

Directions under section 124A of the Patents Act 1977

[Ref. PD/ERD/18]

Renewal of UK Patents and European Patents (UK) by electronic means

Introduction

1. The comptroller has given the following Directions under section 124A of the Patents Act 1977 ("the Act") to direct the form and manner in which patents which are in force in the UK may be renewed in electronic form by using electronic communications.
2. If an electronic request to renew a patent is delivered to the Office in a form or a manner which does not comply with these directions, the Office may treat the request as not having been delivered, and the renewal fee as not having been paid. The patent in question will cease to have effect under section 25(3) of the Act subject to the period set out under section 25(4) of the Act.
3. These Directions come into force on 21 June 2014.
4. The Directions given on 12 March 2014 are revoked.

Interpretation

5. In these Directions:

"the Act" means the Patents Act 1977;

"additional late renewal fee" means any additional fee for late renewal prescribed under rule 5 of the Fees Rules and listed at Schedule 2 Part 2 to those Rules;

"the Fees Rules" mean the Patents (Fees) Rules 2007;

"the Office" means the Patent Office or, where appropriate, the comptroller;

"online", in relation to a document or message being delivered, refers to a document or message that has been transmitted from one device to another by means of an electronic communications network (within the meaning of section 32 of the Communications Act 2003);

"patent" means a patent which is granted and in force in the UK, that is to say, a UK patent or a European Patent (UK);

"register" means the Register of Patents kept under section 32 of the Act;

“renewal fee” means the fee referred to under section 25(3) and rule 36 of the Rules and prescribed under rule 4 of the Fees Rules and listed at Schedule 2 Part 1 to those Rules;

“renewal period” refers to the periods specified by rules 37(1) and (2) and 38 of the Rules;

“request” means a request to renew a patent;

"requester" means a person making the request;

“the Rules” mean the Patents Rules 2007;

“web interface” means the Office’s dedicated web page for filing electronic patent renewal requests.

Patent renewal requests

6. Patent renewals may be requested via the web interface at any time. Online or electronic requests to renew a patent not sent via the web interface may be treated as not having been delivered.
7. Renewal payments cannot be made using the web interface where an application to cancel a licence of right entry under section 47 of the Act is pending or where a licence of right has been cancelled but the balance of renewal payments as required by section 47(2) of the Act is still outstanding.

Illegible or incomplete requests or incorrect or incomplete patent numbers

8. A request to renew a patent must be accompanied by an e-mail address to which an email acknowledging receipt of the renewal request(s), receipt of payment and the certificate of payment can be sent. Requests containing an incorrect e-mail address may be treated as not having been delivered to the Office.

Payment of fees

9. Renewal fees and, where due, additional late renewal fees must be paid via the web interface at the time the request is made. Failure to pay all of the fees due may result in the request being treated as not having been received.
10. Renewal fees payable with the request must be paid in Sterling using a deposit account held with the Office or by a valid credit card or debit card.
11. Where an online payment is subsequently rejected, the request will be treated as not having been received.

Acknowledgment and time of delivery

12. Where a request has been received an online acknowledgement (“the receipt”) will be sent by the Office to the requester’s email address specifying the time and date of the request and the patent(s) for which renewal was requested. The

requester should not assume the Office has definitely received the request until the receipt has been received.

13. A subsequent email will be sent to the e-mail address given by the requester when the renewal payment is accepted. This will specify the date the renewal request was received, the patent(s) for which renewal was requested, the total fees paid and the date on which the payment was processed.
14. Once the full renewal payment has been accepted, the Office will issue a certificate of payment to the email address supplied by the requester.
15. A patent renewal will not be treated as having been completed until the Office has both issued an e-mail containing this certificate of payment to the requester and entered details of the renewal on the register.

Specifying the address to which the next renewal notice is to be sent

16. A request under rule 39(3)(a) that the next renewal notice is to be sent to an address other than the address for service entered in the register cannot be filed using the web interface. Any online communication to that effect shall be treated as not having been delivered irrespective of whether a request to renew the patent has been accepted or entered onto the register.

John Alty
Comptroller-General of Patents Designs and Trade Marks
June 2014

For background and additional information refer to guidance and notes on the Directions

Guidance and notes on the Directions given under section 124A of the Patents Act 1977

Renewal of UK Patents and European Patents (UK) by electronic means

Introductory notes

- a) These notes are not part of the Directions. They are intended to provide background and additional information.
- b) Where any document is submitted in a form or manner which does not comply with the Directions, the comptroller may treat the document as not having been delivered (see section 124A(3) of the Patents Act 1977).
- c) Granted UK patents and European Patents (UK) can be renewed electronically using the Office's dedicated [web interface](#).

Payment of renewal fees

- d) The web interface requires the requester to give an account name and number if paying by deposit account, or the full card details (name, number, expiry date and the like) if paying by credit or debit card. Customers who hold existing Intellectual Property Office deposit accounts should use their existing details when using the web interface to request a renewal.
- e) The web interface will require payment in full at the time of the renewal request and part payments will not be accepted.
- f) The web interface will accept payments for the renewal of multiple patents up to a maximum number of eight patents.
- g) As from 21st June 2014, the web interface accepts payments for [late grant](#) patents which include the payment of previous renewal anniversaries. From the same date, the web interface accepts reduced renewal payments for patents on which a [licence of right](#) has been recorded.
- h) The web interface will not accept payments for the renewal of a patent where an application to [cancel a licence of right](#) entry is pending or where a licence of right has been cancelled but the balance of renewal payments as required by section 47(2) of the Act is still outstanding.

Email acknowledgement and confirmation of renewal

- i) The web interface will require the requester to provide a valid email address where they can receive emails sent by the Office which confirm (i) the receipt of the renewal request, (ii) the acceptance of the relevant renewal fee and (iii) the successful renewal of the patent through the issuing of a certificate of payment.

Enquires and service availability

- j) Helpdesk support for online filing is available between 08:30 and 17:00 hours Monday to Friday excluding bank holidays. The web interface will also provide a feedback facility which can be used to report problems and provide feedback on any aspect of the electronic renewals service.
- k) Advance notice of any planned unavailability of online filing due to maintenance is given on the [Office website](#) and by email to registered users.
- l) The Interpretation Act 1978 applies to these Directions. Therefore, all the definitions set out in the Patents Act apply to these Directions. Further, amongst other things, generally any words importing the masculine gender include the feminine and words in the singular include the plural and words in the plural include the singular.
- m) Any queries about these Directions should be addressed to:

Patents Legal Section
Intellectual Property Office
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ
United Kingdom
Tel: +44 (0)1633 814140

The British Library - Recent Additions to the Library

The following transcripts of High Court Decisions have been received at the British Library.

Plaintiff(s) & Defendants(s)	Date Of Hearing	SRIS code No.
Kennametal Inc -and- (1) Pramet Tools SRO (2) Associated Productions Tools Limited		C/043/14
Kennametal Inc -and- (1) Pramet Tools SRO (2) Associated Productions Tools Limited		C/044/14
Karen Millen Fashions Limited -and- Karen Millen OBE		C/045/14
Karen Millen Fashions Limited -and- Karen Millen OBE		C/046/14
(1) Starsight Telecast, Inc. (2) United Video Properties, Inc. -and- (1) Virgin Media Limited (2) Virgin Media Payments Limited (3) TiVo Inc.		C/047/14
(1) Starsight Telecast, Inc. (2) United Video Properties, Inc. -and- (1) Virgin Media Limited (2) Virgin Media Payments Limited (3) TiVo Inc.		C/048/14
Idenix Pharmaceuticals, Inc. -and-		C/049/14

<ul style="list-style-type: none"> (1) Gilead Sciences, Inc (2) Gilead Sciences Ltd (3) Centre National De La Recherche Scientifique (4) Universita Degli Studi Di Cagliari (5) L' Universite Montpellier II 		
<p>And Between:</p>		
<ul style="list-style-type: none"> (1) Gilead Sciences, Inc (2) Gilead Sciences Ltd -and- (1) Idenix Pharmaceuticals, Inc. (2) Centre National De La Recherche Scientifique (3) Universita Degli Studi Di Cagliari (4) L' Universite Montpellier II 		
<p>Swarovski-Optik KG</p> <p>-and-</p> <ul style="list-style-type: none"> (1) Leica Camera AG (2) Leica Camera Ltd 	<p>18 & 19 March 2014</p>	<p>C/050/14</p>
<ul style="list-style-type: none"> (1) Actavis UK Limited (2) Actavis Group EHF (Formerly Actavis Group HF) (3) Actavis Group PTC EHF (4) Medis EHF (5) Actavis Deutschland GMBH & Co. KG (6) Medis Pharma GMBH (7) Medis Pharma France SAS (8) Actavis France SAS (9) Actavis Spain S.A. (10) Actavis Italy SPA A Socio Unico -and- Eli Lilly & Company 	<p>9 -10, 15-16 April 2014</p>	<p>C/051/14</p>

WITHDRAWING PATENT APPLICATIONS

This notice seeks to inform applicants and practitioners of the method the Intellectual Property Office recommends for withdrawing patent applications.

Background

Any request to withdraw an application is always an important action and is dealt with as quickly as possible in the Office. However, quick action in the Office becomes *crucial* when a withdrawal request is received for an application which is soon to be published. We of course wish to avoid erroneous publication.

Ways of withdrawing applications

Withdrawal of a patent application can be made by:

- emailing withdraw@ipo.gov.uk
- faxing the Office on 01633 817777
- writing to the Office

We ***highly recommend*** that the email option be used, as this will ensure that the request is dealt with quickly by a dedicated team of staff. Full details of this service can be found at <http://www.ipo.gov.uk/p-direction-withdrawal.htm>.

Notifying the Office of withdrawal in time to prevent publication

An application for withdrawal in time to prevent publication must be received in this Office by 23:59 on the day before preparations for publication are complete (the *PPC date*). The official letter notifying applicants of the PPC date for their application will only be received 2 or 3 days prior to the PPC date. That leaves a very short time in which to notify the Office of withdrawal. If the email message or written notification is not received by 23:59 on the day before the PPC date, it will be too late to prevent publication.

Therefore the earlier applicants and practitioners can make decisions about withdrawal and notify the Office, the better.

Further guidance on withdrawal of patent applications can be found at:

<http://www.ipo.gov.uk/p-withdraw.htm>

If you have any queries about this notice, please contact:

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Room 1.B75
Concept House
Cardiff Road
Newport
NP10 8QQ
+44 (0)1633 814422

or
Christine Farrington
Room 1.Y20
Concept House
Cardiff Road
Newport
NP10 8QQ
+44 (0)1633 814701

Provision of Information from the Intellectual Property Office

On-Line Web Services

A number of **free** services are available via our web site which is located at www.ipo.gov.uk.

esp@cenet

This service provides an interface to the published patent application databases of the Intellectual Property Office, the European Patent Office and other European national patent offices, as well as access to the PCT database of published patent applications. A full copy of the specification, claims and drawings may be viewed if available.

Designs Image Search

This service provides access to images of UK registered designs along with bibliographic information.

Trade Mark Text

This service provides searches for trade marks matching/starting with specified text.

Trade Mark Proprietor

This service provides searches for trade mark proprietors.

Trade Mark Classification Index

The index serves as a guide to the classes of goods and services to specify when applying for Trade Mark registration. With over 70,000 terms, the index shows which class to put each term in.

Legal Decisions

This service provides the text of reasoned decisions issued by the office since the beginning of 1998.

Status Information

This service provides the status information for Patents, Supplementary Protection Certificates, Trade Marks and Designs.

Other Services

The Status Information and further information can also be obtained on paper from the office. Some of the information available is shown below, along with the relevant prices.

Patents	Request for uncertified copy from file or register	£5
Designs	Request for uncertified copy of extract	£5
Trade Marks	Request for uncertified copy from file or register	£5

Note Trade Marks & Designs: The cost is £5 per file copied, though we reserve the right to quote for our actual costs where particularly large files are involved.

General Cost, per page, of faxing information £1 (plus VAT)

Payment

Deposit accounts: Customers may charge orders against their account with the Office. In such cases the deposit account number should be quoted on the order.

Credit and debit cards: Payment can be made using the following credit and debit cards: Visa, MasterCard, American Express, Switch, Maestro (only if the card is issued by a UK Bank) and Solo.

Cheque: These should accompany any order, be crossed "Account Payee Only" and made payable to "The Intellectual Property Office". Payments from overseas must be in sterling drawn on a UK clearing bank.

Orders

Post: Sales, Concept House, Cardiff Road, Newport, South Wales NP10 8QQ

e-mail (Deposit Account Holders only): sales@ipo.gov.uk

Telephone (Deposit Account Holders and payments by credit and debit card only):
+44(0)1633 813651

Fax (Deposit Account Holders and payments by credit and debit card only):
+44(0)1633 817777.

Patent Publication Enquiry Service

The Patents Publication Enquiry Service www.ipo.gov.uk/patent/p-find/p-find-publication.htm enables you to search for, view and download newly published, granted and corrected GB patents. Patents are added on a weekly basis on the day of publication (usually every Wednesday).

The following types of GB published documents are available:

Document code A – for the published "A" application.

Document code A8 – for the corrected front page of a published "A" application (changes to bibliographical data only).

Document code A9 – for the complete re-issue of a published "A" application (as a result of a correction).

Document code B – for the granted 'B' specification.

Document code B8 – for the corrected front page of a granted "B" specification (changes to bibliographical data only).

Document code C - for complete re-issue of a granted "B" specification (as a result of a correction or amendment).

If you have any queries regarding this notice please contact Emma Sharman - Tel: 01633 614876, or via e-mail: emma.sharman@ipo.gov.uk