

Directions under section 124A of the Patents Act 1977

[Ref. PD/ERD/17]

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 31 March 2014.

Interpretation

4. 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

5. 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.
6. Where rule 37(3) of the Rules applies, renewal payments which include payments for previous renewal anniversaries cannot be made using the web interface.

Illegible or incomplete requests or incorrect or incomplete patent numbers

7. 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

8. 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.
9. 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.
10. Where an online payment is subsequently rejected, the request will be treated as not having been received.

Acknowledgment and time of delivery

11. 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.

12. 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.
13. Once the full renewal payment has been accepted, the Office will issue a certificate of payment to the email address supplied by the requester.
14. 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

15. 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
12 March 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

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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) The web interface will not accept payments for the renewal of a [late grant](#) patent where it is necessary to include payments for previous renewal anniversaries to renew the patent.

Email acknowledgement and confirmation of renewal

- h) 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

- i) 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.
- j) Advance notice of any planned unavailability of online filing due to maintenance is given on the [Office website](#) and by email to registered users.
- k) 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.
- l) 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

Patents Practice Change

Practice change: Ceasing to issue Patents Form 10 reminder letter

We have changed our practice so that, as of 1 July 2014, if you have not requested substantive examination (by filing Patents Form 10) we will no longer send you any reminders. More information on this change in practice can be found at www.ipo.gov.uk/p-pn-form10.

How to request substantive examination

You may request and pay for substantive examination online by using our web filing service at www.ipo.gov.uk/p-apply-online-sfdchecklist.

Alternatively Patents Form 10 may be downloaded at www.ipo.gov.uk/p-formsfees.

More information on requesting substantive examination can be found on our website at www.ipo.gov.uk/p-subexam.

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.
Cranford Community College -and- Cranford College Limited (1) Nigel Woolley (2) Timesource Limited -and- (1) Up Global Sourcing UK Limited (formerly Ultimate Products Limited) (2) The Lacamanda Group Limited (formerly Henleys Clothing Limited)	17 February 2014	C/018/14
Merck KGaA -and- (1) Merck Sharp & Dohme Corp (2) Merck & Co, Inc (3) Merck Sharp & Dohme Limited (4) Intervet UK Limited (5) Intervet International BV		C/019/14
(1) Hearst Holdings Inc (2) Fleischer Studios Inc -and- (1) A.V.E.L.A. Inc (2) Poeticgem Limited (3) The Partnership (Trading) Limited (4) U Wear Limited (5) J Fox Limited	29,30,31 Jan, 02, 05 Feb 2014	C/020/14
(1) Elsworth Ethanol Company Limited (2) Neil Bookless -and- (1) Brian Selby Hartley (2) Namdar Baghaei-Yazdi (3) Muhammad Javed (4) Bioconversion Technologies Limited		C/021/14
		C/022/14

(5) Ensus Limited		
(1) Barco De Vapor B.V. (2) Onderwater Agneaux B.V (3) Johannes Quirinius Wouterius Maria Onderwater (Trading as Joint Carrier) -and- Thanet District Council	11, 12, 16 and 17 December 2013	C/023/14
Magmatic Ltd -and- PMS International Ltd	21 January 2014	C/024/14
MB Garden Buildings Limited -and- (1) Mark Burton Construction Limited (2) Mark Burton	14 February 2014	C/025/14
Jarden Consumer Solutions (Europe) Limited -and- SEB SA -and- Groupe SEB UK Limited	4-6, 10 February 2014	C/026/14
F H Brundle (a private unlimited company) -and- Richard Perry -and- (1) Betafence Limited (2) Britannia Fasteners Limited	23 January 2014	C/027/14
(1) Brian Wade (2) Geraldine Perry -and- British Sky Broadcasting Limited	18, 19, 20, 21 February 2014	C/028/14
Samsung Electronics Co Ltd -and- (1) Apple Retail UK Ltd (2) Apple Sales International	12 February 2014	C/029/14