

**PATENTS ORDER, 2011**

(S 57/2011)

**PATENTS RULES, 2012**

ARRANGEMENT OF RULES

**Rule**

**PRELIMINARY**

1. Citation and commencement.
2. Interpretation.
3. Fees.
4. Forms.
5. Costs.
6. Taxation of costs.
7. Taxation proceedings.
8. International exhibitions.
9. Declaration of priority for purposes of section 17(2).
10. Request to Registrar for permission to make late declaration under section 17(4).
11. Furnishing of application or file number and of priority documents to support declaration under section 17(2).
12. Translation of priority documents.

**RIGHT TO APPLY FOR AND OBTAIN A PATENT**

13. References under section 20(1)(a).
14. References by co-proprietors under section 20(1)(b).
15. Orders under section 20.

16. Prescribed period for new application under section 20(3).
17. Authorisation under section 20(5).
18. Request by joint applicants under section 22.
19. Referral to Registrar under section 23.

## **INVENTORS**

20. Mention of inventor.
21. Procedure where applicant is not inventor or sole inventor.

## **APPLICATIONS FOR PATENTS**

22. Application for grant of patent.
23. Micro-organisms.
24. Drawings.
25. Abstracts.
26. Size and presentation of documents.
27. Form of statements, counter-statements and evidence.
28. Unity of invention.
29. Certain matters prescribed under section 26.
30. Missing parts.
31. New applications under section 26(11).
32. Extension of period for filing new applications.
33. Publication of applications.
34. Completion of preparations for publication.

## **PROCEDURE FOR GRANT**

35. Address for service.
36. Formal requirements.
37. Preliminary examination.
38. Request for search report.
39. Request for search and examination report.

40. Period for filing request for search report.
41. Minimum documentation for search.
42. Prescribed patent offices.
43. Request for examination report.
44. Reliance on international preliminary report on patentability.
45. Period prescribed under section 29(2)(b) to (e) or (4).
46. Information prescribed under section 29(2)(c)(ii) or (d)(ii).
47. Search procedure where 2 or more inventions claimed.
48. Written opinion of Examiner etc.
49. Putting application in order.
50. Extension of prescribed periods under sections 29(7) and 30(1)(a).
51. Application for amendment before grant.
52. Time for making amendments before grant.
53. Certificate of grant.

#### **PATENTS AFTER GRANT**

54. Renewal of patents.
55. Extension of term of patent.
56. Amendment of specification after grant.
57. Search and examination after grant.
58. Restoration of lapsed patent.
59. Modified application of section 40 to patent to which section 115(4) applies.
60. Surrender of patents.

#### **REGISTER AND OFFICIAL DOCUMENTS**

61. Register of patents.
62. Alteration or correction of name, address or address for service.
63. Application for registration of transaction etc.
64. Request for correction of errors.
65. Inspection of register etc.
66. Advertisement of matters contained in register.

67. Entries in respect of right to a patent.
68. Certificates and copies supplied by Registrar.
69. Orders or directions by court.

### **ENTITLEMENT TO PATENT**

70. Reference to Registrar of right to patent.
71. Application for authorisation to carry out directions.
72. Time limits for making new application.
73. Request for licence to continue working new patent.
74. Reference as to entitlement to grant of licence.

### **LICENCES OF RIGHT**

75. Entry in register of licence of right.
76. Settlement of terms of licence of right.
77. Cancellation of entry in register as to licence of right by proprietor.
78. Cancellation of entry in register as to licence of right by third party.
79. Procedure as to cancellation of entry in register as to licence of right.
80. Action by Registrar on cancellation in register as to licence of right.

### **INFRINGEMENT OF PATENTS**

81. Particulars prescribed under section 64(4).

### **INFRINGEMENT PROCEEDINGS BEFORE REGISTRAR**

82. Reference to Registrar for determination of infringement.
83. Procedure where validity of patent is in dispute.
84. Application for declaration as to non-infringement.

## **REVOCATION OF PATENTS**

- 85. Procedure on application for revocation.
- 86. Material information prescribed under section 80(1)(f)(iii).
- 87. Procedure relating to preparation of re-examination report.
- 88. Copies and conclusions of re-examination report.
- 89. Award of costs on surrender of patent.
- 90. Notification of an opportunity to amend.

## **AMENDMENT OF PATENTS IN INFRINGEMENT OR REVOCATION PROCEEDINGS**

- 91. Procedure as to opposition to amendment.

## **NATIONAL PROCESSING OF INTERNATIONAL APPLICATIONS**

- 92. Treatment of international applications.

## **HEARINGS, AGENTS AND CORRECTION OF ERRORS**

- 93. Registrar's discretionary powers.
- 94. Request for hearing.
- 95. Hearings in public.
- 96. Right of audience.
- 97. Correction of errors in patents and applications.

## **INFORMATION AND INSPECTION**

- 98. Information about patents and patent applications.
- 99. Inspection of documents.
- 100. Confidential documents.

- 101. Publication of bibliographic information.
- 102. Request for information on unpublished patent applications.

## **GENERAL**

- 103. Service of documents.
- 104. Hours of business and excluded days.
- 105. Correction of irregularities.
- 106. Dispensation by Registrar.
- 107. Filing of evidence.
- 108. Statutory declarations and affidavits.
- 109. Admission of documents.
- 110. Directions as to furnishing of documents.
- 111. Filing of miscellaneous documents.
- 112. Supporting statements or evidence.
- 113. Appointment of scientific advisers by Registrar.
- 114. Alteration of time limits.
- 115. Protection and compensation of persons affected by extension of time.
- 116. Calculation of times or periods.
- 117. Copies of documents.
- 118. Translations.
- 119. Publication and sale of documents.
- 120. Journal.
- 121. Reports of cases.

## **INTERNATIONAL APPLICATIONS**

- 122. Filing of international applications.
- 123. Fees for international applications.
- 124. Certified copies.
- 125. Fee currency.

<b>FIRST SCHEDULE</b>	<b>– FEES PAYABLE</b>
<b>SECOND SCHEDULE</b>	<b>– DESCRIPTIONS OF FORMS</b>
<b>THIRD SCHEDULE</b>	<b>– SCALE OF COSTS</b>
<b>FOURTH SCHEDULE</b>	<b>– MICRO-ORGANISMS</b>
<b>FIFTH SCHEDULE</b>	<b>REMUNERATION OF SCIENTIFIC ADVISERS</b>

## **PATENTS ORDER, 2011**

**(S 57/2011)**

## **PATENTS RULES, 2012**

In exercise of the powers conferred by sections 43, 107 and 112 of the Patents Order, 2011, the Minister of Energy in the Office of the Prime Minister, with the approval of His Majesty the Sultan and Yang Di-Pertuan, hereby makes the following Rules –

### **PRELIMINARY**

#### **Citation and commencement.**

1. These Rules may be cited as the Patents Rules, 2012 and shall commence on the same date as the Patents Order, 2011.

#### **Interpretation.**

2. (1) In these Rules, unless the context otherwise requires –

“certificate of grant” means a certificate for the purposes of section 34(1);

“convention country” has the same meaning as in section 17(10);

“costs” includes fees, charges, disbursements, expenses, allowances and remuneration;

“declared priority date” means –

- (a) the date of filing of the earliest relevant application specified in a declaration made for the purposes of section 17(2) where the



priority date claimed in the declaration has not been lost or abandoned and where the declaration has not been withdrawn before preparations for the publication of the application in suit have been completed by the Registry in accordance with section 27; or

- (b) where an international application for a patent (Brunei Darussalam) is to be treated as an application for a patent under the Order, the date of filing of the earliest application filed in or for a country which is a convention country or which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to such an application, the priority of which is claimed in a declaration filed for the purposes of Article 8 of the Patent Co-operation Treaty, provided that such priority claim has not been lost or abandoned under the provisions of that Treaty;

“initiation date” , in relation to a new application for a patent, means the date on which the application was initiated by the filing at the Registry of any document which satisfies any condition referred to in section 26(1)(a), (b) or (c);

- (2) In these Rules, except where otherwise indicated –
  - (a) references to a section are references to that section of the Order;
  - (b) references to a rule are references to that rule in these Rules;
  - (c) references to a Schedule are references to that Schedule to these Rules;and
  - (d) references to the filing of a form or other document are references to filing it at the Registry.

- (3) The Examiners prescribed for the purposes of section 2 shall be the Austrian Patent Office, the Danish Patent and Trademark Office and the Hungarian Patent Office.

**Fees.**

3. (1) The fees to be paid in respect of matters arising under the Order or these Rules shall be those prescribed in the First Schedule.

(2) Unless –

- (a) otherwise provided for in these Rules; or
- (b) the Registrar permits or directs otherwise,

where a fee is prescribed in the First Schedule in respect of any matter, the fee shall be paid at the same time as the filing of the form corresponding to the matter.

**Forms.**

4. (1) The Registrar shall publish in the journal –

- (a) the forms to be used for any purpose relating to –
  - (i) any application for or grant of a patent;
  - (ii) any proceedings before the Registrar under the Order or these Rules; or
  - (iii) any other matter under the Order or these Rules;
- (b) the Registrar's directions relating to the use of any form; and
- (c) any amendment or modification of any such form or direction.

(2) Any form may be modified on the direction of the Registrar for use in a case other than the case for which it is intended.

(3) Any reference in these Rules to a numbered form shall be construed as a reference to the current version of the form bearing the corresponding number which is –

- (a) described in the Second Schedule; and
- (b) published in the journal.

**Costs.**

5. The Registrar may make an order for costs in respect of –

- (a) any of the matters set out in the second column of Part I of the Third Schedule;
- and

(b) the expenses and allowances of a person in relation to proceedings under the Order or these Rules.

**Taxation of costs.**

6. (1) Where the Registrar has made an order for costs in favour of a party to proceedings before the Registrar and the party wishes to have party and party costs taxed by the Registrar, the party shall, within one month from the date of the order for costs –

(a) apply for the costs to be taxed by filing a copy of the bill of costs; and

(b) send at the same time a copy of the bill of costs to every other person entitled to be heard in the taxation proceedings.

(2) Every bill of costs shall set out in 2 separate sections the following –

(a) work done in the cause or matter; and

(b) all disbursements made in the cause or matter.

(3) The costs claimed under sub-rule (2) shall set out the sum claimed for each item.

(4) The bill of costs shall set out in chronological order, with dates, all relevant events in the cause or matter.

(5) Where costs have already been awarded for any of the events set out, this fact and the amount awarded shall be indicated.

(6) Any party on whom a copy of the bill of costs has been served in accordance with sub-rule (1) shall, if he wishes to dispute the bill, within 14 days from the receipt of the copy of the bill, mark the copy thereof in accordance with sub-rule (7) and send a copy thereof duly marked to both the Registrar and the party requesting for taxation.

(7) A party on whom a copy of the bill of costs has been served shall effect marking on the copy thereof served by writing on the right hand margin against each item the word “Agree” if he agrees with the cost claimed for that item or the word “Disagree” if he disagrees.

(8) Upon the expiry of the period of time referred to in sub-rule (6), the Registrar shall give to the parties entitled to be heard in the taxation proceedings notice of the date and time appointed for taxation.

**Taxation proceedings.**

7. (1) If any party entitled to be heard in any taxation proceedings before the Registrar does not attend at the time appointed for the taxation, the Registrar may proceed with the taxation.

(2) The Registrar may, if he thinks it is necessary to do so, adjourn the proceedings from time to time.

(3) The provisions relating to the scale of costs in the Third Schedule shall apply to the taxation proceedings.

(4) When the bill has been taxed, the Registrar shall proceed to make his certificate for the amount of the taxed costs.

(5) Costs awarded in proceedings before the Registrar are not intended to compensate the parties for the expense to which they have been put.

**International exhibitions.**

8. (1) An applicant for a patent who wishes the disclosure of matter constituting an invention to be disregarded in accordance with section 14(4)(c) shall, within the same day of filing the application for the patent, inform the Registrar in writing that the invention has been displayed at an international exhibition.

(2) The applicant shall, within 4 months from the day of filing the application, file a certificate, issued by the authority responsible for the exhibition, stating that the invention was in fact exhibited there.

(3) The certificate shall also state the opening date of the exhibition and, where the first disclosure of the invention did not take place on the opening date, the date of the first disclosure.

(4) The certificate shall be accompanied by an identification of the invention, duly authenticated by the authority.

(5) For the purposes of section 2(2), a statement may be published in the journal that an exhibition described in the statement falls within the definition of international exhibition in section 2(1).

(6) In the case of an international application for a patent (Brunei Darussalam), the application of this rule shall be subject to rule 92(5).

**Declaration of priority for purposes of section 17(2).**

9. (1) Subject to sub-rule (2), a declaration for the purposes of section 17(2) made in or in connection with an application for a patent (referred to in this rule and rules 10 and 11 as the application in suit) shall be made at the time of filing the application in suit.

(2) A declaration for the purposes of section 17(2) may be made after the date of filing if –

- (a) it would cause –
  - (i) the application in suit to have a declared priority date, where there was none previously; or
  - (ii) the declared priority date of the application in suit to be brought forward to an earlier date;
- (b) it is made within 16 months from –
  - (i) where paragraph (a)(i) applies, the declared priority date; or
  - (ii) where paragraph (a)(ii) applies, the earlier date;
- (c) it is made on Patents Form 62;
- (d) the prescribed fee has been paid; and
- (e) the condition referred to in sub-rule (4) is satisfied.

(3) Where a request to the Registrar to correct a mistake in a declaration for the purposes of section 17(2) would, if granted, cause the declared priority date to be changed to a different date, the request shall not be granted unless –

- (a) it is made within 16 months from the declared priority date, as changed;
- (b) it is made on Patents Form 62;
- (c) the prescribed fee has been paid; and
- (d) the condition referred to in sub-rule (4) is satisfied.

(4) For the purposes of sub-rules (2)(e) and (3)(d), the condition is that –

- (a) the applicant has not made any request under section 27(2) to publish the application in suit during the period prescribed for the purposes of section 27; or
- (b) any such request has been withdrawn.

(5) Subject to sub-rule (6), a declaration for the purposes of section 17(2) shall specify, in respect of each priority application –

- (a) the date of filing of the priority application; and
- (b) the country in or for which the priority application was made.

(6) Where the application in suit is an international application for a patent (Brunei Darussalam), sub-rule (5) shall not apply in respect of a priority application if –

- (a) the date of filing of that priority application; and
- (b) the country in or for which that priority application was made,

have been indicated in compliance with rule 4.10(a) and (b) of the Rules under the Patent Co-operation Treaty.

(7) Where section 26(11) applies, a declaration for the purposes of section 17(2) shall not be made in or in connection with a new application referred to in section 26(11) if the declaration has not also been made in or in connection with the earlier application.

(8) In this rule and rules 10 and 11 –

“priority application” means an earlier relevant application specified in a declaration for the purposes of section 17(2);

“relevant application” has the same meaning as in section 17(9).

**Request to Registrar for permission to make late declaration under section 17(4).**

- 10.** (1) The period prescribed for the purposes of section 17(3)(b) shall be 2 months.
- (2) For the purposes of section 17(6)(a), a request under section 17(4) shall –
- (a) subject to rule 92(4), be made before the end of the period referred to in section 17(3)(b);
  - (b) be made on Patents Form 62;
  - (c) be made only if the prescribed fee has been paid;
  - (d) if the applicant failed to file the application in suit within the period referred to in section 17(3)(a), state the reason for the failure to file the application in suit within that period; and
  - (e) be made only if –
    - (i) the request relates to an international application for a patent (Brunei Darussalam); or
    - (ii) where the request does not relate to an international application for a patent (Brunei Darussalam), the condition referred to in sub-rule (3) is satisfied.
- (3) For the purposes of paragraph (2)(e)(ii), the condition is that –
- (a) the applicant has not made any request under section 27(2) to publish the application in suit during the period prescribed for the purposes of section 27; or
  - (b) any such request has been withdrawn.
- (4) Where the Registrar determines that every applicable condition referred to in section 17(6) for granting a request under section 17(4) has been satisfied, the Registrar shall grant the request and notify the applicant accordingly.

(5) Where the condition referred to in section 17(6)(b) for granting a request under section 17(4) has not been satisfied, the Registrar shall notify the applicant that the Registrar intends to refuse the request unless –

(a) observations are made or evidence is filed, within 2 months from the date of the notification, to satisfy the Registrar that the applicant's failure to file the application in suit within the period referred to in section 17(3)(a) –

- (i) occurred in spite of due care required by the circumstances having been taken; or
- (ii) was unintentional; and

(b) the Registrar is so satisfied on the observations made or evidence filed.

(6) Where sub-rule (5) applies, the Registrar shall refuse the request under section 17(3), and shall inform the applicant accordingly, if –

(a) the applicant fails to make the observations or file the evidence within 2 months from the date of the Registrar's notification; or

(b) the Registrar is not satisfied, on all the observations made and evidence filed, that the applicant's failure to file the application in suit within the period referred to in section 17(3)(a) –

- (i) occurred in spite of due care required by the circumstances having been taken; or
- (ii) was unintentional.

**Furnishing of application or file number and of priority documents to support declaration under section 17(2).**

**11.** (1) Subject to sub-rule (3), the applicant shall, before the end of the period of 16 months from the declared priority date, furnish to the Registry the application or file number of each priority application.

(2) Subject to sub-rule (3), if the applicant fails to comply with sub-rule (1) in respect of any priority application, the declaration for the purposes of section 17(2) shall be disregarded in so far as it relates to that priority application.



(3) Where the application in suit is an international application for a patent (Brunei Darussalam), sub-rules (1) and (2) shall not apply in respect of any priority application the application or file number of which has been indicated in compliance with rule 4.10(a) of the Rules under the Patent Co-operation Treaty.

(4) Where the Registrar, by notice sent to the applicant or proprietor, as the case may be, requires him to furnish to the Registry, in respect of any priority application, a copy of that priority application which is –

- (a) duly certified by the authority with which it was filed; or
- (b) otherwise acceptable to the Registrar,

the applicant or proprietor, as the case may be, shall, within 2 months from the date of the notice –

- (i) comply with the Registrar's requirement; or
- (ii) if a copy of that priority application is kept at the Registry, as an alternative to complying with the Registrar's requirement, file –
  - (A) a request that a copy of that priority application be prepared; and
  - (B) Patents Form 31 requesting the Registrar to certify the prepared copy.

(5) If the applicant or proprietor, as the case may be, fails to comply with sub-rule (4) in respect of any priority application, the declaration for the purposes of section 17(2) shall be disregarded in so far as it relates to that priority application.

#### **Translation of priority documents.**

**12.** (1) Where –

- (a) a copy of any priority application is furnished under rule 11(4);
- (b) that priority application is in a language other than the English language;
- (c) the validity of the claim to priority is relevant to determining whether the invention concerned is patentable; and

(d) the Registrar, by notice sent to the applicant or proprietor, as the case may be, requires him to furnish to the Registry an English translation of that priority application,

the applicant or proprietor, as the case may be, shall, within 2 months from the date of the notice –

- (i) furnish to the Registry both of the following at the same time –
  - (A) an English translation of that priority application;
  - (B) a copy of a verification document –
    - (BA) made in accordance with the Registrar's requirements; and
    - (BB) verifying that the translation corresponds to the original text of that priority application; or
- (ii) if an English translation of that priority application is kept at the Registry, as an alternative to complying with the Registrar's requirement, file –
  - (A) a request that a copy of the translation be prepared; and
  - (B) Patents Form 31 requesting the Registrar to certify the prepared copy.

(2) The Registrar may, by notice, require to be filed at the Registry or sent to the Registrar, within such period as may be specified in the notice, the original of the verification document.

- (3) If the applicant or proprietor, as the case may be, fails to comply with –
- (a) sub-rule (1) in respect of any priority application; or
  - (b) the Registrar's requirement under sub-rule (2) in respect of any verification document relating to any priority application,

the declaration for the purposes of section 17(2) shall be disregarded in so far as it relates to that priority application.

## RIGHT TO APPLY FOR AND OBTAIN A PATENT

### References under section 20(1)(a).

**13.** (1) A reference under section 20(1)(a) shall be made on Patents Form 2 and shall be accompanied by a copy thereof and a statement setting out fully the nature of the question, the facts upon which the person making the reference relies and the order or other relief which he is seeking.

(2) The Registrar shall send a copy of the reference and statement to –

(a) any person (other than the person referred to in sub-rule (1)) alleged in the reference to be entitled to be granted a patent for the invention;

(b) any person (not being a party to the reference) who is shown in the register as having a right in or under the patent application;

(c) any person (not being a party to the reference) who is an applicant for the patent or has given notice to the Registrar of a relevant transaction, instrument or event; and

(d) every person who has been identified in the application for a patent or a statement filed under section 24(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention.

(3) If any person who is sent a copy of the reference and statement under sub-rule (2) wishes to oppose the making of the order or the granting of the relief sought, he (“the opponent”) shall, within 2 months from the date of the Registrar’s letter forwarding such copies, file a counter-statement on Patents Form 3 setting out fully the grounds of his opposition and the Registrar shall send a copy of the counterstatement to the person making the reference and to those recipients of the copy of the reference and statement who are not party to the counter-statement.

(4) The person making the reference or any such recipient may, within 2 months from the date of the Registrar’s letter forwarding a copy of the counter-statement, file evidence in support of his case and shall send a copy of the evidence –

(a) in any case, to the opponent; and

(b) in the case of evidence filed by such a recipient, to the person making the reference.

(5) Within 2 months from the date of the Registrar's letter forwarding the copy of such evidence to him or, if no such evidence is filed, within 2 months from the expiration of the period within which the copy of such evidence could have been filed, the opponent may file evidence in support of his case and shall send a copy of the evidence so filed to the person making the reference and those recipients; and, within 2 months from the date of receipt of the copy of the opponent's evidence, that person or any of those recipients may file further evidence confined to matters strictly in reply and shall send a copy of it to the persons mentioned in sub-rule (4)(a) and (b).

(6) No further evidence shall be filed except by leave or direction of the Registrar.

(7) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**References by co-proprietors under section 20(1)(b).**

**14.** (1) A reference under section 20(1)(b) shall be made on Patents Form 2 and shall be accompanied by a copy thereof and a statement setting out fully the nature of the question, the facts relied upon by the co-proprietor making the reference and the order he is seeking.

(2) The Registrar shall send a copy of the reference and statement to –

(a) each co-proprietor who is not a party to the reference and who has not otherwise indicated, in writing, his consent to the making of the order sought;

(b) any person to whom it is alleged in the reference that any right in or under an application for a patent should be transferred or granted;

(c) any person (not being a party to the reference) who is shown in the register as having a right in or under the patent application;

(d) any person (not being a party to the reference) who has given notice to the Registrar of a relevant transaction, instrument or event; and

(e) every person who has been identified in the application for the patent or a statement filed under section 24(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention.

(3) Any person who receives a copy of the reference and statement and who wishes to oppose the order sought may, within 2 months from the date of the Registrar's letter forwarding copies of the reference and statement, file a counter-statement on Patents Form 3 setting out fully the grounds of his opposition.

(4) The Registrar shall, as appropriate, send a copy of any counter-statement to –  
(a) each co-proprietor who is a party to the reference; and  
(b) any person to whom a copy of the reference and statement were sent pursuant to sub-rule (2).

(5) Any person who receives a copy of the counter-statement may, within 2 months from the date of the Registrar's letter forwarding such copy, file evidence in support of his case and shall send a copy of the evidence so filed to the co-proprietor making the reference and to each person who has filed a counter-statement.

(6) Any person entitled to receive a copy of the evidence filed under sub-rule (5) may, within 2 months from the date of receipt of the copy of such evidence or, if no such evidence is filed, within 2 months from the expiration of the period within which it could have been filed, file evidence in support of his case and shall send a copy of the evidence so filed to each of the other parties listed in sub-rule (4).

(7) Any person who receives a copy of the evidence filed under sub-rule (6) may, within 2 months from the date of receipt of the copy of such evidence, file further evidence confined to matters strictly in reply and shall, as appropriate, send a copy of the evidence so filed to the parties listed in sub-rule (4).

(8) No further evidence shall be filed by any party except by leave or direction of the Registrar.

(9) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Orders under section 20.**

**15.** (1) Where an order is made under section 20 that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant, the Registrar shall notify all original applicants and their licensees, of whom he is aware, of the making of the order.

(2) A person notified under sub-rule (1) may make a request under section 23(3) within 2 months from the date of the notification received from the Registrar.

**Prescribed period for new application under section 20(3).**

**16.** The prescribed period for the purpose of section 20(3) shall be 3 months from the day on which the time for appealing from an order made under that subsection expires without an appeal being brought or, where an appeal is brought, from the day on which it is finally disposed of.

**Authorisation under section 20(5).**

**17.** (1) An application under section 20(5) for authority to do anything on behalf of a person to whom directions have been given under section 20(2)(d) or (4) shall be made on Patents Form 4 and shall be accompanied by a copy thereof and a statement setting out fully all the facts upon which the applicant relies and the nature of the authorisation sought.

(2) The Registrar shall send a copy of the application and statement to the person alleged to have failed to comply with the directions.

(3) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Request by joint applicants under section 22.**

18. (1) A request under section 22 by a joint applicant shall be made on Patents Form 5 and shall be accompanied by a copy thereof and a statement setting out fully the facts upon which he relies and the directions which he seeks.

(2) The Registrar shall send a copy of the request and statement to each of the other joint applicant who shall, if he wishes to oppose the request, within 2 months from the date of the Registrar's letter forwarding such copies to him, file a counter-statement on Patents Form 3 setting out fully the grounds of his opposition, and the Registrar shall send a copy of the counter-statement to the person making the request and to each of the other joint applicant who is not a party to the counter-statement.

(3) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Referral to Registrar under section 23.**

19. (1) Where, following the making of such an order as is mentioned in section 23(3), a question is referred to the Registrar under section 23(5) as to whether any person is entitled to be granted a licence or whether the period or terms of the licence are reasonable, the reference shall be made on Patents Form 6 and shall be accompanied by a copy thereof and a statement setting out fully the facts upon which the person making the reference relies and the terms of the licence which he is prepared to accept or grant.

(2) The Registrar shall send a copy of the reference and statement to every person in whose name the application is to proceed or, as the case may be, every person claiming to be entitled to be granted a licence, in either case not being the person who makes the reference, and if any recipient does not agree to grant or accept a licence for such period and upon such terms, he shall, within 2 months from the date of the Registrar's letter forwarding such copies to him, file a counter-statement on Patents Form 3 setting out fully the grounds of his opposition and the Registrar shall send a copy of the counter-statement to the person making the reference.

(3) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

## INVENTORS

### **Mention of inventor.**

**20.** (1) An application to the Registrar under section 24(1) or (3) by any person who alleges –

(a) that he ought to have been mentioned as the inventor or joint inventor of an invention in any patent granted or published application for a patent for the invention; or

(b) that any person mentioned as sole or joint inventor in any patent granted or published application for a patent for the invention ought not to have been so mentioned,

shall be made on Patents Form 7 and shall be accompanied by a statement setting out fully the facts relied upon.

(2) The Registrar shall send a copy of any such application and statement to –

(a) every person registered as proprietor of, or applicant for, the patent (other than the applicant under section 24 himself);

(b) every person who has been identified in the application for the patent or a statement filed under section 24(2)(a) as being, or being believed to be, the inventor or joint inventor of the invention; and

(c) every other person whose interests the Registrar considers may be affected by the application.

(3) Any recipient of a copy of such an application and statement who wishes to oppose the application shall, within 2 months from the date of the Registrar's letter forwarding such copies to him, file a counter-statement on Patents Form 3 setting out fully the grounds of his opposition, and the Registrar shall send a copy of the counter-statement to each of the persons described in this rule other than any person who is party to the counter-statement.



(4) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

(5) The document prescribed for the purposes of section 24(1) shall be an addendum or erratum slip.

**Procedure where applicant is not inventor or sole inventor.**

**21.** (1) Subject to rules 32 and 92(9) and (10), the period prescribed for the purposes of section 24(2) shall be –

(a) where there is no declared priority date, 16 months from the date of filing of the application for a patent; or

(b) where there is a declared priority date, 16 months from the declared priority date.

(2) A statement filed under section 24(2) shall be made on Patents Form 8.

(3) Where –

(a) the applicant is not the sole inventor; or

(b) the applicants are not the joint inventors of the invention,

and the application does not contain a declared priority date which relates to an earlier relevant application as defined in section 17(9)(b), the Registrar shall send a copy of the Patents Form 8 filed under sub-rule (1) to each inventor who is not one of the applicants.

(4) Where the application is an international application for a patent (Brunei Darussalam), the requirements of sub-rule (1) shall be treated as having been complied with if the provisions of rules 4.1(a)(iv) and 4.6 of the Rules under the Patent Co-operation Treaty have been complied with, whether or not there was any requirement that they be complied with.

## **APPLICATIONS FOR PATENTS**

**Application for grant of patent.**

**22.** (1) A request for the grant of a patent shall be made on Patents Form 1.

(2) Where a document containing an indication that a patent is sought in pursuance of an application is filed with the Registrar without Patents Form 1 or the filing fee, the Form shall be filed with, and the fee shall be paid to, the Registry within one month from the date of the filing of the document.

(3) The specification contained in an application for a patent made under section 25 shall state the title of the invention and continue with the description and the claim or claims and the drawings, if any, in that order.

(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 sub-rule, the Registrar may reframe it so that it does so comply.

(5) The description shall first state the title of the invention as appearing in the request and shall –

(a) specify the technical field to which the invention relates;

(b) indicate the background art which, as far as it is known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention;

(c) disclose the invention as claimed in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and shall state the advantageous effects, if any, of the invention with reference to the background art;

(d) briefly describe the figures in the drawings, if any;

(e) set forth at least one mode for carrying out the invention claimed, with examples where appropriate, and with reference to the drawings, if any; and

(f) indicate explicitly, when it is not otherwise obvious from the description or the nature of the invention, the way or ways in which the invention satisfies the condition in section 13(1)(c) of being capable of industrial application.

(6) The number of claims shall be reasonable in consideration of the nature of the invention claimed, and where there are several claims, the claims shall be numbered consecutively in Arabic numerals.

(7) The definition in the claim of the matter for which protection is sought shall be in terms of the technical features of the invention which may be expressed in structural, functional or mathematical terms.

(8) Claims shall be written –

(a) in 2 parts, the first part consisting of a statement indicating those technical features of the invention which are necessary in connection with the definition of the claimed subject-matter and which, in combination, appear to be part of the prior art and the second part preceded by the words “characterised in that”, “characterised by”, “wherein the improvement comprises”, or other words to the same effect, followed by a statement stating concisely the technical features which, in combination with the features stated in the first part, define the matter for which protection is sought; or

(b) in a single statement containing a recitation of a combination of several elements or steps, or a single element or step, which defines the matter for which protection is sought.

(9) Claims shall not rely, in respect of the technical features of the invention, on references to the description or drawings, unless such a reference is necessary for the understanding of the claim or enhances the clarity or conciseness of the claim.

(10) Where –

(a) the documents filed at the Registry to initiate an application for a patent include something which –

(i) is or appears to be a description of the invention for which the patent is sought; and

(ii) is in a language other than the English language; and

(b) the applicant has not filed an English translation of that thing, the Registrar shall notify the applicant that an English translation of that thing is required.

(11) Where the applicant has been notified under sub-rule (10), he shall, within 2 months from the date of the notification, file an English translation of that thing.

(12) If the applicant fails to comply with sub-rule (11), the Registrar shall refuse his application for a patent.

### **Micro-organisms.**

**23.** The Fourth Schedule shall have effect in relation to certain applications for patents, and granted patents, for inventions which require for their performance the use of micro-organisms.

### **Drawings.**

**24.** (1) Drawings forming part of an application for a patent made under section 25 shall be on sheets the size of which shall be A4 (29.7 cm x 21 cm).

(2) The sheets shall not contain frames round the usable or used surface.

(3) The minimum margins shall be as follows –

- (a) top: 2.5 cm;
- (b) left side: 2.5 cm;
- (c) right side: 1.5 cm; and
- (d) bottom: 1.0 cm.

(4) The margins, when submitted, must be completely blank.

(5) Drawings shall be executed as follows –

- (a) without colouring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;
- (b) cross-sections shall be indicated by oblique hatching which should not impede the clear reading of the reference signs and leading lines;
- (c) the scale of the drawings and the distinctiveness of their graphical execution shall be such that a photographic reproduction with a linear reduction in

size to two-thirds would enable all details to be distinguished without difficulty. If, as an exception, the scale is given on a drawing, it shall be represented graphically;

(d) all numbers, letters and reference lines, appearing on the drawings, shall be simple and clear and brackets, circles and inverted commas shall not be used in association with numbers and letters;

(e) each element of each figure shall be in proper proportion to each of the other elements in the figure, except where the use of a different proportion is indispensable for the clarity of the figure;

(f) the height of the numbers and letters shall not be less than 0.32 cm and for the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used;

(g) the same sheet of drawings may contain several figures; where figures drawn on 2 or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures; and the different figures shall be arranged without wasting space, clearly separated from one another and shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets;

(h) reference signs not mentioned in the description or claims shall not appear in the drawings, and *vice versa*; and the same features, when denoted by reference signs, shall throughout the application, be denoted by the same signs;

(i) the drawings shall not contain textual matter, except, when required for the understanding of the drawings, a single word or words such as “water”, “steam”, “open”, “closed”, “section on AA”, and in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords; and

(j) the sheets of drawings shall be numbered in accordance with rule 26(14) and (15).

(6) Flow sheets and diagrams shall be considered drawings for the purposes of these Rules.

### **Abstracts.**

**25.** (1) The abstract shall commence with a title for the invention.

(2) The abstract shall contain a concise summary of the disclosure as contained in the specification.

(3) The summary shall indicate the technical field to which the invention belongs and be drafted in such a way which allows a clear understanding of the technical problem to which the invention relates, the gist of the solution of that problem through the invention, and the principal use or uses of the invention.

(4) Where appropriate, the abstract shall also contain the chemical formula which, among those contained in the specification, best characterises the invention but shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(5) The abstract shall be as concise as the disclosure permits and shall normally not contain more than 150 words.

(6) If the specification contains any drawings, the applicant shall indicate on the abstract the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when published.

(7) The Registrar may decide to publish one or more other figures if he considers that they better characterise the invention.

(8) Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.

(9) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.

#### **Size and presentation of documents.**

**26.** (1) This rule shall apply to all documents (including drawings) making up an application for a patent, including any replacement thereof, to be filed with the Registry.

- (2) All documents referred to in sub-rule (1) shall be in the English language.
- (3) Unless otherwise provided, the specification (including any drawing therein), abstract and any replacement sheet thereof shall be filed singly.
- (4) All documents referred to in sub-rule (1) shall be so presented as to permit direct reproduction by photography, electrostatic or electronic processes, scanning, photo offset and microfilming, in an unlimited number of copies.
- (5) All sheets must be free from cracks, creases and folds.
- (6) Only one side of the sheet shall be used.
- (7) All documents referred to in sub-rule (1) shall be in A4 sheet size (29.7 cm x 21 cm) and shall be on pliable, strong, white, smooth, matt and durable paper.
- (8) Each sheet (other than drawings) shall be used with its short sides at the top and bottom (upright position).
- (9) The request for the grant of a patent, the description, claims, drawings and abstract shall each commence on a new sheet.
- (10) The sheets shall be so connected that they can be easily turned when consulted, and easily separated and joined again if they have been separated.
- (11) The minimum margins of the sheets containing the description, the claims and the abstract shall be as follows –
  - (a) top: 2.0 cm;
  - (b) left side: 2.5 cm;
  - (c) right side: 2.0 cm; and
  - (d) bottom: 2.0 cm.

(12) The margins of the documents making up the application, when filed, and of any replacement documents, must be completely blank.

(13) In the application, except in the drawings –

(a) all sheets in the request shall, when filed, be numbered consecutively;  
and

(b) all other sheets shall, when filed, be numbered consecutively as a separate series, and all such numbering shall be in Arabic numerals placed at the top or bottom of the sheet, in the middle, but not in the top or bottom margin.

(14) All sheets of drawings contained in the application shall be numbered consecutively as a separate series.

(15) Such numbering shall be in Arabic numerals placed at the top or bottom of the sheet, in the middle, but not in the top or bottom margin.

(16) Every document (other than drawings) referred to in sub-rule (1) shall be typed or printed in a dark, indelible colour in at least 1 1/2 line spacing and in characters of which the capital letters are not less than 0.21 cm high except that graphic symbols and characters and chemical and mathematical formulae may be written or drawn, in a dark indelible colour.

(17) The request for the grant of a patent, the description, claims and abstract shall not contain drawings.

(18) The description, claims and abstract may contain chemical or mathematical formulae.

(19) The description and the abstract may contain tables.

(20) The claims may contain tables only if their subject-matter makes the use of tables desirable.



(21) In all documents referred to in sub-rule (1), units of weights and measures shall be expressed in terms of the metric system.

(22) If a different system is used, units of weights and measures shall also be expressed in terms of the metric system.

(23) Temperatures shall be expressed in degrees Celsius.

(24) For the other physical values, the units recognised in international practice shall be used, for mathematical formulae the symbols in general use, and for chemical formulae the symbols, atomic weights and molecular formulae in general use shall be employed.

(25) In general, use should be made of technical terms, signs and symbols generally accepted in the field in question.

(26) If a formula or symbol is used in the specification, a copy thereof, prepared in the same manner as drawings, shall be furnished if the Registrar so directs.

(27) The terminology and the signs shall be consistent throughout the application.

(28) All documents referred to in sub-rule (1) shall be reasonably free from deletions and other alterations, over-writings and interlineations and shall, in any event, be legible.

(29) Non-compliance with this rule may be authorised by the Registrar if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

#### **Form of statements, counter-statements and evidence.**

**27.** Rule 26(4) to (8) shall apply, with the necessary modifications, to any statement, counter-statement or evidence filed, unless the Registrar directs otherwise.

**Unity of invention.**

**28.** (1) Notwithstanding section 25(5)(d), where 2 or more inventions are claimed (whether in separate claims or as alternatives within a single claim), such inventions shall be treated as being so linked as to form a single inventive concept only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

(2) In this rule, “special technical features” means those technical features which define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

**Certain matters prescribed under section 26.**

**29.** (1) The information on an earlier relevant application prescribed for the purposes of section 26(1)(c)(ii)(B) shall be –

- (a) the date of filing of the earlier relevant application; and
- (b) the country in or for which the earlier relevant application was made.

(2) The period prescribed for the purposes of section 26(3)(b) shall be 2 months from the date of the Registrar’s notification under section 26(3)(a).

(3) The period prescribed for the purposes of section 26(7) shall be –

- (a) subject to paragraph (b), 3 months from the date of filing of the application for a patent; or
- (b) where a new application has been filed under section 20(3), 26(11) or 48(4), 3 months from the initiation date.

(4) The documents prescribed for the purposes of section 26(7)(c) shall be –

- (a) either of the following –
  - (i) a copy of the earlier relevant application referred to in section 26(1)(c)(ii)(C) which is –
    - (A) duly certified by the authority with which it was filed;
    - or
    - (B) otherwise acceptable to the Registrar;

- (ii) if a copy of that earlier relevant application is kept at the Registry –
    - (A) a request that a copy of that earlier relevant application be prepared; and
    - (B) Patents Form 31 requesting the Registrar to certify the prepared copy;
  - (b) where the earlier relevant application referred to in section 26(1)(c)(ii)(C) is in a language other than the English language, either of the following –
    - (i) an English translation of that earlier relevant application;
    - (ii) if an English translation of that earlier relevant application is kept at the Registry –
      - (A) a request that a copy of the translation be prepared; and
      - (B) Patents Form 31 requesting the Registrar to certify the prepared copy; and
  - (c) Patents Form 61.
- (5) The period prescribed for the purposes of section 26(12)(a) shall be –
- (a) subject to paragraph (b) –
    - (i) where there is no declared priority date, 12 months from the date of filing of the application for a patent; or
    - (ii) where there is a declared priority date, whichever following period expires later –
      - (A) 12 months from the declared priority date; or
      - (B) 2 months from the date of filing of the application; or
  - (b) where a new application has been filed under section 20(3), 26(11) or 48(4), 2 months from the initiation date.

**Missing parts.**

- 30.** (1) The period prescribed for the purposes of section 26(8) shall be –
- (a) if the applicant makes a request under section 26(9)(b)(i) –
    - (i) subject to sub-paragraph (ii), 3 months from the date of filing of the application for a patent; or

- (ii) where a new application has been filed under section 20(3), 26(11) or 48(4), 3 months from the initiation date; or
  - (b) if the applicant does not make any request under section 26(9)(b)(i), any time before payment of the fee for the grant of the patent.
- (2) For the purposes of section 26(8), if the applicant makes a request under section 26(9)(b)(i), any missing part of an application for a patent shall be filed on Patents Form 61.
- (3) An applicant may only withdraw a missing part by giving written notice to the Registrar.
- (4) The period prescribed for the purposes of section 26(9)(b) shall be –
  - (a) subject to paragraph (b), 3 months from the date of filing of the application for a patent; or
  - (b) where a new application has been filed under section 20(3), 26(11) or 48(4), 3 months from the initiation date.
- (5) Any request under section 26(9)(b)(i) shall –
  - (a) be made at the time the applicant files any missing part of the application under section 26(8);
  - (b) be accompanied by –
    - (i) the statement under section 26(9)(b)(ii);
    - (ii) the information under section 26(9)(b)(iii); and
    - (iii) the documents under section 26(9)(b)(iv); and
  - (c) be considered never to have been made unless every requirement under section 26(9) has been complied with.
- (6) The information on an earlier relevant application prescribed for the purposes of section 26(9)(b)(iii) shall be –
  - (a) the date of filing of the earlier relevant application;
  - (b) the application or file number of the earlier relevant application; and
  - (c) the country in or for which the earlier relevant application was made.

- (7) The documents prescribed for the purposes of section 26(9)(b)(iv) shall be –
- (a) either of the following –
    - (i) a copy of the earlier relevant application referred to in section 26(9)(a) which is –
      - (A) duly certified by the authority with which it was filed;  
or
      - (B) otherwise acceptable to the Registrar;
    - (ii) if a copy of that earlier relevant application is kept at the Registry –
      - (A) a request that a copy of that earlier relevant application be prepared; and
      - (B) Patents Form 31 requesting the Registrar to certify the prepared copy; and
  - (b) where the earlier relevant application referred to in section 26(9)(a) is in a language other than the English language, either of the following –
    - (i) an English translation of that earlier relevant application or of every part of that earlier relevant application in which the missing part of the application for a patent is contained;
    - (ii) if an English translation of that earlier relevant application, or of every part of that earlier relevant application in which the missing part of the application for a patent is contained, is kept at the Registry –
      - (A) a request that a copy of the translation be prepared; and
      - (B) Patents Form 31 requesting the Registrar to certify the prepared copy.

**New applications under section 26(11).**

**31.** (1) Subject to sub-rules (2), (3) and (4), a new application for a patent which includes a request that it be treated as having as its date of filing the date of filing of an earlier application may be filed in accordance with section 26(11) –

- (a) of the applicant's own volition; or
- (b) to comply with the requirements of section 25(5)(d).

- (2) Such new application shall in any event be made –
- (a) before the earlier application has been refused, withdrawn or treated as having been abandoned; and
  - (b) before all the conditions in section 30(2) and (3) are satisfied.

(3) Where possible, the description and drawings of the earlier application and the new application shall respectively relate only to the matter for which protection is sought by that application.

(4) Where it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a reference by number to that other application.

#### **Extension of period for filing new applications.**

**32.** Where a new application is filed under section 20(3), 26(11) or 48(4) –

- (a) the requirement under rule 9(1) shall be complied with on the initiation date;
- (b) after the expiry of the period referred to in rule 9(2)(b), the requirements under rule 9(2)(c) and (d) shall be complied with on the initiation date;
- (c) after the expiry of the period referred to in rule 9(3)(a), the requirements under rule 9(3)(b) and (c) shall be complied with on the initiation date;
- (d) after the expiry of the period referred to in rule 10(2)(a), the requirements under rule 10(2)(b), (c) and (d) shall be complied with on the initiation date;
- (e) after the expiry of the period referred to in rule 11(1), the requirement under rule 11(1) shall be complied with on the initiation date;
- (f) after the expiry of the period referred to in rule 21(1), the requirement under section 24(2) read with rule 21(2) shall be complied with on the initiation date; and
- (g) the requirements under 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 paragraph 1(3) of that Schedule or the initiation date, whichever is the later.

**Publication of applications.**

**33.** (1) Subject to sub-rules (2), (3) and (4), an application for a patent shall be published for the purposes of section 27 as soon as possible after the expiration of 18 months from the declared priority date or, where there is no declared priority date, the date of filing the application.

(2) Where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, the period prescribed for the purposes of section 27 shall be 18 months from the declared priority date for the earlier application or, where there is no declared priority date, the date of filing the earlier application.

(3) A request for early publication of an application in accordance with section 27(2) shall be made on Patents Form 9.

(4) No application for a patent may be published if it is –  
(a) withdrawn by filing Patents Form 10; or  
(b) treated as having been abandoned or refused,  
earlier than one month preceding the expiration of the time period applicable under sub-rule (1) or (2).

**Completion of preparations for publication.**

**34.** The Registrar may determine when the preparations for publication of an application for a patent are to be treated as having been completed.

**PROCEDURE FOR GRANT**

**Address for service.**

**35.** Every person concerned in any proceedings to which these Rules relate and every proprietor of a patent shall furnish to the Registrar an address for service in Brunei Darussalam and that address may be treated for all purposes connected with such proceedings or patent as the address of the person concerned in the proceedings or the proprietor of the patent.

### **Formal requirements.**

- 36.** (1) The following shall be formal requirements for the purposes of the Order –
- (a) the requirements of rule 22(1) and (4);
  - (b) the requirements laid down in rules 24(1), (2), (3), (4), (5) (other than those contained in sub-rule (5)(h)), 25 and 26 (other than those contained in sub-rules (19), (20) and (26));
  - (c) the requirements of rule 35; and
  - (d) the filing of an abstract referred to in section 25(3)(c).

(2) Where the application is an international application for a patent (Brunei Darussalam) which, by virtue of section 82, is to be treated as an application for a patent under the Order, the requirements of rules 19(1), 21, 22 and 23 shall be treated as having been complied with to the extent that the requirements of the corresponding provisions of the Rules under the Patent Co-operation Treaty, have been fulfilled.

### **Preliminary examination.**

**37.** (1) Where, on a preliminary examination of an application for a patent (referred to in this sub-rule as the application in suit), the Registrar finds that a declaration for the purposes of section 17(2) specifies a date of filing for an earlier relevant application which is more than 12 months before the date of filing of the application in suit, the Registrar shall notify the applicant accordingly.

- (2) The period prescribed for the purposes of section 28(8) shall be –
- (a) if the applicant makes a request under section 28(9)(b)(i), 3 months from the date of the Registrar's notification under section 28(7); or
  - (b) if the applicant does not make any request under section 28(9)(b)(i), any time before payment of the fee for the grant of the patent.

(3) For the purposes of section 28(8), if the applicant makes a request under section 28(9)(b)(i), the drawing or part of the description of the invention that is missing from the application shall be filed on Patents Form 61.



(4) An applicant may only withdraw the drawing or part of the description of the invention that is missing from the application by giving written notice to the Registrar.

(5) The period prescribed for the purposes of section 28(9)(b) shall be 3 months from the date of the Registrar's notification under section 28(7).

(6) Any request under section 28(9)(b)(i) shall –

(a) be made at the time the applicant files the drawing or part of the description of the invention that is missing from the application under section 28(8);

(b) be accompanied by –

(i) the statement under section 28(9)(b)(ii);

(ii) the information under section 28(9)(b)(iii); and

(iii) the documents under section 28(9)(b)(iv); and

(c) be considered never to have been made unless every requirement under section 28(9) has been complied with.

(7) The information on an earlier relevant application prescribed for the purposes of section 28(9)(b)(iii) shall be –

(a) the date of filing of the earlier relevant application;

(b) the application or file number of the earlier relevant application; and

(c) the country in or for which the earlier relevant application was made.

(8) The documents prescribed for the purposes of section 28(9)(b)(iv) shall be –

(a) either of the following–

(i) a copy of the earlier relevant application referred to in section 28(9)(a) which is –

(A) duly certified by the authority with which it was filed;

or

(B) otherwise acceptable to the Registrar;

(ii) if a copy of that earlier relevant application is kept at the Registry –

(A) a request that a copy of that earlier relevant application be prepared; and

- (B) Patents Form 31 requesting the Registrar to certify the prepared copy; and
- (b) where the earlier relevant application referred to in section 28(9)(a) is in a language other than the English language, either of the following –
- (i) an English translation of that earlier relevant application or of every part of that earlier relevant application in which the drawing or part of the description of the invention that is missing from the application for a patent is contained;
  - (ii) if an English translation of that earlier relevant application, or of every part of that earlier relevant application in which the drawing or part of the description of the invention that is missing from the application for a patent is contained, is kept at the Registry –
    - (A) a request that a copy of the translation be prepared; and
    - (B) Patents Form 31 requesting the Registrar to certify the prepared copy.

**Request for search report.**

**38.** A request for a search report under section 29(2)(a) shall be made on Patents Form 11.

**Request for search and examination report.**

**39.** A request for a search and examination report under section 29(2)(b) shall be made on Patents Form 12.

**Period for filing request for search report.**

**40.** (1) The period prescribed for the purposes of section 29(2)(a) shall be –

- (a) if the application contains no declared priority date, 13 months from the date of filing; or
- (b) if the application contains a declared priority date, 13 months from the declared priority date.

(2) Notwithstanding sub-rule (1), where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, the period prescribed for the purposes of section 29(2)(a) shall be 13 months from the actual date of filing of the new application.

**Minimum documentation for search.**

**41.** (1) The documentation prescribed for the purposes of section 29(3) and (6) (referred to in this sub-rule as the minimum documentation) shall consist of –

- (a) the patents issued by or registered in Brunei Darussalam;
- (b) the patent applications published in Brunei Darussalam;
- (c) the national patent documents as specified in sub-rule (3); and
- (d) the published international (Patent Co-operation Treaty) applications.

(2) The documentation prescribed for the purposes of section 39(7) (referred to in this sub-rule as the minimum documentation) shall consist of –

- (a) the patents issued by or registered in Brunei Darussalam;
- (b) the patent applications published in Brunei Darussalam;
- (c) the national patent documents as specified in sub-rule (3); and
- (d) the published international (Patent Co-operation Treaty) applications.

(3) Subject to sub-rules (4) and (5), the national patent documents shall be the following –

- (a) the patents issued by Australia, France, the former Reichspatentamt of Germany, Japan, Switzerland (in French and German languages only), the United Kingdom and the United States of America;
- (b) the patents issued by the Federal Republic of Germany; and
- (c) the patent applications, if any, published in the countries referred to in paragraphs (a) and (b).

(4) The patent documents of Japan, for which no abstracts in the English language are generally available, need not form part of the minimum documentation referred to in sub-rule (1) or (2).

(5) Only those patents issued and those patent applications published, after a date not more than 50 years before the declared priority date or, where there is no declared priority date, the date of filing of the application being subjected to a search, need form part of the minimum documentation referred to in sub-rule (1) or (2).

**Prescribed patent offices.**

**42.** The patent offices prescribed for the purposes of the definitions of “corresponding application” and “corresponding patent” in section 2(1) and section 29(2)(c) shall be –

(a) those of Australia, Canada (in respect of applications for a Canadian patent filed in the English language), Japan, New Zealand, Republic of Korea, the United Kingdom and the United States of America; and

(b) the European Patent Office (in respect of applications for a European patent filed in the English language).

**Request for examination report.**

**43.** (1) A request for an examination report under section 29(2)(c)(i), (d)(i) or (e)(i) or (4) shall be made on Patents Form 16.

(2) A request for an examination report under section 29(2)(c)(i), (d)(i) or (e)(i) shall not be treated as having been made unless the form required under sub-rule (1) is accompanied by –

(a) in the case of a request for an examination report under section 29(2)(c)(i), a copy of the search report referred to in section 29(2)(c)(i) together with each of the documents referred to in that search report;

(b) in the case of a request for an examination report under section 29(2)(d)(i), a copy of the international search report in respect of the corresponding international application referred to in section 29(2)(d)(i) together with a copy of each of the documents referred to in that international search report;

(c) in the case of a request for an examination report under section 29(2)(e)(i), a copy of the international search report in respect of the application referred to in section 29(2)(e)(i) together with a copy of each of the documents referred to in that international search report;

(d) a list of references to the patent family members as corresponding to each of the non-English documents cited in the search report referred to in section 29(2)(c)(i) or the international search report referred to in section 29(2)(d)(i) or (e)(i); and

(e) where any list of references to the patent family members referred to in paragraph (d), or

any part of that list, is in a language other than the English language, an English translation of that list or part.

(3) Where –

(a) an applicant has filed a request for an examination report under section 29(2)(c)(i), (d)(i) or (e)(i); and

(b) any document referred to in the search report or international search report, as the case may be, is in a language other than the English language,

the Registrar may require the applicant to furnish, within such period as the Registrar may specify –

(i) an English translation of the whole or any part of that document; and

(ii) a copy of a verification document –

(A) made in accordance with the Registrar's requirements; and

(B) verifying that the translation corresponds to the original text of that document or part thereof.

(4) Where an applicant fails to comply with the Registrar's requirements under sub-rule (3)(i) and (ii) within the period specified by the Registrar, the request for an examination report shall be treated as having been abandoned.

#### **Reliance on international preliminary report on patentability.**

**44.** A notice of intention to rely on an international preliminary report on patentability under section 29(2)(e)(ii) shall be filed using Patents Form 15.

**Period prescribed under section 29(2)(b) to (e) or (4).**

**45.** (1) Subject to sub-rules (2) and (3), the period prescribed for filing a request for a search and examination report under section 29(2)(b) or a request for an examination report under section 29(2)(c)(i), (d)(i) or (e)(i) or (4) shall be –

(a) subject to paragraph (b), 21 months from –

(i) the declared priority date; or

(ii) where there is no declared priority date, the date of filing of the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), 21 months from the actual date of filing of the new application.

(2) Subject to sub-rule (3), where the Registrar sends the applicant a copy of the search report under section 29(3)(b) at any time later than one month before the expiry of the period prescribed under sub-rule (1)(a) or (b), as the case may be, the period prescribed for filing a request for an examination report under section 29(4) shall be one month from the date of the Registrar's notification under section 29(3)(b).

(3) Where a request under sections 29(7) and 30(1)(a) to extend a prescribed period under section 29(2)(b), (c)(i), (d)(i) or (e)(i) or (4) and the corresponding prescribed period under section 30(1)(a) is filed in accordance with rule 50(1), the period prescribed for filing a request for a search and examination report under section 29(2)(b) or a request for an examination report under section 29(2)(c)(i), (d)(i) or (e)(i) or (4) shall be the prescribed extended period under section 29(7) for performing that act.

(4) Subject to sub-rule (5), the period prescribed for filing the prescribed information relating to a corresponding application under section 29(2)(c)(ii), the prescribed information relating to a corresponding international application under section 29(2)(d)(ii) or a notice in Patents Form 15 under section 29(2)(e)(ii) shall be –

(a) subject to paragraph (b), 42 months from –

(i) the declared priority date of the application; or

(ii) where there is no declared priority date, the date of filing of the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), 42 months from the actual date of filing of the new application, or the date on which section 30(2)(c) is complied with and the prescribed fee for the grant of a patent is paid in accordance with rule 49(3), whichever is the earlier.

(5) Where a request under sections 29(7) and 30(1)(a) to extend a prescribed period under section 29(2)(c)(ii), (d)(ii) or (e)(ii) and the corresponding prescribed period under section 30(1)(a) is filed in accordance with rule 50(1), the period prescribed for filing the prescribed information relating to a corresponding application under section 29(2)(c)(ii), the prescribed information relating to a corresponding international application under section 29(2)(d)(ii) or a notice in Patents Form 15 under section 29(2)(e)(ii) shall be –

(a) subject to paragraph (b), 39 months from –

(i) the declared priority date of the application; or

(ii) where there is no declared priority date, the date of filing of the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), 39 months from the actual date of filing of the new application.

**Information prescribed under section 29(2)(c)(ii) or (d)(ii).**

**46.** (1) The information prescribed for the purposes of section 29(2)(c)(ii) or (d)(ii) shall be –

(a) that which is sufficient to indicate the result of the corresponding application under section 29(2)(c)(ii) or corresponding international application under section 29(2)(d)(ii), as the case may be, and shall be in the form of –

(i) a copy of the patent granted by the patent office in question which is –

(A) duly certified by that patent office; or

(B) otherwise acceptable to the Registrar; or

(ii) other documents, to the satisfaction of the Registrar, setting out the final results of the search and examination as to substance and a copy of the patent claims referred to in the final results; and

(b) any symbol of the International Patent Classification which has been or which in the opinion of the applicant should be allocated to the application.

(2) The information referred to in sub-rule (1) shall be furnished in Patents Form 14.

**Search procedure where 2 or more inventions claimed.**

47. (1) If during the preparation of a report under section 29(2)(a) or (b) it appears that an application relates to 2 or more inventions, but they are not so linked as to form a single inventive concept, the search may be restricted to one in relation to the first invention specified in the claims of the application, and the Registrar shall notify the applicant of that fact.

(2) If the applicant desires a search to be conducted in relation to a second or subsequent invention specified in the claims, he shall, within 2 months from the date of the Registrar's notification referred to in sub-rule (1), request on Patents Form 11 for a supplementary search report and pay the prescribed search fee for each invention in respect of which the search is to be made.

(3) If a new application for a patent is filed under section 26(11) in respect of any part of the matter contained in an earlier application for a patent, the applicant may, *in lieu* of complying with section 29(2)(a), notify the Registrar in writing that he intends to rely on –

(a) any search report or supplementary search report established in the earlier application; or

(b) where the earlier application is an international application for a patent (Brunei Darussalam) that has entered the national phase in Brunei Darussalam under section 83(3), any international search report or international supplementary search report established during the international phase of the earlier application.

(4) Rule 43(2), (3) and (4) shall apply to any request for an examination report that is filed by an applicant who relies on an international search report or international supplementary search report under sub-rule (3).



**Written opinion of Examiner etc.**

**48.** (1) If during an examination under section 29(5) or (6), the Examiner is of the opinion that –

(a) the description, claims, or drawings are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on –

- (i) the novelty or inventive step of the claimed invention; or
- (ii) whether the claimed invention is capable of industrial application;

(b) the invention defined in any claim –

- (i) does not appear novel;
- (ii) does not appear to involve an inventive step; or
- (iii) does not appear to be capable of industrial application;

(c) the conditions specified in sections 13 and 25(4) and (5) have not been complied with;

(d) the application discloses –

- (i) any additional matter referred to in section 81(1); or
- (ii) any matter extending beyond that disclosed in the application for the patent as filed; or

(e) a claim relates to an invention in respect of which no search has been completed, and he has decided not to carry out the examination in respect of that claim,

the Examiner shall notify the Registrar in writing of that opinion and shall state fully the reasons for his opinion.

(2) The Registrar shall, on receipt of the written opinion, forward the opinion as soon as possible to the applicant together with an invitation to the applicant to file a response thereto.

(3) The applicant may file a response to the written opinion in Patents Form 18 containing –

- (a) written submissions on the Examiner's opinion; or
- (b) an amendment of the specification of the application,

and where the applicant wishes to make written submissions and amend the specification of the application, he shall do both at the same time.

(4) Subject to sub-rule (5), where an amendment of the specification of the application is filed under sub-rule (3), it shall be in the form of a copy of the specification with the amendment indicated in the following manner –

(a) by striking through any text, figure or other matter to be replaced or deleted; and

(b) by underlining any replacement text, figure or other matter.

(5) Sub-rule (4) shall not apply if the amendment is filed using the electronic online system, and the amendment shall instead comply with practice directions issued by the Registrar in place of the requirements of that sub-rule.

(6) Any response under sub-rule (3) to a first written opinion in respect of –

(a) an examination report under section 29(5); or

(b) a search and examination report under section 29(6),

shall be filed within 5 months from the date of the Registrar's notification enclosing the written opinion.

(7) Where the applicant has filed a response under sub-rule (3) –

(a) the Examiner may, in his discretion, issue a further written opinion to the Registrar stating fully the reasons for the opinion;

(b) sub-rules (2) and (3) shall accordingly apply; and

(c) any response under sub-rule (3) to the further written opinion shall be filed within 5 months from the date of the Registrar's notification enclosing the further written opinion.

(8) In deciding whether to issue any further written opinion, the Examiner may also take into consideration whether sufficient time remains for the applicant to respond to his written opinion and for him to draw up the examination report or the search and examination report.

(9) A further opinion or report issued by the Examiner need not take into account any response filed by the applicant after he has commenced writing and drawing up his opinion or report.

(10) Subject to sub-rules (11) and (12), the Examiner shall send the search and examination report or examination report to the Registrar before the expiry of –

(a) 39 months from –

(i) the declared priority date; or

(ii) where there is no declared priority date, the date of filing the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, 39 months from the actual date of filing of the new application.

(11) Where the applicant does not file a response within the period specified in sub-rule (6) or (7), the Examiner shall send the search and examination report or the examination report to the Registrar at the expiration of that period.

(12) Where the period for filing a request for a search and examination report under section 29(2)(b) or a request for an examination report under section 29(2)(c)(i), (d)(i) or (e)(i) or (4) has been extended under section 29(7), the Examiner shall send the search and examination report or examination report to the Registrar before the expiry of –

(a) 57 months from –

(i) the declared priority date; or

(ii) where there is no declared priority date, the date of filing the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, 57 months from the actual date of filing of the new application.

#### **Putting application in order.**

**49.** (1) Subject to sub-rule (2), the period prescribed for the purposes of section 30(1)(a) shall be 42 months from –

(a) the declared priority date; or

(b) the date of filing of the application where there is no declared priority date.

(2) Where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, the period prescribed in sub-rule (1) shall be 42 months from the actual date of filing of the new application.

(3) Payment of the prescribed fee for the grant of a patent must be accompanied by Patents Form 19 duly completed and filed by the applicant.

(4) Where the specification of the application for a patent has been amended or corrected since the filing of the application –

(a) if any such amendment or correction is made before or at the time of compliance with sub-rule (3), the applicant shall file a specification incorporating every such amendment and correction at the time of compliance with sub-rule (3); and

(b) if any such amendment or correction is made after the time of compliance with sub-rule (3),

the applicant shall file a specification incorporating every such amendment and correction within such period as the Registrar may specify.

(5) The documents prescribed for the purposes of section 30(2)(c) shall be –

(a) the completed Patents Form 19 filed under sub-rule (3); and

(b) every specification required to be filed under sub-rule (4).

(6) No amendment or correction (other than an amendment or correction introduced in order to comply with the formal requirements) may be introduced in the specification to be filed under sub-rule (4).

(7) Sub-rules (4) and (6) shall not apply to an international application for a patent (Brunei Darussalam) if the only amendment to the specification since the filing of the application was an amendment referred to in section 83(5) which has been incorporated in the specification of the application before it was published in accordance with the Patent Co-operation Treaty.

**Extension of prescribed periods under sections 29(7) and 30(1)(a).**

**50.** (1) A request under sections 29(7) and 30(1)(a) to extend a prescribed period under section 29(2)(b), (c)(i) or (ii), (d)(i) or (ii) or (e)(i) or (ii) or (4) and the corresponding prescribed period under section 30(1)(a) shall be made on Patents Form 51 within –

(a) subject to paragraph (b), 39 months from –

(i) the declared priority date; or

(ii) where there is no declared priority date, the date of filing the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, 39 months from the actual date of filing of the new application.

(2) The extended period prescribed under section 29(7) for filing a request for a search and examination report under section 29(2)(b) or a request for an examination report under section 29(2)(c)(i), (d)(i) or (e)(i) or (4) shall be –

(a) subject to paragraph (b), 39 months from –

(i) the declared priority date; or

(ii) where there is no declared priority date, the date of filing the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, 39 months from the actual date of filing of the new application.

(3) The extended period prescribed under section 29(7) for filing the prescribed information relating to a corresponding application under section 29(2)(c)(ii), the prescribed information relating to a corresponding international application under section 29(2)(d)(ii) or a notice in Patents Form 15 under section 29(2)(e)(ii) shall be –

(a) subject to paragraph (b), 60 months from –

(i) the declared priority date of the application; or

(ii) where there is no declared priority date, the date of filing of the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, 60 months from the actual date of filing of the new application,

or the date on which section 30(2)(c) is complied with and the prescribed fee for the grant of a patent is paid in accordance with rule 49(3), whichever is the earlier.

(4) For the purposes of section 30(1)(a), the extended prescribed period shall be –

(a) subject to paragraph (b), 60 months from –

(i) the declared priority date; or

(ii) where there is no declared priority date, the date of filing the application; or

(b) where a new application is filed under section 20(3), 26(11) or 48(4), as the case may be, 60 months from the actual date of filing of the new application.

#### **Application for amendment before grant.**

**51.** (1) Subject to rules 48(3) and (4) and 62(1) and (3), an application for amendment of –

(a) the request for the grant of a patent on Patents Form 1; or

(b) the description, claims, drawings and abstract,

shall be made on Patents Form 17.

(2) The application for amendment of a document referred to in sub-rule (1)(a) or (b) shall be accompanied by a copy of that document with the proposed amendment indicated therein in the following manner–

(a) by striking through any text, figure or other matter to be replaced or deleted; and

(b) by underlining any replacement text, figure or other matter.

#### **Time for making amendments before grant.**

**52.** (1) The applicant may, of his own volition, amend the request for the grant of a patent at any time before payment of the fee for the grant of the patent.

(2) The applicant may, unless the Registrar otherwise requires, of his own volition, amend the description, claims, drawings and abstract at any time before payment of

the fee for the grant of a patent, except that any such application for amendment shall not be made –

(a) after filing of the request for a search report referred to in section 29(2)(a) and before receipt of that report by the applicant;

(b) after filing of the request for a search and examination report referred to in section 29(2)(b) and before receipt of that report by the applicant; or

(c) after filing of the request for an examination report referred to in section 29(2)(c)(i), (d)(i) or (e)(i) or (4) and before receipt of that report by the applicant.

### **Certificate of grant.**

53. A certificate of grant under section 34(1) shall be in Certificate Form 1.

## **PATENTS AFTER GRANT**

### **Renewal of patents.**

54. (1) If it is desired to keep a patent in force for a further year or part thereof after the expiration of the fourth or any succeeding year from the date of filing an application for that patent as determined in accordance with section 26 or section 115(5), an application for its renewal, in respect of the next succeeding year, accompanied by the prescribed renewal fee for that year, shall be filed in the 3 months ending with the fourth or, as the case may be, succeeding anniversary of the date of filing.

(2) Where a patent is granted under section 30 after the expiry of the period of 45 months from the date of filing, the application for the renewal of the patent may be filed, and any renewal fees which have become due (including any fees due in respect of preceding years) may be paid, at any time up to the end of the period of 3 months from the date on which the patent is granted.

(3) Where the Registrar has extended the term of a patent under section 36 after the expiry of the period of 20 years referred to in section 35(1), an application for the renewal of the patent may be filed, and any renewal fees which have become due (including any fees

due in respect of preceding years) may be paid, within 3 months from the date of the certificate of extension of patent term issued under section 36(11) in respect of the patent.

- (4) An application for the renewal of a patent under this rule shall be filed –
- (a) on Patents Form 20; or
  - (b) on Patents Form 58 if an entry has been made in the register under section 55(2) that licences under the patent are to be available as of right.

(5) Payment of any additional fee for a late application for the renewal of a patent referred to in section 35(3) shall be made to the Registry together with Patents Form 21.

- (6) On receipt by the Registrar of –
- (a) an application for the renewal of a patent that is filed in accordance with the Order and these Rules; and
  - (b) payment for the renewal fee and (if applicable) the additional fee for late application, that is made in accordance with the Order and these Rules,
- the patent shall be renewed.

(7) Where the period for payment of a renewal fee pursuant to sub-rule (1) has expired, the Registrar shall, not later than one month from the last date for payment under that paragraph and if the fee still remains unpaid, send to the proprietor of the patent a notice reminding him that payment is overdue and of the consequences of non-payment.

(8) Where a patent to which section 115(4) applies has never been renewed under sub-rule (1), the application of section 35(4) in relation to the patent is modified to the extent that the Registrar is not required to send a notice reminding the proprietor of the patent that the payment is overdue.

- (9) The Registrar shall send a notice under sub-rule (7) to –
- (a) the address in Brunei Darussalam specified by the proprietor on payment of the last renewal fee; or
  - (b) where another address in Brunei Darussalam has been notified to him for that purpose by the proprietor since the last renewal, that address,



and, in any other case, the address for service entered in the register.

(10) Payment of the additional fee referred to in section 35(3) shall be made on Patents Form 21 and shall be accompanied by the additional fee prescribed for late payment, and shall also be accompanied by Patents Form 20 together with the corresponding renewal fee.

**Extension of term of patent.**

**55.** (1) For the purposes of section 36(10), an application to extend the term of a patent under section 36(1)(a) or (b) shall be –

(a) made on Patents Form 59 within 6 months from the date of the grant of the patent; and

(b) accompanied by –

(i) the prescribed fee; and

(ii) all documentary evidence which the applicant wishes to rely on to support the application.

(2) For the purposes of section 36(10), an application to extend the term of a patent under section 36(1)(c) shall be –

(a) made on Patents Form 59 –

(i) within 6 months from –

(A) the date of the grant of the patent; or

(B) the date marketing approval was obtained,

whichever is the later;

(ii) not later than 6 months before the end of the period of 20 years referred to in section 35(1); and

(iii) in any case, while the patent is still in force; and

(b) accompanied by –

(i) the prescribed fee;

(ii) a certificate under section 36(7); and

(iii) all other documentary evidence which the applicant wishes to rely on to support the application.

(3) Notwithstanding sub-rule (1)(b) or (2)(b), the Registrar may direct an applicant for an extension of the term of a patent to produce, within such period as the Registrar may specify, such additional evidence in support of the application as the Registrar may reasonably require.

(4) A certificate of extension of patent term under section 36(11) shall be in Certificate Form 2.

**Amendment of specification after grant.**

**56.** (1) An application to the Registrar for leave to amend the specification of a patent shall be made on Patents Form 22 and shall be advertised by publication of the application and the reasons for the proposed amendment in the journal and in such other manner, if any, as the Registrar may direct.

(2) Any person wishing to oppose the application to amend shall, within 2 months from the date of the advertisement in the journal, file notice to the Registrar on Patents Form 23.

(3) Such notice shall be accompanied by a copy thereof and be supported by a statement setting out fully the facts upon which the opponent relies and the relief which he seeks. The Registrar shall send a copy of the notice and of the statement to the applicant.

(4) Within 2 months from the date of the Registrar's letter forwarding such copies to him, the applicant shall, if he wishes to continue with the application, file a counter-statement on Patents Form 3 setting out fully the grounds upon which the opposition is resisted; and the Registrar shall send a copy of the counter-statement to the opponent.

(5) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

(6) An application under this rule shall be accompanied by a copy of the specification with the proposed amendment indicated therein in the following manner –

(a) by striking through any text, figure or other matter to be replaced or deleted; and

(b) by underlining any replacement text, figure or other matter.

(7) Where notice of opposition has been filed, the Registrar, in determining whether leave to amend should be granted, may cause the patent as proposed to be amended to be examined by an examiner to determine whether the amendment is allowable under section 81(3), in which case the application for leave to amend together with the notice of opposition, the accompanying statement and any counter-statement, shall be taken into consideration by the examiner during his examination.

(8) Where leave to amend a specification is given, the applicant shall, if the Registrar so requires, and within a time to be fixed by him, file a new specification as amended, which shall be prepared in accordance with rules 22, 24 and 26.

(9) No amendment or correction (other than an amendment or correction introduced in order to comply with rule 22, 24 or 26) may be introduced in the new specification to be filed under sub-rule (8).

(10) Where no notice of opposition is received by the Registrar under sub-rule (2) or where such notice fails to comply with sub-rule (3) and the Registrar is satisfied with the reasons for making the proposed amendments, he may give leave to the applicant to amend the specification of the patent.

#### **Search and examination after grant.**

**57.** (1) A request for a search and examination report under section 39(1) shall be made on Patents Form 60 and shall be accompanied by –

(a) the prescribed fee;

(b) a statement –

(i) identifying each ground under section 39(1) on which the request has been made; and

(ii) explaining how that ground has been satisfied; and

(c) each observation or document referred to in section 39(3), if any.

(2) Where the Registrar grants a request under section 39(1), he shall forward to the Examiner –

- (a) the request;
- (b) the statement referred to in sub-rule (1)(b); and
- (c) any observation or document filed under section 39(3) and sub-rule

(1).

(3) If during the preparation of a report under section 39 in respect of any claim or claims in the specification of a patent, it appears that the claim or claims relate to 2 or more inventions which are not so linked as to form a single inventive concept –

(a) the search and examination may be restricted to the first invention specified in the claim or claims; and

(b) the Registrar shall notify –

- (i) the proprietor of the patent; and
- (ii) where the request under section 39(1) was not filed by the proprietor, the person who filed the request,

of that fact.

(4) If –

(a) the proprietor of the patent; or

(b) where the request under section 39(1) was not filed by the proprietor,

the person who filed the request, desires a search and examination to be conducted in relation to a second or subsequent invention specified in the claim or claims, he shall, within 2 months from the date of the Registrar's notification referred to in sub-rule (3), request on Patents Form 60 for a supplementary search and examination report and pay the prescribed search and examination fee for each invention in respect of which the search and examination is to be made.

(5) If during an examination under section 39, the Examiner is of the opinion that –

(a) the description, claim or claims, or drawings are so unclear, or the claim or claims are so inadequately supported by the description, that no meaningful opinion can be formed on –

- (i) the novelty or inventive step of the claimed invention; or
- (ii) whether the claimed invention is capable of industrial application;

(b) the conditions specified in requirements of sections 13 and 25(4) and (5) have not been complied with; or

(c) the specification of the patent discloses –

- (i) any additional matter referred to in section 81(1); or
- (ii) any matter extending beyond that disclosed in the application for the patent as filed,

the Examiner shall notify the Registrar in writing of that opinion and shall state fully the reasons for his opinion.

(6) The Registrar shall, on receipt of the written opinion, forward the opinion as soon as possible to the proprietor of the patent, together with an invitation to the proprietor to file a response to the opinion.

(7) The proprietor of the patent may file a response to the written opinion in Patents Form 18 containing –

- (a) written submissions on the Examiner's opinion; or
- (b) a proposed amendment of the specification of the patent,

and where the proprietor wishes to make written submissions and propose an amendment of the specification of the patent, he shall do both at the same time.

(8) Subject to sub-rule (9), where a proposed amendment of the specification of the patent is filed under sub-rule (7), it shall be in the form of a copy of the specification with the proposed amendment indicated in the following manner –

- (a) by striking through any text, figure or other matter to be replaced or deleted; and
- (b) by underlining any replacement text, figure or other matter.

(9) Any response under sub-rule (7) to a written opinion in respect of a search and examination report under section 39 shall be filed within 3 months from the date of the Registrar's notification enclosing the written opinion.

(10) Where the proprietor of a patent has filed a response under sub-rule (7) –  
(a) the Registrar shall forward the response to the Examiner; and  
(b) the Examiner shall consider the response and prepare the search and examination report.

(11) Where the proprietor of a patent does not file a response under sub-rule (7) within the period specified in sub-rule (8) –

(a) the Registrar shall notify the Examiner accordingly; and  
(b) the Examiner shall prepare the search and examination report.

(12) The Examiner shall send the search and examination report to the Registrar before the expiry of 10 months from the date the Registrar forwarded the request under section 39(1) to the Examiner.

(13) Upon receiving the search and examination report, the Registrar shall proceed in accordance with section 39(9).

### **Restoration of lapsed patent.**

**58.** (1) An application under section 40 for the restoration of a patent –  
(a) may be made at any time within 30 months from the day on which it ceased to have effect; and

(b) shall be made on Patents Form 24 together with a statutory declaration or affidavit setting out the grounds for the application and the evidence in support thereof,

and the Registrar shall publish in the journal notice of the making of the application.

(2) Where the application is for the restoration of a patent to which section 115(4) applies, the evidence referred to in sub-rule (1)(b) shall include –

(a) that which establishes that the patent remained in force in the United Kingdom, Malaysia and Singapore, as the case may be, at the time the first renewal was due if the patent had never been renewed under the Order; and

(b) a statutory declaration stating that the patent has not been revoked in the United Kingdom, Malaysia and Singapore, as the case may be.

(3) If, upon consideration of the grounds and evidence, the Registrar is not satisfied that a case for an order under section 40 has been made out, he shall notify the applicant accordingly and, unless within one month from the date of the Registrar's notification the applicant requests to be heard in the matter, the Registrar shall refuse the application.

(4) If the applicant requests a hearing within the time allowed, the Registrar shall, after giving the applicant an opportunity of being heard, determine whether the application shall be allowed or refused.

(5) If the Registrar decides to allow the application, he shall notify the applicant accordingly and require him, within 2 months from the date of the Registrar's notification to him, to file Patents Form 25 accompanied by the prescribed additional fee, together with Patents Form 20, duly completed, and the amount of any unpaid renewal fee, upon receipt of which the Registrar shall order the restoration of the patent and publish the fact in the journal.

**Modified application of section 40 to patent to which section 115(4) applies.**

**59.** Where a patent to which section 115(4) applies has never been renewed under rule 54(1), the application of section 40(5) in relation to the patent is modified to the extent that the Registrar may, apart from the ground stated in section 40(5), by order restore the patent if the Registrar is satisfied that the failure to pay any renewal fee was unintentional and the proprietor of the patent has good cause for failing to renew the patent within the period prescribed.

### **Surrender of patents.**

**60.** (1) A notice of an offer under section 41 by a proprietor of a patent to surrender his patent shall be given on Patents Form 26 and shall be advertised by the Registrar in the journal.

(2) At any time within 2 months from the date of the advertisement, any person may give notice of opposition to the surrender to the Registrar on Patents Form 27.

(3) Such notice of opposition shall be accompanied by a copy thereof and be supported by a statement setting out fully the facts upon which the opponent relies and the relief which he seeks. The Registrar shall send a copy of the notice and of the statement to the proprietor of the patent.

(4) Within 2 months from the date of the Registrar's letter forwarding the copies of the notice and statement, the proprietor of the patent shall, if he wishes to continue with the surrender, file a counter-statement on Patents Form 3 setting out fully the grounds upon which the opposition is resisted; and the Registrar shall send a copy of the counter-statement to the opponent.

(5) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

## **REGISTER AND OFFICIAL DOCUMENTS**

### **Register of Patents.**

**61.** (1) There shall be kept at the Registry a Register of Patents which shall comply with these Rules.

(2) No entry shall be made in the register in respect of any application for a patent before the application has been published in accordance with section 27.

(3) Upon such publication, the Registrar shall cause to be entered in the register –



- (a) the name and address of the applicant or applicants;
- (b) the name and address of the person or persons stated by the applicant or applicants to be believed to be the inventor or inventors;
- (c) the title of the invention;
- (d) the date of filing and the file number of the application for the patent;
- (e) the date of filing and the file number of any application declared for the purposes of section 17(2) and the country in or for which the application was made;
- (f) the date on which the application was published;
- (g) the address for service of the applicant or applicants; and
- (h) the symbol or symbols of the International Patent Classification allocated to the application.

(4) The Registrar shall also cause to be entered in the register –

- (a) the date on which the application is withdrawn, treated as having been abandoned, treated as having been withdrawn, refused or treated as having been refused;
- (b) the date on which the patent is granted;
- (c) the name and address of the person or persons to whom the patent is granted if different to the entries made in accordance with sub-rule (3)(a);
- (d) the address for service, if different to the entry made in accordance with sub-rule (3)(g);
- (e) notice of any transaction, instrument or event referred to in section 44(3);
- (f) the date of renewal of the patent, if any;
- (g) the date of any application under section 36 to extend the term of the patent;
- (h) the period of the extension of the term of the patent under section 36, if any;
- (i) the date of any search and examination report issued under section 39;
- (j) the cessation of the patent, if any;
- (k) the restoration of the patent, if any;
- (l) particulars of any decision to revoke the patent; and

(m) particulars of any court order in relation to the patent.

(5) The Registrar may at any time enter in the register such other particulars as he may think fit.

**Alteration or correction of name, address or address for service.**

**62.** (1) A request by any person, upon the alteration of his name, for that alteration to be entered in the register or on any application or other document filed at the Registry shall be made on Patents Form 28.

(2) Before acting on a request to alter a name, the Registrar may require such proof of the alteration as he thinks fit.

(3) A request by a person for –

(a) the alteration of his address or address for service; or

(b) the correction of any error in his name, address or address for service,

as entered in the register or on any application or other document filed at the Registry, shall be made on Patents Form 28.

(4) If the Registrar is satisfied that any request to alter or correct any name, address or address for service may be allowed, he shall cause the register, application or other document to be altered or corrected accordingly.

**Application for registration of transaction etc.**

**63.** (1) An application to register, or to give notice to the Registrar of, any transaction, instrument or event to which section 44 applies shall be made on Patents Form 29.

(2) Subject to sub-rule (3), an application under sub-rule (1) in respect of any transaction, instrument or event referred to in section 44(3)(a), (b), (c) or (d) shall, for –

(a) each party to the transaction or instrument; or

(b) each person –

(i) giving assent; or

- (ii) on whom any patent, application for a patent or right is to be vested,

under section 44(3)(d),

be accompanied by a declaration of authorisation in Patents Form 46 in respect of that party or person.

(3) An application under sub-rule (1) in respect of any transaction, instrument or event referred to in section 44(3)(a), (b), (c) or (d) need not be accompanied by a declaration of authorisation in Patents Form 46 in respect of a party or person referred to in sub-rule (2) if –

- (a) a declaration of authorisation in Patents Form 46 which was filed earlier in respect of that party or person is in sufficiently wide terms to cover that transaction, instrument or event;

- (b) that party or person is the person making the application; or

- (c) the person making the application complies with sub-rule (4).

(4) If –

- (a) sub-rule (2) is not complied with and paragraphs (a) and (b) of sub-rule (3) do not apply;

- (b) sub-rule (2) does not apply; or

- (c) the Registrar so directs,

the person making an application under sub-rule (1) shall lodge with the Registrar, within such period as the Registrar may specify –

- (i) a copy of any document establishing the transaction, instrument or event which is –

- (A) duly certified; or

- (B) otherwise acceptable to the Registrar; or

- (ii) a copy each of such extracts from such documents as are sufficient to establish the transaction,

instrument or event which is –

- (A) duly certified; or

- (B) otherwise acceptable to the Registrar.

### **Request for correction of errors.**

**64.** (1) Without prejudice to rule 62(3), a request for the correction of each error in the register or in any document filed at the Registry in connection with registration shall be made on Patents Form 28; and the correction shall be clearly identified on a document filed together with the form or, if not, on the form itself.

(2) Where a request is sought to correct the same error in both the register and any document filed at the Registry in connection with the registration, the request may be made on a single form.

(3) The Registrar may call for such written explanation of the reasons for the request or evidence in support of it as he may require in order to satisfy himself that there is an error and, upon being so satisfied, shall make such correction as may be agreed between the proprietor of the patent or applicant and the Registrar.

(4) This rule is without prejudice to the power of the Registrar to correct any entry in the register which is attributable wholly or in part to an error, default or omission on the part of the Registry.

### **Inspection of register etc.**

**65.** Any person may, upon payment of the prescribed fee referred to in the First Schedule –

- (a) inspect the register; or
- (b) search and retrieve –
  - (i) published patents specifications in respect of a patent or application for a patent;
  - (ii) an entry in the register; or
  - (iii) information as to the renewal of a patent.

### **Advertisement of matters contained in register.**

**66.** The Registrar may arrange for the publication and advertisement of such things done under the Order or these Rules in relation to the register as he may think fit.

**Entries in respect of right to a patent.**

**67.** On the reference to the Registrar of a question under section 20(1) or 48(1), he shall, subject to rule 61(2), cause an entry to be made in the register of the fact and of such other information relating to the reference as he may think fit.

**Certificates and copies supplied by Registrar.**

**68.** (1) Upon request made on Patents Form 31 and payment of the prescribed fee, but subject to sub-rule (3), the Registrar shall supply –

- (a) a certified copy or certified extract falling within section 46;
- (b) a copy of an entry in or an extract from the register or a copy of or an extract from anything referred to in section 46, certified by the impression of a rubber stamp; and
- (c) a certificate for the purposes of section 46.

(2) Upon request made on Patents Form 30 and payment of the prescribed fee, but subject to sub-rule (3), the Registrar shall supply an uncertified copy of an entry in or an uncertified extract from the register or an uncertified copy of or an uncertified extract from anything referred to in section 46.

(3) The restrictions on making documents available for inspection contained in rule 99(4) shall apply equally to the supply by the Registrar under this rule of copies of or extracts from such documents or requests as are referred to in rule 99(4); and nothing in this rule shall be construed as imposing upon the Registrar the duty of supplying copies of or extracts from any document or file of a description referred to in rule 99(5).

**Orders or directions by court.**

**69.** (1) Where any order or direction has been made or given by the court –

- (a) transferring a patent or application or any right in or under it to any person;
- (b) that an application should proceed in the name of any person;
- (c) allowing the proprietor of a patent to amend the specification; or
- (d) revoking a patent,

the person in whose favour the order is made or the direction is given –

- (i) shall file Patents Form 32 accompanied by a copy of the order or direction; and
- (ii) if the Registrar so requires and before a time limit fixed by him, shall file a specification as amended which shall be (prepared in accordance with rules 22, 24 and 26).

(2) Upon a filing under sub-rule (1), the specification shall be amended or the register rectified or altered, as the case may require.

## **ENTITLEMENT TO PATENT**

### **Reference to Registrar of right to patent.**

**70.** (1) A reference under section 48(1) shall be made on Patents Form 2 and shall be accompanied by a copy thereof and a statement setting out fully the nature of the question, the facts upon which the person making the reference relies and the order which he is seeking.

(2) The Registrar shall send a copy of the reference and statement to every person who is not a party to the reference being –

- (a) a person who is shown on the register as having any right in or under the patent;
- (b) a person who has given notice to the Registrar of a relevant transaction, instrument or event; or
- (c) a person who is alleged in the reference to be entitled to a right in or under the patent.

(3) If any person who is sent a copy of the reference and statement under sub-rule (2) wishes to oppose the making of the order sought (“the opponent”), he shall, within 2 months from the date of the Registrar’s letter forwarding such copies to him, file a counter-statement on Patents Form 3 setting out fully the grounds of his opposition and the Registrar shall send a copy of the counter-statement to the person making the reference and to those recipients of the copy of the reference and statement who are not party to the counter-statement.

(4) The person making the reference or any such recipient may, within 2 months from the date of the Registrar's letter forwarding the copy of the counter-statement, file evidence in support of his case and shall send a copy of the evidence –

- (a) in any case, to the opponent; and
- (b) in the case of evidence filed by such a recipient, to the person making the reference.

(5) Within 2 months from the date of receipt of the copy of such evidence or, if no such evidence is filed, within 2 months from the expiration of the time within which the copy of such evidence could have been filed, the opponent may file evidence in support of his case and shall send a copy of that evidence to the person making the reference and to those recipients; and, within 2 months from the date of receipt of the copy of the opponent's evidence, that person or any of those recipients may file further evidence confined to matters strictly in reply and shall send a copy of it to the persons mentioned in sub-rule (4)(a) and (b).

(6) No further evidence shall be filed by any party except by leave or direction of the Registrar.

(7) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

#### **Application for authorisation to carry out directions.**

**71.** (1) An application under section 48(3) for authority to do anything on behalf of a person to whom directions have been given under section 48(2)(d) shall be made on Patents Form 4 and shall be accompanied by a copy thereof and a statement setting out fully the facts upon which the applicant relies and the nature of the authorisation sought.

(2) The Registrar shall send a copy of the application and statement to the person alleged to have failed to comply with the directions.

(3) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Time limits for making new application.**

72. Where the Registrar orders that a new application may be made under section 48(4), it shall be made within 3 months from the day on which the time for appealing from that order expires without an appeal being brought or, where an appeal is brought, from the day on which it is finally disposed of.

**Request for licence to continue working new patent.**

73. (1) Where an order is made under section 48 that a patent shall be transferred to one or more persons none of whom was an old proprietor of it or that a person other than an old proprietor may make a new application for a patent, a request under section 49(3) for the grant of a licence to continue working or, as the case may be, to work the invention shall be made within 2 months from the date of notification by the Registrar of the making of the order.

(2) Where such an order is made, the Registrar shall notify the old proprietor or proprietors, and their licensees of whom he is aware, of the making of the order.

**Reference as to entitlement to grant of licence.**

74. (1) Where a question is referred to the Registrar under section 49(5) as to whether any person is entitled to be granted a licence or whether the period or terms of a licence are reasonable, the reference shall be made on Patents Form 6 and shall be accompanied by a copy thereof and a statement setting out fully the facts upon which the person making the reference relies and the terms of the licence which he is prepared to accept or grant.

(2) The Registrar shall send a copy of the reference and statement to the new proprietor or proprietors and every person claiming to be entitled to be granted a licence, in either case not being the person who makes the reference, and if any recipient does not agree to grant or accept a licence for such period and upon such terms, he shall, within 2 months from the date of the Registrar's letter forwarding such copies to him, file a counter-statement on Patents Form 3 setting out fully the grounds of his objection and the Registrar shall send a copy of the counter-statement to the person making the reference.



(3) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

## LICENCES OF RIGHT

### Entry in register of licence of right.

75. (1) An application under section 55(1) shall be made on Patents Form 33.

(2) Every entry made in the register consequent upon such an application shall be published in the journal and in such other manner (if any) as the Registrar thinks necessary.

### Settlement of terms of licence of right.

76. (1) An application under section 55(3)(a) or (b) shall be made on Patents Form 34 together with –

(a) in the case of an application by the proprietor of the patent, one copy of a draft of the licence he proposes and of a statement of the facts he relies on; and

(b) in the case of an application by any other person, one copy of a draft of the licence he seeks.

(2) The Registrar shall –

(a) in the case of an application by the proprietor, send a copy of Patents Form 34 and a copy of the documents filed under sub-rule (1)(a) to the person to whom the proprietor proposes to grant the licence; and

(b) in the case of an application by any other person, send a copy of Patents Form 34 and a copy of the documents filed under sub-rule (1)(b) to the proprietor.

(3) Within 2 months from the date when the documents are sent to him under sub-rule (2) –

(a) in the case of an application by the proprietor, the person referred to in sub-rule (2)(a) may file a counter-statement on Patents Form 3 setting out fully the grounds of his objection; and

(b) in the case of an application by any other person, the proprietor may file a statement setting out fully the grounds of his objection, and, if he does so, he shall at the same time send a copy of the statement or counter-statement, as the case may be, to the other party.

(4) Within 2 months from the date when a statement under sub-rule (3)(b) is sent to him, the person therein referred to may file a counter-statement on Patents Form 3; and, if he does so, he shall at the same time send a copy of the counter-statement to the proprietor.

(5) No further statement or counter-statement shall be served by either party without the leave or direction of the Registrar.

(6) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Cancellation of entry in register as to licence of right by proprietor.**

77. An application under section 56(1) shall be made on Patents Form 35.

**Cancellation of entry in register as to licence of right by third party.**

78. (1) An application under section 56(3) shall be made on Patents Form 35 within 2 months from the date of publication in the journal of the relevant entry and shall be accompanied by a copy of the application supported by a statement setting out fully the nature of the claimant's interest and the facts upon which he relies.

(2) The Registrar shall send a copy of the application and statement to the proprietor of the patent.

**Procedure as to cancellation of entry in register as to licence of right.**

79. (1) Every application under section 56(1) or (3) shall be advertised in the journal and the period within which notice of opposition to the cancellation of an entry may be given under section 56(7) shall be 2 months from the date of the advertisement.

(2) Such notice of opposition shall be given on Patents Form 36 and shall be accompanied by a supporting statement setting out fully the facts upon which the opponent relies.

(3) The Registrar shall send a copy of the notice and statement to the applicant for cancellation of the entry who, if he desires to proceed with the application, shall, within 2 months from the date of the Registrar's letter forwarding such copies to him, file a counter-statement on Patents Form 3 setting out fully the grounds on which the opposition is contested and the Registrar shall send a copy of the counter-statement to the opponent.

(4) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Action by Registrar on cancellation in register as to licence of right.**

**80.** (1) Where the Registrar has received an application from the proprietor of a patent to cancel an entry in the register under section 56(1), the Registrar shall notify the proprietor of the patent who shall, within 2 months from the date of the Registrar's notification to him, pay fees equal to the amount of the balance of all renewal fees which would have been payable if the entry had not been made.

(2) Upon receipt of the fees under sub-rule (1), the Registrar may proceed to cancel the entry if he is satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.

(3) Where the Registrar cancels an entry in the register in respect of a patent under section 56(3), the Registrar shall notify the proprietor of the patent who shall, within 2 months from the date of the Registrar's notification to him, pay fees equal to the amount of the balance of all renewal fees which would have been payable if the entry had not been made.

(4) Patents Form 20 shall be filed with the Registry when fees are paid to the Registry under this rule.

## **INFRINGEMENT OF PATENTS**

### **Particulars prescribed under section 64(4).**

**81.** A written notice to an importer under section 64(4) shall contain the following particulars—

- (a) a statement that the notice is issued in accordance with section 64(4);
- (b) the patent number (or P-No.) of the patent relied on, as stated in the certificate of grant;
- (c) the date of filing of the application pursuant to which that patent was granted;
- (d) the date on which that patent was granted;
- (e) the name and address of each proprietor of that patent;
- (f) the address for service of the proprietor or proprietors, as the case may be;
- (g) the name and address of the person referred to in section 64(3)(b)(ii);
- (h) a detailed statement explaining how the import of the patented product by the importer would result in the product being distributed in breach of the contract referred to in section 64(3)(b);
- (i) the text of all clauses in the contract referred to in section 64(3)(b) which are relied on or referred to in the statement under paragraph (h).

## **INFRINGEMENT PROCEEDINGS BEFORE REGISTRAR**

### **Reference to Registrar for determination of infringement.**

**82.** (1) Where a reference is made to the Registrar under section 65(3), the parties thereto shall make it on Patents Form 37, accompanied by a joint statement giving full particulars of the matters which are in dispute and of those on which they are in agreement.

(2) The procedure set out in this rule shall apply unless the only matter stated in the reference to be in dispute is the validity of any patent or part of a patent.

(3) The party to the dispute who is the proprietor of the patent or an exclusive licensee of the patent (such party being referred to in this rule and rule 83 as the plaintiff) shall, if he desires to proceed with the reference, within 14 days from making the reference,

file a statement giving full particulars of his case on the matters in dispute and shall at the same time send a copy of the statement to the other party to the dispute.

(4) Within 2 months from the date of receipt by the other party to the dispute of the copy of the plaintiff's statement, the other party (referred to in this rule and rule 83 as the defendant) shall, if he wishes to contest the plaintiff's case, file a counter-statement on Patents Form 3 setting out fully the grounds on which he contests the plaintiff's case and shall at the same time send a copy of the counter-statement to the plaintiff.

(5) If the defendant alleges in his counter-statement that the patent or any part of it alleged by the plaintiff to have been infringed is not valid, the plaintiff shall, if he wishes to contest the defendant's allegation, within 2 months from the date of receipt of the counter-statement, file a further statement setting out fully the grounds on which he contests the defendant's allegation and shall at the same time send a copy of the further statement to the defendant.

(6) Subject to such directions as the Registrar may give, the plaintiff may, within 2 months from the date of receipt of the counter-statement, or, if he has filed a further statement under sub-rule (5), within 2 months thereof, file evidence in support of his case and shall send a copy thereof to the defendant.

(7) Within 2 months from the date of receipt of the copy of the plaintiff's evidence or, if the plaintiff does not file any evidence, within 2 months from the expiration of the time within which such evidence could have been filed, the defendant may file evidence in support of his case and shall send a copy of that evidence to the plaintiff; and, within 2 months from the date of receipt of the copy of the defendant's evidence, the plaintiff may file further evidence confined to matters strictly in reply and shall send a copy of it to the defendant.

(8) No further evidence shall be filed by either party except by leave or direction of the Registrar.

(9) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Procedure where validity of patent is in dispute.**

**83.** (1) Where the only matter stated in the reference made under section 65(3) to be in dispute is the validity of any patent or part of a patent, the procedure set out in this rule shall apply.

(2) The defendant shall, if he wishes to contest the plaintiff's case, within 14 days from making the reference, file a statement giving full particulars of the grounds on which he alleges that the patent or part of the patent is invalid and shall at the same time send a copy of the statement to the plaintiff.

(3) The plaintiff shall, if he wishes to contest the defendant's allegation, within 2 months from the date of receipt of the defendant's statement, file a counter-statement on Patents Form 3 giving full particulars of the grounds on which he contests the defendant's allegations, and shall at the same time send a copy of it to the defendant.

(4) Subject to such directions as the Registrar may think fit to give, the defendant may, within 2 months from the date of receipt of the plaintiff's counter-statement, file evidence in support of his case, and shall send a copy of it to the plaintiff.

(5) Within 2 months from the date of receipt of the copy of the defendant's evidence or, if the defendant does not file any evidence, within 2 months from the expiration of the time within which such evidence could have been filed, the plaintiff may file evidence in support of his case and shall send a copy of that evidence to the defendant; and, within 2 months from the date of receipt of the copy of the plaintiff's evidence, the defendant may file further evidence confined to matters strictly in reply and shall send a copy of it to the plaintiff.

(6) No further evidence shall be filed by either party except by leave or direction of the Registrar.

(7) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Application for declaration as to non-infringement.**

**84.** (1) An application to the Registrar under section 76 for a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent shall be made on Patents Form 38 and shall be accompanied by a copy thereof and a statement setting out fully the facts upon which the applicant relies as showing that section 76(1)(a) and (b) have been complied with and the relief which he seeks.

(2) The Registrar shall send a copy of the statement to the proprietor of the patent who shall, if he wishes to contest the application, within 2 months from the date of the Registrar's letter forwarding such copy to him, file a counter-statement on Patents Form 3 setting out fully the grounds on which he contests the applicant's case and shall at the same time send a copy thereof to the applicant.

(3) Subject to such directions as the Registrar may think fit to give, the applicant may, within 2 months from the date of receipt of the copy of the counter-statement, file evidence in support of his application and shall send a copy thereof to the proprietor of the patent.

(4) Within 2 months from the date of receipt of the copy of the applicant's evidence or, if the applicant does not file any evidence, within 2 months from the expiration of the time within which such evidence could have been filed, the proprietor of the patent may file evidence in support of his case and shall send a copy of that evidence to the applicant; and, within 2 months from the date of receipt of the copy of the proprietor's evidence, the applicant may file further evidence confined to matters strictly in reply and shall send a copy of it to the proprietor.

(5) No further evidence shall be filed by either party except by leave or direction of the Registrar.

(6) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

## **REVOCATION OF PATENTS**

### **Procedure on application for revocation.**

**85.** (1) An application to the Registrar for the revocation of a patent shall be made on Patents Form 40 and shall be accompanied by a statement setting out fully the grounds of revocation, including the facts upon which the applicant relies and the relief which he seeks.

(2) The Registrar shall send a copy of the application and the statement to the proprietor of the patent.

(3) Within 3 months from the date of receipt of the copies of the application and statement, the proprietor of the patent, if he wishes to contest the application, shall file a counter-statement on Patents Form 3 setting out fully the grounds upon which the application is contested and he may, at the same time file an amendment of the specification of the patent in accordance with section 80, and shall at the same time send a copy of the amendment (if any) and the counter-statement to the applicant.

(4) If the proprietor of the patent fails to file the counter-statement in accordance with sub-rule (3), he shall not be allowed to take part in the subsequent proceedings, and the application for revocation shall be considered by the Registrar as if each specific fact set out in the statement were conceded, except in so far as it is contradicted by other document in the possession of the Registrar.

(5) The applicant may, within 3 months from the date of receipt of the copy of the amendment (if any) and the counter-statement, file evidence as he may desire to adduce in support of his case and shall at the same time send a copy of that evidence to the proprietor.

(6) If the applicant files no evidence in accordance with sub-rule (5), he shall, unless the Registrar otherwise directs, be deemed to have abandoned his application.



(7) If the applicant files evidence in accordance with sub-rule (5), then, within 3 months from the date of receipt of the copy of the applicant's evidence, the proprietor of the patent may file evidence as he desires to adduce in support of his case and shall at the same time send a copy of that evidence to the applicant.

(8) Within 3 months from the date of receipt by the applicant of the copy of the proprietor's evidence, the applicant may file further evidence confined to matters strictly in reply and shall at the same time send a copy of that evidence to the proprietor.

(9) No further evidence shall be filed by either party, but in any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either party to file any evidence upon such terms as to costs or otherwise as he may think fit.

(10) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

**Material information prescribed under section 77(1)(f)(iii).**

**86.** The material information for the purposes of section 77(1)(f)(iii) shall be –

(a) any prescribed information relating to a corresponding application referred to in section 29(2)(c)(ii); or

(b) any prescribed information relating to a corresponding international application referred to in section 29(2)(d)(ii); and

(c) where the prescribed information referred to in paragraph (a) or (b) includes any document that is not in the English language, the English translation of such document that was filed.

**Procedure relating to preparation of re-examination report.**

**87.** (1) If the Registrar decides to cause the patent to be re-examined –

(a) the Registrar shall direct the applicant for revocation of the patent to file Patents Form 41 requesting re-examination of the patent, together with the prescribed re-examination fee and any security for the costs or expenses of the proceedings specified by the Registrar, within 2 months from the date of the direction,

and if the applicant fails to do so within that period he shall be deemed to have abandoned his application; and

(b) the Examiner shall during re-examination take into consideration the statement by the applicant, any amendment of the specification of the patent, the counter-statement by the proprietor of the patent and any evidence filed under rule 85 and shall recommend whether or not the patent should be revoked on any of the grounds specified in the application for revocation,

and shall notify the Registrar of the conclusions in the re-examination report stating fully the reasons for such conclusions.

(2) If amendments have been proposed under section 80(1) by the proprietor of the patent, the Examiner shall in the re-examination report include an opinion as to whether the amendment proposed –

(a) is allowable under section 81(3); and

(b) would overcome, in whole or in part, any of the grounds of revocation specified in the application for revocation.

#### **Copies and conclusions of re-examination report.**

**88.** The Registrar shall send a copy of the re-examination report to both the applicant for revocation of the patent and the proprietor of the patent, and he shall take into consideration the conclusions of the re-examination report in making his determination on the patent or the patent as amended.

#### **Award of costs on surrender of patent.**

**89.** If, in proceedings before the Registrar under section 77, the proprietor of a patent offers to surrender his patent under section 41, the Registrar shall, in deciding whether costs should be awarded to the applicant for revocation, consider whether proceedings might have been avoided if the applicant had given reasonable notice to the proprietor before the application was filed.

#### **Notification of an opportunity to amend.**

**90.** (1) Where it appears to the Registrar in accordance with section 78 that the patent ought to be revoked, the proprietor of the patent shall be so notified and afforded an

opportunity, within 3 months from the date of such notification, to make observations and to amend the specification of the patent.

(2) Where the Registrar allows under section 80 the proprietor of the patent to amend the specification of the patent, he may, before the specification is amended, require the applicant to file a new specification, as amended, prepared in accordance with rules 22, 24 and 26.

## **AMENDMENT OF PATENTS IN INFRINGEMENT OR REVOCATION PROCEEDINGS**

### **Procedure as to opposition to amendment.**

**91.** (1) Where in proceedings before the Registrar a proposed amendment under section 80 is advertised, notice of opposition to such an amendment may, within 2 months from the date of advertisement in the journal, be filed on Patents Form 23.

(2) Such notice of opposition shall be accompanied by a copy thereof and be supported by a statement setting out fully the facts upon which the opponent relies and the relief which he seeks.

(3) The Registrar shall send a copy of the notice of opposition and statement to the proprietor of the patent and any other party to the proceedings before the Registrar.

(4) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

## **NATIONAL PROCESSING OF INTERNATIONAL APPLICATIONS**

### **Treatment of international applications.**

**92.** (1) Subject to this rule, in relation to an international application for a patent (Brunei Darussalam) which is, under section 82, to be treated as an application for a patent under the Order, the prescribed period for the purposes of section 83(3) and (5) shall be –

(a) in a case where Brunei Darussalam has been elected in accordance with Chapter II of the Patent Co-operation Treaty, 30 months from the relevant date;  
or

(b) in any other case, 20 months from the relevant date.

(2) Payment of the prescribed fee shall be made within the period prescribed in sub-rule (1)(a) or (b), as the case may be, and if the applicant so wishes, together with the filing of Patents Form 42.

(3) Where an international application for a patent (Brunei Darussalam) has begun the national phase, a request may be made under section 17(4) within one month from the date the national phase of the application begins.

(4) In the case of an international application for a patent (Brunei Darussalam) –

(a) rule 8(1) shall not apply if the applicant, on filing the application, states in writing to the receiving Office that the invention has been displayed at an international exhibition;

(b) rule 8(2), (3) and (4) may be complied with at any time before the end of 2 months from the time limit for entering the national phase;

(c) where an English translation of a document or part of a document is required by the Order or these Rules to be filed before or at the time limit for entering the national phase, verification of the translation, as required under rule 118 and permitted by rule 51 bis 1(d) of the Rules under Patent Co-operation Treaty, may be given to the Registrar at any time before the end of 2 months from that time limit.

(5) For the purposes of section 83(3) and (5), where an English translation of the application or any amendment of the application is required, the translation –

(a) shall exclude the request and abstract unless –

(i) the applicant expressly requests the Registrar to proceed earlier than the expiry of the period prescribed in sub-rule (1); and

(ii) the application has not been published in accordance with the Patent Co-operation Treaty;

(b) shall include any textual matter in the drawings in a form which complies with rule 49.5(d) of the Rules under the Patent Co-operation Treaty;

(c) where a title has been established by the International Searching Authority under rule 37.2 of the Rules under the Patent Co-operation Treaty which differs from the title included in the application as originally filed, shall include the former title in place of the latter; and

(d) may exclude any textual matter contained in a sequence listing forming part of the description if such textual matter complies with rule 12.1(d) of the Rules under the Patent Co-operation Treaty and the description complies with rule 5.2(b) of those Rules.

(6) Where an applicant is required to file a translation into the English language both of an application as originally filed and of the amendment to it, in accordance with sub-rule (5), in order to satisfy the relevant conditions of section 83(3) and (5) and at the expiry of the applicable period referred to in sub-rule (1), the prescribed fee has been paid and one but not both of the necessary translations has been filed –

(a) the Registrar shall give notice to the applicant at the address furnished by the applicant in accordance with rule 35 requiring the applicant to file the required translation within 2 months from the date on which the notice is sent; and

(b) the applicable period shall be treated in respect of that translation as not expiring until the end of the period specified in the notice given under paragraph (a).

(7) The Registrar shall publish any translation supplied in accordance with section 83(3) or (5) following the filing of Patents Form 43 accompanied by the payment of the prescribed fee.

(8) In the case of an international application for a patent (Brunei Darussalam) in respect of which the conditions specified in section 83(3)(a) are satisfied, the period prescribed for the purposes of section 24(2) shall be 2 months from the time limit for entering the national phase.

(9) In the case of an international application for a patent (Brunei Darussalam) in respect of which the conditions specified in section 83(3)(b) are satisfied, the period prescribed for the purposes of section 24(2) shall be the later of the following periods to expire –

- (a) the period prescribed by rule 21(1);
- (b) 2 months from the date on which those conditions are satisfied.

(10) Where, in relation to an international application for a patent (Brunei Darussalam), the applicant desires that section 82(1) shall not cease to apply to the application by virtue of the operation of section 82(3), application shall be made to the Registrar on Patents Form 44, accompanied by a statement of the facts upon which the applicant relies.

(11) An international application for a patent (Brunei Darussalam) shall not be treated as withdrawn under the Order if it, or the designation of Brunei Darussalam in it, is deemed to be withdrawn under the Patent Co-operation Treaty where, in the same or comparable circumstances in relation to an application under the Order (other than an international application for a patent) –

- (a) the Registrar could have directed that an irregularity be rectified under rule 105 or that an extension be granted under rule 114; and
- (b) the Registrar determines that the application would not have been treated as withdrawn under the Order.

(12) Where under section 82(3) an application is not to be treated as withdrawn and the applicant wishes to proceed –

- (a) the Registrar may amend any document received by the Registry from the receiving Office or the International Bureau and alter any period or time which is specified in the Order or these Rules upon such terms (including payment of any appropriate prescribed fee) as he may direct; and
- (b) the fee prescribed under section 83(3) shall not be payable.

(13) Where the applicant satisfies the Registrar that –

(a) because of an error made by the receiving Office, an international application for a patent (Brunei Darussalam) has been accorded a date of filing which is incorrect; or

(b) the priority claim made under Article 8(1) of the Patent Co-operation Treaty has been considered not to have been made by the receiving Office or the International Bureau because of an error made by the Office or the Bureau,

the Registrar may amend any document received by the Registry from the receiving Office or the International Bureau or alter any period or time which is specified in the Order or these Rules as if the error were an error on the part of the Registry.

(14) Where –

(a) an international application for a patent (Brunei Darussalam) purports to designate Brunei Darussalam; and

(b) the applicant alleges that he has been refused a filing date under the said Patent Co-operation Treaty on account of an error or omission in any institution having functions under the said Patent Co-operation Treaty,

the applicant may apply to the Registrar for it to be treated as an application under the Order by filing Patents Form 44, accompanied by a statement of the facts upon which he relies; and the Registrar may amend any document filed by the applicant and alter any period or time which is specified in the Order or these Rules upon such terms as he may direct.

(15) In this rule, “receiving Office” has the same meaning as in the Patent Co-operation Treaty.

(16) In this rule, in relation to an international application for a patent (Brunei Darussalam) –

“relevant date” means the declared priority date or, where there is no declared priority date, the date of filing of that application;

“time limit for entering the national phase” means the end of the relevant period prescribed by sub-rule (1) or, in a case where that period has been

extended under sub-rule (6), rule 105 or 114, the end of that period as so extended.

## **HEARINGS, AGENTS AND CORRECTION OF ERRORS**

### **Registrar's discretionary powers.**

**93.** Before exercising any discretionary power vested in him by or under the Order adversely to any party to a proceeding before him, the Registrar shall, if so required, hear such person thereon.

### **Request for hearing.**

**94.** (1) A request for the exercise of the discretionary powers of the Registrar under rule 83 shall be made on Patents Form 45 and shall be filed within one month from the date of notification by the Registrar of any objection to an application or the date of any other indication that he proposes to exercise a discretionary power, and the Registrar may refuse to hear any party who has not filed the request within the time allowed.

(2) Upon receipt of a request under sub-rule (1), the Registrar shall send to the person making the request a notice of a time when he may be heard which shall be not less than 14 days from the date of the notice.

(3) In *inter partes* proceedings, any party who intends to refer at the hearing to any document not already mentioned in the proceedings shall, unless the Registrar consents and the other party agrees, give at least 14 days' notice of his intention with details of, or a copy of, the document to the Registrar and the other party.

(4) After hearing the party or parties desiring to be heard or, if no party so desires, without a hearing, the Registrar shall decide the matter and shall notify all parties of his decision and, if any party so desires, shall give his reasons for the decision.

### **Hearings in public.**

**95.** (1) Subject to sub-rule (2), where a hearing before the Registrar of any dispute between 2 or more parties relating to any matter in connection with a patent or an application



for a patent takes place after the publication of the application under section 27, the hearing of the dispute shall be in public.

(2) After consulting those parties to the dispute who appear in person or are represented at a hearing to which sub-rule (1) applies, the Registrar may direct that the hearing not be held in public.

### **Right of audience.**

**96.** (1) Unless the Registrar directs otherwise in any particular case –

(a) all attendances upon the Registrar by a party to any proceedings before the Registrar or any other matter under the Order or these Rules may be made by or through –

- (i) an advocate and solicitor; or
- (ii) any other person,

appointed by the party to act on his behalf; and

(b) every notice, application or other document filed under the Order by the party may be signed by the advocate and solicitor or the person so appointed.

(2) Where any party to any proceedings before the Registrar or any other matter under the Order or these Rules appoints an advocate and solicitor or any other person –

- (a) to act on his behalf; or
- (b) to act on his behalf in substitution for another,

the advocate and solicitor or person shall file a declaration of authorisation in Patents Form 46 on the first occasion when he acts on behalf of the party.

### **Correction of errors in patents and applications.**

**97.** (1) Except where rule 9(3) or 62(3) applies, a request for the correction of an error of translation or transcription or of a clerical error or mistake in any specification of a patent, in an application for a patent or in any document filed in connection with a patent or such an application shall be made on Patents Form 28.

(2) The request shall be accompanied by a copy of the document with the proposed correction indicated in the following manner –

(a) by striking through any text, figure or other matter to be replaced or deleted; and

(b) by underlining any replacement text, figure or other matter.

(3) Where such a request relates to a specification, no correction shall be made therein unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

(4) Where the Registrar requires notice of the proposed correction to be advertised, he shall inform the applicant in writing accordingly and request him, within 2 months from the date of his letter, to file Patents Form 47; and upon receipt of the form the Registrar shall proceed with the advertisement.

(5) The advertisement under sub-rule (4) shall be made by publication of the request and nature of the proposed correction in the journal and in such other manner as the Registrar may direct.

(6) Any person may, at any time within 2 months from the date of the advertisement, give notice to the Registrar of opposition to the request on Patents Form 48.

(7) Such notice of opposition shall be accompanied by a supporting statement setting out fully the facts on which the opponent relies and the relief which he seeks.

(8) The Registrar shall send a copy of the notice and the statement to the person making the request who, if he desires to proceed with the request, shall, within 2 months from the date of the Registrar's letter forwarding such copies to him, file a counter-statement on Patents Form 3 setting out fully the grounds on which he contests the opposition and the Registrar shall send a copy of the counter-statement to the opponent.

(9) The Registrar may give such directions as he may think fit with regard to the subsequent procedure.

(10) Where the Registrar grants the request for correction, the person making the request shall, if the Registrar so requires, and within the time specified by the Registrar, file a new specification as amended, which shall be prepared in accordance with rules 22, 24 and 26.

(11) No amendment or correction (other than an amendment or correction introduced in order to comply with the formal requirements) may be introduced in the new specification to be filed under sub-rule (10).

## **INFORMATION AND INSPECTION**

### **Information about patents and patent applications.**

**98.** (1) A request under section 105 for information relating to any patent or application for a patent may be made as to –

(a) the date that the reports or information, as the case may be, referred to in section 30(2) were received by the Registrar;

(b) when the specification of a patent or application for a patent was published;

(c) when an application for a patent was withdrawn, was treated as having been withdrawn, was treated as having been abandoned, was refused or was treated as having been refused;

(d) whether a renewal fee was not paid within the period prescribed for the purposes of section 35(2);

(e) whether a renewal fee was paid within the 6 months referred to in section 35(3);

(f) when a patent has ceased to have effect and/or an application for restoration of a patent was filed;

(g) when an entry was made in the register or an application was made for the making of such entry;

(h) when any application or request was made or action taken involving an entry in the register or advertisement in the journal, if the nature of the application, request or action is specified in the request;

(i) when any document may be inspected in accordance with rule 99 or 100; and

(j) such other particulars referred to in any patent or application for a patent as the Registrar may in any particular case allow.

(2) As regards information relating to any patent in force by virtue of section 115(4), a request may also be made as to when –

(a) a certificate of registration was issued;

(b) the patent was first renewed under this Order; and

(c) an entry was made in the Register of Patents under the repealed Inventions Act (Chapter 72).

(3) Any such request shall be made on Patents Form 49 and a separate form shall be used in respect of each item of information required.

### **Inspection of documents.**

**99.** (1) Subject to sub-rule (5), and to the restrictions prescribed in sub-rule (4), after the date of publication of an application for a patent in accordance with section 27, the Registrar shall, upon request made on Patents Form 30 and upon payment of the prescribed fee, permit all documents filed or kept at the Registry in relation to the application or any patent granted in pursuance of it, to be inspected at the Registry.

(2) Subject to the same restrictions and rule 102 where the circumstances specified in section 105(4) or (5) exist, the Registrar shall, upon request made on Patents Form 30, and upon payment of the prescribed fee, permit inspection of such documents before the publication in accordance with section 27.

(3) Where a declaration has been made in accordance with section 17(2), inspection of any application referred to therein and of any translation thereof shall be permitted upon request under sub-rule (1) or (2) without payment of any fee.

(4) The restrictions referred to in sub-rule (1) are –

(a) that no document shall be open to inspection until 14 days after it has been filed at the Registry;

(b) that documents prepared in the Registry solely for use therein shall not be open to inspection;

(c) that any document sent to the Registry, at its request or otherwise, for inspection and subsequent return to the sender, shall not be open to inspection;

(d) that no request made under rule 65, 68(2), 98 or this rule shall be open to inspection; and

(e) that documents in respect of which the Registrar issues directions under rule 100 that they are to be treated as confidential shall not be open to inspection, except as permitted in accordance with that rule.

(5) Nothing in this rule shall be construed as imposing on the Registrar any duty of making available for public inspection any document or any part of a document –

(a) which in his opinion disparages any person in a way likely to damage him; or

(b) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

(6) No appeal shall lie from a decision of the Registrar under sub-rule (5) not to make a document or part of a document available for public inspection.

### **Confidential documents.**

**100.** (1) Where a document other than a Patents Form is filed at, or sent to, the Registry, and the person filing or sending it or any party to the proceedings to which the document relates so requests, giving his reasons, within 14 days from the filing or sending of the document, the Registrar may direct that it be treated as confidential, and the document shall not be open to public inspection while the matter is being determined by the Registrar.

(2) Where such a direction has been given and not withdrawn, nothing in this rule shall be taken to authorise or require any person to be allowed to inspect the document to which the direction relates except by leave of the Registrar.

(3) The Registrar shall not withdraw any direction given under this rule nor shall he give leave for any person to inspect any document to which a direction which has not been withdrawn relates without prior consultation with the person at whose request the direction was given, unless the Registrar is satisfied that such prior consultation is not reasonably practicable.

(4) Where such a direction is given or withdrawn, a record of the fact shall be filed with the document to which it relates.

(5) Where the period referred to in sub-rule (1) is extended under rule 114, the relevant document shall not be, or, if the period is extended upon expiry, the relevant document shall cease to be open to public inspection until the expiry of the extended period, and, if a request for a direction is made, the document shall not be open to public inspection while the matter is being determined by the Registrar.

**Publication of bibliographic information.**

**101.** The following bibliographic information is prescribed for the purposes of section 105(3)(a) –

(a) the number of the application;

(b) the date of filing of the application and, where a declaration has been made under section 17(2), the filing date, country and file number, when available, of each application referred to in that declaration;

(c) the name of the applicant or applicants including any applicant or applicants resulting from an order under section 20;

(d) an alteration of the name of the applicant or applicants under rule 62;

(e) the title of the invention; and

(f) if the application has been withdrawn, has been treated as having been withdrawn, has been treated as having been abandoned, has been refused or has been treated as having been refused, that fact.

**Request for information on unpublished patent applications.**

**102.** (1) Where the circumstances specified in section 105(4) exist, a request under section 105(1) shall be accompanied by a statutory declaration verifying their existence and such documentary evidence (if any) supporting the request as the Registrar may require.

(2) The Registrar shall send a copy of the request, the declaration and the evidence (if any) to the applicant for the patent and shall not comply with the request until the expiry of 14 days thereafter.

**GENERAL**

**Service of documents.**

**103.** (1) Any notice, application or other document authorised or required by the Order or these Rules to be filed at or sent to or from the Registry may be sent through the post, and the service and filing shall be deemed to be effected by properly addressing, prepaying and posting a letter containing the document, and unless the contrary is proved, shall be deemed to have been effected at the time at which the letter would be delivered in the ordinary course of post.

(2) Any notice, application, request or other document authorised or required by the Order or these Rules to be filed at or sent to or from the Registry may be filed or sent by means of facsimile transmission in accordance with the procedure set out in practice directions issued by the Registrar.

(3) A document containing an indication that a patent is sought in pursuance of an application, and any document or correspondence relating thereto and not requiring the payment of any prescribed fee, may be transmitted by facsimile subject to the following provisions –

(a) where the sender has attempted to transmit a document by facsimile, but part or all of the document received by the Registry is illegible or part of the document is not received by the Registry, the document shall be treated as not having been submitted; and

(b) the burden of proving legibility and completeness of transmission lies with the sender.

**Hours of business and excluded days.**

**104.** (1) Subject to sub-rules (4) and (6), any business done under the Order or these Rules –

(a) on any day after the hours of business of the Registry for that class of business; or

(b) on any day which is an excluded day for that class of business,

shall be taken to have been done on the next following day which is not an excluded day for that class of business.

(2) Where the time for doing any business under the Order or these Rules expires on an excluded day for the doing of that class of business, that time shall be extended to the next following day which is not an excluded day for the doing of that class of business.

(3) For the avoidance of doubt, where the time for the submission or filing of any document pertaining to an application for a patent by means of the Patents Deposit Box expires on an excluded day for the submission or filing of that document in that manner, that time shall be extended to the next following day which is not an excluded day for the submission or filing of that document in that manner, notwithstanding the availability of the Patents Deposit Box for the submission or filing of that document.

(4) Where a document is submitted or filed by means of the Patents Deposit Box at any time before midnight on any day which is not an excluded day for the business of submitting or filing that document, that document shall be treated as submitted or filed at that time and on that day.

(5) For the purposes of sub-rule (4), a document shall be treated as submitted or filed if all sheets comprising the complete document have been deposited in the Patents Deposit Box.

(6) Subject to rule 103(3), where a document referred to in rule 103(3) –



(a) is transmitted to the Registrar or Registry by means of facsimile transmission; and

(b) is received –

(i) by any facsimile machine designated by the Registry for the receipt of such transmissions; and

(ii) at any time before midnight on any day which is not an excluded day for the business of sending to or filing with the Registry of that document by means of facsimile transmission,

that document shall be treated as sent to or filed with, and received by, the Registry at that time and on that day.

(7) For the purposes of sub-rule (6) –

(a) a document shall be treated as sent to or filed with, and received by, the Registry if sheets comprising the complete document are received by the facsimile machine referred to in that paragraph; and

(b) the date and time of receipt of the document, as recorded by the facsimile machine referred to in that sub-rule, shall, until the contrary is proved, be treated as the date and time when the document was sent to or filed with, and received by, the Registry.

(8) In the Order and these Rules, “excluded day”, in relation to any specific class of business, means any day on which the Registry shall be taken to be closed for the purposes of the transaction by the public of that class of business.

(9) In this rule, “Patents Deposit Box” means the box with openings for placing documents that is installed at the premises of the Registry and designated as such.

### **Correction of irregularities.**

**105.** (1) Subject to sub-rule (2), any document filed in any proceedings before the Registrar may, if he thinks fit, be amended, and any irregularity in procedure in or before the Registry may be rectified, on such terms as he may direct.

(2) In the case of an irregularity or prospective irregularity –

(a) which consists of a failure to comply with any limitation as to times or periods prescribed in these Rules which has occurred or appears to the Registrar is likely to occur in the absence of a direction under this rule;

(b) which is attributable wholly or in part to an error, default or omission on the part of the Registry; and

(c) which it appears to the Registrar should be rectified,

the Registrar may direct that the time or period in question shall be altered but not otherwise.

(3) Sub-rule (2) is without prejudice to the Registrar's power to extend any time or period under rule 114 or 116.

### **Dispensation by Registrar.**

**106.** Where, under these Rules, any person is required to do any act or thing, or any document or evidence is required to be produced or filed, and it is shown to the satisfaction of the Registrar that from any reasonable cause that person is unable to do that act or thing, or that document or evidence cannot be produced or filed, the Registrar may, upon the production of such evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing, or the production or filing of such document or evidence.

### **Filing of evidence.**

**107.** (1) Where under these Rules evidence may be filed, it shall be by statutory declaration or affidavit.

(2) The original statutory declaration or affidavit shall be filed, unless the Registrar directs in any particular case that a copy thereof may be filed.

(3) Unless the Registrar directs otherwise, he –

(a) may, if he thinks fit in any particular case, *in lieu* of or in addition to such evidence –

(i) take oral evidence; or

(ii) accept any written statement or documentary evidence; and

(b) shall allow any witness to be cross-examined on any evidence given by the witness.

**Statutory declarations and affidavits.**

**108.** Any statutory declaration or affidavit, the original or a copy of which is to be filed under the Order or these Rules, shall be made and subscribed as follows –

(a) in Brunei Darussalam, before any justice of the peace, or any commissioner or other officer authorised by any written law to administer an oath for the purpose of any legal proceedings;

(b) in any part of the Commonwealth except Brunei Darussalam, before any judge, justice of the peace, or any officer authorised by any written law to administer an oath for the purpose of any legal proceedings; and

(c) elsewhere, before a Brunei Darussalam consul or vice-consul, or other person performing the functions of a Brunei Darussalam vice-consul, or before a notary public, judge or magistrate, or any officer authorised by any written law to administer an oath for the purpose of any legal proceedings.

**Admission of documents.**

**109.** Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by rule 108 to take a declaration, in testimony that the declaration was made and subscribed before him, may be admitted by the Registrar without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

**Directions as to furnishing of documents.**

**110.** At any stage of –

(a) any proceedings before the Registrar; or

(b) any other matter under the Order or these Rules,

the Registrar may direct that such documents, information or evidence as he may require shall be furnished within such period as he may fix.

**Filing of miscellaneous documents.**

**111.** Where –

(a) it is provided or directed that a specific numbered form is to be accompanied by a document when that form is filed at or submitted to the Registry, and that form is filed or submitted without that document;

(b) any person wishes to file at or submit to the Registry any document (other than any letter to the Registrar or the Registry), and there is no provision or direction for that document to be filed or submitted using any specific numbered form; or

(c) the Registrar has directed that a document be filed at or submitted to the Registry using Patents Form 99, that document shall be filed or submitted using Patents Form 99.

### **Supporting statements or evidence.**

**112.** (1) Where, by virtue of any of the rules mentioned in sub-rule (2), any notice or application is required to be supported by a statement or evidence, such a statement or evidence shall be filed on, or within 14 days after, the date on which the notice is given or the application is made.

(2) The rules referred to in sub-rule (1) are rules 56(3), 58(1), 60(3), 78(1), 79(2), 91(2) and 97(7).

### **Appointment of scientific advisers by Registrar.**

**113.** (1) The Registrar may at any time and on his own motion nominate a scientific adviser or scientific advisers from a panel of advisers to assist him in any proceeding under the Order or these Rules, either –

(a) by sitting with the Registrar at the hearing of the proceedings; or

(b) by inquiring and reporting on any question of fact or opinion not involving a question of law or construction,

as the Registrar may direct.

(2) Upon the nomination of a scientific adviser under sub-rule (1), the Registrar shall notify all parties to the proceedings of his nominated adviser.

(3) The question to be submitted to the nominated adviser and the instructions to be given to him shall, failing agreement between the parties, be settled by the Registrar.

(4) The remuneration of the nominated adviser for assisting in proceedings under the Order or these Rules, including his allowance and expenses, shall be as determined by the Registrar in accordance with the provisions of the Fifth Schedule.

(5) Without prejudice to any other order of the Registrar in providing for payment of a nominated adviser's remuneration, the party shall be liable, or where there are more than one party to the proceedings be jointly and severally liable, to pay the amount determined by the Registrar as the nominated adviser's remuneration.

(6) The payment of the remuneration of the nominated adviser by the party, or where more than one party to the proceedings are liable for such remuneration by the parties, shall be through such mode and in such manner as the Registrar may direct.

(7) Where the proceedings under the Order or these Rules are initiated by a party who neither resides nor carries on business in Brunei Darussalam, the Registrar may require the party to give security for the remuneration of the nominated adviser, and in default of such security being given, may treat the proceedings as being abandoned.

**Alteration of time limits.**

**114.** (1) The times or periods prescribed by these Rules for doing any act or taking any proceedings or specified by the Registrar thereunder, other than the times or periods prescribed in the provisions mentioned in sub-rules (3) and (4), may, on written request by a party, be extended by the Registrar if he thinks fit, upon such notice to the parties and upon such terms as he may direct.

(2) Any extension may be granted under sub-rule (1) notwithstanding that the time or period for doing such act or taking such proceedings has expired.

(3) The provisions referred to in sub-rule (1) are –

(a) rules 8(1), 9(1), (2) and (3), 10(1) and (2)(a), 22(2), 29(5), 30(1) and (5)(a), 32(a), (b), (c) and (d), 37(2), 48(6) and (7)(c), 50(1), 52, 54(1) and (3), 55(1)

and (2), 56(2), 57(4) and (8), 58(1), 60(2), 78(1), 79(1), 80, 91(1), 92(3), 97(4) and (6) and paragraph 4(2) of the Fourth Schedule;

(b) rule 29(3) (except so far as it relates to the filing of the documents prescribed under rule 29(4)(a) and (b));

(c) rule 30(4) (except so far as it relates to the furnishing of the information prescribed under rule 30(6)(b) and the filing of the documents prescribed under rule 30(7)); and

(d) rule 37(5) (except so far as it relates to the furnishing of the information prescribed under rule 37(7)(b) and the filing of the documents prescribed under rule 37(8)).

(4) A time or period prescribed in –

(a) rule 10(5), 11(1) or (4), 12(1), 21(1), 22(11), 29(2), 32(e), (f) or (g), 40, 45, 47(1) or (2), 58(5), 98(1), (6), (8) or (9), 118(4) or (5)(b) or paragraph 1(3) of the Fourth Schedule;

(b) rule 29(3) (so far as it relates to the filing of the documents prescribed under rule 29(4)(a) and (b));

(c) rule 30(4) (so far as it relates to the furnishing of the information prescribed under rule 30(6)(b) and the filing of the documents prescribed under rule 30(7)); or

(d) rule 37(5) (so far as it relates to the furnishing of the information prescribed under rule 37(7)(b) and the filing of the documents prescribed under rule 37(8)),

shall, if not previously extended, be extended for a period not exceeding 3 months upon filing Patents Form 50 before the end of the period for which extension is sought.

(5) Where in any proceedings more than one such time or period referred to in sub-rule (4) expires on the same day (but not otherwise), those times or periods may be extended upon the filing of a single Patents Form 50.

(6) Notwithstanding sub-rule (4) but subject to sub-rule (7) –

(a) a time or period prescribed in the rules referred to in sub-rule (4) may, upon request made on Patents Form 52, be extended or further extended if the

Registrar thinks fit, whether or not the time or period (including any extension obtained under sub-rule (4)) has expired; and

(b) the Registrar may allow an extension, or further extension, under this sub-rule –

- (i) on such terms as he may direct; and
- (ii) subject to the furnishing of a statutory declaration or affidavit setting out the grounds for the request.

(7) Where the period under rule 92(1) has expired and a request to extend the period is made under sub-rule (6) within 42 months from –

(a) the declared priority date; or

(b) where there is no declared priority date, the date of filing of the application for a patent, the Registrar shall allow an extension for a period not exceeding 12 months if he is satisfied, after considering the statutory declaration or affidavit setting out the grounds for the request, that the delay giving rise to the request was unintentional.

(8) A single request may be made under sub-rule (6) for the extension of more than one time or period in the same proceedings if the extensions are to be made to a common date (but not otherwise).

(9) If, on consideration of a request under sub-rule (6), the Registrar decides that the extension requested (or, in a case falling within sub-rule (8), any or all of the extensions requested) may be granted, he shall notify the applicant accordingly and invite him, within 2 months from the date the notification is sent to him, to file Patents Form 53, upon receipt of which the Registrar shall effect the extension or extensions in accordance with the decision.

(10) Where the period within which any party to a dispute may file evidence under these Rules is to begin after the expiry of any period in which any other party may file evidence under these Rules and that other party notifies the Registrar that he does not wish to file any, or any further, evidence, the Registrar may direct that the period within which the first-mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

**Protection and compensation of persons affected by extension of time.**

**115.** (1) Where the Registrar has granted an extension of time of more than 3 months under rule 105(2), 114(1) or 114(6) for any act in relation to an application for a patent that had been published under section 27, or in proceedings under the Order or these Rules which has not been so done within the time required, he shall publish in the journal a notification of his decision.

(2) Where the Registrar has granted an extension of time for more than 3 months or has refused an application for extension of time for more than 3 months under rule 105(2), 114(1) or 114(6) for any act in relation to an application for a patent that had been published under section 27, or in proceedings under the Order or these Rules, and where the court reviews the decision of the Registrar under section 87 or 88 and decides to vary the decision under review or set aside the decision under review and make a decision in substitution for the decision so set aside, the Registrar shall cause to be published in the journal a notification of the decision of the court.

(3) Where a notification referred to in sub-rule (1) or (2) has been published, a person who availed himself, or took definite steps by way of contract or otherwise to avail himself, of the invention and the subject of the application for the patent concerned by reason of the act or step in relation to which the extension was granted not having been done or taken within the time allowed shall have the right to continue to avail himself of the invention but this right does not extend to granting a licence to another person in respect of the invention.

(4) If the person entitled to the right conferred by sub-rule (3) availed himself, or took the steps to avail himself, of the invention in the course of business, that person may –

(a) authorise any partners of his for the time being in that business to avail themselves of the invention; and

(b) assign that right, or transmit it on death (or in the case of a body corporate, on its dissolution), to any person who acquires that part of the business.



(5) Where a product is disposed of to another in exercise of the rights conferred by sub-rule (3) or (4), that other person and any person claiming through him may deal with the product in the same way as if it has been disposed by the registered proprietor of the patent.

**Calculation of times or periods.**

**116.** (1) Where, on any day, there is –

(a) a general interruption or subsequent dislocation in the postal services of Brunei Darussalam; or

(b) an event or circumstances causing an interruption in the normal operation of the Registry,

the Registrar may certify the day as being one on which there is an interruption and, where any period of time specified in the Order or these Rules for the giving, making or filing of any notice, application or other document expires on a day so certified the period shall be extended to the first following day (not being an excluded day) which is not so certified.

(2) Any certificate of the Registrar given pursuant to this rule shall be posted on the notice board in the Registry.

(3) Where, in or in connection with an application for a patent (“the application in suit”), it is desired to make a declaration specifying for the purposes of section 17(2) an earlier relevant application and the period of 12 months immediately following the date of filing the earlier relevant application ends on a day which is an excluded day for the purposes of section 108, then if the declaration is made on the first following day on which the Registry is open for the transaction of such business, such period shall be altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration is made in or in connection with the application in suit.

(4) Where it is desired to make such a declaration and the period of 12 months referred to in sub-rule (3) from the date of filing the earlier relevant application ends on a day certified under sub-rule (1) as being one on which there is an interruption, and if the declaration is made on the first day after the end of the interruption, the period shall be

altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration is made in or in connection with the application in suit.

(5) Where an application for a patent is filed on the day immediately following a day which is certified under sub-rule (1) as being one on which there is an interruption or which is an excluded day for the purposes of section 108, the period of 12 months specified in section 14(4) shall be computed from the day after the next preceding day which is neither so certified nor so excluded.

(6) If in any particular case the Registrar is satisfied that the failure to give, make or file any notice, application or other document within –

(a) any period of time specified in the Order or these Rules for such giving, making or filing;

(b) the period of 12 months following a disclosure of matter constituting an invention falling within paragraph (a), (b), (c) or (d) of section 14(4); or

(c) the period of 12 months referred to in paragraph (3),

was wholly or mainly attributable to a failure or undue delay in the postal services in Brunei Darussalam, the Registrar may, if he thinks fit –

(i) extend the period of time for the giving, making or filing so that it ends on the day of the receipt by the addressee of the notice, application or other document (or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day);

(ii) determine that the period of 12 months referred to in subparagraph (b) shall be altered so that it begins on the day of the disclosure and ends on the day of receipt by the Registry of the application for the patent (or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day); or

(iii) determine that the period of 12 months referred to in sub-rule (3) shall be altered so as to include both the day of filing of the earlier relevant application and the day on which the declaration specifying that application is received by the

Registry (or, if the day of such receipt is an excluded day, the first following day which is not an excluded day),

as the case may be, in each case upon such notice to other parties and upon such terms as he may direct.

**Copies of documents.**

**117.** (1) Where a document, other than a published Brunei Darussalam specification or application, is referred to in any reference, notice, statement, counter-statement or evidence required by the Order or these Rules to be filed at the Registry or sent to the Registrar, one copy of that document shall be furnished to the Registry within the period that the reference, notice, statement, counter-statement or evidence may be filed or sent.

(2) Where a copy of any evidence is required by the Order or these Rules to be sent direct to any person, a copy of any document referred to in that document shall also be sent direct to that person.

**Translations.**

**118.** (1) Except as expressly provided in the Order or these Rules, this rule shall apply where, in pursuance of the Order or these Rules, there is filed at the Registry or sent to the Registrar –

- (a) any document or part of a document which is in a language other than the English language; or
- (b) an English translation of any document or part of a document.

(2) Subject to sub-rule (3), where any document or part of a document filed at the Registry or sent to the Registrar is in a language other than the English language, an English translation of the document or part shall be filed or sent together with the document or part.

(3) Where the document or part has been or will be translated into the English language under the Patent Co-operation Treaty, the Registrar may permit the English translation to be filed or sent after the document or part has been filed at the Registry or sent to the Registrar.

(4) Where any English translation of a document or part of a document is filed at the Registry or sent to the Registrar under sub-rule (2) –

(a) the Registrar may refuse to accept the translation if it is in his opinion inaccurate; and

(b) if he does so –

(i) he shall notify the person who filed or sent the translation of his refusal to accept the translation; and

(ii) another English translation of the document or part shall be filed or sent within 2 months from the date of the Registrar's notification.

(5) Where any English translation of a document or part of a document is filed at the Registry or sent to the Registrar under sub-rule (2) –

(a) there shall be filed or sent together with the translation a copy of a verification document –

(i) made in accordance with the Registrar's requirements; and

(ii) verifying that the translation corresponds to the original text of the document or part; and

(b) the Registrar may, by notice, require to be filed at the Registry or sent to the Registrar, within 2 months from the date of the notice, the original of the verification document.

(6) Where any document or part of a document filed at the Registry or sent to the Registrar is in a language other than English, the Registrar may treat the document or part as not having been filed or sent unless –

(a) there is sent or filed together with the document or part –

(i) an English translation of the document or part; and

(ii) a copy of a verification document under sub-rule (5)(a) made in respect of the translation; and

(b) if the Registrar has issued a notice under sub-rule (5)(b), the original of the verification document is filed at the Registry or sent to the Registrar within 2 months from the date of the notice.

(7) sub-rules (4), (5) and (6)(a)(ii) and (b) shall not apply to any document or part of a document translated into English under the Patent Co-operation Treaty.

#### **Publication and sale of documents.**

**119.** The Registrar may arrange for the publication and sale of copies of specifications and other documents in the Registry and of indexes to, and abridgements or abstracts of, such documents.

#### **Journal.**

**120.** (1) The Registrar shall publish a journal containing particulars of applications for and grant of patents and other proceedings under the Order and any other information that he may deem to be generally useful or important.

(2) The journal shall be entitled “The Patents Journal”.

(3) Unless the Registrar otherwise directs, the journal shall be published monthly.

#### **Reports of cases.**

**121.** The Registrar may from time to time publish reports of –

(a) cases relating to patents decided by him; and

(b) cases relating to patents (whether under the Order or otherwise) decided by any court or body (whether in Brunei Darussalam or elsewhere), being cases which he considers to be generally useful or important.

## **INTERNATIONAL APPLICATIONS**

#### **Filing of international applications.**

**122.** (1) Where the Registry is the competent receiving Office under the Patent Co-operation Treaty, an international application for a patent shall be filed at the Registry in the English language in triplicate.

(2) If less than 3 copies of the international application for a patent are so filed, upon preparation by the Registry of the number of copies of it required to bring the total to 3,

the applicant shall on demand pay to the Registry the appropriate charge for the preparation of the additional copies required.

**Fees for international applications.**

**123.** (1) Subject to sub-rule (5), payment of the transmittal fee referred to in rule 14 of the Rules under the Patent Co-operation Treaty shall be made to the Registry, accompanied by Patents Form 54, within one month from the date on which the international application for a patent to which it relates is filed at the Registry.

(2) Where, in accordance with rule 19.4(a) of the Rules under the Patent Co-operation Treaty, an international application for a patent is considered to have been received by the Registry on behalf of the International Bureau as receiving Office, the transmittal of the application by the Registry shall be subject to a payment of the fee under rule 19.4(b) of those Rules.

(3) Subject to sub-rule (5), payment of the international filing fee referred to in rule 15.1 of the Rules under the Patent Co-operation Treaty shall be made to the Registry within the period referred to in rule 15.4 of those Rules.

(4) Subject to sub-rule (5), payment of the search fee referred to in rule 16.1 of the Rules under the Patent Co-operation Treaty shall be made to the Registry within the period referred to in rule 16.1(f) of those Rules.

(5) Where the payment of a fee referred to in sub-rule (1), (3) or (4) has not been made to the Registry within the period prescribed under the applicable sub-rule (referred to in this sub-rule as the specified period) –

(a) the Registry shall give notice to the applicant requiring the applicant to pay the Registry the outstanding fee and a late payment fee calculated in accordance with rule 16 bis.2 of the Rules under the Patent Co-operation Treaty within one month from the date on which the notice is sent to the applicant; and

(b) the specified period shall be treated in respect of the outstanding fee as not expiring until the end of the one-month period referred to in paragraph (a).

(6) Where an international application for a patent is filed at the Registry as receiving Office, and a request is made under rule 26 bis.3(a) of the Rules under the Patent Co-operation Treaty, payment of the prescribed fee shall be made to the Registry within the period referred to in rule 26 bis.3(e) of those Rules.

**Certified copies.**

**124.** A request under rule 17.1 or rule 21.2 of the Rules under the Patent Co-operation Treaty for a certified copy of an international application for a patent as filed with the Registry as receiving Office and of any corrections thereto shall be made on Patents Form 31 and shall be accompanied by the appropriate fee.

**Fee currency.**

**125.** The fees referred to in rules 123 and 124 shall be paid in Brunei dollars.

**FIRST SCHEDULE**

rules 3 and 65

**FEES PAYABLE**

	<i>Matter of Proceeding</i>	<i>Amount</i> \$	<i>Corresponding</i> <i>Form No.</i>
1.	On filing a request for the grant of a patent	160	1
2.	On reference under section 20(1) or 48(1)	450	2
3.	On filing a counter-statement in each of the following cases –	40	3
	(a) Opposing the making of an order under section 20 or 48		
	(b) Opposing a request under section 22		
	(c) In respect of a reference under section 23(5)		
	(d) Opposing an application under section 24		
	(e) In answer to a notice of opposition under section 38		
	(f) In answer to a notice of opposition under section 41		
	(g) In respect of a reference under section 49(5)		
	(h) In respect of an application under section 55(3)		
	(i) In answer to a notice of opposition under section 56(7)		
	(j) In respect of a reference under section 65(3)		
	(k) On contesting an application under section 76 for declaration of non- infringement		
	(l) On contesting an application under section 77 for revocation of a patent		
	(m) In answer to a notice of opposition under section 104(2) to the correction of an error, clerical error or mistake		



	<i>Matter of Proceeding</i>	<i>Amount</i> \$	<i>Corresponding</i> <i>Form No.</i>
4.	On application under section 20(5) or 48(3) for authorisation by Registrar	50	4
5.	On request for directions under section 22	450	5
6.	On reference under section 23(5) or 49(5) to determine the question of a licence	450	6
7.	On application to the Registrar under section 24(1) and/or 24(3)	450	7
8.	On filing a statement of inventorship and of right to the grant of a patent	–	8
9.	On request for early publication under section 27(2)	50	9
10.	On filing a notice of withdrawal of an application for a patent under section 27(1)	–	10
11.	On filing a request for a search report or a supplementary search report	1,750	11
12.	On filing a request for a search and examination report	2,600	12
13.	On furnishing information referred to in rule 46(1)	–	14
14.	On filing a notice of intention to rely on an international preliminary report on patentability	–	15
15.	On filing a request for an examination report	1,100	16
16.	On request to amend application before grant	–	17
17.	On filing a response to a written opinion under section 31 or 39	–	18
18.	On request that a certificate of grant be issued –		19
	(a) where the application for a patent has not more than 25 claims in the patent specification when rule 49(3) is complied with	200	
	(b) where the application for a patent has more than 25 claims in the patent specification when rule 49(3) is complied with	200 plus 20 for each claim in excess of 25 claims	

	<i>Matter of Proceeding</i>	<i>Amount</i> \$	<i>Corresponding</i> <i>Form No.</i>
19.	On payment of renewal fee (not including payment of back renewal fees pursuant to restoration or cancellation of entry in the register that licences are available as of right)	–	20
	(a) for each year in respect of the 5th, 6th or 7th year of the patent	160	
	(b) for each year in respect of the 8th, 9th or 10th year of the patent	270	
	(c) for each year in respect of the 11th, 12th or 13th year of the patent	350	
	(d) for each year in respect of the 14th, 15th or 16th year of the patent	450	
	(e) for each year in respect of the 17th, 18th or 19th year of the patent	550	
	(f) for the 20th year of the patent	650	
	(g) for each year after the 20th year of the patent	950	
20.	On payment of an additional fee for renewal under section 35(3) –		21
	(a) not exceeding one month	50	
	(b) each succeeding month (but not exceeding 6 months)	100	
21.	On application to amend specification after grant	100	22
22.	On notice of opposition to amendment of specification after grant	480	23
23.	On application for the restoration of a patent	500	24
24.	On payment of additional fee on the application for the restoration of a patent	300	25
25.	On filing an offer to surrender a patent	70	26
26.	On notice of opposition to offer to surrender a patent	250	27

	<i>Matter of Proceeding</i>	<i>Amount</i>	<i>Corresponding</i>
		\$	<i>Form No.</i>
27.	On application to register or give notice of a transaction, instrument or event affecting the rights in a patent or an application for a patent – for each patent or application for a patent affected by such transaction, instrument or event	70	29
28.	On filing a request, in respect of one or more patents or applications for patents, for – (a) each alteration or correction of name (b) each alteration or correction of address (not being an address for service)	12	28
29.	On filing a request, in respect of each patent or application for a patent, for – (a) each alteration or correction of address for service (b) each correction of an error in the register or any connected document (c) each correction of an error of translation or transcript or clerical error or mistake in the specification of a patent, in an application for a patent or in any document filed in connection with a patent or such an application	12	28

	<i>Matter of Proceeding</i>	<i>Amount</i> \$	<i>Corresponding</i> <i>Form No.</i>
30.	On request for the furnishing of or access to miscellaneous information –		30
	(a) fee for inspecting each file or document relating to a patent or patent application	6.50	
	(b) fee for furnishing each file or document	6	
	(c) fee for photocopying each page or part thereof of any other document by the staff of the Registry	0.30	
	(d) where the document is placed in the public search room –		
	(i) fee for self-service photocopying of each page or part of the document using a stored-value card	0.15	
	(ii) fee for photocopying of each page or part thereof by the staff of the Registry	0.30	
31.	On request for certificate of the Registrar –		31
	(a) by impressed stamp –		
	(i) for the first 20 sheets	18	
	(ii) for each additional sheet thereafter	0.30	
	(b) sealed and attached to the documents –		
	(i) for the first 20 sheets	30	
	(ii) for each additional sheet thereafter	0.30	
	(c) in respect of a priority document under rule 17.1(b) of the Regulations under the Patent Co-operation Treaty	50	
	(d) in respect of a certified copy of the international application for a patent under rule 124	28	
32.	On application for entry of order of court in the register	10	32

	<i>Matter of Proceeding</i>	<i>Amount</i> \$	<i>Corresponding</i> <i>Form No.</i>
33.	On application by proprietor for entry to be made in the register to the effect that licences under the patent are to be available as of right	70	33
34.	On application for settlement of terms of licence of right	380	34
35.	On application under section 56(1) or section 56(3) for cancellation of entry in the register	70	35
36.	On notice of opposition to an application under section 56(1) or 56(3) for cancellation of entry in the register	90	36
37.	On reference to the Registrar of a dispute as to infringement	280	37
38.	On application for declaration of non- infringement	280	38
39.	On application under section 77 for the revocation of a patent	500	40
40.	On request for re-examination of a patent in response to the Registrar's direction	900	41
41.	On payment of prescribed fee for entry into the national phase under section 83(3)	160	42
42.	On payment of prescribed fee and request for publication of translation	70	43
43.	On application to Registrar for an international application for a patent (Brunei Darussalam) to be treated as an application under the Order	160	44
44.	On request for the exercise of the discretionary powers of the Registrar	100	48
45.	On declaration of authorisation where agent appointed or in substitution for another	10 for each patent or application for patent	46
46.	On payment of the advertisement fee upon receipt of the Registrar's request under rule 97(4)	18	47

	<i>Matter of Proceeding</i>	<i>Amount</i> \$	<i>Corresponding</i> <i>Form No.</i>
47.	On notice of opposition to the correction of an error, clerical error or mistake	100	48
48.	On request for information relating to a patent or an application for a patent	24	49
49.	On request for extension of each time or period under rule 114(4) – for each month or part of a month for which the extension is sought	200	50
50.	On request for extension of each time or period under rule 114(6)	200	52
51.	On payment of additional fee for extension of each time or period under rule 114(9) – for each month, or part of a month, for which the extension is granted	200	53
52.	On request for extension of periods under sections 29(7) and 30(1)(a) –		51
	(a) where the application is not an international application for a patent (Brunei Darussalam) that has entered the national phase in Brunei Darussalam under section 83(3)	1,800	
	(b) where the application is an international application for patent (Brunei Darussalam) that has entered the national phase in Brunei Darussalam under section 83(3)	Nil	
53.	On payment of transmittal fee under rule 14 of the Regulations under the Patent Co-operation Treaty	150	54
54.	On payment of fee under rule 123(6) in respect of a request under rule 26 bis.3(a) of the Regulations under the Patent Co-operation Treaty	250	–
55.	On request for certificate authorising release of sample of micro-organism	15	55
56.	On notice of intention to restrict availability of samples of micro-organisms to experts	15	56

	<i>Matter of Proceeding</i>	<i>Amount</i> \$	<i>Corresponding</i> <i>Form No.</i>
57.	On request for certificate authorising release of sample of micro-organism to an expert	15	57
58.	On payment of renewal fee under section 55 or 56 –		58
	(a) for each year in respect of the 5th, 6th or 7th year of the patent	80	
	(b) for each year in respect of the 8th, 9th or 10th year of the patent	135	
	(c) for each year in respect of the 11th, 12th or 13th year of the patent	175	
	(d) for each year in respect of the 14th, 15th or 16th year of the patent	225	
	(e) for each year in respect of the 17th, 18th or 19th year of the patent	275	
	(f) for the 20th year of the patent	325	
	(g) for each year after the 20th year of the patent	475	
59.	On application to extend the term of a patent under section 36	950	59
60.	On filing a request for a search and examination report after grant under section 39 –		60
	(a) where the Examiner is the Austrian Patent Office	2,680	
	(b) where the Examiner is the Danish Patent and Trademark Office	3,100	
	(c) where the Examiner is the Hungarian Patent Office	2,680	
61.	On filing one or more documents under section 26(7) (c) or (8) or 28(8)	–	61
62.	On filing a declaration under rule 9(2) or a request under rule 9(3)	120	62
63.	On filing a request under rule 10(2)	250	62
64.	On filing any miscellaneous document or documents	–	99

	<i>Matter of Proceeding</i>	<i>Amount</i> \$	<i>Corresponding</i> <i>Form No.</i>
65.	For using the patent computer facilities in the public search room of the Registry		
	(a) for every half hour or part thereof of log on access using the patent search terminal	2	
	(b) for each sheet of information printed	0.30	
66.	Purchase of a copy of –		
	(a) Patents Journal A	10	
	(b) Patents Journal B	36	



## SECOND SCHEDULE

rule 4 (3)

### DESCRIPTIONS OF FORMS

<i>Form</i>	<i>Description of Form</i>
Certificate Form 1	Certificate of Grant
Certificate Form 2	Certificate of Extension of Patent Term
Patents Form 1	Request for the Grant of a Patent under section 25
Patents Form 2	Reference under section 20(1) or 48(1)
Patents Form 3	Counter-Statement
Patents Form 4	Application under section 20(5) or 48(3) for Authorisation by the Registrar
Patents Form 5	Request for Directions under section 22
Patents Form 6	Reference under section 23(5) or 48(5) to Determine the Question of a Licence
Patents Form 7	Application to Registrar under section 24(1) and/or 24(3)
Patents Form 8	Statement of Inventorship and of Right to the Grant of a Patent under section 24
Patents Form 9	Request for Early Publication under section 27(2)
Patents Form 10	Withdrawal of an Application for a Patent under section 27(1)
Patents Form 11	Request for a Search Report or Supplementary Search Report
Patents Form 12	Request for a Search and Examination Report
Patents Form 13	Furnishing of Prescribed Details
Patents Form 14	Furnishing of Prescribed Information
Patents Form 15	Notice of Intention to Rely on International Preliminary Report on Patentability under section 29(2)(e)(ii)
Patents Form 16	Request for an Examination Report

<i>Form</i>	<i>Description of Form</i>
Patents Form 17	Request to Amend Application before Grant under section 31(2)
Patents Form 18	Response to Written Opinion under section 31 or 39
Patents Form 19	Payment of Fee for Grant of a Patent under section 30
Patents Form 20	Payment of Renewal Fee under section 35(2) or 56(2)
Patents Form 21	Payment of Additional Fee under section 35(3)
Patents Form 22	Application to Amend Specification after Grant under section 38
Patents Form 23	Notice of Opposition to Amendment of Specification after Grant under section 38 or 80
Patents Form 24	Application for Restoration of a Patent under section 40
Patents Form 25	Additional Fee on the Application for Restoration of a Patent under section 40
Patents Form 26	Offer to Surrender a Patent under section 41(1)
Patents Form 27	Notice of Opposition to Offer to Surrender a Patent under section 41(2)
Patents Form 28	Request for Alteration of Name, Address or Address for Service, or Correction of an Error, Clerical Error or Mistake under section 104
Patents Form 29	Application to Register or to Give Notice of a Transaction, Instrument or Event Affecting the Rights in a Patent or an Application for a Patent under section 44
Patents Form 30	Request for Miscellaneous Information under section 43 or 105
Patents Form 31	Request for Certificate of the Registrar under section 46
Patents Form 32	Application for Entry of Order of Court in the Register under section 44

<i>Form</i>	<i>Description of Form</i>
Patents Form 33	Application for Entry to be Made in the Register to the effect that Licences under the Patent are to be available as of Right under section 55(1)
Patents Form 34	Application for Settlement of Terms of a Licence of Right under section 55(3)
Patents Form 35	Application under section 56(1) or (3) for Cancellation of Entry in the Register
Patents Form 36	Notice of Opposition to an Application under section 56(1) or (3) for Cancellation of Entry in the Register
Patents Form 37	Reference to the Registrar of a Dispute as to Infringement under section 65(3)
Patents Form 38	Application for Declaration of Non-Infringement under section 76
Patents Form 39	Application for Information on Corresponding Applications for a Patent
Patents Form 40	Application for Revocation of a Patent under section 77
Patents Form 41	Request for Re-Examination of a Patent in Response to direction of the Registrar under section 77
Patents Form 42	Payment of Fee for Entry into National Phase under section 83(3)
Patents Form 43	Payment of Prescribed Fee and Request for Publication of Translation under section 83(7)
Patents Form 44	Application to the Registrar for an International Application to be Treated as an Application under section 82 of the Order
Patents Form 45	Request for the Exercise of the Registrar's Discretionary Powers under section 89
Patents Form 46	Declaration of Authorisation where an Agent is Appointed or where One Agent is Substituted for Another

<i>Form</i>	<i>Description of Form</i>
Patents Form 47	Additional Fee for the Advertisement of Proposed Correction under section 104
Patents Form 48	Notice of Opposition to the Correction of an Error, Clerical Error or Mistake under section 104
Patents Form 49	Request for Information Relating to a Patent or an Application for a Patent under section 105
Patents Form 50	Request for Extension of Time or Period under rule 114(4)
Patents Form 51	Request for Extension of Periods under sections 29 (7) and 30(1)(a)
Patents Form 52	Request for Extension of Time or Period under rule 114(6)
Patents Form 53	Additional Fee for Extension of Time or Period under rule 114(9)
Patents Form 54	Payment of Transmittal Fee under rule 14 of the Regulations under the Patent Co-Operation Treaty
Patents Form 55	Request for Certificate Authorising Release of Sample of Micro-Organism
Patents Form 56	Notice of Intention to Restrict Availability of Samples of Micro-Organisms to Experts
Patents Form 57	Request for Certificate Authorising Release of Sample of Micro-Organisms to an Expert
Patents Form 58	Payment of Renewal Fee pursuant to section 55(3)(d)
Patents Form 59	Request for an Extension of the Term of a Patent under section 36
Patents Form 60	Request for Search and Examination after Grant under section 39
Patents Form 61	Filing of Documents under section 26(7)(c) or (8) or 28(8)
Patents Form 62	Declaration under rule 9(2) or Request under rule 9(3) or 10(2)
Patents Form 99	Filing of Miscellaneous Document or Documents

**THIRD SCHEDULE**

rules 5 and 7

**SCALE OF COSTS**

**PART I – BASIC COSTS**

<i>Item</i>	<i>Matter</i>	<i>Amount</i>
1	Drawing and filing notice of opposition or application for revocation together with statement of case	\$200
2	Drawing and filing a counter-statement	\$150
3	Preparing and lodging evidence for a notice of opposition, an application for revocation or a counter-statement	\$200-\$800
4	Perusing a notice of opposition, an application for revocation or a counter-statement (per <i>folio</i> )	\$2
5	Preparing for all interlocutory proceedings	\$25-\$120
6	Attending all interlocutory proceedings	\$25-\$50
7	Preparing for hearing	\$500-\$1,500
8	Attendance at hearing by patent agent without advocate or solicitor	\$100 per hour up to a maximum of \$450 per day
9	Attendance at hearing by patent agent with instructing advocate or solicitor	\$60 per hour up to a maximum of \$270 per day
10	Advocate or Solicitor fees	\$120 per hour up to a maximum of \$540 per day
11	Drawing bill of costs (per <i>folio</i> )	\$2
12	Attending taxation, and obtaining the Registrar's certificate or order	\$50-\$120

## PART II – ADDITIONAL COSTS

1. A person who has paid a fee prescribed in these Rules in relation to proceedings before the Registrar shall be paid the amount of the fee.
  
2. A person attending proceedings before the Registrar shall be paid –
  - (a) a reasonable amount for expenses incurred for transport between the usual place of residence of the person and the place that he attends for that purpose; and
  - (b) if the person is required to be absent overnight from his usual place of residence, a reasonable amount as allowances up to a daily maximum of \$250 for meals and accommodation.
  
3. A person who, because of his professional, scientific or other special skill or knowledge, is summoned to appear before the Registrar as a witness shall be paid –
  - (a) if the person is remunerated in his occupation by wages, salary or fees, an amount equal to the amount of wages, salary or fees not paid to the person because of his attendance before the Registrar for that purpose, but such amount should not exceed \$150 per day; or
  - (b) in any other case, an amount of not less than \$100 but not more than \$150 for each day on which he so attends.

## MICRO-ORGANISMS

**Applications.**

1. (1) The specification of an application for a patent, or of a patent, for an invention which requires for its performance the use of a micro-organism –

(a) which is not available to the public at the date of filing of the application; and

(b) which cannot be described in the specification in such a manner as to enable the invention to be performed by a person skilled in the art,

shall, in relation to the micro-organism itself, be treated for the purposes of the Order as disclosing the invention in such a manner only if one of the conditions set out in sub-paragraph (2), is satisfied.

(2) The conditions referred to in sub-paragraph (1) are –

(a) a condition that –

(i) not later than the date of filing of the application, a culture of the micro-organism has been deposited with any international depositary authority which is able to furnish a sample of the micro-organism; and

(ii) the name of the international depositary authority, the date when the culture was deposited and the accession number of the deposit are given in the specification of the application; and

(b) a condition, in the case of an international application for a patent (Brunei Darussalam) which is treated, by virtue of section 85 as a patent under the Order, or, as the case may be, an application for a patent under the Order, that the corresponding provisions of the Implementing Regulations to the Patent Co-operation Treaty have been complied with,

and where a new deposit is made under paragraph 4, a further condition that the applicant or proprietor makes a new deposit in accordance with that paragraph.

(3) Where the condition of sub-paragraph (2)(a)(ii) is not satisfied at the time the application for a patent is filed, it shall be satisfied –

(a) within 16 months from –

(i) the declared priority date; or

(ii) the date of filing the application where there is no declared priority date;

(b) where, on a request made by the applicant, the Registrar publishes the application before the end of the period prescribed for the purposes of section 27(1), before the date of the request; or

(c) where the Registrar sends notification to the applicant that, in accordance with section 105(4), he has received a request by any person for information and inspection of documents under subsection (1) of that section, before the end of one month after his sending to the applicant notification of his receipt of the request,

whichever is the earliest.

(4) The giving of the information specified in sub-paragraph (2)(a)(ii) shall constitute the unreserved and irrevocable consent of the applicant to the international depositary authority with which a culture (including a deposit which is to be treated as having always been available by virtue of paragraph 4(2)) is from time to time deposited making the culture available on receipt of the Registrar's certificate authorising the release to the person who is named therein as a person to whom the culture may be made available and who makes a valid request therefor to the authority.

### **Availability of cultures.**

2. (1) Subject to paragraph 3, a request that the Registrar certify a person as a person to whom an international depositary authority may furnish a sample of a micro-organism –

(a) before publication of the application for a patent, to a person who has made a request under section 105(1) in the circumstances mentioned in paragraph 1(3)(c); and

(b) at any later time, to any person,

shall be made on Patents Form 55 together with the form provided for by the Regulations under the Budapest Treaty.



(2) The Registrar shall send a copy of any form lodged with him under sub-paragraph (1) and of his certificate authorising the release of the sample –

- (a) to the applicant for, or proprietor of, the patent;
- (b) to the international depositary authority; and
- (c) to the person making the request.

(3) A request under sub-paragraph (1) shall comprise, on the part of the person to whom the request relates, undertakings for the benefit of the applicant for, or proprietor of, the patent –

(a) not to make the culture, or any culture derived from it, available to any other person; and

(b) not to use the culture, or any culture derived from it, otherwise than for experimental purposes relating to the subject matter of the invention, and –

- (i) subject to sub-paragraph (iii), both undertakings shall have effect during any period before the application for a patent has been withdrawn, has been treated as having been abandoned, has been refused or is treated as having been refused (including any further period allowed under rule 110, 120(1) or (6) but excluding, where an application is reinstated under either of those rules, the period before it is reinstated);
- (ii) if a patent is granted on the application, the undertaking set out in sub-paragraph (a) shall also have effect during any period for which the patent is in force and during the period of 6 months referred to in section 35(3); and
- (iii) the undertaking set out in sub-paragraph (b) shall not have effect after the date of publication in the journal of a notice that the patent has been granted,

and, in this sub-paragraph, references to a culture derived from a deposited culture of a microorganism are references to a culture so derived which exhibits those characteristics of the deposited culture essential for the performance of the invention.

(4) For the purpose of enabling any act specified in section 59 to be done in relation to the culture for the services of the Government, the undertakings specified in sub-paragraph (3) –

(a) shall not be required from any Government department or person authorised in writing by a Government department for the purposes of this paragraph; and

(b) shall not have effect in relation to any such person who has already given them.

(5) An undertaking given pursuant to sub-paragraph (3) may be varied by way of derogation by agreement between the applicant or proprietor and the person by whom it is given.

(6) Where, in respect of a patent to which the undertaking set out in sub-paragraph (3)(a) has effect –

(a) an entry is made in the register under section 55 to the effect that licences are to be available as of right; or

(b) a compulsory licence is granted under section 57,

that undertaking shall not have effect to the extent necessary for effect to be given to any such licence.

#### **Availability of cultures to experts.**

3. (1) Subject to sub-paragraph (3), where, before the preparations for publication under section 27 of an application for a patent have been completed, the applicant gives notice to the Registrar on Patents Form 56 of his intention that a sample of the micro-organism should be made available only to an expert, the provisions of this paragraph shall have effect.

(2) The Registrar –

(a) shall, at the time of publication of the application under section 27, publish a notice in the journal that the provisions of this paragraph have effect; and

(b) notwithstanding paragraph 2, shall not, until the patent is granted or the application has been withdrawn, has been treated as having been abandoned, has been

refused or is treated as having been refused, issue any certificate authorising release of a sample otherwise than under this paragraph.

(3) In the case of an international application for a patent (Brunei Darussalam), the applicant may, for the purpose set out in sub-paragraph (1), give notice in writing to the International Bureau under rule 13 bis 3 of the Regulations under the Patent Co-operation Treaty before the technical preparations for international publication of the application are complete of his intention that a sample of the micro-organism should be made available only to an expert and he shall be treated by the Registrar for the purposes of this paragraph as having complied with the conditions in sub-paragraph (1) and sub-paragraph (2)(a) shall not apply.

(4) Any person wishing to have a sample of the micro-organism made available (“the requester”) –

(a) shall apply to the Registrar on Patents Form 57 together with the form provided for by the Regulations under the Patent Co-operation Treaty nominating the person (“the expert”) to whom he wishes the sample to be made available; and

(b) shall at the same time file undertakings by the expert as set out in paragraph 2 (3) in accordance with the provisions of that paragraph.

(5) The Registrar shall send a copy of Patents Form 57 filed under sub-paragraph (4) to the applicant for the patent and shall specify the period within which the applicant may object, in accordance with sub-paragraph (6), to a sample of the micro-organism being available to the expert.

(6) Unless, within the period specified by the Registrar under sub-paragraph (5) (or within such longer period as the Registrar may, on application made to him within that period, allow), the applicant for the patent sends notice in writing to the Registrar that he objects to a sample of the micro-organism being made available to the expert and gives his reasons for his objection, the Registrar shall send a copy of any form lodged with him under sub-paragraph (4)(a) and of his certificate authorising the release of the sample –

(a) to the applicant for the patent;

(b) to the international depositary authority concerned;

(c) to the requester; and

(d) to the expert.

(7) Where, in accordance with sub-paragraph (6), the applicant for the patent sends notice to the Registrar of his objection to the issue of a certificate in favour of the expert, the Registrar –

(a) shall decide, having regard to the knowledge, experience and technical qualifications of the expert and to any other factors he considers relevant, whether to issue his certificate in favour of the expert; and

(b) if he decides to authorise the release of the sample to the expert, shall send to the persons referred to in sub-paragraph (6) a copy of any form lodged with him under subparagraph (4)(a) and of his certificate authorising the release of the sample to the expert.

(8) Before making a decision in accordance with sub-paragraph (7), the Registrar shall afford the applicant and the requester the opportunity of being heard.

(9) If the Registrar decides under sub-paragraph (7) not to issue his certificate in favour of the expert, the requester may, by notice in writing to the Registrar and the applicant, nominate another person as the expert for the purposes of this paragraph; and the Registrar shall give such directions as he may think fit with regard to the subsequent procedure.

(10) Nothing in this paragraph shall affect the rights under section 58 of any Government department or of any person authorised in writing by a Government department.

#### **New deposits.**

**4.** (1) Where the international depositary authority with which a deposit or a new deposit of a culture has been made under this Schedule –

(a) notifies the applicant or proprietor that it –

(i) cannot satisfy a request made in accordance with paragraph 2(1) or 3(4); or

- (ii) is not able lawfully, to satisfy such a request, for the culture to be made available;
- (b) ceases temporarily or permanently to carry out the functions of an international depositary authority; or
- (c) ceases for any reason to conduct its activities as an international depositary authority in an objective and impartial manner, subject to sub-paragraph (3), the applicant or proprietor may, unless the culture has been transferred to another international depositary authority which is able to make it available, make a new deposit of a culture of the micro-organism.

(2) For the purposes of paragraph 1 and this paragraph, the deposit shall be treated as always having been available if, within 3 months of the receipt of such notification or of the international depositary authority ceasing to perform the functions of an international depositary authority or to conduct its activities as such an authority in an objective and impartial manner, the applicant or proprietor –

- (a) in a case where the deposit has not already been transferred, makes the new deposit;
- (b) furnishes to the international depositary authority with which the new deposit is made a declaration that the culture so deposited is of the same micro-organism as was the culture originally deposited; and
- (c) requests amendment of the specification under section 31 or 38, as the case may be, so as to indicate the accession number of the transferred or new deposit and, where applicable, the name of the international depositary authority with which the deposit has been made.

- (3) The new deposit referred to in sub-paragraph (1) –
- (a) shall, subject to sub-paragraph (b), be made with the same international depositary authority as was the original deposit; or
  - (b) in the cases referred to in sub-paragraphs (1)(a)(ii), (b) and (c), shall be made with another international depositary authority which is able to satisfy the request.

**Interpretation.**

**5.** In this Schedule –

“Budapest Treaty” means the Treaty on the International Recognition of the Deposit of Microorganisms for the purposes of Patent Procedure done at Budapest in 1977;

“depository institution” means an institution which, at all relevant times –

- (a) carries out the functions of receiving, accepting and storing microorganisms and the furnishing of samples thereof; and
- (b) conducts its affairs in so far as they relate to the carrying out of those functions in an objective and impartial manner;

“international depository authority” means a depository institution which has acquired the status of international depository authority as provided in Article 7 of the Budapest Treaty.

**REMUNERATION OF SCIENTIFIC ADVISERS**

1. A person appointed as a scientific adviser to assist the Registrar in proceedings under the Order and who attends the proceedings before the Registrar shall be paid –

(a) a reasonable amount for expenses incurred for transport between his usual place of residence and the place where the proceedings take place; and

(b) if the scientific adviser is required to be absent overnight from his usual place of residence, a reasonable amount as allowance for meals and accommodation up to a daily maximum of \$250.

2. A person appointed as a scientific adviser to assist the Registrar in proceedings under the Order shall, apart from the expenses and allowances referred to in paragraph 1, be paid an amount of not less than \$650 but not more than \$2,000 for each day or part thereof for which he hears the case or works on the report pursuant to an inquiry referred to him under rule 119(1)(b).

3. A person appointed as a scientific adviser to sit with the Registrar at the hearing of any proceedings may, apart from the expenses and allowances referred to in paragraph 1, be paid an amount not less than \$650 but not more than \$2,000 if he is subsequently not required to hear the proceedings with the Registrar.

Made this    day of    1433 Hijriah corresponding  
to the    day of    2012.

**Minister of Energy in the Office of the Prime Minister.**