

## 2007 No. 677

### PATENTS

#### The Patents (Amendment) Rules 2007

<i>Made</i>	- - - -	<i>4th March 2007</i>
<i>Laid before Parliament</i>		<i>6th March 2007</i>
<i>Coming into force</i>	- -	<i>1st April 2007</i>

The Secretary of State makes the following Rules in exercise of the powers conferred on him by section 123 of the Patents Act 1977<sup>(a)</sup>:

1. These Rules may be cited as the Patents (Amendment) Rules 2007 and they come into force on 1st April 2007.

2. The Patents Rules 1995<sup>(b)</sup> are amended as follows.

#### **Late declaration of priority for international application for a patent (UK)**

3.—(1) Rule 6A (request to the comptroller for a late declaration) is amended as follows.

(2) After paragraph (1) insert—

“(1A) Subject to rule 85(3A), a request under section 5(2B) may only be made before the end of the period allowed under section 5(2A)(b).”.

(3) For paragraph (2) substitute—

“(2) A request under section 5(2B) shall be—

(a) made on Form 3/77; 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).

(2A) Such a request may only be made where—

(a) the condition in paragraph (3) is met; or

(b) the request is made in relation to an international application for a patent (UK).”.

(4) Rule 85 (international applications for patents) is amended as follows.

(5) After paragraph (3) insert—

“(3A) Where an international application for a patent (UK) has begun the national phase, a request may be made under section 5(2B) before the end of the period of 1 month beginning with the date the national phase of the application begins.”.

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<sup>(a)</sup> 1977 c. 37; to which there are amendments not relevant to these Rules.

<sup>(b)</sup> S.I. 1995/2093, amended by S.I. 2002/529, 2003/513, 2004/2358, 2005/2496; there are other amending instruments but none is relevant.

(6) The amendments made by this rule shall not apply to any international application for a patent (UK) which began the national phase of the application before the coming into force of these Rules.

#### **Removing requirement to file duplicates in respect of patent applications**

4.—(1) Rule 20 (size and presentation of documents) is amended as follows—

- (a) paragraph (2) is revoked;
- (b) in paragraph (16), for “(2)” substitute “(3)”.

(2) What is now rule 112 (copies of documents) shall become paragraph (1) of rule 112, and after that paragraph insert—

“(2) A specification filed under rule 40(8), 53(ii), 77(2) or 78(5) shall be filed in duplicate.”.

(3) The amendments made by this rule shall not apply to any application for a patent filed before 26 June 2006.

#### **Removing restriction on inspection of newly filed documents**

5.—(1) In rule 93 (inspection of documents), paragraph (4)(a) is revoked.

(2) In rule 94 (confidential documents), paragraph (5) is revoked.

(3) The amendments made by this rule shall not apply to any document filed at the Patent Office before the coming into force of these Rules.

#### **Alteration of time limits**

6. In Schedule 4A, Part 1, after “rule 82(1) (request from a foreign industrial property office for a direction under section 81)” insert—

“rule 85(3A) (international applications for patents)”.

4th March 2007

*Malcolm Wicks*  
Minister for Science and Innovation  
Department of Trade and Industry

## **EXPLANATORY NOTE**

*(This note is not part of the Rules)*

These Rules make further amendments to the Patents Rules 1995 (SI 1995/2093) (“the 1995 Rules”).

These Rules and the 1995 Rules are made under the Patents Act 1977 (c. 37) (“the 1977 Act”). The 1977 Act and the 1995 Rules together comprise the principal United Kingdom legislation on patents. The amendments to the 1995 Rules made by this instrument concern the following matters.

### **Late declaration of priority for international application for a patent (UK)**

Rule 3 makes changes which implement the amended Regulations under the Patent Co-operation Treaty (“PCT”). The PCT, which currently has 136 contracting states, provides a streamlined procedure by which patents in many countries may be acquired by filing a single international patent application at one of a number of selected patent offices. From 1 April 2007, the PCT Regulations will allow an applicant to request that his international application is given a “priority date” which is up to 14 months earlier than the actual date of filing of the application – if various conditions are met.

In particular, new rule 49ter PCT will allow a request to be made either with the relevant Receiving Office in the international phase of the patent application, or with each relevant designated Office in the national phase. Rule 49ter.2 PCT states that the applicant has up to one month from entry into the national phase to make such a request with the relevant designated Office.

Rule 3 accordingly amends rules 6A and 85 of the 1995 Rules, so that the rule 6A deadline for making a request is disappplied for international applications. Instead, the one month deadline from national phase entry is set out in new rule 85(3A) of the 1995 Rules. By virtue of the amendment made by rule 6, this deadline is not extendable.

A late declaration request is generally not allowed under rule 6A of the 1995 Rules if the applicant has requested (early) publication of his application under section 16 of the 1977 Act. Rule 3 amends rule 6A of the 1995 Rules so that this restriction does not apply to a request for a late declaration on an international application which has entered the national phase. This is because rule 49ter PCT does not envisage such a restriction.

The amendments do not apply to an international application which has entered the national phase before 1 April 2007.

### **Removing requirement to file duplicates in respect of patent applications**

Rule 4 amends rule 20 of the 1995 Rules so that there is no longer a requirement to file duplicate copies of documents provided in connection with a patent application. However, rule 112 of the 1995 Rules is amended to clarify that it will remain necessary to file duplicate documents in connection with amendment of a patent after grant.

The requirement to file duplicates will cease for all patent applications filed on or after 1 April 2007. It will also no longer be necessary to file duplicates on pending patent applications, if those applications were filed on or after 26 June 2006. That is because such applications are held only as electronic case-files within the Patent Office. For pending patent applications filed before 26 June 2006, it will be necessary to continue to file duplicate copies of documents.

### **Confidentiality of documents at the Patent Office**

Rule 5 amends rules 93 and 94 of the 1995 Rules in order to remove the requirement that documents filed at the Office remain confidential for fourteen days after filing. This will mean that, generally speaking, any document which relates to a published patent application or patent will be open to inspection on filing. However, rule 94(1) to (4) of the 1995 Rules remains in place, so that a request for confidentiality can be made at the time of filing the document, or up to fourteen days afterwards. If such a request is made, the document will not become open, or will cease to be open, while the request is considered.

The amended provisions will apply to any document filed on or after 1 April 2007.

A regulatory impact assessment has been prepared for this instrument. It was placed in the libraries of both Houses of Parliament and is also available from the Patent Office, Patents Legal Section, Concept House, Newport, South Wales, NP10 8QQ.

**£3.00**

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