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STATUTORY INSTRUMENTS

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**2007 No. 3291**

**The Patents Rules 2007**

**PART 9**

**MISCELLANEOUS**

*Agents and advisers*

**Agents**

**101.**—(1) Any act required or authorised by the Act or these Rules to be done by or to any person in connection with an application for a patent, or any procedure relating to a patent, may be done by or to an agent authorised by that person orally or in writing—

- (a) where an agent is appointed when a person starts or joins any proceeding under the Act, once the comptroller has been notified of his appointment in writing; or
- (b) where an agent is appointed after a person has started or joined any proceeding under the Act, once Patents Form 51 has been filed in duplicate.

(2) Where an agent has been authorised under paragraph (1), the comptroller may, in any particular case, require the signature or presence of his principal.

**Appointing advisers**

**102.** The comptroller may appoint an adviser to assist him in any proceeding before him and shall settle any question or instructions to be given to the adviser.

*Address for service*

**Address for service**

**103.**—(1) For the purposes of any proceeding under the Act or these Rules, an address for service must be furnished by—

- (a) an applicant for the grant of a patent;
- (b) a person who makes any other application, reference or request or gives any notice of opposition under the Act; and
- (c) any person opposing such an application, reference, request or notice.

(2) The proprietor of a patent, or any person who has registered any right in or under a patent or application, may furnish an address for service by notifying the comptroller.

(3) Where a person has furnished an address for service under paragraph (1) or (2), he may substitute a new address for service by notifying the comptroller.

(4) An address for service furnished under paragraph (1)(a) or (2) must be an address in the United Kingdom, another EEA State or the Channel Islands.

(5) An address for service furnished under paragraph (1)(b) or (c) must be an address in the United Kingdom, unless in a particular case the comptroller otherwise directs.

#### **Failure to furnish an address for service**

**104.**—(1) Where—

- (a) a person has failed to furnish an address for service under rule 103(1); and
- (b) the comptroller has sufficient information enabling him to contact that person,

the comptroller shall direct that person to furnish an address for service.

(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of two months beginning with the date of the direction, furnish an address for service.

(3) Paragraph (4) applies where—

- (a) a direction was given under paragraph (1) and the period prescribed by paragraph (2) has expired; or
- (b) the comptroller had insufficient information to give a direction under paragraph (1),

and the person has failed to furnish an address for service.

(4) Where this paragraph applies—

- (a) in the case of an applicant for the grant of a patent, the application shall be treated as withdrawn;
- (b) in the case of a person mentioned in rule 103(1)(b), his application, reference, request or notice of opposition shall be treated as withdrawn; and
- (c) in the case of a person mentioned in rule 103(1)(c), he shall be deemed to have withdrawn from the proceedings.

(5) In this rule an “address for service” means an address which complies with the requirements of rule 103(4) or (5).

#### *Corrections and remission of fees*

#### **Correction of errors**

**105.**—(1) A request to the comptroller to correct an error or mistake under section 117 must be made in writing and identify the proposed correction.

(2) The comptroller may, if he thinks fit, require the person requesting a correction to produce a copy of the document indicating the correction.

(3) Where the request is to correct a specification of a patent or application, the request shall not be granted unless the correction is obvious (meaning that it is immediately evident that nothing else could have been intended in the original specification).

(4) But paragraph (3) does not apply where the error in the specification of the patent or application is connected to the delivery of the application in electronic form or using electronic communications.

(5) Where the comptroller determines that no person could reasonably object to the correction no advertisement shall be published under rule 75.

(6) Where the comptroller is required to publish a notice under section 117(3), it must be published in the journal.

(7) This rule does not apply to a correction of a name, address or address for service (which may be corrected under rule 49).

### **Remission of fees**

- 106.**—(1) A person may apply to the comptroller for the remission of a fee.
- (2) The comptroller may remit the whole or part of a search fee where—
- (a) in relation to an international application for a patent (UK), a copy of the International Search Report (as defined in rule 64) for that application is available to the comptroller; or
  - (b) a new application for a patent is filed as mentioned in section 15(9) and, in connection with the earlier application, the applicant has already paid the search fee for the invention described in the new application.
- (3) The comptroller may remit the whole or part of any fee where—
- (a) a person has requested the comptroller or an examiner to do something in accordance with the Act or these Rules; and
  - (b) the request is withdrawn before it is carried out.
- (4) The comptroller may remit the whole or part of the fee payable in respect of a request for an opinion under section 74A where he has refused the request.
- (5) Where a supplementary protection certificate lapses or is declared invalid, the comptroller must remit any fee which has been paid in respect of the relevant period.
- (6) In paragraph (5) “the relevant period” is the period—
- (a) beginning with the next anniversary of the start date following the date the certificate lapsed or was declared invalid; and
  - (b) ending with the date the certificate would have expired but for its lapse or invalidity.
- (7) Any decision of the comptroller under this rule is excepted from the right of appeal conferred by section 97.

### **Correction of irregularities**

- 107.**—(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.
- (2) Any rectification made under paragraph (1) shall be made—
- (a) after giving the parties such notice; and
  - (b) subject to such conditions,
- as the comptroller may direct.
- (3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—
- (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and
  - (b) it appears to the comptroller that the irregularity should be rectified.

### *Time limits and delays*

### **Extension of time limits**

- 108.**—(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4.

(2) The comptroller shall extend, by a period of two months, any period of time prescribed by the provisions listed in Part 2 of Schedule 4 where—

- (a) a request is filed on Patents Form 52;
- (b) no previous request has been made under this paragraph; and
- (c) that request is filed before the end of the period of two months beginning with the date on which the relevant period of time expired.

(3) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by the rules listed in Part 2 of Schedule 4 where—

- (a) a request is filed on Patents Form 52; and
- (b) the person making the request has furnished evidence supporting the grounds of the request, except where the comptroller otherwise directs.

(4) Each request under paragraph (2) or (3) for a period of time to be extended must be made on a separate form unless—

- (a) each of those requests relate to the same patent or application for a patent; and
- (b) the grant of each of those requests would result in the expiry of all the extended periods of time on the same date,

in which case those requests may be combined and made on a single form.

(5) Any extension made under paragraph (1) or (3) shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the comptroller may direct, except that a period of time prescribed by the rules listed in Part 3 of Schedule 4 may be extended (or further extended) for a period of two months only.

(6) An extension may be granted under paragraph (1) or (3) notwithstanding the period of time prescribed by the relevant rule has expired.

(7) But no extension may be granted in relation to the periods of time prescribed by the rules listed in Part 3 of Schedule 4 after the end of the period of two months beginning immediately after the period of time as prescribed (or previously extended) has expired.

#### **Extension of time limits specified by comptroller**

**109.**—(1) A request under section 117B(2) must be—

- (a) made in writing; and
- (b) made before the end of the period prescribed by paragraph (2).

(2) The period prescribed for the purposes of section 117B(3) is two months beginning immediately after the expiry of the period to which section 117B(2) applies.

#### **Interrupted days**

**110.**—(1) The comptroller may certify any day as an interrupted day where—

- (a) there is an event or circumstance causing an interruption in the normal operation of the Patent Office; or
- (b) there is a general interruption or subsequent dislocation in the postal services of the United Kingdom.

(2) Any certificate of the comptroller given under paragraph (1) shall be displayed in the Patent Office and advertised in the journal.

(3) The comptroller shall, where the time for doing anything under the Act expires on an interrupted day, extend that time to the next following day not being an interrupted day (or an excluded day).

(4) In this rule—

“excluded day” means a day specified as an excluded day in directions given under section 120; and

“interrupted day” means a day which has been certified as such under paragraph (1).

### **Delays in communication services**

**111.**—(1) The comptroller shall extend any period of time specified in the Act or these Rules where he is satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the comptroller may direct.

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, electronic communications, and courier.

### *Copies available to the comptroller*

### **Copies available to the comptroller**

**112.**—(1) This rule applies where an applicant is not required to file a copy of an application at the Patent Office because that application or a copy of that application is available to the comptroller.

(2) Where this rule applies the comptroller shall make a copy (or further copy) of that application and certify it accordingly.

### *Translations*

### **Translations**

**113.**—(1) Where any document filed at the Patent Office, or sent to the comptroller, is in a language other than English or Welsh it must be accompanied by a translation into English of that document.

(2) But paragraph (1) does not apply to the following documents—

- (a) where the documents filed to initiate an application for a patent include something which is or appears to be a description of the invention, the document containing that thing;
- (b) a priority application;
- (c) a copy of an application provided under section 15(10)(b)(ii);
- (d) a copy of a specification of a European patent (UK) filed in connection with an application by the proprietor to amend the specification;
- (e) a copy of an application for a European patent (UK) provided under section 81(2)(b)(ii);
- (f) an international application for a patent (UK), where a translation of the application or an amendment to it is a necessary translation;
- (g) a document referred to in paragraph (5).

(3) Where more than one copy of the document mentioned in paragraph (1) is filed or sent, a corresponding number of translations shall accompany it.

(4) Where a document to which paragraph (1) applies is not accompanied by a translation, the comptroller may, if he thinks fit, take no further action in relation to that document.

(5) In relation to an international application for a patent (UK), where any document which is in a language other than English or Welsh is—

(a) referred to in an International Search Report or International Preliminary Report on Patentability; or

(b) cited in an International Preliminary Examination Report,

and the relevant report is filed at the Patent Office, the comptroller may direct that a translation into English of that document be filed.

(6) Where a direction is given under paragraph (5) a translation of that document must be filed before the end of the period of two months beginning with the date on which the direction is given; otherwise the comptroller may, if he thinks fit, take no further action in relation to the application.

(7) Subject to rule 82(1)(b), where a patent application or any document related to such application is filed at the Patent Office or sent to the comptroller in Welsh, and is not accompanied by a translation into English, the comptroller must obtain such a translation.

(8) In this rule a reference to a document includes a reference to a part of a document; and in paragraph (5) “International Preliminary Examination Report”, “International Preliminary Report on Patentability” and “International Search Report” and have the same meaning as in rule 64.

### **Translations in proceedings in relation to a European patent (UK)**

**114.**—(1) Where—

(a) proceedings are started before the comptroller in relation to a European patent (UK); and

(b) the specification of that patent was published in French or German,

the person who starts those proceedings shall file at the Patent Office a translation into English of the specification.

(2) But paragraph (1) shall not apply where—

(a) a translation into English of the specification has been filed under section 77(6); or

(b) the comptroller directs that a translation is unnecessary.

(3) Where, in the course of such proceedings, leave is given to amend the specification of the patent, the proprietor shall file at the Patent Office a translation of the amendment into the language in which the specification of the patent was published.

(4) This rule applies to making a request for an opinion under section 74A as it applies to proceedings started before the comptroller.

### **Establishing the accuracy of translations**

**115.** If the comptroller has reasonable doubts about the accuracy of any translation of a document that has been filed at the Patent Office by any person in accordance with the Act or these Rules—

(a) he shall notify that person of the reasons for his doubts; and

(b) he may require that person to furnish evidence to establish that the translation is accurate,

and where that person fails to furnish evidence the comptroller may, if he thinks fit, take no further action in relation to that document.

### *Supplementary Protection Certificates*

#### **Supplementary protection certificates**

**116.**—(1) An application for—

- (a) a supplementary protection certificate shall be made on Patents Form SP1; and
- (b) an extension of the duration of a supplementary protection certificate under Article 8 of the Medicinal Products Regulation shall be made on Patents Form SP4.

(2) The period prescribed for the purposes of paragraph 5(a) of Schedule 4A to the Act is—

- (a) three months ending with the start date; or
- (b) where the certificate is granted after the beginning of that period, three months beginning with the date the supplementary protection certificate is granted.

(3) The comptroller must send a notice to the applicant for the certificate—

- (a) before the beginning of the period of two months immediately preceding the start date; or
- (b) where the certificate is granted as mentioned in paragraph (2)(b), on the date the certificate is granted.

(4) The notice must notify the applicant for the certificate of—

- (a) the fact that payment is required for the certificate to take effect;
- (b) the prescribed fee due;
- (c) the date before which payment must be made; and
- (d) the start date.

(5) The prescribed fee must be accompanied by Patents Form SP2; and once the certificate has taken effect no further fee may be paid to extend the term of the certificate unless an application for an extension of the duration of the certificate is made under the Medicinal Products Regulation.

(6) Where the prescribed fee is not paid before the end of the period prescribed for the purposes of paragraph 5(a) of Schedule 4A to the Act, the comptroller shall, before the end of the period of six weeks beginning immediately after the end of that prescribed period, and if the fee remains unpaid, send a notice to the applicant for the certificate.

(7) The notice shall remind the applicant for the certificate—

- (a) that payment is overdue; and
- (b) of the consequences of non-payment.

(8) The comptroller must send the notices under this rule to—

- (a) the applicant's address for service; and
- (b) the address to which a renewal notice would be sent to the proprietor of the basic patent under rule 39(3).

### *Publications*

#### **The journal**

**117.** The comptroller must publish a journal containing—

- (a) particulars of applications for and grants of patents and of other proceedings under the Act;
- (b) any directions given under section 120(1) specifying hours of business or excluded days;
- (c) any directions under section 123(2A) setting out forms; and

- (d) any other information that the comptroller considers to be generally useful or important.

### **Reports of cases**

**118.** The comptroller must make arrangements for the publication of—

- (a) reports of cases relating to patents, trade marks, registered designs or design right decided by him; and
- (b) reports of cases relating to patents (whether under the Act or otherwise), trade marks, registered designs, copyright and design right decided by any court or body (whether in the United Kingdom or elsewhere).

### **Publication and sale of documents**

**119.** The comptroller may arrange for the publication and sale of copies of documents (in particular, specifications of patents and applications for patents) in the Patent Office.

### *Transitional provisions and revocations*

### **Transitional provisions and revocations**

- 120.**—(1) Schedule 5 (transitional provisions) shall have effect.
- (2) The instruments set out in Schedule 6 (revocations) shall be revoked to the extent specified.