
STATUTORY INSTRUMENTS

1995 No. 2093

The Patents Rules 1995

*EUROPEAN PATENTS AND PATENT APPLICATIONS AND
NATIONAL PROCESSING OF INTERNATIONAL APPLICATIONS*

Entries in the register

79.—(1) Upon publication of an application for a European patent (UK) under Article 93 of the European Patent Convention, the comptroller shall cause to be entered in the register a copy of every entry which, at the date of such publication, has been made in the Register of European Patents kept under Article 127 of that Convention in respect of that application.

(2) The comptroller shall also cause to be entered in the register in respect of an application for a European patent (UK) which has been published under Article 93 of the Convention copies of any entry made in the Register of European Patents following such publication, provided that an application to that effect is made to the comptroller in writing, accompanied by a copy of the relevant entry in the Register duly certified to the satisfaction of the comptroller and by the prescribed fee, if any.

European patents and applications (UK): translations

Schedule 4 shall have effect in cases where translations are required by the Act to be filed in connection with applications for, and with, European patents (UK).

Procedure for making request under section 81(2)(b)(i)

81.—(1) The request referred to in section 81(2)(b)(i) shall be made in writing within three months of the date on which the applicant is notified by the European Patent Office that his application for a European patent (UK) has been deemed to be withdrawn and shall be accompanied by the said notification and by the prescribed fee, if any.

(2) At the same time as making the request referred to in paragraph (1) above, the applicant may also request that a copy of the European patent application, together with a copy of the above request, be sent by the comptroller in accordance with relevant provisions of the European Patent Convention to the central industrial property office of any specified Contracting State designated in the application.

(3) The applicant shall pay the filing fee referred to in section 81(2)(c) for the purposes of section 81(2)(b)(i) within two months of the date on which the comptroller receives the request mentioned in paragraph (1) above.

(4) The applicant shall also, within the period referred to in paragraph (3) above, for the purposes of section 15(5)(b), file Patents Form 9/77, and, for the purposes of section 13(2), file Patents Form 7/77.

Procedure where section 81(2)(b)(ii) applies

82.—(1) Where section 81(2)(b)(ii) applies, the period within which a request may be transmitted to the comptroller shall be the twenty months calculated from the declared priority date or, where there is no declared priority date, the date of filing of the application for the European patent (UK).

(2) Upon receipt of the request, the comptroller shall notify the applicant thereof.

(3) The applicant shall pay the filing fee and file any necessary translation referred to in section 81(2)(c) for the purpose of section 81(2)(b)(ii) within four months of the date of the notification referred to in paragraph (2).

(4) The applicant shall also, within the period referred to in paragraph (3) above, for the purposes of section 15(5)(b), file Patents Form 9/77 and, for the purposes of section 13(2), file Patents Form 7/77.

Procedure for making request for substantive examination where section 81(2) applies

83.—(1) The period within which a request may be made to the comptroller for substantive examination of any application for a patent to which section 81(2) applies shall be two years from the declared priority date or, where there is no declared priority date, the date of filing of the application for the European patent (UK).

(2) The request shall be made on Patents Form 10/77.

(3) The periods prescribed for the purposes of sections 18(4) and 20(1) by paragraphs (1)(a), (1A) (insofar as paragraph (1A) applies to paragraph (1)(a)) and (2) of rule 34 above shall also apply to an application for a European patent (UK) which is to be treated as an application for a patent under the Act, except that any reference to the date of filing of the application in paragraph (1)(a) of the said rule 34 shall be taken to refer to the date of filing of the application for the European patent (UK).

Recognition of determinations in proceedings before comptroller

84. Any person seeking recognition in proceedings before the comptroller of a determination by a competent authority of a relevant contracting state other than the United Kingdom of a question to which section 82 applies shall furnish the comptroller with a copy thereof certified as a true copy by an official of the said authority.

International applications for patents: sections 89 and 89A

85.—(1) Subject to the provisions of this rule, in relation to an international application for a patent (UK) which is, under section 89, to be treated as an application for a patent under the Act, the prescribed periods for the purposes of section 89A(3) and (5) are—

- (a) the period of twenty months calculated from the date which, by virtue of section 89B(1)(b), is to be treated as the declared priority date or, where there is no declared priority date, the date of filing of the international application for a patent (UK); or
- (b) in a case where the United Kingdom has been elected in accordance with Chapter II of the Patent Co-operation Treaty—
 - (i) before the expiry of nineteen months calculated from the declared priority date, the period of thirty months calculated from the declared priority date; or
 - (ii) where there is no declared priority date and the United Kingdom has been so elected before the expiry of nineteen months calculated from the date of filing of the international application for a patent (UK), the period of thirty months calculated from the date of filing of that international application.

(2) Where, in accordance with paragraph 1 of Schedule 2, the information specified in subparagraph (2)(a)(ii) of that paragraph is added to an international application for a patent (UK) after the international filing date, rule 113(1) shall not apply in respect of that information; and where the translation of the information, the filing of which is required to satisfy the relevant conditions of section 89A(3), has not been filed at the Patent Office before the end of the relevant period referred to in paragraph (1) above,—

- (a) the comptroller shall give notice to the applicant at the address furnished by the applicant in accordance with rule 30 requiring the applicant to file the translation within the period of two months commencing on the day on which the notice is sent; and
- (b) the relevant period shall be treated in respect of the translation as not expiring until the end of the period specified in the notice given under subparagraph (a) above.

(3) In the case of an international application for a patent (UK),—

- (a) rule 5(1) shall not apply if the applicant, on filing the application, states in writing to the receiving office that the invention has been displayed at an international exhibition;
- (b) rule 5(2) may be complied with,—
 - (i) where subparagraph (a) of paragraph (1) above applies, at any time before the end of the period of twenty-two months, or
 - (ii) where sub-paragraph (b) of paragraph (1) above applies, at any time before the end of the period of thirty-two months,

after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK);

- (c) rule 6(6) shall have effect with the substitution, for the reference to the period of twenty-one months after the declared priority date, of a reference to the period of twenty-two months after that date;
- (d) where the United Kingdom has been elected in accordance with Chapter II of the Patent Co-operation Treaty before the expiry of the nineteenth month after the declared priority date, rule 6(6) shall have effect with the substitution, for the reference to the period of twenty-one months after the declared priority date, of a reference to the period of thirty-two months after that date; and
- (e) where a translation into English of a document or part of a document is required by the Act or these Rules to be filed—
 - (i) before the end of the relevant period referred to in paragraph (1)(a) above, verification of the translation, as required by rule 113(1), may be given to the comptroller at any time before the end of the period of twenty-two months, or
 - (ii) before the end of the relevant period referred to in paragraph (1)(b) above, verification of the translation, as required by rule 113(1), may be given to the comptroller at any time before the end of the period of thirty-two months,

after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK).

(4) Where the relevant period referred to in paragraph (1) above has been extended under paragraph (5A) below, rule 100 or rule 110 so as to expire later than one month before the end of a period prescribed by paragraph (3) above or (7) below, paragraphs (3) above and (7) below shall have effect with the substitution for the period so prescribed of a period ending one month later than the relevant period referred to in paragraph (1) above as so extended.

(5) For the purposes of section 89A(3) and (5), to the extent that the application and any amendment as published under the Patent Co-operation Treaty and any amendment annexed to the international preliminary examination report under Chapter II of the Treaty are not in English, a

translation into English of the application as originally filed or, as the case may be, of the application as originally filed and of the amendment is necessary; however, the translation—

- (a) shall exclude the request and abstract unless—
 - (i) the applicant expressly requests the comptroller to proceed earlier than the expiry of the period prescribed in paragraph (1) above; and
 - (ii) a copy of the application published by the International Bureau has not yet been sent to the Patent Office in accordance with the Treaty; and
- (b) shall include any textual matter in the drawings in a form which complies with rule 49.5(d) of the Patent Co-operation Treaty; and,
- (c) where a title has been established by the International Searching Authority under rule 37.2 of the Regulations under the Patent Cooperation Treaty which differs from the title included in the application as originally filed, shall include the former title in place of the latter.

(5A) Where an applicant is required to file a translation into English both of an application as originally filed and of the amendment to it, in accordance with paragraph (5) above, in order to satisfy the relevant conditions of section 89A(3) and (5) and at the expiry of the relevant period referred to in paragraph (1) above the prescribed fee has been paid and one but not both of the necessary translations has been filed—

- (a) the comptroller shall give notice to the applicant at the address furnished by the applicant in accordance with rule 30 requiring the applicant to file the required translation within the period of one month commencing on the day on which the notice is sent; and
- (b) the relevant period shall be treated in respect of that translation as not expiring until the end of the period specified in the notice given under sub-paragraph (a) above.

(6) Payment of the fee prescribed under section 89A(6) shall be accompanied by a request in writing by the applicant for publication under that subsection.

(7) In the case of an international application for a patent (UK) in respect of which the conditions specified in section 89A(3)(a) are satisfied, the period prescribed,—

- (a) for the purposes of sections 13(2), 15(5)(b) and 17(1),—
 - (i) where sub-paragraph (a) of paragraph (1) above has effect, shall be the period which expires twenty two months; or
 - (ii) where sub-paragraph (b) of paragraph (1) above has effect, shall be the period which expires thirty two months; and
- (b) for the purposes of section 18(1),—
 - (i) where sub-paragraph (a) of paragraph (1) above applies, shall be the period which expires two years; or
 - (ii) where sub-paragraph (b) of paragraph (1) above applies, shall be the period which expires thirty two months,

after the declared priority date or, if there is no declared priority date, the date of filing of the international application for a patent (UK).

(7A) In the case of an international application for a patent (UK) in respect of which the conditions specified in section 89(A)(3)(b) are satisfied, the period prescribed—

- (a) for the purposes of section 13(2), shall be the period prescribed by rule 15(1) or two months from the date on which the said conditions are satisfied, whichever expires the later;
- (b) for the purposes of sections 15(5)(b) and 17(1), shall be the period prescribed by rule 25(2) or two months from the date on which the said conditions are satisfied, whichever expires the later; and

- (c) for the purposes of section 18(1), shall be the relevant period prescribed by paragraph (7)(b) above but, where paragraph (7)(b)(i) applies and the application is actually published under section 16, shall be the period prescribed by rule 33(2).

(8) Where, in relation to an international application for a patent (UK), the applicant desires that section 89(1) shall not cease to apply to the application by virtue of the operation of section 89(3), application in writing to that effect shall be made to the comptroller including a statement of the facts upon which the applicant relies, accompanied by the prescribed fee, if any.

(9) An international application for a patent (UK) shall not be treated as withdrawn under the Act if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Patent Co-operation Treaty where, in the same or comparable circumstances in relation to an application under the Act (other than an international application)—

- (a) the comptroller could have directed that an irregularity be rectified under rule 100, or could have granted a dispensation for the doing of any act or thing, or the production or filing of any document under rule 101, or could have granted an extension of time under rule 110, or could have extended the time or determined the times or periods under rule 111; and
- (b) the comptroller determines that the application would not have been treated as withdrawn under the Act.

(10) Where under section 89(3) an application is not to be treated as withdrawn and the applicant wishes to proceed—

- (a) the comptroller may amend any document received by the Patent Office from the receiving office or the International Bureau and alter any period or time which is specified in the Act or these Rules upon such terms (including payment of any appropriate prescribed fee) as he may direct; and
- (b) the fee prescribed under section 89A(3) shall not be payable.

(11) Where the applicant satisfies the comptroller that,—

- (a) because of an error made by the receiving office, an international application for a patent (UK) has been accorded a date of filing which is not correct; or
- (b) the declaration made under Article 8(1) of the Patent Co-operation Treaty has been cancelled or corrected by the receiving office or the International Bureau because of an error made by the office or the Bureau,

the comptroller may amend any document received by the Patent Office from the receiving office or the International Bureau or alter any period or time which is specified in the Act or these Rules as if the error were an error on the part of the Patent Office.

(12) Where—

- (a) an international application for a patent (UK) purports to designate the United Kingdom; and
- (b) the applicant alleges that he has been refused a filing date under the said Treaty on account of an error or omission in any institution having functions under the said Treaty,

the applicant may apply in writing to the comptroller for the international application to be treated as an application under the Act by filing a statement of the facts upon which he relies accompanied by the prescribed fee, if any; and the comptroller may amend any document filed by the applicant and alter any period or time which is specified in the Act or these Rules upon such terms as he may direct.

(13) In this rule “receiving office” has the same meaning as in the Patent Co-operation Treaty.

Obtaining evidence for proceedings under European Patent Convention

86.—(1) An application to the comptroller under section 1 of the Evidence (Proceedings in Other Jurisdictions) Act 1975(1), as applied by section 92 of the Act, for an order for evidence to be obtained in the United Kingdom shall be made *ex parte* in writing and shall be accompanied by—

- (a) an affidavit made by a person duly authorised in that behalf by the relevant convention court, evidencing that the request is made in pursuance of a request issued by or on behalf of that court and that the evidence to which the application relates is to be obtained for the purposes of civil proceedings before it; and
- (b) the prescribed fee, if any.

(2) After such an application as is mentioned in paragraph (1) above has been made, an *ex parte* application for a further order or directions in relation to the same matter may be made to the comptroller in writing.

(3) The comptroller may allow an officer of the European Patent Office to attend the hearing of such an application as is mentioned in paragraph (1) above and examine the witnesses or request the comptroller to put specified questions to them.

Communication of information to European Patent Office

87. The comptroller may authorise the communication to the European Patent Office or the competent authority of any country which is party to the European Patent Convention of such information in the files of the Patent Office as may be disclosed in accordance with section 118 and rule 93.