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Briefing

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Changes in EPO Fees

A pair of Decisions of the Administrative Council of the EPO passed in December 2007 and October 2008 made a number of important changes to the fees payable in respect of European patent applications. These changes come into effect from 1 April 2009.

Some changes have been made by the EPO in an attempt to discourage applicants from filing applications having a large number of pages and/or claims. Currently, an “additional page fee” of €12 for each page of the application in excess of 35 is due when an application is granted. For applications filed from 1 April 2009, those additional page fees will instead be due when the application is filed. For an application having 100 pages, for example, that represents an increase of €780 in the official fees due on filing. For applications where the excess page fees are paid on entry to the European phase, a flat fee for grant will be payable regardless of the number of pages making up the application.

Further, the excess claims fees for claims in excess of 50 is increasing from €200 to €500 per claim. (The excess claims fees for claims 16 to 50 remain at €200 per claim.) For an application with 65 claims, that represents an increase of 4,500 Euros.

Another change is to simplify the system for the designation of contracting states. Under the current system a fee of €85 is due for each designated contracting state, with a payment of seven times the fee for a single state (i.e. €595) being sufficient to designate all states. For applications filed from 1 April 2009 this will be replaced in all cases by a single flat fee of €500 for the designation of contracting states. This has the effect that applications filed from 1 April 2009 will be granted in all available contracting states, unless for some reason a designation is explicitly withdrawn during prosecution (for example to avoid revocation of a corresponding national patent). It will, of course, remain necessary to carry out any validation formalities required by the national Patent Offices.

The above changes apply to applications filed from 1 April 2009, which the EPO takes to mean direct European applications filed from that date, divisional applications lodged at the EPO from that date (regardless of the filing date of the parent application), and PCT

applications entering the European phase from that date (regardless of the filing date of the PCT application itself).

The final change is to the period under which renewal fees can be paid in advance, which has been made to prevent applicants paying renewal fees excessively early in order to avoid future fee increases. Currently, renewal fees can be paid up to one year in advance. From 1 April 2009, it will only be possible to pay renewal fees up to three months in advance. This change applies to all European applications regardless of when they were filed.

Macedonia joins the EPC

The European Patent Convention entered into force for the former Yugoslav Republic of Macedonia on 1 January 2009. Macedonia can be designated in a European patent application having a filing date on or after 1 January 2009 and, in an International (PCT) application, will be included in the list of states for which a European patent is sought. It is not possible to designate Macedonia retroactively in applications having a filing date before 1 January 2009. However, the “extension state” system will continue to apply for Macedonia for European applications having a filing date prior to 1 January 2009.

The accession of the former Yugoslav Republic of Macedonia to the EPC brings the number of Contracting States to thirty-five.

The EPO and Montenegro sign an extension agreement

The EPO and Montenegro have signed an agreement under which it will be possible to extend the effect of a European patent to Montenegro. The date of entry into force is not set yet, but is expected to be fixed later this year.

There are currently three “extension states” – Albania, Bosnia and Herzegovina, and Serbia, in addition to the 35 EPC member states.

Changes to UK Trade Mark Rules

New Rules governing the administration of UK trade mark prosecution and inter partes proceedings came into effect on 1 October 2008.

The main amendments include the following:-

- A reduction in the opposition period to two months from the previous three months. It is possible to extend that initial two month period by one further month but the identity of the potential opponent must be given in the extension request. Despite the change in examination practice on relative grounds in 2007 which now allows all inherently registrable marks to be accepted for publication irrespective of the existence of earlier conflicting rights, fewer than 10% of published UK Applications are opposed. Unopposed UK Applications can therefore be expected to achieve registration in approximately four or five months from filing.
- The period for filing a counterstatement in all contentious proceedings has been set at two months (previously three months or six weeks depending on the type of proceedings). The UK IPO will also now have discretion to consider counterstatements filed out of time.
- Reduction of the “cooling off” period in oppositions, designed to facilitate negotiations leading to an amicable settlement, from twelve months to nine months. However, it will be possible to extend that period to eighteen months.
- The new Rules provide trade mark applicants and proprietors with the right to a retrospective extension of time to complete an action before the UK IPO, provided it is sought within two months of the end of the expired period.
- The introduction of a power to set aside decisions. Under the old regime, there was no entitlement to contest a decision to refuse or cancel a mark where a proprietor could show that it had been unaware of the opposition

or application for cancellation. The UK IPO will now allow a six month period for reinstatement.

- The procedure for verifying priority claims will be similar to that adopted by OHIM, i.e. where the UK IPO can verify a priority claim by consulting the website of the IP Office responsible for the priority application, it will no longer call for certified documentation to substantiate priority.

Community Trade Marks - Proposed reduction in official fees

OHIM has published details of proposals to reduce the official fees for CTMs. The proposals would see the registration fee heavily reduced so that the combined total amount of application and registration fees for electronically filed Applications would be around €1000, i.e. some 40% lower than the current total of €1600. It is currently expected that the reductions will come into force in Summer 2009.

If you have any questions regarding any of the above changes, or any other aspects of European and UK patent, design or trade mark law, please do not hesitate to get in touch with your usual contact at Abel & Imray or email us at ai@patentable.co.uk, with “A&I Briefing” in the subject line.

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