
STATUTORY INSTRUMENTS

2004 No. 2357

The Regulatory Reform (Patents) Order 2004

Amendment of the Patents Act 1977

5. For section 15 of that Act (date of filing application) there shall be substituted—

“15 Date of filing application

(1) Subject to the following provisions of this Act, the date of filing an application for a patent shall be taken to be the earliest date on which documents filed at the Patent Office to initiate the application satisfy the following conditions—

- (a) the documents indicate that a patent is sought;
- (b) the documents identify the person applying for a patent or contain information sufficient to enable that person to be contacted by the Patent Office; and
- (c) the documents contain either—
 - (i) something which is or appears to be a description of the invention for which a patent is sought; or
 - (ii) a reference, complying with the relevant requirements of rules, to an earlier relevant application made by the applicant or a predecessor in title of his.

(2) It is immaterial for the purposes of subsection (1)(c)(i) above—

- (a) whether the thing is in, or is accompanied by a translation into, a language accepted by the Patent Office in accordance with rules;
- (b) whether the thing otherwise complies with the other provisions of this Act and with any relevant rules.

(3) Where documents filed at the Patent Office to initiate an application for a patent satisfy one or more of the conditions specified in subsection (1) above, but do not satisfy all those conditions, the comptroller shall as soon as practicable after the filing of those documents notify the applicant of what else must be filed in order for the application to have a date of filing.

(4) Where documents filed at the Patent Office to initiate an application for a patent satisfy all the conditions specified in subsection (1) above, the comptroller shall as soon as practicable after the filing of the last of those documents notify the applicant of—

- (a) the date of filing the application, and
- (b) the requirements that must be complied with, and the periods within which they are required by this Act or rules to be complied with, if the application is not to be treated as having been withdrawn.

(5) Subsection (6) below applies where—

- (a) an application has a date of filing by virtue of subsection (1) above;
- (b) within the prescribed period the applicant files at the Patent Office—
 - (i) a drawing, or

- (ii) part of the description of the invention for which a patent is sought, and
 - (c) that drawing or that part of the description was missing from the application at the date of filing.
- (6) Unless the applicant withdraws the drawing or the part of the description filed under subsection (5)(b) above (“the missing part”) before the end of the prescribed period—
 - (a) the missing part shall be treated as included in the application; and
 - (b) the date of filing the application shall be the date on which the missing part is filed at the Patent Office.
- (7) Subsection (6)(b) above does not apply if—
 - (a) on or before the date which is the date of filing the application by virtue of subsection (1) above a declaration is made under section 5(2) above in or in connection with the application;
 - (b) the applicant makes a request for subsection (6)(b) above not to apply; and
 - (c) the request complies with the relevant requirements of rules and is made within the prescribed period.
- (8) Subsections (6) and (7) above do not affect the power of the comptroller under section 117(1) below to correct an error or mistake.
- (9) Where, after an application for a patent has been filed and before the patent is granted—
 - (a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and
 - (b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below),the new application shall be treated as having, as its date of filing, the date of filing the earlier application.
- (10) Where an application has a date of filing by virtue of this section, the application shall be treated as having been withdrawn if any of the following applies—
 - (a) the applicant fails to file at the Patent Office, before the end of the prescribed period, one or more claims and the abstract;
 - (b) where a reference to an earlier relevant application has been filed as mentioned in subsection (1)(c)(ii) above—
 - (i) the applicant fails to file at the Patent Office, before the end of the prescribed period, a description of the invention for which the patent is sought;
 - (ii) the applicant fails to file at the Patent Office, before the end of the prescribed period, a copy of the application referred to, complying with the relevant requirements of rules;
 - (c) the applicant fails to pay the application fee before the end of the prescribed period;
 - (d) the applicant fails, before the end of the prescribed period, to make a request for a search under section 17 below and pay the search fee.
- (11) In this section “relevant application” has the meaning given by section 5(5) above.

15A Preliminary examination

(1) The comptroller shall refer an application for a patent to an examiner for a preliminary examination if—

- (a) the application has a date of filing;
- (b) the application has not been withdrawn or treated as withdrawn; and
- (c) the application fee has been paid.

(2) On a preliminary examination of an application the examiner shall—

- (a) determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act; and
- (b) determine whether any requirements under section 13(2) or 15(10) above remain to be complied with.

(3) The examiner shall report to the comptroller his determinations under subsection (2) above.

(4) If on the preliminary examination of an application it is found that—

- (a) any drawing referred to in the application, or
- (b) part of the description of the invention for which the patent is sought,

is missing from the application, then the examiner shall include this finding in his report under subsection (3) above .

(5) Subsections (6) to (8) below apply if a report is made to the comptroller under subsection (3) above that not all the formal requirements have been complied with.

(6) The comptroller shall specify a period during which the applicant shall have the opportunity—

- (a) to make observations on the report, and
- (b) to amend the application so as to comply with those requirements (subject to section 76 below).

(7) The comptroller may refuse the application if the applicant fails to amend the application as mentioned in subsection (6)(b) above before the end of the period specified by the comptroller under that subsection.

(8) Subsection (7) above does not apply if—

- (a) the applicant makes observations as mentioned in subsection (6)(a) above before the end of the period specified by the comptroller under that subsection, and
- (b) as a result of the observations, the comptroller is satisfied that the formal requirements have been complied with.

(9) If a report is made to the comptroller under subsection (3) above—

- (a) that any requirement of section 13(2) or 15(10) above has not been complied with; or
- (b) that a drawing or part of the description of the invention has been found to be missing,

then the comptroller shall notify the applicant accordingly.?”