STATUTORY INSTRUMENTS

1999 No. 1093

PATENTS

The Patents (Fees) (Amendment) Rules 1999

Made - - - -	*31st March 1999*
Laid before Parliament	*9th April 1999*
Coming into force	*4th May 1999*

The Secretary of State, in exercise of powers conferred upon him by section 123(1), (2) and (3) of, and paragraph 14 of Schedule 4 to, the Patents Act 1977**(a)**, of the power conferred upon him by the Department of Trade and Industry (Fees) Order 1988**(b)**, and of all other powers enabling him in that behalf, after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992**(c)**, and with the consent of the Treasury pursuant to subsection (4) of the said section 123, hereby makes the following Rules:–

1. These Rules may be cited as the Patents (Fees) (Amendment) Rules 1999 and shall come into force on 4th May 1999.

2. Part A of the Schedule to the Patents (Fees) Rules 1998**(d)** shall be amended as follows.

3. In respect of the item, the patents form relating to which is Form 9/77, and the fee specified in respect of it, there shall be substituted the following:

"9/77	**On request for preliminary examination and search under section 17(1)–**	
	(a) in respect of an international application for a patent (UK) falling to be treated as an application for a patent under the Act which has already been the subject of a search by the International Searching Authority in accordance with the Patent Co-operation Treaty	**100**
	(b) in respect of any other application	**130**
	On request for a further search under section 17(6) or payment for a supplementary search under section 17(8)	**130".**

4. The fee to be paid in respect of the following item shall be as specified below–

On entry of an international application for a patent (UK) into the national phase (section 89A(3))	**"10".**

Kim Howells
Parliamentary Under Secretary of State
for Competition and Consumer Affairs,
Department of Trade and Industry

29th March 1999

(a) 1977 c. 37.
(b) S.I. 1988/93, as amended by S.I. 1990/1473, which was made under section 102 of the Finance (No. 2) Act 1987 (c. 51). The relevant provisions of that Order are article 7 and Part IV of Schedule 1.
(c) 1992 c. 53.
(d) S.I. 1998/1778.

We consent to the making of these Rules.

Jim Dowd
David Jamieson
31st March 1999 Two of the Lords Commissioners of Her Majesty's Treasury

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the Patents (Fees) Rules 1998 (S.I. 1998/1778) for the following reasons–

(a) at present the preliminary search and examination fee is £130 for all applications. Under rule 102(a) of the Patents Rules 1995, the comptroller may remit the whole or part of this fee in respect of any international application for a patent designating the United Kingdom which falls to be treated as an application for a patent under the Patents Act 1977 because when these applications enter the national phase under section 89A(3)(a) they will as such have already been the subject of a search by the International Searching Authority in accordance with the Patent Co-operation Treaty. The usual amount of the remittance is £20. Making the remittance is time consuming and inefficient. The relevant amendment reduces the fee to be paid for the preliminary search and examination for these applications by £30 (the £10 difference is recovered by the amendment described in paragraph (b)) (rule 3);

(b) the Patents (Fees) Rules 1998 removed the fee (£25) which previously had to be paid before an international application for a patent (UK) could enter the national phase under section 89A(3) of the Patents Act 1977. In the absence of a prescribed fee, there is no barrier to the automatic entry into the national phase of an English language international application. This has had the unintended effect of denying patent applicants the opportunity to reconsider whether such entry is desired or desirable given that on entry, such applications become published and part of the state of the art under section 2(3) of the Patents Act 1977. The amendment re-introduces a reduced fee (£10 instead of £25) to correct this (rule 4).

A Regulatory Impact Assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies are available also from the Legal Division, Patents and Designs Directorate, the Patent Office, Newport, South Wales, NP9 1RH.

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£1.50

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WO 4596 4/99 ON (MFK)