

## CHANGES IN UK PATENT REGULATIONS EFFECTIVE 1 JANUARY 2005

The Regulatory Reform (Patents) Order 2004 and the Patents (Amendment) Rules 2004 came into force on 1 January 2005. Changes provide for deregulation of the existing UK patents legislation.

Some key aspects of the changes are discussed below.

### *Language of the patent specification*

It is no longer necessary for the patent specification to be in English to qualify for a date of filing. A translation can be provided up to approximately 2 months after filing.

### *'Application by reference'*

It is possible to file an application without a specification, by referring to the description of an earlier relevant application (i.e. an earlier UK patent application or a convention country application), and for the application still to be accorded a filing date. It will be necessary, however, to provide the country, filing date and application number of the earlier application at the time of filing the application by reference. A certified copy of the earlier relevant application must be provided within 4 months of the filing date of the 'application by reference'. A certified copy will not be required if the earlier relevant application is a UK application.

Note that this procedure is appropriate only if the new application is to be filed with exactly the same content as the earlier application. Extreme care must be taken in providing the correct reference details. For this reason at least, we do not recommend using this facility if it can be avoided.

### *Recovery of lapsed applications and patents*

Under certain circumstances, pending applications that have lapsed unintentionally by withdrawal or by an omitted act can be recovered, provided that it can be shown to the satisfaction of the Patent Office that the lapse was 'unintentional'. A similar test is to be applied to requests for restoration of lapsed patents. We believe that the new test for unintentional lapse cannot be more onerous than the test it replaces.

It should be noted that rights of third parties who, in good faith, commence potentially infringing activities in a period while an application or patent has effectively lapsed, continue to be protected even if the application or patent is subsequently restored.

### *Transactions involving patents*

For transactions signed on or after 1 January 2005, the requirement that an assignment, mortgage or assent on a patent must be signed by both parties to the transaction is relaxed. The transaction need only be signed by the assignor, mortgagor or personal representative.

We note, however, that no change to a corresponding provision in the European Patent Convention has yet been made and thus assignments of European patents and patent applications should still be signed by both assignor and assignee.

### ***Making late declarations of priority***

For applications filed within 12 months of the earliest priority date, it will now be possible to make or add a new priority claim at any time up to 16 months after the earliest priority date, provided that the application has not been published early, and providing that the failure to claim priority can be shown, to the satisfaction of the Patent Office, to have been unintentional.

For applications filed after 12 months from the earliest priority date, it will be possible to make a priority claim within 2 months after the expiry of the 12 month priority period, provided that the application in suit has not been published early and provided that it can be shown, to the satisfaction of the Patent Office, that the failure to file the application within the 12 month Paris Convention period was unintentional.

### ***Translations of priority documents***

Translations of priority documents into English will no longer be required as a matter of course. However, should a translation be required, the applicant will be notified by the Patent Office.

### ***Extending specified time limits***

Provision has been made for periods for response to examination reports and other deadlines to be extendable as of right, by two months.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

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