

# **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**

### **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) 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

## **Directions under section 123(2A) of the Patents Act 1977**

### **Patents Form 1**

1. The comptroller has made these Directions under section 123(2A) of the Patents Act 1977.

2. These Directions set out some changes to the forms whose use is required by rules.

3. These Directions come into force on 1 April 2014.

4 The following Patents Forms as set out in the Schedule to these Directions are the forms the use of which is required by the Patents Rules 2007 (SI 2007/3291):

- **Patents Form SP1** (Application for grant of a supplementary protection certificate)
- **Patents Form SP3** (Application for declaration of lapse or validity, or to revoke an extension of the duration of a supplementary protection certificate)

5. Patents Forms SP1 and SP3 as so set out, replace the corresponding forms in the Schedule to the Directions made on 5 December 2007 (which came into force on 17 December 2007). The Directions made on 5 December 2007 are, to that extent, revoked.

**John Alty**

**Comptroller-General of Patents, Designs and Trade Marks**

**13 February 2014**

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

## Guidance and notes on the Directions given under section 123(2A)

### Patents Forms SP1 and SP3

- (a) These notes are not part of the Directions. They are intended to provide background and additional information.
- (b) The Interpretation Act 1978 applies to these Directions. Therefore, all the definitions set out in that 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.
- (c) Section 123(2A) of the Patents Act allows the comptroller to give directions specifying any forms the use of which is required by the Patents Rules.
- (d) Patent Form SP1 has been amended in line with the decision in [BL O/418/13](#) (Genzyme Corporation). The form now requests the date of notification and copy of the Official Journal of the European Union be provided when the earliest authorisation is a European Marketing Authorisation granted through the centralised system under Regulation (EC) No 726/2004.
- (e) Patent Forms SP1 and SP3 have also both been amended to refer to the codified Council Regulation concerning the supplementary protection certificates for medicinal products ((EC) No 469/2009).
- (e) All of the UK patents forms (and information about associated fees) are available on our website.
- (f) 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 813822



Intellectual  
Property  
Office

**Patents Form SP1**

Patents Act 1977 (Rules 116(1))

**Application for grant of a Supplementary Protection Certificate**

(See the notes on the back of this form. You can also get an explanatory booklet from the Office to help you fill in this form)

Concept House  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ

1. Your reference

2. Certificate application number  
(The Office will fill in this part)

3. Full name, address and postcode of the or of  
each applicant (underline all surnames)

ADP number (if you know it)

4. Name of your agent (if you have one)

"Address for service" in the European  
Economic Area or Channel Islands to  
which all correspondence should be sent  
(including the postcode) (see note (d))

ADP number (if you know it)

5. Are you applying for a certificate under  
(a) the EC Regulation for medicinal  
products (No. 469/2009)?  
(b) the EC Regulation for plant protection  
products (No. 1810/96)?  
(Answer by writing (a) or (b))

6. What is the product that you want to protect?

(Identify the active ingredient(s) or active substance(s).  
If possible use chemical or generic names)

7. Number, title and expiry date of the basic  
patent (GB or EP(UK)). If the patent was  
granted after the date of authorisation at 8  
below, give the patent grant date also.

Number

Title

(The expiry date is the day before the  
20<sup>th</sup> anniversary of the filing date)

Expiry Date  
(day/month/year)

Grant Date  
(day/month/year)



8. Number and date of the first authorisation to place the product on the market in the UK <i>(Articles 3 and 8(1)(b) of the EC Regulations see note (f) below)</i>	Number	Date <i>(day/month/year)</i>
9. Where the authorisation at 8 is not the first authorisation to place the product in the market in the Community, give the information requested about the first such authorisation  <i>(Article 8(1)(c) of the EC Regulations; see also note (e) below)</i>	State and Number	Date <i>(day/month/year)</i>
	Identity of the product authorized  Legal provision under which the authorisation took place	
10. If you are filing any of the following documents, state which <i>(Answer by writing (a) - (f) as appropriate)</i>		
<p>(a) Copy of a UK authorisation at 8 above <i>(Article 8(1)(b) of the EC Regulations)</i></p> <p>(b) Notice publishing authorisation at 9 above <i>(Article 8(1)(c) of the EC Regulations)</i></p> <p>(c) Verified translation of (b) if not in English</p> <p>(d) Information showing that the product is protected by the basic patent</p> <p>(e) excerpt from the OJEU showing the notification date of a centralised authorisation granted under Regulation (EC) No 726/2004 (see note (f) below)</p> <p>(f) Other <i>(please specify)</i></p>		
11. I/We request the grant of a certificate on the basis of this application.	Signature	Date
12. Name, e-mail address, telephone, fax and/or mobile number, if any, of a contact point for the applicant		

## Reminder

**Documents relating to an application for a certificate will normally be open to public inspection. If you want us to keep copies of any documents such as marketing authorisations (or parts of them) confidential, you must ask for this when filing or sending the document. You must give reasons for your request.**

## Notes

- a) *If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000.*
- b) *Write your answers in capital letters using black ink or you may type them.*
- c) *If there is not enough space for all the relevant details on any part of this form, please continue on a separate sheet of paper and write "see continuation sheet" in the relevant part(s). Any continuation sheet should be attached to this form.*
- d) *Although you may have an address for service in the Channel Islands, any agent you appoint to act for you must reside in or have a place of business in the European Economic Area or Isle of Man.*
- e) *In some cases, an authorisation in a state which is not an EU Member State, but is a party to the European Economic Area Agreement, may constitute the first authorisation in the Community. Please refer to the Office's explanatory booklet Supplementary Protection Certificates Guide For Applicants for further information. This explains the effect of a first authorisation in Switzerland in relation to Liechtenstein.*

- f) In cases where the earliest marketing authorisation is a European Marketing Authorisation granted through the centralised system under Regulation (EC) No 726/2004, the date of the first authorisation in the Community is the date of notification to the applicant of the grant of this authorisation, because this is the date that such an authorisation takes effect (for further information please refer to the Office's explanatory booklet Supplementary Protection Certificates Guide For Applicants)*
- g) Once you have filled in the form remember to sign and date it.*
- h) For details of the fee and ways to pay please contact the Office.*



Intellectual  
Property  
Office

**Patents Form SP3**

Patents Act 1977 (Rule 76(3))

**Application for declaration of lapse or invalidity, or to  
revoke an extension of the duration of a supplementary  
protection certificate**

*(See the notes on the back of this form)*

Concept House  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ

1. Your reference:

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2. Certificate number:

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3. Full name of the or of each certificate holder

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4. Your full name, address and postcode

ADP number *(if you know it)*

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5. Is this application for:

(a) A declaration of lapse under Article 14(d)  
of the EC Regulation for medicinal  
products (No. 469/2009)?

(b) A declaration of invalidity under Article 15  
of the EC Regulation for medicinal  
products (No. 469/2009)?

(c) Revocation of an extension of the duration  
of a supplementary protection certificate under  
Article 15a of the EC Regulation for medicinal  
products (No. 469/2009)?

(d) A declaration of lapse under Article 14(d)  
of the EC Regulation for plant protection  
products (No. 1610/96)?

(e) A declaration of invalidity under Article 15  
of the EC Regulation for plant protection  
products (No. 1610/96)?

*(answer by writing (a), (b), (c), (d) or (e))*

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6. Name of your agent *(if you have one)*

"Address for service" (including postcode) in the  
European Economic Area or Channel Islands to  
which all correspondence should be sent.  
*(see note f)*

ADP number *(if you know it)*

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7.

Signature

Date

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8. Name, e-mail address, telephone, fax and /or  
mobile number, if any, of a contact point for the  
applicant

**(REV FEB14)**

Intellectual Property Office is an operating name of the Patent Office

**Patents Form SP3**

**Notes**

- a) *If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000*
- b) *Write your answers in capital letters using black ink or you may type them.*
- c) *If there is not enough space for all the relevant details on any part of this form, please continue on a separate sheet of paper and write "see continuation sheet" in the relevant part(s) of the form. Any continuation sheets should be attached to this form.*
- d) *You must file this form in duplicate.*
- e) *You must also file two copies of a statement in which you should set out*
- *the facts and grounds which you rely on*
  - *what you want the Office to decide*
- f) *Although you may have an address for service in the Channel Islands, any agent you may appoint to act for you must reside in or have a place of business in the European Economic Area or Isle of Man.*
- g) *Once you have filled in the form remember to sign and date it.*
- h) *For details of the fee and ways to pay, please contact the Office.*

## 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](http://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](http://www.ipo.gov.uk/p-apply-online-sfdchecklist).

Alternatively Patents Form 10 may be downloaded at [www.ipo.gov.uk/p-formsfees](http://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](http://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  C/019/14  C/020/14
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  (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/021/14
(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/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