

CAN FILING BY REFERENCE SAVE APPLICANTS TIME AND MONEY?

Under the EPC2000, a European patent application may not only be filed in any language (Article 14 EPC), but can also be filed by reference to an earlier application (Rule 40 EPC). Furthermore, it is no longer necessary to file an application with at least one claim in order for the application to obtain a filing date. The following discussion reviews the advantages and disadvantages of filing by reference and provides a recommendation which can be made to Applicants.

A European patent application can now be filed with reference to an earlier application. Rule 40 (2) EPC requires that to file a European patent application by reference, the Applicant must provide the application number, the filing date and the Patent Office where the patent application on which the European patent application is to be based (herein after referred to as the base application) was filed. As such, on the face of it, a European patent application can be filed very easily, with a minimum amount of information, simply by filing an appropriate form advising of the filing details of the base application. Therefore, one question that Applicants might ask is; can this apparently simplified way of obtaining a filing date for a European patent application be used to reduce the filing costs?

Furthermore, according to Article 14(2) EPC, the application in the language as filed is the definitive version of the European patent application with regard to content and subject matter. Therefore, if the base application is not in an official language of the EPO (not in English, French or German), then any mistakes which are made in the translation can be corrected to the content and the subject matter of that base application. This correction can

be done at any time during proceedings before the EPO. Given that the post grant Opposition proceedings are also "proceedings before the EPO", then this implies that a correction in translation can be made even during the Opposition proceedings.

Thus, although a translation into one of the Official Languages must be filed within two months (Rule 40(2) EPC), the translation can be made to conform to the original application at any time during proceedings.

Filing by reference may be seen to provide the following advantages:

- A European patent application can be filed very simply, with only a small amount of information using a prescribed form;
- Accordingly, a European patent application can be filed at very short notice, which having regard to the 12 month Paris Convention period, can be used to obtain a filing date, when last minute instructions are received by a client, although of course this is not encouraged;
- If the base patent application on which the European patent application is to be based is in a non-EPO language (not in English, French or German), then any mistakes which are made in the translation can be corrected at any time during proceedings before the EPO;
- Applicants may feel more comfortable with controlling the exact form of the application as filed at the EPO, which provides a similar effect to activating the European regional phase of a PCT application.

CONTINUED ON PAGE 2

EDITORIAL

Just as we go to press, we are able to confirm that the London Agreement will enter into force on 1 May 2008. France deposited the instrument of ratification with the German Ministry of Justice on 29 January 2008. For more information please see www.epo.org/topics/news/2008/20080130.html.

As reported in our December 2007 newsletter, the London Agreement will reduce the cost of translations at grant for some of the most commonly designated EPO states, so that it makes sense to delay grant until after 1 May 2008 where this is possible without risking accidental abandonment. Further information can be found at www.dyoung.com/publications/londonagreement.htm.

Although the London Agreement will save costs, the EPO has recently announced that it is increasing some fees from 1 April 2008 (see www.epo.org/patents/law/legal-texts/decisions/archive/14122007.html). Whereas most of the increases are relatively modest, the EPO is dramatically increasing claims fees. With effect from 1 April 2008, the claim fee for the 16th and each subsequent claim will be Euro 200. As this will have a significant effect on the cost of filing applications with larger numbers of claims, applicants may wish to consider bringing forward the filing of new European applications with larger numbers of claims to before 1 April 2008 in order to avoid this dramatic claim fee increase.

CONTENTS

PAGE 3
REGISTRATION OF ASSIGNMENTS
AT THE UK INTELLECTUAL
PROPERTY OFFICE

PAGE 4
UK-IPO INTRODUCES NEW
PATENTS RULES

CONTACT AND SUBSCRIPTIONS

On the other hand, although filing by reference may appear attractive, there are some disadvantages.

Within two months of the date of filing of a European patent application by reference, the applicant must provide a certified copy of the original application and, where that copy is not in an Official Language, file a translation of the earlier application in one of the Official Languages of the EPC (Rule 40(3) EPC).

If the base application was filed at the JPO or the USPTO, the EPO has an agreement that a certified copy is communicated automatically from the JPO and the USPTO. However, one is at the mercy of the JPO or the USPTO to satisfy this formality. Furthermore, the provisions of further processing, which allow the applicant to recover a missed time limit relatively easily are not available for both of these two month time limits. Furthermore, the time limit for filing the search and filing fees runs from one month from the filing date or from notification by the EPO. As such the time limit for paying the search and filing fees will run separately from the time limit for filing the certified copy and the translation thereof if relevant. Yet further, the time limit for paying any claims fees (payable for each claim after the eleventh claim), is one month from filing the first set of claims or one month from notification of non-payment of any claims fees (Rule 45(2) EPC 2000). Of course, the European patent attorney will not know the set of claims which is being filed until the patent specification of the base application is available, and so potentially there may be two actions required to pay the EPO fees in order to perfect the filing date.

Therefore, on reflection, although a filing date for a

European patent application can be obtained with greater simplicity with reference to an earlier application, the practical requirements which must be satisfied to perfect the filing process are still present but moved to after the filing date, with equally negative consequences if these dates are missed. As such, filing by reference can be seen as shifting the burden in perfecting the filing formalities from the Paris Convention deadline to two months later. With regard to a general principle that Patent Attorneys charge for work undertaken and liability incurred with respect to this work, it can be seen generally that any cost saving that one might make, when filing a European patent application by reference, is consumed by the work, which must be undertaken post-filing, to complete the filing formalities.

Perhaps an even more important consideration is that filing in a language that a European patent attorney can understand can provide some significant benefits, which would be lost if filing by reference. When filing a European patent application, a European patent attorney is provided with an opportunity to review the patent specification before filing, provided the European patent specification is available to the European patent attorney and in a language that the attorney can understand. This review of the patent specification provides the attorney with an opportunity, where appropriate, to introduce amendments in order to modify statements in the patent specification, which may be used during examination or during any court proceedings to force the applicant to restrict the scope of protection beyond that which the applicant would otherwise be entitled. Furthermore, the European patent attorney typically introduces general statements to provide legal basis for supporting amendments, which otherwise may not be allowed due to the strict interpretation on what constitutes introducing new subject matter. This could be as simple as reducing the number of claims, to avoid paying claims fees unnecessarily, or introducing a statement

into the patent specification to the effect that combinations of features maybe made beyond those explicitly mentioned in the claims. Such a statement may be used to avoid the EPO Examiner alleging that the European patent has been extended beyond the content of the application as originally filed, where the applicant seeks to amend the European patent by combining features, which are not in exact correspondence with the claim dependency expressed in the European patent application. Thus, filing by reference would deny the attorney the opportunity to introduce such amendments on filing or modifying statements which may be used to limit the scope of protection of the European patent.

Disadvantages of filing an application by reference can be seen therefore as the following:

- The European patent attorney cannot provide any review of the patent specification to modify limiting statements, suggest revision of the claims to reduce the claims fees and correct any formal deficiencies which are likely to give rise to objection when the European patent application is examined.
- A certified copy of the earlier application must be filed within two months of the date of filing, which is usually something which must be obtained from a Patent Office or forwarded to the EPO in the case of the JPO and the USPTO. Thus the applicant is at the mercy of the national patent office to complete a filing formality, for which there is no possibility of obtaining an extension, or further processing.
- There is a need to docket a separate two month time limit for filing the translation of the European patent application into one of the Official Languages, and to docket and have available for filing a certified copy of the earlier application for which the reference is being made.

REGISTRATION OF ASSIGNMENTS AT THE UK INTELLECTUAL PROPERTY OFFICE

- The national basic fee and search fee must be filed within one month from the date of filing the European patent application. If translation and certified copy is not received within one month of the filing date then claims fees may have to be paid separately from the payment of the national basic fee and search fee.

Filing by reference provides an applicant with an opportunity to obtain a filing date for a European patent application very simply and can also preserve a right to correct a translation of the European patent application from the language of the earlier application for which filing by reference is being made, where that application is not in an official language of the EPC. However, in practice, correction of a translation of an earlier application is rarely of value. Furthermore, although filing by reference provides a simple way to obtain a filing date for a European patent application, the requirements for perfecting the filing must be strictly observed within further one and two month time limits, undermining the simplicity of obtaining the initial filing data. Perhaps more significantly, the European patent attorney will be denied an opportunity to review the patent specification before filing, and make important modifications, which cannot be made after filing.

Following the introduction of the Patents Act 2004 and the amendments made by the Regulatory Reform (Patents) Order 2004 and the Patents (Amendment) Rules 2004, it has never been easier to register changes of ownership on the Register of Patents at the UK Intellectual Property Office (UK-IPO). The 1977 Patents Act has been amended to relax the rules somewhat concerning the documents filed for evidencing the change of ownership of a patent.

REQUIREMENTS

Under the revised provisions, the UK-IPO will accept an assignment deed containing the date of the transaction, the name and address of both parties, the patent number and the signature of the assignor.

The acceptance of single-signature documents relates only to transactions dated after 31 December 2004. Consequently, any transactions taking place before 1 January 2005 must contain the signatures of both the assignor and the assignee.

Assuming a document assigning the patent(s) has not been executed, we can prepare a standard assignment deed in preparation for signing.

Alternatively, for European patents designating the UK and where the change of ownership has already been registered at the European Patent Office, a copy of the communication confirming the recordal will suffice.

If the transfer of ownership has occurred because of a merger, the UK-IPO will accept a copy of the merger deed, an extract from the Trade Register, a document from the appropriate registration authority or a notarial declaration attesting to the merger.

A simple copy of the document affecting the transfer is acceptable. Authentication of the document itself or the signatories in any form is not required.

It is compulsory to file an English translation of any document in a foreign language although verification of the translation is unnecessary. We may be able to obtain an English translation upon request.

The document evidencing the transfer of ownership will be open to public inspection and therefore any information that is confidential should be concealed by filing relevant extracts of the assignment deed. The Patent Office reserves the right to request additional documentary evidence if in any doubt.

TIME FRAME FOR REGISTRATION

To obtain maximum protection from the UK Patents Act the transfer should be registered within six months from execution of the deed affecting the transfer.

CONSEQUENCES OF NON-REGISTRATION

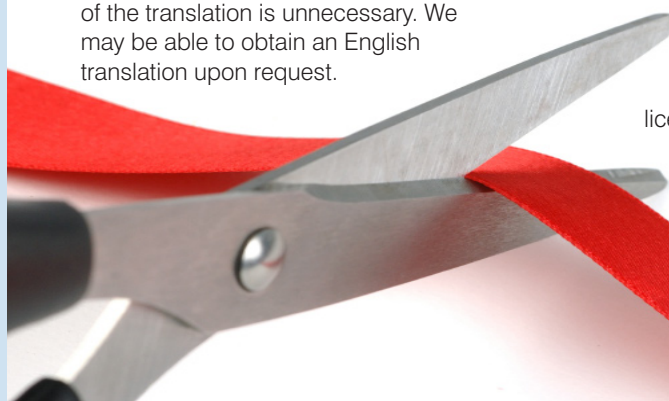
UK patent law stipulates that the assignment is not enforceable against third parties until it has been registered at the UK-IPO. In the event of legal proceedings the UK-IPO will not award damages for the period prior to registration of the assignment.

In addition, the assignee may lose the right, title and interest in and to the patent if another party acquires the patent, without notice of the unregistered right, and records his interest at the UK-IPO in good faith.

CONCLUSION

Whilst it is not compulsory to register any change of ownership on the Register of Patents, it is highly advisable to do so particularly in view of the simplicity of recordal and the nominal costs involved.

In closing it is worth mentioning that any change to the title of a patent should be registered at the UK-IPO including mortgages and company name changes. It is not necessary to register a licence under the patent but it may be advantageous to do so.



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UK-IPO INTRODUCES NEW PATENTS RULES

The UK Intellectual Property Office (UK-IPO) procedural rules in relation to patent applications and patents have been extensively revised and updated. The new rules, which came into force on 17th December 2007, include a number of changes aimed at modernising and clarifying the practices of the UK-IPO.

In particular, the rules governing the filing procedures for patent applications have generally been simplified and liberalised. The revised rules take into account the current practices of e-filing of patent applications and electronic case files. In specified circumstances, a paper copy of a document may no longer need to be filed if a UK-IPO examiner can access it from the internet. It is even possible now to file a UK patent application in Welsh.

There are also new flexible procedures for handling patent litigation in the UK-IPO, which are aimed at accelerating proceedings and reducing cost. The rules governing supplementary protection certificates (SPCs), which extend protection for certain patented pharmaceutical and agrochemical products, have also been simplified and harmonised with the rules relating to patents. The rules now include a procedure for applying for the new extension of 6 months to the term of SPCs for products approved for paediatric use.

Applicants working in the biotechnology area now need to file a document (in a defined format) listing any nucleotide or amino acid sequences in their UK patent application. Since this provision already applied to international and European patent applications, this change may simply mean that the sequence listing needs to be prepared at an earlier stage of the procedure.

In general these rule changes are good news for applicants as they should ensure that UK-IPO procedure reflects modern business practices and is as cost-effective as possible.

If you have any questions about the rule changes please contact your usual D Young & Co advisor.

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