The Patent Office
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For Innovation

Code of Practice

For Patent Applicants and Agents

A DTI SERVICE

Contents

What are the Code's objectives?

The Code of Practice for patent applicants and agents aims to identify what the Patents Directorate believes are best practices for those dealing with the Directorate.

Best practices are those which contribute to the efficient operation of the patent granting system. Such operation allows the grant of patent rights to be expedited, while allowing speedier customer service, minimising uncertainties over pending rights, and improving the efficiency of operation of the Directorate.

The Directorate does not expect applicants and agents to be able to adhere to best practice all the time: there are many factors which might prevent best practice being followed. In particular the Directorate acknowledges the primary duty that professional representatives have towards their clients. What is important is that best practices are known, and applied wherever that is achievable. This means that efforts should be made to keep departures from these practices to a minimum.

Who is the Code directed at?

The Code is directed at anyone who makes more than occasional applications for patents, because the benefits of the Code will mainly accrue if applicants apply it routinely across significant numbers of applications. Many applicants appoint agents to represent them in their dealings with the Directorate, and this Code is of particular importance for such agents. The term "agent" is used in this Code to mean anyone who is in the business of representing applicants for patents.

What does the Code comprise?

The Code comprises Code Points, which are specific statements of best practice. The Points are amplified by reference to updated paragraphs of the Manual of Patent Practice (not included here) which are initially available in the online version of the Manual that can be seen at
www.patent.gov.uk/patent/p-decisionmaking/p-law/p-law-manual/p-law-manual-practice.htm
and which will be incorporated into the next paper update to the Fifth edition.

The Code Points deal with three general areas:

- the drafting and filing of UK patent applications
- the subsequent prosecution of UK patent applications
- the filing of international patent applications

How is the Code presented in the Manual of Patent Practice?

The Code Points relating to *the drafting and filing of UK patent applications* are listed at the start of the Manual chapter on section 14 of the Act. These Code Points are explained and amplified in those paragraphs of the Manual identified against each Point, and those paragraphs will not necessarily be in the section 14 chapter. The Manual paragraphs are not included in this document.

The Code Points relating to *the prosecution of UK patent applications* are listed at the start of the Manual chapter on section 18 of the Act. Again, these Code Points are explained in those paragraphs of the Manual identified against each Point, and those paragraphs will not necessarily be in the section 18 chapter. The Manual paragraphs are not included in this document.
The Code Points relating to *the filing of international patent applications* at the UK Patent Office, acting as a receiving Office under the Patent Cooperation Treaty, are listed and explained at the start of the Manual chapter on section 89 of the Act.

How will the Code develop?

The Code will be kept under continuous review, and we welcome comments and suggestions on how to improve it, to Ros Lyon at mppeditor@patent.gov.uk or

Room 3.Y26
The Patent Office
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ
United Kingdom

Tel: +44(0)1633 813677

Drafting and filing patent applications

This part of the Code of Practice relates to the drafting and filing of patent applications under the Patents Act 1977. The quality of the application that is received by the Patent Office determines in large part the effort that has to be expended during the statutory search and examination, in putting the application in a state to be granted, and is thus a central factor for the Code. The Code does not seek to eliminate the need for search and examination, but rather to optimise drafting towards UK law and practice and to avoid formulations that are clearly problematic for the UK search and examination. When drafting specifications for filing at this Office the aim should therefore be to adhere to the Code points below. If the specification has been drafted abroad and not primarily for filing at this Office then desirably the specification, particularly the claims, should be adapted to comply with the Code points *before* it is filed here. If that is not possible because of time constraints, the necessary adaptations should be made in time for search or examination, so that meaningful work can then be done without delay, and the examiner may require such adaptations to be made.

This part of the Code also deals with presentational and procedural matters that have to be checked by the Office after the initial filing. Here also there is substantial scope for efficiency savings if UK practice is known and followed.

1. The claims as filed: Structure

The claims filed should be structured to have:

a. One independent claim defining all the technical features essential to the invention or inventive concept. This should include the core integers as well as sufficient details of interrelationship, operation or utility to establish that the invention achieves the intended objectives (see 14.110.1); and

b. Dependent claims incorporating all the features of the independent claim and characterised by additional non-essential features (see 14.134).

c. Further independent claims are only justified where the inventive concept covers more than one category, e.g. apparatus, use, process, product (see 14.168), complementary versions within one category, e.g. plug and socket, transmitter and receiver, which work only together (see 14.161), or distinct medical uses of a substance or composition (see 14.162).

Therefore claims as filed should not, where it might have been avoided, contain:

d. Multiple unrelated inventions that would clearly give rise to a plurality objection (see 14.157.1).

e. Multiple independent claims in any one category, even if only one inventive concept is present (see 14.110.1 and 14.140).

f. Claims of a total number or complexity not justified by the nature of the invention (see 14.110.1 and 14.140).

g. Claims which are in principle unsearchable by reason of the number of alternatives embraced, or the choice of characterising parameters or desiderata (see 14.110 and 14.133).

h. Dependent claims that are not fully limited by the terms of the preceding independent claim, e.g. dependent claims which omit, modify or substitute a feature of an independent claim (see14.134).

If these points are not met on filing, suitable claim amendments should be filed if the search examiner requests them to enable search (see 17.94 and 17.108). Amendments may be required by the substantive examiner before examining such claims (see 18.43.1 and 18.39).

The above points also apply at the entry into the UK national phase of international applications under the Patent Cooperation Treaty.

2. The claims as filed: patentability

- The claims as filed should not, where it might have been avoided, define an invention which is clearly excluded from being patentable under the Act (see 1.07 to 1.32).

If this point is not met on filing, suitable claim amendments should be filed if the search examiner requests them to enable search (see 17.94). Examiners may either require amendment before searching or examining such claims, or may issue a report that a search would serve no useful purpose (see 17.94 and 17.98).

The above points also apply at the entry into the UK national phase of international applications under the Patent Cooperation Treaty.

3. Other aspects of the specification as filed

a. The use of a compact style of consistory clause, which in the description defines the invention by reference to the claims, is encouraged (see 14.148).

b. Trade marks are an indication of the origin rather than the composition or content of goods, and should not be used in patent applications where a generic term can be used instead. Trade marks are only permitted in claims where it can be shown that their use is unavoidable and does not introduce ambiguity (see 14.137). Where marks that are registered are mentioned, they should be acknowledged as such (see 14.70 and 14.71). If a trade mark is not registered, its owner should be indicated (see 14.70).

c. Passages which confuse the scope of the invention (see 14.64.1) or claims that are unspecific (e.g. those claiming “Any novel matter...”) (see 14.139) should not be filed.

4. The abstract

a. The abstract and abstract title should meet the requirements of Rule 19 of the Patents Rules 1995, summarising the distinctive technical features of the invention in technical language (see 14.173 to 14.184).

b. An abstract having wording that merely reproduces an independent claim will not adequately meet these requirements (see 14.184).

5. Forms and formalities on filing

The Patent Office tries to keep red tape to a minimum, but some formalities are necessary for the system to work properly. These may seem like trivial matters, but they can add up to a lot of work, and it helps greatly if applicants and agents not only know what the requirements are, but also check carefully that they have been followed in each case.

a. The presentation of the application should meet the requirements of Rules 18 and 20 of the Patents Rules 1995 (see 14.26 - 14.57). For example, the margins should be kept clear and free from headers or footers denoting references or other matter (see 14.28).

b. An official form should be used where required by the Rules, and it should be completed fully and accurately, and signed (see 14.04 for the application form).

c. Supporting documents should also be provided where ppropriate; for example:

   a fee sheet where fees are being paid;
   a covering letter where some explanation is needed.

d. To allow us to direct incoming items quickly to the right place all appropriate identifiers should be given:

   Form 1/77 should give ADP number and customer reference;
   Forms and letters filed after Form 1/77 should give application number and (optionally) customer reference;
   Fee sheets should give cash or deposit account number;
   Bank transfers should state the application or patent number, or, if not known, the reason for payment e.g. search fee.

In correspondence with applicants and their representatives, the Patent Office will use customer references if given, and will tell agents the applicant's ADP numbers (see 14.04.1 and 14.04.5).

e. If it is critical that an application be filed within a certain time window such as the twelve months of the Paris Convention, the application should be filed with sufficient time remaining for any fatal defects to be detected and put right.

f. The originals of faxed documents should only be filed when requested to do so by the Patent Office (see 14.02).

Prosecuting patent applications

This part of the Code of Practice relates to the prosecution of patent applications. The process of examination and amendment of patent applications ideally proceeds by eliminating objections until the application can be granted. To expedite the granting of an application, the substantive examiner will attempt to indicate all objections in the first report issued under s.18(3). The main exception to this will occur where only major objections (such as patentability issues) are raised and minor matters are deferred until the major points have been settled. This process of eliminating objections minimises the time taken conducting a comprehensive review of the specification as it will generally only be necessary to decide whether or not the amendments or arguments advanced meet the objections raised. However, for this process to be efficient for both sides it is necessary that the following points are observed.

6. Responding to the examiner's objections

a. A full response should be made to each and every objection raised in an examination report through amendment and/or argument so as to progress the application towards grant (see 18.63 to 18.63.2).

b. When objections are to be met by amendment, an appropriate explanation should be provided, in particular as to how the amendment meets the objection and how it is supported by the specification as originally filed (see 18.63 to 8.63.2).

c. Amendments must not add new technical disclosure, or broaden the scope of claims over the disclosure as originally filed to claim a new inventive concept (see 76.04 - 76.22).

d. Pages showing the amendments, in manuscript or distinctive type, should be filed in addition to the clean replacement pages for the specification (see 18.61).

e. Consequential amendment of the description may be deferred until the independent claims have been agreed upon (see 18.52).

7. Time issues in patent processing

The efficiency of the patent granting process depends in no small part on the timeliness of the Office as well as of applicants and agents. The Patent Office will set a timetable for the various stages in processing a patent application to grant. Applicants and agents should use their best endeavours to comply with the timetable by acting within the periods for response that will be specified. It will be helpful if action is taken before the end of the period for response. Requests for extensions of those periods for response will be considered if made in the recommended way. Requests for processing to be accelerated will also considered if made in the recommended way.

a. Action should be taken within a period specified for response and not delayed until the last day if that is avoidable.

b. A request for extension of a period for response should be made within the period for response and should be supported by an adequate reason that is peculiar to the circumstances of the case (although a limited first extension may be granted more freely) (see 18.54 - 18.60, particularly 18.57.1).

c. A request for accelerated processing of search or examination should be supported by an adequate reason that is peculiar to the circumstances of the case (see 17.05.1 and 18.07 - 18.07.2).

d. When time is short, the covering letters or fax header sheets accompanying responses to Office actions should be marked "URGENT" (see 18.72.1).

e. Notification of withdrawal of an application *must* reach us before the date on which preparations for publication are completed if it is wished to prevent publication: the publication process does not admit of later withdrawals (see 14.205).

f. Voluntary amendments should be filed early (see 19.13).

8. Filing divisional applications

a. Divisional applications should be filed early as time is limited under rule 34 (see 15.20.2).

b. A divisional application should have a single claimed invention (or inventive concept) that is distinct from that of the parent application (see 15.20.2 and 15.29).

c. The description and drawings of the divisional application should be provided in a form appropriate to the invention of the divisional application, and irrelevant material excised (see 15.32).

d. Amendments already known to be required at the date of filing of the divisional application should be made (see 15.32).

If the above points are not met on filing a divisional application, suitable amendments should be filed as soon as possible (see 15.36).

9. Forms and formalities after filing

- Information about changes should be notified promptly and by the recommended method. Global changes affecting more than one patent application should be notified by one communication, with a list of the patent application numbers (or patents) appended. The distinction between amendment and correction should be appreciated (see 19.03), and where a correction is proposed, sufficient evidence demonstrating that the correction was the applicant's intention at the time of filing should be provided (see 117.19). Supporting proof where needed should be adequate to establish and verify the circumstances.

Change of address (only):

a letter will suffice for this, whether it is amendment or correction (see 19.05, 117.03).

Change of agent:

Form 51/77 is used for this amendment (see 14.04.12).

Appointment of an agent for the first time (after the filing date):

Form 51/77 is used.

Amendment or correction of other data on the application form:

Form 11/77 is used, and will require supporting proof for the change of an applicant's name (see 19.05 - 19.12 and 117.17 - 117.21).

Amendment of name (ownership) in the Register:

Form 20/77 is used and will require supporting proof (see 32.06).

International applications for patents

The legal requirements of the Patent Cooperation Treaty (PCT) differ from those of the Patents Act in important ways and those filing international applications with the UK Patent Office as PCT Receiving Office need to take particular care to follow PCT requirements. It may not be possible to remedy some problems if they are not spotted in time. The more important points are summarised in a checklist overleaf. The International Unit of the Patents Directorate can provide further guidance and queries may be made to Phil Jones at phil.jones@patent.gov.uk or by telephone on +44 (0) 1633 814586.

10. International Applications

- The provisions of the Patent Cooperation Treaty, e.g. as to forms and formalities, should be observed when filing international applications with the UK Patent Office as PCT Receiving Office.

Claims

It is vital for claims to be included in the international application if it is to be awarded an international filing date.

Timing

If it is critical that an international application be filed within a certain time window such as the twelve months of the Paris Convention, the application should be filed with sufficient time remaining for any fatal defects to be detected and put right.

Application form

It is necessary to complete a Request Form (number RO101), and it is important that the current version be used. British nationality/residency should be shown as “GB/United Kingdom”. Applicants should be identified by family name followed by forename(s). It is possible to request correction of a PCT form, but a replacement form with the correction should be provided with such a request. If priority from a previous GB application is claimed, a Patents Form 23/77 should be filed for each such application.

Powers of attorney

If the application has multiple applicants, a power of attorney has to authorise an attorney on behalf of each of the applicants. The address of the attorney should match that on the Request Form. If completed on behalf of an applicant company, the power should state the capacity of the officer who signs it.

Fees and copies

A fee sheet should be completed if fees are being paid. If there is doubt over what fee is due the Receiving Office will clarify this by issuing a form RO102. Three copies of the specification and drawings are required.

Withdrawals

Notices of withdrawal should be sent to the International Bureau in Geneva, with a copy sent to the UK Patent Office.

For additional copies
please contact

Ros Lyon
Ext: 3677
Room: 3Y26

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