

2010 No. 33

INTELLECTUAL PROPERTY

**The Patents and Patents and Trade Marks (Fees) (Amendment)
Rules 2010**

<i>Made</i>	- - - -	<i>7th January 2010</i>
<i>Laid before Parliament</i>		<i>12th January 2010</i>
<i>Coming into force</i>	- -	<i>6th April 2010</i>

The Secretary of State makes the following Rules in exercise of the powers conferred by section 123 of the Patents Act 1977(a) and sections 78 and 79 of the Trade Marks Act 1994(b).

In accordance with articles 5 and 7 of the Department of Trade and Industry (Fees) Order 1988(c), the Secretary of State has taken into account the functions and matters specified in Parts 2 and 4 of Schedule 1 and Parts 1 and 2 of Schedule 2 to that Order.

In accordance with paragraph 24 of Schedule 7 to the Tribunals, Courts and Enforcement Act 2007(d), the Secretary of State has consulted the Administrative Justice and Tribunals Council before making these Rules.

Citation and commencement

1. These Rules may be cited as the Patents and Patents and Trade Marks (Fees) (Amendment) Rules 2010 and come into force on 6th April 2010.

Amendments to the Patents Rules 2007

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

3. In rule 80(1)(a) (Evidence rounds and the hearing) omit “and” and after paragraph (a) insert—
“(aa) specify the period within which the claimant must file Patents Form 4; and”.

4. After rule 80(1) insert—

“(1A) If the claimant wishes to continue the proceedings following receipt of the counter-statement, the claimant must file Patents Form 4.”.

5. After rule 81 (Alteration of time limits) insert—

(a) 1977 c.37. Section 123 was amended by the Copyright, Designs and Patents Act 1988 (c. 48), Schedule 5, paragraph 29, and the Patents Act 2004 (c.16), Schedule 2, paragraph 26.

(b) 1994 c.26.

(c) S.I. 1988/93, amended by S.I. 1990/1473, both of which were made under section 102 of the Finance (No.2) Act 1987 (c.51); there are other amending instruments but none is relevant.

(d) 2007 c.15.

(e) S.I. 2007/3291, to which there are amendments not relevant to these Rules.

“Failure to file Patents Form 4

81A. If the claimant fails to file Patents Form 4 within the period specified by the comptroller the claimant shall be deemed to have filed a request to withdraw from the proceedings.”.

Amendments to the Patents (Fees) Rules 2007

6. The Patents (Fees) Rules 2007(a) are amended as follows.

7. In rule 3A (Electronic filing fee reduction) for “£10” substitute “£20”.

8. In rule 7(3) (Other fees) for “£55” substitute “£75”.

9. After rule 7(3) insert—

“(3A) The fee to request restoration of the right of priority of an international application for a patent filed at the Patent Office in accordance with the Patent Co-operation Treaty(b) is £150.”.

10.—(1) Schedule 1 (Use of Forms) is amended as follows.

(2) In the entry “Patents Form Number 9A” for “80” substitute “120” and for “100” in both places where it appears substitute “150”.

(3) In the entry “Patents Form Number 10” for “70” substitute “100”.

(4) After the entry “Patents Form Number 3” insert the following—

“4 On continuing proceedings 350”.
following receipt of a counter-statement in accordance with rule 80(1A) of the 2007 Rules

(5) In the third column of the entry “Patents Form Number 21” insert “50”.

11. In Schedule 2 (Renewal Fees) for Part 1 substitute the following—

**“PART 1
RENEWAL FEE**

<i>Anniversary of date of filing</i>	<i>Amount (£)</i>
4th	70
5th	90
6th	110
7th	130
8th	150
9th	170
10th	190
11th	210
12th	250
13th	290
14th	350
15th	410
16th	460

(a) S.I. 2007/3292, amended by S.I. 2009/2089.

(b) Cmnd 7340 Treaty series 78/1978.

17th	510
18th	560
19th	600”

Amendments to the Trade Marks (Fees) Rules 2008

12. The Schedule to the Trade Marks (Fees) Rules 2008(a) is amended as follows.

13. After the entry “TM16 – Request to enter details of an assignment (rule 49(1)(a)) – 50” insert the following—

“ TM24	Request to enter details relating to the grant, amendment or termination of any security interest or the making by personal representatives of an assent or to an order of a court or other competent authority (rule 49(1)(d) and (e))	50”
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14. After the entry “TM36 – Request to amend regulations governing the use of a certification or collective mark (rule 30(1)) – 100” insert the following—

“ TM50	Request to enter details relating to a grant of a licence (rule 49(1)(b))	50
TM51	Request to enter details relating to an amendment to, or termination of a licence (rule 49(1)(c))	50”

Transitional Provisions

15. Rules 3, 4 and 5 shall not apply to proceedings which started before 6th April 2010.

16. Rule 11 shall not apply to a renewal fee paid on or after 6th April 2010 in respect of a renewal date which falls prior to 6th April 2010 if it is paid by the end of the period specified in section 25(4) of the Patents Act 1977.

7th January 2010

David Lammy
Minister of State for Higher Education and Intellectual Property
Department for Business, Innovation and Skills

(a) S.I. 2008/1958, amended by S.I. 2009/2089.

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the Patents Rules 2007 (SI 2007/3291) (“the 2007 Rules”), the Patents (Fees) Rules 2007 (SI 2007/3292) (“The Patents (Fees) Rules”) and the Trade Marks (Fees) Rules 2008 (SI 2008/1958) (“the Trade Marks (Fees) Rules”).

The amendments to the 2007 Rules and the Patents (Fees) Rules contained in rules 3 to 11 make the following changes of substance—

(1) A claimant must file Patents Form 4 together with a fee of £350 in order to continue the proceedings following receipt of a counter-statement. If the claimant fails to file the form within the period specified by the comptroller the claimant shall be deemed to have filed a request to withdraw from the proceedings.

(2) The reduction in the search fee and the examination fee where the relevant form (Patents Form 9A or Patents Form 10) is filed electronically is increased from £10 to £20.

(3) The fee to transmit an international application to the International Bureau and the International Searching Authority is increased from £55 to £75 and a new fee of £150 is introduced to request restoration of the right of priority of an international application for a patent filed at the Patent Office in accordance with the Patent Co-operation Treaty (Cmnd 7340 Treaty series 78/1978).

(4) The search fee associated with Patents Form 9A filed under rule 27 of the 2007 Rules is increased from £80 to £120 in respect of an international application for a patent (UK) which has already been the subject of a search by the International Searching Authority and from £100 to £150 in respect of any other application (including a request for a further or supplementary search under section 17(6) and (8) of the Patents Act 1977).

(5) The examination fee associated with Patents Form 10 filed under rule 28 of the 2007 Rules is increased from £70 to £100.

(6) A fee of £50 is introduced to register transactions under rule 47 of the 2007 Rules.

(7) The fees to renew a patent associated with Patents Form 12 filed under rules 36 to 38 of the 2007 Rules are increased in accordance with the amendments to Part 1 of Schedule 2 to the Patents (Fees) Rules as set out in rule 11.

The Trade Marks (Fees) Rules are amended by rules 13 and 14 which introduce a fee of £50 where Trade Mark Forms TM24, TM50 or TM51 are filed requesting to enter details in the Register of Trade Marks in accordance with rule 49 of the Trade Marks Rules 2008 (SI 2008/1797).

Rules 15 and 16 contain transitional provisions.

A full impact assessment of the effect that this instrument will have on the costs of business and the voluntary sector is available from the Intellectual Property Office, Room 3Y60, Concept House, Cardiff Road, Newport, NP10 8QQ and is annexed to the Explanatory Memorandum which is available alongside the instrument on the OPSI website.

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