
STATUTORY INSTRUMENTS

2007 No. 3291

The Patents Rules 2007

PART 5

EUROPEAN PATENTS (UK)

Translations

Translations of European patents (UK)

56.—(1) A translation into English of either—

- (a) the specification of the European patent (UK), which is filed under section 77(6); or
- (b) the claims of the specification of the application for a European patent (UK), which is filed under section 78(7),

must be accompanied by Patents Form 54.

(2) The translation must comply with the requirements set out in Parts 1 to 3 of Schedule 2.

(3) The translation and Patents Form 54 must be filed in duplicate.

(4) But paragraph (2) does not apply where a translation is delivered in electronic form or using electronic communications.

(5) Where the specification includes any drawings all annotations in French or German must be replaced with annotations in English.

(6) The period prescribed for the purposes of section 77(6)(a) is three months beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin.

(7) The period prescribed for the purposes of section 77(6)(b) is three months beginning with the date of publication, by the European Patent Office, of the specification as amended.

(8) No translation may be filed under section 77(6)(a) or (b) before the beginning of the period prescribed for the purposes of that provision.

(9) On a day appointed under section 77(9), section 77(6) and paragraphs (1)(a) and (5) to (8) of this rule shall cease to have effect.

(10) The day appointed for the purpose of paragraph (9) shall be the day of the coming into force of the Agreement on the application of Article 65 of the Convention on the Grant of European Patents made in London on 17th October 2000(1).

Corrected translations

57.—(1) A corrected translation filed under section 80(3) must be accompanied by Patents Form 54.

(2) The corrected translation must comply with the requirements set out in Parts 1 to 3 of Schedule 2.

(3) Where the corrected translation includes any drawings all annotations in French or German must be replaced with annotations in English.

(4) The corrected translation and Patents Form 54 must be filed in duplicate.

(5) But paragraph (2) does not apply where a translation is delivered in electronic form or using electronic communications.

(6) The period prescribed for the purposes of section 80(3) for payment of the prescribed fee is 14 days beginning with the day the corrected translation is filed.

Conversion requests

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

58.—(1) A request under section 81(2)(b)(i) must be—

- (a) made in writing; and
- (b) accompanied by a copy of the notification by the European Patent Office that the application has been deemed to be withdrawn.

(2) When making such a request, a person may also request the comptroller to send—

- (a) a copy of his application for a European patent (UK); and
- (b) a copy of the request,

to the central industrial property office of any contracting state designated in the application.

(3) The period prescribed for the purposes of section 81(2)(b)(i) is three months beginning with the date of the notification mentioned in paragraph (1)(b).

(4) Where a request has been made under section 81(2)(b)(i), the period prescribed for the purposes of sections 13(2), 15(10)(d) and 81(2)(c) is two months beginning with the date on which the comptroller received that request.

(5) In paragraph (2) “contracting state” means a country which is a party to the European Patent Convention.

Procedure for making a conversion request under section 81(2)(b)(ii)

59.—(1) The period prescribed for the purposes of section 81(2)(b)(ii) is twenty months beginning with—

- (a) where there is no declared priority date, the date of filing of the application; or
- (b) where there is a declared priority date, that date.

(2) Where a request, transmitted under section 81(2)(b)(ii), has been received by the comptroller, he must notify the applicant accordingly.

(3) Where a request has been transmitted under section 81(2)(b)(ii), the period prescribed for the purposes of sections 13(2), 15(10)(d) and 81(2)(c) is four months beginning with the date of that notification.

Request for substantive examination following a direction under section 81

60. Where an application for a European patent (UK) falls to be treated as an application for a patent under the Act by virtue of a direction under section 81, the period prescribed for the purposes of section 18(1) is two years beginning with—

- (a) where there is no declared priority date, the date of filing of the application; or
- (b) where there is a declared priority date, that date.

Obligations to other contracting parties to the European Patent Convention

Recognition of patent decision of competent authorities of other states

61.—(1) Where in proceedings before the comptroller a person seeks recognition of a relevant determination, he must furnish to the comptroller a copy of the determination duly certified by the relevant official of the competent authority.

(2) In paragraph (1) “relevant determination” means the determination of a question to which section 82 applies by the competent authority of a relevant contracting state other than the United Kingdom.

Procedure for obtaining evidence for proceedings under the European Patent Convention

62.—(1) An application to the comptroller for an order under the Evidence (Proceedings in Other Jurisdictions) Act 1975(2) as applied by section 92(1) must be—

- (a) made in writing;
- (b) supported by written evidence;
- (c) accompanied by the request as a result of which the application is made, and where appropriate, a translation of the request into English; and
- (d) accompanied by the prescribed fee.

(2) The application must be made without notice.

(3) The comptroller may permit an officer of the European Patent Office to attend the hearing and either—

- (a) examine the witnesses; or
- (b) request the comptroller to put specified questions to the witnesses.

Communication of information to the European Patent Office

63. The comptroller may authorise any information in the files of the Patent Office to be communicated to the European Patent Office or to a competent authority of any country which is a party to the European Patent Convention, except where that information cannot be communicated under section 118.