
STATUTORY INSTRUMENTS

2007 No. 3291

The Patents Rules 2007

PART 2

APPLICATIONS FOR PATENTS

Search and substantive examination

Search under section 17

27.—(1) A request under section 17(1)(c)(i) for a search must be made on Patents Form 9A.

(2) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner's report made under section 17.

(3) Where an examiner conducts a search in relation to the first only of two or more inventions, in accordance with section 17(6), he must report this fact to the comptroller, and the comptroller must notify the applicant accordingly.

(4) The applicant must pay any search fee in relation to those inventions (other than the first) on or before the relevant date.

(5) The relevant date is the first day of the three month period ending with the compliance date of the application.

(6) The fee for a supplementary search under section 17(8), or a search under section 17(6), must be accompanied by Patents Form 9A.

Request for substantive examination under section 18

28.—(1) A request under section 18 for a substantive examination of an application must be made on Patents Form 10.

(2) Subject to paragraphs (3) and (4) and rules 60 and 68(4), the period prescribed for the purposes of section 18(1) is six months beginning with the date the application was published.

(3) Where the comptroller has given directions under section 22(1) or (2) in relation to information contained in the application, the period prescribed for the purposes of section 18(1) is the relevant period.

(4) Paragraphs (2) and (3) do not apply to a new application.

(5) In relation to a new application, the period prescribed for the purposes of section 18(1) is—

(a) two months beginning with its initiation date; or

(b) if it expires later, the relevant period,

and the reference in paragraph (7) to the date of filing of the application is a reference to the date of filing of the earlier application.

(6) But where the new application is filed less than six months before the compliance date, the period prescribed for the purposes of section 18(1) is the period ending with its initiation date.

- (7) For the purposes of this rule the relevant period is two years beginning with—
 - (a) where there is no declared priority date, the date of filing of the application; or
 - (b) where there is a declared priority date, that date.

Substantive examination reports

29.—(1) Whenever the examiner reports to the comptroller under either section 18(3) or (4) on whether the application complies with the requirements of the Act and these Rules, the comptroller must send a copy of that report to the applicant.

(2) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner’s report.

(3) For the purposes of rules 30 and 31—

- (a) “first substantive examination report” means the first report sent to the applicant under paragraph (1); and
- (b) “first observations report” means a report sent to the applicant under paragraph (1) which meets the condition in paragraph (4).

(4) The condition is that—

- (a) a person has made observations to the comptroller under section 21(1) on the question whether the invention is a patentable invention;
- (b) the examiner has reported to the comptroller, as a consequence of those observations, that the invention does not comply with the requirements of the Act or these Rules; and
- (c) the comptroller has not previously sent to the applicant a report, relating to those observations, under paragraph (1).

Period for putting application in order

30.—(1) The period prescribed for the purposes of sections 18(4) and 20(1) (failure of application) is the compliance period.

(2) For the purposes of paragraph (1), subject to paragraphs (3) and (4), the compliance period is—

- (a) four years and six months beginning with—
 - (i) where there is no declared priority date, the date of filing of the application, or
 - (ii) where there is a declared priority date, that date; or
- (b) if it expires later, the period of twelve months beginning with the date on which the first substantive examination report is sent to the applicant.

(3) Subject to paragraph (4), where a new application is filed the compliance period is—

- (a) where it is filed under section 8(3), 12(6) or 37(4)—
 - (i) the period specified in paragraph (2) in relation to the earlier application, or
 - (ii) if it expires later, the period of eighteen months beginning with the initiation date; and
- (b) where it is filed as mentioned in section 15(9), the period specified in paragraph (2) in relation to the earlier application.

(4) Where the first observations report is sent to the applicant during the last three months of the period specified in paragraphs (2) or (3), the compliance period is three months beginning with the date on which that report is sent.

Amendment of application before grant

31.—(1) A request to amend an application for a patent under section 19(1) must be made in writing.

(2) The conditions prescribed under section 19(1) are as follows.

(3) The applicant may amend his application only within the period beginning with the date on which the applicant is informed of the examiner's report under section 17(5) and ending with the date on which the comptroller sends him the first substantive examination report.

(4) But after the end of this period, the applicant may—

(a) where the first substantive examination report states that his application complies with the requirements of the Act and these Rules, amend his application once before the end of the period of two months beginning with the date on which that report was sent; or

(b) where the first substantive examination report states that his application does not comply with the requirements of the Act and these Rules—

(i) amend his application once at the same time as he makes his first observations on, or amendments to, his application under section 18(3), and

(ii) if the first substantive examination report is sent before preparations for the application's publication have been completed by the Patent Office, amend his application prior to any further amendment he may make under sub-paragraph (b)(i).

(5) However, the conditions in paragraphs (3) and (4) do not apply—

(a) where the comptroller consents to the amendment; or

(b) to an amendment of a request for the grant of a patent.

(6) Where the comptroller's consent is required, or the applicant wishes to amend the request for the grant of a patent, the applicant must include the reasons for the amendment.

Reinstatement of applications under section 20A

32.—(1) A request under section 20A for the reinstatement of an application must be made before the end of the relevant period.

(2) For this purpose the relevant period is—

(a) two months beginning with the date on which the removal of the cause of non-compliance occurred; or

(b) if it expires earlier, the period of twelve months beginning with the date on which the application was terminated.

(3) The request must be made on Patents Form 14.

(4) Where the comptroller is required to publish a notice under section 20A(5), it must be published in the journal.

(5) The applicant must file evidence in support of that request.

(6) Where that evidence does not accompany the request, the comptroller must specify a period within which the evidence must be filed.

(7) Where, on consideration of that evidence, the comptroller is not satisfied that a case for an order under section 20A has been made out, he must notify the applicant accordingly.

(8) The applicant may, before the end of the period of one month beginning with the date of that notification, request to be heard by the comptroller.

(9) Where the applicant requests a hearing, the comptroller must give him an opportunity to be heard, after which the comptroller shall determine whether the request under section 20A shall be allowed or refused.

(10) Where the comptroller reinstates the application after a notice was published under paragraph (4), he must advertise in the journal the fact that he has reinstated the application.

(11) In determining the date on which the removal of the cause of non-compliance occurred, the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.

Observations by third parties on patentability

33.—(1) The comptroller must send to the applicant a copy of any observations on patentability he receives under section 21.

(2) But paragraph (1) does not apply to any observation which, in the opinion of the comptroller, would—

(a) disparage any person in a way likely to damage such person; or

(b) be generally expected to encourage offensive, immoral or anti-social behaviour.

(3) The comptroller may, if he thinks fit, send to the applicant a copy of any document referred to in the observations.

(4) The comptroller must send to an examiner any observations on patentability.

(5) But paragraph (4) does not apply where the observations are received after the examiner has reported under section 18(4) that an application complies with the requirements of the Act and these Rules.