

Forthcoming Changes to the UK Patents Rules

Following consultation earlier this year, the UK Intellectual Property Office (UKIPO) has accepted eleven proposed amendments to the Patents Rules 2007.

Respondents to the consultation were generally in favour of the proposals, which are set out below. Most proposals reduced administrative burdens or clarified confusing rules. Most worthy of note, perhaps, is the restriction to be placed on omnibus claims, which has remained a feature of UK patent practice long after other jurisdictions have prohibited them. The proposals are to be brought into effect "at the earliest opportunity", although a specific date has not yet been set.

Proposal I: Introducing a notification of intention to grant 4 weeks before grant.

This welcome change, which is similar to the notification system in operation at the EPO, should mean that fewer applicants miss the opportunity to file divisional applications, which under the current rules is at risk of happening when grant of their patent takes them by surprise.

Proposal II: Prohibiting the use of omnibus claims except where absolutely essential.

This proposal will limit the use of omnibus claims to circumstances where the technical features of the invention cannot be clearly defined in words, by a mathematical or chemical formula, or by any other written means.

The respondent felt they would not suffer any loss in competitive advantage in the absence of these kinds of claims, and whilst some may regret the passing of the ultimate fall-back position, most users were in support of this proposal to further harmonization efforts with other major jurisdictions.

Proposal III: Introducing a legislative

change to set the deadline for requesting reinstatement as 12 months after the application was terminated in all cases.

Following the rule changes, the deadline for requesting reinstatement will always be 12 months after an application is terminated, giving greater legal certainty to third parties while potentially being more generous for applicants than the current provisions. The alternative 'administrative' period of 2 months from a self-declared date of the applicant becoming aware of the termination, which some users found subjective and confusing, will therefore no longer apply.

Proposal VII: Clarifying when applicants can make amendments to international patent applications entering the UK national phase.

The current rules are unclear as to whether it is possible to amend PCT applications at the time of, or after, entry into the UK national phase and prior to UK examination because these rules rely on the issue of a communication that, in most cases, the UKIPO no longer sends. Under this proposal a new rule will be introduced to clarify that PCT applications can be amended at any time between entry to the national phase and the comptroller sending the first substantive examination report.

The remaining proposals, which follow, are self-explanatory and were generally welcomed by all.

Proposal IV: Allowing extensions (of two months) to the period for filing an address for service.

Proposal V: Relaxing the formal requirements to allow applicants

to provide shaded drawings and photographs.

Proposal VI: Removing the requirement for patent holders to notify the IPO each year of the address they wish to use to receive renewal reminders.

Proposal VIII: Clarifying the requirements concerning changes of names and addresses.

Proposal IX: Correcting the drafting of the rule concerning advertising of amendments made during infringement and revocation proceedings.

Proposal X: Removing the requirement for triplicate copies of international applications when filed with the IPO in its function as a receiving office.

Proposal XI: Removing the requirement for duplicate copies of Patents Form 51.

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Need advice?

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