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## Implications of the London Translation Agreement

### Introduction

1. TMPDF and its member companies have enthusiastically welcomed the London Translation Agreement (LTA), because it should reduce both the costs and the risks to patent applicants that translation requirements create, without imposing excessive burdens on possible infringers. Almost all member companies are sometimes applicants for patents and at other times potential infringers of the patents of competitors, so we speak with authority. This paper reviews some issues in relation to the implementation of the Agreement.

### Effect of the Agreement

2. It is our understanding that, in accordance with the LTA and the current list of states that have committed themselves to it, an applicant who has prosecuted a European patent application to grant in English and has provided the EPO with translations of the claims into French and German:

- (i) will have no more translation work to do at all to validate the European patent (EP) in France, Germany, Liechtenstein, Luxembourg, Monaco, Switzerland and the United Kingdom; and
- (ii) will have to translate only the claims into the local language for Croatia, Denmark, Iceland, Latvia, the Netherlands, Slovenia and Sweden.

3. An applicant who prosecuted the European patent application in French or German must also provide an English translation of the description in all the countries listed in paragraph 2(ii), except Latvia and Slovenia. However, such an applicant is likely in many cases to have prepared an English text for a US application, so this may not be an unduly heavy additional requirement.

4. ***The accession of Belgium<sup>1</sup> and Austria<sup>2</sup> to the LTA would be especially valuable***, because an applicant who wants to validate in these states must prepare a translation of the description into French (or Flemish), or German respectively if French or German is not the respective EPO language of grant, whereas such a translation will not be required by other states having French or German as an official language.

5. ***Spain and Italy are major countries whose accession would also be very helpful.***

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<sup>1</sup> We have recently been informed that accession is under active consideration by the Belgian legislature and trust that a positive outcome will be speedily achieved.

<sup>2</sup> We understand that there may be constitutional difficulties in Austria regarding accession, which we hope can be soon resolved.

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## Issues of implementation

6. The LTA (OJEPO, 12/2001, pages 549-553) leaves certain things unclear. It has been suggested by a French commentator, Jean-Christophe Galloux (see article in *Propriété Industrielle - Revue Mensuelle LexisNexis Jurisclasseur - Février 2007, pp 19-23: Londres, le brouillard et les gens sérieux*), that national administrations should fill the gaps when implementing the LTA. We consider that at least the following matters need to be satisfactorily resolved by the participating states as soon as possible:

### **Abolition of requirements for locally-approved or locally-resident agents**

7. The Federation has long been of the view that a European Patent Attorney should be able to "validate" an EP in any contracting state regardless of what translations are necessary. The effect of the LTA in the states listed in 2(i) above should be that no translations are required to be filed locally at all. Therefore, if any of these states insists on a locally-approved or locally-resident agent, it will, even more blatantly than in the past, be imposing on patentees unnecessary, indefensible and anti-*communautaire* costs.

### **Treatment of translation errors**

8. Several member states have implemented the option permitted under Article 70 (3) and (4) EPC. This provides that when a translation of the European patent into an official national language has been filed at the national industrial property office (as may be required under Article 65 EPC), then the translation will be considered as the authentic text where it confers narrower protection than that conferred in the EPO language of proceedings (see e.g., UK Patents Act 1977 section 80(4)). The patentee must be permitted to correct the translation, but may be required to concede user rights (without payment) to anyone who has made preparations to use the invention in a way that does not infringe the original translation. This is a serious disadvantage for the patentee, in that the error is most likely to be noticed exactly when there is such a user. A particularly painful case of such an error was Rhône-Poulenc Santé's European Patent (UK), [1996] RPC 125, where the error was not linguistic at all. A range of water concentration of 35 to 80% was narrowed to 35 to 50% in the English text, perhaps through a typing mistake.

9. The question now arises as to what is to be considered as the authentic text when translations of claims have been filed at the EPO under the grant procedure of Rule 71(3) EPC. Are states at liberty to consider the translated claims to be authentic text and impose the sanction permitted under Article 70 EPC? We consider that they are not - the authentic text should, in accordance with the EPC, be that in which the patent was granted. All the states mentioned in paragraph 2(i) above should clarify the position on this. We understand for example that the United Kingdom will treat the text in the language of grant as the authentic text of the patent.

10. This question also arises in modified form for the states listed in paragraph 2(ii) above - modified, because in these states something additional has to be filed locally, whereas in the 2(i) states all necessary translations are provided to the EPO. We consider that these states also should recognise the text in the EPO language of grant as the authentic text.

### **Impact of the LTA on protection after grant**

11. M. Galloux has argued that the European Convention on Human Rights applies and its effect is that there can be no infringement of an EP which has effect in France until the full text has been translated into French. Against this, it can be noted that provisional protection under Article 67 (3) EPC requires translation only of the claims in France, and this has been in effect since 1979 when the EPC came into force. Moreover, in the early days of the EPC, UK and Germany - both major states - did not require translations of the description into a local language as a condition of protection after grant. No human rights argument has so far been substantiated.

12. There are provisions in a number of laws (see e.g., UK Patents Act 1977 section 62(1)) that no damages can be recovered in an infringement action if the infringer can show that he was unaware, and had no reasonable grounds for supposing, that a patent existed.

However, it would be difficult to deny awareness of the existence of a patent brought to the infringer's attention when the claims are in his language.

**The EPO publication "National law relating to the EPC"**

13. This valuable work, now in its 13<sup>th</sup> edition (November 2006), needs to be updated as soon as possible to deal with the issues discussed above.

TMPDF June 2008

NOTE: TMPDF represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. This paper represents the views of the innovative and influential companies which are members of this well-established trade association; see list of members below.

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