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STATUTORY INSTRUMENTS

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**2016 No. 892**

**PATENTS**

**The Patents (Amendment) (No. 2) Rules 2016**

<i>Made</i>	- - - -	<i>5th September 2016</i>
<i>Laid before Parliament</i>		<i>8th September 2016</i>
<i>Coming into force</i>		
<i>for the purposes of rules</i>		
<i>3(b), 9 and 17</i>		<i>6th April 2017</i>
<i>for all other purposes</i>		<i>1st October 2016</i>

The Secretary of State makes the following Rules in exercise of the powers conferred by sections 19(1), 32(2) and 123 of the Patents Act 1977(1).

**Citation and commencement**

1.—(1) These Rules may be cited as the Patents (Amendment) (No. 2) Rules 2016.

(2) This rule and rules 2, 3(a), 3(c) to 8, 10 to 16 and 18 come into force on 1st October 2016 and rules 3(b), 9 and 17 come into force on 6th April 2017.

**Amendments to the Patents Rules 2007**

2. The Patents Rules 2007(2) are amended as follows.

**Applications for the grant of patents under sections 14 and 15**

3. In rule 12—

(a) in paragraph (4)(c) after “drawing” insert “or photograph”,

(b) after paragraph (6) insert—

“(6A) The claim or claims must not rely in respect of the technical features of the invention on references to the description or any drawing or photograph unless the

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(1) 1977 c.37; see section 123(1) for the definitions of “prescribed” and “rules”; section 32 was substituted by the Patents, Designs and Marks Act 1986 (c.39), Schedule 1, paragraph 4 and amended by section 13(3) of the Patents Act 2004 (c.16) (there are other amendments to section 32 but none is relevant), section 123 was amended by the Copyright, Designs and Patents Act 1988 (c.48), Schedule 5, paragraph 29. There are other amendments to section 123 which are not relevant to these Rules.

(2) S.I. 2007/3291; amended by S.I. 2011/2052, S.I. 2014/578 and S.I. 2014/2401; there are other amending instruments but none is relevant.

feature cannot otherwise be clearly and concisely defined in words, by a mathematical or chemical formula or by any other written means.”; and

- (c) in paragraph (7) after the first reference to “drawings” insert “or photographs” and after the second reference insert “and photographs”.

#### **Size and presentation of application**

4. In rule 14—

- (a) in paragraphs (1), (2) and (4) after “drawings” insert “and photographs”, and  
(b) in paragraph (3) after “drawing” insert “and a photograph”.

#### **The abstract**

5. In rule 15, in paragraphs (4), (5) and (6), after “drawing” in each place where it occurs insert “or photograph”.

#### **New applications**

6. For rule 19, substitute—

##### **“New applications filed as mentioned in section 15(9)**

19.—(1) For the purposes of section 15(9)(3) a new application may only be filed in accordance with this rule.

(2) A new application may be filed as mentioned in section 15(9) if—

- (a) the earlier application(4) has not been terminated or withdrawn; and  
(b) the period ending three months before the compliance date(5) of the earlier application has not expired.

(3) A new application must include a statement that it is filed as mentioned in section 15(9).”

#### **Amendment of application before grant**

7. At the beginning of rule 31(3) insert “Subject to rule 66A”.

#### **Reinstatement of applications under section 20A**

8. In rule 32—

(a) for paragraph (2) substitute—

“(2) For this purpose the relevant period is twelve months beginning immediately after the date on which the application was terminated.”; and

(b) omit paragraph (11).

#### **Renewal notice**

9. In rule 39, for paragraph (3)(a) substitute—

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(3) Section 15(9) of the Patents Act 1977 was substituted by [S.I. 2004/2357](#); see rule 2(1) of the Patents Rules 2007 for the meaning of “section”.

(4) See section 15(9) of the Patents Act 1977 for the meaning of “earlier application”.

(5) See rule 2(1) of the Patents Rules 2007 for the meaning of “compliance date”.

- “(a) the last address specified by the proprietor on payment of a renewal fee (or to another address that has since been notified to him for that purpose by the proprietor); or”.

### **Correction or change of name or address; correction of address for service**

**10.** In rule 49—

- (a) for the heading substitute “Correction or change of name or address; correction of address for service”; and
- (b) for paragraph (6) substitute—
- “(6) For the purposes of this rule a request for a correction includes—
- (a) a correction made for the purposes of section 117(6); and
- (b) a change to any of the matters listed in paragraph (1)(a) or (b) in respect of an entry recorded in the register or made to any application or other document filed at the Patent Office.”

### **Filing of international applications at the Patent Office**

**11.** In rule 65—

- (a) in paragraph (1), for the words from “be filed” to the end, substitute “be filed in English or Welsh.”; and
- (b) omit paragraph (2).

### **International applications**

**12.** After rule 66 insert—

**“Amendment of international application before grant**

**66A.**—(1) This rule applies to an international application for a patent (UK)(7) which has begun the national phase of the application(8).

(2) The period within which an applicant may amend his application under section 19(1) is as follows.

(3) Where during the international phase of the application(9), the International Searching Authority(10) has sent to the applicant the International Search Report(11) relating to the invention, the period within which the applicant may amend his application is the period beginning with the date on which the national phase of the application begins and ending with the date on which the comptroller sends the applicant the first substantive examination report.

(4) Where during the international phase of the application, the International Searching Authority has not sent to the applicant the International Search Report relating to the

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(6) Section 117 of the Patents Act 1977 was amended by [S.I. 2004/2357](#).

(7) See section 130(1) of the Patents Act 1977 for the definition of “international application for a patent (UK)”; section 130(1) was amended by the Patents Act 2004, Schedule 1, paragraphs 1, 9(1) and (2)(a).

(8) See section 89A(3) of the Patents Act 1977 for the meaning of when “the national phase of the application begins” (section 89A was substituted by the Copyright, Designs and Patents Act 1988, Schedule 5, paragraph 25).

(9) See section 89A(2) of the Patents Act 1977 for the meaning of “the international phase of the application” (section 89A was substituted by the Copyright, Designs and Patents Act 1988, Schedule 5, paragraph 25).

(10) See rule 64 of the Patents Rules 2007 for the definition of “International Searching Authority”.

(11) See rule 64 of the Patents Rules 2007 for the definition of “International Search Report”.

invention, the period during which the applicant may amend his application is the first to commence of—

- (a) the period prescribed by rule 31(3); and
- (b) the period beginning with the date on which the International Searching Authority sends the International Search Report to the applicant and ending with the date on which the comptroller sends the applicant the first substantive examination report.”

### **Publication of notices**

13. For rule 75 substitute—

#### **“Publication of notices**

75.—(1) Subject to paragraph (2) and rule 105(5) the comptroller must advertise in the journal<sup>(12)</sup> any event to which it is possible to object under any of the provisions mentioned in Part 2 or 3 of Schedule 3.

(2) Where an amendment to the specification of a patent is proposed by the proprietor under section 75(1)<sup>(13)</sup> the comptroller may, if he thinks fit, advertise in the journal the proposed amendment.”.

### **Agents**

14. In rule 101(1)(b) omit “in duplicate”.

### **Requirements of documents contained in an application**

15.—(1) Schedule 2 is amended as follows.

(2) In the heading to Part 2 and to Part 3, after “Drawings” insert “and Photographs”.

(3) In Part 3—

- (a) in paragraphs 11, 18, 19 and 20 after “drawing” insert “or photograph”,
- (b) in paragraphs 12, 13 and 14 after “drawings” insert “ or photographs”,
- (c) omit paragraph 15 and substitute—

“15. Drawings must comprise black lines and may be shaded where the shading assists in representing the shape of a thing provided that it does not obscure other elements of the drawing.”; and

(d) after paragraph 20 insert—

“20A. Photographs must be black and white, clear and capable of direct reproduction.”.

(4) In Part 4, in paragraph 21 after “drawing” insert “or photograph”.

### **Period for furnishing an address for service**

16. In Schedule 4—

- (a) in Part 1, omit the entry in respect of rule 104(2); and

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<sup>(12)</sup> See section 130(1) of the Patents Act 1977 for the definition of “the journal” (there are amendments to section 130(1) which are not relevant to that term).

<sup>(13)</sup> Section 75(1) of the Patents Act 1977 was amended by the Patents Act 2004, Schedule 2, paragraphs 1 and 19.

- (b) in Parts 2 and 3, after each entry in respect of rule 68, insert the following entry—
- “rule 104(2) (period for furnishing an address for service), in relation to an application for a patent”.

### **Transitional Provision**

**17.**—(1) The amendment made by rule 3(b) does not apply to an application for a patent in respect of which the compliance period expired before 6th April 2017.

(2) In paragraph (1) “compliance period” has the same meaning as it has in rule 2(1) of the Patents Rules 2007.

### **Review**

**18.**—(1) The Secretary of State must from time to time—

- (a) carry out a review of these Rules,
- (b) set out the conclusions of the review in a report, and
- (c) publish the report.

(2) The report must in particular—

- (a) set out the objectives intended to be achieved by the regulatory system established by these Rules,
- (b) assess the extent to which those objectives are achieved, and
- (c) assess whether those objectives remain appropriate and, if so, the extent to which they could be achieved with a system that imposes less regulation.

(3) The first report under this rule must be published before the end of the period of five years beginning with the day on which rule 9 comes into force.

(4) Reports under this rule are afterwards to be published at intervals not exceeding five years.

*Neville-Rolfe*  
Minister of State for Energy and Intellectual  
Property  
Department for Business, Energy and Industrial  
Strategy

5th September 2016

## EXPLANATORY NOTE

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

These Rules amend the Patents Rules 2007 (SI 2007/3291).

Rule 3 amends rule 12 to permit photographs to be filed as part of an application for a patent. It also limits the use of “omnibus” claims (being claims which are drafted in terms of the invention “as described in” the description or drawings) to cases where the features of the invention cannot be clearly and concisely defined by other means.

Rules 4 and 5 amend rules 14 and 15 (which set out the requirements for the documents contained in an application for a patent/the abstract) to include references to photographs.

Rule 6 replaces rule 19 in relation to the deadline for filing a new application for a patent as mentioned in section 15(9) of the Patents Act 1977 (“the Act”) based on an earlier application (commonly known as a “divisional application”). New rule 19 retains the requirement that a divisional application may only be made before the earlier application has been granted, terminated or withdrawn (see section 15(9) of the Act and new rule 19(2)(a)). However, it removes the deadline for filing a divisional application based upon whether the earlier application has been found to meet the requirements for the grant of a patent under section 18 of the Act and provides a single deadline of three months before the compliance date of the earlier application (see rule 2(1) of the Patents Rules 2007 for the meaning of “compliance date”).

Rule 8 amends rule 32 to provide that the period for making a request to reinstate an application under section 20A of the Act is 12 months beginning immediately after the date on which the application was terminated.

Rule 9 amends rule 39 to provide that renewal notices shall be sent to the last address specified by the proprietor on payment of a renewal fee unless the proprietor has subsequently notified an address for this purpose.

Rule 10 amends rule 49 to clarify that a request for a correction in relation to a name or address in the register or any application or document may be made where there has been any change in those matters.

Rule 11 amends rule 65 to remove the requirement for international applications for patents to be filed at the Patent Office in triplicate.

Rule 12 inserts a new rule 66A which regulates the period during which an applicant may amend an international application for a patent (UK) filed under the Patent Co-operation Treaty<sup>(14)</sup> once it has begun the national phase of the application. The period varies depending upon whether and when the International Searching Authority (as defined in rule 64 of the Patents Rules 2007) sends to the applicant an International Search Report (as defined in rule 64 of the Patents Rules 2007) which the applicant has requested the International Searching Authority to conduct.

Rule 13 amends rule 75 to confer a discretion on the comptroller whether to advertise in the journal an amendment to the specification of a patent which is proposed by a proprietor under section 75 of the Act.

Rule 14 amends rule 101 to remove the requirement for the notification of the appointment of an agent on Patents Form 51 to be filed in duplicate.

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<sup>(14)</sup> The Patent Co-operation Treaty was made in Washington on 19th June 1970, amended on 28th September 1979 and modified on 3rd February 1984 and 3rd October 2001 (Treaty Series No. 78 (1978) Cmnd. 7340 as amended) and is available on the WIPO website.

Rule 15 amends Schedule 2 to apply to photographs the requirements in Parts 3 and 4 which apply to drawings. New paragraph 15 provides that drawings may be shaded in certain circumstances and new paragraph 20A provides that photographs must be black and white, clear and capable of direct reproduction.

Rule 16 amends Schedule 4 to enable the comptroller to extend the period of time permitted for furnishing an address for service in relation to an application for a patent.

Rule 17 is a transitional provision. The amendment made by rule 3(b) (which limits the use of omnibus claims) does not apply to a patent application whose compliance date (as defined in rule 2(1) of the Patents Rules 2007) is a date prior to 6th April 2017.

Rule 18 requires the Secretary of State to review the operation and effect of these Rules and publish a report by 6th April 2022 and within every five years after that.

A full impact assessment of the effect that this instrument will have on the costs of business, the voluntary sector and the public sector is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport, South Wales, NP10 8QQ and is available with the Explanatory Memorandum alongside this instrument on the Legislation UK website at [www.legislation.gov.uk](http://www.legislation.gov.uk).