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STATUTORY INSTRUMENTS

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**2007 No. 3291**

**The Patents Rules 2007**

**PART 8**

**OPINIONS**

*Interpretation*

**Interpretation**

**92.** In this Part—

“request” means, unless the context otherwise requires, a request for an opinion under section 74A <sup>M1</sup>;

“requester” means the person who makes that request;

“patent in suit” means the patent to which that request relates;

“patent holder” means the proprietor of that patent and any exclusive licensee of the patent; and

“relevant proceedings” means proceedings (whether pending or concluded) before the comptroller, the court or the European Patent Office.

**Marginal Citations**

**M1** 1977 c.37; section 74A was inserted by the Patents Act 2004 (c.16), section 13.

*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.

[<sup>F1</sup>(6) The prescribed matters for the purposes of section 74A(1) are as follows—

- (a) whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;
- (b) whether, or to what extent, an invention for which the patent has been granted is not a patentable invention;
- (c) whether the specification of the patent discloses the invention clearly enough and completely enough for it to be performed by a person skilled in the art;
- (d) whether the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed or, if the patent was granted on a new application, in the earlier application as filed;
- (e) whether the protection conferred by the patent has been extended by an amendment which should not have been allowed;
- (f) whether a supplementary protection certificate is invalid under Article 15 of the Medicinal Products Regulation; and
- (g) whether a supplementary protection certificate is invalid under Article 15 of the Plant Protection Products Regulation.]

#### Textual Amendments

**F1** [Rule 93\(6\)](#) inserted (1.10.2014) by [The Patents \(Amendment\) \(No. 2\) Rules 2014 \(S.I. 2014/2401\)](#), rules 1, **10**

#### 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 [<sup>F2</sup>beginning immediately after] the date of advertisement under rule 95(4).

#### **Textual Amendments**

- F2** Words in rule 96(7) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), rules 1, 3, [Sch.](#) (with rule 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).

*Review of opinion*

**Review of opinion**

**98.**—(1) The patent holder may, before the end of the period of three months [<sup>F3</sup>beginning immediately after] the date on which the opinion is issued, apply to the comptroller for a review of the opinion.

(2) However, such proceedings for a review may not be brought (or if brought may not be continued) if the issue raised by the review has been decided in other relevant proceedings.

(3) The application must be made on Patents Form 2 and be accompanied by a copy and a statement in duplicate setting out the grounds on which the review is sought.

(4) The statement must contain particulars of any relevant proceedings of which the applicant is aware which may be relevant to the question whether the proceedings for a review may be brought or continued.

- (5) The application may be made on the following grounds only—
- (a) that the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent; or
  - (b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

**Textual Amendments**

**F3** Words in [rule 98\(1\)](#) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), [rules 1, 3, Sch.](#) (with [rule 4](#))

**Procedure on review**

**99.**—(1) On receipt of the application, the comptroller must send a copy of the form and statement filed under rule 98 to—

- (a) the requester (if different from the applicant); and
- (b) any person who filed observations under rule 96.

(2) The comptroller must advertise the application in such manner as he thinks fit.

(3) Before the end of the relevant period, any person may file a statement in support of the application or a counter-statement contesting it (which in either case must be in duplicate), and on so doing shall become a party to the proceedings for a review.

- (4) For the purposes of paragraph (3) the relevant period is—
- (a) four weeks [<sup>F4</sup>beginning immediately after] the date on which the application is advertised under paragraph (2); or
  - (b) if it expires later, the period of two months [<sup>F5</sup>beginning immediately after] the date on which the opinion is issued under rule 97(2).

(5) The comptroller shall send to the other parties a copy of each statement or counter-statement filed under paragraph (3).

(6) The rules listed in Parts 4 and 5 of Schedule 3 shall apply to the proceedings for a review and for the purposes of rule 83(3)—

- (a) a reference to “the claimant” is a reference to the applicant for a review; and
- (b) a reference to “the defendant” is a reference to any other party.

#### Textual Amendments

- F4** Words in rule 99(4)(a) 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 99(4)(b) substituted (1.10.2011) by [The Patents \(Amendment\) Rules 2011 \(S.I. 2011/2052\)](#), [rules 1, 3](#), [Sch.](#) (with [rule 4](#))

#### Outcome of review

**100.**—(1) On completion of the proceedings under rule 99 the comptroller shall either—

- (a) set aside the opinion in whole or in part; or
- (b) decide that no reason has been shown for the opinion to be set aside.

(2) A decision under paragraph (1)(a) or (b) shall not estop any party to any proceedings from raising any issue regarding the validity or the infringement of the patent.

(3) No appeal under section 97 shall lie from a decision to set aside the opinion under paragraph (1)(a), except where the appeal relates to a part of the opinion that is not set aside.

**Changes to legislation:**

There are currently no known outstanding effects for the The Patents Rules 2007, PART 8.