

European Patent Application Renewal Fees WARNING!

Annual maintenance fees are payable to the European Patent Office from the end of the second year of an application, counted from its date of filing in the EPO. In the case of applications derived from international applications filed under the Patent Co-operation Treaty (PCT), the second year is counted from the international filing date of the PCT application.

HGF has a maintenance fee payment service. However, some clients prefer to handle their own renewals, or appoint specialist annuity service firms to pay their fees on their behalf. HGF is content to prosecute patent applications either case. This note explains some of the risks of NOT appointing HGF to handle this aspect of a European patent application and the procedures put in place in the case a renewal fee is missed by an external (to HGF) provider.

If HGF are to be responsible for renewal fee payments:

If HGF are to be responsible for the annual renewal fees of a European application then we enter the requisite details into our Central Renewals System and send timely reminders, and pay the requisite fees, according to your instructions. We monitor late payments (if you require them) and ensure that deadlines are met. ***In the absence of specific instructions to the contrary, this is our default position and we assume that we are responsible for payment of renewal fees. We need no separate instruction.***

If HGF are not to be responsible for renewal fees:

If we are not to be responsible for payment of renewal fees, then please note the due date of the next renewal fee to be paid (which will be mentioned in our reporting letter). No reminders will be sent by HGF.

We draw your attention to the fact that not appointing HGF does involve some small risk in the event that:

- a renewal fee is missed, which
- results in the application becoming deemed withdrawn, and for which
- a request for re-establishment of the application becomes necessary.

In such a request, re-establishment of the application can only be secured if all parties connected with the application have taken all due care. This applies to the applicant and to the annuity service employed. However, it can also apply to the authorised professional representative (i.e. HGF), even though we have no responsibility for the payments. Thus, unless all due care by all parties is exercised (including HGF), it is unlikely that a request for reestablishment of the application will be successful.

We will not be exercising such due care in monitoring due dates of annual renewal fees. This is part of the risk that the applicant runs in the event that their annuity service misses a renewal fee (despite the annuity service and the applicant taking all due care).

The EPO normally issues to the professional representative a notice of overdue renewal if a renewal fee is not paid in due time. We will endeavour to forward that notice to you if we receive it, (or to whomever you tell us to send it). However, the notice is issued as a courtesy by the EPO. It cannot be relied upon as a method of ensuring that a missed renewal fee is caught.

There are two circumstances in which we will receive such a notice:

When you have already informed us that the application is to be abandoned, or that the fee has deliberately not been paid on time, with the object of taking advantage of the six month penalty period for later payment.

When you have NOT informed us as above, and as far as we know the application is still pending and there is no reason known to us why the payment should have been missed.

When you have previously notified HGF

In this event, we will forward the notice to you as a matter of courtesy and not take any further action. We will not seek an acknowledgement of receipt of the notice from you nor will we further monitor the application. The application will irrevocably be deemed abandoned on the first anniversary of the missed renewal fee initial due date.

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When you have NOT previously notified HGF

In this event we will report the late-payment notice in the same way as any other official action of the EPO, seeking your acknowledgement of receipt and monitoring receipt of your instructions. In order to ensure maximum chance of later reinstatement, EPO case law appears to suggest that merely sending the notice is insufficient. A professional representative is required also to continue to monitor payment of the fee and to ensure that the permitted extended deadline is not missed. If this is not done, a subsequent reinstatement application is unlikely to succeed.

In this circumstance we will therefore also insert reminders into our diary system and charge our normal reporting and docketing fee of £125. We will subsequently attempt to obtain your instructions as to whether the fee is indeed to be paid or the application abandoned. We will NOT pay the renewal fee without specific instruction.