

# **Patents (Amendment) Rules 1997**

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**No. S 132**

**PATENTS ACT  
(CHAPTER 221)**

**PATENTS (AMENDMENT) RULES 1997**

In exercise of the powers conferred by sections 42, 110, 115 and 116(3)(b) of the Patents Act, the Minister for Law hereby makes the following Rules:

**Citation and commencement**

1. These Rules may be cited as the Patents (Amendment) Rules 1997 and shall come into operation on 1st April 1997.

### **Amendment of rule 9**

2. Rule 9 of the Patents Rules (R 1) is amended —

(a) by deleting paragraph (2) and substituting the following paragraphs:

“(2) Subject to rule 28, where the application in suit is for a patent under the Act, the applicant shall, within 16 months from the declared priority date, furnish to the Registry in respect of every application specified in the declaration its file number.

(2A) Subject to paragraph (4), the applicant shall, within 22 months from the declared priority date, furnish to the Registry, in respect of every application specified in the declaration, a copy of that application duly certified by the authority with which it was filed or otherwise verified to the satisfaction of the Registrar.”.

(b) by deleting the words “and (2)” in the fourth line of paragraph (4) and substituting the words “, (2) and (2A)”;

(c) by deleting paragraph (5) and substituting the following paragraph:

“(5) Where a copy of an application is filed or treated as having been filed under paragraph (2A), (3) or (4) and that application is in a language other than English, a translation thereof into English, verified to the satisfaction of the Registrar as corresponding to the original text, shall be filed within 22 months from the declared priority date.”.

(d) by deleting the words “rule 86(3)(c)” in paragraph (6) and substituting the words “rule 86(4)(c);” and

(e) by inserting, immediately after the words “paragraph (2)” in paragraph (7), the words “, (2A)”.

### **Amendment of rule 19**

3. Rule 19 of the Patents Rules is amended by deleting paragraph (4) and substituting the following paragraph:

“(4) The title appearing in the request, specification and abstract shall be short, precise and indicate the matter to which the invention relates; and if in the opinion of the Registrar it fails to comply with this paragraph, the Registrar may reframe it so that it does so comply.”.

## **Amendment of rule 28**

### **4. Rule 28 of the Patents Rules is amended —**

(a) by deleting paragraph (1) and substituting the following paragraph:

“(1) Where a new application is filed under section 20(3), 26 (6) or 47 (4) —

- (a) subject to this rule, the requirements of rule 9(1) and (3) shall be complied with at the time of filing the new application;
- (b) after the period of 16 months prescribed in rules 9(2) and 18, then, subject to this rule, the requirements of rules 9(2) and 18 shall be complied with at the time of filing the new application; and
- (c) the requirements of paragraph 1(2)(a)(ii) and (3) of the Fourth Schedule, in a case to which they apply, shall be complied with on or before the time ascertained under the said paragraph 1(3) or the time of filing the new application, whichever is the later.”.

(b) by deleting the words “rule 9(5)” in paragraph (2) and substituting the words “rule 9(2A) and (5)”; and

(c) by deleting paragraph (3) and substituting the following paragraph:

“(3) Where a new application is filed under section 26(6) after —

- (a) the period of 16 months prescribed in rule 9(2) or 18 (1); or
- (b) the period of 22 months prescribed in rule 9(2A) and (5) as modified, in the case of an international application, by rule 86(4),

but within an extension of that period under rule 108(3) or (4) in respect of the earlier application, the requirements of rule 9(2), (2A) and (3), and rule 9(5) or 18, as the case may be, shall be complied with before the end of the extended period.”.

## **Amendment of rule 33**

**5.** Rule 33(1) of the Patents Rules is amended by deleting the words “In examining for the purposes of section 28(1) (“formalities examination”)” in the first and second lines and substituting the words “For the purposes of sections 28(1) (“formalities

examination”) and 30(2)(a)”.

#### **Amendment of rule 42**

6. Rule 42 of the Patents Rules is amended by deleting paragraph (2) and substituting the following paragraphs:

“(2) A request for an examination report under section 29(3) (in the case of an application under section 116(6)), 29(5)(a) or 29(8) shall not be treated as having been made unless the form required under paragraph (1) is accompanied by —

- (a) a copy of the search report referred to in section 29(3) (in the case of an application under section 116(6)) or 29 (5)(a) or a copy of the international search report referred to in section 29(8) together with each of the documents referred to in that search report or international search report; and
- (b) a list of references to the patent family members as corresponding to each of the non-English documents cited in the search report or international search report mentioned in paragraph (a).

(3) The Registrar may require an applicant to furnish a translation into English, verified to the satisfaction of the Registrar as corresponding to the original text, of part or the whole of any document referred to in that search report or international search report within such period as the Registrar may specify.

(4) Where an applicant does not comply with all the requirements of the Registrar within the period specified under paragraph (3), the request for an examination report shall be treated as having been abandoned.”.

#### **Deletion and substitution of rule 44**

7. The Patents Rules are amended by deleting rule 44 and substituting the following rule:

##### **“Information for purposes of section 29 (4)**

44. The information prescribed for the purposes of section 29(4) shall be —

- (a) that which is sufficient to indicate the result of an application filed before any one of the prescribed patent offices, and shall be in the form of —
  - (i) a certified copy of the patent granted by the patent office in question; or
  - (ii) other documents, to the satisfaction of the Registrar, setting