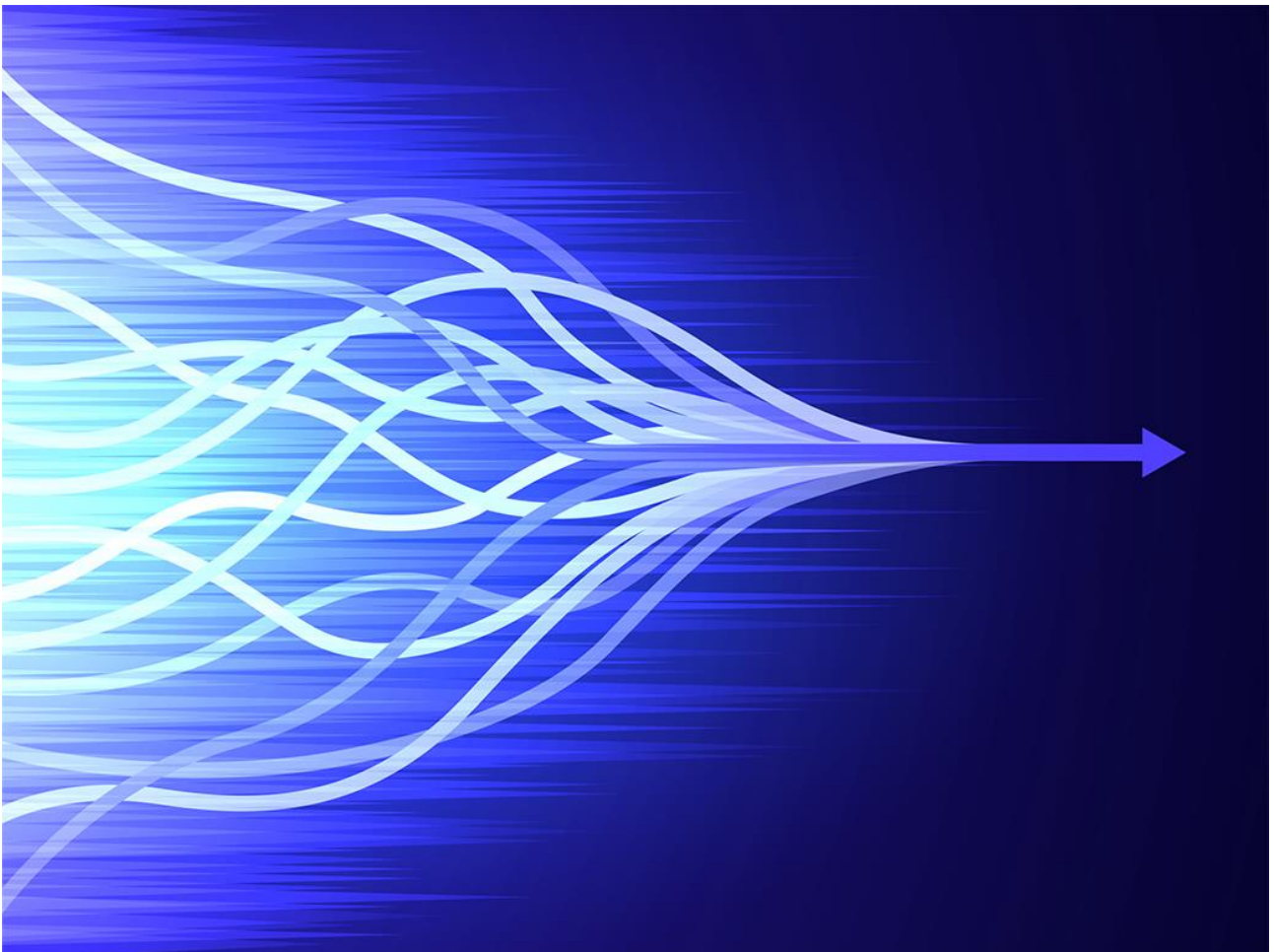


Convergence of practice

Common practice as regards assignments

March 2025



Common practice as regards assignments

Considering that assignments of patent applications/patents allow for the transfer of legal ownership of patent applications/patents from one or more assignors to one or more assignees;

Considering that the registration of assignments of patent applications/patents with patent offices is necessary in some EPC contracting states to enable the applicant/proprietor to act before the patent office and against third party infringers, and in some EPC contracting states it is of importance for determining the ownership of patent applications/patents;

Considering that the introduction of electronic filing methods to submit requests for the registration of assignments of patent applications/patents introduces flexibility for users, benefits the environment and helps the patent system keep pace with the digital world;

Considering that practices concerning the registration of assignments of a patent application/patent at patent offices are of great importance because variations in how assignments are registered and differences in the formalities and evidence required can have costly effects upon users seeking to register the assignment of patents/patent applications in multiple jurisdictions;

Having regard to the opinion of the Committee on Patent Law;

The Administrative Council of the European Patent Organisation at its meeting on 20 March 2025 approved the following common practice as regards practices concerning assignment:

Provision of an (electronic) request form for the registration of an assignment

- Offices are to provide an (electronic) request form for the registration of an assignment of a patent application and patent.

Electronic filing of requests for the registration of an assignment

- Offices are to provide for electronic filing for the submission of a request for the registration of an assignment of patent applications and patents, including supporting evidence.

Electronic signatures on requests for registration of an assignment

- Offices are to provide that requests for the registration of an assignment of patent applications and patents can be signed using an electronic signature of a kind accepted under national law. This does not cover the signing of any documents filed as supporting evidence.

Fee reductions for the submission of requests for registration of an assignment depending on the filing method

- Offices are to provide a fee reduction for requests for the registration of an assignment of patent applications and patents, when users file these requests electronically.

Procedure for rectifying deficiencies and correcting errors in pending requests

- Offices are to adopt a process for the rectifying of deficiencies and the correction of errors in a pending request for registering an assignment of patent applications and patents, before it is entered in the register.

1. Introduction

The convergence of practice programme is a cornerstone of the EPO's Strategic Plan 2028. On the basis of this programme and with the involvement of user associations, the EPO and the national offices strive to find common ground in areas where diverging administrative practices exist. After the completion of the first convergence cycle, the Administrative Council approved the continuation of the convergence of practice programme and the launch of six new topics for a second cycle (CA/73/22 Rev. 1). The second pair of topics was rolled out in 2024/2025 namely "Observations by third parties" and "Practices concerning assignment".

Pursuant to the working method established by the Committee on Patent Law (CA/PL 14/19), Working Group 10 on "Practices concerning assignment" was set up. A call for interest was launched in December 2023, whereupon 25 EPC contracting states, 1 extension state, and 2 validation states indicated their interest in participating in the discussions of Working Group 10. BUSINESSEUROPE, epi and WIPO each nominated one representative as an observer in the discussions of the Working Group.

The composition of the Working Group was as follows: Austria, Belgium, Bosnia and Herzegovina, Croatia, Cyprus, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Italy, Latvia, Lithuania, Moldova, Monaco, Morocco, Netherlands, North Macedonia, Norway, Poland, San Marino, Serbia, Slovakia, Spain, United Kingdom as well as the EPO and BUSINESSEUROPE, epi and WIPO.

In February 2024, the chairperson of the Working Group (a representative of the EPO) issued a detailed questionnaire to identify the practices concerning assignment and to determine any differences and similarities among these practices. The answers from the participants were compiled in a summary document which served as a basis for the discussions within the Working Group.

The Working Group held four virtual meetings (18 April 2024, 24 May 2024, 4 July 2024, 26 September 2024). Based on the discussions in these meetings and considering the results of the questionnaire, the Working Group identified five areas where a convergence of practice was considered to particularly benefit both users and patent offices.

In parallel to the discussions in the Working Group and in accordance with the methodology agreed by the Committee on Patent Law (see CA/PL 14/19, point 21), users were consulted and updated on the progress of the work via the SACEPO Working Party on Rules on 11 April 2024 and 24 October 2024. In order to further broaden the scope of the consultation process, on 21 October 2024 the EPO organised the fifth virtual platform on convergence of practice and informed users and offices of the results achieved within Working Groups 9 and 10 until then.

At its fourth meeting on 26 September 2024, the Working Group agreed upon a draft common practice as regards practices concerning assignment (see Annex 1). The Working Group also agreed upon explanatory remarks to the five different areas contained in this draft common practice which are reflected below.

2. Explanatory remarks

2.1 Provision of an (electronic) request form for the registration of an assignment

Almost all Offices confirmed that in their jurisdiction a form is provided which can be used to request the registration of an assignment of patent applications/patents. However, the replies to the questionnaire also showed that a few Offices do not provide for such a form for their users to rely upon. As set out in the preamble to the draft common practice, the Working Group recognises that proper registration of assignments of patent applications/patents in some EPC contracting states is necessary for different reasons: i) to act before the patent office; ii) to act against third-party infringers; and iii) important for determining the ownership of the patent applications/patents. Providing a form can alleviate the burden on users of potentially omitting the formal requirements that are necessary for registration of an assignment of a patent application/patent, which can have costly effects upon users. The Working Group recognises that in order to achieve an improved user experience the form could be an electronic form that can be filed via existing electronic filing systems or making use of online services (without prejudice to the possibility of filing for example by post or in person). This common practice does not require Offices who already make use of electronic filing systems to implement an electronic form. The Working Group therefore recommends that Offices are to provide an (electronic) form for submission of a request for the registration of an assignment of a patent application/patent.

2.2 Electronic filing of requests for the registration of an assignment

It emerged from the results of the questionnaire that not all jurisdictions provide for the electronic filing of requests for the registration of an assignment of a patent application/patent. Electronic filing of requests for the registration of an assignment of a patent application/patent has evident advantages and provides for an accessible and convenient way of filing such requests. This, in turn, can contribute to timeliness in the processing of the requests for the registration of an assignment of a patent application/patent. As set out in the preamble to the draft common practice, the Working Group recognised that is important to keep pace with digital advancements and provide efficiency benefits for users, without prejudice to the possibility of filing for example by post. It therefore proposes that offices are to provide for the electronic filing of requests for the registration of an assignment of a patent application/patent. Importantly, this does neither preclude filing of requests for the registration of an assignment of a patent application/patent to be submitted by any other means accepted by the relevant Office (such as post) nor does it preclude the relevant Office to require that for specific pieces of supporting evidence, means of filing mandated by the relevant Office or by national law (such as paper filing via post) must be used.

2.3 Electronic signatures for registration of an assignment

It emerged from the responses to the questionnaire that not all jurisdictions provide for the possibility of signing requests for the registration of assignments using an electronic signature. The use of electronic signatures has evident advantages for users, providing for an accessible and convenient method of certifying requests for the registration of assignments. The timeliness benefits gained through using electronic signatures can also contribute to faster processing of requests for the registration of assignments of patent applications/patents. As set out in the preamble to the draft

common practice, the Working Group recognised that making use of electronic signatures on requests for the registration of assignments of patent applications/patents contributes to the important goal of keeping pace with digital advancements and providing efficiency benefits for users. This is without prejudice to the possibility of signing requests by hand. The Working Group also recognised the role of signatures in legally certifying requests, and in providing identification and security. It therefore proposes that offices are to provide for electronic signatures as accepted under national law for requests for the registration of an assignment of a patent application/patent. Importantly, this does neither preclude the acceptance of handwritten signatures on requests for the registration of an assignment of a patent application/patent nor does it establish a specific type or standard of electronic signature to be required by offices on requests for the registration of patent applications/patents. This common practice does not apply to supporting evidence, which is filed in accordance with national law.

2.4 Fee reductions for the submission of requests for registration of an assignment depending on the filing method

Most jurisdictions confirmed in the results of the questionnaire that they do not offer a reduction in fees for filing requests for the registration of patent applications/patents when a specific filing method (such as electronic filing) is chosen by their users. Providing for a fee reduction for users when they choose to file requests for the registration of patent applications/patents using specific (electronic) filing methods not only provides cost benefits, but also encourages the use of new technologies which provide evident accessibility, convenience and timeliness advantages for both users and offices. The Working Group recognised in the preamble to this draft common practice that embracing digitalisation and providing cost benefits to users are crucial goals which would be served through offering fee reductions to users when they opt to use electronic filing methods. The Working Group also recognised that the results of the questionnaire demonstrated that some offices already offer fee reductions when users choose specific filing methods or have either no fees or low levels of fees for the filing of requests for the registration of assignments of patent applications/patents. Therefore, offices are encouraged to provide for a fee reduction for users when they opt to file requests for the registration of assignments of patent applications/patents using an electronic filing method. This is without prejudice to those offices who already offer such a fee reduction or have no fees for the filing of requests

2.5 Procedure for rectifying deficiencies and correcting errors in pending requests

It emerged from the results of the questionnaire that most jurisdictions, although not all, have an established process for the rectification of deficiencies and the correction of minor errors in submitted requests for the registration of assignments of patent applications/patents that are still pending entry in the register. Establishing a defined process for the correction of errors in pending requests for registration provides convenience and cost saving advantages for users, allowing them to ensure that their requests for registration of assignments are not rejected by offices even if a human error or other mistake was made when filing the request. It also provides efficiency benefits to offices, as less requests for registration must be rejected and resubmitted, and office staff spend less time assessing the content of submitted requests for the registration of assignments through implementation of the process. The Working Group therefore recognises that to achieve an improved user experience through alleviating the burden of rejected requests for registration of assignments

on users, and to provide efficiency benefits to offices, offices are to implement a defined process for rectifying deficiencies and correcting minor errors in requests for the registration of assignments of patent applications/patents that are pending entry in the register.