

The Impact of Brexit on UK and EU Intellectual Property Rights

On June 23, 2016, the United Kingdom (UK) voted to exit the European Union (EU). This leaves many of our clients who own patents and trademarks in the EU wondering how the UK's exit will impact their rights. Neither the UK nor the EU have any legislation in place to address this issue. The good news is that protection in the UK under all EU intellectual property rights will remain in place for now, as the UK will remain a member of the EU until the terms of its EU exit are determined. We expect that over the next two (or more) years, while the UK negotiates the terms of its exit from the EU, the UK will enact legislation to determine how intellectual property rights will be handled.

Patents

Patent protection in the UK may be acquired by obtaining a UK patent either directly through the UK Intellectual Property Office or through the European Patent Office (EPO) by validation of a granted European Patent (EP) specifically in the UK. These options for obtaining patent protection specifically in the UK should not be affected by the UK's exiting the EU, as the EPO is part of the European Patent Organization, which is a separate body from the EU. The EU is also developing an option for obtaining a Unitary Patent (UP) upon grant from the EPO and a Unified Patent Court (UPC) system to enforce UPs in the EU, although such option is not expected to be available until 2017, at the earliest. If and when such UP and UPC systems are made available, the protection provided by a UP would not extend to the UK once the UK has exited the EU. Separate validation of a granted EP specifically in the UK must be separately considered even when obtaining a UP validation for the granted EP.

Trademarks Registered in the European Union (EUTMs, formerly known as CTMs or Community Trademarks)

The EUTM system is available to only EU Member States, so after the withdrawal and negotiation period, the UK likely cannot participate in the EUTM system. The laws and regulations governing EUTMs have no provisions regarding the departure of a country from the EU, so it is unclear whether EUTM rights will be recognized in the newly-independent UK. Further, the UK Intellectual Property Office has issued no guidance on this situation. The future could bring several situations: (a) the UK could recognize all EUTMs or all EUTMs filed and/or registered by a certain date; (b) the UK could require rights holders to "extend" EUTMs to the UK, which could include filing documents with the UK Intellectual Property Office; or (c) while unlikely, EUTMs could no longer be recognized or offered protection in the UK, which would require rights holders to file new applications in the UK.

We expect this issue to gain clarity over the next few years. We will monitor developments and provide recommendations as options develop for maintaining and acquiring trademark and patent protection in the UK.

Should you have questions or concerns, please contact any member of our Intellectual Property Group at 585-232-6500. ■

PRACTICE LEADER

Brian B. Shaw
bshaw@hselaw.com

PARTNERS

Kenneth W. Africano
kafricano@hselaw.com

Jerauld E. Brydges
jbrydges@hselaw.com

F. Paul Greene
fgreene@hselaw.com

John G. Horn
jhorn@hselaw.com

Kimbery I. Shimomura
kshimomura@hselaw.com

Erika N. D. Stanat
estanat@hselaw.com

Jeffrey A. Wadsworth
jwadsworth@hselaw.com

Jon O. Webster
jwebster@hselaw.com

COUNSEL

Andrew J. Anderson
aanderson@hselaw.com

A. Paul Britton
pbritton@hselaw.com

Jodi Reynolds
jreynolds@hselaw.com

ASSOCIATES

Kyra Tichacek Keller
kkeller@hselaw.com

Katherine A. Markert
kmarkert@hselaw.com

Timothy W. Menasco
tmenasco@hselaw.com

Anna J. Oakes
aoaks@hselaw.com

REGISTERED PATENT AGENT

Thomas B. Ryan
tryan@hselaw.com



Harter Secret & Emery LLP

ATTORNEYS AND COUNSELORS

ROCHESTER

1600 Bausch & Lomb Place
Rochester, NY 14604-2711
585.232.6500

BUFFALO

Twelve Fountain Plaza, Suite 400
Buffalo, NY 14202-2293
716.853.1616

ALBANY

111 Washington Ave., Suite 303
Albany, NY 12210-2209
518.434.4377

CORNING

8 Denison Parkway East, Suite 403
Corning, NY 14830-2638
607.936.1042

NEW YORK

733 Third Avenue
New York, NY 10017
646.790.5884