

BRIEFING: ABANDONING A PATENT

In order to maintain a patent in force, it is necessary to pay annual renewal fees to the UKIPO. If the cost of patent renewals can no longer be justified, then the patentee may abandon its patent. In such a situation, it will cease to have effect, and the technology covered by the patent will become free for anyone to use. In the United Kingdom, there are, however, several ways of abandoning a patent, which this leaflet will attempt to summarise.

Taking no further action:

By taking no action and failing to pay the next renewal fee when it becomes due, the patent will *eventually* cease to have effect. This occurs upon expiration of the current patent year, but it is nevertheless possible to pay renewal fees up to six-months late - upon payment of modest late payment fees. Thereafter, the patentee may still apply to restore his or her patent up to 13-months after the expiry of the 6-month late-payment period if reasons are given and the Patent Office is satisfied that the failure to pay the renewal fee was "unintentional". These provisions can be useful where it is unclear whether the patent will continue to be of commercial value. In other words, the patentee still has the opportunity to "change his or her mind" up to six-months after the renewal deadline, and can still apply to restore the patent if the failure to renew on time was "unintentional". It should be borne in mind, however, that if a third party makes effective and serious preparations to put the invention into effect, at any time between the 6- and 19-month deadlines, then he or she may be entitled to continue those acts, notwithstanding the fact that the patent may be restored at a later date.

Licenses of right:

A patentee may choose to advertise the fact that licenses under the patent are available as of right, in which case, the renewal fees will be halved. In such a situation, the patentee must continue to pay annual renewal fees at the reduced rate, and will not be able to prevent third parties from using the patented technology under license. This provision may be useful where the patentee seeks to reduce its costs, where he or she wishes to encourage others to use the patented technology, and/or where it is felt that making licenses available as of right may encourage third parties to license the technology on favourable terms. Licenses of right status can also be withdrawn at a later date, whereupon the full renewal fees will be payable although the rights of licensees may not be altered by the change of status.

Surrender:

In certain rare cases, the patentee may wish to formally surrender his or her patent. This can be done by simply writing to the Patent Office and the offer to surrender will usually be accepted - unless there are infringement or revocation proceedings pending in relation to the patent. Third parties may oppose the offer to surrender. If the Patent Office accepts the offer to surrender, the patent will be treated as if it never had effect, and so the former patentee will be barred from bringing any infringement action – even in respect of allegedly infringing acts that took place whilst the patent was in force, and before its date of surrender.

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