

## 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 13th month from the last day it was possible to pay the renewal fee on the patent, i.e. 6 months from the date the patent ceased. The 6 months following the renewal date is sometimes referred to as the grace period and is the period in which the patent can be renewed with payment of a surcharge. 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. There is no provision in the Act or Rules that provides for third parties to oppose an application for restoration

#### A1 Initial Actions

- 28.05 On receipt of Patents Form 16/77, the A1 should:

- 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 complete a restoration procedure sheet (See Annex 1a). Import the restoration procedure sheet into PECS].
- Obtain patent file from NMP. For EP (UK) cases if a file has not been raised obtain a copy of the patent specification using espacenet and import into PECS. (See 25.14)  
[PECS ACTION – If the application relates to a GB case, use the PECS voucher to obtain the patent file 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, Index & Scanning will have allocated it an LIT number so Optics will need to be updated to record this].  
[PECS ACTION – A message should be sent to the B2 Case Officer entitled NEW CASE]

## Evidence

28.06 If evidence is filed directly by fax to Litigation Section:

The A1 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 Patents 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 1b). The B2 should then diary the application for two months  
[PECS ACTION – Import both the letter and minute reflecting the diary entry into PECS.  
Check the address for service details on the Form 16. If the applicant has entered ‘YES’ in box 6 of the form and they are not already the address for service on the register, minute the file to Register Maintenance section to action the request.  
[PECS ACTION – Import the minute into PECS and send a message to Register Maintenance]
- 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. Defer the examination and diary the file for two months to await these documents.  
[PECS ACTION – Import both the letter and minute reflecting the diary entry into PECS.
- 28.10 Defer the examination of the evidence while you wait for the assignment documents. On receipt, send the assignment documents to Register Maintenance for them to update the register.
- 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 A1.

[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 28.72).

### 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**. **The proprietor must prove that at some point when the fee was due to be paid (from 3 months before the annual renewal date until the end of the sixth month following the renewal date) they intended to make the payment.**

- 28.16 If you decide to allow the application for restoration summarise your decision in a minute and issue the 'Offer to Restore' Letter (see 28.21 and annex 3).

[PECS ACTION – Import the minute into PECS]

- 28.17 If you decide not to allow the application for restoration, then write a brief summary of your decision in a minute 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). You should diary the application for 1 month to await a reply.

[PECS ACTION – Import the letter into PECS and annotate the front cover with the diary date.]

28.18 If further evidence is required, write to the applicant giving him 2 months to file any further documents (see annex 5). Diary the application to await any new evidence filed.

[PECS ACTION – Import the letter into PECS and annotate the front cover with the diary date]

### Managing the application

28.19 Whenever you complete an action the restorations spreadsheet should be updated to reflect the current status of the application. Any diary dates need to be added to the relevant column.

28.20 The B2 should check the diary dates on a regular basis. If the diary date has matured and no correspondence has been received the B2 should issue a minded letter (see 28.17).

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

If a response has been received then the B2 will have already received a message entitled New Docs.

### Issuing the Offer to Restore Letter (annex 3)

28.21 Once you have decided to allow restoration you need to issue the 'offer to restore letter'.

- Take an Optics print (PRI RES)

This will show any fees due on this patent and will help in generating the offer letter. If any future fees are due use the Prose letter REST-11, if not use REST-12.

- Generate the offer letter using PROSE

When drawing up the letter, an automatic calculator will appear on screen. The OPTICS PRI RES report will show the details of unpaid fees. The starting year will be the 1<sup>st</sup> unpaid payment year. Fill in the details and then OK it.

[PECS ACTION – Import the letter into PECS]

- Diary the application for 2 months. The proprietor has the option to apply for an automatic 2 month extension of time so issue a reminder letter (annex 3b) if no fees are received.
- If the fees are not paid within these 4 months, the application should be refused and a refusal decision needs to be issued (see 28.31).

### Drafting an Order

28.22 When the renewal payments arrive, you will receive a PECS message and a minute from Renewals section.

28.23 Using Word compile an Order (annex 6) allowing restoration. Ensure that any assignments or change of names are documented in the Order.

28.24 Issue a copy of the order to the applicant and arrange for it to be added to the file (status = OPI). Make the relevant register entry (REC RES), clear the case records on the restorations spreadsheet and minute the file to Renewals Section for them to complete their actions.

[PECS ACTION – Import a copy of the Order, annotate the front cover with the diary date and send a message to RENEWALS section entitled PSM (date)]

28.25 Once Renewals have completed their actions they will close the PECS dossier 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 still required, write again to the applicant. The case needs to be diarised for two months to await the applicant's response.  
[PECS ACTION – Import the letter into PECS and annotate the front cover with the diary date.]
- 28.30 If restoration is allowed on the basis of the new evidence filed, then follow the procedures in 28.16. If restoration is refused on the basis of the new evidence, a minded letter should be issued (see 28.17).

#### Various Stages of Refusal

- 28.31 As mentioned in 28.17 the application may be refused. In each instance, the minded letter needs to be issued stating the reasons for refusal.
- 28.32 If no further evidence is filed, a preliminary view letter should be issued (see Annex 7). If no request for a Hearing is filed in response to the preliminary view letter, a Refusal decision should be drafted and sent to the B3 for authorisation before being issued to the applicant (see annex 8). A covering letter (see annex 8a) giving the applicant details of how to file an appeal should accompany the decision. Update Optics and the Journal using REG RES to record the refusal.  
[PECS ACTION – Import both letters and the Refusal decision into PECS]  
Diary the application to await expiry of the appeal period. If no appeal is filed then update the spreadsheet and clear the case.

- 28.33 If the applicant requests a hearing, minute 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 Following the Hearing 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 restoration is allowed, issue the offer to restore letter (see 28.21).
- 28.36 Deleted
- 28.37 If the restoration is refused the B2 examiner should update Optics using (REG RES) – **Register Restoration Decision** – by entering the filing date of the Form 16, REFUSED (upper case used) and today's date.
- 28.38 Annotate the front cover of the PECS dossier saying:  
Case refused. Advertised in Jnl number ..... dated .....
- 28.39 Update the restorations spreadsheet and close the PECS dossier.

#### 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 When a request to withdraw is received an official letter should be 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 B2 examiner will update OPTICS using (REG RES) – **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 Annotate the front cover of the PECS dossier saying:  
Case refused. Advertised in Journal number.....dated.....
- 28.45 Deleted
- 28.46 Update the spreadsheet and close the PECS dossier down.

### Refunds

- 28.47 The B2 examiner will select the refund letter on Prose 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 B2 examiner.
- 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 GY75.

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 CONFIDENTIAL]

28.55 On receipt of the request the B2 Case Officer may be inclined 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.

[PECS ACTION – Import both the letter and minute into PECS and diary the application for one month.

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 when informing the applicant of the deadline for paying his renewal fees, then he may apply for re-instatement rather than restoration of his patent.

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 3<sup>rd</sup> Party Window and the 3<sup>rd</sup> 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 (REG ENT) stating that a request for re-instatement is being considered.

28.65 If necessary the B2 examiner should update the restorations spreadsheet to show re-instatement has been actioned and diary the application for two months to await a response to the 3<sup>rd</sup> Party Terms Letter.

28.66 If no response is received to this letter, a further letter should be issued (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 do this we 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 3<sup>rd</sup> Party Terms letter, first check that acceptance is unequivocal. The B2 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 3<sup>rd</sup> 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 a free text entry on Optics (REG ENT) to update the register stating that a request for re-instatement has been allowed. An email should also be sent to Publishing containing details of the PDJ entry to be placed in the next available journal.

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]

28.71 Ensure that the patent is placed back 'in force' on Optics. Use the CHA CAS function, choose number 2 'bibliographic and register info' and then option 3 'status information'. You then need to delete the information out of the 'reason not in force' and the 'date not in force' boxes and press return. The patent will then be back in force.

28.72 Clear down the records and return the case to NMP.

## ANNEX 1

### Patents Directorate

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

**Examiner:** XXXXXXXXXX

**E-Mail:** XXXXXXXXXXXX

**Switchboard:** 01633 814000

**Fax:** 01633 817777

**Minicom:** 08459 222250

**DX:** 722540/41 Cleppa Park 3

**Internt:** [www.ipo.gov.uk](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).

### **Third Party Terms**

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. Section 28A (4) to (6) of the act 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 to continue what they have started without infringing the restored patent, but they are prevented from licensing 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.
5. Once you have filed your application for restoration and it has been advertised in the Patents & Designs Journal, these third party rights are suspended. This means that from that date no-one can then take steps to work your invention without your permission. If your application is subsequently refused, third party rights will be reinstated; if the application is allowed, they will remain suspended.
6. 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.
7. 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.
8. 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.
9. 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: **XXXXXX**

Patent No: **XXXXXXX**

Applicant: **XXXXXXXXXXXXXXXXXXXX**

Attorney: **XXXXXXXXXXXXXXXXXXXX**

Date of Lapse: **XXXXXX**

Year of lapse: **XX**

Pren 5 issued on: **XXXXXX**

Cea1 issued on: **XXXXXX**

Application for restoration due by: **XXXXXX**

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

**(Your Name)**

**(Date)**

## ANNEX 1b

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

**Direct line: 01633 81XXXX**  
**Email: xxxxxxxxxxxx**  
**Switchboard: 01633 814000**  
**Fax: 01633 814491**  
**Minicom: 08459 22250**  
**DX 722540/41 Cleppa Park 3**  
**Internet 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 XXXXXXXXXXXXX).
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 (XXXXXXXXXX)** 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: XXXXXXXXX  
Switchboard: 01633 814000  
Fax: 01633 814491  
Minicom: 08459 222250  
DX 722540/41 Cleppa Park 3  
Internet 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 **XXXXXXXXXXXX**, 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 or for you to request a hearing in front of a senior officer regarding this matter. 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  
E-Mail: XXXXXXXXX  
Switchboard: 01633 814000  
Fax: 01633 814491  
Minicom: 08459 222250  
DX: 722540/41 Cleppa Park 3  
Internet: www.ipo.gov.uk

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

(DATE)

Dear Sirs

#### **Ceased Patent No: XXXXXXXXX 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 XXXXXXXXX until XXXXXXXXX protection for third parties will apply.

Yours faithfully

XXXXXXXXXXXX

Restorations Manager

## ANNEX 3b

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

**Tel No: 01633 81xxxx  
Email: xxxxxxxxxxxxxx  
Switchboard: 01633 814000  
Fax: 01633 814491  
Minicom: 08459 222250  
DX 722540/41 Cleppa Park 3  
Internet: www.ipo.gov.uk**

Your Reference: n/a  
Our Reference: **3Y31/name/number ref**

**(DATE)**

Dear Sir(s)

### **REMINDER**

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

1. My letter dated **XXXXXX** informed you that your application for restoration of patent number (**patent number**) had been allowed subject to payment of the outstanding renewal fees of **£XXX**
2. You were asked to pay this fee by **(DATE)**; however it would appear that you have not done so.
3. If you still intend to pay the outstanding renewal fee, it is possible for us to grant you an extension of a further two months in which to do so. If you would like us to do this, you need to put your request in writing and send it to us as a matter of urgency.
4. The consequences of failing to request an extension of time and paying the outstanding fee are set out below.

### **Failure to request an extension and pay the renewal fee**

5. If you do not request an extension of time and do not pay the outstanding fee, your application for restoration will be refused by an official decision. This means that we will be unable to accept any subsequent payment of the renewal fee.
6. Should you still wish to pay the fee, you will need to file an appeal at the Patents Court. An appeal may cost you a lot of money and take up a great deal of your time.

Costs, which may be large, are also normally awarded against the unsuccessful party.

7. You should note that no further reminder will be issued by the Office. However should you require any additional information relating to restoration of patent number **XXXXXXXX**, please contact me.

Yours sincerely

**XXXXXXXXXXXXXXXXXX**  
Patent Restorations Manager

## ANNEX 4

### Patents Directorate

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

Direct line: 01633 81XXXX  
E-mail: XXXXXXXXXXXX  
Switchboard: 01633 814000  
Fax: 01633 814491  
Minicom: 08459 222250  
DX 722540/41 Cleppa Park 3  
Internet: [www.ipo.gov.uk](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

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**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: XXXXXXXXXXXXX  
Switchboard: 01633 814000  
Fax: 01633 814491  
Switchboard: 08459 222250  
DX 722540/41 Cleppa Park 3  
Internet: [www.ipo.gov.uk](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**



**INTELLECTUAL  
PROPERTY OFFICE**

(DATE)

**PATENTS ACT 1977**

APPLICANT XXXXXXXXXXXXXXXX

ISSUE Whether patent number  
XXXXXXXXXXXX should be restored under  
section 28(3)

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**DECISION**

- 1 The renewal fee in respect of the X<sup>th</sup> year of the patent fell due on (DATE). The renewal fee was not paid by that date or during the six months allowed under section 25(4) of the Patents Act 1977 upon payment of the prescribed additional fees. The patent therefore lapsed on (DATE).
- 2 The patent was originally filed in the name of XXXXXXXXXXXXXXXX. It was assigned to XXXXXXXXXXXXXXXX by virtue of an assignment dated (DATE). On (DATE), XXXXXXXXXXXXXXXX filed an application for restoration of the patent.
- 3 In an official letter dated (DATE), the Office set out its preliminary view that the application should be refused. The Office took the view that the evidence filed indicated that the patent proprietor ..... etc. As such, the failure to pay the renewal fee could not be said to be unintentional.
- 4 The applicant for restoration filed further evidence on (DATE). Having considered the additional evidence filed, the Office maintained its preliminary view in a letter dated (DATE). The applicant was also informed that the application for restoration would be refused unless a hearing was requested.
- 5 No response has been received from the proprietor. Consequently I now refuse the application for restoration as I consider that the requirements laid down in section 28(3) of the Patents Act 1977 have not been met.

June 2011

## **Appeal**

- 6 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

**XXXXXXXXXXXXXXXXXX**

B3 Head of Litigation Section acting for the Comptroller

ANNEX 8a

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

**Direct line:**  
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**Minicom:** 08459 222250  
**Fax:** 01633 814444  
**DX** 722540/41 Cleppa Park 3  
**Internet:** 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

XXXXXXXXXXXXX  
Restorations Manager

**ANNEX 9**

**Patents Directorate**

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

**Direct Line: 01633 81XXXX  
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DX: 722540/41 Cleppa Park 3  
Internet: 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**

1. 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  
Cardiff Road, Newport  
South Wales NP10  
8QQ  
United Kingdom

Direct line: 01633 81XXXX  
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Fax: 01633 814444  
Minibus: 08459 222250  
DX 722540/41 Cleopa Park 3

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 XXXXXXXXXXXXXXXXXXXXXXXX. 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 XXXXXXXXX, consequently the terms set out below are considered necessary.
  - (i) If between XXXXXXXXX (i.e. the date on which the patent was announced as ceased in the PDJ) and XXXXXXXXX (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 X<sup>th</sup> year.** Please note that it is now also possible to pay the X<sup>th</sup> 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 faithfully

XXXXXXXXXXXXXX

Patent Restorations Manager

**ANNEX 11**

**Patents Directorate**

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

**Direct line: 01633 81XXXX  
E-mail XXXXXXXXXXXX  
Switchboard: 01633 814000  
Fax: 01633 814444  
Minibus: 08459 222250  
DX 722540/41 Cleppa Park 3**

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

(DATE)

Dear Sirs

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

1. 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.
2. Please file a response by XXXXXXXXXXXX otherwise the reinstatement of your application will be refused.

Yours faithfully

XXXXXXXXXXXXXX  
Patent Restorations Manager

## ANNEX 12

### Patents Directorate

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

Direct line: 01633 81XXXX  
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Fax: 01633 814444  
Minibus: 08459 222250  
DX 722540/41 Cleopa Park 3

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

(DATE)

Dear Sirs

#### Patents Act 1977: Patents Rules 2007 Patent No XXXXXXXXXXX

1. Thank you for your letter of XXXXXXXXXXXX confirming you have accepted the terms for re-instatement of the patent set out in my earlier letter of XXXXXXXXXXXX. These terms are set out again below:
  2. As the patent was advertised as *ceased*, in the Patents Designs Journal (PDJ) on XXXXXXXXXXXX, consequently the terms set out below are considered necessary.
- (v) 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-
- (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 X<sup>th</sup> and X<sup>th</sup> year annuities to be processed.
  4. If you would like to discuss any of the points in this letter, please contact me.

Yours faithfully

XXXXXXXXXXXXXX

Patent Restorations Manager