STATUTORY INSTRUMENTS

2016 No. 892

PATENTS

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

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

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

(**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—

(**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

(**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".