority has sent to the applicant the International Search Report relating to the invention, the period within which the applicant may amend his application is the period beginning with the date on which the national phase of the application begins and ending with the date on which the comptroller sends the applicant the first substantive examination report.

(4) Where during the international phase of the application, the International Searching Authority has not sent to the applicant the International Search Report relating to the invention, the period during which the applicant may amend his application is the first to commence of—

- (a) the period prescribed by [rule 31\(3\)](#); and
- (b) the period beginning with the date on which the International Searching Authority sends the International Search Report to the applicant and ending with the date on which the comptroller sends the applicant the first substantive examination report.]

**Textual Amendments**

- F6** [Rule 66A](#) inserted (1.10.2016) by [The Patents \(Amendment\) \(No. 2\) Rules 2016 \(S.I. 2016/892\)](#), [rules 1\(2\), 12](#)

## International exhibitions

67.—(1) Paragraph (2) applies where an applicant, on filing an international application for a patent (UK), states in writing to the receiving office that the invention has been displayed at an international exhibition.

(2) The prescribed period for the purposes of section 2(4)(c) is two months [<sup>F7</sup>beginning immediately after] the date on which the national phase begins.

### Textual Amendments

**F7** Words in rule 67(2) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with rule 4)

## Altered prescribed periods

68.—(1) This rule applies to an international application for a patent (UK) which has begun the national phase of the application.

(2) The period prescribed for the purposes of section 13(2) is—

- (a) the period prescribed by rule 10(3); or
- (b) if it expires later, the period of two months [<sup>F8</sup>beginning immediately after] the date on which the national phase begins.

(3) The period prescribed for the purposes of sections 15(10)(c) and (d) and 17(1) is—

- (a) the period prescribed by rule 22(2) and (7); or
- (b) if it expires later, the period of two months [<sup>F9</sup>beginning immediately after] the date on which the national phase begins.

(4) The period prescribed for the purposes of section 18(1) is—

- (a) thirty three months [<sup>F10</sup>beginning immediately after]—
  - (i) where there is no declared priority date, the date of filing of the application; or
  - (ii) where there is a declared priority date, that date; or
- (b) if it expires later, the period of two months [<sup>F11</sup>beginning immediately after] the date on which the national phase begins.

### Textual Amendments

**F8** Words in rule 68(2)(b) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with rule 4)

**F9** Words in rule 68(3)(b) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with rule 4)

**F10** Words in rule 68(4)(a) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with rule 4)

**F11** Words in rule 68(4)(b) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with rule 4)

### *Translations*

#### **Necessary translations under section 89A(3) and (5)**

**69.**—(1) A translation is necessary for the purposes of section 89A(3) where any of the following are not in English—

- (a) the international application for a patent (UK) as published in accordance with the Patent Co-operation Treaty;
- (b) where the information mentioned in paragraph 3(2)(a) and (b) of Schedule 1 (biological material) has been provided, that information.

(2) Where the applicant expressly requests the comptroller to proceed with the national phase before the end of the period prescribed by rule 66(1), the translation must include the request and abstract.

(3) But paragraph (2) does not apply where a copy of the application, as published in accordance with the Patent Co-operation Treaty, is available to the comptroller.

(4) A translation of an amendment is necessary for the purposes of section 89A(5) where any amendment made to the application is not in English and has either been—

- (a) published under the Patent Co-operation Treaty; or
- (b) annexed to the International Preliminary Examination Report.

(5) At the end of the period prescribed by rule 66(1), the comptroller must notify the applicant that a necessary translation is missing if—

- (a) a translation of the application has been filed, but a translation of the amendment has not been filed; or
- (b) the information mentioned in paragraph 3(2)(a) and (b) of Schedule 1 (biological material) has been provided, but a translation of that information has not been filed,

and the prescribed fee has been paid.

#### **Requirements of necessary translations**

**70.**—(1) This rule applies to translations which are necessary for the purposes of section 89A(3) and (5).

(2) Such a translation is necessary for only that part of the application which is in a language other than English.

(3) Where the application includes a drawing which is annotated, the translation shall include either—

- (a) a copy of the original drawing where the original annotations have been replaced by annotations in English; or
- (b) a new drawing with the annotations in English.

(4) Where a title has been established for the application by the International Searching Authority, the translation must include that title (and not any title which was included in the application as it was originally filed).

(5) Where—

- (a) the description of the invention includes a sequence listing; and
- (b) the listing complies with the relevant requirements of the Patent Co-operation Treaty,

the translation of the application may exclude a translation of the sequence listing.

(6) This rule applies to translations of amendments as it applies to translations of applications and accordingly references to “application” shall be construed as references to “amendment”.

*Application deemed withdrawn or filing date refused under the Patent Co-operation Treaty*

### **Directions under section 89(3) and (5)**

**71.**—(1) The applicant may, before the end of the relevant period, make a written request to the comptroller to give a direction under section 89(5).

(2) The applicant may notify the comptroller that the circumstances mentioned in section 89(3) or rule 72 apply to his application.

(3) The request under paragraph (1) must be accompanied by—

- (a) a statement of the reasons for the request; and
- (b) the fee prescribed for the purposes of section 89A(3).

(4) The relevant period is two months [<sup>F12</sup>beginning immediately after] the date on which—

- (a) the International Bureau; or
- (b) the receiving Office,

notifies the applicant that his international application for a patent (UK) is refused a filing date under the Patent Co-operation Treaty.

(5) Where the applicant has made a request to the comptroller under paragraph (1), the comptroller may direct the applicant to furnish him with any document, information or evidence within such period as the comptroller may specify.

(6) Where the applicant fails, before the end of the period specified, to comply with a direction given under paragraph (5), the comptroller may treat him as having withdrawn his request.

(7) Where section 89(3) applies or a direction has been given under section 89(5) the comptroller may—

- (a) alter any period of time (whether it has already expired or not) specified in the Act or listed in Parts 1 to 3 of Schedule 4; and
- (b) amend any document kept at the Patent Office in relation to the application,

subject to such conditions as the comptroller may direct.

#### **Textual Amendments**

**F12** Words in [rule 71\(4\)](#) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), [rules 1, 3, Sch.](#) (with [rule 4](#))

### **Circumstance prescribed for the purposes of section 89(3)**

**72.** The other circumstance prescribed for the purposes of section 89(3) is where the comptroller determines that, in comparable circumstances in relation to an application under the Act (other than an international application for a patent (UK)), he would have exercised his powers under rule 107 or 108 to prevent the application being treated as withdrawn.

**Changes to legislation:**

There are currently no known outstanding effects for the The Patents Rules 2007, PART 6.