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Key points for EU IP maintenance after Brexit

As Brexit approaches, IP owners should be taking pro-active steps to ensure that their rights are well-managed and adequately protected. Whilst Patent owners and Applicants remain largely unaffected by the unfolding Brexit scenario, owners and Applicants of Trademarks and Registered Designs should actively safeguard their interests, by paying attention to the action points outlined below.

There will be no fundamental changes insofar as **PATENTS** are concerned. As the European Patent Office is not an EU Institution, so the European Patent Convention is unrelated to EU law and practice will continue as usual.

Here are some key points for **TRADEMARKS & DESIGNS** for the post-Brexit proposals:

Registered EU Trademarks and Designs:

- New UK right will be automatically created with the original filing/priority dates being preserved and will be treated as if it had been applied for and registered under UK law.

Pending EU Trademarks and Designs applications:

- Applicants will be able to re-file in the UK within nine (9) months from the date of Brexit to preserve the same priority and filing dates as the pending EU application.

Pending UK applications or Registered UK Trademarks and Designs:

- Applications for UK national are made to the UK Intellectual Property Office, not to an EU institution. Existing UK national registrations and applications will remain in force.
- The UK will remain a party to a number of international agreements, including the Paris Convention. The UK IP applicants are possible to claim the priority in the EU (or elsewhere) and vice versa.

International Trademark Registrations (IRs):

- The IRs designating the EU registered prior to Brexit will be cloned into a new UK registration (which will bear the same filing/priority and registration dates) but not a UK designation.
- The IRs applications file after Brexit need to extend the scope of protection to both the EU and the UK.

Our suggestions:

- File applications in both the EU and the UK from this moment to ensure to obtain rights in the EU and UK after Brexit.
- While filing IRs which designates the EU, a separate UK designation should be added.

Renewal EU registration:

- Renewals filing prior to Brexit will encompass the UK.
- Renewals filing after Brexit will not encompass the UK; separate renewal in UK is required.

Evidence of Use:

- Evidence of use in the UK will not be valid for EU Registration and vice versa.

Pending Proceedings:

- Closure of pending proceedings prior to the effective date of Brexit is to be recommended. As such, Cooling Off periods in pending EUIPO Oppositions should be brought to an end, and ongoing proceedings to be expediated.
- Any ongoing EU Opposition and Invalidation proceedings based solely on a UK right, may be thrown out following Brexit.

Licences and Security Interests:

- Licences or security interests recorded against a registered EU Trademark or Design should also be recorded against its clone when this is created.

Contracts and Agreements:

- The terms of any pre-Brexit agreements should be reviewed, to ensure compliance following Brexit – opting-out or surrendering a clone might be necessary, as the existence of a UK Registration might be contravening earlier agreements.
- Any clauses related to jurisdiction, governing law, and territory in existing contracts should be reviewed and amended to include the UK, as well as the EU, wherever appropriate.
- Distribution agreements should also be reviewed in anticipation of changes to the exhaustion regime.