

BREXIT AND IP – UPDATE ON DESIGNS – DECEMBER 2018

Key Highlights - Designs

- There is a proposed transitional period and status quo is likely to be maintained until 31 December 2020;
- Thereafter, or in the event of a no deal Brexit on 29 March 2019, Community Design Applications/Registrations will no longer cover the UK in territorial scope;
- National UK applications/registrations for designs unaffected.

Will I lose my right to protection in the UK from my EU Community Design Registration (“RCD”)?

- UK Government has stated formally in a technical notice that no EU IP holder will lose rights;
- The Withdrawal Agreed states cloned UK equivalent registrations will be created mirroring existing EU RCDs, if published, maintaining filing, registration and renewal dates, and priority dates;
- To be automatic with minimal administrative burden – UK IPO will send notice of new registration details automatically, at no cost;
- The technical notice states this is the case whether deal or no deal scenario arises ;
- RCD applications will not have automatic cloned UK registration created – EU IP holder will have nine months (either from the agreed transition expiry date or 29 March 2019) to re-file at their own cost in line with national legislation to maintain EU filing date. No notification will be sent.

Issues

- EU RCD applications filed now may not be registered by 29 March 2019 if no deal or if publication is deferred;
- A design application in ordinary circumstances must not be filed more than 12 months after the design is put into the public arena or it will have deemed to have destroyed its own novelty, but a UK Design application being filed in the nine month period after Brexit may well have been in the public arena more than 12 months at date of filing and therefore deemed not novel. No information as to how this will be approached has been provided.
- If no deal scenario arises, UK IPO may be approaching creation of cloned rights after the event, rather than before (it is currently proposed cloned registrations will be created in the transition period) and this could create uncertainty in the interim period if need to enforce rights in the UK;
- There is no notification what will happen to International Design Registrations filed by UK businesses utilising an EU RCD as the home base application or registration – will it

automatically be amended to cloned UK registration? WIPO has been silent on the point to date;

- The Technical Notice is not legally binding – given the political uncertainty, a new government could be in place at the time of Brexit, although unlikely the stance on IP would alter.

Recommendations

- New Designs should be filed as both UK and EU design registrations;
- This is particularly the case if deferment of the publication of the design is required, or the design has been in the public arena for part of the 12 month grace period at the time of filing;
- IP Holders with EU RCD applications/registrations for designs which have been in the public area for less than 12 months should file corresponding UK Design applications before the expiry of the 12 month period;
- For existing EU RCDs which have been in the public arena more than 12 months, refiling now would not result in a valid design registration, so existing EU RCDs should wait to receive cloned UK registration.
- File any new International design registration on the basis of a UK home application or registration and do not base such an application on an EU registration.

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