

CHAPTER 28

RESTORATIONS

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28 RESTORATIONS

INTRODUCTION

- 28.01 If a GB or EP (UK) patent has ceased due to failure to pay the relevant renewal fees, an application for restoration of the patent may be filed under section 28 (see rule 40). An application can be filed, for example either by a patent attorney acting on behalf of the patent proprietor or may be filed by the proprietor himself, that is, the applicant for restoration. The applicant may be one or more joint proprietors, or anyone who would have been entitled to the patent if it had not ceased.
- 28.02 An application must be filed by the end of the 19th month from the date on which the renewal fee fell due. An application to restore a patent that ceased on 20 August 2008 must therefore be filed by 31 March 2010.
- 28.03 To make an application, an applicant needs to file patents Form 16 with the appropriate fee. The form should be accompanied by evidence supporting the application. The letter shown in annex 1 should be issued to applicants enquiring about restoration.
- 28.04 The applicant no longer has to provide the office with a sworn statement. Evidence is now acceptable in any written format.

A3 Initial Actions

28.05 On receipt of Patents Form 16/77, the A3 should check:

- Patents Form 16 (with fee) has been filed within the 13 month period allowed. The period starts from 6 months after the period in which the renewal fee could have been paid with additional fees. If the application has been filed late or the fee has only been partially paid, then minute the file to the B2 Restoration Case

Officer pointing this out.

- Restoration has been applied for by the patent proprietors, or a licensee, or a person entitled to the patent. If restoration has been applied for by someone else, minute the B2 Restorations Case Officer.
- The address for service details on the Patents Form 16 match those on the register.
- If the applicant has entered 'YES' in box 6 of 16/77 and they are not the address for service on the register, inform Register Maintenance of the need to update the register with the new address for service.

[PECS ACTION – Create a minute, import into PECS and send a message to REG MAIN]

- Evidence has been filed. If nothing has been received, minute the case to the B2 Restorations Case Officer informing him that no evidence has been filed.

[PECS ACTION – If the application is a GB case create a minute, import into PECS and send a message to the B2 Case Officer]

The A3 should also:

- Enter the details of the application in the Restoration ledger on the H drive and allocate a case reference number
- Update OPTICS using the REG FIL option – menu 11. There is no need to suppress the Journal entry

[PECS ACTION – Use Optics Prints DIS FUL and DIS HIS to create a restoration procedure sheet (See Annex 1a). Import the restoration procedure sheet along with any minute sheet into PECS].

- Obtain patent file from NMP. For EP (UK) cases if a file has not been raised before, make up a file. Obtain a copy of the patent specification using the Ad Hoc Ordering system and make a free text entry on OPTICS – 'File raised'

[PECS ACTION – If the application is a GB case, use the PECS voucher to obtain the application from NMP if the case is not already on PECS. Index and Scanning will then scan the main file into PECS. If the application is an EP case, on arrival pass to the A1 for the allocation of an LIT number, then send to Index

& scanning for them to scan into PECS].

- Complete Journal Entry Form on H drive – Litigation – Restorations – file movement. The current week's journal is selected and all details required are entered

[PECS ACTION – Send a message to the B2 Case Officer entitled NEW RESTORATION]

Evidence

28.06 If evidence is filed later than Patents Form 16:

- Link to the restoration file
- Update Restoration ledger
- Minute case to examiner

[PECS ACTION – The A3 Restorations officer should arrange for the document to be scanned into PECS and for a message to be sent to the B2 Case Officer. The document code for PECS is EVID-LIT].

Extension of Time for filing evidence

28.07 Under rule 109 of the Patents Rules 2007 applicants for restoration may apply in writing for an EOT of two months for filing evidence. They will need to apply before the two month extended period has expired. Any further requests need to set out in detail why more time is required.

B2 Initial Actions

28.08 Ensure Form 16 is in order and evidence has been filed to support the application. If the evidence has not been filed then write to the address for service and allow the applicant two months to submit evidence (see annex 1). The B2 should then minute the A3 instructing them to diary the application for

two months

[PECS ACTION – Import both the letter and minute into PECS and send a message to the A3 entitled PSM (date) DIARY

28.09 Check that the applicant for restoration is the same as the registered proprietor. If there is a change then write to the address for service and give the applicant two months in which to file an assignment or change of name certificate before restoration is allowed. Minute the application to the A3 for diary action.

[PECS ACTION – Import both the letter and minute into PECS and send a minute to the A3 entitled PSM (date) DIARY

28.10 Proceed to examine the evidence while you wait for the assignment documents. On receipt, send the assignment documents to Register Maintenance for them to update our records.

28.11 If the application for restoration has not been filed on time, then write to the applicant explaining that he has missed the deadline (see annex 2). All applications for restoration, even if too late to have effect, should still be entered on the Register by the A3 Restorations officer.

[PECS ACTION – Import the letter into PECS using Manual Import]

28.12 Where the office has made an error that prevented the proprietor from paying the renewal fees or applying for restoration on time, then he may be able to apply for re-instatement of his application under rule 107 (see 28.61 to 28.70).

Examination of the application

28.13 Having analysed the evidence provided, the B2 will decide whether restoration should be allowed.

28.14 The applicant for restoration no longer has to provide the office with sworn evidence. Although the majority of applicants still send in witness statements it

is permissible for them to file their evidence in any written format.

- 28.15 When analysing the evidence it must be determined whether the failure to make the renewal payment was **unintentional**. Was it the intention of the proprietor to pay the fee at some point during the renewal period?
- 28.16 If you decide to allow the application for restoration then summarise your decision on the minute sheet. Write a further minute to the A3 Restorations Officer instructing him to issue the 'Offer to Restore' Letter (see annex 3).
[PECS ACTION – Import the minutes into Madras and send a message entitled PSM (date) ISSUE OFFER to A3 Restorations Officer]
- 28.17 If you decide not to allow the application for restoration, then write a brief summary of your decision on the minute sheet and issue a 'Minded' letter to the applicant informing him that we are minded to refuse the application and giving a month to submit comments (see annex 4). The B2 should also minute the A3 Restorations Clerk asking them to diary the application to await a reply.
[PECS ACTION – Import both the letter and minute into Madras and send a message entitled PSM (date) ISSUE OFFER to A3 Restorations Officer]
- 28.18 If further evidence is required write to the applicant giving him 2 months to file any further documents (see annex 5). Minute the A3 Restorations Clerk and ask them to diary the application to await the new evidence.
[PECS ACTION – Import both the letter and minute into Madras and send a message entitled PSM (date) DIARY]

Managing the application

- 28.19 On receiving a request to diary the case the A3 should update the Excel Spreadsheet, make the relevant diary entry in Outlook and annotate the front of the dossier with the diary date.
[PECS ACTION – Carry out the relevant actions and close the message down]

28.20 If the diary date has matured and no correspondence has been received pass the application to the B2 Case Officer for action.

[PECS ACTION – Send a message entitled DIARY to the B2 Case Officer]

If the applicant files a response, place the documents on the open part of the file and minute the B2 Case Officer that further documents have been received.

[PECS ACTION – Arrange for the documents to be scanned into PECS with the document code LETTER-LIT, import the above minute, and instruct Index and Scanning to send a message to the B2 Case Officer entitled New Documents].

Issuing the Offer to Restore Letter

28.21 On receiving a request to issue the offer to restore letter, the A3 should:

- Update Optics – Enter menu number 6 – Restorations allowable (REC RES)
Enter Patent number
Enter filing date of the Form16
Optics will generate the Restoration Allowed report. Place this on the closed part of the file. This will show any fees due within the next three months. The Offer letter will also include a reference to the fees so that the applicant may pay them at the same time as the overdue fees.
- Send out offer letter – PROSE
If there has not been a hearing use – **offer letter**
If there has been a hearing use – **offer after hearing letter**
When drawing up the letter an automatic calculator will appear on screen. The Optics Restoration Allowed report will show the details of unpaid fees. The starting year will be the 1st unpaid payment year. Press EDIT button to fill in details and then OK it.
Print 2 copies of the letter marking 1 as **Copy**. Place the **Copy** on the open part of the file. The applicant has two months to pay the outstanding renewal fees.
[PECS ACTION – Import the letter into PECS]

- Diary the application for 2 months.
- Refer the application to the B2 if the fees have not been paid by the deadline set.

Drafting an Order

28.22 When the renewal payments arrive check that the correct number of Form12s have been filed with the correct fees. Arrange for the forms to be added to the file (status = OPI).

28.23 Compile an Order (two top copies) allowing restoration for the B2 Case Officer to sign (see annex 6). Ensure that any assignments or change of names are documented in the Order. Pass the orders to the B2 case officer.

28.24 On receipt of the signed Orders from the B2, issue one copy to the applicant and arrange for the order to be added to the file (status = OPI). Make the relevant journal entry and minute the file to Renewals Section for them to complete their actions.

[PECS ACTION – Import a copy of the Order and the minute into PECS and send a message to RENEWALS section entitled PSM (date)]

28.25 Once Renewals have completed their actions they will send the file back to Litigation Section to update the restorations spreadsheet and to send the case to NMP.

[PECS ACTION – Ensure that everything has been placed on the dossier correctly and close the message down]

Further evidence received

28.26 On receipt of further evidence from the applicant, check that the applicant has

filed all that was requested. Then reconsider the case, taking into account both the original and further evidence.

28.27 Deleted

28.28 Deleted

28.29 If further evidence is required, write again to the applicant. The case should again be minuted to the A3 Restorations Clerk to diary for two months to await these documents.

[PECS ACTION – Import both the letter and minute into Madras and send a message entitled PSM (date) DIARY]

28.30 If restoration is allowed on the basis of the new evidence filed then follow the procedures in 28.15.

Various Stages of Refusal

28.31 As mentioned in 28.16 the application may have been refused. In this case, the minded letter will have been issued stating the reasons for refusal.

28.32 If no further evidence is filed a further preliminary view letter is to be issued (see Annex 7). If no request for a Hearing has been filed then a Refusal decision is drawn up by the B2 case officer and issued to the applicant (see annex 8). A covering letter (see annex 8a) giving the applicant a period of appeal should accompany the decision.

[PECS ACTION – Import both letters and the Refusal decision into PECS if necessary]

28.33 If the applicant requests a hearing, minute the file to the Hearings Clerk who will make the necessary arrangements.

[PECS ACTION – Ensure all documents from the applicant have been scanned

into PECS. Import the minute and send a message to the Hearings Clerk entitled PSM (date)

28.34 If following the Hearing, the Hearing Officer allows the request for restoration a decision will be issued by the Hearings Clerk.

[PECS ACTION – The Hearings Clerk will import a copy of the decision into PECS]

28.35 If the Hearing Officer refuses the request for restoration, then he will draft his decision for issue by the A3 Restorations Officer to the applicant.

28.36 Issue the Prose decision letter.

[PECS ACTION – Import a copy of the letter and decision into PECS]

28.37 The A3 Restorations Officer will then update Optics using number 15 – **Register Restoration Decision** – by entering the filing date of the Form 16, REFUSED (upper case used) and today's date.

28.38 The minute sheet is noted as follows:

Case refused. Advertised in Jnl number dated

[PECS ACTION – Import the minute into PECS]

28.39 The spreadsheet will then be updated by the A3 and the case cleared.

Withdrawal of the Application for Restoration

28.40 Withdrawal can occur at any point in the restoration process, but can only be instigated by the applicant or their agent.

28.41 An official letter is sent to the applicant by the B2 confirming that the application has been withdrawn (see annex 9).

[PECS ACTION – Import the letter into PECS]

- 28.42 The date of withdrawal is the filing date of the applicant's/agent's correspondence.
- 28.43 The A3 Restorations Officer will update OPTICS using number 15 – **Register Restoration Decision** – by entering the date of the Form 16, WITHDRAWN (using upper case), and the date which is the filing date of applicants/agents letter.
- 28.44 The minute sheet is noted as follows:
- a) Date:
 - b) Case withdrawn advert in journal no.....dated.....clear records to NMP.
 - c) Signed.....Ext no.....Room No.....
- [PECS ACTION – Import the minute into PECS]
- 28.45 An entry is made on the journal entry sheet with relevant details.
- 28.46 The spreadsheet will then be updated by the A3, and the case cleared.

Refunds

- 28.47 The A3 Restorations Officer will select the refund letter on PMAC and insert the B3's name at the end of the letter. Two copies of this letter should be printed.
[PECS ACTION – Import a copy of the letter into PECS]
- 28.48 Make a copy of the Form 16 and attach to the letters and a copy of the refund schedule which should also be completed with details of the refund.
- 28.49 The B3 should then sign the refund schedule and return the file to the A3 Restorations Officer.
- 28.50 The schedule for deposit accounts is sent to the customer accounts manager in

document reception, room GR43. The schedule for cash accounts is sent to the asset supervisor in Finance, Room 3R45.

28.51 Once the correspondence is returned from Finance, the date is stamped where required on letters (the date schedule went through Finance). With deposit accounts, the invoices are matched to the correct letters and sent out together.

28.52 With cheques, once the finance schedule is returned, it is checked with the correct letters and the cheque number entered in cheque number column on refunds copy of schedule. With deposit and cheque correspondence, the forms are stamped with either full payment or part payment.

[PECS ACTION – Import a copy of the refund schedule into the Dossier]

Request for Confidentiality of Documents

28.53 Under rule 53 of the Patents Rules 2007, a request may be made to treat documents as confidential. This request must be made within 14 days of the document being filed.

28.54 Deleted

[PECS ACTION – Ensure that all confidential documents that are scanned are set Not Open to Public Inspection and are annotated with CONFIDENTIAL]

28.55 The A3 should minute the file to the B2 Case Officer who may be required to issue a holding reply. The B2 will then minute the file to the C2 with a recommendation concerning the request.

[Import minutes into Madras and generate relevant messages]

28.56 Once a decision on the request has been taken by the C2, the file will be minuted to the B2 for action.

[PECS ACTION – The C2 should import the minute into PECS and send

message entitled PSM (date) to the B2

28.57 If the request is refused, the B2 will write to the applicant to inform them giving a period of one month for reply. The documents should be kept NOPI until this time period has elapsed. Minute the file to the A3 Restorations Officer to diary the application for one month.

[PECS ACTION – Import both the letter and minute into PECS and send a message to the A3 entitled PSM (date) DIARY

28.58 If no reply is received from the applicant, then the documents should be moved to the open part of the file.

[PECS ACTION – Ensure that each document status is changed to Open to Public Inspection and the annotations of CONFIDENTIAL are removed]

28.59 If further information is filed by the applicant, then the B2 should send the application to the C2 for further consideration of the refusal.

28.60 Where the C2 is in agreement that the documents should be kept confidential the following actions should be taken:

- COMPLETE DOCUMENTS

Each document should be annotated:

This document has been made confidential under Rule 53 of the Patents Rules 2007

The public status of these documents MUST always be set to NO as they are not open to public inspection.

PART DOCUMENTS

The original document should be duplicated.

The original document should then be annotated and its public status set to NO as is the case with complete documents.

The copy document with the relevant confidential extract deleted should be annotated:

Part of the original document has been made confidential

under Rule 53 of the Patents Rules 2007

The copy document, with the confidential extract deleted, may be placed OPI.

[PECS ACTION – Import the copy document into PECS and set its status as Open to Public Inspection. Annotate the document to say that part of the document has been made confidential]]

- A confirmatory letter should be issued by the B2 case officer confirming that the request for confidentiality has been allowed.
[PECS ACTION – Import the letter into PECS]

Rule 107 Request to Re-instate the Application

28.61 If the Office has made an error in informing the applicant of the deadline for paying his renewal fees, then he may apply for re-instatement rather than restoration of his application.

28.62 The applicant should write outlining the error he believes the Office has made. The B2 should investigate the sequence of events leading to the ceasing of the patent.

[PECS ACTION – Arrange for letter to be added to PECS]

28.63 Once we are satisfied that re-instatement is applicable, a PDJ entry should be made immediately to close the 3rd Party Window and the 3rd Party Terms letter (see annex 10) should be issued to the address for service.

[PECS ACTION – Import the letter into PECS]

28.64 Make an entry on Optics and in the journal stating that a request for re-instatement is being considered.

28.65 The A3 Restorations Officer should update the spreadsheet to show re-instatement has been actioned and diary the application for two months to await a response to the 3rd Party Terms Letter.

- 28.66 If no response is received to this letter then issue a further letter (see annex 11) allowing a month for reply but warning that reinstatement will be withdrawn if no response is made. In effect we would need to cancel the OPTICS Register entry and announce the same in the PDJ. However, before we did this we would need to give the proprietors a short period of 2 weeks in which to comply or request a hearing.
[PECS ACTION – Ensure all letters are imported into PECS]
- 28.67 On receipt of a reply to the 3rd Party Terms letter, first check that acceptance is unequivocal. The A3 should check to see whether there are sufficient funds stamped on the Form 12s to cover all outstanding renewals.
[PECS ACTION – Ensure that the letter is scanned into PECS]
- 28.68 Prepare the second 3rd Party terms letter (see annex 12) to confirm their agreement to the re-instatement of the patent. If there are monies outstanding edit the letter to include a reply date of 2 months in which to file these fees.
[PECS ACTION – Import the letter into PECS]
- 28.69 Once all the outstanding fees have been paid, the B2 should make an entry on Optics and in the Journal stating that a request for re-instatement has been allowed.
- 28.70 Reconstitute the Patent file – take care as not all the papers supplied by the applicant are necessarily Open to Public Inspection.
[PECS ACTION – Check the public status of all the documents in the dossier and update if necessary]

ANNEX 1

Patents Directorate

Concept House
Cardiff Road, Newport
South Wales, NP10 8QQ

Examiner: 01633 814886

E-Mail: gareth.jenkins@ipo.gov.uk

Switchboard: 01633 814000

Fax: 01633 817777

Minicom: 08459 222250

DX: 722540/41 Cleppa Park 3

<http://www.ipo.gov.uk>

Your reference:

Our reference:

(DATE)

Dear Sirs

Ceased Patent Number:

Advice on Filing an Application for Restoration under Section 28 of the Patents Act 1977

Filing your application

1. In response to your enquiry of **(DATE)** regarding the possibility of restoring the above ceased patent, I enclose copies of the relevant section of the Patents Act 1977 and rules governing procedure from the Patents Rules 2007. I also enclose our leaflets "Restoring your Patent" and "Evidence".
2. An application for restoration must be filed within 19 months from the ceasing date. In this case, the last date on which such an application may be filed within the period allowed is **(DATE)**. To file an application what you need to do is complete Patents Form 16 and send this to us with the fee (£135). You should also send us evidence to support your application.
3. You should also tell us, if you can, what happened to the official overdue reminder (PREN5) issued to you on **(DATE)**. (Any evidence sent to the Office in a language other than English or Welsh should be accompanied by a translation which is verified as accurate).

After you have applied

4. Once a Form 16 is received, the application is published in the Patents and Designs Journal - this usually occurs within four weeks of receipt. Once the application is published, third-party rights which came into force at the end of the grace period for paying the renewal fee will be suspended. If the application is refused, third party rights will be reinstated in due course; if the application is allowed, they will not be reinstated. So, if third party terms are reinstated this means that any person will be able to start, or make plans to use your patent.
5. Section 28(3) of the Act states that restoration can only be offered if the proprietor of the patent can satisfy the Comptroller that failure to pay the renewal fee was an unintentional act.
6. The evidence which you supply may not in itself be sufficient to allow the Comptroller to reach a view on your application. If this is the case, you may be asked, to provide further evidence. When all the evidence has been presented and assessed the Comptroller will either reject the application, with the offer of a hearing, or will make an offer of restoration. The terms of that offer will be that all outstanding renewal fees are paid. The offer will also be subject to such terms as the office considers appropriate.
7. It is always advisable to consult a patent attorney, or solicitor familiar with patent matters, before deciding whether to proceed with an application. The Office can inform you about procedural matters but cannot give advice on a specific case as this would compromise our decision making role.
8. If you would like further information, please contact me.

Yours faithfully

(NAME)

Restorations Section

ANNEX 1a

(Case Officers Name)

Ref: **XXX/XX**

Application for restoration of lapsed patent

Filing date of 16/77: **XXXXXXX**

Patent No: **XXXXXXX**

Applicant: **XXXXXXXXXXXXXXXXXXXXXXX**

Attorney: **XXXXXXXXXXXXXXXXXXXXXXX**

Date of Lapse: **XXXXXXX**

Year of lapse: **XX**

Pren 5 issued on: **XXXXXXX**

Cea1 issued on: **XXXXXXX**

Application for restoration due by: **XXXXXXX**

Application to restore advertised in Journal number: **XXXX** Dated: **XXXXXXX**

(Your Name)

(Date)

ANNEX 1b

Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ
United Kingdom

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†Email: XXXXXX@ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 22250
DX 722540/41 Cleppa Park 3
Internet <http://www.ipo.gov.uk>

Your ref:
Our ref: 3Y31/name/number ref

(DATE)

Dear Sirs

Patents Act 1977: Patents Rules 2007
Application for Restoration of Patent No. XXXXXXXXXXXX

1. Thank you for your application to restore the above patent. In order for the application to be considered further you must file written evidence explaining why the renewal fee was not paid within the prescribed period (XXXXXXXXXXXX to XXXXXXXXXXXXXXX).
2. Section 28(3) of the Act states that restoration can only be offered if the comptroller is satisfied that the failure of the proprietor to pay the renewal fee was 'unintentional'.
3. The evidence which you supply in the first instance may not, in itself be sufficient to allow the comptroller to reach a view on your application. You may be asked therefore to provide further evidence to elaborate on the information that you have provided. You may also be asked to provide information in respect of other matters that appear relevant to the assessment being undertaken. When all the evidence has been presented and assessed, the Comptroller will either reject the application with the offer of a hearing, or will make an offer of restoration. The terms of that offer will be that all outstanding renewal fees are paid.
4. A period of **two months from the date of this letter (XXXXXXXXXXXX)** is allowed for your response.

5. If you require any further information, please contact me.

Yours faithfully

XXXXXXXXXXXXXXXXXXXXX
Patent Restorations Manager

ANNEX 2

Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ
United Kingdom

Direct line: 01633 81XXXX
†Email: XXXXXX@ipo.gov.uk
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Fax: 01633 814491
Minicom: 08459 222250
DX 722540/41 Cleppa Park 3
Internet <http://www.ipo.gov.uk>

Your ref
Our ref 3Y31/name/number ref

(DATE)

Dear Sirs

Patents Act 1977: Patents Rules 2007
Application for Restoration of Patent No. XXXXXXXXXXXXXXXX

1. Thank you for your application to restore the above patent. However, your application has been filed outside the period set out in rule 40(1) of the Patents Rules 2007.
2. For restoration to be considered, your application should have been filed by XXXXXXXXXXXXXXXX, that is, 13 months from the last day it was possible for you to pay your renewal fee.
3. Unfortunately as this date has passed, there is no other way of restoring the patent as rule 40(1) is not extendable.
4. A period of one month from the date of this letter is allowed for any comments you wish to make. If nothing further is received from you within this period I will arrange for a refund of the £135 fee that you have paid.

Yours faithfully

XXXXXXXXXXXXXXXXXXXXX
Patent Restorations Manager

ANNEX 3

Patents Directorate

Concept House
Cardiff Road, Newport
South Wales, NP10 8QQ

Direct Line: 01633 81XXXX
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Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX: 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your ref:
Our ref: 3Y31/name/number ref

(DATE)

Dear Sirs

Ceased Patent No: XXXXXXXXXX **Application for Restoration under Section 28 of the Patents Act 1977**

1. Your application for restoration of the above patent has been allowed subject to payment of the outstanding renewal fees for the Nth year(s). The fees required, on separate Patent Form 12's, are £xx for the Nth year, and £xx for the Nth year, making the total due £xxx. The above fees should be received by us by (insert date of issue of letter plus two months).
2. You should note that an Order for restoration gives certain rights to third parties in accordance with the terms prescribed under Section 28A of the Patents Act 1977.
3. Section 28A (4) to (6) gives protection to third parties who take steps to work an invention which is the subject of a lapsed patent before notice of an application for restoration is published. They are free not only to continue what they have started without infringing the restored patent, but also to pass their right to work the invention to others (but not to license others to work the invention). However, this protection does not apply to steps taken during the six months period of grace under section 25(4) in which late renewal is still possible.

4. Applying the contents of section 28A(4) to this patent, you should note that from XXXXXXXXXXX until XXXXXXXXXXX protection for third parties will apply.

Yours faithfully

XXXXXXXXXXXX
Restorations Manager

ANNEX 4

Patents Directorate

Concept House
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United Kingdom

Direct line: 01633 81XXXX
E-mail: XXXXXX@ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Minicom: 08459 222250
DX 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your ref:
Our ref: 3Y31/name/number ref

(DATE)

Dear Sirs

Patents Act 1977: Patents Rules 2007
Application for Restoration of Patent No XXXXXXXXXXXXX

1. I refer to the evidence filed in support of your application for restoration of (patent number). The evidence has been considered but it is the preliminary view of the Office that the application should be refused.
2. For restoration to be allowed, the applicant has to show that failure to pay the renewal fee was unintentional. The evidence filed shows XXXXXXXXXXXXXXXXXXXXX. Thus the failure to pay the renewal fee was as a result of a conscious decision, and the decision could not be said to be unintentional.
3. I should advise you that this view is based upon the evidence provided so far. It may be that you feel that other factors need to be considered. If this is the case, please send us any further evidence within one month of the date of this letter.

4. If you require any further information, please contact me.

Yours faithfully

XXXXXXXXXXXXXXXXXX
Patent Restorations Manager

ANNEX 6

PATENTS ACT 1977

(MONTH & YEAR)

APPLICANT

(APPLICANT NAME)

ISSUE

Whether Patent **(NUMBER)** should be restored
under Section 28

ORDER TO RESTORE

- 1 Patent number **(NUMBER)**, filed on **(FILING DATE)**, ceased to have effect on **(DATE PATENT CEASED)** through failure to pay the renewal fee for the **(YEAR MISSED)** year by that date or during the six months allowed under section 25(4) upon payment of the prescribed additional fees. On **(DATE APP FOR RESTORATION WAS FILED)**, **(APPLICANT NAME)** applied to have this patent restored.

- 2 Having examined the evidence filed in support of the application, I am satisfied that restoration should be allowed. All fees required by Rule 36(4) of the Patents Rules 2007 have now been paid. I therefore order that the patent shall be restored under section 28.

XXXXXXXXXXXXXXXXXX

Restoration Manager
Acting for the Comptroller

ANNEX 7

Patents Directorate
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ
United Kingdom

Direct line: 01633 81XXXX
†E-mail: XXXXXX@ipo.gov.uk
Switchboard: 01633 814000
Fax: 01633 814491
Switchboard: 08459 222250
DX 722540/41 Cleppa Park 3
Internet: <http://www.ipo.gov.uk>

Your ref:
Our ref: 3Y31/name/number ref

(DATE)

Dear Sirs

Patents Act 1977: Patents Rules 2007
Application for Restoration of Patent No. XXXXXXXX

1. I refer to my letter of (DATE) in connection with the above mentioned restoration application. In that letter I advised you that it was the preliminary view of the Office that the application for restoration should be refused. You were invited to submit any additional evidence which might add weight to your argument by (DATE).
2. That deadline has now passed and no further evidence has been submitted. Accordingly, I am writing to confirm that, for the reasons given in my letter of (DATE) (copy attached) a sufficient case for restoration has not been made out.
3. This is a preliminary view. However, the application for restoration will be finally refused unless, within one month of the date of this letter, a formal request is made to this Office for a hearing. A hearing is your chance to present oral arguments in person to one of our senior officers known as a hearing officer. The hearing officer will consider the arguments carefully and will issue a formal decision which is appealable to the Patents Court. If you would like the Office to arrange a hearing you should let me know before (DATE).

4. Please contact me if you would like to discuss any matters raised in this letter.

Yours faithfully

XXXXXXXXXXXXXXXXXXXXX
Patent Restorations Manager

ANNEX 8

Example of Refusal Decision

PATENTS ACT 1997

IN THE MATTER OF an application
under Section 28 to restore
Patent Number XXXXXXXXXX

DECISION TO REFUSE

1. Patent Number XXXXXXXXXX was filed on XXXXXXXXXX and was granted to XXXXXXXXXX. This patent ceased to have effect on XXXXXXXXXX through failure to pay the renewal fee for the Nth year within the prescribed period or within the period as lawfully extended.
On (date), (applicant for restoration) applied to have this patent restored.
2. Following an interchange of correspondence between the applicant and this Office it was stated, in an official letter dated XXXXXXXXXX, that this restoration application would be refused unless, within one month you requested a Hearing. As you have not requested a Hearing the application for restoration under the provisions of Rule 40 (7) of the Patents Rules 2007 is now refused.
3. An appeal against this decision must be lodged within 28 days.

(Date)

XXXXXXXXXXXXXX

Restorations Manager
Acting for the Comptroller

ANNEX 8a

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<http://www.ipo.gov.uk>

Your ref:

Our ref:

(DATE)

Dear Sirs

Patents Act 1977: Patents Rules 2007 Notice of issue of decision

1. I enclose a copy of a decision dated (DATE).
2. The Patents Act 1977 gives you the right to appeal to the Patents Court (part of the High Court) against the decision if you wish to do so. The procedure for appeal is governed by Part 52 of the Civil Procedure Rules, 1988 (as amended). If you decide to appeal, a Notice of Appeal must be made in the appropriate format. Further details may be obtained from the following address:

The High Court Appeals Office
Room WG07, West Green Building
Royal Courts of Justice
Strand
London
WC2A 2LL
(Telephone number 020 7947 7383)

3. Two copies of the Notice of Appeal must be lodged with the High Court Appeals Office (address above) together with the fee (currently £200) **within the time period specified in the decision**. The latest date for appeal is therefore (DATE). Any request for an extension to the appeal period identified in the decision must be made to the court.

4. Once you have filed your appeal, you must send a copy of the Notice of Appeal to the Office as soon as practicable and no later than 7 days from the date of filing the appeal.

Yours faithfully

Andrew Bushell
Restorations Manager

ANNEX 9

Patents Directorate

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Internet: <http://www.ipo.gov.uk>**

**Your ref:
Our ref: 3Y31/name/number ref**

(DATE)

Dear Sirs

**Ceased Patent No: XXXXXXXX
Application for Restoration under Section 28 of the Patents Act 1977**

Further to your letter dated XXXXXXXX, I can confirm that your application for restoration has been withdrawn.

Yours faithfully

XXXXXXXXXXXXXXXXXX
Restorations Manager

ANNEX 10

Patents Directorate

Concept House
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Internet: <http://www.ipo.gov.uk>

Your ref:
Our ref: 3Y31/name/number ref

(DATE)

Dear Sirs

Patents Act 1977: Patents Rules 2007
Patent No XXXXXXXXX

1. I refer to your application for re-instatement of the above patent.
2. I have investigated the circumstances in which your patent lapsed and have identified an error in Office procedure in that XXXXXXXXXXXXXXXXXXXXXXXXXXXX. Because of this error you did not receive our renewal reminder letter in time for you to renew your patent.
3. Please accept my sincere apologies for this error. However, I am pleased to advise you that the comptroller is prepared, to exercise discretion under rule 107 of the Patents Rules 2007 and will reinstate the patent subject to the following.
4. The patent was advertised as ceased, in the Patents Designs Journal (PDJ) on XXXXXXXXXXXX, consequently the terms set out below are considered necessary.
 - (i) If between XXXXXXXXXXXX (i.e. the date on which the patent was announced as ceased in the PDJ) and XXXXXXXXXXXX (i.e. the date on which an application for restoration was announced in the PDJ), a person-
 - (a) began in good faith to do an act which would constitute an infringement of the patent if it had not been treated as ceased by virtue of Section 25(3) of the Act, or.
 - (b) made in good faith effective and serious preparations to do such an act.

he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding the re-instatement of the patents; but this does not extend to granting a licence to another person to do the act.

- (ii) If the act was done, or the preparations were made, in the course of a business,

the person entitled to the right conferred by sub-paragraph (i) above may –

- (a) authorise the doing of that act by any partners of his for the time being in that business, 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 in the course of which the act was done or the preparations made.
- (iii) Where a product is disposed of to another in the exercise of the right conferred by sub-paragraph (i) or (ii) above, that other and any other person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.
- (iv) The above provisions apply in relation to the use of a patent for the services of the Crown as they apply in relation to the infringement of the patent.
5. If you accept the terms, you should inform us in writing within **two months of the date of this letter, that is by (DATE)**.
6. If you do not accept the terms, you should request a hearing. This gives you the chance to explain your case in person to one of our senior officers known as a “hearing officer”. The hearing officer is independent and will look at all sides of the argument before making the final decision about the case.
7. **You also need to pay the outstanding renewal fee of £XXX for the Xth year.** Please note that it is now also possible to pay the Xth year renewal fee of £XXX which is due on XXXXXXXXXXXX. I have enclosed two copies of a Form 12 with this letter should you wish to make both payments at this time.
8. If you would like to discuss any of the points in this letter, please contact me.

Yours sincerely

XXXXXXXXXXXXXX

Patent Restorations Manager

ANNEX 11

Patents Directorate

**Concept House
Cardiff Road, Newport
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Internet: <http://www.ipo.gov.uk>**

Your ref:
Our ref: 3Y31/name/number ref

(DATE)

Dear Sirs

**Patents Act 1977: Patents Rules 2007
Patent No XXXXXXXXXX**

Please find attached a copy of the letter sent to you on XXXXXXXXXXXX. As you will have noticed, the deadline for responding has now passed and we have yet to hear from you regarding this matter.

Please file a response by XXXXXXXXXXXX otherwise the reinstatement of your application will be withdrawn.

Yours sincerely

XXXXXXXXXXXXX
Patent Restorations Manager

ANNEX 12

Patents Directorate

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Internet: <http://www.ipo.gov.uk>

Your ref:
Our ref: 3Y31/name/number ref

(DATE)

Dear Sirs

Patents Act 1977: Patents Rules 2007
Patent No XXXXXXXXXX

1. Thank you for your letter of XXXXXXXXXX confirming you have accepted the terms for re-instatement of the patent set out in my earlier letter of XXXXXXXXXX. These terms are set out again below:
 2. As the patent was advertised as *ceased*, in the Patents Designs Journal (PDJ) on XXXXXXXXXX, consequently the terms set out below are considered necessary.
- (v) If between XXXXXXXXXX (i.e. the date on which the patent was announced as ceased in the PDJ) and XXXXXXXXXX (i.e. the date on which an application for restoration was announced in the PDJ), a person-
- (c) began in good faith to do an act which would constitute an infringement of the patent if it had not been treated as ceased by virtue of Section 25(3) of the Act, or.
 - (d) made in good faith effective and serious preparations to do such an act.

he shall have the right to continue to do the act or, as the case may be, to do the act, notwithstanding the re-instatement of the patents; but this does not extend to granting a licence to another person to do the act.

- (vi) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by sub-paragraph (i) above may –
- (c) authorise the doing of that act by any partners of his for the time being in that business, and
 - (d) 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 in the course of which the act was done or the preparations made.

- (vii) Where a product is disposed of to another in the exercise of the right conferred by sub-paragraph (i) or (ii) above, that other and any other person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.
 - (viii) The above provisions apply in relation to the use of a patent for the services of the Crown as they apply in relation to the infringement of the patent.
3. I will now arrange for the patent to be reinstated on the Register of Patents and the Xth and Xth year annuities to be processed.
 4. If you would like to discuss any of the points in this letter, please contact me.

Yours sincerely

XXXXXXXXXXXXXX

Patent Restorations Manager