

## 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 change their names and premises regularly. 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 below. 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 publicly 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 European Patent Office (EPO)) will correct errors in the patent register (such as applicant names) on request if those errors are obvious.

This paper is intended as a guide only and should not be used as a substitute for legal advice. © 2024 – 2025 Barker Brettell LLP

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.

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

This paper is intended as a guide only and should not be used as a substitute for legal advice. © 2024 – 2025 Barker Brettell LLP

## Special notes

### Austria

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

### Denmark

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

### Finland

- Assignment document can be certified by a Finish attorney

### France

- 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

### Germany

- Both the deed of assignment (Übertragungserklärung, signed by the assignor) and the declaration of acceptance (Annahmeerklärung) can be signed by an attorney at law or patent attorney on behalf of the assignor and/or the assignee, in which case power of attorney signed by assignee is required

### Italy

There are two options for recording an assignment:

- Deed of assignment/purchase agreements – in original, both signatures notarized and legalised up to the Italian Consulate or by Apostille
- 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

- Only assignor signature needed for a declaratory

### Spain

There are two options for recording an assignment:

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

This paper is intended as a guide only and should not be used as a substitute for legal advice. © 2024 – 2025 Barker Brettell LLP

## Sweden

- Assignment document can be certified by a Swedish attorney

## What next?

If you would like more information, then please get in touch. You can email us [info@barkerbrettell.co.uk](mailto:info@barkerbrettell.co.uk) or call us on **+44 (0)121 456 0000**.

This paper is intended as a guide only and should not be used as a substitute for legal advice. © 2024 – 2025 Barker Brettell LLP