

**EXPLANATORY MEMORANDUM TO
THE PATENTS (AMENDMENT) RULES 2014**

2014 No. 578

1. This explanatory memorandum has been prepared by the Department for Business, Innovation and Skills and is laid before Parliament by Command of Her Majesty.

2. Purpose of the instrument

2.1 The instrument replaces rule 19 of the Patents Rules 2007 (S.I. 2007/3291, as amended), which governs procedure for filing a “divisional application” - an application for a patent based upon material contained in an earlier application. The instrument corrects a defect in the original drafting regarding deadlines for filing divisional applications. Since the amending instrument corrects a defect in the previous instrument, the procedure for free issue has been applied.

3. Matters of special interest to the Joint Committee on Statutory Instruments

3.1 None.

4. Legislative Context

4.1 The principal statute on patents is the Patents Act 1977 (c.37) (“the Act”).

4.2 The Patents Rules 2007 (“the 2007 Rules”) are the main piece of legislation made under the Act, and they regulate applications for patents and the business and procedure of the statutory body called “the Patent Office”, which uses “the Intellectual Property Office” as an operating name (and is referred to as “the Office” below).

4.3 Amongst other things, the Office examines patent applications, grants patent rights and is a quasi-judicial body with jurisdiction over certain legal proceedings concerning patents. The 2007 Rules prescribe many periods in connection with the processes for applying for and maintaining patent rights, and for resolving disputes over those rights.

4.4 The new instrument corrects an error in rule 19 of the 2007 Rules. In error, rule 19 fails to set different time periods for filing a divisional application by reference to whether the associated earlier application had to be examined once or more than once to determine that it met the requirements of the Act for the grant of a patent.

5. Territorial Extent and Application

5.1 This instrument applies to all of the United Kingdom.

5.2 The provisions of the Act extend to the Isle of Man (subject to modifications made by Order in Council). This instrument therefore applies to the Isle of Man, although the provisions it contains relate solely to procedures at the Office.

6. European Convention on Human Rights

As the instrument is subject to negative resolution procedure and does not amend primary legislation, no statement is required.

7. Policy background

- **What is being done and why**

7.1 The 2007 Rules were a wholesale modernisation and consolidation of previous legislation (the Patents Rules 1995, SI 1995/2093, as amended) (“the 1995 Rules”). Certain rules were modernised and clarified in their wording, whilst more substantive changes were made to other rules. The intention with regard to rule 19 of the 2007 Rules was to simplify and modernise the equivalent rule in the 1995 Rules but not to change its effect. Guidance published at the time confirmed this intention, and the Office and its users maintained the view that this was what the wording had done.

7.2 However, it has now become apparent that it is questionable whether the wording of rule 19 does indeed replicate the effect of the 1995 Rules. In particular, rule 24 of the 1995 Rules provided a two-month period following examination in which to file a divisional application if the first (and only) examination report on the related earlier patent application was issued under s.18(4) of the Act – i.e. if the Office examined the earlier application once and in that examination determined that the application met all requirements necessary for grant of a patent. Rule 19 of the 2007 Rules provides a similar two-month period but it is questionable whether this period is restricted to only apply to those applications where just one examination is required to confirm that the earlier application is in order. Instead, it refers to any notification under s.18(4), and therefore seemingly also would apply in the situation where multiple examination rounds take place before the earlier application is found to meet the requirements necessary for grant of a patent.

7.3 The policy is to ensure that all applicants have an opportunity to file a divisional application if they so wish, whilst not unduly delaying grant of the earlier application. Where an application undergoes multiple examination rounds before it is found to meet the requirements necessary for grant, the applicant has ample time to file a divisional application. The two-month period is intended to ensure that an applicant whose application has only been examined once, and in that examination was found to meet the requirements for grant, also has an opportunity to file a divisional application - without delaying grant of those applications which have undergone multiple examination rounds.

7.4 Therefore, the purpose of this instrument is to correct the wording used in rule 19 to clarify that the two-month period only applies where just one examination is required

to determine that the application meets all necessary requirements for grant. This will give effect in this respect to the position under the Patents Rules prior to their modernisation, and accords with the continuing practice of the Office and the expectations of its users.

- **Consolidation**

7.5 No consolidation of the amended instrument is planned at present. An informal consolidated text of the 2007 Rules is available to the public for free on the Office's website at www.ipo.gov.uk/p-legislation

8. Consultation outcome

8.1 As this instrument corrects drafting defects of which users were generally unaware, no formal consultation has taken place.

9. Guidance

9.1 The Office will inform key stakeholders that this corrective instrument has been made. Guidance for users will also be updated to reflect this correction.

10. Impact

10.1 The impact on business, charities or voluntary bodies is none.

10.2 The impact on the public sector is none.

10.3 An Impact Assessment has not been prepared for this instrument.

11. Regulating small business

11.1 The instrument applies to small business but, as for other sectors, it has no impact because it makes a correction so that existing legislation has the effect which the Office and users already understood it to have.

12. Monitoring & review

12.1 No review of the corrections is envisaged.

13. Contact

Sarah Barker at the Intellectual Property Office (an executive agency of the Department for Business, Innovation and Skills) can answer any queries regarding the instrument. Tel: 01633 814807 or email: sarah.barker@ipo.gov.uk