

UNITED KINGDOM: DRAFT STATUTORY INSTRUMENT PROVIDING FOR CONTINUED PROTECTION IN THE UNITED KINGDOM TO DESIGNATIONS OF THE EUROPEAN UNION UNDER THE HAGUE SYSTEM IN CASE OF A NO DEAL BREXIT

The Government of the United Kingdom (UK) has published a draft statutory instrument providing for, amongst other things, continued protection in the UK to industrial designs in international applications and registrations under the Hague System in which the European Union (EU) has been designated. The solutions provided for in the draft statutory instrument will only come into effect on a day the UK effectively leaves the EU (exit day) where the UK leaves the EU without a deal. The draft statutory instrument is available at: <http://www.legislation.gov.uk/ukxi/2019/638/contents/made>.

1. The draft statutory instrument covers the following three scenarios: (i) international registrations in which industrial designs are protected in the EU before exit day; (ii) international registrations which have expired during the period of six months ending on exit day; and (iii) international applications or registrations pending before exit day, including international registrations which have not been published by the International Bureau of the World Intellectual Property Organization (WIPO) before exit day.
2. While there are ongoing negotiations between the UK Government and the EU concerning a possible Brexit deal, the International Bureau of WIPO has prepared, in consultation with the UK's Intellectual Property Office (UKIPO), this explanatory note on the solutions provided for in the above mentioned draft statutory instrument so as to inform users of the Hague System of the way in which their rights will be preserved in the UK, and, in particular, to alert them to any action they would need to take to safeguard their rights in the UK in the event that the UK leaves the EU without a deal.
3. Users of the Hague System should also refer to the guidance that has been published by the UKIPO at: <https://www.gov.uk/government/publications/changes-to-design-and-trade-mark-law-if-the-uk-leaves-the-eu-without-a-deal>. This contains further information on the draft statutory instrument including its practical implications. Users may also wish to view the draft explanatory memorandum to the draft statutory instrument prepared by the UKIPO and available to view at: <https://www.legislation.gov.uk/ukdsi/2019/9780111180037/memorandum/contents>. This describes the general effect of the draft statutory instrument and its impact.
4. In all cases, as from exit day, the designation of the EU in any international application or registration will not cover the territory of the UK.

INTERNATIONAL REGISTRATIONS IN WHICH INDUSTRIAL DESIGNS ARE PROTECTED IN THE EU BEFORE EXIT DAY

5. This scenario applies where before exit day and in respect of the industrial design in your international registration:
 - The European Union Intellectual Property Office (EUIPO) has sent¹ to the International Bureau a statement of grant of protection pursuant to Rule 18*bis* of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (“Common Regulations”); and

¹ This means that the “date of the statement” must bear a date earlier than exit date. The “date of the statement” is indicated in each statement of grant of protection.

– The effects of the international registration have not been declared invalid pursuant to Article 106f of the Council Regulation (EC) No 6/2002 of December 12, 2001 on Community Designs (“Community Design Regulation”).

6. Where this scenario applies, the UKIPO will automatically create a new UK registration for your industrial design at no cost². This new UK registration will be known in the UK as a “*re-registered international design*” or “*comparable right*” and will, as from exit day, be governed by the UK Registered Designs Act 1949.

7. Your *re-registered international design* will benefit from the priority claimed in your international application under Article 4 of the Paris Convention. The date of registration of your *re-registered international design* will be the date of the original international registration. Accordingly, the maximum duration of 25 years provided for in Section 8(2) of the UK Registered Designs Act 1949 will be counted from the date of that international registration.

8. You should renew your *re-registered international design* directly with the UKIPO before the expiry of the current five-year period. For example, on the hypothesis that March 29, 2019, is exit day, if the corresponding international registration is dated May 1, 2014, its renewal is due on May 1, 2019. Thus, you should renew your *re-registered international design* directly with the UKIPO on or before that day³.

9. The UK draft statutory instrument also provides for the possibility of opting-out from obtaining a *re-registered international design*. Opting-out can be achieved under certain conditions by sending a notice to the UKIPO on or after exit day. You are only able to request opt-out up until the first renewal. Once you have given opt-out notice, UKIPO will remove your *re-registered international design* from its Register, and it will be treated as never having been registered under the UK law.

SPECIAL CASE OF INTERNATIONAL REGISTRATIONS WHICH HAVE EXPIRED DURING THE PERIOD OF SIX MONTHS ENDING ON EXIT DAY

10. If you have an international registration protected in the EU that has expired within the six-month period ending on exit day, you will get a *re-registered international design*. However, it will be entered in the UK Register as expired.

11. In such a situation, the only way to give effect to your *re-registered international design* entered in the UK Register is to renew the international registration with the International Bureau of WIPO. If you renew your international registration with the International Bureau of WIPO on or after exit day, benefiting the six-month grace period provided for in Rule 24(1)(c) of the Common Regulations, you must notify the UKIPO (renewal notice) within nine months counted from exit day.

12. Similarly, if the renewal of your international registration was requested but was not published by exit day⁴, you must notify the UKIPO (renewal notice) within nine months counted from exit day.

² This will take place regardless of the fact that both EU and UK have been designated in the international registration.

³ Section 8(4) of the UK Registered Designs Act 1949 provides for a six-month grace period for renewal.

⁴ Your certificate of renewal indicates the International Design Bulletin number through which you will be able to know the publication date of the renewal.

13. Once you give the said renewal notice to the UKIPO, your *re-registered international design* will no longer be treated as expired. Then, where applicable, the next renewal (after five years) of your *re-registered international design* should be requested with the UKIPO.

14. If you fail to give the UKIPO the abovementioned renewal notice within the said nine-month period, the UKIPO will remove your *re-registered international design* from the UK Register.

INTERNATIONAL APPLICATIONS AND REGISTRATIONS DESIGNATING THE EU AND PENDING BEFORE EXIT DAY

15. This scenario applies to industrial designs contained in:

- International applications designating the EU that are pending before exit day;
- International registrations designating the EU which have not been published by the International Bureau of WIPO before exit day (whether their publication has been deferred or not); and
- International registrations designating the EU published by the International Bureau of WIPO but that are not, before exit day, the subject of a refusal under Rule 18 of the Common Regulations or a statement of grant of protection under Rule 18*bis* of the Common Regulations by the EUIPO.

16. Where this scenario applies, you can file an application for the registration of your industrial design in the UK within nine months counted from exit day and benefit from the filing date of your international application and, where applicable, priority date and date of international registration. Your application filed with the UKIPO will then be governed by the UK Registered Designs Act 1949.

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