

SCHEDULE 5

Rule 120(1)

TRANSITIONAL PROVISIONS

Interpretation

1. In this Schedule, the “1995 Rules” means the Patents Rules 1995(1) as they had effect immediately prior to their revocation by these Rules.

Periods of time

2. Where, in relation to any proceedings under the Act, a period of time prescribed by the 1995 Rules for the purposes of a particular provision of the Act has not expired before the date on which these Rules come into force, that period continues to apply.

Proceedings before the comptroller

3. Proceedings before the comptroller which commenced before these Rules came into force shall continue in accordance with Part 7 of these Rules, subject to paragraph 2 of this Schedule.

Service by post

4. Any document sent to the comptroller by posting it in the United Kingdom before the day these Rules come into force shall be deemed to have been filed at the time when it would be delivered in the ordinary course of post.

Applications to which certain amendments made to the Act by the Regulatory Reform (Patents) Order 2004 do not apply.

5.—(1) This paragraph applies to an application for a patent to which article 20, 21 or 22 of the Regulatory Reform (Patents) Order 2004(2) applies.

(2) Any reference in these Rules to—

- (a) section 15(9) of the Act is a reference to section 15(4) of the unamended Act;
- (b) section 15(10)(a) of the Act is a reference to section 15(5)(a) of the unamended Act;
- (c) section 15(10)(b) or (c) of the Act shall be disregarded;
- (d) section 15(10)(d) of the Act is a reference to section 15(5)(b) of the unamended Act;
- (e) section 15A of the Act is a reference to section 17(1) of the unamended Act;
- (f) section 17(1)(c)(i) of the Act is a reference to section 17(1)(a) of the unamended Act; and
- (g) Patents Form 9A is a reference to Patents Form 9.

(3) The following provisions do not apply—

- rule 6(2) and (3) (declaration of priority made after date of filing);
- rule 7 (permission to make late declaration under section 5(2B));
- rule 12(2), (3), (8) and (9) (notifications of deficiencies in application);
- rule 17 (references under section 15(1)(c)(ii));
- rule 18 (missing parts);

(1) SI 1995/2093; as amended by SI 1999/1092, 1999/1899, 1999/3197, 2001/1412, 2002/529, 2003/513, 2004/2177 (C. 94), 2004/2358, 2004/3205 (C. 140), 2005/2496, 2006/760 and 2007/677.

(2) SI 2004/2357.

Status: This is the original version (as it was originally made).

rule 22(3) (prescribed period for the purpose of section 15(10)(b)(ii)).

(4) In this paragraph “unamended Act” means the Act as it had effect immediately before the Regulatory Reform (Patents) Order 2004 came into effect.

Security for costs

6. Rule 85 does not apply in respect of proceedings started before 1st October 2005.

Patent applications filed before 7th January 1991

7.—(1) This paragraph applies to an application for a patent filed before 7th January 1991(3) and to a patent granted in pursuance of such application.

(2) Schedule 1 has effect with the following modifications.

(3) In paragraph 2, for the words “involves the use of or concerns biological material” substitute the words “requires for its performance the use of a micro-organism”.

(4) In paragraph 5(3)(b), insert at the beginning the words “in the case of an undertaking given in accordance with paragraph 1(a),” and insert at the end the word “or” followed by:

“(c) in the case of an undertaking given in accordance with paragraph (1)(b), when the patent is granted.”.

(5) Any reference to “biological material”—

(a) in paragraphs 3(1)(a), 4, 5 and 8 is a reference to “culture of the micro-organism”; and

(b) other than in those provisions, is a reference to “micro-organism”.

(6) For the purposes of paragraph 3(2) the relevant period is the period of two months beginning with the date of filing of the application for a patent.

(7) The following provisions do not have effect—

paragraph 3(3) (defining relevant period);

paragraph 6 (restriction of availability of biological material to experts);

paragraph 7 (request for sample to be made available to expert).

Patent applications filed between 7th January 1991 and 27th July 2000

8.—(1) This paragraph applies to an application for a patent filed during the period beginning with 7th January 1991 and ending with 27th July 2000(4) and to a patent granted in pursuance of such application.

(2) Schedule 1 to these Rules has effect with the following modifications.

(3) In paragraph 2, for the words “involves the use of or concerns biological material” substitute the words “requires for its performance the use of a micro-organism”.

(4) In paragraph 5(3)(b), insert at the beginning the words “in the case of an undertaking given in accordance with paragraph 1(a),” and insert at the end the word “or” followed by:

“(c) in the case of an undertaking given in accordance with paragraph (1)(b), when the patent is granted.”.

(5) Any reference to “biological material”—

(3) The date that section 125A of the Patents Act 1977 came into effect (see paragraph 30 of Schedule 5 to the Copyright, Designs and Patents Act 1988 (c. 48)) and SI 1990/2168.

(4) The date that SI 2000/2037 came into force. Regulation 9 of that SI limits the amendments to applications made after the provision came into force.

- (a) in paragraphs 3(1)(a), 4, 5, 6(3), 7(2) and 8 is a reference to “culture of the micro-organism”; and
 - (b) other than in those provisions, is a reference to “micro-organism”.
- (6) Paragraph 2(2)(b) (requirement that application contains relevant information) does not have effect.
- (7) In paragraph 6(5)(b), for the words from “the period of 20 years” to the end of that provision substitute “the period ending with the date on which the application was terminated or withdrawn”.
- (8) The specification of an application for a patent, or of a patent, must mention any international agreement under which the micro-organism is deposited.

Continued application of Patents Rules 1968 to existing patents

- 9.—(1) This paragraph and paragraph 10 apply to existing patents and applications.
- (2) Rules 4, 58 and 59 of the Patents Rules 1968(5) continue to apply.

Application of these Rules to existing patents and applications

- 10.—(1) Rules 4, 10(2), 44 to 50, 73 to 88, 101, 103 to 105 and 107 apply to existing patents and applications.
- (2) In those provisions as they apply by virtue of this paragraph, a reference to a specified provision of these Rules other than one of those provisions is a reference to the corresponding provision of the Patents Rules 1968 (any provision of those Rules being treated as corresponding to a provision of these Rules if it was made for purposes which are the same as or similar to that provision of these Rules).

Application of the 1995 Rules to sections 8 and 12

- 11. If before 1st January 2005 a question has been referred to the comptroller under section 8 or 12, in relation to that reference, sections 8, 11 and 12 have effect as if the amendments to those sections by the Patents Act 2004(6) had not been made and rules 9 and 13 of the 1995 Rules have effect as in force immediately before 1st January 2005.

(5) SI 1968/1389.

(6) 2004 (c.16).