

**2004 No. 2357**

**REGULATORY REFORM**

**PATENTS**

**The Regulatory Reform (Patents) Order 2004**

*Made* - - - - *22nd September 2004*

*Coming into force*  
*in accordance with article 1(2)* *1st January 2005*

Whereas:

- (a) the Secretary of State for Trade and Industry (“the Secretary of State”) has consulted<sup>(a)</sup>—
  - (i) such organisations as appear to her to be representative of interests substantially affected by her proposals for this Order,
  - (ii) the Comptroller-General of Patents, Designs and Trade Marks,
  - (iii) the Law Commission,
  - (iv) the National Assembly for Wales, and
  - (v) such other persons as she considers appropriate;
- (b) following the consultation mentioned in recital (a) the Secretary of State considered it appropriate to proceed with the making of this Order;
- (c) a document containing the Secretary of State's proposals was laid before Parliament as required by section 6 of the Regulatory Reform Act 2001<sup>(b)</sup> and the period for Parliamentary consideration under section 8 of that Act has expired;
- (d) the Secretary of State has had regard to the representations made during this period, in particular to the Sixth Report of Session 2003-2004 of the Delegated Powers and Regulatory Reform Committee of the House of Lords<sup>(c)</sup> and the Second Report of Session 2003-2004 of the Regulatory Reform Committee of the House of Commons<sup>(d)</sup>;
- (e) a draft of this Order was laid before Parliament with a statement giving details of those representations and the changes to the Secretary of State's proposals in the light of them;
- (f) the draft was approved by resolution of each House of Parliament;
- (g) the Secretary of State is of the opinion that this Order does not remove any necessary protection or prevent any person from continuing to exercise any right or freedom which he might reasonably expect to continue to exercise; and

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<sup>(a)</sup> A consultation document on the deregulation of patents legislation entitled “Towards the Simplification and Rationalisation of Patents Formalities” was published by the Patent Office on 24<sup>th</sup> February 2003. Copies may be obtained from the Patents Directorate, The Patent Office, Concept House, Cardiff Road, Newport, NP10 8QQ.

<sup>(b)</sup> 2001 c.6.

<sup>(c)</sup> Sixth Report published on 30<sup>th</sup> January 2004, HL32, ISBN 0104849169.

<sup>(d)</sup> Second Report published on 17<sup>th</sup> February 2004, HC337, ISBN 0215015436.

- (h) this Order creates burdens affecting persons in the carrying on of certain activities, and the Secretary of State is of the opinion that—
  - (i) the provisions of this Order, taken as a whole, strike a fair balance between the public interest and the interests of the persons affected by the burdens being created, and
  - (ii) the extent to which this Order removes or reduces one or more burdens, or has other beneficial effects for persons affected by the burdens imposed by the existing law, makes it desirable for this Order to be made;

Now therefore the Secretary of State, in exercise of the powers conferred by section 1 of the Regulatory Reform Act 2001, hereby makes the following Order:—

**Citation, commencement and extent**

- 1.—(1) This Order may be cited as the Regulatory Reform (Patents) Order 2004.
- (2) This Order shall come into force on the first day of the fourth month following the month in which it is made.
- (3) This Order extends to the United Kingdom and the Isle of Man.

**Amendment of the Patents Act 1977**

- 2. The Patents Act 1977(a) shall be amended as follows.
- 3. In section 5(2) of that Act (priority date) for the words from “each having” to “date of filing the application in suit” there shall be substituted “the application in suit has a date of filing during the period allowed under subsection (2A)(a) or (b) below” and after that subsection there shall be inserted—
  - “(2A) The periods are—
    - (a) the period of twelve months immediately following the date of filing of the earlier specified relevant application, or if there is more than one, of the earliest of them; and
    - (b) where the comptroller has given permission under subsection (2B) below for a late declaration to be made under subsection (2) above, the period commencing immediately after the end of the period allowed under paragraph (a) above and ending at the end of the prescribed period.
  - (2B) The applicant may make a request to the comptroller for permission to make a late declaration under subsection (2) above.
  - (2C) The comptroller shall grant a request made under subsection (2B) above if, and only if—
    - (a) the request complies with the relevant requirements of rules; and
    - (b) the comptroller is satisfied that the applicant’s failure to file the application in suit within the period allowed under subsection (2A)(a) above was unintentional.”.

- 4.—(1) Section 14 of that Act (making of application) shall be amended as follows.
- (2) Subsection (1)(b) and the word “and” immediately preceding it shall cease to have effect.
- (3) After subsection (1) there shall be inserted—
  - “(1A) Where an application for a patent is made, the fee prescribed for the purposes of this subsection (“the application fee”) shall be paid not later than the end of the period prescribed for the purposes of section 15(10)(c) below.”.
- (4) After subsection (9) there shall be inserted—

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(a) 1977 c.37.

“(10) Subsection (9) above does not affect the power of the comptroller under section 117(1) below to correct an error or mistake in a withdrawal of an application for a patent.”.

5. For section 15 of that Act (date of filing application) there shall be substituted—

**“15 Date of filing application**

(1) Subject to the following provisions of this Act, the date of filing an application for a patent shall be taken to be the earliest date on which documents filed at the Patent Office to initiate the application satisfy the following conditions—

- (a) the documents indicate that a patent is sought;
- (b) the documents identify the person applying for a patent or contain information sufficient to enable that person to be contacted by the Patent Office; and
- (c) the documents contain either—
  - (i) something which is or appears to be a description of the invention for which a patent is sought; or
  - (ii) a reference, complying with the relevant requirements of rules, to an earlier relevant application made by the applicant or a predecessor in title of his.

(2) It is immaterial for the purposes of subsection (1)(c)(i) above—

- (a) whether the thing is in, or is accompanied by a translation into, a language accepted by the Patent Office in accordance with rules;
- (b) whether the thing otherwise complies with the other provisions of this Act and with any relevant rules.

(3) Where documents filed at the Patent Office to initiate an application for a patent satisfy one or more of the conditions specified in subsection (1) above, but do not satisfy all those conditions, the comptroller shall as soon as practicable after the filing of those documents notify the applicant of what else must be filed in order for the application to have a date of filing.

(4) Where documents filed at the Patent Office to initiate an application for a patent satisfy all the conditions specified in subsection (1) above, the comptroller shall as soon as practicable after the filing of the last of those documents notify the applicant of—

- (a) the date of filing the application, and
- (b) the requirements that must be complied with, and the periods within which they are required by this Act or rules to be complied with, if the application is not to be treated as having been withdrawn.

(5) Subsection (6) below applies where—

- (a) an application has a date of filing by virtue of subsection (1) above;
- (b) within the prescribed period the applicant files at the Patent Office—
  - (i) a drawing, or
  - (ii) part of the description of the invention for which a patent is sought, and
- (c) that drawing or that part of the description was missing from the application at the date of filing.

(6) Unless the applicant withdraws the drawing or the part of the description filed under subsection (5)(b) above (“the missing part”) before the end of the prescribed period—

- (a) the missing part shall be treated as included in the application; and
- (b) the date of filing the application shall be the date on which the missing part is filed at the Patent Office.

(7) Subsection (6)(b) above does not apply if—

- (a) on or before the date which is the date of filing the application by virtue of subsection (1) above a declaration is made under section 5(2) above in or in connection with the application;

- (b) the applicant makes a request for subsection (6)(b) above not to apply; and
- (c) the request complies with the relevant requirements of rules and is made within the prescribed period.

(8) Subsections (6) and (7) above do not affect the power of the comptroller under section 117(1) below to correct an error or mistake.

(9) Where, after an application for a patent has been filed and before the patent is granted—

- (a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and
- (b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below),

the new application shall be treated as having, as its date of filing, the date of filing the earlier application.

(10) Where an application has a date of filing by virtue of this section, the application shall be treated as having been withdrawn if any of the following applies—

- (a) the applicant fails to file at the Patent Office, before the end of the prescribed period, one or more claims and the abstract;
- (b) where a reference to an earlier relevant application has been filed as mentioned in subsection (1)(c)(ii) above—
  - (i) the applicant fails to file at the Patent Office, before the end of the prescribed period, a description of the invention for which the patent is sought;
  - (ii) the applicant fails to file at the Patent Office, before the end of the prescribed period, a copy of the application referred to, complying with the relevant requirements of rules;
- (c) the applicant fails to pay the application fee before the end of the prescribed period;
- (d) the applicant fails, before the end of the prescribed period, to make a request for a search under section 17 below and pay the search fee.

(11) In this section “relevant application” has the meaning given by section 5(5) above.

### **15A Preliminary examination**

(1) The comptroller shall refer an application for a patent to an examiner for a preliminary examination if—

- (a) the application has a date of filing;
- (b) the application has not been withdrawn or treated as withdrawn; and
- (c) the application fee has been paid.

(2) On a preliminary examination of an application the examiner shall—

- (a) determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act; and
- (b) determine whether any requirements under section 13(2) or 15(10) above remain to be complied with.

(3) The examiner shall report to the comptroller his determinations under subsection (2) above.

(4) If on the preliminary examination of an application it is found that—

- (a) any drawing referred to in the application, or
- (b) part of the description of the invention for which the patent is sought,

is missing from the application, then the examiner shall include this finding in his report under subsection (3) above .

(5) Subsections (6) to (8) below apply if a report is made to the comptroller under subsection (3) above that not all the formal requirements have been complied with.

(6) The comptroller shall specify a period during which the applicant shall have the opportunity—

- (a) to make observations on the report, and
- (b) to amend the application so as to comply with those requirements (subject to section 76 below).

(7) The comptroller may refuse the application if the applicant fails to amend the application as mentioned in subsection (6)(b) above before the end of the period specified by the comptroller under that subsection.

(8) Subsection (7) above does not apply if—

- (a) the applicant makes observations as mentioned in subsection (6)(a) above before the end of the period specified by the comptroller under that subsection, and
- (b) as a result of the observations, the comptroller is satisfied that the formal requirements have been complied with.

(9) If a report is made to the comptroller under subsection (3) above—

- (a) that any requirement of section 13(2) or 15(10) above has not been complied with; or
- (b) that a drawing or part of the description of the invention has been found to be missing,

then the comptroller shall notify the applicant accordingly.”.

**6.**—(1) Section 17 of that Act (preliminary examination and search) shall be amended as follows.

(2) For the heading there shall be substituted “Search”.

(3) For subsection (1) there shall be substituted—

“(1) The comptroller shall refer an application for a patent to an examiner for a search if, and only if—

- (a) the comptroller has referred the application to an examiner for a preliminary examination under section 15A(1) above;
- (b) the application has not been withdrawn or treated as withdrawn;
- (c) before the end of the prescribed period—
  - (i) the applicant makes a request to the Patent Office in the prescribed form for a search; and
  - (ii) the fee prescribed for the search (“the search fee”) is paid;
- (d) the application includes—
  - (i) a description of the invention for which a patent is sought; and
  - (ii) one or more claims; and
- (e) the description and each of the claims comply with the requirements of rules as to language.”.

(4) Subsections (2) and (3) shall cease to have effect.

**7.**—(1) Section 18 of that Act (substantive examination and grant or refusal of patent) shall be amended as follows.

(2) In subsection (1) the words “preliminary examination and ” shall be omitted.

(3) In subsection (2) after the words “any examination” there shall be inserted “ carried out under section 15A above”.

(4) In subsection (4) for the words “section 17” there shall be substituted “section 15A”.

8. After section 20 of that Act there shall be inserted—

**“20A Reinstatement of applications**

(1) Subsection (2) below applies where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is—

- (a) set out in this Act or rules, or
- (b) specified by the comptroller.

(2) Subject to subsection (3) below, the comptroller shall reinstate the application if, and only if—

- (a) the applicant requests him to do so;
- (b) the request complies with the relevant requirements of rules; and
- (c) he is satisfied that the failure to comply referred to in subsection (1) above was unintentional.

(3) The comptroller shall not reinstate the application if—

- (a) an extension remains available under this Act or rules for the period referred to in subsection (1) above; or
- (b) the period referred to in subsection (1) above is set out or specified—
  - (i) in relation to any proceedings before the comptroller;
  - (ii) for the purposes of section 5(2A)(b) above; or
  - (iii) for the purposes of a request under this section or section 117B below.

(4) Where the application was made by two or more persons jointly, a request under subsection (2) above may, with the leave of the comptroller, be made by one or more of those persons without joining the others.

(5) If the application has been published under section 16 above, then the comptroller shall publish notice of a request under subsection (2) above in the prescribed manner.

(6) The reinstatement of an application under this section shall be by order.

(7) If an application is reinstated under this section the applicant shall comply with the requirement referred to in subsection (1) above within the further period specified by the comptroller in the order reinstating the application.

(8) The further period specified under subsection (7) above shall not be less than two months.

(9) If the applicant fails to comply with subsection (7) above the application shall be treated as having been withdrawn on the expiry of the period specified under that subsection.

**20B Effect of reinstatement under section 20A**

(1) The effect of reinstatement under section 20A of an application for a patent is as follows.

(2) Anything done under or in relation to the application during the period between termination and reinstatement shall be treated as valid.

(3) If the application has been published under section 16 above before its termination anything done during that period which would have constituted an infringement of the rights conferred by publication of the application if the termination had not occurred shall be treated as an infringement of those rights—

- (a) if done at a time when it was possible for the period referred to in section 20A(1) above to be extended, or
- (b) if it was a continuation or repetition of an earlier act infringing those rights.

(4) If the application has been published under section 16 above before its termination and, after the termination and before publication of notice of the request for its reinstatement, a person—

(a) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place, or

(b) made in good faith effective and serious preparations to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the reinstatement of the application and the grant of the patent; but this right does not extend to granting a licence to another person to do the act.

(5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (4) above may—

(a) authorise the doing of that act by any partners of his for the time being in that business, and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(6) Where a product is disposed of to another in exercise of a right conferred by subsection (4) or (5) above, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant.

(7) In this section “termination”, in relation to an application, means—

(a) the refusal of the application, or

(b) the application being treated as having been refused or withdrawn.”.

**9.** In section 28 of that Act (restoration of lapsed patents) for subsection (3) there shall be substituted—

“(3) If the comptroller is satisfied that the failure of the proprietor of the patent—

(a) to pay the renewal fee within the prescribed period; or

(b) to pay that fee and any prescribed additional fee within the period of six months immediately following the end of that period,

was unintentional, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.”.

**10.—**(1) Section 30 of that Act (nature of, and transactions in, patents and applications for patents) shall be amended as follows.

(2) In subsection (6)—

(a) for the words “the parties to the transaction” there shall be substituted “the assignor or mortgagor”;

(b) the words “ or in the case of a body corporate” to the end of the subsection shall be omitted.

(3) After subsection (6) there shall be inserted—

“(6A) If a transaction mentioned in subsection (6) above is by a body corporate, references in that subsection to such a transaction being signed by or on behalf of the assignor or mortgagor shall be taken to include references to its being under the seal of the body corporate.”.

**11.** In section 60(6)(b) of that Act (meaning of infringement)—

(a) after the words “virtue of” there shall be inserted “section 20B(4) or (5) above or”;

(b) after the words “section 64 below” there shall be inserted “ or section 117A(4) or (5) below”.

12. In section 72(1)(d) of that Act (power to revoke patents on application) for the words “section 15(4)” there shall be substituted “section 15(9)”.

13.—(1) Section 76 of that Act (amendments of applications and patents not to include added matter) shall be amended as follows.

(2) In subsection (1) for the words “section 15(4)” there shall be substituted “section 15(9)”.

(3) After subsection (1) there shall be inserted—

“(1A) Where, in relation to an application for a patent—

(a) a reference to an earlier relevant application has been filed as mentioned in section 15(1)(c)(ii) above; and

(b) the description filed under section 15(10)(b)(i) above discloses additional matter, that is, matter extending beyond that disclosed in the earlier relevant application,

the application shall not be allowed to proceed unless it is amended so as to exclude the additional matter.”.

(4) In subsection (2) for the words “section 17(3)” there shall be substituted “section 15A(6)”.

(5) After subsection (3) there shall be inserted—

“(4) In subsection (1A) above “relevant application” has the meaning given by section 5(5) above.”.

14. In section 78(3)(b) of that Act (effect of filing an application for a European patent (UK)) for the words “specified in section 5(2)” there shall be substituted “allowed under section 5(2A)(a)”.

15.—(1) Section 81 of that Act (conversion of European patent applications) shall be amended as follows.

(2) In subsection (2)(c) for the words “filing fee” there shall be substituted “application fee”.

(3) In subsection (3)(d) after the words “required by sections” there shall be inserted “15A, ”.

16.—(1) Section 89B of that Act (adaptation of provisions in relation to international application) shall be amended as follows.

(2) In subsection (1)(b) for the words “specified in section 5(2)” there shall be substituted “allowed under section 5(2A)(a) above”.

(3) In subsection (5) for the words “under section” there shall be substituted “under sections 15A, ”.

17. In section 117 of that Act (correction of errors in patents and applications) after subsection (2) there shall be inserted—

“(3) Where the comptroller is requested to correct an error or mistake in a withdrawal of an application for a patent, and—

(a) the application was published under section 16 above; and

(b) details of the withdrawal were published by the comptroller;

the comptroller shall publish notice of such a request in the prescribed manner.

(4) Where the comptroller publishes a notice under subsection (3) above, the comptroller may only correct an error or mistake under subsection (1) above by order.”.

18. After section 117 of that Act there shall be inserted—

**“Section 117A Effect of resuscitating a withdrawn application under section 117**

(1) Where—

(a) the comptroller is requested to correct an error or mistake in a withdrawal of an application for a patent; and

(b) an application has been resuscitated in accordance with that request,

the effect of that resuscitation is as follows.

(2) Anything done under or in relation to the application during the period between the application being withdrawn and its resuscitation shall be treated as valid.

(3) If the comptroller has published notice of the request as mentioned in section 117(3) above, anything done during that period which would have constituted an infringement of the rights conferred by publication of the application if the application had not been withdrawn shall be treated as an infringement of those rights if it was a continuation or repetition of an earlier act infringing those rights.

(4) If the comptroller has published notice of the request as mentioned in section 117(3) above and, after the withdrawal of the application and before publication of the notice, a person—

(a) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the withdrawal had not taken place, or

(b) made in good faith effective and serious preparations to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the resuscitation of the application and the grant of the patent; but this right does not extend to granting a licence to another person to do the act.

(5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (4) above may—

(a) authorise the doing of that act by any partners of his for the time being in that business, and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(6) Where a product is disposed of to another in exercise of a right conferred by subsection (4) or (5) above, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant.

### **117B Extension of time limits specified by comptroller**

(1) Subsection (2) below applies in relation to a period if it is specified by the comptroller in connection with an application for a patent, or a patent.

(2) Subject to subsections (4) and (5) below, the comptroller shall extend a period to which this subsection applies if—

(a) the applicant or the proprietor of the patent requests him to do so; and

(b) the request complies with the relevant requirements of rules.

(3) An extension of a period under subsection (2) above expires—

(a) at the end of the period prescribed for the purposes of this subsection, or

(b) if sooner, at the end of the period prescribed for the purposes of section 20 above.

(4) If a period has already been extended under subsection (2) above—

(a) that subsection does not apply in relation to it again;

(b) the comptroller may further extend the period subject to such conditions as he thinks fit.

(5) Subsection (2) above does not apply to a period specified in relation to proceedings before the comptroller.”.

**19.** In section 130(1) of that Act (interpretation) the definition of “filing fee” shall be omitted and, at the appropriate place, there shall be inserted—

““application fee” means the fee prescribed for the purposes of section 14(1A) above;”.

## Transitional provisions

**20.**—(1) This article applies to an application for a patent where—

- (a) it was initiated by documents containing the information mentioned in any of paragraphs (a) to (c) of section 15(1) of the Patents Act 1977 (as that section had effect immediately before the coming into force of this Order) being filed at the Patent Office;
- (b) those documents were filed before the coming into force of this Order.

(2) Where this article applies to an application—

- (a) the following provisions have effect in relation to it in the form they had immediately before the coming into force of this Order— sections 5, 14(1)(b), 15, 17, 18, 72, 76, 78 and 130(1) of the Patents Act 1977; and
- (b) the following provisions, which are inserted by this Order, have no effect— sections 14(1A) and 15A of that Act.

**21.**—(1) This article applies to an application for a patent where—

- (a) it is treated as an application for a patent under the Patents Act 1977 by reason of a direction given under section 81(1) of that Act;
- (b) that direction was given before the coming into force of this Order.

(2) Where this article applies to an application—

- (a) the following provisions have effect in relation to it in the form they had immediately before the coming into force of this Order— sections 5, 14(1)(b), 15, 17, 18, 72, 76, 78, 81 and 130(1); and
- (b) the following provisions, which are inserted by this Order, have no effect— sections 14(1A) and 15A of that Act.

**22.**—(1) This article applies to an international application for a patent (UK) which began the national phase before the coming into force of this Order.

(2) Where this article applies to an application—

- (a) the following provisions have effect in relation to it in the form they had immediately before the coming into force of this Order— sections 15, 17, 18 and 89B of the Patents Act 1977; and
- (b) the following provision, which is inserted by this Order, has no effect— section 15A of that Act.

(3) For the purposes of paragraph (1) the national phase shall be treated as beginning at the same time as it does under section 89A(3) of the Patents Act 1977.

(4) In this article—

“international application for a patent” means an application made under the Patent Co-operation Treaty;

“Patent Co-operation Treaty” has the same meaning as in the Patents Act 1977.

**23.** Regulation 9 shall not apply in respect of any patent which ceased to have effect, by reason of section 25(3) of the Patents Act 1977, before the coming into force of this Order.

22nd September 2004

*Sainsbury of Turville,*  
Parliamentary Under Secretary of State for Science and Innovation,  
Department of Trade and Industry

## EXPLANATORY NOTE

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

This Order amends the Patents Act 1977 (c.37) (“the Act”) to enable it to be administered in conformity with the Patent Law Treaty (which was adopted at Geneva on 1<sup>st</sup> June 2000).

Article 3 amends section 5 of the Act so that declarations can, when certain conditions are met, be made in respect of an application filed more than twelve months after the date of filing of the earlier specified relevant application, or if there is more than one, of the earliest of them.

Article 4 amends section 14 of the Act and removes the requirement to pay a filing fee, but replaces it with a requirement to pay an application fee. It also makes it clear that section 117 applies to correction of errors in withdrawals of applications.

Article 5 substitutes a new section 15 and inserts a new section 15A into the Act. The new section 15 includes a number of changes, the most significant of these are more relaxed conditions for obtaining a date of filing, permitting missing parts of the description and drawings to be filed late and removing the need to request a preliminary examination.

The new section 15A sets out the requirements of preliminary examination, which unlike its predecessor under section 17, will include further duties on the examiner to determine whether the requirements under section 13(2) and the new section 15(10) are met. Further if the examiner finds that a drawing or part of the description is missing from the application this will be included in his report. After the examination, the examiner will have to make a report to the Comptroller, who in turn must give the applicant an opportunity to rectify any deficiencies.

Article 6 amends section 17 of the Act. In particular, a new subsection (1) is inserted and subsections (2) and (3) are repealed. These amendments are made in consequence of the requirements of preliminary examination being moved to the new section 15A.

Article 7 makes consequential amendments to section 18 of the Act.

Article 8 inserts a new section 20A and 20B into the Act. These new sections allow an application to be re-instated where it has been refused or treated as refused or withdrawn as a direct consequence of the applicant failing to comply with a requirement of the Act or any rules within the applicable time limit. The new section 20B provides similar protection to those persons affected by a reinstatement under section 20A as is presently provided by section 28A in the case of a restoration of a lapsed patent under section 28.

Article 9 amends section 28 of the Act. This amendment will mean that an applicant will only have to show that their failure to pay the renewal fee on time was unintentional, instead of having to prove that they exercised reasonable care to see that the renewal fee was paid on time.

Article 10 amends section 30 of the Act so that in future only assignors or mortgagors will need to sign relevant transactions, such as assignments and mortgages of patents.

Article 11 amends section 60 of the Act. This amendment is part of the granting of third party rights by sections 20B and 117A of the Act (inserted respectively by article 8 and 22 of this Order).

Article 12 makes a consequential amendment to section 72 of the Act.

Article 13 amends section 76 of the Act, so that where a reference to an earlier application is filed in place of something that appears to be a description of an invention under section 15(1) (as inserted by this Order), the description that is filed under section 15(10) must not include new matter that is not contained in the referred to application. There are also some consequential changes made to rest of section 76.

Articles 14 to 16 make consequential amendments to sections 78, 81 and 89B of the Act.

Articles 17 and 18 amend section 117 of the Act and insert new sections 117A and 117B into the Act. These changes will allow the comptroller to correct the mistaken withdrawal of an application. Similar protection is provided under section 117A as that provided under the new section 20B.

The new section 117B will enable the comptroller to extend certain time limits he has previously specified.

Article 19 makes a consequential amendment to section 130.

Articles 20 to 23 provides transitional provisions, which detail how any pending application will be affected by the changes to the Act.

A Regulatory Impact Assessment together with a more detailed explanation of the changes made by this Order, in particular the impact of the changes have on certain burdens, on any necessary protection and on the maintenance of rights and freedoms, is available either from the Patent Office website ([www.patent.gov.uk](http://www.patent.gov.uk)) or by contacting the Patents Directorate, The Patent Office, Concept House, Cardiff Road, Newport, NP10 8QQ.

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