

ANNEX 1

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)
Patent Restorations Officer