

# Brexit – the effect on IP

## Designs and Patents

Robert Watson

Milan, Italy

22 February 2019



# Review of the effect on Designs



# Registered Community Designs – No-deal

- Registrations will give rise to a re-registered UK design
  - Retaining priority and filing dates
  - Possibility of opting-out of re-registration
  - Licence for RCD continues to have effect in UK
  - Pending proceedings in a Community Court in UK will only have effect on the re-registered UK design
  - Existing injunction continues to have effect in UK
- Pending applications need to be refiled
  - Within 9 months
- RCDs where publication is deferred need to be refiled
  - Within 9 months
  - No examination of whether a design, dictated by technical function or contrary to morality – just formalities

# Registered Community Designs – No-deal

- RCDs which expire (by non-payment of the renewal fee in the 6 months before exit day) can be renewed at EUIPO in the grace period and become a UK re-registered design
- RCDs which are restored to EU register, can become a UK re-registered design
  - Need to apply to go on the register within 6 months of EU restoration
- RCDs which are part of a Hague Registration will also give rise to a UK re-registered design

# Unregistered Community Designs – No-deal

- Existing Unregistered Community Designs (UCDs) become “continuing unregistered Community Designs”
  - Same rights as UCD, but enforced in a UK court
- New right created – “supplementary unregistered designs”
  - Based on the UCD, but for the UK only
  - Still has the uncertainty in Article 11 about geographical locus of disclosure
  - “A design which meets the requirements under Section 1 shall be protected by a supplementary design for a period of three years as from the date on which the design was first made available to the public within the United Kingdom, a qualifying country or a qualifying territory.”
  - Possible intended to provide reciprocal rights in future

# Designs – If there is a Deal

- Essentially the same as No-deal
- Except:
  - Registered Designs to be given continued protection *free of charge* (Art. 54)
  - For International Designs, the re-registered UK part may be able to be part of the International registration (to be agreed with WIPO)

# Review of the effect on Patent rights



# European Patents

- The EPO is not an EU institution
- No change in the UK membership of the EPO

EPO and CIPA: no impact of Brexit on UK membership of EPO

25 January 2018

High-level representatives and experts of the EPO, led by President Benoît Battistelli, met yesterday in Munich with a delegation of the Chartered Institute of Patent Attorneys (CIPA) headed by its President, Stephen Jones.



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets



# Unitary Patents

- Plans for the Unified Patent Court on hold due to pending challenge in the Bundesverfassungsgericht
- Strongly held views on either side whether UK can participate
- Life Sciences branch of Central Division ready to go in London



# Supplementary Protection Certificates

- SPCs are a national right issued based on EU Regulation to compensate for delays in being able to market pharmaceutical and agrochemical products due to need to obtain regulatory approval
- Existing SPCs to continue in the event of a no-deal Brexit
  - Original granted term
- New SPCs will be available in the event of a no-deal Brexit
  - Require UK Marketing Authorisation & EU27 Marketing Authorisation
  - Unusual, but results from the nature of the EU (Withdrawal) Act 2018
  - Applies to pending SPCs on exit day
- Likely to be similar provisions with a Deal Brexit





# Thoughts on Future Relationship Agreement



- Could the UK remain in the EU Design system?
  - Could happen under a Future Relationship Agreement
  - Has been included in a motion in the House of Lords
- No need for separate filings – UK attorneys to retain status as EUIPO Professional Representatives
- No need for conversion, with all the work this will bring

- Possible for the UK to remain within the EMA in a Future Relationship
- Easier for SPCs to be granted as no need to for separate UK authorisation
- Or ... mutual recognition of authorisations would have the same effect
- Future Relationship Agreement could include the UK in the Unified Court System and Unitary Patent
  - Having the UK in the system would be attractive due to EP validations in the UK, UK judges and UK barristers



## Questions

City Tower  
40 Basinghall Street  
London EC2V 5DE  
United Kingdom  
T +44 (0)20 7776 5300  
F +44 (0)330 111 4455

**mewburn.com**  
mail@mewburn.com

Mewburn Ellis LLP is a Limited Liability Partnership. Registered in England no. OC306749  
Registered office: City Tower, 40 Basinghall Street, London EC2V 5DE. Regulated by the Intellectual Property Regulation Board  
A list of members of the partnership can be found at [www.mewburn.com/our-people](http://www.mewburn.com/our-people) or at the above address.