



INTELLECTUAL
PROPERTY OFFICE

Code of Practice

For Patent Applicants and Agents



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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 when filing and prosecuting patent applications.

Parts of the Code of Practice relate directly to the legal requirements set out in the Patents Act 1977 and Patents Rules 2007. Failure to comply with the Act and Rules may have detrimental consequences for the patent application. Other parts of the Code of Practice set out best practice under those legal requirements.

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 the Code of Practice all the time. 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.

Similarly, it is accepted that there are occasions when patent applications are filed solely with the intention of securing a priority date and upon which a later application may be based. Some of the best practices set out in the Code of Practice may not be considered to be of high priority when filing such applications.

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 paragraphs of the Manual of Patent Practice (not included here) which are available in the online version of the Manual that can be seen at www.ipo.gov.uk/p-manual-practice.

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 Intellectual Property 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 was revised on 1 April 2010 following consultation with users and Office staff. It will be kept under continuous review, and we welcome comments and suggestions on how to improve it, to Sarah Barker at mppeditor@ipo.gov.uk or

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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 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.

This part of the Code also deals with presentational and procedural matters that have to be checked by the Office after the initial filing. The Office tries to keep red tape to a minimum, but some formalities are necessary for the system to work properly. There is substantial scope for efficiency savings if the best practices set out in this Code are 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. Inessential or optional features should not be included in this claim; consequently terms such as “preferably”, “for example”, or “more particularly” should not be included, as the feature being introduced by such terms does not restrict the scope of the claim in any way. The independent claim should include sufficient details of interrelationship, operation or utility of the essential features to enable the scope of the claim to be determined (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).

In addition:

- 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 (see 14.134).

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

- a. 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).

3. Other aspects of the specification as filed

- a. The use of a compact style of consistency 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.
- d. The specification should be clear and precise. It should not repeat matter unnecessarily, nor should it contain matter which is irrelevant to the invention (see 14.64) - for example the complete details of well-known ancillary features need not be given.
- e. Only the most relevant prior art should be discussed (see 14.83 and 14.84). For example, a few documents which illustrate how a problem has previously been approached could be discussed with a view to distinguishing the invention in suit from them or illustrating its advantages.
- f. If the specification has been drafted abroad then it should be adapted to comply with sections 14(3) and 14(5) of the Patents Act 1977 and the Code points before it is filed here. Action should be taken to ensure that it is written in a reasonable standard of English before it is filed.
- g. The patent specification is intended to describe the invention precisely and it is vital that the meaning of all abbreviations and words used is clear and unambiguous. Words, abbreviations or acronyms used in the specification that are new, may be considered to be jargon, or may be at risk of being ambiguous (for example because their meaning is not yet generally settled in the field in question) should not be used unless unavoidable, in which case a definition should be given in the specification.

4. The abstract

- a. The abstract and abstract title should meet the requirements of rule 15 of the Patents Rules 2007, summarising the distinctive technical features, technical field and principal use 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 comply with this Code and may be rejected on the ground of non-compliance with the Rules (see 14.184).

5. Forms and formalities on filing

- a. The presentation of the application (including drawings) should meet the requirements of rule 14 of the Patents Rules 2007 (see 14.26 - 14.57). For example, documents must be legible and capable of reproduction, and 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 (see 14.04 for the application form).
- c. Supporting documents should also be provided where appropriate; 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 should give ADP number(s) and customer reference;*
 - *Forms and letters filed after Form 1 should give application number and (optionally) customer reference;*
 - *Fee sheets should give all relevant details, such as deposit account number or credit/debit card details;*
 - *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 Intellectual Property 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 Office (see 14.02).
- g. Electronic filing of applications is strongly encouraged; official fees are reduced for certain electronically-filed documents. See www.ipo.gov.uk/p-apply-online.

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 18.63.2).
- c. Amendments must neither add new technical disclosure, nor broaden the scope of claims beyond the disclosure as originally filed (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).
- f. The Office recommends the use of electronic filing when submitting amended pages or arguments in response to the examiner's objections, whether the original application was filed electronically or not. See www.ipo.gov.uk/p-apply-online.

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 Office will set a timetable for the various stages in processing a patent application to grant, by setting periods for responding to various Office letters and reports. Applicants and agents should use their best endeavours to act within the periods for response that will be specified. Requests for extensions of those periods for response will be considered if made in the recommended way and in accordance with the legislation relating to extensions of time. Requests for processing to be accelerated will also be 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 in a timely manner. The request may be e-mailed to the dedicated pateot@ipo.gov.uk email address (see www.ipo.gov.uk/p-direction-extension), in which case, an automatic acknowledgement of receipt will be issued. Alternatively, the extension may be requested in the response letter itself. Where an as-of-right extension is not available, the request should be supported by an adequate reason that is peculiar to the circumstances of the case (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 permit 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 30 (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

- a. 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 is used for this amendment (see 14.04.12).

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

Form 51 is used.

Amendment or correction of other data on the application form:

Form 20 is used for correction of an applicant's name, and may require supporting proof. All other amendments or corrections should be made in writing (see 19.05 - 19.12 and 117.17 - 117.21).

Amendment of name (ownership) in the Register:

Form 20 is used and may 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 Intellectual Property 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@ipo.gov.uk or by telephone on +44 (0) 1633 814586.

10. International Applications

- a. The provisions of the Patent Cooperation Treaty, e.g. as to forms and formalities, should be observed when filing international applications with the Intellectual Property Office as PCT Receiving Office.
- b. A power of attorney and/or a copy of a previously-filed general power of attorney is needed: (i) for all withdrawal requests; and (ii) where it is unclear that an agent or common representative has power to act on behalf of the applicant.
- c. **Withdrawals:** Notices of withdrawal should be sent to the International Bureau in Geneva, with a copy sent to the Intellectual Property Office (see also point b above).

PCT filing checklist

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 (Form PCT/RO/101), and it is important that the current version be used. British nationality and residency should be shown as either “GB” or “United Kingdom”. Applicants should be identified by family name followed by forename(s). It is possible to request correction of a PCT form; in some circumstances we may request a replacement form be provided.

Fees and copies

A fee sheet should be completed if fees are being paid. Details of fees payable for PCT applications can be found at www.ipo.gov.uk/p-pct-fees. If there is doubt over what fee is due the Receiving Office will clarify this by issuing a Form PCT/RO/102.

Filing PCT applications electronically

PCT applications can be filed electronically using EPO Online Services (www.ipo.gov.uk/p-apply-online-epoline) or PCT-Safe (www.ipo.gov.uk/p-apply-online-pctsafe). When using EPO Online Services, it is important that the latest version of the software is used to ensure that the request form and fees are current.

For additional copies please contact

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