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STATUTORY INSTRUMENTS

2014 No. 578

PATENTS

The Patents (Amendment) Rules 2014

<i>Made</i>	- - - -	<i>8th March 2014</i>
<i>Laid before Parliament</i>		<i>12th March 2014</i>
<i>Coming into force</i>	- -	<i>6th April 2014</i>

The Secretary of State makes the following Rules in exercise of the powers conferred by section 123 of the Patents Act 1977(a).

Citation and commencement

1. These Rules may be cited as the Patents (Amendment) Rules 2014 and shall come into force on 6th April 2014.

Substitution of rule 19 of the Patents Rules 2007

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

(2) For rule 19 substitute—

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

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

(2) A new application may not be filed if the earlier application(d) has been terminated or withdrawn.

(3) Where there has not been a section 18(4)(e) notification, a new application may be filed before the end of the period ending three months before the compliance date of the earlier application.

(4) Where there has been a section 18(4) notification, a new application may be filed if—

- (a) the earlier application has not, prior to the date of the section 18(4) notification, been the subject of an examiner’s report which states that the earlier application does not comply with the Act and these Rules; and

(a) 1977 c.37; there are amendments to section 123 which are not relevant to these Rules.
(b) S.I. 2007/3291, amended by S.I. 2011/2052; there are other amending instruments but none is relevant.
(c) Section 15(9) of the Patents Act 1977 (c.37) was substituted by S.I. 2004/2357.
(d) See section 15(9) of the Patents Act 1977 (c.37) for the meaning of “earlier application”.
(e) Section 18(4) of the Patents Act 1977 (c.37) was amended by S.I. 2004/2357.

(b) the period of two months beginning immediately after the date of the section 18(4) notification has not expired.

(5) Where an earlier application has been the subject of more than one section 18(4) notification, a reference in paragraph (4) to a section 18(4) notification is a reference to the first of those section 18(4) notifications.

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

(7) In this rule “section 18(4) notification” means notification under section 18(4) that the earlier application complies with the Act and these Rules.”

Younger of Leckie

Parliamentary Under Secretary of State for Business, Innovation and Skills

8th March 2014

Department for Business, Innovation and Skills

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules replace rule 19 of the Patents Rules 2007 (S.I. 2007/3291, amended by S.I. 2011/2052; there are other amending instruments but none is relevant) (the “Patents Rules”).

New rule 19 of the Patents Rules governs procedure for filing a new application for a patent out of material contained in an earlier application such that the new application is treated as having the same date of filing as the earlier application under section 15(9) of the Patents Act 1977 (c.37; section 15 was substituted by S.I. 2004/2357). Such new applications are commonly known as “divisional applications”.

In all cases, a divisional application may only be made before the earlier application has been granted, terminated or withdrawn (see section 15(9) of the Patents Act 1977 and new rule 19(2) of the Patents Rules). The deadline for filing a divisional application is further influenced by whether the earlier application has been found to meet the requirements for the grant of a patent under the Patents Act 1977.

Where an earlier application has not been found to meet the requirements for the grant of a patent, the deadline for filing a divisional application is the date three months before the compliance date of the earlier application (see rule 2(1) (for the meaning of “compliance date”) and new rule 19(3) of the Patents Rules).

Where an earlier application has been found to meet the requirements for the grant of a patent, the deadline for filing a divisional application depends upon whether the earlier application was found to meet the requirements for grant after one examination or more than one examination under section 18 of the Patents Act 1977 (section 18 was amended by the Copyright, Designs and Patents Act 1988 (c.48), Schedule 5, paragraph 4 and S.I. 2004/2357).

If the earlier application was found to meet the requirements for the grant of a patent after one examination, a period of two months is available for filing a divisional application following notification to the applicant of the successful examination. If the earlier application was found to meet the requirements for grant after more than one examination, that period does not apply and a divisional application cannot be filed once the applicant has been notified that the earlier application complies with the requirements of the Patents Act 1977 and the Patents Rules (see new rule 19(4) of the Patents Rules).

A full impact assessment has not been produced for this instrument as no, or no significant, impact on the private, voluntary or public sectors is foreseen.

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