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## 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”), and to the Patents (Fees) Rules 1998 (SI 1998/1778) (“the Fees Rules”). The amendments arise from provisions of the Patents Act 2004 (c. 16) (“the 2004 Act”) that are commenced on 1st October 2005 by the Patents Act 2004 (Commencement No. 3 and Transitional Provisions) Order 2005 (SI 2005/2471 (C.105)) (“the Commencement Order”).

The 2004 Act amends the Patents Act 1977 (c. 37) (“the 1977 Act”). The 1977 Act, the 1995 Rules and the Fees Rules together comprise the principal United Kingdom legislation on patents. The amendments to the 1977 Act made by those provisions of the 2004 Act commenced on 1st October 2005, and the corresponding amendments to the 1995 Rules and the Fees Rules made by this instrument, affect the following matters.

### **Publication of names and addresses of inventors**

Section 13 of the 1977 Act gives the inventor the right to be mentioned as such in any patent (or application for a patent) for the invention, and requires the applicant for the patent to identify the person (or persons) believed to be the inventor. Disputes over the right to be so mentioned are determined by the comptroller under section 13(3). Paragraph 26(2) of Schedule 2 to the 2004 Act amends section 123 of the 1977 Act to enable rules to be made providing for a procedure whereby this right may be waived.

*Rule 2* accordingly inserts a new rule 15A in the 1995 Rules providing for such a procedure, and *rules 3, 4 and 5* make consequential amendments to rules 27, 44 and 93(4) respectively. Any person identified as the inventor may apply not to be mentioned as such, and in particular the person who has the right to be so mentioned may apply to waive that right. The application must be supported by reasons, although an application relating solely to the applicant’s address need not be so supported.

No transitional provision is necessary.

### **Renewal of patents**

Section 25 of the 1977 Act provides for a patent to have a term of 20 years from the date of filing of the application; however, if a renewal fee is not paid within the period prescribed by rules the patent expires at the end of that period. As a result of the amendments made by section 8 of the 2004 Act, rules may now prescribe both a period for the payment of a patent renewal fee, and a date for the expiry of the patent for non-payment of the fee. Thus, following the amendments, the period prescribed for payment may end on a different date from that on which the patent itself expires.

*Rule 6* accordingly substitutes, for the existing rule 39 of the 1995 Rules, new rules 39 to 39C. The new rules prescribe a “renewal date” as the date on which a patent expires for non-payment, but ensures that any period prescribed for payment does not expire until the end of the month in which that date falls. In most cases, the renewal date is the anniversary of the filing date – although separate provision is made for the circumstances where the date that the patent is granted falls close to, or after, the first renewal date. In addition, the new rules seek to set out the provisions on patent renewal in a more accessible way, in particular by treating separately the case of the first renewal date (rule 39A) and that of subsequent renewal dates (rule 39B).

*Status: This is the original version (as it was originally made). This item of legislation is currently only available in its original format.*

*Rules 7 to 10* then make consequential and supplementary changes to rules 41(1), 42 and 92 of the 1995 Rules, and to paragraph 2(4) of Schedule 2 and Schedule 4A to those Rules. In particular, the change to rule 41(1) ensures that the period for applying for restoration of a patent now ends at the end of the relevant month.

*Rules 26 to 28* and rule 30 contain transitional provisions. The effect of rule 27 is that the changes in respect of the renewal fee payment period apply to a patent where the old payment period expires on or after 1st October 2005. *Rule 28* has the effect that the changes in respect of the period for applying for restoration of a patent apply where the old restoration period expires on or after 1st October 2005.

### **Co-ownership and revocation of patents**

Section 9 of, and paragraph 18 of Schedule 2 to, the 2004 Act amend sections 36(3) and 72(1) of the 1977 Act, clarifying the rights of owners and co-owners of a patent in respect of applying for its amendment or revocation.

*Rule 11* makes a consequential amendment to rule 75 of the 1995 Rules.

No transitional provision is necessary

### **Opinions as to validity or infringement**

Section 13 of the 2004 Act inserts new sections 74A and 74B in the 1977 Act, and makes consequential amendments to sections 32(2) and 74. Section 74A enables any person to make a request to the Patent Office for a non binding opinion on the questions of validity or infringement of a patent; and section 74B enables provision to be made by rules for the review by the comptroller of an opinion issued under section 74A.

*Rule 12* inserts new rules 77A to 77K in the 1995 Rules, making provision for the relevant procedures. Rules 13 to 18 make consequential and supplementary changes to rules 92(1), 93(4), 94(1), 102, 108, 112 and 113 of the 1995 Rules.

Of those new rules, rule 77A sets out relevant definitions; rule 77B lays down requirements for making a request for an opinion, including the documents and other information to be provided; rule 77C provides for certain matters to be entered in the register of patents; rule 77D prescribes conditions under which a request will be refused; and rules 77E to 77G provide for the subsequent procedure, including the advertisement of the request and the ensuing observations rounds. Rules 77H and 77I lay down the procedure for obtaining a review of an opinion; rule 77J lays down the consequences of such a review; and rule 77K lays down the circumstances in which an appeal may subsequently be brought in the Patents Court.

No transitional provision is necessary.

### **Security for costs**

Section 15 of the 2004 Act amends section 107 of the 1977 Act, in order to redefine the circumstances in which an order for security for costs (or, in Scotland, expenses) may be made in proceedings before the comptroller, and in particular enabling conditions for making such an order to be prescribed by rules.

*Rule 19* inserts a new rule 89A in the 1995 Rules, prescribing such conditions. The conditions prescribed are closely similar to those contained in the Civil Procedure Rules 1998 ([SI 1998/3132](#)).

The amendment made by section 15 of the 2004 Act applies only in respect of proceedings commenced on or after 1st October 2005 (see article 4 of the Commencement Order); accordingly, *rule 25* makes it clear that the conditions prescribed by the new rule 89A do not apply to proceedings commenced at an earlier date.

## **Fees payable**

*Rules 20 to 24* make amendments to the Fees Rules which are consequential on the amendments to the 1995 Rules mentioned above.

*Rules 21 and 22* replace rule 3 of the Fees Rules by new rules 3 and 3A which take account of the changes to the 1995 Rules made by *rule 6* above. Furthermore, the patent renewal fees (including the additional fees prescribed for late payment) are now set out in the new Part AA inserted in the Schedule to the Fees Rules by *rule 24*.

*Rule 23(3)* prescribes the fee of £200 for an application for a request for an opinion under section 74A of the 1977 Act, and *rule 23(1)* prescribes the fee of £50 for an application for the review of an opinion.

*Rules 29 and 30* contain transitional provisions. In particular, *rule 30* applies to a patent where the renewal fee payment period has expired before 1st October, but the late payment period is still running on that date. The rule clarifies how the late payment fees apply to such a patent.

A regulatory impact assessment has not been prepared for this instrument. A regulatory impact assessment for the Patents Bill was placed in the libraries of both Houses of Parliament, and is also available from the Patent Office, Intellectual Property and Innovation Directorate, Concept House, Newport, South Wales, NP10 8QQ.