STATUTORY INSTRUMENTS

1972 No. 1940 (L.28)

PATENTS

The Patents Appeal Tribunal Rules 1972

Made - - -	*8th December* 1972
Coming into Operation	*1st January* 1973

The Appeal Tribunal constituted under section 85(2) of the Patents Act 1949(**a**), as amended by section 24 of the Administration of Justice Act 1969(**b**), in exercise of the powers conferred on it by section 85(8) and (8A) of the Patents Act 1949, as amended by section 24 of the Administration of Justice Act 1969 and section 10 of the Administration of Justice Act 1970(**c**), hereby makes the following Rules:—

1.—(1) These Rules may be cited as the Patents Appeal Tribunal Rules 1972 and shall come into operation on 1st January 1973.

(2) The Interpretation Act 1889(**d**) shall apply to the interpretation of these Rules as it applies to the interpretation of an Act of Parliament.

(3) In these Rules, unless the context otherwise requires—

"the Act" means the Patents Act 1949 as amended;

"Appeal Tribunal" means the Appeal Tribunal constituted under section 85(2) of the Act, as amended by section 24 of the Administration of Justice Act 1969;

"Comptroller" means the Comptroller-General of Patents, Designs and Trade Marks;

"counsel" means a member of the Bar of England and Wales or of Northern Ireland or a member of the Faculty of Advocates in Scotland;

"Registrar" means the Registrar of the Appeal Tribunal;

"report" means a report by a scientific adviser;

"respondent's notice" means a notice given under rule 7;

"scientific adviser" includes a person with scientific qualifications, a medical practitioner, engineer, architect, surveyor, accountant, actuary and any other specially skilled person whose opinion in relation to any matter arising on an appeal may be of assistance to the Appeal Tribunal.

2.—(1) Any person who desires to appeal to the Appeal Tribunal from a decision of the Comptroller in any case in which a right of appeal is given by

(**a**) 1949 c. 87.
(**b**) 1969 c. 58.
(**c**) 1970 c. 31.
(**d**) 1889 c. 63.

the Act shall file with the Registrar a notice of appeal in the form set out in Schedule 1 to these Rules.

(2) The notice of appeal shall be filed—

(*a*) in the case of a decision on a matter of procedure, within 14 days after the date of the decision; and

(*b*) in any other case, within six weeks after the date of the decision.

(3) The Comptroller may determine whether any decision is on a matter of procedure and any such determination shall itself be a decision on a matter of procedure.

3.—(1) Notice of appeal may be given in respect of the whole or any specific part of the decision of the Comptroller and must specify the grounds of the appeal and the relief which the appellant seeks.

(2) Except with the leave of the Appeal Tribunal the appellant shall not be entitled on the hearing of the appeal to rely on any ground of appeal or to apply for any relief not specified in the notice of appeal.

4. The appellant shall, within two days of filing the notice of appeal, send a copy thereof to the Comptroller and any other party to the proceedings before the Comptroller.

5. On receiving the notice of appeal the Comptroller shall forthwith transmit to the Registrar all the papers relating to the matter which is the subject of the appeal.

6. Except by leave of the Appeal Tribunal, no appeal shall be entertained unless notice of appeal has been given within the period specified in rule 2(2) or within such further time as the Comptroller may allow upon request made to him prior to the expiry of that period.

7.—(1) A respondent who, not having appealed from the decision of the Comptroller, desires to contend on the appeal that the decision should be varied, either in any event or in the event of the appeal being allowed in whole or in part, must give notice to that effect, specifying the grounds of that contention and the relief which he seeks from the Appeal Tribunal.

(2) A respondent who desires to contend on the appeal that the decision of the Comptroller should be affirmed on grounds other than those set out in the decision must give notice to that effect, specifying the grounds of that contention.

(3) A respondent's notice shall be sent to the Comptroller and to the apellant and every other party to the proceedings before the Comptroller within 14 days after receipt of the notice of appeal by the respondent, or within such further time as the Appeal Tribunal may direct.

(4) A party by whom a respondent's notice is given must within two days after service of the notice on the appellant, furnish two copies of the notice to the Registrar.

8. The Registrar shall give to the Comptroller and to the appellant and every other party to the proceedings before the Comptroller not less than

seven days' notice of the date appointed for the hearing of the appeal, unless the Appeal Tribunal directs shorter notice to be given.

9. A party to an appeal before the Appeal Tribunal may appear and be heard either in person or by a patent agent, a solicitor or counsel.

10. An appeal to the Appeal Tribunal shall be by way of rehearing and the evidence used on appeal shall be the same as that used before the Comptroller and no further evidence shall be given, except with the leave of the Appeal Tribunal.

11.—(1) Subject to the provisions of this rule, all proceedings before the Appeal Tribunal shall be heard and determined in public unless in any particular case the Tribunal directs that they shall be heard in private.

(2) Proceedings before the Tribunal relating to a decision of the Comptroller in any case in which the complete specification of the patent application has not been published shall be heard and determined in private unless the Tribunal directs that they shall be heard in public.

(3) A direction under this rule may be given by the Tribunal either of its own motion or on the application of a party to the proceedings, and the direction may relate to all the proceedings or to any specified part of them.

12. The rules applicable to the filing of documentary evidence on proceedings before the Comptroller shall apply to documentary evidence filed on an appeal to the Appeal Tribunal.

13. The Appeal Tribunal may, at the request of any party, order the attendance at the hearing for the purpose of cross-examination of any person who has made a statutory declaration or sworn an affidavit in the matter to which the appeal relates.

14. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

15. On any appeal, the Appeal Tribunal may, at any time, either of its own motion or on the application of any party, appoint an independent scientific adviser to assist the Appeal Tribunal or to enquire and report upon any question of fact or of opinion not involving questions of law or construction.

16. Any report, so far as it is not accepted by all parties, shall be treated as information furnished to the Appeal Tribunal, and shall be given such weight as the Appeal Tribunal may think fit.

17. All reports shall be made in writing to the Appeal Tribunal, together with such copies as the Appeal Tribunal may require, and copies of the report shall be forwarded by the Registrar to the parties.

18. Any party may, within 14 days of receiving a copy of the report, or within such other time as the Appeal Tribunal may direct, apply for leave to cross-examine the scientific adviser on his report, and the Appeal Tribunal may on such application make an order for the cross-examination of the

scientific adviser at the hearing of the appeal. The Appeal Tribunal shall at the hearing direct at what stage the scientific adviser is to be called.

19. If the scientific adviser considers that any experiment or test (other than one of a trifling character) is necessary to enable him to report in a satisfactory manner he shall inform the parties and shall endeavour to agree with them as to the expenses involved and as to the persons to attend the experiment or test. In default of agreement between the parties, all such matters shall be determined by the Appeal Tribunal.

20. The Appeal Tribunal may at any time direct the scientific adviser to make a further or supplemental report and the provisions of rules 16 to 19 shall apply to such report as they apply to an original report.

21. The remuneration of the scientific adviser shall be fixed by the Appeal Tribunal, and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser is required to attend before the Appeal Tribunal.

22. The Appeal Tribunal may, in awarding costs, either fix the amount thereof or direct by whom and in what manner the amount of the costs is to be ascertained.

23. If the costs awarded are not paid within 14 days after the amount thereof has been fixed or ascertained, or within such shorter period as may be directed by the Appeal Tribunal, the party to whom the costs are payable may apply to the Appeal Tribunal for an order for payment under the provisions of section 85(5) of the Act.

24. Any notice or other document required to be filed with or sent to the Registrar under these Rules may be sent by prepaid letter through the post.

25.—(1) The Rules specified in Schedule 2 to these Rules are hereby revoked.

(2) Nothing in these Rules shall apply to an appeal of which notice has been given prior to the commencement of these Rules.

Dated 8th December 1972.

Patrick Graham, J.
Senior Judge of the Appeal Tribunal.

SCHEDULE 1

Rule 2

NOTICE OF APPEAL

IN THE MATTER OF AN APPLICATION BY (*a*)

and

IN THE MATTER OF AN OPPOSITION THERETO BY (*b*)

I/We (*c*)

of

hereby give notice of appeal to the Patents Appeal Tribunal from (*d*)

of the (*e*)

dated the day of 19 .

The grounds of my/our appeal are as follows: (*f*)

I/We ask the Appeal Tribunal to grant the relief set out below: (*g*)

Signature (*h*) .....

Address.....

.....

Date.....

(*a*) Here insert the nature of the application or proceedings, the name of the applicant and the number of the application for Letters Patent.

(*b*) Here insert the name(s) of the Opponent(s) if the application is opposed.

(*c*) Here insert name(s) and full address(es) of Appellant(s).

(*d*) Here insert "the decision" or "that part of the decision" as the case may be.

(*e*) Here insert "Comptroller-General" or "Officer acting for the Comptroller-General" as the case may be.

(*f*) Here specify the grounds of appeal.

(*g*) Here set out the relief which the Appellant seeks.

(*h*) To be signed by the Appellant personally or by his duly authorised representative.

NOTE:—This notice must be sent to the Registrar of the Patents Appeal Tribunal, Royal Courts of Justice, London, WC2A 2LL. It must be marked with a receipt for the fee prescribed for the filing of a notice of appeal. A copy of the notice, not so marked, must be sent to the Comptroller-General at the Patent Office, 25 Southampton Buildings, London, WC2A 1AY and to any party entitled to appear on the hearing before the Appeal Tribunal within the period prescribed by the Patents Appeal Tribunal Rules.

SCHEDULE 2

Rule 25(1)

RULES REVOKED

Title	*Reference*
The Patents Appeal Tribunal Rules 1950	S.I. 1950/392 (1950 II, p.201)
The Patents Appeal Tribunal (Amendment) Rules 1956	S.I. 1956/470 (1956 II, p.1722)
The Patents Appeal Tribunal (Amendment) Rules 1961	S.I. 1961/1016 (1961 II, p.1965)
The Patents Appeal Tribunal (Amendment) Rules 1969	S.I. 1969/500 (1969 I, p.1404)
The Patents Appeal Tribunal (Amendment) Rules 1970	S.I. 1970/1074 (1970 II, p.3330)
The Patents Appeal Tribunal (Amendment) Rules 1971	S.I. 1971/394 (1971 I, p.1201)

EXPLANATORY NOTE

(*This Note is not part of the Rules.*)

These Rules amend and consolidate the Rules governing the procedure of the Patents Appeal Tribunal. Provision is made to permit respondents to appeals to contend that the decision appealed from should be varied. All existing Rules are revoked.

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