Changes to the UK Patent Rules

The UK Intellectual Property Office (UKIPO) has announced a number of important changes to the Patents Rules. The changes apply to GB applications filed directly with the UKIPO and to GB applications which enter the GB national phase via the PCT route. This is a summary of some of the key changes.

NOTIFICATION OF INTENTION TO GRANT

A significant change in UK practice is a new Notification of Intention to Grant communication. At the moment, except in special circumstances, GB applications become granted patents without any warning. This differs from the practice at the European Patent Office and in the USA, where the applicant receives a notice that the application is allowable. From 01 October 2016 the UKIPO will issue a Notification of Intention to Grant communication on all cases, giving at least one month’s notice before the patent is granted.

This makes dealing with the issue of divisional applications more straightforward. Under current practice, it is usual to “foreshadow” divisional applications, asking the examiner to contact the applicant or their patent attorney informally to provide some warning before grant. However, this informal system requires the applicant to have considered the possibility that a divisional application may be wanted in advance. Under the new rules, from 01 October 2016 the official warning means that applicants will have the opportunity to decide finally if a divisional application is wanted.

Simplified Deadlines

The time period for requesting reinstatement of an application (if a deadline is missed) is also being simplified, to the benefit of applicants. From 01 October 2016 the deadline for requesting reinstatement will be 12 months from the date of termination of the application, regardless of when the applicant learned that the deadline had been missed. However, we continue to recommend that requests for reinstatement are filed as soon as possible because third parties can accrue rights to use your invention in the period while the application is terminated.

The deadline for restoration of patents (when a renewal fee is missed) is unchanged.

OMNIBUS CLAIMS

From 06 April 2017 omnibus claims will no longer be allowed. Omnibus claims refer generally to the description or drawings – for example, “A widget substantially as described herein with reference to the accompanying drawings” – and are considered something of a curiosity in the UK patent system. Indeed, very few other jurisdictions permit them. From 06 April 2017 patent examiners will object to the presence of omnibus claims in GB applications. However, patents already granted with omnibus claims will be unaffected, and the claims will be considered valid.

If you have any questions about these changes, please ask your usual Mewburn Ellis contact or email mail@mewburn.com.

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For more information on Mewburn Ellis LLP and other intellectual property matters, please visit our website at www.mewburn.com.

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