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STATUTORY INSTRUMENTS

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**1999 No. 3197**

**PATENTS**

**The Patents (Amendment) (No. 2) Rules 1999**

*Made* - - - - 29th November 1999  
*Laid before Parliament* 30th November 1999  
22nd December  
*Coming into force* - - 1999

The Secretary of State, in exercise of the powers conferred upon him by sections 5(2), 8(3), 13(1) and (2), 14(1) and (2), 15(2), (3) and (5), 17(1), (2) and (8), 29, 32(2), (5), (6) and (7), 89, 89A, 123, 124 and 127(6) of, and paragraph 14 of Schedule 4 to, the Patents Act 1977<sup>(1)</sup>, after consultation with the Council on Tribunals pursuant to section 8(1) of the Tribunals and Inquiries Act 1992<sup>(2)</sup>, hereby makes the following Rules—

**Citation, commencement and transitional**

**1.**—(1) These Rules may be cited as the Patents (Amendment) (No. 2) Rules 1999 and subject to paragraph (2) shall come into force on 22nd December 1999.

(2) Rules 3, 18 and 21 of these Rules shall not apply to any proceeding commenced before the comptroller before the entry into force of these Rules but shall apply to such proceedings as from 26th April 2000.

**2.** The Patents Rules 1995<sup>(3)</sup> shall be amended as follows.

**3.**—(1) In relation to the time or period for doing any act or taking any proceeding, for the words “two months” in each place where they occur in any of the rules mentioned in paragraph (2) below, there shall be substituted the words “six weeks”.

(2) The rules referred to in paragraph (1) above are rules 7(3), (4) and (5) (references under section 8(1)(a) or 12(1)(a)), rules 8(3), (5), (6) and (7) (references by co-proprietors under section 8(1)(b) or 12(1)(b)), rule 12(2) (request by joint applicant under section 10 or 12(4)), rule 13(2) (reference to the comptroller under section 11(5)), rule 14(3) (mention of inventor under section 13), rule 40(4) (amendment of specification after grant), rule 43(4) (surrender of patents), rules 54(3), (4) and (5) (reference of question to the comptroller under section 37(1)), rule 58(2) (reference to comptroller under section 38(5)), rules 59(3), (4) and (5) (application under section 40 for compensation), rules 62(3) and (4) (application under section 46(3) to settle licences of right),

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(1) 1977 c. 37.

(2) 1992 c. 53.

(3) S.I. 1995/2093.

rule 71(3) (opposition under section 52), rules 72(4), (5), (6) and (7) (procedure on reference to comptroller under section 61(3)), rules 73(3), (4) and (5) (procedure where validity of patent in dispute), rules 74(2), (3) and (4) (procedure on application under section 71) and rules 75(3), (4) and (5) (procedure on application for revocation under section 72).

**4.** In rule 6 (declaration of priority for the purposes of section 5)—

(a) for paragraph (6) substitute—

“(6) Where a copy of an application is filed or treated as having been filed under paragraph (2)(b), (3), (4) or (5) above and that application is in a language other than English:

- (a) a translation thereof into English verified to the satisfaction of the comptroller as corresponding to the original text (“verified translation”); or
- (b) a declaration to the effect that the application in suit is a complete translation into English of the priority application

shall be filed before the patent is granted or within such other period as the comptroller may specify in a particular case.

Provided that where the comptroller considers the filing of a declaration under subparagraph (b) to be inappropriate in a particular case, the comptroller may require the applicant to file a verified translation.”;

(b) paragraph (7) is omitted.

**5.** In rule 7(2) (references under section 8(1)(a) or 12(1)(a)), immediately after subparagraph (d) there shall be inserted—

“other than any person who has consented in writing to the reference.”.

**6.** In rule 8(2) (references by co-proprietors under section 8(1)(b) or 12(1)(b)), immediately after subparagraph (e), there shall be inserted—“other than the co-proprietor making the reference under section 8(1)(b) or 12(1)(b)”.

**7.** In rule 14 (mention of inventor under section 13)—

- (a) in subparagraph (a) of paragraph (1) for the word “he” substitute the words “any person”;
- (b) after paragraph (5), insert—

“(6) This procedure shall not apply where the question of inventorship by the inventor or joint inventor is put in issue by a reference under section 8 or 37.”.

**8.** In rule 24 (new applications under section 15(4)), in paragraph (1)—

- (a) the words “the latest of” are omitted;
- (b) in subparagraph (a)—
  - (i) the reference in parentheses to “(a)” is omitted;
  - (ii) for the words “sixth month” substitute “third month”;
- (c) subparagraphs (b) and (c) are omitted;

**9.** In rule 25 (periods prescribed under sections 15(5)(a) and (b) and 17(1) for filing claims, abstract and request for preliminary examination and search)—

- (a) in paragraph (3), for the word “on” substitute the words “at the end of two months from”;
- (b) after paragraph (3), insert—

“(4) In a case where the new application is filed under section 8(3), 12(6), 15(4) or 37(4) after the beginning of the sixth month before the end of any period prescribed in rule 34 (period for putting application in order) in relation to the earlier application,

as altered, if that be the case, under rule 100 or rule 110, the period prescribed for the purposes of sections 15(5) and 17(1) shall be the period which expires on the actual date of filing of the new application.”.

**10.** In rule 32(2) (searches under sections 17(6) and (8)), for the words “before the expiry of the period specified for the making of observations on the report made under section 18(3)” substitute “not later than the beginning of the third month before the end of the period prescribed under rule 34, as altered, if that be the case, under rule 100 or rule 110”.

**11.** In rule 38 (certificates of grant), for the words “the form set out in Schedule 3” substitute “a form which includes the name of the proprietor of the patent and the date of filing of the application.”.

**12.** In rule 39 (renewal of patents)—

- (a) in paragraphs (1) and (2), the words “accompanied by the prescribed renewal fee for that year” and the words “accompanied by the prescribed renewal fee” are omitted;
- (b) in paragraph (1) after the word “filed” where it occurs in the fifth line insert the words “and the prescribed renewal fee paid”;
- (c) in the proviso to paragraph (1), after the word “filed” insert the words “and the prescribed renewal fee paid”;
- (d) in paragraph (2), after the word “filed”, insert the words “and the prescribed renewal fee paid”;
- (e) for paragraph (3) substitute—

“(3) On receipt of the prescribed renewal fee, the comptroller shall (if the patent has been granted) issue a certificate of payment.”.

**13.** In rule 43(1) (surrender of patents), for subparagraph (a) substitute—

- “(a) given in writing accompanied by:
  - (i) a declaration that no action is pending before the court for infringement or for revocation of the patent; or
  - (ii) if an action before the court is pending full particulars of the action in writing;”.

**14.** In rule 44 (entries in the register), after paragraph (2) insert—

“Provided that the comptroller may omit from the register, the address of the person or persons stated by the applicant or applicants to be believed to be the inventor or inventors, if so requested by the applicant or applicants.”.

**15.** In rule 46(2) (registrations under section 33), in subparagraph (a), after the word “thereto” insert the words “or the assignor only”.

**16.** In rule 54(2) (reference of question to the comptroller under section 37(1)) immediately after subparagraph (b), there shall be inserted—

“other than the person making the reference under section 37(1) or any person who has consented in writing to the reference.”.

**17.** In rule 85 (international applications for patents: sections 89 and 89A)—

- (a) in paragraph (1)—
  - (i) in subparagraph (a), for the words “twenty months” substitute “twenty-one months”;
  - (ii) in subparagraph (b)(i), for the words “thirty months” substitute “thirty-one months”;
  - and
  - (iii) in subparagraph (b)(ii), for the words “thirty months” substitute “thirty-one months”;
- (b) in paragraph (2)—

- (i) in subparagraph (a), for the words “two months” substitute “three months”;
  - (c) in paragraph (3)—
    - (i) for subparagraph (c) substitute—
      - “(c) rule 6(6) shall apply.”;
    - (ii) in subparagraph (d) in the third line after the word “shall” for the rest of the paragraph substitute—
      - “apply”; and
  - (d) in paragraph (5A)—
    - (i) in subparagraph (a), for the words “one month” substitute “three months”.
- 18.** In rule 88 (Comptroller’s discretionary powers)—
- (a) in paragraph (1), for the words “the party concerned consents to shorter notice” substitute the words “he considers a different period is appropriate”;
  - (b) after paragraph (1) insert—
    - “(1A) At any stage of any proceedings before the comptroller, he may direct that the party or parties to the proceedings attend a case management conference at which he may give such directions as he may think fit with regard to the management of the proceedings. The comptroller shall give the party or parties at least fourteen days notice of the date of the case management conference.
    - (1B) Before hearing any party or parties that desire to be heard in any proceedings before him, the comptroller may direct that the party or parties attend a pre-hearing review at which he may give such directions as he may think fit with regard to the management of the hearing. The comptroller shall give the party or parties at least fourteen days notice of the date of the pre-hearing review.”;
  - (c) in paragraphs (2) and (3) for the words “*inter partes*” substitute the word “any”.
- 19.** In rule 103 (evidence)—
- (a) in paragraph (1) after the words “statutory declaration” insert the words “, witness statement”;
  - (b) in paragraph (2) after the word “affidavit” insert the words “, witness statement”;
  - (c) after paragraph (4) insert—
    - “(5) The comptroller may give a direction as he thinks fit in any particular case that evidence shall be given by affidavit or statutory declaration instead of or in addition to a witness statement.
    - (6) Where in proceedings before the comptroller, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the comptroller may, if he thinks fit, permit any other party to the proceedings to call that person as a witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief”.
- 20.** After rule 104 (statutory declarations and affidavits) insert—

**“Witness Statements**

**104A.** Any witness statement filed under these Rules shall—

- (a) be a written statement signed and dated by a person which contains the evidence which the person signing it would be allowed to give orally; and

(b) include a statement by the intended witness that he believes the facts in it are true.”.

**21.** In rule 110 (alteration of time limits)—

(a) after paragraph (2) insert—

“(2A) A time or period prescribed in rules 7(3), (4) and (5), 8(3), (5), (6) and (7), 9(2), 12(2), 13(2), 14(3), 40(4), 43(4), 54(3), (4) and (5), 56, 57(1), 58(2), 59(3), (4) and (5), 62(3) and (4), 70(1), 71(3), 72(3), (4), (5), (6) and (7), 73(3), (4) and (5), 74(2), (3) and (4), 75(3), (4) and (5), 77(1), 88(1) and (3), 88(1A) and (1B) for doing any act or taking any proceeding thereunder, may be shortened by the comptroller if he thinks fit, upon such notice to the parties and upon such terms as he may direct.”;

(b) in paragraph (3), after the words “rule 6(2)” omit “and

(6) (including the period therein prescribed as substituted by rule 85(3)(c) and (d))”.

**22.** In Schedule 1, for Patents Form 12/77 (Payment of renewal fee (and additional fee for late payment)) substitute the form in the Schedule to these Rules.

**23.** Schedule 3 is omitted.

*Kim Howells,*  
Parliamentary Under-Secretary of State for  
Consumers and Corporate Affairs,  
Department of Trade and Industry

29th November 1999

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SCHEDULE

Patents Form 12/77

Patents Act 1977  
(Rules 39 and 41)



12/77

**Payment of renewal fee  
(and additional fee for  
late payment)**  
*(see notes on the back of this form)*

**The Patent Office**  
Cardiff Road  
Newport  
South Wales NP10 8QQ

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1. Your reference

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2. Patent number

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3. Which year are you paying for?  
*(In terms of the life of the patent e.g. 6th)*

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4. Amount of renewal fee

Amount of late payment fee

Total amount paid

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5. Name, address and postcode of the person  
paying the fee

Patents ADP number *(if you know it)*

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6. If next year you want the reminder that renewal is  
overdue sent to an address other than the address  
for service registered with the Patent Office,  
you should enter details of this other address here  
and sign and date it. Otherwise you should leave  
this space blank. *(Permanent changes of the address for  
service should be notified in a separate letter.)*

Signature

Date

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7. Name and daytime telephone number of  
person to contact in the United Kingdom

**Patents Form 12/77**

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## **Patents Form 12/77**

### **Notes**

- a) *If you need help to fill in this form or you have any questions, please contact the Patent Office on 0645 500505.*
- b) *Write your answers in capital letters using black ink or you may type them.*
- c) *If you have filled in part 6 of the form you must remember to sign and date it.*
- d) *For details of fees and ways to pay, please contact the Patent Office on 0645 500505.*

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## EXPLANATORY NOTE

*(This note is not part of the Rules)*

These Rules further amend the Patents Rules 1995 (S.I. 1995/2093) (which were previously amended by the Patents (Amendment) Rules 1999 (S.I. 1999/1092) and the Patents and Trade Marks (World Trade Organisation) Regulations 1999 (S.I. 1999/1899)) (“the Patents Rules”). In addition to minor and drafting amendments, these Rules—

- (a) shorten the prescribed time limits in relation to certain proceedings under the Patents Act from two months to six weeks. The relevant rules of the Patents Rules where the time limits have been reduced and the proceedings to which they apply are:
  - rules 7(3), (4) and (5) (references under section 8(1)(a) or 12(1)(a));
  - rules 8(3), (5), (6) and (7) (references by co-proprietors under section 8(1)(b) or 12(1)(b));
  - rule 12(2)(request by joint applicant under section 10 or 12(4));
  - rule 13(2)(reference to the comptroller under section 11(5));
  - rule 14(3)(mention of inventor under section 13);
  - rule 40(4)(amendment of specification after grant);
  - rule 43(4)(surrender of patents);
  - rules 54(3), (4) and (5) (reference of question to the comptroller under section 37(1));
  - rule 58(2)(reference to comptroller under section 38(5));
  - rules 59(3), (4) and (5) (application under section 40 for compensation);
  - rules 62(3) and (4) (application under section 46(3) to settle licences of right);
  - rule 71(3)(opposition under section 52(1));
  - rules 72(4), (5), (6) and (7) (procedure on reference to comptroller under section 61(3));
  - rules 73(3), (4) and (5) (procedure where validity of patent in dispute);
  - rules 74(3) and (4) (procedure on application under section 71); and
  - rules 75(3), (4) and (5) (procedure on application for revocation under section 72);
- (b) provide for the filing of translations or declarations in relation to translations of priority applications up to the date of grant (rule 4);
- (c) provide that references under section 8(1)(a) or (b) or 12(1)(a) or (b) do not have to be copied by the comptroller to any person who has already given his consent (rules 5 and 6);
- (d) provide for any person to file a request to add an inventor’s name except where inventorship is put in issue under sections 8 or 37 (rule 7);
- (e) provide for the extension of the period in which to file a new application under section 15(4) (rule 8);
- (f) provide for the extension of the time for filing claims, abstract and search request where a new application is filed under section 8(3), 12(6), 15(4) or 37(4) (rule 9);
- (g) provide for an extension of the time for filing a search request on a second invention under section 17(6) and (8) (rule 10);



- (h) omit the form in relation to certificates of grant (rules 11 and 23);
- (i) omit the requirement for the prescribed renewal fee to accompany the Patents Form 12/77 with consequential changes to Form 12/77 (rules 12, 22 and Schedule 1);
- (j) provide for the surrender of patents to be given in writing and not on Form 2/77 (rule 13);
- (k) provide for the comptroller to omit the address of the inventor from the register, where requested (rule 14);
- (l) provide for the assignor, as the case may be, to sign applications to register or give notice of an assignment or assignation (rule 15);
- (m) provide that a copy of a reference does not have to be copied by the comptroller under section 37(1) to any person who has consented (rule 16);
- (n) provide for the extension of certain time limits in relation to international applications for patents: and apply rule 6(6) to such applications (rule 17);
- (o) provide for the comptroller to call case management conferences and pre-hearing reviews (rule 18);
- (p) provide for the giving of evidence by witness statement and the calling of witnesses in certain circumstances (rule 19); and
- (q) provide for the comptroller to shorten certain time limits as he sees fit upon notice to the parties and terms as the comptroller may direct (rule 21). The relevant rules of the Patents Rules and the proceedings to which they apply are:
  - rules 7(3), (4) and (5) (references under section 8(1)(a) or 12(1)(a));
  - rules 8(3), (5), (6) and (7) (references by co-proprietors under section 8(1)(b) or 12(1)(b));
  - rule 9(2)(orders under section 8 or 12);
  - rule 12(2)(request by joint applicant under section 10 or 12(4));
  - rule 13(2)(reference to the comptroller under section 11(5));
  - rule 14(3)(mention of inventor under section 13);
  - rule 40(4)(amendment of specification after grant);
  - rule 43(4)(surrender of patents);
  - rules 54(3), (4) and (5) (reference of question to the comptroller under section 37(1));
  - rule 56 (time limit for new application);
  - rule 57(1)(request under section 38(3));
  - rule 58(2)(reference to comptroller under section 38(5));
  - rules 59(3), (4) and (5) (application under section 40 for compensation);
  - rules 62(3)and (4) (application under section 46(3) to settle licences of right);
  - rule 70(1)(procedure on receipt of application under section 48 or 51);
  - rule 71(3)(opposition under section 52(1));
  - rules 72(3), (4), (5), (6) and (7) (procedure on reference to comptroller under section 61(3));
  - rules 73(3), (4) and (5) (procedure where validity of patent in dispute);
  - rules 74(3)and (4) (procedure on application under section 71);
  - rules 75(3), (4) and (5) (procedure on application for revocation under section 72);
  - rule 77(1)(revocation and amendment of patents under section 73);

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rules 88(1) and (3) (Comptroller's discretionary powers); and  
rules 88(1A) and (1B) (Comptroller's discretionary powers).

These Rules take effect from 22nd December 1999 save that rules 3, 18 and 21 shall not apply to any proceedings already begun before the Comptroller at the time of entry into force of these Rules but that they should apply after 26 April 2000 to any such proceedings after that date;

A Regulatory Impact assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment are also available from the Patents and Designs Directorate, Concept House, Cardiff Road, Newport NP9 1RH.