

2005 No. 2471 (C.105)

PATENTS

The Patents Act 2004 (Commencement No. 3 and Transitional Provisions) Order 2005

Made - - - - *5th September 2005*

Coming into force - - *1st October 2005*

The Secretary of State makes the following Order in exercise of the powers conferred upon him by section 17 of the Patents Act 2004(a):

Citation, commencement and interpretation of this Order

1.—(1) This Order may be cited as the Patents Act 2004 (Commencement No. 3 and Transitional Provisions) Order 2005 and shall come into force on 1st October 2005.

(2) In this Order—

“the 1977 Act” means the Patents Act 1977(b);

“the 2004 Act” means the Patents Act 2004;

“the appointed day” means the day appointed by article 2.

Commencement of the 2004 Act

2. 1st October 2005 is the day appointed for the coming into force of the following provisions of the 2004 Act—

(a) section 8;

(b) section 9;

(c) section 13;

(d) section 15;

(e) section 16(1) (for the purposes of the provisions of Schedule 2 mentioned below);

(a) 2004 c. 16.

(b) 1977 c. 37. Sections 16, 24, 25, 28, 32, 36, 46, 62, 72, 74, 107 and 123 are amended by the provisions of the 2004 Act which are brought into force by article 2 of this Order. Previous amendments to those provisions were as follows: section 28 was amended by paragraph 6 of Schedule 5 and Schedule 8 to the Copyright, Designs and Patents Act 1988 (c. 48); section 32 was substituted by paragraph 4 of Schedule 1 to the Patents, Designs and Marks Act 1986 (c. 39), and then amended by Schedule 6 to the Youth Justice and Criminal Evidence Act 1999 (c. 23); section 46 was amended by paragraph 12 of Schedule 5 to the Copyright, Designs and Patents Act 1988; sections 72 and 74 were amended by paragraphs 10 and 18 of Schedule 5 and Schedule 8 to that Act; section 107 was amended by paragraph 20 of Schedule 6 to the Debtors (Scotland) Act 1987; and section 123 was amended by paragraph 29 of Schedule 5, paragraph 22 of Schedule 7, and Schedule 8 to the Copyright, Designs and Patents Act 1988. In addition, sections 120 and 123 of the 1977 Act were amended by the provisions of the 2004 Act which were brought into force on 22nd September 2004 by SI 2004/2177 (C. 94). And sections 8, 11, 12, 22, 23, 38, 40, 41, 43, 53, 60, 61, 63, 70, 75, 89, 89B, 91, 95, 103, 105, 106, 121, 130 and 131 were amended, and sections 86 and 87 repealed, by the provisions of the 2004 Act which were brought into force on 1st January 2005 by SI 2004/3205 (C. 140). Details of previous amendments to those provisions are noted in SI 2004/2177 and 2004/3205.

- (f) section 16(2) (for the purpose of the entry in Schedule 3 relating to the repeal made by paragraph 18 of Schedule 2);
- (g) paragraphs 6, 9, 15, 18 and 26(2) of Schedule 2.

Transitional provisions

3.—(1) Where the prescribed period in respect of a patent expires on or after the appointed day, section 25(3) of the 1977 Act as amended by section 8(1) of the 2004 Act shall have effect in respect of that patent.

(2) Where, in respect of a patent—

- (a) the renewal fee is not paid by the end of the prescribed period, and
- (b) that period expires before the appointed day, but
- (c) the period of six months immediately following the end of the prescribed period does not expire before the appointed day,

the provisions mentioned in paragraph (3) shall have effect in respect of that patent.

(3) Those provisions are—

- (a) section 25(4) of the 1977 Act as amended by section 8(2) of the 2004 Act;
- (b) section 28(3) of the 1977 Act as amended by section 8(3) of the 2004 Act.

(4) In this article, “prescribed period” means the period prescribed by rule 39 of the Patents Rules 1995(a) as it stands immediately before the appointed day.

4. Section 15 of the 2004 Act shall apply in respect of proceedings commenced on or after the appointed day.

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

5th September 2005

EXPLANATORY NOTE

(This note is not part of the Order)

Article 2 of this Order brings into force, on 1st October 2005, a number of provisions of the Patents Act 2004 (c. 16), all of which make amendments to the Patents Act 1977 (c. 37) (“the 1977 Act”). The Order also makes appropriate transitional provision.

Changes to the Patents Rules 1995 (SI 1995/2093) and the Patents (Fees) Rules 1998 (SI 1998/1778) which are related to the commencement of those provisions are made by the Patents (Amendment) Rules 2005 (SI 2005/), which also come into force on 1st October 2005.

Term of patent and periods allowed for payment of renewal fees

Section 8 is brought into force, enabling both a period to be prescribed for the payment of a patent renewal fee and a date to be prescribed for the expiry of the patent for non-payment of the fee. As a result, the period prescribed for payment may end on a different date from that on which the patent expires (see rules 39 to 39B of the Patents Rules 1995 as substituted by rule 6 of the Patents (Amendment) Rules 2005). Section 8 also enables the period of grace for late payment of the fee to end at the end of the relevant month. The minor clarificatory amendment made by paragraph 15 of Schedule 2 is also brought into force.

Article 3 contains related transitional provisions. The effect of *article 3(1)* is that the changes in respect of the renewal fee payment period apply to a patent where the old payment period expires

(a) SI 1995/2093; rule 39 was amended by SI 1999/3197.

on or after 1st October 2005. The effect of *article 3(2) and (3)* is that the changes in respect of the period of grace for late payment apply to a patent where the old late payment period expires on or after 1st October 2005.

Co-ownership and revocation of patents

Section 9 and paragraph 18 of Schedule 2 are brought into force, clarifying the rights of owners and co-owners of a patent in respect of applying for its amendment or revocation.

No transitional provision is necessary.

Opinions as to validity or infringement

Section 13 is brought into force, enabling requests to be made to the Patent Office for a non-binding opinion on the questions of validity or infringement of a patent. (Procedures for such requests, and for the review of the resulting opinion, are contained in rules 77A to 77K of the Patents Rules 1995 inserted by rule 12 of the Patents (Amendment) Rules 2005.)

No transitional provision is necessary.

Security for costs

Section 15 is brought into force, redefining the circumstances in which an order for security for costs may be made in proceedings before the comptroller and, in particular, enabling conditions for making such an order to be prescribed (for which see rule 89A of the Patents Rules 1995 inserted by rule 19 of the Patents (Amendment) Rules 2005).

Article 4 contains a transitional provision, with the result that the changes will apply only to proceedings commenced on or after 1st October 2005.

Publication of names and addresses of inventors

Paragraphs 6, 9 and 26(2) of Schedule 2 are brought into force, enabling provision to be made allowing an inventor to waive his right to be mentioned as such in documents published by the Patent Office (see rule 15A of the Patents Rules 1995 inserted by rule 2 of the Patents (Amendment) Rules 2005).

No transitional provision is necessary.

NOTE AS TO EARLIER COMMENCEMENT ORDERS

(This note is not part of the Order)

The provisions of the Patents Act 2004 which are set out in the table below have been brought into force before the date of this Order by the Patents Act (Commencement No. 1 and Consequential and Transitional Provisions) Order 2004 (SI 2004/2177 (C. 94)) and the Patents Act (Commencement No. 2 and Consequential, etc. and Transitional Provisions) Order 2004 (SI 2004/ 3205 (C. 140)).

<i>Provision</i>	<i>Date of Commencement</i>	<i>S.I. No.</i>
Sections 6, 7, 10, 11, 12 and 14.	1st January 2005	2004/3205
Section 16(2) (for the purposes of the entries in Schedule 3 relating to the provisions brought into force by SI 2004/2177).	22nd September 2004	2004/2177
Section 16(2) (for the purposes of the entries in Schedule 3 relating to provisions brought into force by SI 2004/3205 and to the amendment of section 106 of the 1977 Act).	1st January 2005	2004/3205

Section 16(3).	1st January 2005	2004/3205
Paragraphs 1, 6, 7 and 8, and paragraph 9(1), (2)(a) and (3), of Schedule 1 (and section 5 for the purposes of those provisions).	1st January 2005	2004/3205
Paragraph 9(2)(b) of Schedule 1 (for the purposes of the Patent Co-operation Treaty), and section 5 for the purpose of that provision.	1st January 2005	2004/3205
Paragraphs 1, 5, 8, 10 to 14, 16, 17, 19, 20 to 22, 25, 27 and 28 of Schedule 2 (and section 16(1) for the purposes of those provisions).	1st January 2005	2004/3205
Paragraph 24 and paragraph 26 of Schedule 2 (except for paragraph 26(2)), and section 16(1) for the purposes of those provisions	22nd September 2004	2004/2177

In addition, paragraphs 7 and 23 of Schedule 2 came into force (pursuant to section 17(2) of the Patents Act 2004) with the commencement of the Regulatory Reform (Patents) Order 2004 (SI 2004/2357) on 1st January 2005.

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.

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