

**Update:**  
**The Effect of the London Agreement in the United Kingdom**

Under the London Agreement, which comes into force on 1<sup>st</sup> May 2008, the United Kingdom dispenses with the requirement to file an English language translation of a French or German language European Patent specification as granted or amended. Consequently any European Patent having a grant date (European Patent Bulletin publication date) on or after **1<sup>st</sup> May 2008** will automatically take effect in the United Kingdom, irrespective of its language of publication, and no translation will be required.

**Amended European Patent specifications**

The United Kingdom has not implemented any statutory provision corresponding to Article 9 of the London Agreement.

This effectively removes the requirement to file an English language translation of an amended European Patent specification, even where the European Patent in question has a grant date prior to the date of the London Agreement. Therefore any amended European Patent specification published on or after **1<sup>st</sup> May 2008** will also automatically take effect in the United Kingdom, irrespective of its language of publication, and irrespective of the grant date of the original European Patent. No translation will be required. (Of course, translations of the amended claims of a European Patent will still be required prior to publication of the amended specification under the EPC.)

**European Patents having a date of grant or date of publication of the amended specification prior to 1<sup>st</sup> May 2008**

Some legal uncertainty has arisen as to the correct interpretation of section 77 of the United Kingdom Patents Act 1977 in respect of the translation requirement for European Patents having a date of grant or date of publication of the amended specification from 1<sup>st</sup> December 2007 to 30<sup>th</sup> April 2008.

In view of this legal uncertainty we recommend that the safest course is to file an English translation in respect of any European Patent having a grant date (or amended specification publication date) *prior to 1<sup>st</sup> May 2008*, and patent proprietors should not rely on the official guidance on translation requirements provided by the United Kingdom Intellectual Property Office in this respect.

## Validation of a European Patent in the United Kingdom

- Renewal fees

It follows that the only statutory requirement for a European Patent having a grant date on or after 1<sup>st</sup> May 2008 to take effect in the United Kingdom will be the payment of the annual renewal fee, starting from the fourth anniversary of the filing date.

- Address for service

The proprietor of a European Patent (UK) may file an address for service anywhere within the United Kingdom, the European Economic Area or the Channel Islands. In the event that no address for service is filed, any official renewal reminders will be sent to the address supplied for the purpose of renewals, or otherwise to the proprietor's address as recorded by the United Kingdom Intellectual Property Office, even where that address is outside the EEA.

It remains a statutory requirement that an address for service within the United Kingdom must be filed by any person who enters into any legal proceedings in respect of the European Patent (UK).

## Recovery of damages for infringement occurring prior to grant

It is worth noting that the existing regime relating to the recovery of damages for acts of infringement occurring prior to grant remains unchanged. Damages may be obtainable for infringement of a granted European Patent (UK) occurring between publication and grant, but only as long as the infringing act would also have infringed the claims as they stood immediately before the date of publication, and only as long as the European Patent application was published in the English language.

Applications published in French or German will not qualify for pre-grant damages unless an English language translation of the claims of the published application is filed at and published by the United Kingdom Intellectual Property Office.

### References:

United Kingdom Patents Act 1977 : Sections 69, 77, and 78

United Kingdom Patents Rules 2007 : Rules 56, 103, 104, and 108 (2)

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