TMPDF
TRADE MARKS, PATENTS & DESIGNS FEDERATION

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PP06/07

Patents Rules: Modernisation and Consolidation

Comments on the consultation paper issued by the Patent Office (now the UK Intellectual Property Office), March 2007

Introduction

This Federation has already made clear that it supports, in principle, the Patent Office intention to modernize and consolidate the UK Patents Rules, including the proposed new part structure and the proposed contents of the parts. We have also confirmed that we approve, in principle, the proposed new Part 7 and schedule 3, concerning proceedings heard before the comptroller.

We now generally welcome the new draft rules, subject to the comments below on individual rules. In most cases where changes have been made relative to the existing rules, a revised rule is clearer than that replaced; moreover, there appear to be somewhat more flexibilities and tolerances for applicants. We welcome the abolition of some fee bearing forms. We agree with the aim in the new rules to avoid repeating in different words matters already covered in the Patents Act.

It is always a matter of concern that a change in wording from an existing rule, in order to "modernize" it, might imply a change in the way that the rule is to be interpreted. Annex B to the consultation paper gives assurances in relation to a considerable number of the rules that no change of practice is intended. We emphasise that we expect these assurances to be reliable in relation to possible future disputes.

Abolition of rule 97

We are very concerned about the proposed abolition of existing rule 97, the postal deeming rule. Even though it may rarely be necessary to substitute an actual date of filing by a deemed date under the rule, the rule is of great value in reassuring applicants that an application posted to arrive in good time to meet a particular deadline in the normal course of post will be treated as having been filed in due time. Reassurance is particularly important in relation to priority date deadlines.

We do not agree that abandonment of the postal deeming provisions is a necessary consequence of the liberalisation of the address for service provisions under SI 2006 No. 760. It might be noted that the rules under the European Patent Convention include a similar provision (Rule 84a(1)) which appears to operate satisfactorily throughout Europe. In the event that "normal course of post" might be considered

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to discriminate against applicants from outside the UK, a longer fixed period as applied by the EPO might be adopted (in the EPO case 5 days).

Neither do we accept that extension of the provisions for extending time limits is a complete or proper replacement. Most extensions are to some degree discretionary and may require payment of a fee. These provisions should not be used to replace a provision designed to provide applicants with certainty. Whilst we recognise the desire to encourage on-line filing, we believe it is important for applicants, especially SMEs and private applicants, to be able to use traditional postal and possibly courier services with confidence.

Paragraph 9.5 of the Impact Assessment in Annex C of the Consultation document refers to the administrative burden on the Office imposed by postal deeming. Whilst we can understand the Office wish to abolish the present laborious methods by which it tracks the arrival of applications in the post, we are convinced that improved procedures should enable some form of deeming rule to be maintained. For example, it might be provided that applicants must use an approved service guaranteeing timed delivery to benefit from the rule, only one application per package, the package to be retained with the file. A declaration claiming the benefit of the rule could be required to be enclosed with the documents, to alert the post room to the need to ensure that the package will be associated with the papers being passed forward for processing. Where post marks are illegible, the applicant could be required to supply a proof of posting.

We suggest that the Office should conduct a meeting at which possible schemes could be discussed. The Federation would be happy to participate. Any more sophisticated regime than that which operates at present would require a greater degree of awareness amongst applicants. However the Office could ensure that guidance materials used by unrepresented applicants provide full explanations.

Welsh language applications

The draft rules treat the Welsh language equally with English at the application stage. Translations of documents filed in Welsh into English are not required, foreign language priority documents may be translated into Welsh rather than English and correspondence may be in Welsh. The consultation document says that details of the Welsh language scheme are to be published separately and this publication has just appeared (late May). We are considering the scheme and may comment in due course, but not in the present document.

Our concern is that it is nowhere made clear that applications for UK patents and granted patents will be published in English, the predominant language of the UK. We consider that it should be made clear **in the rules** that all UK applications and patents will be published in English, which should be the authentic text in the event of disputes.

Moreover, translations into English of everything filed in Welsh and eventually open to inspection (applications, priority documents, forms, correspondence, etc.) should be included in the file.

We also consider that filing of correspondence and translations of priority documents, references etc., in Welsh should only be permissible if the basic application is in Welsh.

Proceedings held before the Comptroller

We commented on the earlier consultation on what is now Part 7. Many of our comments still stand and are repeated below for convenience.

Particular points on individual rules

Rule 4 (Forms and documents)

Para (4) appears to allow any sheet of paper where both sides have been used to be ignored (the rule says "if thought fit, take no further action"). We do not consider that this is reasonable. At least the sheet should be referred back to the applicant, so that he can provide new sheets to meet the rule.

Para (5) seems unnecessary, since information in electronic form is dealt with by directions under Section 124A, which will override the need for forms. If the paragraph is maintained, a reference to section 124A would improve it.

Rule 9 (Translation of priority documents)

Priority documents may now be translated into Welsh. There seems no very good reason, since a translation is involved anyway, why these translations should not be into English, but at the least, translations into Welsh should only be allowed if the application and specification are in Welsh.

Rule 12 (Applications)

Para (5) Reference to directions under section 124A in existing rule 16(2) has been dropped, though this seemed to serve a useful purpose in making the context clear (as it would also in rule 4(5)).

Rule 13 (Biological material and sequence listings)

Para (4) requires sequence listings to be delivered in electronic form "if reasonably possible". Some clarification of how this is to be determined would be desirable, e.g., will what is reasonable depend on the resources of the applicant?

Rule 14 (Size and presentation) and **Schedule 2**

Schedule 2 refers to the "content of the paper" when in the context, paper is the carrier material rather than the information on it. It would be better to refer to the content of the document.

Rule 17 (References under S 15(1) (c) (ii)

Para (2) (b) Translation of references into Welsh will be allowable. This should be the case only where the application is in Welsh.

Rule 20 (New application under sections 8(3), 12(6), 37(4))

Para (4) permits the comptroller to shorten the relevant period (3 months) for filing new application, after giving notice. This is not in existing rules concerning Sections 8(3) and 12(6). This has the potential to make things more difficult for the parties involved by taking away an expectation of the time available. The period should be shortened only with the agreement of the affected party, or at least only after hearing any objection.

Rule 31 (Amendment before grant)

Para (6) (new) forbids amendment by adding a sequence listing. We consider that it should be made clear that this applies only to the extent that the sequence listing

would be added subject matter and does not forbid amendment so as to put a sequence listing included in the description into proper form for publication provided there is no added matter.

Rule 32 (Reinstatement under section 20A)

Para (11) indicates that "the comptroller shall have regard to any relevant principles applicable under the EPC". The significance of this is unclear, especially since section 20A is not among those listed in section 130(7) as being intended to have the same effect as the corresponding provision in EPC. Does this mean that the Office will follow EPO instructions and practice on *restitutio in integrum,* or merely consider its practice for guidance? If the latter, there is no need to refer to the EPC (since looking at practice elsewhere for guidance might be considered normal),

Rule 33 (Observations by 3rd parties on patentability)

Para (2) indicates that a copy of observations will not be sent to the applicant if, in the comptroller's opinion, they disparage anyone in a damaging way or encourage offensive immoral etc behaviour. This seems to go too far. The bulk of the observations will probably not be offensive in most cases. It would be better to prescribe that the comptroller should exclude any matter that in his opinion is disparaging or offensive before sending the observations.

Rule 35 (Amendment of specification after grant)

Para (2) reproduces an existing provision that says that the specification shall be delivered in electronic form or using electronic communication "if reasonably possible". See comment above on rule 13(4) concerning the problem of what is reasonably possible.

Rule 65 (Filing of international applications at the Patent Office)

Para (1) provides for the international application to be filed in Welsh. It should be made clear to applicants that a translation within one month into a language which is accepted by the ISA (likely to be English) and is also a language of publication will have to be provided. This could perhaps be referred to in e.g. paragraph (3) of this rule.

Rule 70 (Requirements of necessary translations)

Para (2) provides that a translation is only necessary where the application is in a language other than English or Welsh.

This paragraph is either superfluous or misleading. Under section 89A(3) a necessary translation into English must be filed to start the national phase if the international application has not been published in English. Presumably international applications filed in Welsh will be published in English, thus no translation will be necessary under rule 69. If they are not published in English, then a translation into English will be required under rule 69 and section 89A (3).

Rule 74 (Overriding objective)

Our comments made during an earlier consultation on rules concerning proceedings before the comptroller still stand. They are repeated here for convenience:

"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.

We appreciate that the draft rule has been modelled 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.

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 para. (2) of the rule relate essentially to procedure rather than substantive law. For example, para. (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.*

Whilst we realise that para. (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 resources to other cases" (para (2) (e)) and argument might ensue as to whether this applies only to hearings or also to ex parte prosecution.

Overall, we consider that the need for this rule, at least in its present form, should be reconsidered. It may well be that a suitable reference to the CPR would be better."

Rule 77 (Notification of the parties)

Para (1) (b) Our previous comment on this paragraph stands:

"As regards this rule, 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."

Rule 81 (Alteration of time limits)

Para (1) gives the comptroller the power to shorten periods that have been specified. While this reproduces existing rule 110(2), we consider that parties involved should be able to rely on what has been specified. Those who object to shortening should be heard (see also rule 20 above.)

Rule 84 (Hearings)

There is a misprint in para 3(a) where the first "in" is superfluous.

Rule 89 (Proceedings started under section 46(3) by other than the proprietor)

Para (3) The copy should be of "the draft of" the licence mentioned in para (1)(b).

Para (4) should make clear that a statement of grounds by the proprietor will be in rebuttal of the application for or terms of the required licence.

Moreover, reference in para (5) to rule 76(4), without some qualification, does not seem entirely appropriate, since the proprietor is not the claimant and stating a

case against the application for a licence, i.e., in favour of the *status quo*, is hardly a "remedy".

Rule 96 (Submission of observations etc.)

Para (6) Observations are to be delivered **only** in electronic form "if reasonably possible". See previous comment under rule 13(4) on the problem of what is reasonably possible

Rule 98 (Review of opinion)

We have commented before on the limitation to interpretation, imposed by the opening part of paragraph (5) (b), on the review. We consider that this limitation should be removed. The interpretation of the specification might have been reasonable, but the opinion might still have been wrong.

Rule 103 Address for service

Para (6) refers to "a member State". The UK is a member state of many treaties, several of them in the fields of patents and litigation. Perhaps it should be made clear in this context that membership of the European Union is referred to, if that is the intention.

Rule 105 (Correction of errors)

Para (4) refers to the error as being "connected to the application being delivered" in electronic form etc. This is not entirely clear. Perhaps the paragraph applies when the error is due to faulty electronic transmission.

(After) **Rule 107** (Correction of irregularities)

We note with some unease that existing rule 101 (Dispensation by comptroller) is to be abolished, since the rule appears to provide a useful safeguard should things go wrong out of the control of the person involved. We appreciate that rule 107(1) will allow the comptroller to rectify irregularities of procedure (except where a time limit is missed through no fault of the Office). This does not go as far as existing rule 101, and we are not entirely persuaded by the argument that the rule is impotent. We would welcome any evidence that the Office has on this point (e.g., has the rule been invoked in the past and with what result?).

Rule 108 (Extension of time limits) and **schedule 4**

We recognize that this rule, in the main, reflects existing rule 110. Although complicated, with different time limits treated in different ways, it is somewhat simpler than the existing rule (because e.g., the need for form 53/77 has been abolished). There may be a case for further review of all extendable time limits, with the aim of reducing the different ways in which they may be treated.

Rule 120 (Index)

Reference to the "same" rule is unclear. Perhaps a "single" rule is intended.

NOTE: TMPDF represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. This paper represents the views of the innovative and influential companies which are members of this well-established trade association; see list of members below.

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