



Restorations – the UK landscape

IP rights are essential to many businesses but in some circumstances they may be lost

There are mechanisms for restoration available for IP rights lost in a variety of ways, including: non-payment of an annuity (renewal fee); inadvertently missing the filing date of a PCT application; and missing the deadline for national/regional phase entry (e.g. into Europe). This article focuses on patents/patent applications, although many of the principles can apply to trade marks or other registered rights.

The most common cause of rights being lost inadvertently is because of a missed annuity payment. This article tells you how you can go about restoring a patent that has lapsed for this reason at the UKIPO

Whether the patent which has lapsed is a GB patent or an EP(UK) patent doesn't make any difference – they are both treated the same. This is because, once granted, a European patent application that is validated in the UK becomes a national patent equivalent to a patent granted on a GB patent application; the same restoration procedure applies to both.

What do I have to do, and when do I have to do it?

If you have just realised that a UK patent for which you are responsible has lapsed, you need to make an application for restoration at the UKIPO as soon as possible – this is to minimize the risk that a third party will gain the right to use your invention. As background, once a patent has lapsed, third parties are able to use the invention freely and carry out what would otherwise have been infringing acts. This can be stopped, though, even before the lost rights have been restored, by filing an application at the UKIPO to restore the patent (using the relevant form, PF16). Evidence supporting the restoration request does not need to be filed at the same time as the PF16; evidence can be filed later.

Once the PF16 is filed, third parties are again stopped from using the invention, and that will continue to be the case if restoration is successful.



It is important to note, though, that any person who took steps to work the invention during the period after the patent lapsed (the UKIPO register uses the word 'ceased') but before the restoration application was made is free to continue what they have started without infringing the restored patent. In other words, they can work the invention during the restoration procedure and also even after restoration has been successful. This protection to third parties only applies once the patent has actually lapsed, though, and not during the six months' grace period when late annuities can still be paid.

Once the UKIPO has received your request for restoration, it will contact you giving a deadline by which supporting evidence needs to be filed. This is generally around eight weeks later.

The application for restoration needs to be made by the party that was the proprietor of the patent at the time the missed annuity was due. Therefore, if the patent had been assigned from Party A to Party B but the assignment had not been recorded, the restoration application should be filed by Party B, along with a request to record the assignment from Party A to Party B (using the relevant form, PF21).

Whilst it is important to file the restoration request as soon as possible after the patent has lapsed, in reality you may for one reason or another not find out about the lapse until much later. It is possible to file a restoration request at the UKIPO up until 13 months from the end of the six months' grace period (i.e. 19 months from the date the annuity was missed).

I didn't mean it, cross my heart: the meaning of 'unintentional'

For UK patents that lapsed before 1st January 2005, the proprietor needed to show that the lapse occurred in spite of 'reasonable care' having been taken by the proprietor and/or their representatives.

Now, in order for a restoration request to succeed, the proprietor needs to provide evidence to the UKIPO that it didn't intend for the patent to lapse; that it was the proprietor's intention to maintain the patent and thus that the lapse was 'unintentional'. Even though this 'unintentional' standard is lower than the old UK 'reasonable care' one, and is also lower than the EPO's 'all due care' standard, an explanation of the circumstances which led to the error still needs to be provided to the UKIPO. It is not sufficient to apply to the UKIPO simply stating that the lapse was unintentional, and requesting that the Comptroller please restore the patent (see *Matsushita Electric Industrial Co. v Comptroller General of Patents* [2008] 35 RPC 2071 (EWHC)).

However, showing that the lapse was unintentional is not always straightforward. The relevant circumstances and internal decision-making within the proprietor's organization during the period before the patent lapsed may not always be clear-cut, so care often needs to be exercised when putting together a witness statement even with regard to this lower, 'unintentional' standard. It is important to note that the UKIPO will not restore a patent if it considers that the proprietor had intended to allow the patent to lapse, and subsequently changed its mind.

The Comptroller's decision

After receiving the further evidence supporting the request for restoration, the UKIPO generally responds within two to three weeks, either stating that it is minded to grant the restoration request (upon the proprietor paying the outstanding annuities), or stating that it is minded to refuse the request. In the latter case, the proprietor is given a period of one month to provide further submissions in support of its request for the Comptroller to restore the lapsed patent. An application for restoration cannot be opposed by other parties – once made, the Comptroller's decision is final.



In the case of a successful request for restoration, and once the annuities which are due have been paid, the UKIPO issues an order of restoration.

When the lost patent has been restored, the most important thing to do is to make sure that all of the docketing and records systems reminders and related checks, including the proper treatment of external annuity reminders, which should have been in place and functioning efficiently to avoid any inadvertent lapses, are now in place. Thus, the proprietor's records ensure that future annuities are dealt with smoothly and in a timely fashion.

Authors: [Jake Marshall](#), [Simon Keevey-Kothari](#), [Chloe Taylor](#) and [Kasia Ksiezopolska](#)

Need advice?

For more information, please contact:
email@carpmaels.com.

Carpmaels & Ransford is a leading European IP firm based in London. For more information about our firm and our practice, please visit our website at:
www.carpmaels.com.

This information provides a summary of the subject matter only. It should not be acted on without first seeking professional advice.

Carpmaels & Ransford LLP is regulated by the Intellectual Property Regulation Board (IPREG).

Copyright © Carpmaels & Ransford LLP 2018