

United Kingdom decision to leave the European Union

On Thursday June 23, 2016 the voting public of the United Kingdom made the momentous decision to leave the European Union. Below, we have outlined what the possible effects may be for patent, trade mark and design portfolios.

Patents

There is no significant immediate effect which we can identify. The European Patent Organisation (European patent office) is an intra-governmental organisation which is not part of the European Union. Your patent portfolio will continue as before unaffected.

Trade marks - existing portfolio

For any individual national trade mark rights in your portfolio, these are unaffected.

For EU trade mark registrations, the United Kingdom will remain part of the European Union for the immediate future until the arrangements for the United Kingdom leaving the European Union are finalised. For the immediate near future, European Union trade marks are still effective in the United Kingdom and all 27 other EU member states. It is anticipated that it will be up to two years before any changes come into effect.

When the United Kingdom leaves the European Union, your existing EU trade mark registrations will continue to be effective in the remaining 27 EU member states, and will continue to be automatically extended to any new EU member states as these join.

It is not yet clear how UK legislation will handle the UK effect of existing EU trade mark registrations. One possibility is that all existing EU trade mark registrations could be automatically converted to UK national trade mark registrations without any further formalities being necessary, this being enacted as a single block of legislation.

Another possibility is that EU trade mark registrations will need to be re - registered as UK national trade mark registrations.

A further, but less likely scenario, is that the rights in existing EU trade mark registrations will simply not cover the United Kingdom at all in due course.

The UK Trade Marks Registry has not so far issued any practice notes as far as we are aware, but we would expect one to issue shortly.

Since there is uncertainty, the safest option now for continuing your UK trade mark protection is to immediately file a new UK trade mark applications corresponding to each of your existing EU trade mark registrations.

Such applications could turn out to be redundant in due course, depending upon future changes to UK legislation, but we are not in a position to be sure of how future UK legislation will be enacted.

Trade marks - new applications

For clients requiring protection in the UK, our previous default advice was to file a European trade mark application covering all EU member states including the United Kingdom.

The choices now include:

- To file a UK trade mark application for UK protection only.
- To file a UK trade mark application covering the United Kingdom, and an EU trade mark application covering the remaining 27 member states of the European Union.

International trade mark registrations

If you already have an international trade mark registration, but do not have a corresponding UK national trade mark registration, a UK national trade mark registration can be obtained by extending your existing international trade mark registration to the United Kingdom as an extra designated state.

This will have substantially the same effect as a UK national trade mark registration.

Registered Community designs - existing registrations

For registered Community designs, the United Kingdom will remain part of the European Union for the immediate future until the arrangements for the United Kingdom leaving the European Union are finalised. It is anticipated that it will be at least two years before any changes come into effect.

It is not clear whether the rights to registered design protection in the United Kingdom arising from existing registered Community designs will be continued in the United Kingdom by further UK legislation. It would seem sensible to do so, but we are not aware of any legislation to this effect.

Therefore, if you have a recently filed a registered Community design, or a design which has been first published less than one year ago, we recommend immediately filing a corresponding UK registered design application for the same subject matter as your existing registered Community design.

The above advice also applies for International Registered Designs filed in the past year designating the European Union.

Such UK registered design applications could turn out to be redundant in due course, depending upon future changes to UK legislation, but we are not in a position to be sure of how future UK legislation will be enacted.

Unregistered Community design right

Unregistered Community design has a term of three years from the date of first publication of a design within the European Union. At the moment, unregistered Community design rights continue to include the United Kingdom until the UK leaves the European Union.

After leaving the European Union, it is possible that there will be some transitional UK legislation concerning existing unregistered Community design. We are not aware of any UK legislation to replace unregistered Community designs and our default advice is to file a registered Community design to protect your designs in the EU.

Product clearance searches

These will be unaffected. We already search the relevant territories, and this will not change. No changes to our product clearance search strategy is necessary.

Specific advice

As you will appreciate, we are advising our clients under conditions of uncertainty in which no UK government legislation has been prepared in advance. We therefore recommend you seek specific advice from one of our attorneys concerning your trade mark and design portfolio.

Continuity of service

As Chartered Patent Attorneys, UK registered trade mark attorneys, and members of the Chartered Institute of Trade Mark Attorneys, all aspects of our business in all territories continue exactly the same as previously.

We will continue to act as Professional Representatives before the European Patent Office, and will continue to be European Patent Attorneys, irrespective of the recent referendum decision. The European Patent Organisation is not an EU organisation.

For the immediately foreseeable future, we will also continue to act directly before the European Union Intellectual Property Office (which is an EU organisation) in respect of EU trade marks and registered Community designs.

Franks & Co

15 Jessops Riverside

Brightside Lane

Sheffield

S9 2RX

T: +44 (0)114 249 9888

F: +44 (0)114 249 9666

E: franksco@franksco.com

Franks & Co (South)

Carlton House

26 Billing Road

Northampton

NN1 5AT

T: +44 (0)1604 632436

F: +44 (0)1604 626128

E: northampton@franksco.com

Franks & Co (Mancunium)

Cheadle Place, Cheadle Point

Stockport Road, Cheadle

Manchester

SK8 2JX

T: +44 (0)161 820 2891

F: +44 (0)114 2499666

E: manchester@franksco.com

www.franksco.com

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