

Filing Translations for Granted European Applications

Introduction

1. This Guidance Note explains the changes to UK patent law, made by the Patents (Translations) Rules 2005, regarding the filing of translations upon grant of a European patent application, designating the UK and having been filed in French or German.

What is the background?

2. Prior to the changes made by these Rules, applicants were required to file a translation into English with the UK Intellectual Property Office of patents granted by the European Patent Office (EPO) if they wished their patent to have effect in the UK. The "London" Agreement on Translations aims to reduce the cost to business of such translations, by creating a reciprocal system in which applicants would not have to file translations upon grant.

The old law

An applicant who gained a granted European patent, who wished to obtain protection within the UK, and where the European application was pursued in either French or German (as the official languages of the European Patent Convention other than English) was required after grant by the EPO to file a translation with the UK Intellectual Property Office within three months.

Why change this legislation?

3. The cost of translation of a specialised document such as a patent is significant, and evidence shows that only a very small proportion of the translations filed with the Intellectual Property Office were ever consulted. Moreover, this information continues to be available through other channels. Therefore, there appeared to be little benefit to business of this regulatory burden.

When will the legislation take effect?

4. The Patents (Translations) Rules will only take effect once the agreement as a whole comes into force, that is to say three months after the eighth ratification has taken place (provided that includes the UK, France and Germany.) The commencement date referred to in the SI does NOT mean that translations will no longer need to be filed after 6 April 2005.

What's the purpose of the new legislation?

5. The new legislation aims to enact the provisions of the Agreement on Translations, in a way that ensures that the reciprocal nature of the Agreement is maintained. The Patents (Translations) Rules 2005 therefore will only come into effect when the Agreement as a whole enters into force. Under the provisions of the Agreement, this will occur three months after eight states, which must include the UK, France and Germany have ratified. Until this "appointed day," applicants will still have to file such translations if they wish to obtain protection in the UK.

Who will be affected by the changes?

6. The changes will affect any patent applicant or agent who wishes to maintain protection in the UK for a granted European patent, filed and prosecuted before the EPO in either French or German.

What are the changes in detail?

7. The changes effectively switch off the requirements in section 77(6) of the Patents Act 1977 which required that an applicant to file a translation after grant of a European patent application by the European patent office, where that application is not in English. This will only take effect once the "appointed day" is reached. The appointed day is when the Agreement enters into force. This date will be publicised via the Patent Office website. The provisions in Article 6 of the Agreement on translations set out that the agreement enters into force three months after the Agreement has been ratified by eight states, including specifically the UK, France and Germany as the three states in which the most European patents were granted.

The new law

After the appointed day, a patent application in French or German granted by the European patent office and designating the UK, will have legal effect in the UK in the same way as a patent granted in English. However, during court proceedings, or in proceedings before the comptroller, the rules of procedure may require that a translation will be required. Before the appointed day, the Patents (Translations) Rules 2005 have no effect, and applicants will continue to need to file translations under section 77(6) if they wish to have patent protection in the UK.

Where can I get more information?

8. Further information on the Agreement on Translations is available On this website

9. The *Manual of Patent Practice*, which reflects practice before in the UK Intellectual Property Office under the Patents Act 1977, will be updated to reflect the provisions of the Patents (Translations) Rules 2005. The Manual is available to download from the UK-IPO website.

Status of this Guidance Note

10. This Guidance Note has been prepared by the Intellectual Property Office. It gives the Office's view of the changes made by the Patents (Translations) Rules 2005 and as such it has no legal force.

UK Intellectual Property Office