



CHANGE

Need to record a change?

Many patents will see a change in ownership at some time in their lives, or might be licensed for use by a third party. Companies also regularly change their names and premises. To ensure these changes are effective, many European countries require them to be formally registered at the local Patent Office. In cases where registration is not essential, there are often advantages in doing so.

Patents are territorial rights, and so separate registration is usually required in each country in which the transaction has effect. One notable exception to this is European patents that have not yet been granted (or not yet reached the end of the opposition period) - for those changes can be registered centrally at the European Patent Office. After grant however, (or after the final conclusion of any opposition proceedings), all changes must be registered separately at the various local Offices.

The formal requirements for registration differ between Patent Offices, and also differ depending on the type of change that is being recorded. An overview of the requirements for recording various types of changes is provided below.

Assignments

An assignment transfers the ownership of a patent or application from one legal entity to another. Typically Patent Offices require payment of a fee before they will record an assignment. They also usually require documentary evidence proving the assignment took place.

The current requirements for registering an assignment in each of the various countries in Europe are included in the table attached to this handout. Some of these requirements differ significantly from US practice, and so before executing an assignment document it is worth considering the following:

- Who will sign the document? In many European countries an assignment agreement must be signed by all the parties to the agreement, i.e. the assignor and any assignees.
- Does the document refer only to the US application, or does it refer to the European counterparts too? Some countries will expect an explicit reference to (at least) foreign applications claiming priority from the US case before they will record the assignment, and may require a document which refers to the patent/application in that country by number.
- How many originals should you have made? Some, but not all, European countries require us to submit an original document as evidence of the assignment. These may need to be notarized and/or legalized as well. It can therefore often be useful to execute multiple identical copies of the same assignment if it is to be recorded in a large number of countries, to avoid the need to re-execute confirmatory assignments at a later time.

- What does the document say? Documents submitted as evidence of a transaction will usually be made publically available by the Patent Office - you should therefore consider whether they include any commercially sensitive material that should be redacted before filing.
- Finally, some European countries (such as the UK) request that an assignment should be registered within six months of the date of the assignment agreement. Doing this is not essential, but failure to do so can mean that the assignee can lose their right to recover costs and expenses in any successful infringement proceedings.

Licences

A licence grants another party permission to do something that would otherwise be an infringement of a patent, but does not change the overall ownership of the patent.

Typically the requirements for recording licenses are the same as, or more lenient than, the requirements for recording an assignment, and so similar considerations to those highlighted above should be borne in mind before executing a license agreement.

As is the case for assignments, most countries (such as the UK) stipulate that licences should be registered within six months of the date of the licence to protect the right of the licensee to recover their costs and expenses in any successful infringement proceedings.

As a licensee, it can be particularly important to ensure your license is registered, as doing so ensures that any person who subsequently acquires rights in the patent (e.g. by way of a subsequent licence or assignment) is prevented from denying knowledge of your earlier licence. This means that you, as the earlier licensee, can continue to exercise your rights even if a later licence is granted.

Change of name or address

Most Patent Offices will record a change of name or address on request, and many offices do not charge an official fee for this. For changes of name documentary evidence is usually required (e.g. a copy of a certificate of change of name). Typically, no supporting evidence is required for a change of address, though a UK Companies House extract or company website extract can sometimes speed up the process.

In general, there is no legal consequence if a change of name or address is not registered immediately. However, in many countries, patent rights are often only enforceable once the owner details are correct in the register. Registering a change also helps to eliminate the risk of not receiving communications from the Patent Office.

Errors

If a patent or application is in the wrong name due to an error, then recording an assignment or requesting a change of name may not be appropriate, or even possible.

Most European Patent Offices (including the EPO) will correct errors in the patent register (such as applicant names) on request, if those errors are obvious.

If the error is not obvious - for instance, if the patent application was filed in the name of one legal entity, but it should have been filed in the name of a completely different legal entity, then supporting evidence is likely to be required that explains how and why the error occurred. The evidence that is required is likely to vary depending on the circumstances of the case.

One advantage of correcting an error, rather than requesting a change, is that if the error correction is granted then the error will be deemed to not have occurred. That is, errors can be corrected retrospectively, whereas changes are only recorded as of the date that the request for a change is filed.

If you need to record a change of any sort, or if you are unsure which course of action is appropriate for you, please contact your normal Barker Brettell attorney.

Country	Who must sign?		POA required?	Type of assignment document required	Translations of documents in English required?
	Assignor	Assignee			
EPO	x	x	No	Simple copy	No
Albania	x	x	Yes	Notarized document	Yes
Austria	x	x	Yes	Original (+ see special notes)	No
Belgium	x	x	Yes (both parties)	Simple copy	Yes
Bosnia	x	x	Yes	Original	Yes
Bulgaria	x	x	Yes	Simple copy	Yes
Croatia	x	x	Yes	Notarized document	Yes
Cyprus	x	x	Yes	Original	Yes
Czech Republic	x	x	Yes	Original/certified	No
Denmark*	x		No	Simple copy	No
Estonia	x		Yes (original)	Simple copy	No
Finland	x		Yes	Simple copy	No
France*	x		No	Simple copy	Yes
Germany	x	x	No	Simple copy	No
Greece	x	x	Yes	Original, notarized + apostilled	Yes
Hungary	x	x	Yes	Original	No
Iceland	x		Yes	Original/notarized	No
Ireland	x		No	Simple copy	No
Italy*	x	x	Yes (original)	Original (+ see special notes)	Yes
Kosovo	x	x	Yes	Notarized document	Yes
Latvia*	x	x	No	Simple copy	Yes
Lithuania	x	x	Yes	Original	No
Luxembourg	x	x	No	Simple copy	No
Macedonia	x	x	Yes	Notarized document	Yes
Malta	x	x	Yes	Original	No
Montenegro	x	x	Yes	Original	Yes
Netherlands	x	x	Yes (both, original)	Original/certified	No
Norway	x		Yes	No need to supply document	N/A
Poland	x	x	Yes	Scanned copy of certified copy	Yes
Romania	x	x	Yes	Notarized document	No
Russia	x	x	Yes (both parties)	Original/apostilled	Yes
Serbia	x	x	Yes	Original	Yes
Slovakia	x	x	Yes	Original	No
Slovenia	x	x	Yes	Original	No
Spain*	x	x	Yes	Original (see special notes)	Yes
Sweden*	x		Yes (original)	Certified copy (see special notes)	No
Switzerland	x		Yes	Simple copy	No
Turkey	x	x	Yes (original)	Original, notarized + apostilled	Yes
United Kingdom	x		No	Simple copy	No

* See special notes (on next page)

Special Notes

Austria

- 1) Original versions of assignment documents needed, signature of the assignor must be legalised by a notary public and further legalised by the apostille.

Denmark

- 1) Both signatures recommended but not necessary.
- 2) POA only needed if want to change appointed representative.

France

- 1) According to the French Law, the assignment must be signed by both parties, Assignor and Assignee as well; however, if the assignment can be regarded as relating to a foreign Law, the signature of the Assignor alone can be considered as sufficient, it is a question of International Civil Law rules.

Italy

There are two options for recording an assignment:

- 1) Deed of assignment/purchase agreements – in original, both signatures notarized and legalised up to the Italian Consulate or by Apostille.
- 2) Declaration to have assigned – in original, sign by both parties, no notarization/legalisation required.

Both options require a monetary consideration to be indicated for the purpose of fiscal registration of the deed (+ pay tax).

Latvia

- 1) Only assignor signature needed for a declaratory.

Spain

There are two options for recording an assignment:

- 1) Notarized and apostilled copy of the Deed of Assignment (+ translation).
- 2) Assignment Document/Assignment Certificate (Spanish patent office standard forms), originals required.

Sweden

- 1) Assignment document can be certified by a Swedish attorney.