



Advancing Industry's View On Intellectual Property Since 1920

THE LONDON AGREEMENT

UK Patent Office Consultation

General Statement of TMPDF¹ Position

1. We support the abolition of translation requirements for European patents (UK), but only in the context of the London Agreement. The UK should not abolish the requirements unilaterally. This would only benefit the mainly non-UK firms that have filed European patents in French or German, with no reciprocal benefit to UK companies owning European patents in other EPO states. There should be no thought of giving effect to the agreement in UK law in advance of the agreement entering into force.
2. The issues of ratification of the agreement and implementation of it, i.e., the changes needed in UK patent law to give effect to the agreement, should be considered separately.

Ratification

3. Ratification is the formal act that signifies that the UK will abide by the agreement when it enters into force. **The UK should deposit its instrument of ratification with the Government of the Federal Republic of Germany, in accordance with Article 3(2) of the agreement, as soon as possible.**
4. This will not bring the agreement into force. To bring the agreement into force, 8 states must submit their instruments of ratification or accession, including the 3 in which the most European patents took effect in 1999, i.e., UK, France Germany (hereafter referred to as the *required 8 states*) By ratifying the agreement, the UK will accept that the agreement will enter into force as provided in article 6 of the agreement, i.e., on the first day of the 4th month after the deposit of the last instrument of ratification or accession by the required 8 states.

Implementation

5. As regards implementation, we agree that this can be achieved by rule, as in rule 2 of the draft "Patents (Translations) Rules 2004" (Annex C of the consultation document). This rule states that Section 77(6) (which when in force effectively provides that European patents (UK) granted by the EPO shall be treated as UK patents only when a translation into English has been filed) shall cease to have effect on *the appointed day*.
6. The appointed day is defined in draft rule 1(2) as the day beginning after three months have elapsed from and including the day of coming into force of the agreement. This definition of the appointed day appears to be ultra vires. By ratifying (as the UK must do to bring the agreement into force), the UK will accept article 6 of the agreement. Article 6 defines when the agreement

¹ TMPDF represents the views of UK industry in matters concerning intellectual property. It has close links with the CBI. Its members include many of the major innovative UK companies, which are represented at meetings of the governing Council and Committees of the Federation by their professional IP managers. Before the Federation takes a position on any issue, official consultation documents and other relevant papers are submitted to the members for debate and dialogue. An appropriate Committee and/or the Council, depending on the issue, then determines the position, taking account of comments.

The published views/opinions/submissions of the Federation are normally approved by consensus. In cases where there is a substantial majority view falling short of consensus, any significant disagreement will be indicated.

Fifth Floor, 63-66 Hatton Garden, London EC1N 8LE
Tel: 020 7242 3923 Fax: 020 7242 3924
admin@tmpdf.org.uk www.tmpdf.org.uk

enters into force for the required 8 ratifying or acceding states. Draft rule 1(2) implies that the UK intends to apply the agreement three months later than the day specified in the agreement!

7. **The appointed day in rule 1(2) should be the day when the agreement enters into force.** It might be observed that (i) this day is the first day of the fourth month after the deposit of the last of the 8 required instruments of ratification or accession, (ii) as noted in the consultation document, this is the day when the revised German law will enter into force (i.e., three months after sufficient states, as provided in the agreement, have ratified).
8. It is important that the German government, the EPO and the national patent offices should ensure, when the time comes, that the deposit of the eighth instrument is announced promptly, so that proprietors of European patents will be given adequate warning that they can stop making translations that will no longer be needed.

Matters beyond the mandatory requirements of the agreement

EPC Article 67 and UK section 78(7)

9. EPC Article 67 permits translations into English of claims in published EP applications in French or German to be required, if rights in the published application are to be secured. The London Agreement does not cover this article. However, draft UK rule 3 proposes that UK section 78(7), which implements the procedure allowed by EPC Article 67, shall cease to have effect on the appointed day. It is argued in the consultation document that there is no logical reason to separate this from the change as regards section 77(6).
10. This argument in favour of applying the same treatment to section 78(7) as to 77(6) is not correct, since (a) this treatment will mean that claims in a published application in French or German will not be translated into English to have effect, whereas the claims in the granted patent **will** be published in English, by the EPO (EPC rule 51); (b) the change in section 77(6) stems from the agreement, which ensures reciprocity and thus benefits UK companies, whereas this change would be unilateral and not of benefit.
11. **We consider that rule 3 should not be made.** It will only benefit those mainly non-UK firms that have filed European patents in French and German. It will be disadvantageous to UK firms that may be affected by such patents. The UK should not act unilaterally. If other countries agree to make similar changes, so that UK firms would derive some benefits elsewhere in Europe, then the matter can be reconsidered.

Article 2 of the Agreement

12. Article 2 provides in paragraph (a) that states may require that proprietors should supply translations at the request of alleged infringers. We provisionally accept the arguments in the consultation document that it is unnecessary to legislate on this, but consider that the issue should be kept under review as experience of the "no-translation" regime develops. We consider that translations should be supplied by the proprietor in court proceedings, and that this will be provided for by rules of court, as permitted in article 2(b) of the agreement. (Similarly for proceedings before the comptroller.)

Further point

13. There are fears that the agreement may never take effect, if France in particular has problems with ratification. It has been suggested that a similar agreement within a smaller group might be beneficial. Our view is that we should ratify and see how other countries react. If there is no progress, then negotiations among a smaller or different group could be initiated. In any event, the UK should **not** unilaterally introduce legislation in correspondence with the agreement.

The Consultation questions

Some questions are rather obscurely drafted (indicated below by underlining), partly perhaps because the issues of ratification and implementation, which are dealt with separately in the above discussion, have been conflated in the consultation document. Insofar as we understand the questions, our views are as follows:

Question 1: Please give your views on the proposed implementation with a delay in the force date of the London Agreement (See paragraphs 15 and 23)

Our answer: The implementing rules should be such that they enter into force on the day that the agreement enters into force (i.e., on the first day of the 4th month after the last of the required 8 states has deposited its instrument of ratification or accession). Furthermore, the UK should deposit its own instrument of ratification as soon as possible; it should not try to be last.

Question 2: Please give your views on the proposed rule under section 77(9) to appoint a day for section 77(6) to cease to have effect and to apply to all patents granted after the date concerned as in the Agreement (paragraph 23).

Our answer: We agree with the proposed rule 2, save that the "appointed day", defined in proposed rule 1(2), should be the day when the agreement enters into force, not three months later than that. The proposed rule 1(2) should be redrafted to provide that the appointed day is the day on which the agreement enters into force, i.e., the first day of the fourth month after the last of the required 8 states has deposited its instrument of ratification or accession. Furthermore, the new rules should apply to all patents granted **on or after** the appointed day. So the last day that section 77(6) applies is the day before that.

Question 3: Please give your views on what should be expected of parties in case of a dispute and how this should be reflected in with notice hearings before the Office and under the Court procedure rules. At what stage in a dispute should a translation be required? (Paragraphs 19, 21, 22)

Our answer: We see no reason at present to make rules requiring a patent proprietor to supply a translation directly to an alleged infringer. We would expect that common sense and good practice would lead the proprietor to provide a translation, of at least the relevant parts of the specification concerned, with any notice alleging infringement or suggesting negotiations.

However, we do consider that the Patents Rules and Rules of Court should ensure that any patent specification, not in English, that is submitted to the Patent Office or to the Court respectively by the proprietor in proceedings concerning that patent should be accompanied by a translation into English (or, at least, a translation should be supplied within a relatively short period). The action should be stayed until a reasonable period has elapsed after the translation has become available to the Office or Court respectively, and to the other party.

Question 4: Please give your views on what effect the non availability of a translation should have and whether, this is something that judges would already take account of, if so, would parties voluntarily send a translation to an alleged infringer, so that there is no need for specific provision to implement article 2(a) (paragraph 19)

Our answer: As indicated under question 3 above, the proprietor should supply a translation into English of any patent on which he bases proceedings before the Court or Comptroller. Except in such proceedings, we see no reason for judges to take any account of absent translations. (Note: as discussed in paragraphs 9 - 11 of our general comments above and under question 5 below, we do not think that the need for an English translation should be abolished in relation to section 78(7). Thus in our view, the question of how a judge should assess the effect of the lack of a translation of the published claims into English should not arise.)

As regards correspondence or discussions between the parties in advance of proceedings, we are convinced that proprietors will make clear to the opposite party what the relevant parts of the patent specification involved mean. We also consider that opposite parties will obtain their own translations in cases of doubt, e.g., where precise meanings of words are important. Even SMEs should not find it difficult to obtain translations of texts in French or German.

Question 5: Please give your views on the provisional protection in section 78(7) between publication and grant (Article 67 of the EPC) and the effect of this remaining as present, on filing of translation of claims where they are not in English, or whether provisional protection should be provided without English claims (paragraph 20).

Our answer: Article 67 EPC is not covered by the London Agreement. Thus any action by the UK to abolish the translation requirements that it permits would be unilateral.

We are opposed to any unilateral action by the UK regarding the abolition of translations. This would benefit mainly foreign firms, filing in French or German, to the disadvantage of UK firms affected by the foreign language applications, with no reciprocal advantages to UK firms in other EPC states. Until there is a multilateral agreement, translation requirements under section 78(7) for the claims of published applications should **not** be abolished.

We appreciate it is rare for the translations of claims in published applications as currently filed to be consulted. This may be because few such applications are litigated - indeed, we doubt that many translations of published claims are actually filed. However, for those who are sued for infringement back to the publication date, we consider that section 78(7), which ensures that translations of claims in published applications are available in English, as they are for granted patents, should remain in force. If other states are prepared to abolish their equivalent provisions, then the matter can be reconsidered.

Question 6: Please give your views on whether the Patent Office could, as a consequence of translations no longer being required, usefully provide any non-statutory service (paragraph 22).

Our answer: We do not see any need for the Patent Office to provide non-statutory services such as acting as a depository for voluntary translations, nor do we consider that this would or should serve any role in assisting patent proprietors to assert their rights.

Question 7: Please show how you rate the proposals relating to remove the requirement for translation of patents granted by the European Patent Office

Our answer:

Comment: The consultation document failed to separate the issue of when to ratify the London Agreement (i.e., when to deposit the UK's instrument of ratification) from the issue of how to legislate to meet the obligations under the Agreement. This led to confusion in the discussion of when the appropriate legislation should take effect.

The document also failed to analyse the issue of section 78(7) adequately (in the context of reciprocity) and failed to appreciate the need to link the operative date of new legislation with the day of the entry into force of the agreement.

TMPDF November 2004