

9 Ways To Prepare Your IP Rights For Brexit

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On March 29, 2019, the U.K. is scheduled to leave the European Union under Brexit. Less than a month before the scheduled exit date, it is still unclear if the exit will be delayed, with or without a deal with the EU, or potentially abandoned.

What does this mean for your European intellectual property portfolio, particularly your EU trademarks and registered community designs? While the future is uncertain, there are practical steps that you can take now to prepare.

What You Need to Know

European Patents and Copyrights Are Not Affected

Patents issued by the European Patent Office will not be affected by Brexit. EPO patents are governed by the European Patent Convention, an agreement that is separate from the European Union. Therefore, your European patents validated in the U.K. will remain in force in the U.K.

Copyrights are created on a national basis. Both the EU and the U.K. are members of the main international treaties providing reciprocal rights for copyright protection. Therefore, if the U.K. leaves the EU, copyright rights will not be affected.

Registered European Union Trademarks and Registered Community Designs

The current draft of the Brexit withdrawal agreement provides that the U.K. will automatically grant owners of European Union trademarks and registered community designs a duplicate or "cloned" right in the U.K. if the EU rights were registered or granted before the end of the "transition period." That period is currently set at March 30, 2019, through Dec. 31, 2020.

If, however, the U.K. leaves the EU without a deal, then there will be no transition period. The EUTMs and RCDs must have been registered as of the date of withdrawal for the IP right to be cloned.

The renewal date of the cloned U.K. right will be the same as the corresponding EU right. The U.K. Intellectual Property Office will publish a notification of the cloned rights, and there will be procedures for opting out of the

U.K. registered trademark or design. The U.K. IP Office has stated that it will not be charging any fees in connection with the cloned U.K. rights.

Pending European Union Trademark Applications and Unregistered Community Designs

If you own a pending application for a EUTM or RCD at the expiration of the transition period (if there is one), you will have nine months upon the expiration to apply for the equivalent protection in the U.K. to retain the original EU priority filing date for the trademark or design right, including applicable U.K. seniority claim for EUTMs.

To date, the U.K. IP Office has not been entirely clear about the examination process for the new U.K. applications. It also is uncertain what will happen if the U.K. withdraws without an agreement. Owners of pending trademark applications likely will need to file new U.K. trademark applications.

Unregistered community design rights in existence at the end of the transition period (if there is one) will continue to be protectable and enforceable in the U.K. for the remaining term of protection of the relevant UCD right. Currently, there is a separate unregistered

U.K. design right under the U.K. Copyright Design and Patents Act, but it is not the same as an unregistered community design right. For designs not in existence at the end of the transition period (if there is one), the U.K. plans to establish a "supplementary unregistered design right" that will be essentially the equivalent of the UCD enforceable in the U.K.

Strategy Recommendations to Consider

Even though it is uncertain what Brexit will look like, or if it will ultimately occur, here are some strategy recommendations and practical approaches for you to consider today:

1. File a separate U.K. trademark application if you own a European Union trademark and are using the mark solely in the U.K. and you do not want to wait until there is more clarity about when you will receive a U.K. clone of your EUTM. If you rely solely on your U.K. rights to support your EUTM, the EUTM could be subject to cancellation for failure to use the mark throughout the EU.
2. Renew your EUTM if you are within the six-month renewal period, and you want your mark protected in the EU and the U.K. If the timing works in your favor, this would allow you to obtain duplicate

protection in the U.K. without having to pay a filing fee for a new application. Your U.K. filing also would have the priority, and if applicable, U.K. seniority, date associated with EUTM.

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