STATUTORY INSTRUMENTS

1964 No. 228

PATENTS

The Patents (Amendment) Rules 1964

Made - - - -	*18th February* 1964
Laid before Parliament	*25th February* 1964
Coming into Operation	*4th March* 1964

The Board of Trade, in pursuance of the powers conferred on them by sections 94, 95 and 99 of the Patents Act 1949(a), as amended by the Patents Act 1957(b), and of all other powers enabling them in that behalf, after consultation with the Council on Tribunals and, as regards Rule 2 hereof, with the consent of the Treasury, hereby make the following Rules:—

Amendment of Patents Rules 1958

1. The Patents Rules 1958(c), as amended(d), (hereinafter referred to as "the Rules") shall have effect subject to the following amendments:—

(*a*) after Rule 13(1) there shall be added the following:—

"(1A) Where an applicant having made an application for a patent subsequently discloses to the Office additional matter in connection therewith, and before the acceptance of the complete specification makes a fresh application for a patent in respect of the additional matter, the Comptroller may direct that the fresh application or any specification filed in pursuance thereof shall be antedated to a date not earlier than the date on which the matter was first disclosed to the Office if the applicant includes in the fresh application a request to that effect.";

(*b*) the Rule hitherto numbered "75" shall be omitted and the Rule hitherto numbered "74" shall be re-numbered "75";

(*c*) after Rule 73 there shall be added the following:—

"74.—(1) An opponent shall be entitled on request made to the applicant within one month of the giving of the notice of opposition, to be supplied, at his own expense, by the applicant with a copy of the application and of the evidence filed in support.

(2) Within three months of the receipt of the copy of the evidence filed in support of the application, the opponent may file additional evidence and shall deliver to the applicant a copy of such evidence and, within three months of the receipt of the copy of the opponent's additional evidence, the applicant may file further evidence confined to matters strictly in reply and shall deliver to the opponent a copy of such evidence.";

(*d*) for Rule 108(1) there shall be substituted the following:—

"108.—(1) A copy of the notice and of the statement shall be sent by the Comptroller to the applicant for cancellation of the endorsement and thereafter Rules 41 to 46 shall apply.";

(a) 12, 13 & 14 Geo. 6. c. 87. (b) 5 & 6 Eliz. 2. c. 13. (c) S.I. 1958/73 (1958 II, p. 1713).
(d) S.I. 1959/524, 1962/2730, 1963/1982 (1959 II, p. 2001; 1962 III, p. 3699; 1963 III, p. 4169).

(*e*) for Rules 115(3), (4) and (5) there shall be substituted the following:—

"(3) Such notice shall be given on Patents Form No. 51, accompanied by a copy thereof, and shall be supported by evidence (in duplicate) verifying the statements made therein.

(4) The Comptroller shall send a copy of the notice and the evidence to the applicant and thereafter the provisions of Rule 43 (so far as they are applicable) and of Rules 44 to 46 shall apply.";

(*f*) after Rule 153 there shall be added the following:—

"153A.—(1) Where by virtue of any of the Rules mentioned in sub-rule (2) of this Rule any notice of opposition or application for the revocation of a patent is required to be supported by a statement or evidence, such statement or evidence shall be filed on, or within 14 days after, the date on which the notice is given or the application is made.

(2) The Rules referred to in sub-rule (1) are Rules 40(1), 73(2), 81(2), 87(2), 92(2), 97(1), 101(1), 107(2), 115(3) and 133(2).";

(*g*) the Rules mentioned in column 1 of Schedule 1 to these Rules shall be amended in the manner specified in column 2 in relation thereto.

2. With a view to adapting the Rules, as amended by Rule 1 of these Rules, to the provisions of the Public Offices Fees (Patents, Designs and Trade Marks) Order 1964(a) (under which fees are required in the cases therein prescribed to be collected in money) the Rules shall have effect subject to the following amendments:—

(*a*) for Rule 3 there shall be substituted the following:—

"3. The fees to be paid in respect of any matters arising under the Act shall be those specified in Schedule 1 to these Rules and in any case where a form specified in that Schedule as the corresponding form in relation to any matter is required to be used that form shall be accompanied by the fee specified in respect of that matter.";

(*b*) for Rule 4 there shall be substituted the following:—

"4. The forms mentioned in these Rules are those set out in Schedule 2 to these Rules, modified as necessary to enable them to be used accompanied by the appropriate fee (if any) and such forms shall be used in all cases in which they are applicable and may be modified as directed by the Comptroller.";

(*c*) the Rules specified in column 1 of Schedule 2 to these Rules shall be amended in the manner specified in column 2 in relation thereto:

Provided that in any case in which fees may lawfully be collected otherwise than in money by virtue of the Public Offices Fees (Patents, Designs and Trade Marks) Order 1964 (which provides that fees may be collected by means of impressed Inland Revenue stamps purchased prior to the coming into operation of that Order) the Rules shall continue to have effect as if the amendments made in this Rule had not been made.

Revocation and re-enactment of previous amendments of Patents Rules 1958

3. The Patents Rules 1958 shall, subject to the provisions of Rules 1 and 2 hereof, continue to have effect subject to the amendments specified in Schedule 3 to these Rules.

4. The Rules specified in column 1 of Schedule 4 to these Rules are hereby revoked to the extent specified in column 3 of that Schedule.

(a) S.I. 1964/45 (1964 I, p. 75).

Interpretation and Citation

5. The Interpretation Act 1889(a) shall apply to the interpretation of these Rules as if these Rules and the Rules hereby revoked were Acts of Parliament.

6. These Rules may be cited as the Patents (Amendment) Rules 1964 and shall come into operation on 4th March 1964.

18th February 1964.

David Price,
Parliamentary Secretary
to the Board of Trade.

We consent to the making of Rule 2 of these Rules:

John Peel,
M. A. Hamilton,
Lords Commissioners of
Her Majesty's Treasury.

18th February 1964.

SCHEDULE 1

Column 1 Rule	Column 2 Amendments
Rule 18(1)	For the words "made on" there shall be substituted the words "hand-made or reproduced on".
Rules 40(1)(*c*), 92(2), 97(1)(*c*), 101(1), 107(2) and 133(2)	For the words "and a statement (in duplicate)" there shall be substituted the words "and shall be supported by a statement (in duplicate)".
Rules 73(2), 81(2) and 87(2)	For the words "together with a statement (in duplicate)" there shall be substituted the words "and shall be supported by a statement (in duplicate)".
Rule 73(2)	The word "and", where it first occurs, shall be omitted.
Rule 73(3)	For the words "six weeks" there shall be substituted the words "three months".
Rule 137(1)	At the end of paragraph (*g*) there shall be added the words "if the nature of the application or action is specified in the request".
Rule 137(2)	For the words "of the said matters" there shall be substituted the words "item of information required".

(a) 52 & 53 Vict. c. 63.

SCHEDULE 2

Column 1 Rule	Column 2 Amendments
Rules 40(1)(*c*), 73(2), 81(2), 87(2), 92(2), 97(1)(*c*), 101(1), 104(1), 106, 107(2), 118(1), 119(1) and 133(2)	For the words "an unstamped copy" there shall be substituted the words "a copy".
Rule 65	For the words "the prescribed renewal fee shall be paid by filing Patents Form No. 24" there shall be substituted the words "Patents Form No. 24 accompanied by the prescribed renewal fee shall be filed".
Rules 83, 105 and 108(2) ...	For the words "bearing fees" there shall be substituted the words "accompanied by fees".

SCHEDULE 3

1. For Rule 17 there shall be substituted the following:—

"17. Drawings, when supplied, shall be furnished in duplicate and shall accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 25.".

2. Rule 21 shall be omitted.

3. In Rule 22(1)(*b*) for the words "true copy" there shall be substituted the word "duplicate".

4. In Rule 23—

(*a*) paragraph (3) shall be omitted; and

(*b*) for paragraph (4) there shall be substituted the following:—

"(4) No drawing or sketch, other than a graphic chemical formula or a mathematical formula, symbol, or equation, shall appear in the verbal part of the specification and if such a formula, symbol or equation is used therein a copy thereof, prepared in the same manner as drawings, shall be furnished if the Comptroller so directs.".

5. For Rule 38(1) there shall be substituted the following:—

"38.—(1) There is hereby prescribed for the purposes of section 12(1) as the period within which an application for the grant of a patent is to be put in order for acceptance—

(*a*) in the case of an application for the grant of a patent filed before 1st January 1962, a period of three years and six months;

(*b*) in the case of an application for the grant of a patent filed on or after that date but before 1st January 1964, a period of three years;

(*c*) in the case of an application for the grant of a patent filed on or after 1st January 1964, a period of two years and six months.".

6. After Rule 38(1) there shall be added the following:—

"(1A) Where an application for the grant of a patent is post-dated under any of the provisions of the Act, it shall nevertheless be treated for the purpose of determining the relevant period prescribed for the purposes of section 12(1) as if it had not been so post-dated.".

7. Rule 123 shall be omitted.

8. After Rule 155 there shall be added the following:—

"155A. Where the hearing before the Comptroller of any dispute between two or more parties relating to any matter in connection with a patent or an application for a patent takes place after the date of the publication of the complete specification, the hearing of the dispute shall be in public unless the Comptroller, after consultation with those parties to the dispute who are represented at the hearing, otherwise directs.".

SCHEDULE 4

Column 1 Rules	Column 2 S.I. Number and reference	Column 3 Extent of Revocation
The Patents (Amendment) Rules 1959.	S.I. 1959/524 (1959 II, p. 2001).	The whole Rules.
The Patents (Amendment) Rules 1962.	S.I. 1962/2730 (1962 III, p. 3699).	The whole Rules.
The Patents (Amendment) Rules 1963.	S.I. 1963/1982 (1963 III, p. 4169).	Paragraphs (1) and (2) of Rule 1.

EXPLANATORY NOTE

(This Note is not part of the Rules, but is intended to indicate their general purport.)

These Rules amend the Patents Rules 1958 and revoke and replace the Patents (Amendment) Rules 1963 (other than the list of fees payable which was consolidated in those Rules) and all the other amending Rules as set out in Schedule 4.

The principal changes are:—

(1) a period of fourteen days is prescribed as the period within which statements or evidence in support of notices of opposition or of application for the revocation of a patent must be filed. Hitherto such statements or evidence have been required to accompany the relevant notice or application;

(2) the procedure laid down in the principal Rules regarding opposition to the grant of a patent now applies to opposition to (*a*) the cancellation of the endorsement of patents "Licences of Right", (*b*) applications for a compulsory licence, and (*c*) applications for revocation of a patent under Section 42 of the Act. Hitherto the procedure in these matters has been to a greater extent at the discretion of the Comptroller;

(3) the period allowed for an applicant for the extension of the term of a patent to file evidence in reply to opposition to such extension is extended from six weeks to three months, and provision is made for both the opponent and the applicant to file additional evidence within further periods of three months;

(4) the Rules are further amended by adapting them to the provisions of the Public Offices Fees (Patents, Designs and Trade Marks) Order 1964 under which fees are required to be collected in money instead of, as hitherto, mainly in impressed stamps.