



## Minor changes to Patents legislation made by the Intellectual Property Act 2014 – business guidance

### Background

The Intellectual Property Act 2014 makes various minor changes to the Patents Act 1977, which will come into effect on 1 October 2014. These minor changes are contained in the Schedule to the Act.

In general, these changes will have little impact on users of the patent system. However where a business or individual finds themselves in the very particular circumstances concerned, these changes will provide clarity and legal certainty.

This document summarises those minor patents changes that will have an impact on businesses, whether they are users of the patent system or have an interest in the patents and patent applications of others. [Separate guides](#) are available on the more significant changes in the IP Act, including: patents webmarking, changes to the patent opinions service, changes to patents worksharing, and changes to design law.

### Payment of renewal fees on restored European patents (UK)

A “renewal” fee has to be paid annually to keep a patent in force in the UK. Currently, in one very rare situation where a European patent (UK) has been revoked and is later restored there is nothing in the legislation which requires the patent owner to pay UK renewal fees for the period when the patent was revoked. This situation is so rare that only 4 patents have ever been affected (correct at the time of drafting).

Businesses finding themselves in this very particular situation generally wish to pay these fees in order to keep their patents in force. On 1 October 2014 the law will change to ensure that there is a clear legal requirement setting out when these fees must be paid. This will provide legal certainty as to what is required to keep such patents in force, reduce the possibility of a later legal challenge to such patents, and may lead to a reduction in legal costs for the businesses involved.

### Change to the deadline for challenging patent ownership

Anyone who believes they are the rightful owner of a patent owned by someone else has two years from the date the patent is granted to challenge its ownership, if they want to benefit from the full range of legal remedies available. On 1 October 2014 the law will change to extend this deadline by one day so that it expires on the two-year anniversary of the date of grant, rather than one day prior to that. This will make the deadline intuitive and clear for both patent owners and those who wish to challenge the ownership of a patent, and will ensure it is consistent with other time periods in patent law.

## Assertion of third party rights when an application is terminated

A patent application may be terminated if it fails to meet certain requirements. However, in certain circumstances such an application can be reinstated - bringing the application back to life.

The law is currently unclear about the status of other businesses that start to manufacture, sell or otherwise use the invention in the UK during the period after a patent application is terminated and before it is clear whether it will be reinstated. The law is therefore changing on 1 October 2014 to clarify the point at which someone can start manufacturing, selling or using an invention without being in fear of infringement proceedings, in the situation where a patent application for that invention is terminated and may still be reinstated. This change will provide legal certainty by ensuring the law is clear and fits with user expectations.

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