

Restoration of lapsed UK and European (UK) patents

Maintenance of UK patents after grant.

Maintenance of UK patents after grant requires payment of an annual renewal fee to the patent office. Normally this is payable annually at the end of the month containing the anniversary of the filing date, but it can be paid with a surcharge within a further six-month period.

Provided renewal fees are paid, then the patent terminates at the end of the normal patent term, which is a 20 years from the filing date for the majority of patents, but extendable by a supplementary protection certificate for some types of patent concerned with pharmaceuticals.

Where a patent has ceased to have effect due to non-payment of an annual renewal fee, restoration can be applied for under section 28 of the UK Patents Acts.

This applies both to UK national patents prosecuted and granted by the UK patent office, and to European patents (UK) which were prosecuted and granted by the European patent office and which are effective in the United Kingdom.

Who can apply for restoration?

The person who was the proprietor of the patent, or any other person who would have been entitled to a patent if it had not ceased to have effect, may apply to restore the patent. If the patent was held jointly by two or more persons, any one of those persons can apply to restore the patents and it is not necessary that the other joint owners join in the application for restoration.

What are the time limits for applying for restoration?

The time limit for applying to restore a patent is set out in rule 40 of the patent rules, and is currently the end of the thirteenth month from the end of the six -month extension period after the renewal due date, during which the unpaid renewal fee could have been paid. In other words, the period during which restoration can be applied for is 19 months from the due date on which the renewal fee should have been paid.

What is the legal test?

Non-payment of the renewal fee must have been unintentional.

If the comptroller is satisfied that the failure of the proprietor of the patent to pay the renewal fee within the prescribed period; or to pay that renewal fee and any prescribed additional fee within the period ending with the sixth month period after the month in which the prescribed period ended, was unintentional, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.

There is no requirement to show that all due care required in the circumstances has been taken to make sure the renewal fee was paid.

What is the procedure?

To apply for restoration under section 28, the application must be made on patents form 16, and the applicant must file evidence in support of the application. If the evidence is not filed immediately, the patent office will set a period in which the evidence needs to be filed.

Typically, such evidence may explain how and why the payment of the renewal fee was missed, and may declare that the applicant intended to pay the renewal fee, and that non-payment was unintentional.

The patent office will make a decision on the information and evidence filed, although the applicant has a right to a hearing, where they can present the case orally.

If the patent office decides to allow restoration, they will set a period within which the applicant must pay the original renewal fee, plus the surcharge to the renewal fee.

The information that the patent is restored is published in the Official Journal of Patents.

Does restoration affect the enforceability of the patent?

For any patent infringement which occurred during the period during which it was possible to renew the patent, including the additional six-month extension period, or anything which is a continuation or repetition of an earlier infringing act, is still treated as an infringement, notwithstanding that the patent ceased but was then restored.

However, after the expiry of the renewal period as extended by the six-month period during which the renewal fee could still be paid, any person who began in good faith to do something which would be an infringement of the patent if it had not expired, has the right to continue to do that act, notwithstanding that the patent has subsequently been restored (section 28A(4)). However that right to continue doing an otherwise infringing act does not extend to granting a licence to another person to do that act. It applies to the person who

began in good faith to do the otherwise infringing act. This includes any of that person's business partners, and anyone who acquires the person's business which started to do the otherwise infringing act, either by assignment or on death.

Similarly where a person made in good faith effective and serious preparations to do an act which would otherwise be an infringing act if the patent not expired, the patent will be ineffective against those acts.

Infringements which started or which were prepared to be started during the period where the patent could no longer have been renewed according to the rules, and before restoration of the patent occurred are exempt from infringement after the patent is restored.

However against all other infringements, once the patent is restored, then it is effective as previously, before it ceased to have effect.

This information is correct at the time of writing, however the law and the patent rules change from time to time. This information sheet should not be relied on as definitive legal advice. Please seek specific advice from one of our Chartered patent attorneys if you wish to apply to restore a UK patent.

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