October 27th 2016

New Guidelines for Examination: Assignment Requirements at the EPO

The EPO Guidelines for Examination\(^1\) provide clarity as to how the European Patent Office (EPO) applies the Articles and Rules of the European Patent Convention (EPC). The Guidelines provide guidance on matters ranging from the formality aspects of prosecution, the substantive issues of novelty and inventive step and the operation of the Patent Office itself. With changes in practice, the EPO updates its Guidelines for Examination and the latest revision to the Guidelines comes into effect on November 1, 2016.

One change which represents a significant departure from existing practice is what the EPO will accept as evidence of a transfer of ownership. Art. 72 EPC\(^2\) and Rule 22 EPC\(^3\) govern the formal requirements of such transfers. While Art 72 EPC is clear that:

> An assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract,


to date, the practice of the European Patent Office has been to accept as evidence of a transfer, a document that is only signed by the Assignor. However, the new Guidelines now require the signatures of both parties- the assignor(s) and the assignee(s) - i.e. strict compliance with the wording of Art 72 EPC.

This change will only affect what the EPO accepts as evidence of transfer and does not affect what constitutes the legal transfer as that is determined by the national law in the country where the assignment is executed. Thus, for derivation of rights purposes- i.e. demonstrating to the EPO on filing an application, how the Applicant entity has derived the right to the invention claimed in that application, the EPO will continue to accept a date of agreement of, or by virtue of employment statement without having to provide the underlying documentary evidence.

Going forward, however, the new approach means that if there is a need to change the recorded ownership on the EPO Register, it will be necessary to provide documentation signed by both parties. This applies to both pending applications and assignments recorded during opposition proceedings. The payment of the official fee, currently €100 per entry in the EPO Patent Register, continues to apply. It is important therefore that any assignment documents prepared for the transfer of EP patent rights include the signature(s) of the Assignors(s) as well as the signature(s) of the Assignees(s). In addition, to avoid potential problems with the recordal of an assignment at the EPO, we recommend providing the printed names and capacity as signatory for both parties in the transfer document.

Please do not hesitate to contact us at Hanna Moore + Curley with any query on this or any other European Patent law or practice matter. We also invite you to view our website at: www.hmc-ip.com

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