

## **Client Information February 2008**

### **The London Agreement – Finally, a Happy Ending**

Decided in the year 2000, then blocked by France for seven years – that was, until just a few days ago, the story of the London Agreement, which is intended to reduce the translation costs for European patents.

Now, finally, France deposited the instrument of ratification of the Agreement with the Federal Foreign Office in Berlin, and the London Agreement will enter into force on

**1 May 2008.**

The effects of the Agreement will be to the benefit of all European patents for which the mention of the grant will be published after the effective date of the Agreement.

We have compiled some important information about the London Agreement below:

#### **(1) Summary of the contents of the London Agreement**

The London Agreement provides that the Contracting States to a large extent waive the requirement for a translation of a European patent into their respective national language. An important aspect is that accession to the London Agreement is voluntary. Nothing will change about the translation requirement for the member states of the European Patent Convention that do not accede (which currently is the majority).

For those Contracting States that do accede to the London Agreement, a distinction is made between two groups of States:

- (i) Those Contracting States whose national language is one of the official languages of the European Patent Office will dispense with a translation entirely. Currently, these are Germany, Great Britain, France, Switzerland/Liechtenstein, and Luxembourg.

- (ii) The other Contracting States may at most require a translation of the description into an official language of the European Patent Office and a translation of the claims into their national language. Such a translation is currently required by the Netherlands, Sweden, and Denmark. Some other Contracting States (Latvia and Slovenia) require no translation at all.

There is no change to the requirement to file, upon grant of the patent, a translation of the claims into the two official languages other than the language of the application.

## **(2) Reduction in the Volume of Translations in Practice**

We have attached an overview of those member states of the European Patent Convention which were the most frequently designated states in the year 2000 (in descending order). Printed in bold type are those states that are also Contracting States of the London Agreement.

It can be seen that it is not possible to make a sweeping statement about the reduction in the requirement for translations. Rather, it depends on the EPC member states specifically designated in a particular patent whether translation costs will be reduced at all.

Example: As a Contracting State, France requires no translation at all. But, if Belgium has been designated, it is still necessary to prepare a French translation of the description.

## **(3) Possible Changes for Practical Orientation**

We have outlined a few possible changes to filing strategies below which may be derived from the London Agreement.

### **(a) Filing an application in English**

If the Netherlands, Sweden and/or Denmark are usually designated in a European patent application, but Austria is not, the application could be filed in the English language in future (rather than in the German language). In many cases, an English version of the application documents is available anyway for counterpart applications in, e.g., the USA. If the EP application is filed in English right from the start, a separate translation for the Netherlands, Sweden and/or Denmark which would otherwise have to be prepared after grant becomes unnecessary. However,

these countries continue to require translations of the claims into the respective national language, to be published along with the English-language description.

(b) Checking the designated states

With a view to the requirement for translations ceasing to exist in some states, it should be checked whether it would be of advantage to designate these states more frequently. In an optimum case, protection by patent in a further Contracting State may be obtained by payment of only the designation fee. Of course, annuities will also become due for these States, which increase disproportionately as the term of the patent progresses.

(c) Several national patent applications vs. one single European patent application

The rule of thumb applicable up to now was that three national patent applications give rise to roughly the same costs as one single European patent application. With the requirement for translations no longer existing in some states, the limit as from which a European patent application is profitable, as compared with several national applications, will shift further in favour of the EP application.

**(4) Summary**

European patent applications will, in principle, become more attractive since the costs of translations of the patent specification into different languages will become lower upon the London Agreement entering into force. But the extent to which the translation costs decrease depends on the states that are specifically designated in a European patent and in which the patent is validated later. It should be checked whether in future it may be of advantage to designate other Contracting States or to select a different language for a particular application.

At all events, it is advisable to obtain client-specific advice on the advantages and disadvantages involved.

**Overview of the translation requirements after the effective date of the  
London Agreement**

for the 15 Contracting States of the European Patent Convention which were designated most frequently in the year 2000 (in descending order)

Contracting State	Translation of the description	Translation of the claims
<b>Germany</b>	No	No
<b>Great Britain</b>	No	No
<b>France</b>	No	No
Italy	National language	National language
<b>Netherlands</b>	English	National language
Spain	National language	National language
<b>Sweden</b>	English	National language
Belgium	National language	National language
<b>Switzerland/Liechtenstein</b>	No	No
Austria	National language	National language
<b>Denmark</b>	English	National language
Portugal	National language	National language
Greece	National language	National language
<b>Luxembourg</b>	No	No
Ireland	National language	National language

Member states of the London Agreement printed in bold type

# PRINZ & PARTNER GbR

Patentanwälte • European Patent and Trademark Attorneys

Our “client information” newsletters appear in no particular order and deal with issues that may be of interest to our clients. They are intended for general information and do not contain any legal advice or technical information. We do, therefore, not assume any liability for the consequences of any actions taken on the basis of general information given here.

Should you consider it appropriate to take action based on our information, we recommend that you contact us for a detailed legal consultation in which all circumstances of a particular case can be taken into account.

Any questions you may have in connection with the topic of this newsletter will be gladly answered by Jochen Sties (j.sties@prinz.eu).

© Prinz & Partner 2008

Prinz & Partner GbR  
D-80335 München  
Tel: + 49 (0) 89 / 59 98 87-0  
Fax: + 49 (0) 89 / 59 98 87-211  
[www.prinz.eu](http://www.prinz.eu)

Egon Prinz Dipl.-Ing. (1928 - 1997) • Hartmut Degwert Dipl.-Phys.  
Dr. Werner Sulzbach Dipl.-Chem. • Thomas Kitzhofer Dipl.-Ing. • Jochen Sties Dipl.-Ing., LL.M.  
Jürgen Strass Dipl.-Phys. • Dr. Bernhard Fuchs Dipl.-Ing. • Hannah Hildebrandt Rechtsanwältin, LL.M.