

Translation requirements for granted European Patents (UK)

Introduction

1. This Guidance Note explains forthcoming changes to the effect of UK patent law resulting from implementation of the London Agreement on the application of Article 65 EPC, which affects the requirement to provide translations of European patents (the London Agreement). The relevant legislative provisions are rule 56 of the Patents Rules 2007 and section 77(6) of the Patents Act 1977 (the Act).

What is the background?

2. Currently, for a granted European Patent (UK) (EP(UK)), the specification of which is published in French or German, the patent proprietor must file at the UK Intellectual Property Office (UKIPO) a translation into English of the specification in order for the patent to come into force in the UK.

3. The cost of filing translations for a European patent represents a significant proportion of the cost of obtaining a European patent. In June 1999 a Paris Intergovernmental conference mandated a working party on cost reduction to find ways of reducing translation-related patent costs by 50%. An Agreement on translations was adopted at the second Intergovernmental Conference in London in October, 2000 (the London Agreement).

When will the legislation change?

4. The London Agreement comes into force on the first day of the fourth month after the eighth Contracting State ratifies the agreement (provided that this includes the UK, France and Germany). Following ratification by France there are now sufficient ratifications for the Agreement to enter into force¹ and the London Agreement will come into effect on 1 May 2008.

What legislation is changing in the UK?

5. Section 77(6) of the Act will cease to have effect on the day appointed by rule 56(10) of the Patents Rules 2007, that is the day of the coming into force of the London Agreement. Section 77(6) requires that a translation into English of the specification of a EP(UK) granted, or subsequently amended, in French or German be filed within three months (rule 56(6)) of the date of grant or publication of the amendment. From 1 May 2008 a translation of an EP(UK) granted in French or German will therefore no longer be required.

¹ On 1 May 2008, the London Agreement will take effect in fourteen countries: Croatia, Denmark, France, Germany, Iceland, Latvia, Liechtenstein, Luxembourg, Monaco, Netherlands, Slovenia, Sweden, Switzerland, and the United Kingdom. Twelve countries have officially ratified the Agreement. Sweden and Denmark have not officially ratified, but will take the necessary steps so that the Agreement also applies to them when it enters into force.

What is the purpose of the change in legislation?

6. The cost of translation of European patent specifications under the arrangements prior to the London Agreement coming into force has been significant; an average translation cost of 7000 euros has been incurred. Evidence, however, shows that only a very small proportion of translations filed are ever consulted. Therefore, there appears to be little benefit to business of this regulatory burden. The removal of the translation requirement for some countries and reduction of the requirements in respect of others is expected to save patent proprietors a significant proportion of the cost of patenting an invention in Europe.

Who will be affected by the changes?

7. Any patent proprietor of a granted European patent, designating a London Agreement state. For an EP(UK) published in French or German a translation into English of such patents will no longer be required in order for the patent to come into force in the UK. The translation requirement for European patents effective in other Contracting States which have also ratified the London Agreement will be similarly reduced in those other Contracting States.

8. Anyone wishing to establish the scope of protection conferred in the UK by a granted EP(UK). An English translation of a specification filed in French or German will no longer be available. However, evidence has shown that only a very small proportion of translations filed with UKIPO are consulted. The claims and abstracts of such patents will continue to be available in English.

Are there any transitional arrangements?

9. Article 9 of the London Agreement makes transitional provision to the effect that the changes apply to European patents whose grant is mentioned in the European Patent Bulletin from the date of coming into force of the Agreement. However, UK legislation was implemented without a similar transitional provision, thus providing additional benefit to patent proprietors by allowing them to take advantage of the existing three-month period for filing translations. This means that any EP(UK) granted on or after 1 February 2008 and therefore having a three month prescribed period for filing a translation expiring on or after 1 May 2008 will not require a translation to be filed. Such a patent will become a patent under the Act by virtue of section 77(1).

Can I extend an existing period for filing a translation that expires before 1 May 2008?

10. Extensions to the prescribed period under rules 108(2) or 108(3) will be treated under current legislation up until 30 April 2008. Requests for extensions to the period made on or after 1 May 2008 will be considered depending on the facts of the case.

For an EP(UK) granted between 1 December 2007 and 31 January 2008

A two month extension to the period may be requested under rule 108(2). A two month extension **requested before 30 April 2008** will be automatically allowed as usual. If the extended period will expire on or later than 1 May 2008 a translation **will not** need to be filed for the patent to come into force.

For an EP(UK) granted prior to 1 December 2007

Any prescribed period extended under rule 108(2) will expire prior to 1 May 2008 and a translation **must** be filed for the patent to come into force in the UK **unless** a discretionary extension under rule 108(3) has been allowed. All such extension requests will be considered based upon the facts of the individual case.

A request for an extension to the prescribed period should be made using Patents Form 52 which requires a fee of £135.

11. Any granted EP(UK) whose (extended) prescribed period for filing a translation expires prior to 1 May 2008 where a translation is not filed will be treated under current legislation as always having been void by virtue of section 77(7). Unless a request for a discretionary extension under rule 108(3) is allowed such a patent will continue to be treated as always having been void.

A brief summary

- The London Agreement comes into force on 1 May 2008 when section 77(6) of the Patents Act 1977 ceases to have effect
- From this date a translation will not be required in order for an EP(UK) to have effect in the UK
- Patent proprietors can take advantage of the existing 3 month period for filing a translation - an EP(UK) granted from 1 February 2008 will not need a translation to be filed
- Extensions requested before 1 May 2008 will be processed according to the current law
- Extensions requested on or after 1 May 2008 will be considered depending on the facts of the request

Where can I get more information?

12. [The Patent Rules 2007](#) which revoked the [Patents \(Translation\) Rules 2005](#) makes relevant provisions in rule 56.

These rules and the superseded Patents (Translation) Rules 2005 and associated [explanatory note](#) are available on the OPSI website.

- The Patents Rules 2007

http://www.opsi.gov.uk/si/si2007/uksi_20073291_en_1

- The Patents (Translation) Rules 2005

<http://www.opsi.gov.uk/si/si2005/20050687.htm>

- Explanatory note to the Patents (Translation) Rules 2005

http://www.opsi.gov.uk/si/em2005/uksiem_20050687_en.pdf

A table listing the [Contracting States](#) that have ratified the London Agreement can be found on the EPO website at:

- Contracting States

<http://www.epo.org/patents/law/legislative-initiatives/london-agreement/status.html>

13. 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:

- Manual of Patent Practice

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

Status of this Guidance Note

14. This Guidance Note has been prepared by the Intellectual Property Office. It gives the Office's view of the changes made by rule 56 of the Patents Rules 2007 in relation to implementation of the London Agreement and as such it has no legal force.