

Brexit: Our handy guide for your Registered and Unregistered Designs



Key dates

**31 Jan
2020**

The UK leaves the EU and will no longer take part in the running of the EU. However, it will effectively remain in the EU single market during the “transition period”.

**1 Feb
2020**

The start of the “transition period” during which time little changes for owners of EU rights. During this period, EU rights (including Registered Community Designs (RCDs), EU Designations of International (Hague) Design Registrations, and Unregistered Community Designs (UCDs) will still extend to the UK and accordingly it is open to the owner of such EU rights to bring infringement proceedings based on those rights.

**31 Dec
2020**

From this date onwards (assuming no extension to the “transition period”), EU rights will no longer extend to the UK.

In order to seek registration of a design in the UK, it will be necessary to file either a UK application or designate the UK under an International (Hague) Design Registration.

The UK will create new equivalent UK registered designs which correspond to existing EU registered designs. The UK will also create a new Continuing Unregistered Design right to provide protection for existing UCDs.

**1 Jan
2021**

From this date onwards (assuming no extension to the “transition period”), EU rights will no longer extend to the UK.

In order to seek registration of a design in the UK, it will be necessary to file either a UK application or designate the UK under an International (Hague) Design Registration.

The UK will create a new Supplementary Unregistered Design to provide protection in the UK that mirrors that currently provided by UCDs.

Note that UK unregistered design protection will only be available to UK residents/businesses for designs first disclosed in the UK.

**Jan-Sept
2021**

The “priority period” (assuming no extension to the “transition period”) during which owners of pending/unpublished EU registered designs (including RCDs and EU Designations of International (Hague) Design Registrations) can file for corresponding UK applications, retaining the original filing date and, where appropriate, the priority date enjoyed by the EU registered designs.

EU Rights after Brexit

Published Registrations

An existing, published RCD.

The UK will create new UK registered designs with exactly the same details, including the same filing date and priority date. The RCD will continue to be protected in the remaining 27 Member States of the EU (“EU27”).

There is no official fee to pay for this new UK registered design and no official form to file. The process will be entirely automatic.

The new equivalent UK registered designs derived from RCDs will have the following numbers:

9[+ all numerals of the RCD number]

As an example, RCD No. 004048098-0004 will give rise to the new equivalent UK registration number 90040480980004

An existing UK registered design.

Brexit will not affect UK registered designs.

An existing protected, EU Designation of a published International (Hague) Design Registration.

As for RCDs, the UK will create national UK registrations (note not new UK Designations) corresponding to EU Designations of International (Hague) Design Registrations.

The new equivalent UK registrations will have the following numbers:

8[+ all numerals of the International Registration number]0000

As an example, International (Hague) Design Registration (EU) No. D069629-0001 will give rise to the new equivalent UK registration number 806962900010000

An existing UK Designation of an International (Hague) Design Registration.

These rights will remain in place and are not affected by Brexit.

EU Rights after Brexit

Pending Applications and Unpublished Registrations

A pending RCD application which has not achieved registration before the end of the “transition period”, due to end on 31 December 2020.

Or

An EU Designation of an International (Hague) Design Registration for which a Statement of Grant of Protection in the EU has not been issued before the end of the “transition period”, due to end on 31 December 2020.

Or

A RCD not published before the end of the “transition period”, due to end on 31 December 2020.

Or

An EU Designations of an International (Hague) Design Registration not published before the end of the “transition period”, due to end on 31 December 2020.

At the end of the “transition period”, there will be a nine-month period in which to file a new UK application with exactly the same details as the corresponding pending application/unpublished registration.

The new UK registered design will have the same filing date and priority date. It does not matter when the original application was filed or on what date within the “priority period” the new application is filed.

Publication of the new UK registered design can be deferred until the sooner of: (1) the end of the maximum deferment period of the original application, and (2) 12 months from the date the new UK registered design is filed in the UK.

To give some examples:

A pending RCD application is filed on 31 December 2020 claiming priority from a US design patent application filed on 30 June 2020. The UK application corresponding to the RCD application must be filed during the “priority period” (January-September 2021). In this case, the UK registered design will be deemed to have a filing date of 31 December 2020 and will be deemed to enjoy the international priority date of 30 June 2020.

A RCD application was filed on 1 January 2020 with a request for deferred publication (allowing publication to be deferred by up to 30 months, i.e. until 1 July 2022). The UK application corresponding to the RCD application is filed on 1 April 2020. In this case, the UK registered design will be published on 1 April 2021, 12 months after the UK application was filed.

Alternatively, taking the same RCD application filed on 1 January 2020 with a request for deferred publication (allowing publication to be deferred by up to 30 months, i.e. until 1 July 2022). The UK application corresponding to the RCD application is filed on 30 September 2021. In this case, the UK registered design will be published on 1 July 2022, 30 months after the original RCD application was filed.

The UK will **not** remind owners of the need to file new UK applications, and action will need to be taken before the end of the nine-month period.

Where we are the responsible Attorneys for the relevant applications we will contact applicants with further details.

EU Rights after Brexit

Renewals

RCDs due for renewal **before** the end of the “transition period”.

Or

EU Designations of International (Hague) Design Registrations due for renewal **before** the end of the “transition period”.

If the EU registration/designation is renewed before the end of the “transition period”, the first renewal date for the new equivalent UK registration will be the same as the next renewal date for the corresponding EU registration/designation.

To give an example:

A RCD is due for renewal, and renewed, on 31 October 2020. The equivalent UK registration will be renewable every five years up to the maximum 25 year term of the original RCD/Hague application. Assuming that 31 October 2025 and there will be no need to renew the UK registration retrospectively from 31 October 2020.

RCDs due for renewal **before** the end of the “transition period” but where the renewal fee is paid late, after the end of the transition period.

Or

EU Designations of International (Hague) Design Registrations due for renewal **before** the end of the “transition period” but where the renewal fee is paid late, after the end of the “transition period”.

In this case, the late renewal of the corresponding EU registration/designation will automatically renew the new equivalent UK registration.

To give an example:

A RCD is due for renewal on 31 October 2020. However, the official fee (and late renewal surcharge) is only paid on 28 February 2021. In this case, the first renewal deadline for the equivalent UK registration will be 31 October 2025 and there will be no need to renew the UK registration retrospectively from 31 October 2020.

RCDs due for renewal **after** the end of the “transition period”.

Or

EU Designations of International (Hague) Design Registrations due for renewal **after** the end of the “transition period”.

In this case, it will be necessary to pay separately the renewal fee for the new UK registration, even if the renewal fee on the EU registration/designation is paid before the end of the “transition period”.

To give an example:

A RCD is due for renewal on 28 February 2021 and the official renewal fee is paid at the European Union Intellectual Property Office (EUIPO) on 1 December 2020. In this case, it will be necessary to pay the renewal fee for the equivalent UK registration to enjoy further protection until 28 February 2026.

The UK has said that it will not charge any additional “late” fee in the first six months after the end of the “transition period” for the renewal of any new UK registration.

EU Rights after Brexit

Unregistered Designs

An existing Unregistered Community Design (UCD).

The UK will continue to provide protection for any UCD established before the end of the “transition period” for the remaining term of the UCD. It will not be necessary for the UCD to have been established based on first disclosure in the UK – UCDs based on disclosure in the EU but outside the UK before the end of the “transition period” will continue to be recognised in the UK.

An existing UK Design Right.

Brexit will not affect UK Design Rights.

EU Rights after Brexit

Representation

Will Attorneys based in the EEA be able to represent clients before the UK Intellectual Property Office (UKIPO) after the end of the “transition period”?

Yes, for the first three years after the end of the “transition period”, at least for the new equivalent UK rights. Where an EEA Attorney is the representative for an existing EU right at the end of the “transition period”, they will automatically be entered in the UK register as the representative for the new equivalent UK registration.

It is not yet clear what the position will be for existing UK registrations (i.e. existing registrations which are not created as equivalents to EU rights) or indeed new UK applications filed after the end of the “transition period”.

What happens to the rights of representation for EEA Attorneys before the UKIPO in the future is likely to depend on the future commercial relations agreed between the UK and the EU.

Will UK firms be able to represent clients before the European Union Intellectual Property Office (EUIPO) after the end of the “transition period”?

UK Attorneys will continue to be able to represent their clients in any EUIPO proceedings which are still ongoing at the end of the “transition period” until those proceedings are finally determined.

Otherwise, UK Attorneys will not, in principle, be entitled to act before the EUIPO after the end of the “transition period”. In practice, however, most UK firms, including Abel & Imray, have taken steps to establish new offices in the EU in order to be able to continue to represent clients before the EUIPO.

Please feel free to contact us if you have any questions or wish to discuss your portfolio in more detail.

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