

The London Agreement – Implementation in Germany

With entry into force of the London Agreement, the process of validating the German part of a European Patent will change. The below intends to answer the most frequently asked questions in this respect.

Effective date

The law for implementing the London Agreement entered into force on June 17, 2008. Its provisions however retroactively take effect May 1, 2008.

Translation requirements

For European patents for which the mention of grant is published on May 1, 2008, or thereafter, a translation of the specification is no longer required. Since the EP Patent is published with a German translation of the claims, a separate translation of the claims is not required. European patents designating Germany will then be immediately effective in Germany.

However, a translation is still required for all patents with the mention of grant published before May 1, 2008 that are maintained in amended form after opposition proceedings. The regulations that were effective at the date of the grant of the patent apply for the submission of the translation.

Are there any transitional provisions with respect to the London Agreement?

No.

Is a professional representative required?

No professional representative is required for effecting validation before the German Patent and Trademark Office (GPTO). This also holds true for the payment of fees.

Will a Power of Attorney be required?

A Power of Attorney is not required for the validation.

Is an address for service required?

No. If there is no address for service established, the GPTO will send communications to the proprietor (applicant/patentee) designated in the EP Patent or to his representative.

Third parties abroad will need to submit a power of attorney of the proprietor for establishing an address for service.

Are there any practical reasons for having an address for service in Germany?

Practical reasons for having an address for service in Germany encompass e.g. the timely and secure handling of annuity payments and/or receiving fee reminders or the timely reaction on nullity actions. Especially in view of nullity actions filed against the German part of a European Patent, it is recommended to have an address for service in Germany. The statutory period for filing a response to a nullity action is one month and with the absence of an address for service in Germany there is a substantial risk that the one month period for responding to a nullity action is missed.

Does the GPTO send renewal fee reminders / Notification of due annuities?

Yes. The GPTO sends a reminder that overdue annuities may be paid with surcharge, however, this reminder is a service of the GPTO and not required by law.

Will Notifications on missed annuity payments be mailed also to foreign addressees?

Yes. However, if the mail returns undeliverable (e.g. due to address changes

not notified to the GPTO), no further action is taken by the GPTO, resulting in a loss of rights.

Will the Patent Office issue a confirmation of a performed validation?

Yes. A notification of the Official File Number will be sent to the representative registered for the EP-phase. If no

representative is registered, the notification will be sent to the proprietor.

Will the German part of the EP-patent be published separately by the GPTO?

No. Granted EP Patents take immediate effect in Germany.

The above does not replace the taking of legal advice in order to meet the new requirements. The attached table summarizes the translation requirements of the EPC contracting states as of January 2009.

Status: February 5, 2009

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London Agreement: Status of accession and ratification, language requirements

The London Agreement entered into force on May 1st, 2008.

EPC Contracting State		Signature	Instrument	Deposited	Specification	Claims
Austria	AT				DE	DE
Belgium	BE				DE ¹ , FR or NL	dito
Bulgaria	BG				BG	BG
Croatia #	HR	-----	accession	31.10.2007	EN	HR
Cyprus	CY				GR	GR
Czech Republic	CZ				CZ	CZ
Denmark	DK	17.10.2000	ratification	18.01.2008	EN or DK	DK
Estonia	EE				EE	EE
Finland	FI				FI	FI
France	FR	29.06.2001	ratification	29.01.2008	-	-
Germany *	DE	17.10.2000	ratification	19.02.2004	-	-
Greece	GR				GR	GR
Hungary	HU				HU	HU
Iceland	IS	-----	accession	31.08.2004	EN or IS	IS
Ireland	IE				EN	EN
Italy	IT				IT	IT
Latvia	LV	-----	accession	05.04.2005	-	LV
Liechtenstein	LI	17.10.2000	ratification	23.11.2006	-	-
Lithuania	LT				LT	LT
Luxembourg	LU	20.03.2001	ratification	18.9.2007	-	-
Macedonia ^l	MK				MK	MK
Malta	MT				EN or MT	EN or MT
Monaco	MC	17.10.2000	ratification	12.11.2003	-	-
Netherlands	NL	17.10.2000	ratification	04.10.2006	EN or NL	NL
Norway #	NO				NO	NO
Poland	PL				PL	PL
Portugal	PT				PT	PT
Romania	RO				RO	RO
Slovak Republic	SK				SK	SK
Slovenia	SI	-----	accession	18.09.2002	-	SI
Spain	ES				ES	ES
Sweden	SE	17.10.2000	ratification	29.04.2008	SE	SE
Switzerland	CH	17.10.2000	ratification	12.06.2006	-	-
Turkey	TR				TR	TR
United Kingdom	GB	17.10.2000	ratification	15.8.2005	-	-

- : no translation required (any of the official languages of the EPO accepted)

¹: Translation into DE, FR or NL, for DE, however see OJ 1999, 320. According to an official information from the Belgian Patent Office EP Patents filed in German will be accepted, see http://economie.fgov.be/intellectual_property/patents/pdf/Utilisation_de_la_langue_allemande.pdf

* European patents designating Germany will be immediately effective in Germany.

¹ Former Yugoslav Republic of Macedonia: New member since 1st of January 2009: No European patents for the former Yugoslav Republic of Macedonia can be granted on the basis of international applications with a filing date prior to 1st January 2009. The designation of the former Yugoslav Republic of Macedonia at the time an international application with a filing date prior to 1 January 2009 enters the European phase 2 is legally invalid. The extension agreement between the former Yugoslav Republic of Macedonia and the European Patent Organisation will terminate on 1 January 2009. It will therefore no longer be possible to extend European patent applications and patents to the former Yugoslav Republic of Macedonia. The extension system will, however, continue to apply to all European and international applications filed prior to 1 January 2009, as well as to all European patents granted in respect of such applications.

New member states from 1st January 2008: European patent applications filed on or after 1 January 2008 will include the designation of the new contracting state.

Norway and Croatia: No European patents for these countries can be granted on the basis of international applications with a filing date prior to 1 January 2008. It will not be possible to designate these countries retroactively in applications filed before that date. The designation of these countries at the time an international application with a filing date prior to 1 January 2008 enters the European phase is legally invalid.

Croatia: The extension agreement between the Republic of Croatia and the European Patent Organization will terminate with the entry into force of the EPC in Croatia on 1 January 2008. It will thereafter no longer be possible to extend European Patent applications and patents to Croatia. The extension system will, however, continue to apply to all European and international applications filed prior to 1 January 2008, as well as to all European patents granted in respect of such applications.

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