
STATUTORY INSTRUMENTS

2007 No. 3291

The Patents Rules 2007

PART 8

OPINIONS

Request for opinion

Request for an opinion under section 74A

93.—(1) A request must be made on Patents Form 17 and must be accompanied by a copy and a statement setting out fully—

- (a) the question upon which an opinion is sought;
- (b) the requester's submissions on that question; and
- (c) any matters of fact which are requested to be taken into account.

(2) The statement must be accompanied by—

- (a) the name and address of any persons, of whom the requester is aware, having an interest in that question; and
- (b) particulars of any relevant proceedings of which the requester is aware which relate to the patent in suit and which may be relevant to that question.

(3) However, where the requester is acting as an agent in making the request, the persons referred to in paragraph (2)(a) do not include the person for whom the requester is so acting.

(4) The statement shall be accompanied by a copy of any evidence or other document (except a document which has been published by the comptroller or is kept at the Patent Office) which is referred to in the statement.

(5) Each such statement, evidence or other document must be provided in duplicate.

Refusal or withdrawal of request

94.—(1) The comptroller shall not issue an opinion if—

- (a) the request appears to him to be frivolous or vexatious; or
- (b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.

(2) The comptroller shall not issue an opinion if the requester gives him notice in writing that the request is withdrawn.

(3) If the comptroller intends at any time—

- (a) to refuse the request because the condition in paragraph (1)(a) or (b) is satisfied; or
- (b) to refuse the request because, in accordance with section 74A(3)(b), he considers it inappropriate in all the circumstances to issue an opinion,

he shall notify the requester accordingly.

Notification and advertisement of request

95.—(1) The comptroller must notify each of the following persons of the request (except where the person concerned is the requester)—

- (a) the patent holder;
- (b) any holder of a licence or sub-licence under the patent in suit which has been registered under rule 47;
- (c) any person who has made a request in respect of the patent in suit under rule 54 regarding an opinion being requested under rule 93;
- (d) any person who is specified under rule 93(2)(a).

(2) In addition, the comptroller may notify of the request any persons who appear to him to be likely to have an interest in the question upon which the opinion is sought.

(3) The comptroller must send a copy of the form and statement filed under rule 93(1) to each person so notified, together with a copy of such other documents filed under rule 93 as he thinks fit.

(4) The comptroller must advertise a request in such manner as he thinks fit.

(5) However, if the request is refused or withdrawn before a notification has been made under paragraph (1)—

- (a) the patent holder alone must be notified of the request (and of the fact that it has been refused or withdrawn); and
- (b) paragraphs (3) and (4) do not apply.

Submission of observations and observations in reply

96.—(1) If the request has not been refused or withdrawn, any person may, before the end of the relevant period, file observations on any issue raised by the request.

(2) Such observations may include reasons why the comptroller should refuse the request.

(3) Any person who files observations under paragraph (1) must ensure that, before the end of the relevant period, a copy of those observations is received—

- (a) where that person is not the patent holder, by the patent holder; and
- (b) by the requester.

(4) A person to whom observations are sent under paragraph (3) may, during the period of two weeks beginning immediately after the end of the relevant period, file observations confined strictly to matters in reply.

(5) Any person who files observations under paragraph (4) must ensure that, within that period of two weeks, a copy of those observations is received—

- (a) where that person is the requester, by the patent holder; and
- (b) where that person is the patent holder, by the requester.

(6) If it is reasonably possible, the observations filed under this rule and the copies of such observations shall be delivered only in electronic form or using electronic communications.

(7) For the purposes of this rule, the relevant period is four weeks beginning with the date of advertisement under rule 95(4).

Issue of the opinion

97.—(1) After the end of the procedure under rule 96, the comptroller must refer the request to an examiner for the preparation of the opinion.

- (2) The comptroller must issue the opinion that has been prepared by sending a copy to—
- (a) the requester;
 - (b) the patent holder; and
 - (c) any other person who filed observations under rule 96(1).