

POST-GRANT AMENDMENT

Introduction

1. This Guidance Note explains how changes to UK patent law, made by the Patents Act 2004 and implementing provisions of the revised European Patent Convention (“EPC 2000”), will affect post-grant amendment of patents.

What is the background?

2. EPC 2000 comes into force on 13 December 2007. The Patents Act 2004 includes provisions to implement changes necessary to ensure that UK patent law is consistent with EPC 2000. However, these provisions are not yet in force and it is proposed that they will come into force on 13 December 2007 to coincide with EPC 2000.

3. Currently a European patent may be amended separately before the national office or court of each Contracting State designated by the patent. This will remain the case but EPC 2000 introduces a new additional procedure for amending European patents centrally at the European Patent Office (EPO) so that the amendment will be effective in each of the Contracting States that have been designated.

What legislation is changing?

4. Changes to UK patent law are necessary to reflect the new central amendment procedure and are also desirable so that there is a consistent approach to post-grant amendment in the UK and at the EPO. UK patent law is amended to include a requirement that in considering whether to allow or refuse an amendment under section 27 (at the request of the proprietor) or section 75 (in infringement or revocation proceedings) of the Patents Act 1977 the comptroller or court shall have regard to any relevant principles applicable under the European Patent Convention. Changes are also made to sections 63, 58 and 72 of the 1977 Act to reflect the possibility of amending a European patent at the EPO during proceedings for infringement of a partially valid patent, disputes as to Crown Use and revocation.

What is the purpose of the new legislation?

5. The new UK legislation will ensure that there is consistency of approach in post-grant amendment in the UK and at the EPO. While the comptroller and the courts still continue to have discretion to allow or to refuse an amendment, in

exercising that discretion they are required to have regard to any relevant principles applicable under the European Patent Convention (e.g. relevant regulations under the European Patent Convention, any relevant guidelines produced by the European Patent Office and decisions of the Opposition Division and Boards of Appeal). The intended effect in the UK is that the old law relating to covetousness and delay is swept away and these matters are no longer an issue in post-grant amendment.

Who will be affected by the changes?

6. Any patent proprietor applying to amend their patent in the UK, either voluntarily or as part of infringement or revocation proceedings, will have their amendment allowed or refused having regard to principles applicable at the EPO. The old law relating to covetousness and delay will no longer be applicable.

7. Any proprietor of a European patent can apply to the EPO for central amendment of their patent either voluntarily or as part of infringement or revocation proceedings. The amendment will be effective in each Contracting State designated by the patent.

8. Third parties involved in litigation over patent validity will no longer be able to make covetousness/delay arguments.

When will the changes be effective?

9. The new law will apply to all applications to make a post-grant amendment of a patent where a decision on allowance of that application is issued on or after 13 December 2007. For applications to amend which were filed prior to 13 December 2007 and where a decision is issued prior to 13 December 2007 the old regime will apply. However, for those applications where a decision has not issued prior to this date, the new regime will apply and the application will be allowed or refused on the basis of the new law.

Further information - Amendments in a language other than English

10. Under section 77(7) of the Patents Act 1977 in combination with sections 77(4) and 77(6)(b), if a European patent is centrally amended at the EPO and the amendment is made in French or German a translation into English of the specification as amended is required before the end of the prescribed period (section 77(6)(b)). If such a translation is not filed, the patent shall be treated as always having been void (section 77(7)). The prescribed period is three months after publication of the amended specification. Consequently, **any patent proprietor centrally amending their patent at the EPO must file an English**

translation of the amended specification if they wish their European patent to remain in force in the UK. However, once the London agreement takes effect (expected to be early 2008), translations will generally cease to be required. A summary of the London Agreement is available on the EPO website at:

[http://documents.epo.org/projects/babylon/eponet.nsf/0/95467998a8361713c125726f004c6590/\\$FILE/The_London_Agreement_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/95467998a8361713c125726f004c6590/$FILE/The_London_Agreement_en.pdf)

A brief summary

- Allowance or refusal of a request to amend a patent in the UK will give regard to any relevant principles applicable under the European Patent Convention.
- A European patent proprietor may amend their EP (UK) patent in the UK or centrally amend the European patent at the EPO.
- For a centrally amended European patent the amendment will be effective in each designated Contracting State.
- Where the amendment is made centrally in French or German, a translation into English of the specification must be filed at the UK Intellectual Property Office within three months.
- The new law is effective for **all** decisions on the allowance of an application to amend a patent from 13 December 2007.

Where can I get more information?

11. Explanatory Notes to the Patents Act 2004 remain available from the OPSI website:

<http://www.opsi.gov.uk/acts/acts2004/20040016.htm> (The Patents Act 2004)

<http://www.opsi.gov.uk/acts/en2004/2004en16.htm> (Explanatory Notes)

12. Furthermore, the UK Intellectual Property Office's comprehensive guide to patent law and practice, the *Manual of Patent Practice*, will be updated to reflect these changes. The *Manual* is available to download from the UK Intellectual Property Office website at:

<http://www.ipo.gov.uk/patent/p-decisionmaking/p-law/p-law-manual/p-law-manual-practice.htm>

Status of this Guidance Note

13. This Guidance Note has been prepared by the Intellectual Property Office. It gives the Office's view of the changes made by the Patents Act 2004 and as such it has no legal force.

UK Intellectual Property Office

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