

**SIGNATURES TO
AGREEMENTS TO ASSIGN, ASSIGNMENTS AND UK PATENT OFFICE FORMS**

SIGNATURES TO AGREEMENTS TO ASSIGN, ASSIGNMENTS AND [UK P.O. FORMS](#)

Two relevant Court of Appeal Judgements ¹ have recently come to light:

- one dated [31.07.2003](#) – i.e. one day after [Begbies Traynor](#) (the Administrative Receivers to the registered proprietor of the patents at issue) took control of Sense-Sonic Ltd, Jordangate, Macclesfield – the then registered proprietor of the Patents, Rights of Priority, Designs & Trade Mark [at issue since that time](#),
- one dated [22.10.2008](#) – i.e. two days after [the executive of HMRC](#) sought a legal opinion as to the possibility (*in % terms*) of a [Judicial Review](#) ¹ in the event that it did not come down hard on *the executive* of the UK Patent Office over its registration practices (e.g. in cases where applicants' references to *transfer by an [agreement](#)* don't sit well with the standard "[and documents filed on](#)" wording).

It has also recently come to light that there have been some relevant changes at the US Patent & Trade Mark Office ² and at the European Patent Office ³ with which the UK P.O.'s 1995-2021 false pretences of valid [Form-based](#) registration don't sit well.

¹ Unaware of these Judgements, the 2009 Judicial Review Applicant otherwise referred to two UK Patent Office-published Case Reports: (1) "[Coflexip](#)" – which continues to conceal frauds relating to (i) a *Comptroller's officer*-concealed [01.03.1990](#) \$2.5bn *merger* and (ii) its underlying, [insider-traded 05.10.1981 Merger Agreement](#); and (2) "[Nutrinova](#)" – which continues to conceal frauds relating to (i) an unmentioned [01.11.1998](#) \$2.7bn [Demerger](#), (ii) an underlying [28.08.1997 Contributions Contract & Agreement to Assign](#) and (iii) a large number of concealed (from the UK Court proceedings, 1998-2002) *shortform assignments* from the global patentee, [Hoechst](#), to the following four (of many) spin-out companies:

[Nutrinova Nutrition](#) ² [Trespaphan](#) ² [Celgard](#) ² [Clariant](#) ²

All via [Hoechst Celanese Corporation](#)
[AGREEMENT TO ASSIGN](#), [ASSIGNMENT](#), [CHANGE OF NAME](#)

² Lexology webpage:

Assignment documents now publicly available through USPTO website. ...

Assignment documents are available through [the USPTO patent assignment search page](#). However, the location of the document is not immediately apparent. [MORE IN ANNEX 1]

³ D.Young & Co. webpage:

EPO patent assignment recordal: signatures & evidence ...

*Assignments for recordal **at the EPO** are now expected to be in writing and signed by all parties to ensure that they meet the requirements of Article 72 EPC. ...*

We have also been informed that such proof of authority should state that the relevant signatory has authority to sign legally binding documents, [in particular](#) in relation to the assignment or transfer of patents and patent applications, on behalf of the company.

*Whilst we have been able to obtain this guidance from the EPO, **an explanation as to why this degree of evidence is now required has not been forthcoming**. In any event this new approach is now the standard to which applicants must adhere when **requesting recordal of an assignment or transfer at the EPO**.* [MORE IN ANNEX 2]

ANNEX 1

<https://www.lexology.com/library/detail.aspx?g=97b58ea2-5318-4388-91f7-a01abb3c8a41>

Assignment documents now publicly available through USPTO website.

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Assignment documents are available through the USPTO patent [assignment search page](#). However, the location of the document is not immediately apparent. An interested party may use the search page itself to search for assignment documents by patent number, patent application number, patent application publication number, **assignor name** or **assignee name**. The search page then provides a history of conveyances (along with corresponding reel and frame numbers) for the particular patent or patent application. A PDF icon appears next to the name of each conveyance (eg, security agreement or assignment of assignor's interest), which then provides click-through access to a PDF copy of the conveyance document. Otherwise, a searching party may simply click the reel and frame number of a particular conveyance to view [summary](#) data regarding **that particular document**. A PDF copy of the document is then similarly [available](#) from the [individual summary page](#).

Assignment documents are not accessible through the assignments tab of the Patent Application Information Retrieval system (known as 'Public Pair'). Further, the USPTO patent assignment search page provides access to patent assignment documents for issued patents and published patent applications.

The public availability of assignment documents is in line with patent file history information available through Public Pair. **The new service is welcome news** to patent practitioners and IP professionals. Under prior practice, last minute diligence projects faced potential delay while awaiting mail delivery of ordered assignment documents; now, [the information](#) is available with the [click](#) of a button.

ANNEX 2

<https://www.dyoung.com/en/knowledgebank/articles/epo-assignment>

[emphasis and links added]

EPO patent assignment recordal: signatures & evidence

24 April 2018

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The EPO's approach to assignment recordal has changed over the last two years.

At [D Young & Co](#) we have seen that the new approach has required applicants to provide more detailed documentation in [support](#) of their [request](#) which often results in the [recordal](#) taking [longer](#) than expected.

The main requirements for an assignment recordal have not changed. Article 72 EPC states: "An [assignment](#) of a European patent application shall be made in writing and shall [require](#) the [signature](#) of the parties to the [contract](#)".

Whilst this legal basis has not changed, the [level of evidence](#) the EPO [now](#) requires has.

[Previously](#) the EPO was happy to accept [evidence](#) that both parties [agreed](#) to the transfer, for example by having the assignor sign [the assignment](#) and [the assignee](#) request the relevant recordal at the EPO, however this is no longer the case. **[Assignments](#) for recordal at the EPO are now expected to be in writing and signed [by all parties](#) to ensure that they meet the requirements of Article 72 EPC.**

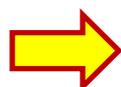
The Guidelines for Examination, which came into force on 01 November 2016, confirmed that the signatures of the parties (that is, the [assignor](#) and the [assignee](#)) must appear on **the documents submitted as [evidence of the transfer](#)** and also stated that a signatory signing [on behalf of](#) a corporate owner **[must give their precise job title](#)**.

The latest version of the Guidelines for Examination, which came into force on 01 November 2017, went further and states: "Where a document is signed **on behalf of** a legal person, **[only such persons as are entitled to sign by law](#)**, by the legal person's articles of association or equivalent or by a [special mandate](#) may do so. **[National law applies in that respect](#)**. In all cases, an indication of the signatory's entitlement to sign, for example his/her position within the legal entity where the entitlement to sign results directly from [such a position](#), is to be given. **The EPO reserves the right to request [documentary proof](#) of the signatory's authority to sign if the circumstances of a particular case necessitate this.** Where the entitlement results from a special authorisation, [this authorisation](#) (a copy thereof, which need not be certified) **[has to be submitted in every case](#)**. The EPO will **[in particular](#)** examine whether the signatory is empowered to enter into a legally binding contract on behalf of the legal entity." (GL E XIV 3) (emphasis added).

Whilst this indicates that proof of a signatory's authority to sign such documents might be requested **in exceptional cases**, at D Young & Co we have noted that **this is being requested as standard**, unless the relevant signatory is a director, president or CEO of the relevant company.

Our discussions with the officers at the EPO have revealed that **this is indeed the case**, and that **proof of authority** for any signatory who is not a director, president or CEO of the relevant company is **required**.

We have also been informed that such proof of authority should state that the relevant signatory **has authority to sign legally binding documents**, in particular in relation to the **assignment** or transfer of patents and patent applications, on behalf of the company.



Whilst we have been able to obtain this guidance from the EPO, an explanation as to why this degree of evidence is now required has not been forthcoming. In any event this new approach is now the standard to which applicants must adhere when requesting recordal of an assignment or transfer at the EPO.

Recommendations

In light of the EPO's **new stricter** approach, and from the experience of our various attorneys in recording assignments over the past two years, we recommend the following actions:

- Ensure any **assignment** that might be recorded at the EPO is **signed by all parties**.
- Ensure the **job titles of the signatories are listed on the assignment**.
- If the job title of any signatory is not director, CEO or president of the company (or company secretary for US companies), **provide proof of authority for that signatory**.
- The proof of authority should state that the signatory is authorised to sign **legally binding documents on behalf of the company (in particular relating to the transfer or assignment of patents and patent applications)**.
- The proof of authority could be in the form of a specific document signed by a director, CEO or president of the company, **an extract from the relevant commercial register** or minutes from a board meeting.

It is hoped that by following these recommendations a request for recordal of assignment **at the EPO** will be swiftly approved and excessive delays avoided.

Applicants considering filing a request for recordal of assignment should contact their usual **D Young & Co patent attorney** who will be happy to advise as to whether **your documentation** will meet the EPO's new requirements and any further steps that should be taken.