Everything You Need To Know About Brexit And How It Affects Your IP

The UK withdrew from the European Union (EU) on 31 January 2020 and the transitional period expired on 31 December 2020.

Brexit had no effect on patents. The European Patent Convention (EPC) and the European Patent Office (EPO) are not instruments of the European Union. The UK remains a full member of the EPC.

European Union Trade Mark (EUTM), Registered Community Design (RCD) and Plant Variety Right (PVR) systems no longer have territorial scope over the UK. In order to obtain protection in the UK, a separate UK Trade Mark/Design/PVR application will need to be filed in the UK. Our trade marks and designs team are able to assist with filing and prosecuting both UK and EU Trade Mark and Design rights, and we also remain able to file both UK and EU PVRs.

A Supplementary Protection Certificate (SPC) is a national right. When the UK was an EU member state, UK SPCs were governed by EU law. At the end of the transition period all EU law relating to SPCs was retained in UK law. For applicants, Brexit had little effect on SPCs.

The withdrawal agreement the UK government and the EU reached resulted in the automatic generation of comparable UK registrations of EUTMs and PVRs and Re-registered designs of RCDs, ensuring continuous protection for rights owners.

The Position in the UK with Regard to EUTM Registrations and Applications and International Trade Mark Registrations designating European Union from 1 January 2021

All EU Trade Mark (EUTM) registrations and protected EU Designations of International Trade Mark Registrations granted prior to 1 January 2021 have resulted in comparable UK trade mark registrations, unless the owner of the EUTM opted out. The UK comparable registration has the same filing, priority and registration date as the parent EU right, but only has territorial effect in the UK.

All pending EUTM applications and pending International Registration (EU) designations as of 31 December 2020 did not result in a UK comparable registration but, where it was possible, to file a UK application before a special priority date of 30 September 2021 in order to retain the EU TM filing date (and any priority date) in the new UK trade mark application.

Representation before the EUIPO and UKIPO from 1 January 2021

All EUIPO matters (pending applications and contentious proceedings) that were in place before 1 January 2021 can remain with UK representatives until they are concluded (including related appeals). Representation for any new matters, including applications, started at the EUIPO from 1 January must be from those on the EUIPO's list of legal or professional representatives. UK representatives were removed from this list on 1 January 2021.

Representation at the UKIPO for any new matters, including new applications, begun after 1 January 2021 must be from a UK (or Channel Islands, Isle of Man and Gibraltar) address for service (save for a few exceptions relating to UK comparable rights, where an EEA representative can remain in place for the next 3 years unless a new matter arises).

Effect of Brexit on contentious proceedings at the UKIPO or EUIPO from 1 January 2021

UK trade mark or unregistered rights, or reputation enjoyed by a trade mark in the UK, will no longer have effect on any pending contentious proceedings at the EUIPO from 1 January 2021, since the UK will not be part of the EU at the date of the decision. Use in the UK up to 31 December 2020 will, however, be counted in non-use revocation proceedings pending or started at the EUIPO from 1 January 2021, as the use made would have been in the EU up until this date. However, it will be of declining importance and will cease to be taken into account in any EUIPO non-use revocation proceedings from 1 January 2025.

Pending contentious proceedings based on EU trade mark rights as at 1 January 2021 will continue at the UKIPO as if under the "old" law. Reputation of an earlier trade mark elsewhere in the EU will continue to be taken into account in such proceedings. Use elsewhere in the EU up to 31 December 2020 will also be counted in non-use revocation proceedings filed against UK comparable rights from 1 January 2021, though will be of declining importance and will cease to be taken into account in any UK non-use revocation proceedings from 1 January 2025.

Practical advice on trade marks

It is now a necessity for clients who wish to have protection in both the UK and the EU to dual file in both jurisdictions. We continue to have the ability both to file EUTMs at the EUIPO via our French entity JAK France Selarl and to file UK trade mark applications at the UKIPO through J A Kemp LLP. We continue to offer a 50% reduction in our service charge for filing in the UK when a corresponding UK case is parallel filed as an EU application or where you or your client already own a corresponding EU application or registration.

Supplementary Protection Certificates (SPCs)

A Supplementary Protection Certificate (SPC) provides an

additional period of protection for patented pharmaceutical products and agrochemicals after patent expiry. A UK SPC is a UK national right, which up to 31 December 2020 was governed by EU law. From 1 January 2021 this ceased to be the case, although equivalent provisions have largely been transposed into UK law. See in particular the Patents (Amendment) (EU Exit) Regulations 2019. Following the end of the implementation period, a UK SPC remains a valid UK IP right, and all existing rights and licences remain in force in the UK. Pending UK SPC applications also continue to be assessed on the same criteria as before and it is possible to file new applications.

The duration of an SPC in the UK is calculated based on the first authorisation to place the product on the market in the territory of the UK or the EEA. The same term of protection as before Brexit thus remains applicable. At present, the SPC manufacturing waiver will apply for export outside of the UK and EU, with stockpiling for sale in the UK or EU permitted within the final 6 months of the SPC term. It is still possible to apply for a 6 month extension to SPCs which protect medicines that have been tested for paediatric use. The same deadline (2 years before SPC expiry) and other conditions apply as previously. The only exception is that it is no longer necessary to provide evidence of authorisations covering the product across the EEA.

Significantly, however, even after Brexit, Northern Ireland (NI) remains subject to EU regulatory laws, whereas the rest of the UK (Great Britain; GB) is free to diverge. Three types of marketing authorisation are therefore possible:

UK(NI) – compliant with EU law, e.g. granted by EMA
UK(GB) – compliant with GB law only
UK – compliant with both

This does not mean separate SPCs. Rather, a single SPC is granted based on whichever NI, GB or UK authorisation the applicant holds when applying. If the SPC enters into force with MA covering only NI or GB, the SPC has the same geographical limit. However, up to entry into force of the SPC (i.e. expiry of the basic patent), the applicant can file additional MAs to make up a complete set and cover the whole UK. In practice, this complexity may not arise for some time. The UK medicines agency (MHRA) has indicated that it intends to recognise EMA marketing authorisations unilaterally in the UK for at least two years from January 2021.

Finally, the significant body of CJEU case law relating to SPCs that existed prior to 31 December 2020 has been directly imported into UK law. Deviation may be possible where a UK court (currently only the Supreme Court) deems that "it appears right to do so". There is no requirement for UK courts to follow new CJEU case law, but they can "have regard to [it] so far as it is relevant". The UK is also in principle free to devise its own, separate SPC regulation, for example to include protection for medical devices or auxiliary substances that are also subject to regulatory approval. However, this is unlikely to be a priority and Northern Ireland considerations will still apply.

Practical advice on SPCs

SPCs remain available post-Brexit on effectively the same terms as before. A product must be protected by a basic patent in force and must be subject to a valid marketing authorisation covering (at least part of) the UK. This must be the first marketing authorisation for the product.

Plant Variety Rights (PVRs)

While the UK was a member of the EU, unitary Community Plant Variety Rights (CPVRs) similar to EUTMs and RCDs covered the UK along with all other EU members. National PVR protection has always also been available in the UK and elsewhere but very few national UK PVR applications were filed while CPVRs were available. Separate, stand-alone PVR protection is however now required in the UK (and the volume of filing has risen accordingly). This takes three different forms depending on timing.

- CPVRs granted more than two months before the UK's EU "exit day", i.e. up to the end of October 2020, have automatically become "comparable rights" in the UK in the same way as for EUTMs and RCDs. For these comparable rights, a UK address for service cannot be required until at least three years after exit day and it is not yet clear whether or not such a requirement will be introduced at that point.
- CPVR applications that were pending on exit day, or that were granted less than two months before exit day (i.e. in the last two months of 2020), were eligible to be re-filed nationally in the UK but maintain their CPVO filing date for novelty purposes. However, this possibility expired six months from exit day, i.e. 30 June 2021.
- In relation to all other varieties, whether pending CPVR applications exist or not, new stand-alone UK applications are required if PVR protection is desired in the UK.

It should often be possible to rely on CPVO DUS tests to secure grant of PVRs in the UK. This is guaranteed for applications filed up to 30 June 2021 and based on pending or recently granted CPVRs, but will also apply in relation to newly filed stand-alone UK applications for the many species for which the UK does not currently have its own DUS testing capacity. A UK DUS test will be required for species for which the UK does have independent testing capability.

At the moment, the UK PVR system does not require payment of renewal fees. However, renewal fees have existed in the past and, in view of the increase in filing volumes, they may be reintroduced at some point in the future.

Practical Advice on PVRs

Comparable Rights derived from CPVRs

J A Kemp is available as a UK address for service for UK PVRs that have come into being automatically as comparable rights. As noted above, a UK address for service cannot be required immediately but we can still record ourselves as one if clients wish. This may be convenient if we will also be filing new applications based on pending or recently granted CPVRs for the same applicants.

New stand-alone UK PVR Applications

Where no CPVR application had been filed before exit day, it has now become a necessity to file PVR applications in both the EU and UK, if protection is required in both jurisdictions. J A Kemp remains able to file in both the UK and the EU through our UK and Paris offices respectively.

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