

IP Renewals Procedure

This note is concerned with the procedure HGF employs when it has responsibility for handling periodic maintenance fees (renewal fees) that are due on IP rights that HGF is also handling in other respects. Patents and patent applications are generally renewable annually, although the start date for payment varies from country to country. Some countries (or international systems) do not require maintenance fees to be paid on applications at all. Designs are generally renewable every five years, and trade marks every ten years. This note is not concerned with other aspects of IP rights on which HGF may be appointed to act, for example: application, grant, opposition or enforcement procedures.

No HGF Renewal Responsibility

Some clients wish to use external providers or to pay renewal fees themselves. In this event, we mark the relevant cases on our records system as “No Renewal Responsibility”. We will generally inform our clients of the first or next renewal due date, but then take no further action thereafter with regard to the periodic maintenance fees. In this case, it is the responsibility of the client/applicant/proprietor to monitor due dates themselves and make the requisite payments. (However, please see our note [here](#) on some specific risks associated with HGF not having responsibility for maintenance fees of European patent applications).

HGF Responsibility for Renewals

Where HGF does have responsibility for renewal fee payments, we have two modes of operation – “Seek Instructions” and “Autopay”. We have the possibility of handling all cases of a particular client, or of a particular applicant, in either of these two modes. We can, on request, split portfolios between these two modes.

Instructions Required

Each month, we interrogate our maintenance system and produce a schedule of cases of a given client/applicant that are due for renewal in three months’ time. We send that schedule by email to the person in our client’s organisation who HGF has been notified is responsible for providing instructions.

We ask for instructions in good time before the due date. We specifically exclude liability in the event of an error occurring in the processing of a renewal if instructions are received within the last five working days before a due date. Late instructions will of course be accepted and acted upon, but last-minute handling makes errors difficult to detect and correct in time.

Sometimes we will ask to be put in funds in order to cover the costs of renewal before we will accept instructions. In this case, instructions are not deemed received by us until we have also received the funds into our account. In this case, clients should tell our renewals team (e.g. on Renewals@hgf.com) when they have paid, so that we can connect the payment with the instruction and act on them.

After our first communication regarding up-coming renewals, we will remind clients of the need to provide instructions if we have not yet received them. However, whilst we have a policy that, in the absence of instructions from our client, we will generally automatically take the minimum necessary steps to maintain IP rights, this does not apply to renewals except in rare circumstances. Generally, we will NOT renew without instructions (and, where we have requested it, without funds having been paid in advance).

Sometimes renewals can be deferred beyond their normal due date. This is typically for six months, but usually only on payment of additional official penalty fees. In the absence of satisfactory instructions by the normal due date, we will automatically make use of such penalty periods and adjust our charges for payment if and when instructions are eventually given.

Autopay

When a client instructs us in relation to specific patent cases, that those cases are to be handled on our Autopay system, we automatically pay due renewal fees in the month preceding the month of their due date for renewal. If payment of our invoices has been delayed in the past, or seems doubtful in the future, we reserve the right to seek funds before we put the renewal in hand. In that circumstance, we will NOT automatically pay the renewal fee until we have received the required funds.

If requested to do so, we will issue each year (or at any time) a schedule of cases in our Autopay system. This will indicate the renewal dates of cases due for renewal in the forthcoming year. It is the responsibility of our client to inform us before we are due to pay a renewal fee if the fee is not to be paid. In that event, we will mark the case as abandoned and not renew it. If we are instructed to abandon an application that we are currently prosecuting to grant, this instruction will be deemed to extend to the renewal of that case.

Autopay is not designed for design and trade mark renewals since these rights are renewed less frequently than patents (generally every five and ten years respectively). Circumstances tend to change over such longer periods and we generally seek instructions.

Invoicing

In either mode of operation, after the renewal fee has been confirmed as paid, we will issue our corresponding invoice.

Address for Correspondence and Instructions

It is of course important that our clients keep us informed of the address and contact details of the person in their organisation to whom we should report and send our invoice, and from whom we should seek instructions, on renewals matters. We cannot accept responsibility for a failure to renew an IP right if our client does not keep us informed of their contact details. This can especially be a problem with designs and trade marks that are renewed every five or ten years. We will of course endeavour to send reminders but can only send them to the last known address of our clients. We would certainly suggest that our clients diarise renewal due dates themselves.