
STATUTORY INSTRUMENTS

1995 No. 2093

The Patents Rules 1995

EXAMINATION AND SEARCH

Preliminary examination and search under section 17

28.—(1) A request under section 17(1)(a) for a preliminary examination and search shall be made on Patents Form 9/77.

(2) On a preliminary examination the examiner shall determine, not only whether the application (“the application in suit”) complies with those requirements of the Act and these Rules which are designated by rule 31 as formal requirements for the purposes of the Act, but also whether the requirements of rules 6(1) and (2) and 15(1) and the provisions of section 15(3) have been complied with.

(3) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part thereof) referred to in the examiner’s report under section 17(5).

Procedure where earlier application made

29. Where the preliminary examination under rule 28 reveals that an earlier relevant application declared for the purposes of section 5 has been stated in the application in suit to have a date of filing more than twelve months before the date of filing of the application in suit, the Patent Office shall notify the applicant that the earlier relevant application will be disregarded unless, within one month, he supplies the Patent Office with a corrected date, being one which falls within those twelve months.

Address for service

30.—(1) There shall be furnished to the comptroller—

- (a) by every applicant for the grant of a patent, an address for service in the United Kingdom for the purpose of his application, and
- (b) notwithstanding the provisions of paragraphs (2) to (4) below, by every person (including the applicant for, or the proprietor of, a patent, as the case may be) concerned in any proceedings to which any of these Rules relate, an address for service in the United Kingdom,

and the address so furnished or, where another address (being an address in the United Kingdom) has been furnished in place thereof, that address shall be treated for the purposes of that application or those proceedings, as appropriate, as the address of that applicant or, as the case may be, of that person.

(2) Upon grant of an application for a patent (not being an application for a European patent (UK)), the applicant’s address for service as shown in the register shall be treated as the address for service of the proprietor of the patent unless an alternative address is furnished.

(3) As from publication of the mention of the grant of every European patent (UK) in the European Patent Bulletin, the address for service of the proprietor shall be the address for service notified to the comptroller by or on behalf of the proprietor, whether before or after the said mention of the

grant, and in the absence of any such notification the proprietor's address on the register shall be treated as the address for service.

(4) An address for service for an applicant for, or a proprietor of, a patent may be withdrawn by the applicant or the proprietor or the person providing the address for service, as the case may be, by notice to the comptroller; and upon such notification the comptroller may treat the address of the applicant or the proprietor previously notified to him, or the address shown in the register, as the address for service until such time as an alternative address is furnished.

Formal requirements

31.—(1) The requirements of rules 16(1), 18(1) and (2) (other than those contained in paragraph (2)(h)), 20 (other than those contained in the last sentence of paragraph (11) and in paragraphs (12) and (14)) and 30(1)(a) shall be formal requirements for the purposes of the Act.

(2) Where the application is—

- (a) an application for a European patent (UK); or
- (b) an international application for a patent (UK)

which, by virtue of section 81 or 89, as the case may be, is to be treated as an application for a patent under the Act, the said requirements of rules 16(1), 18(1) and (2) and 20 shall be treated as having been complied with to the extent that the requirements of the corresponding provisions of the Implementing Regulations to the European Patent Convention or, as the case may be, of the Regulations made under the Patent Co-operation Treaty, have been fulfilled.

Searches under section 17(6) and (8)

32.—(1) Where an examiner conducts a search under section 17(6) in relation to the first only of two or more inventions specified in the claims of an application, the Patent Office shall notify the applicant of that fact.

(2) If the applicant desires a search to be conducted under section 17(6) in relation to a second or subsequent invention specified in the claims, he shall, before the expiry of the period specified for the making of observations on the report made under section 18(3), request the Patent Office on Patents Form 9/77 to conduct such a search and pay the search fee for each invention in respect of which the search is to be made.

(3) The fee for a supplementary search under section 17(8) shall be accompanied by Patents Form 9/77.

(4) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part thereof) referred to in the examiner's report under section 17 pursuant to subsection (6) or (8) thereof.

Request for substantive examination under section 18

33.—(1) A request for a substantive examination of an application for a patent shall be made on Patents Form 10/77.

(2) Subject to the provisions of rules 83(1), 85(7)(b), 85(7A)(c) and paragraphs (3) and (5) below, the request shall be made and the fee for the examination paid within six months of the date of publication of the application in accordance with section 16.

(3) Where an application is subject to directions under section 22(1) or (2), the request shall be made and the fee paid within two years of the declared priority date or, where there is no declared priority date, from the date of filing the application 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.

(4) When he gives the applicant the opportunity under section 18(3) to make observations on the examiner's report under subsection (2) of that section, the comptroller may, if he thinks fit, send to the applicant a copy of any document (or part thereof) referred to in the report.

(5) 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.

Period for putting application in order

34.—(1) Subject to the provisions of paragraph (2) below and of rule 83(3), for the purposes of sections 18(4) and 20(1), the period within which an application for a patent shall comply with the Act and these Rules—

(a) subject to sub-paragraphs (b) and (c) hereof and paragraph (1A) below, shall be—

- (i) the period of four years and six months calculated from its declared priority date or, where there is no declared priority date, from the date of filing of the application; or
- (ii) the period of twelve months calculated from the date the first report under section 18 in respect of that application is sent to the applicant,

whichever expires the later;

(b) in the case of a new application for a patent arising from and made in accordance with an order of the comptroller under section 8(3), 12(6) or 37(4), shall be—

- (i) the period of four years and six months calculated from the declared priority date for the earlier application or, where there is no such declared priority date, the date of filing of the earlier application; or
- (ii) the period of eighteen months calculated from the actual date of filing of the application,

whichever expires the later;

(c) in the case of a new application under section 15(4), shall be the period determined in accordance with sub-paragraph (a) above in respect of the earlier application whose date of filing is to be treated under section 15(4) as the date of filing of the new application.

(1A) Where the first report under section 18 is not sent to the applicant before the expiry of the period prescribed by sub-paragraph (a)(i) of paragraph (1) above, that period shall be extended to such date as that report is sent to the applicant and the period specified by sub-paragraph (a)(ii) of paragraph (1) shall then apply.

(2) In a case where,—

- (a) a third party makes observations under section 21 on an application;
- (b) the examiner, for the first time in a report under section 18(3), relies upon the substance of those observations to report that the patentability requirements of the Act are not met; and
- (c) following that report, and within the last three months of the period ascertained under paragraph (1) above (including any alteration thereof under rule 100 or rule 110) the comptroller gives the applicant the opportunity under section 18(3) to make observations on the report and to amend the application,

the period within which an application for a patent shall comply with the Act and these Rules shall expire at the end of the period of three months beginning on the date when the comptroller sends notification to the applicant of that opportunity.

Amendment of request for grant

35. Subject to rule 45(3), an application for amendment of the request for the grant of a patent shall—

- (a) be made on Patents Form 11/77;
- (b) clearly identify the proposed amendment; and
- (c) state the reasons for it.

Amendment of application before grant

36.—(1) An applicant may not amend the description, claims and drawings contained in his application except in accordance with the following provisions of this rule.

(2) Unless the comptroller so requires or consents, the applicant may not so amend before the comptroller sends to the applicant the examiner's report under section 17(5).

(3) After the comptroller has sent to the applicant the examiner's report under section 17(5) and before he sends to the applicant the first report of the examiner under section 18, the applicant may so amend of his own volition.

(4) After the comptroller has sent to the applicant the examiner's first report under section 18, the applicant may so amend once of his own volition provided that—

- (a) where the report is made under—
 - (i) section 18(3), the amendment is filed at the same time as the applicant replies to that report, or
 - (ii) section 18(4), the amendment is filed within two months of that report being sent to the applicant,except that—

- (b) where the report referred to in sub-paragraph (a)(i) is made before preparations for publication of the application have been completed, the applicant may, in addition and prior to the amendment which may be made in accordance with that sub-paragraph, amend of his own volition the description, claims or drawings.

(5) The right to amend set out in paragraph (4) is in addition to an applicant's right under section 18(3) to amend the application so as to comply with the requirements of the Act and these Rules.

(6) Any further amendment to the description, claims or drawings which the applicant desires to make of his own volition may be made only with the consent of the comptroller following the filing of Patents Form 11/77 clearly identifying the proposed amendment and stating the reasons for it.

Observations on patentability under section 21

37.—(1) Subject to paragraph (2) below, the comptroller shall send to the applicant a copy of—

- (a) any document containing observations which he receives under section 21 in connection with the application; and
- (b) any document referred to in any such observations being a document which he receives from the person making them.

(2) Nothing in paragraph (1) above shall impose any duty on the comptroller in relation to any document—

- (a) a copy of which it appears to the comptroller is readily available for retention by the applicant; or

(b) which in his opinion is not suitable for photocopying, whether on account of size or for any other reason.

(3) If the period ascertained under rule 34 (as altered, if that be the case, under rule 100 or rule 110) has not expired and the comptroller has not sent to the applicant notice in accordance with section 18(4) that the application complies with the requirements of the Act and these Rules, the observations shall be referred to the examiner conducting a substantive examination of the application under section 18; and the examiner shall consider and comment upon them as he thinks fit in his report under that section.