

Brexit and what it means for your IP

The UK has now left the European Union and the so-called 'transition period' has now ended. As a result, new EU trade mark and registered design filings no longer cover the UK (meaning that separate UK applications need to be filed to cover the UK). European patents are unaffected by Brexit.

Mathys & Squire's ability to represent its clients in the UK and Europe is not affected by Brexit. As a firm, we remain a European business with offices in the UK, Germany, Luxembourg and France and we continue to represent our clients across Europe.

On this page, we hope to dispel some of the myths surrounding how patents, trade marks and design rights are affected by Brexit.

European patents

- The European patent system is not affected by Brexit. The UK is, and remains, a member of the European Patent Convention (EPC), as the EPC is unrelated to the EU.
- UK-national European patent attorneys are still able to act before the EPO after Brexit.
- Patents continue to be enforced against infringers in the national courts.

EU trade mark registrations (EUTMs)

- UK-based companies can continue to file and own EUTMs.
- New EUTMs no longer extend to the UK.
- Registered EUTMs no longer extend to the UK, but any in existence before 1 January 2021 have been automatically 'cloned' to create equivalent UK rights.
- A separate UK trade mark registration will be needed to obtain protection for new marks in the UK.
- Use of a trade mark only in the UK will no longer be sufficient to keep an EUTM registered.

Registered community designs (RCDs)

- UK-based companies can continue to file and own RCDs.
- Existing RCDs no longer extend to the UK, but all those registered on 31 December 2020 have automatically been "cloned" to create equivalent UK rights.
- Any new RCD filings will no longer extend to the UK.
- For new designs in the UK, a separate UK Design Registration will need to be filed.

Unregistered designs

- Designs that were protected in the UK as EU unregistered design rights on 31 December 2020 continue to be protected in the UK for the remainder of their three-year term as continuing unregistered designs (CUD), which were automatically established on 1 January 2021.
- A new 'EU equivalent' UK supplementary unregistered design (SUD) right has also been introduced to mirror the protection provided by EU unregistered design rights.
- SUD rights are established by first disclosure in the UK, but not first disclosure in the EU.

The Hague International Design System

- The Hague System allows a design to be registered in several territories starting from a single international application.
- As the UK is now a party to the Hague Agreement in its own right, UK applicants continue to be entitled to use the Hague System.

Litigation

UK Courts will continue to pass judgement on UK IP rights, including European patents validated in the UK (and any registered EU trade marks and designs that have been converted into UK rights).

Address for service

- Following 1 January 2021, only a UK address for service will be accepted for new UK patent, design and trade mark applications.
- In particular, it will no longer be possible to register an European Economic Area (EEA) address as an address for service in respect of granted European patents designating the UK – only a UK address for service will be accepted.
- Registering a UK address for service is advisable because without such an address the UK Intellectual Property Office will enter the first-named proprietor as address for service on the UK Register and send any official correspondence to them. This could lead to important correspondence being overlooked, misdirected or misunderstood.

- It is not necessary to have a UK address for service to pay renewal fees. For all other actions, such as recordals of assignments, licences and changes of name/address, a UK address for service is required.

EU & UK trade mark filing packages

Filing in both the EU and the UK (one class) at a discounted, fixed fee. This fee will cover all costs up to the issuance of the registration certificate, with the exception of official objections or third-party opposition. Additional class fees will then carry a 20% discount.

EU & UK design filing packages

Filing in both the EU and the UK at a discounted, fixed fee. This fee will cover all costs up to and including the issuance of the registration certificate. This fixed fee assumes we receive the drawings in a ready to file format and excludes the cost of any official objections. Additional designs in a filing will also carry a discount.

Mathys & Squire is proud to employ people of different nationalities, with many coming from countries within the EU. We have taken steps to ensure that the firm has a number of locations inside the 'post-Brexit EU' (i.e. without the UK). This has placed us in a strong position to be able to handle both UK trade marks and designs, as well as EU trade mark registrations and registered community designs, and we have been working with our clients on cost-effective strategies for doing so.

If you have any questions, please contact your usual Mathys & Squire adviser, or for more information on this topic, please contact brexit@mathys-squire.com.

