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## Modernisation and Consolidation of the Patents Rules

### An Informal Consultation (October 2005)

#### Preliminary TMPDF comments

##### *General*

1. We support the Patent Office proposal to modernize and consolidate the UK Patents Rules, as suggested in paragraphs 2 and 3 of the informal consultation document.
2. We generally support the proposed part structure for the rules, and the proposed contents of the parts, subject of course to review when the details of the individual parts become clear. We note that there will be schedules as at present, together with new schedules concerning formal requirements and classes of proceedings before the comptroller. New schedule 3 concerning proceedings heard before the comptroller was attached. We see no problem with this at present.
3. Several of the rules that are likely to appear in Part 9 (Miscellaneous) will be concerned with matters common to patents, registered trade marks and registered designs (e.g., business hours, excluded days, interruptions in post, address for service). It will be useful to know how these are to be coordinated as between the different areas of Patent Office operations and whether common wording will be established and maintained in the various statutory instruments.

##### *Part 7 Proceedings heard before the comptroller*

4. We agree with the general plan to provide one generic set of litigation rules for proceedings before the comptroller in respect of patents. We agree with the analysis in paragraph 14 of the disadvantages of the current rules.
5. We have some comments on the proposed rule 2 in Part 7, headed "Overriding objective". We certainly agree that individual cases should be dealt with justly, so far as is practicable. However, the overriding (i.e., first) objective of the comptroller must surely be to deal with them in accordance with the law including procedural rules.
6. We appreciate that the draft rule 2 has been modeled on rules 1.1 1.2 and 1.3 of the Civil Procedure Rules (CPR), rule 1.1 CPR clearly relates to "a new **procedural code** with the overriding objective of enabling the court to deal with cases justly." (emphasis added) Rule 1.1(2) CPR must be read in this context.
7. If therefore a rule on overriding objective is to be included in the patents rules (rather than for example, being by reference to the application of the civil procedure rules), it should be made clear that the principles in Rule 2(2) relate essentially to procedure rather than substantive law. For example Rule 2(1) could read:

*(1) The rules in this part set out the procedure for handling proceedings with the overriding objective of enabling the comptroller to deal with cases justly.*

While we realize that rule 2(2) is based on rule 1.1 (2) of the CPR, we point out that the generality of the wording has the potential to lead to much litigious dispute, as those involved seek to establish an appropriate interpretation in each individual case. Additionally, alleged failings by the Patent Office might be ascribed to "...taking into account the need to allot

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resources to other cases" and argument might ensue as to whether this applies only to hearings or also to ex parte prosecution.

8. Overall, we consider that the need for rule 2, at least in its present form, should be reconsidered. It may well be that a suitable reference to the CPR would be better.
9. As regards rule 5 (1)(b), we are somewhat concerned that the comptroller should have a duty to notify every person who appears to be likely to have an interest in the case. It is highly unlikely that the comptroller would be aware of every person having an interest, with the result that notifications would be arbitrary. We assume that the obligation is to notify every person whose interest is a matter of record, e.g., as an entry in the Register. If this is the case, the rule should make this clear.

***Finally***

10. These are preliminary comments. While the detailed scheme of rules in part 7 appears generally satisfactory on a first appraisal, apart from rule 2 discussed above, we may have more comments as we study the proposals in more detail.