

BREXIT and what it means for your IP

On Friday 29 March 2019 the UK is set to leave the European Union. In this insights sheet we hope to dispel some of the myths surrounding how patents, trade marks and design rights will be affected by Brexit.

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

European Patents

- The European Patent System is not affected by Brexit. The UK is, and will remain a member of the European Patent Convention (EPC), as the EPC is unrelated to the EU.
- There are already a number of other countries who are members of the EPC but who are not members of the EU.
- UK-national European Patent Attorneys will still be able to act before the EPO after Brexit.
- Patents will continue to be enforced against infringers in the national courts as before.
- The proposed pan-European Unitary Patent system has been delayed, but the UK government is exploring ways to ensure that the UK can participate in any system that is brought into effect.

EU Trade Mark Registrations (EUTMs)

- UK-based companies can continue to file and own EUTMs.
- After Brexit new EUTMs will no longer extend to the UK.
- Registered EUTMs will no longer extend to the UK, but will automatically be "cloned" to create equivalent UK rights.
- For pending EUTM applications there will be an option to refile in the UK and retain the same filing date. There will be costs involved and the new application will go through the UK examination process.
- After Brexit, 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 (RCD)

- UK-based companies can continue to file and own RCDs.
- After Brexit new RCDs will no longer extend to the UK.
- Existing RCDs will no longer extend to the UK, but will automatically be "cloned" to create equivalent UK rights.
- After Brexit, a separate UK Design Registration will be needed to obtain protection for new designs in the UK.

The Hague International Design System

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

Unregistered Design Rights

- EU Unregistered Design Rights will cease to have effect in the UK when the UK leaves the EU; however, such rights will automatically be “cloned” to create a new “EU equivalent” UK Unregistered Design Right which corresponds to the present EU Unregistered Design Right. This new “EU equivalent” UK Unregistered Design Right will continue to arise after Brexit for new UK designs.
- Current UK Unregistered Design Rights will still be available to qualifying persons (currently those with a place of business in UK, EU states or UK protectorates, although UK law is likely to be changed to exclude EU states).
- Following Brexit both the current UK Unregistered Design Rights system and the new “EU equivalent” UK Unregistered Designs Rights will exist in parallel.

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).

Mathys & Squire is proud to employ people of different nationalities, with many coming from countries within the EU. We have already taken steps to ensure that the firm has a number of locations inside the “post-Brexit EU” (i.e. without the UK). This places 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.

We shall of course update our clients and contacts when we have further news regarding the IP implications of Brexit. In the meantime, if you have any questions, then please contact your usual Mathys & Squire adviser or for more information on this topic, please contact brexit@mathys-squire.com

