

April 2008

Application of the London Agreement in the UK

Official advice from the UK Intellectual Property Office (UKIPO) that it is not required to file English language translations in respect of French or German language European patents granted on or after 1 February 2008 has been contradicted by advice from patent counsel.

Under the UK Patents Act, translations of European patents in French and German are required to be filed within the usual period of three months from grant. The UKIPO took account of this three month period in determining when the London Agreement takes effect in the UK, and issued official advice that the London Agreement applies to all European patents granted on or after 1 February 2008.

Subsequently, the UK professional association (the Chartered Institute of Patent Attorneys) circulated to its members advice which had been obtained from a specialist patent barrister (advocate) disagreeing with the position of the UKIPO, and stating that the law requires translations to be filed in respect of European patents granted prior to 1 May 2008. The UKIPO has subsequently issued a communication maintaining its position.

Our view is that it is not absolutely safe to assume that translations may be dispensed with, in relation to patents granted between 1 February 2008 and 30 April 2008. Of course, patentees are free to decide, if they wish, that they will rely on the advice of the UKIPO in anticipation that the courts would uphold this position. Any patentee who takes such a view does so at a small but real risk, since the only certain way of guaranteeing validity in the UK is to file a translation in respect of European patents granted in French or German prior to 1 May 2008. Having said that, it is possible that the UKIPO will refuse to accept translations after 1 May 2008 on the grounds that, in their view, there is no requirement for them; of course, a patentee could not be held at fault if the UKIPO refused to accept a translation filed on or after 1 May 2008 and it would in principle be safer to file a translation after that date than not at all.

Consequently, our prudent advice is that clients should file translations, for patents granted prior to 1 May 2008. However, patentees who do decide to file translations should, in our view, endeavour to do so before 1 May 2008, since they may not be permitted to do so afterwards.

If you have any further questions regarding the implementation of the London Agreement, please contact Jonathan Couchman on +44 (0) 113 2330100 or email jcouchman@hgf.com

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