

New guidelines for assignment recordal at the EPO

Welcome clarification or just more red tape?

On 1 November 2016 new guidelines for examination will come into force at the European Patent Office (EPO). Key among the changes to the guidelines are revisions to the EPO's approach to assignment recordal of European patent (EP) applications.

What are the changes?

The EPO's revised [guidelines](#) make two principal changes to current EPO practice, to require that:

- the "signatures of the parties (i.e. assignor and assignee) appear on the documents submitted as evidence of the transfer"; and
- a signatory, if signing on behalf of a corporate owner, must give their precise job title (i.e. "authorised representative" or "authorised signatory" is not sufficient).

Practical tips – how to meet the new requirements

If you are assigning a [pending EP application](#), e.g. between two companies, or between one or more original inventor applicants and a corporate applicant, ensure that:

- [all](#) parties sign the assignment; and
- the individual signatories' names and job titles are clearly set out.

It is not clear that the EPO guidelines create any requirement for a signatory to be a senior employee. However, whoever signs the assignment should be able to demonstrate their authority to sign if requested by the EPO. For company secretaries and directors they may be able to demonstrate their authority to bind the company through

filings from a relevant company registry. For other signatories, particularly those who hold roles which are not "obviously senior", and who are authorised to and routinely do execute assignments on the company's behalf, an alternative form of evidence may be requested by the EPO, acceptable documentation is likely to include: a copy of a company board minute or a power of attorney conferring authority to sign in favour of those individuals. We would recommend that you put such documentation in place in advance of executing new assignments so that you are well placed to meet any later challenge or query from the EPO.

What patents and patent applications will this change affect?

The EPO guidance described above will only affect assignments of pending EP applications. Assignments of national patents (or rights in them) are not affected.

Even if there is a connection between a pending EP and a national patent or application, the assignment of the national right will continue to be governed by the relevant national law. For example the assignment of a US priority application completed before the filing of any related EP application would not be covered by the new guidelines (existing US law requirements would continue to apply).

What is the underlying legal position?

The formal requirements for a valid assignment of a pending EP application are set out in Article 72 of the European Patent Convention (EPC):

"An assignment of a European patent application shall be made in writing and

shall require the signature of the parties to the contract."

The current change to the guidelines for examination is not a change to the EPC. Instead, it is solely a change in the EPO's policy.

Historically, the EPO's approach to recording assignments was that they required evidence that both parties agreed to the transfer. An acceptable approach was for the assignor to have signed the assignment document and the assignee (or their attorneys) to have requested the recordal of that assignment.

Some have described the EPO's old procedure as "pragmatic". However, it created a tension between the formal requirements for a valid assignment under EPC Art. 72 and the EPO's approach to recording assignments.

This change to the EPO's guidelines for recordal should ensure greater consistency between law and policy and is, therefore, something to welcome.

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Need advice?

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