STATUTORY INSTRUMENTS

2005 No. 2496

PATENTS

The Patents (Amendment) Rules 2005

Made - - - -	*5th September 2005*
Laid before Parliament	*8th September 2005*
Coming into force - -	*1st October 2005*

The Secretary of State makes the following Rules in exercise of the powers conferred upon him by section 32(2), section 74B and section 123 of the Patents Act 1977(**a**).

In accordance with article 7 of the Department of Trade and Industry (Fees) Order 1988(**b**), he has taken into account the functions and matters specified in Part 4 of Schedule 1 and Parts 1 and 2 of Schedule 2 to that Order.

In accordance with section 8(1) of the Tribunals and Inquiries Act 1992(**c**), he has consulted the Council on Tribunals.

Citation, commencement and interpretation

1.—(1) These Rules may be cited as the Patents (Amendment) Rules 2005, and shall come into force on 1st October 2005.

(2) In these Rules—

"the 1995 Rules" means the Patents Rules 1995(**d**);

"the Fees Rules" means the Patents (Fees) Rules 1998(**e**).

(3) Unless the context otherwise requires, a reference to a numbered rule or Schedule is a reference to a rule of, or a Schedule to, the 1995 Rules.

Publication of names and addresses of inventors

2. After rule 15 there shall be inserted—

(**a**) 1977 c. 37. Section 74B of the Patents Act 1977 (together with section 74A) is inserted by section 13(1) of the Patents Act 2004 (c. 16), and section 32 is amended by section 13(3) of that Act; section 13 of the Patents Act 2004 is brought into force on 1st October 2005 by SI 2005/2471 (C.105). Section 123(4) of the Patents Act 1977 was repealed by paragraph 26(4) of Schedule 2 to the Patents Act 2004, which was brought into force on 22nd September 2004 by SI 2004/2177 (C. 94).
(**b**) SI 1988/93, amended by SI 1990/1473, which were made under section 102 of the Finance (No 2) Act 1987 (c. 51).
(**c**) 1992 c. 53.
(**d**) SI 1995/2093, relevant amendments to which are noted below.
(**e**) SI 1998/1778, relevant amendments to which are noted below.

"**Waiving the right to be mentioned**

15A.—(1) The inventor may, before preparations for the application's publication have been completed by the Patent Office, apply to the comptroller in writing to waive his right—

(a) to have his name and address mentioned as those of the inventor; or

(b) to have his address mentioned as that of the inventor.

(2) An application by an inventor under paragraph (1)(a)—

(a) shall include his reasons for making the application; and

(b) shall be accepted by the comptroller where the comptroller is satisfied by those reasons.

(3) An application by an inventor under paragraph (1)(b) shall be accepted by the comptroller.

(4) Where the comptroller has accepted an inventor's application to make a waiver under this rule, the inventor may apply to the comptroller to end that waiver.

(5) The comptroller may, if he thinks fit, accept an application to end a waiver, and his acceptance may be made subject to such conditions as he may direct.

(6) An application under paragraph (1)(a) or (b) or under paragraph (4) may also be made by a person who is not the inventor, but who has been identified as such for the purposes of section 13(2).

(7) Where a person makes an application in reliance on paragraph (6), the reference in this rule to an application to waive his right to have his name and address (or his address) mentioned shall be construed as a reference to an application not to have his name and address (or his address) mentioned (and paragraphs (4) and (5) are to be construed accordingly).".

3. For rule 27 there shall be substituted—

"Publication of application

27.—(1) The period prescribed for the purposes of section 16(1)(**a**) shall be—

(a) where there is no declared priority date, the period of 18 months beginning with the date of filing of the application; or

(b) where there is a declared priority date, the period of 18 months beginning with that date.

(2) Where a person's application under rule 15A(1)(a) or (b) has been accepted by the comptroller, the comptroller shall ensure that the application for the patent as published under section 16 does not mention his name and address as those of the person believed to be the inventor (or, as the case may be, his address as that of the person so believed).".

4.—(1) In rule 44(2)(**b**)—

(a) for the words "Upon such publication, the comptroller" there shall be substituted "Subject to paragraph (2A), upon such publication the comptroller"; and

(b) the words from "Provided" to the end of the paragraph shall be omitted.

(2) After rule 44(2) there shall be inserted—

"(2A) Where a person's application under rule 15A(1)(a) or (b) has been accepted by the comptroller, the comptroller may omit from the register his name and address (or, as the case may be, his address) as that of the person believed to be the inventor.".

(**a**) Section 16(1) is amended by paragraph 6 of Schedule 2 to the Patents Act 2004, which is brought into force on 1st October 2005 by SI 2005/2471 (C.105).

(**b**) Rule 44(2) was amended by SI 1999/3197.

5. In rule 93(4)—

(a) the word "and" immediately after sub-paragraph (f) shall be omitted; and

(b) at the end of sub-paragraph (g) there shall be inserted—

"; and

(h) that, where the comptroller has accepted a person's application under rule 15A(1)(a) or (b), no document from which his name and address can be identified as those of the inventor or of the person believed to be the inventor (or, as the case may be, from which his address can be so identified) shall be open to inspection unless the comptroller otherwise directs".

Renewal of patents

6. For rule 39(**a**) there shall be substituted—

"**Renewal of patents: general**

39.—(1) In this rule and in rules 39A to 39C—

"prescribed period" means the period prescribed by rule 39A or 39B for the payment of a renewal fee;

"renewal date" has the meaning given in rules 39A(2) to (4) and 39B(3);

"renewal fee" means the fee prescribed in respect of a renewal date(**b**).

(2) If the renewal fee is not paid by the end of the prescribed period, the patent shall cease to have effect at the end of the renewal date.

(3) Subject to paragraph (4), Patents Form 12/77 must be filed within the prescribed period.

(4) Where payment is made pursuant to section 25(4)(**c**), Patents Form 12/77 must accompany the renewal fee and the prescribed additional fee.

(5) On receipt of the renewal fee the comptroller shall issue a certificate of payment.

Renewal of patents: first renewal

39A.—(1) This rule prescribes the period for the payment of a renewal fee in respect of the first renewal date.

(2) Subject to paragraphs (3) and (4)—

(a) the first renewal date is the fourth anniversary of the date of filing; and

(b) the prescribed period is the period of three months ending with the last day of the month in which that renewal date falls.

(3) Where a patent is granted under the Act in the period of three months ending with the fourth anniversary of the date of filing, or at any time after that anniversary—

(a) the first renewal date is the last day of the period of three months beginning with the date on which the patent was granted; and

(b) the prescribed period begins with the date on which the patent was granted and ends with the last day of the month in which that renewal date falls.

(4) Where the grant of a patent is mentioned in the European Patent Bulletin in the period of three months ending with the fourth anniversary of the date of filing, or at any time after that anniversary—

(**a**) Rule 39 was amended by SI 1999/3197.
(**b**) *See* rule 3A of the Fees Rules, inserted by rule 22 of these Rules.
(**c**) Section 25(4) is amended by section 8(2) of the Patents Act 2004, which is brought into force on 1st October 2005 by SI 2005/2471 (C.105).

(a) the first renewal date is the later of—

(i) the last day of the period of three months beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin (case A); or

(ii) the next anniversary of the date of filing to fall after the date on which the grant of the patent was so mentioned (case B); and

(b) the prescribed period is—

(i) in case A, the period beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin and ending with the last day of the month in which the first renewal date falls; or

(ii) in case B, the period of three months ending with the last day of the month in which the first renewal date falls.

Renewal of patents: subsequent renewals

39B. —(1) This rule prescribes the period for the payment of a renewal fee in respect of renewal dates subsequent to the first renewal date.

(2) The prescribed period is the period of three months ending with the last day of the month in which the renewal date falls.

(3) For those purposes—

(a) the second renewal date is the next anniversary of the date of filing to fall after the first renewal date; and

(b) each subsequent renewal date is the anniversary of the previous renewal date.

Renewal notice

39C.—(1) This rule applies where the renewal fee has not been received by the end of the prescribed period.

(2) The comptroller shall, within the period of six weeks immediately following the end of the prescribed period, and if the fee remains unpaid, send a renewal notice to the proprietor of the patent.

(3) The comptroller shall send the renewal notice to—

(a) the address specified by the proprietor on payment of the last renewal fee (or to another address that has since been notified to him for that purpose by the proprietor); or

(b) where such an address has not been so specified or notified, the address for service entered in the register.

(4) The renewal notice shall remind the proprietor of the patent—

(a) that payment is overdue; and

(b) of the consequences of non-payment.".

7. For rule 41(1)(a) there shall be substituted—

"(a) may be made at any time during the period ending with the thirteenth month after the end of the period specified in section 25(4);".

8. For rule 42 there shall be substituted—

"42.—(1) This rule applies where—

(a) a patent has ceased to have effect because a renewal fee has not been paid by the end of the period prescribed by rule 39A or 39B, and

(b) the renewal fee and the prescribed additional fee have not been paid by the end of the period specified in section 25(4) ("the extended period").

(2) The comptroller shall, within the period of six weeks immediately following the end of the extended period, send a notice to the proprietor of the patent—

(a) stating that the extended period has expired, and

(b) referring him to the provisions of section 28.

(3) The comptroller shall send the notice to the address specified by rule 39C(3).".

9. In rule 92(1)(e) and in paragraph 2(4)(ii) of Schedule 2(**a**), for the words "of six months referred to" there shall be substituted "specified".

10. In Schedule 4A(**b**), for "rule 39(1) and (2)" there shall be substituted "rules 39A and 39B".

Revocation of patents

11. In rule 75(**c**), after paragraph (7) there shall be inserted—

"(8) Where an applicant is one of the proprietors of the patent, any reference in this rule to the proprietor of the patent shall be construed as a reference to those other proprietors who do not make the application.

(9) Where the proprietor of the patent makes (or, where there is more than one proprietor, all the proprietors make) an application for revocation of a patent—

(a) paragraphs (2) to (8) do not apply; and

(b) the comptroller shall give such directions as he may think fit with regard to the procedure for determining the application.".

Patent Office opinions

12. After rule 77 there shall be inserted—

"*Opinions by Patent Office*

Interpretation

77A. In rules 77B to 77K, unless the context otherwise requires—

"request" means a request for an opinion under section 74A;

"requester" means the person who makes that request;

"patent" means the patent to which that request relates;

"patent holder" means the proprietor of that patent and any exclusive licensee of the patent;

"proceedings" means proceedings (whether pending or concluded) before the comptroller, the court or the European Patent Office.

Request for an opinion under section 74A

77B.—(1) A request shall be made on Patents Form 17/77 and shall be accompanied by a copy and a statement setting out fully—

(a) the question upon which an opinion is sought;

(b) the requester's submissions on that question; and

(c) any matters of fact which are requested to be taken into account.

(2) The statement shall be accompanied by—

(**a**) Schedule 2 was substituted by SI 2001/1412.
(**b**) Schedule 4A was inserted by SI 2004/2358.
(**c**) Rule 75 was amended by SI 1999/3197.

(a) the name and address of any persons, of whom the requester is aware, having an interest in that question; and

(b) particulars of any proceedings of which the requester is aware which relate to the patent and which may be relevant to that question.

(3) However, where the requester is acting as an agent in making the request, the persons referred to in paragraph (2)(a) do not include the person for whom the requester is so acting.

(4) The statement shall be accompanied by a copy of any evidence or other document (except a published United Kingdom specification or application) which is referred to in the statement.

(5) Each such statement, evidence or other document must be provided in duplicate.

Entry in the register

77C. The comptroller shall cause to be entered in the register—

(a) a notice that a request under section 74A(1)(a) or (b) has been received;

(b) a notice that a request has been refused or withdrawn;

(c) a notice that an opinion has been issued; and

(d) such other particulars concerning opinions or requests as he may think fit.

Refusal or withdrawal of request

77D.—(1) The comptroller shall not issue an opinion if—

(a) the request appears to him to be frivolous or vexatious; or

(b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any proceedings.

(2) The comptroller shall not issue an opinion if the requester gives him notice in writing that the request is withdrawn.

(3) If the comptroller intends at any time—

(a) to refuse the request because the condition in paragraph (1)(a) or (b) is satisfied; or

(b) to refuse the request because, in accordance with section 74A(3)(b), he considers it inappropriate in all the circumstances to issue an opinion,

he shall notify the requester accordingly.

Notification and advertisement of request

77E.—(1) The comptroller shall notify the following persons of the request (except where the person concerned is the requester)—

(a) the patent holder;

(b) any holder of a licence or sub-licence under the patent which has been registered under rule 46;

(c) any person who has made a request in respect of the patent under rule 92(1)(ff)(**a**); and

(d) any person who is specified under rule 77B(2)(a).

(2) In addition, the comptroller may notify of the request any persons who appear to him to be likely to have an interest in the question upon which the opinion is sought.

(**a**) Sub-paragraph (ff) is inserted by rule 13 of these Rules.

(3) The comptroller shall send a copy of the form and statement filed under rule 77B(1) to each person so notified, together with a copy of such other documents filed under rule 77B as he sees fit.

(4) The comptroller shall advertise a request in such manner as he may think fit.

(5) However, if the request is refused or withdrawn before a notification has been made under paragraph (1)—

(a) the patent holder alone shall be notified of the request (and of the fact that it has been refused or withdrawn); and

(b) paragraphs (3) and (4) do not apply.

Submission of observations and observations in reply

77F.—(1) If the request has not been refused or withdrawn, any person may, before the end of the relevant period, file observations on any issue raised by the request.

(2) Such observations may include reasons why the comptroller should refuse the request.

(3) Any person who files observations under paragraph (1) shall ensure that, before the end of the relevant period, a copy of those observations is received—

(a) where that person is not the patent holder, by the patent holder; and

(b) by the requester.

(4) A person to whom observations are sent under paragraph (3) may, not later than two weeks after the end of the relevant period, file observations confined strictly to matters in reply.

(5) Any person who files observations under paragraph (4) shall ensure that, within that period of two weeks, a copy of those observations is received—

(a) where that person is the requester, by the patent holder; and

(b) where that person is the patent holder, by the requester.

(6) If it is reasonably possible, the observations filed under this rule and the copies of such observations shall be delivered only in electronic form or using electronic communications.

(7) For the purposes of this rule, the relevant period is the period of four weeks beginning with the date of advertisement under rule 77E(4).

Issue of the opinion

77G.—(1) After the end of the procedure under rule 77F, the comptroller shall refer the request to an examiner for the preparation of the opinion.

(2) The comptroller shall issue the opinion that has been prepared by sending a copy to—

(i) the requester;

(ii) the patent holder; and

(iii) any other person who filed observations under rule 77F(1).

Review of opinion

77H.—(1) The patent holder may, before the end of the period of three months beginning with the date on which the opinion is issued, apply to the comptroller for a review of the opinion.

(2) However, such proceedings for a review may not be brought (or if brought may not be continued) if the issue raised by the review has been decided in other proceedings.

(3) The application shall be made on Patents Form 2/77, and shall be accompanied by a copy and a statement in duplicate setting out fully the grounds on which the review is sought.

(4) The statement shall contain particulars of any proceedings of which the applicant is aware which may be relevant to the question whether the proceedings for a review may be brought or continued.

(5) The application may be made on the following grounds only—

(a) that the opinion wrongly concluded that the patent was invalid, or was invalid to a limited extent; or

(b) that, by reason of its interpretation of the specification of the patent, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

Procedure on review

77I.—(1) Upon receipt of the application, the comptroller shall send a copy of the form and statement filed under rule 77H—

(a) to the requester (if different from the applicant); and

(b) to all persons who filed observations under rule 77F.

(2) The comptroller shall advertise the application in such manner as he may think fit.

(3) Before the end of the relevant period, any person may file a statement in support of the application or a counter-statement contesting it (which in either case must be in duplicate), and on so doing shall become a party to the proceedings.

(4) The relevant period is the later to end of the following periods—

(a) the period of four weeks beginning with the date that the application is advertised under paragraph (2);

(b) the period of two months beginning with the date on which the opinion is issued under rule 77G(2).

(5) The comptroller shall send to the other parties a copy of each statement or counter-statement filed under paragraph (3).

(6) The comptroller may give such directions as he thinks fit with regard to the subsequent procedure.

Outcome of review

77J.—(1) Upon the completion of the proceedings under rule 77I the comptroller shall either—

(a) set aside the opinion in whole or in part; or

(b) decide that no reason has been shown for the opinion to be set aside.

(2) A decision under paragraph (1)(a) or (b) shall not estop any party to proceedings from raising any issue regarding the validity or the infringement of the patent.

Appeals against a decision on review

77K. No appeal under section 97 shall lie from a decision to set aside the opinion under rule 77J(1)(a), except where the appeal relates to a part of the opinion that is not set aside.".

13. In rule 92(1), after paragraph (f) there shall be inserted—

"(ff) as to when an opinion has been requested under rule 77B;".

14.—(1) In rule 93(4)(a), after "document" there shall be inserted "(other than a document filed in connection with a request under section 74A)".

(2) In rule 94(1), after "Patents Form" there shall be inserted "or a document filed in connection with a request under section 74A".

15. In rule 102(**a**)—

(a) after paragraph (1) there shall be inserted—

"(1A) The comptroller may remit the whole or part of the fee payable in respect of a request for an opinion under section 74A where he has refused the request."; and

(b) in paragraph (2), after "paragraph (1)(b)" there shall be inserted "or (1A)", and after "applicant" there shall be inserted "or the requester of the opinion".

16. In rule 108(1), after "71 or 72," there shall be inserted "or under rule 77H,".

17. In rule 112—

(a) after "counter-statement", in both places where it occurs, there shall be inserted ", observations"; and

(b) after "a copy of any evidence" there shall be inserted "or observations".

18. In rule 113, after paragraph (5) there shall be inserted—

"(5A) For the purposes of paragraph (4), the institution of proceedings before the comptroller includes the making of a request for an opinion under section 74A.".

Security for costs

19. After rule 89 there shall be inserted—

"**Security for costs or expenses**

89A.—(1) The conditions prescribed for the purposes of making an order for security for costs under section 107(4)(**b**) are that the party against whom the order is made—

(a) is resident outside the United Kingdom, but not resident in—

(i) a Brussels Contracting State,

(ii) a Lugano Contracting State, or

(iii) a Regulation State,

as defined in section 1(3) of the Civil Jurisdiction and Judgments Act 1982(**c**);

(b) is a company or other body (whether incorporated inside or outside the United Kingdom) and there is reason to believe that it will be unable to pay another party's costs if ordered to do so;

(c) has changed his address for service with a view to evading the consequences of the litigation;

(d) has failed to furnish an address for service or furnished an incorrect address for service; or

(e) has taken steps in relation to his assets that would make it difficult to enforce an order for costs against him.

(2) In relation to proceedings in Scotland, references in this rule to costs are to be construed as references to expenses.".

(**a**) Rule 102 was amended by SI 1999/1092 and 2004/2358.

(**b**) Section 107(4) is substituted by section 15 of the Patents Act 2004, which is brought into force on 1st October 2005 in respect of proceedings commenced on or after that date by SI 2005/ 2471 (C.105).

(**c**) 1982 c. 27; section 1(3) was substituted by SI 1990/2591, and then amended by section 2(5) and (6) of the Civil Jurisdiction and Judgments Act 1991 (c. 12) and by SI 2000/1824 and 2001/3929.

Amendment of the Patents (Fees) Rules 1998

20. The Fees Rules shall be amended as follows.

21. For rule 3 of those Rules substitute—

"**3.**—(1) Except where rule 3A or 3B applies, the fees to be paid in respect of any matters arising under the Patents Act 1977 or the Patents Act 1949(**a**) are those specified in Parts A and B of the Schedule(**b**).

(2) Where a form—

(a) is required to be used by the Patents Rules 1995 or the Patents Rules 1968(**c**), and

(b) is specified in Part A or Part B of the Schedule as the corresponding form in relation to any matter,

that form shall be accompanied by the fee specified in respect of that matter.

(3) Paragraph (2) is without prejudice to any provision of those Rules which permits payment to be made before or after the form has been filed.".

22. After rule 3 insert—

"3A.—(1) Subject to paragraphs (2) and (3), the fee to be paid to keep a patent in force after a renewal date which falls on the anniversary indicated in the first column of the first table in Part AA of the Schedule is the amount specified in relation to that anniversary in the second column.

(2) Where rule 39A(3) of the 1995 Rules applies, the fee to be paid to keep a patent in force after the first renewal date is the sum of the following amounts—

(a) the amount specified in relation to the relevant anniversary, and

(b) the amounts specified in relation to all previous anniversaries.

(3) Where rule 39A(4) of the 1995 Rules applies, the fee to be paid to keep a patent in force after the first renewal date is the amount specified in relation to the relevant anniversary.

(4) For the purposes of paragraphs (2) and (3), the relevant anniversary is the last anniversary to fall on or before the first renewal date.

3B.—(1) The additional fees prescribed for late payment under section 25(4) of the Patents Act 1977 are specified in the second table in Part AA of the Schedule.

(2) Where payment is made before the end of the month indicated in the first column of that table, the fee to be paid is the amount specified in the second column.".

23.—(1) In Part A of the Schedule to the Fees Rules, at the end of the entry for Patents Form 2/77—

(a) in the second column, insert "On application under rule 77H for the review of an opinion"; and

(b) at the corresponding place in the third column, insert "50".

(2) In Part A of that Schedule, in the entry for Patents Form 12/77—

(a) for the wording contained in the second column, substitute "*See Part AA of this Schedule*"; and

(b) omit the list of fees contained in the third column.

(3) In Part A of that Schedule, after the entry for Patents Form 16/77, insert a new entry as follows—

(**a**) 1949 c. 87.
(**b**) Part A of that Schedule was amended by SI 1999/1093 and 2004/2358.
(**c**) SI 1968/1389, revoked with savings by rule 124 of SI 1978/216 (which was amended by rule 121(2) of the 1995 Rules).

(a) in the first column, insert "17/77";

(b) in the second column, insert "On request for an opinion under section 74A"; and

(c) in the third column, insert "200".

24. After Part A of the Schedule to the Fees Rules, insert a new Part AA as set out in the Schedule to these Rules .

Transitional provisions

25. Rule 19 of these Rules does not apply in respect of proceedings commenced before 1st October 2005.

26. In the following rules—

"the original rule 39" means rule 39 of the 1995 Rules as it stands immediately before 1st October 2005;

"the original restoration period" means the period prescribed for an application for the restoration of a patent by rule 41(1) of the 1995 Rules (as those Rules stand immediately before 1st October 2005);

"the new restoration period" means the period prescribed for such an application by rule 41(1) of the 1995 Rules (as amended by these Rules);

"the amended Fees Rules" means the Fees Rules as amended by rules 20 to 24 of these Rules;

"the original Fees Rules" means the Fees Rules as they stand immediately before 1st October 2005.

27.—(1) Where the period prescribed for the payment of a renewal fee by the original rule 39 expires on or after 1st October 2005, rules 39 to 39C as substituted by rule 6 of these Rules shall apply in respect of that payment.

(2) Where that period expires before 1st October 2005, rule 42 as substituted by rule 8 of these Rules shall have effect as if the reference to rule 39A or 39B were a reference to paragraphs (1) or (2) of the original rule 39.

28.—(1) Where the original restoration period expires before 1st October 2005, that period shall be the period prescribed for an application under section 28 for the restoration of the patent.

(2) Where the original restoration period expires on or after 1st October 2005, the period prescribed for such an application shall be the new restoration period.

29. The amended Fees Rules shall have effect in relation to any fees which are to be paid on or after 1st October 2005.

30.—(1) This rule applies where—

(a) the period for the payment of a renewal fee prescribed by the original rule 39 expires before 1st October 2005, and

(b) the period specified by section 25(4) as amended by the Patents Act 2004 ("the late payment period") ends after 1st October 2005.

(2) Paragraphs (3) and (4) have effect in relation to the additional fees prescribed for late payment.

(3) The fee prescribed by the original Fees Rules in respect of the month of the late payment period in which 1st October 2005 falls shall (as from that date) continue to be the fee prescribed, but the period in respect of which it is prescribed shall not expire until the end of 31st October 2005.

(4) The additional fees prescribed in respect of the remainder of the late payment period shall be the fees prescribed for the remaining months of that period by the amended Fees Rules.

Alun Michael
Minister for Industry and the Regions
Department for Trade and Industry

5th September 2005

SCHEDULE

Rule 24

PART AA

1. Table of renewal fees

Anniversary of date of filing	*Amount* £
4th	50
5th	70
6th	90
7th	110
8th	130
9th	150
10th	170
11th	190
12th	210
13th	230
14th	250
15th	270
16th	300
17th	330
18th	360
19th	400

2. Table of additional fees

Month beginning after the expiry of the period for payment of the renewal fee	*Amount of additional renewal fee* £
1st	0
2nd	24
3rd	48
4th	72
5th	96
6th	120

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).

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.

£3.00

© Crown copyright 2005

Printed and published in the UK by The Stationery Office Limited
under the authority and superintendence of Carol Tullo, Controller of Her Majesty's
Stationery Office and Queen's Printer of Acts of Parliament.

E1324 9/2005 151324T 19585

ISBN 0-11-073341-X

9 780110 733418