

1980 No. 1783

PATENTS

The Patents (Amendment No. 4) Rules 1980

Made - - - - 20th November 1980

Laid before Parliament 3rd December 1980

Coming into Operation 5th January 1981

The Secretary of State, in exercise of the powers conferred upon him by sections 120(1) and 123 of the Patents Act 1977(a) and of all other powers enabling him in that behalf, after consultation with the Council on Tribunals and, as regards rule 2(aa) and (dd) hereof, with the consent of the Treasury, hereby makes the following Rules:—

1. These Rules may be cited as the Patents (Amendment No. 4) Rules 1980 and shall come into operation on 5th January 1981.

2. The Patents Rules 1978(b) shall have effect subject to the following amendments:—

- (a) in rule 2(1)(a) for the word “applications” there shall be substituted the word “application”;
- (b) in rule 6(3) for the words “period specified” there shall be substituted the words “period prescribed”;
- (c) in the proviso to rule 6(6) for the words “25 months” there shall be substituted the words “26 months”;
- (d) in rule 15(1) after the words “rules 26” there shall be inserted the words “, 81(3), 82(3)”;
- (e) in rule 15(2) for the words “the or each inventor” there shall be substituted the words “each inventor who is not one of the applicants”;
- (f) in rule 17(1)(a)(i) for the word “that” there shall be substituted the word “than” and in the proviso to rule 17(2)(b) for the word “governmental” there shall be substituted the word “government”;
- (g) in rule 19(1) for the words “indicate the title of” there shall be substituted the words “commence with a title for”;
- (h) for rule 26 there shall be substituted the following rule:—

“26.—(1) Where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) after the period of 16 months prescribed in either rule 6 or rule 15 above, the requirements of those rules shall be complied with at the time of filing the new application:

(a) 1977 c. 37.

(b) S.I. 1978/216, amended by S.I. 1980/137, 498, 1146.

Provided that where a new application is filed under section 15(4) after the expiration of the period of 16 months prescribed in either rule 6(2) or rule 15(1) and the period has been extended in respect of the earlier application under rule 110(3) below, the requirements of rule 6(2) and (3) or 15, as the case may be, shall be complied with by the end of the extended period.

(2) Where such a new application is filed after the expiration of the period of 21 months prescribed in rule 6(6), the requirements of that sub-rule shall be complied with in relation to the new application at the time of filing it."

- (i) in rule 28 the word "technical" shall be deleted;
- (j) in rule 33:—
 - (i) in sub-rule (2) for the words "sub-rule (3) below" there shall be substituted the words "sub-rules (3) and (4) below";
 - (ii) in sub-rule (3) there shall be added the words ", except in the case of a new application made under section 8(3), 12(6) or 15(4) after the expiry of the said two years, when the request shall be made and the fee paid at the time of filing the new application.";
 - (iii) the following sub-rule shall be added:—
 - "(4) Where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) then:—
 - (a) if the new application is filed within two years calculated from the declared priority date or, where there is no declared priority date, from the date treated as its date of filing, the request shall be made and the fee for the examination paid within those two years; and
 - (b) if the new application is filed after the expiration of those two years, the request shall be made and the fee for the examination paid at the time of filing the new application.";
- (k) in rule 41(2) the words "prima facie" shall be deleted;
- (l) for rule 43(2) and (3) there shall be substituted the following:—
 - "(2) At any time within three months from the advertisement any person may give notice of opposition to the surrender to the comptroller on Patents Form No. 19/77.
 - (3) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and of the statement to the proprietor of the patent.";
- (m) for rule 78(1) and (2) there shall be substituted the following:—
 - "(1) Where in proceedings before the comptroller a proposed amendment under section 75 is advertised, notice of opposition to such an amendment shall, within the period of three months from the date of advertisement in the Journal, be filed on Patents Form No. 15/77.
 - (2) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The com-

ptroller shall send a copy of the notice and statement to the proprietor of the patent and any other party to the proceedings before the comptroller.”;

- (n) in rules 81(3) and 82(3) there shall be added the words “and, for the purposes of section 13(2), File Patents Form No. 7/77”;
- (o) in rule 85(1)(b) for the words “, the date of filing of the international application for a patent (UK);” there shall be substituted the words “and the United Kingdom has been so elected before the expiry of 19 months calculated from the date of filing of the international application for a patent (UK), the period of 25 months calculated from the date of filing of that international application;”;
- (p) in rule 85(3)(b) after the words “calculated from the declared priority date” there shall be inserted the words “or, where there is no declared priority date, the date of filing of the international application for a patent (UK)”;
- (q) in rule 90(1)(b) the words “, other than a request for grant” shall be deleted;
- (r) for rules 91(4) and (5) there shall be substituted the following:—
 “(4) Any person may, at any time within three months after the date of the advertisement, give notice to the comptroller of opposition to the request on Patents Form No. 48/77.
 (5) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts on which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and the statement to the person making the request who, if he desires to proceed with the request, shall within three months of the receipt of the copies file a counter-statement in duplicate setting out fully the grounds on which he contests the opposition and the comptroller shall send a copy of the counter-statement to the opponent.”;
- (s) in rule 98(a) for the words “6 p.m.” there shall be substituted the word “midnight”;
- (t) in rule 99(1) the words “in the Journal and” shall be deleted;
- (u) in rule 100 there shall be added the following proviso:—
 “Provided that, without prejudice to the comptroller’s power to extend any times or periods under rule 110 below and except where such irregularity is attributable wholly or in part to an error, default or omission on the part of the Office, the comptroller shall not direct that any period of time specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968(a), as they continue to apply, shall be altered.”;
- (v) in rule 110(1) for the word “term” there shall be substituted the word “terms”;
- (w) for rule 110(2) and (3) there shall be substituted the following:—
 “(2) The rules referred to in sub-rule (1) above are rules 6(1), 17(3), 23, 25(3) (except in so far as it relates to the filing of claims for the purposes of the application and also the abstract), 25(4), 26 (in so far as it relates to rule 6), 39(1) and (2), 40(2), 43(2), 60(2), 65(1), 66(1), 71(1), 78(1), 80, 81, 82, 91(4) and 123(1).

- (3) The periods prescribed in rules 6(2) and (6), 15(1), 17(2), 25(2), 26 (in so far as it relates to rule 15), 33(2), (3) and (4), 34, 83(3), 85(1)(a) and (b) and 3(b) and (c) above may be extended for not more than one month upon filing Patents Form No. 50/77.”;
- (x) in rule 111 there shall be added the following sub-rule:—
“(4) Where an application for a patent is filed upon the day immediately following a day which is certified under sub-rule (1) above as being one on which there is a general interruption or subsequent dislocation in the postal service of the United Kingdom or which is an excluded day for the purposes of section 120, the period of six months specified in section 2(4) shall be computed from the day following the next preceding day which is neither so certified nor so excluded.”;
- (y) in rule 113(1) there shall be added the following sentence:—
“Where the document is or forms part of an application for a patent, the Office shall not, in the absence of such a translation, take any further action in relation to that document, unless the comptroller otherwise directs.”;
- (z) in rule 113(3):—
(i) after the words “of that document” there shall be inserted the words “or any part thereof”; and
(ii) for the words “be filed within the two months” to the end there shall be substituted the words “, if the comptroller so directs, be filed within two months of the date on which such direction is given.”;
- (aa) in rule 120 there shall be added the words “and, upon request by the Office, payment shall also be made to it of an amount which is the equivalent in sterling of the search fee referred to in rule 118(2) above.”;
- (bb) in rule 124(1)(d) for the words “subject to sub-rule (3) below” there shall be substituted the words “subject to sub-rules (3) and (4) below”;
- (cc) in rule 124 there shall be added the following sub-rule:—
“(4) In rule 39(1), as it applies by virtue of sub-rule (1) above, the reference to the date of filing an application for a patent as determined in accordance with section 15 shall be treated as being a reference to the date of a patent.”;
- (dd) in Part A of Schedule 1:—
(i) for the words “the date of the patent”, wherever they appear, there shall be substituted the words “the date of filing of the application for the patent or, in the case of an existing patent, the date of the patent”;
- (ii) there shall be added to the entries in the second column relating to Patents Forms Nos. 1/77 and 42/77 the words “(the filing fee)”;
- (iii) there shall be added to the entry in the second column relating to Patents Form No. 12/77 after the words “in the case of an old existing patent”, which appear in respect of the 16th year, the words “in respect of the remainder of its term.”;
- (iv) for the entry in the second column relating to Patents Form No. 50/77 there shall be substituted “On request for extension of time. Each”; and

(*ee*) in Schedule 2:—

- (i) in Part IX of Patents Form No. 1/77, item B4, for the word “Apply” there shall be substituted the word “Grant”;
- (ii) in Note 8 to Patents Form 1/77 for the first sentence there shall be substituted the words “If the request is signed by an agent,”;
- (iii) in Patents Form No. 9/77 for paragraph II there shall be substituted the following:—

“II I/We

hereby request that, in addition to the search carried out by the examiner in relation to the first invention specified in the claims of my/our Patent Application No. a search shall also be carried out in relation to the following other invention specified therein, viz.”

and for Note 2 to that form there shall be substituted the following:—

“2. In the latter case, paragraph II should be completed in such a way as to identify the invention in relation to which the further search is being requested. Reference should be made to the claims in which that invention is specified. If this is not done, the further search will be made in relation to the second invention specified in the search report previously made under section 17(5).”

- (iv) in Patents Form No. 16/77 there shall be inserted after the words “restoration of Patent No. . . .” the words “My/our reasons for applying for this restoration are as follows:”;
- (v) in the title to Patents Forms No. 28/77 for the word “patentee” there shall be substituted the word “proprietor”;
- (vi) the following note shall be added to Patents Forms Nos. 41/77, 42/77 and 43/77:—

“The name, address and nationality of each applicant are to be stated on this form. If there is insufficient space on it for all this information, the rest should be set out on a separate sheet, which should be attached to this form when filed.”; and
- (vii) for Patents Form No. 50/77 there shall be substituted the Form in the Schedule to these Rules.

19th November 1980.

Reginald Eyre,
 Parliamentary Under-Secretary of State
 Department of Trade.

We consent to the making of rule 2(*aa*) and (*dd*) of these Rules.

20th November 1980.

Carol Mather,
J. A. Douglas-Hamilton,
 Two of the Lords Commissioners
 of Her Majesty's Treasury.

SCHEDULE

PATENTS ACT 1977

PATENTS FORM No. 50/77

(Rule 110(3))

The Comptroller
The Patent Office
25 Southampton Buildings
London WC2A 1AY

REQUEST FOR EXTENSION OF TIME

In the matter of application number

I/We

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.....

.....

hereby request an extension of time, as follows:

Signature

NOTES:

1. The person making the request should specify the extension required in the space provided.
2. A separate fee is payable for each extension.

EXPLANATORY NOTE

(This Note is not part of the Rules.)

These Rules further amend the Patents Rules 1978. The principal amendments are as follows:—

- (1) where there are no declared priority dates, certain periods for doing acts are to be calculated from dates of filing the international application concerned (Rule 85(1)(b));
- (2) on weekdays other than Saturdays, the Office will be deemed to be closed for the filing of applications, forms and other documents at midnight instead of 6 p.m. (Rule 98(a));
- (3) the requirement that excluded days be notified in the Official Journal (Patents) is removed (Rule 99(1));
- (4) the number of time limits to which Patents Form No. 50/77 can apply is increased (Rule 110(3));
- (5) where a document forming part of an application for a patent is filed in a language other than English without a translation, it will not be further processed, unless the comptroller otherwise directs (Rule 113(1));
- (6) translation of documents referred to in search reports made under the European Patent Convention or the Patent Co-operation Treaty will only be required if the comptroller so directs (Rule 113(3)); and
- (7) the comptroller is given power to call for payment of certain fees in connection with international applications for patents (Rule 120).

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