

PATENTS ACT 2004

EXPLANATORY NOTES

COMMENTARY ON SECTIONS

Section 8 – Term of patent and periods allowed for payment of renewal fees

56. *Subsection (1)* substitutes a new section 25(3). Under the existing section 25(3), a patent which expires for non-payment of the renewal fee expires at the end of the period prescribed for payment of the fee. The new section 25(3) permits an expiry date to be prescribed which is different from the last day of the prescribed payment period, provided that it falls within the final month of that prescribed period. It is envisaged that the date prescribed for expiry will continue to be the anniversary of the filing date, but that the period prescribed for payment will run until the end of the month in which that date falls (and begin three months before). For example, if the anniversary of the date of filing is 18th June, the renewal payment period will run from 1st April to 30th June; but if the payment is not made by 30th June the patent will be deemed to have expired on 18th June.
57. *Subsection (2)* makes a consequential change to section 25(4) (which allows a further period of grace for the payment of a renewal fee). Under section 25(4) as amended, the period of grace runs until the last day of the sixth month to begin after the end of the period prescribed for payment. However, given that it is intended that the latter period will run until the end of the relevant month, the period of grace will continue to consist in an additional six-month period. Thus, if the prescribed payment period ends on 30th June, the period of grace for late payment will run until 31st December.
58. *Subsection (3)* makes a similar change to section 28 (which permits the restoration of lapsed patents in certain circumstances).
59. *Subsection (4)* amends section 46 (applications for an entry in the register that licences are available as of right), by substituting a new section 46(3)(d) and inserting a new subsection (3B) after section 46(3A). The effect is that (when the powers to prescribe are exercised as indicated above) it will continue to be the case that a patent must be made available for licences of right before the anniversary of the filing date, if the patent proprietor is to take advantage of the reduction by one half in the renewal fee payable for the following year. For example, if the anniversary date is 18th June, the proprietor will have to make licences of right available prior to that date if the renewal fee (payable by 30th June) is to be halved.