EXPLANATORY MEMORANDUM TO

THE PATENTS (AMENDMENT) RULES 2011

2011 No. 2052

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 amends the drafting relating to various prescribed periods contained in an existing instrument, in order to correct a defect in the drafting. The existing instrument relates to intellectual property rights and is the Patents Rules 2007 (SI 2007/3291, as amended). Since the amending instrument corrects a defect in this 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 the business and procedure of the statutory body called "the Patent Office", which uses as an operating name "the Intellectual Property Office". Amongst other things, this 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.

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. During the drafting of that instrument, certain time periods were reformulated using wording "X days/months/years **beginning with**" a particular date or event. The new wording was used to replace periods which had been drafted using the formulation "X days/months/years **from**" a particular date or event (or using a variety of wording with the same effect). The intention was to bring consistency to the wording but not to change the method of computation of the various prescribed periods. 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, there is established case-law that the "beginning with" formulation defines a period which ends one day sooner than the "from" formulation. The former case (the so-called "inclusive rule") includes the defining date when computing the prescribed period whereas, in the latter case, the prescribed period does not start until the day after the defining date (the "exclusive rule"). The purpose of this instrument is therefore to correct the wording used to prescribe the periods so that they all follow the exclusive rule. In practical terms, this means that where a rule requires a document to be filed within one month of an event and the relevant event occurs on 1st March, then the document must be filed on or before 1st April. This will restore the drafting in this respect to that which appeared in the Patents Rules prior to their modernisation, and accords with the practice of the Office and the expectations of its users.

- **Consolidation**

7.3 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.htm

8. Consultation outcome

8.1 As this instrument corrects drafting defects of which users were generally unaware, no formal consultation has taken place. However, the main organisations representing users of the patents system (including small businesses) were made aware informally that this correction would take place, and were content. The Administrative Justice and Tribunals Council were also consulted and were content.

9. Guidance

9.1 The Office will publicise that this corrective instrument has been made through its website, in its official journals and also by notifying users directly – for example by placing notices in their professional journals. The guidance will explain that the correction ensures that the various prescribed periods end on the date which was, in any

event, presumed to be the case prior to the correction. The guidance will also explain how the Office may deal with any miscalculation of a prescribed period which may have arisen prior to the correction being made, using its existing powers in the patent legislation to correct procedural irregularities.

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.

11.2 Nevertheless, one of the organisations consulted informally was one representing small business users of the patents system.

12. Monitoring & review

12.1 No review of the corrections is envisaged.

13. Contact

James Porter at the IPO/Patent Office (an executive agency of the Department for Business, Innovation and Skills) can answer any queries regarding the instrument. Tel: 01633 814521 or email: james.porter@ipo.gov.uk