



PATENTS ACT 1977

APPLICANT	Javier Rodriguez Perez
ISSUE	Can EP3820580 be restored under s28 of the Patents Act following a late application for restoration
HEARING OFFICER	Andrew Bushell

DECISION

Introduction

1. This decision concerns whether EP3820580 can be restored under the provisions of section 28 of the Patents Act 1977 ('the Act') following a failure to pay the renewal fees on the patent in the prescribed time frame.
2. Patent application EP19740512.9 was filed on 10th July 2019 titled 'CONTROL SYSTEM FOR REGULATION BALLS IN A FOOTBALL FIELD AND REGULATION BALL SUPPORT FOR SAME' in the name of Javier Rodriguez Perez and was granted as EP3820580 on 25th October 2023. The patent fell due for renewal on 10th July 2024, and no payment was made within the subsequent six months allowed for a late payment to be made under section 25(4) of the Act. The patent was therefore deemed to have ceased on 10th July 2024.
3. The matter came before me at a hearing on 27th May 2026. Mr Rodriguez Perez was assisted by his friend Mr Enrique Ordoñez Gomez, who translated some of Mr Rodriguez Perez's remarks to assist him in making his case. In my decision I refer only to Mr Rodriguez Perez, but many of the arguments made before me were translated into English by Mr Ordoñez Gomez. I confirm that I have also reviewed the correspondence on file provided by Mr Rodriguez Perez both in advance of the hearing and the further evidence that was filed on 2nd June 2026.

Background

4. The Office wrote to Mr Rodriguez Perez, via his UK address for service, on 14th August 2024 with a reminder to renew the patent by 31st January 2025,

the latest date available under section 25(4). As no payment was made, a notice of cessation letter was sent by the Office on 6th March 2025 to inform him that the patent had ceased.

5. The notice of cessation letter stated that Mr Rodriguez Perez could apply to restore the patent. To do so, the letter informed him to file Patent Form 16 together with the relevant fee and supporting evidence by 28th February 2026.
6. The Office received a completed Patent Form 16 with the relevant fee and supporting evidence from Mr Rodriguez Perez on 10th March 2026. The Office wrote to Mr Rodriguez Perez on 24th March 2026 informing him that his application to restore the patent had been filed outside the period for doing so. On 8th April 2026, Mr Rodriguez Perez requested to be heard on this matter.

The Law

7. Section 28 of the Act sets out the requirements for the restoration of a lapsed patent:

28(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the comptroller within the prescribed period.

(2)...

(3) If the comptroller is satisfied that the failure of the proprietor of the patent –

(a) to pay the renewal fee within the prescribed period; or

(b) to pay that fee and any prescribed additional fee within the period ending with the sixth month 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.

8. Section 25 of the Act states:

25(1)...

25(2)...

25(3) Where any renewal fee in respect of a patent is not paid by the end of the period prescribed for payment ('the prescribed period') the patent shall cease to have effect at the end of such day, in the final month of that period, as may be prescribed.

25(4) If during the period ending with the sixth month after the month in which the prescribed period ends the renewal fee and any prescribed additional fee

are paid, the patent shall be treated for the purposes of this Act as if it had never expired, and accordingly –

(a) anything done under or in relation to it during that further period shall be valid;

(b) an act which would constitute infringement of it if it had not expired shall constitute such an infringement; and

(c) an act which would constitute the use of the patented invention for the services of the Crown if the patent had not expired shall constitute that use.

9. Rule 40 of the Patents Rules 2007 ('the Rules') states:

40(1) An application under section 28 for restoration of a patent may be made at any time before the end of the period ending with the thirteenth month after the month in which the period specified in section 25(4) ends.

(2) The application must be made on Patents Form 16.

10. Extensions to the deadline for applying for restoration set by rule 40 are restricted by rule 108(1) and Part 1 of Schedule 4 of the Rules which are set out below:

108.—(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4.

SCHEDULE 4

EXTENSION OF TIME LIMITS PART 1 PERIODS OF TIME THAT CANNOT BE EXTENDED

rule 6(2)(b) (declaration of priority for the purposes of section 5(2) made after the date of filing)

rule 7(1) (period for making a request to the comptroller for permission to make a late declaration of priority)

rule 32(1) (application to reinstate a terminated application) rule 37 and 38 (renewal of patents)

rule 40(1) (application to restore a lapsed patent)

rule 41A (payment of fees under section 77(5A) following restoration of a European patent (UK)

rule 43(4) (application to cancel entry that licence available as of right)

rule 58(3) (request for a direction under section 81)

rule 59(1) (request from a foreign industrial property office for a direction under section 81)

rule 66(3) (period for making a request to the comptroller for permission to make a late declaration of priority in respect of an international application for a patent (UK))

rule 76(2) (notice of opposition), except in relation to an opposition under section 27(5) where there are pending before the court or the comptroller proceedings in which the validity of the patent is put in issue

rule 77(8) and (10) (opposition periods)

rule 109 (extension of time limits specified by comptroller)

rule 116(2) (fee for supplementary protection certificate) paragraph 8(5) of Schedule 1 (new deposits of biological material)

Arguments

11. Mr Rodriguez Perez explained clearly to me that he had no intention to allow the patent to cease. This was clear from the evidence on file that Mr Rodriguez provided, and throughout his arguments made at the hearing. Mr Rodriguez Perez is clearly passionate about his invention, and I have no doubt he never intended the patent to lapse.
12. Mr Rodriguez Perez explained that he retained the services of a Spanish professional representative to assist him in obtaining his European patent. He explained that his representative assisted him with several worldwide patents, and he was reliant upon his representative to inform him of the actions he was required to take relating to his portfolio.
13. When I explained to Mr Rodriguez Perez that we had sent letters on 14th August 2024 and 6th March 2025 to his UK address for service, Mr Rodriguez Perez queried why they had not been sent to his European representative. I explained to Mr Rodriguez Perez that on occasion patentees provide a UK address for service when their European patent is granted in the UK, and European representatives often have arrangements with representatives in the UK to provide this service. The UKIPO subsequently issues all correspondence to the UK address for service, who then forwards this on to the European representative. Provision of a UK address for service was also necessary for Mr Rodriguez Perez to make his request for restoration. I have

confirmed that the provision of this address was properly made, and these letters were sent by the Office to the UK address for service. Mr Rodriguez Perez confirmed to me that after checking with his European representative, these letters had been received.

14. What was apparent to me during the hearing was that, in part due to some difficult personal circumstances for Mr Rodriguez Perez, correspondence related to his portfolio from his European representative was either not received, was diverted to his 'spam' folder, or was not acted upon at the relevant time. Mr Rodriguez Perez argued before me at the hearing, and in supplementary evidence provided after the hearing, that he believes the issue lay with his European representative not properly informing him of the actions required to maintain the protection he had for his invention. He was able to maintain his European patent as the relevant notifications were sent directly to him, but the correspondence sent by the Office was not raised to his attention for him to act on, both at the time the renewal fees could have been paid or within the period for filing his request for restoration.
15. I understand that, following his concern over the management of his portfolio, Mr Rodriguez Perez requested a review of all his patents in early 2026 from his European representative and upon identification that this patent had lapsed, a request for restoration was filed on 10th March 2026. The notice of cessation letter quoted 28th February 2026 as the latest date to apply for restoration, however under rule 40 the latest date that such a request could have been filed was 2nd March 2026, accounting for the weekend. The request filed by Mr Rodriguez Perez was therefore made outside the period for doing so.
16. Given the restrictions set out in rule 108(1) and Part 1 of Schedule 4 of the Rules, I invited Mr Rodriguez Perez to identify any legal provision which would allow me to extend the prescribed period for applying for restoration. Mr Rodriguez did not advance any case that the Office had mishandled his patent or that the necessary correspondence was not sent. He merely maintained his view that he had every intention to keep his patent in force and that a breakdown in communication between himself and his Spanish representative was the cause of his failure to pay his renewal fees or request restoration within the period for doing so.

Conclusion

17. I have sympathy for Mr Rodriguez Perez as he is an inventor who is clearly passionate about his work. He appointed the services of a professional representative and during some challenging personal circumstances experienced a breakdown in communication with them. When he became aware of the situation with his patent, he acted to try to restore it and made his case before me in an honest, open and respectful manner.

18. However, I am unable to restore his patent under these circumstances.

Section 28 provides for the restoration of patents where the proprietor unintentionally failed to pay their renewal fees, but it is bound by the period set by rule 40, which itself is unextendable by virtue of rule 108(1) and Part 1 of Schedule 4 of the Rules. The request filed by Mr Rodriguez Perez to restore his patent was made outside the period for doing so, and I have found no provision of the Act or Rules which in these circumstances would allow that period to be extended.

19. I therefore conclude the application from Mr Rodriguez Perez to restore his lapsed patent does not meet the requirements of the law, and I must therefore refuse the application for restoration.

Appeal

20. Any appeal must be lodged within 28 days of the date of this decision.

ANDREW BUSHELL

Divisional Director, acting for the Comptroller