

Brexit: EU Designs Checklist

UPDATED (22 January 2020): if the Withdrawal Bill is passed in the UK and the Withdrawal Agreement entered into between the UK and EU, the various changes detailed below will take place at the end of the implementation period (currently expected to be 31 December 2020) – not at the end of January 2020.

**Existing Registered Community Designs (RCDs) and UK comparable/re-registered design**

	<b>Registered Community Design (RCD)/ International Design designating the EU (EU designation)</b>	<b>UK comparable/re-registered design</b>	<b>UK Design Registration (no change unless set out, below)</b>	<b>Check list - consider prior to Exit Day</b>
<b>On Exit Day</b>	RCD International Design continues to apply to the EU27	<p>A new UK domestic design registration comes into existence (“UK comparable design” or “UK re-registered design”).</p> <p>This registration replicates the rights under the RCD or EU designation in the UK and it is treated as if it had been applied for and registered under UK law.</p> <p>The UK comparable design will be independent from the original EU right (it can be challenged, assigned, licensed, renewed separately).</p>		31 December 2020
<b>Territorial scope of protection</b>	Protection in the EU27 only. Protection for the territory of the UK and related UK territories will cease.	Protection is for the territory of the UK, only.		

	<b>Registered Community Design (RCD)/ International Design designating the EU (EU designation)</b>	<b>UK comparable/re-registered design</b>	<b>UK Design Registration (no change unless set out, below)</b>	<b>Check list - consider prior to Exit Day</b>
		This includes the Isle of Man (Registered Designs and Trade Marks (Isle of Man) (Amendment) (EU Exit) Order 2019)		
<b>Priority</b>		The design will retain its EU priority/filing date.		
<b>Formalities</b>	None.	No formalities for the design owner known at this stage; the UK right will be created automatically. Notifications will be sent to RCD owners advising them of the re-registered UK right.		Confirm that contact details registered with the EUIPO are up-to-date.
<b>Fees</b>	None.	None.		
<b>Proof of design registration</b>	RCD Certificate	None. Details of the design will be accessible on the UKIPO database in due course.		
<b>Opt-out option</b>		It is possible for design owners to opt out of owning a UK re-registered design. Opt out is only possible after Exit Day.  The UK re-registered design will be treated as if it had never been filed or registered under UK law.		Review agreements to ensure that there are no limitations on ownership of a UK registered design.

	Registered Community Design (RCD)/ International Design designating the EU (EU designation)	UK comparable/re-registered design	UK Design Registration (no change unless set out, below)	Check list - consider prior to Exit Day
		<p>Opt out is not available</p> <ul style="list-style-type: none"> <li>- if the re-registered design is subject to an assignment/licence/other agreement;</li> <li>- if the re-registered design is subject to litigation.</li> </ul>		
<b>Renewal</b>	<p>Renewal fees paid <i>prior</i> to Exit Day will only cover the UK re-registered design if the renewal date is before Exit Day.</p>	<p>If the RCD renewal date falls <i>after</i> Exit Day then the renewal fee has to be paid to the UKIPO.</p> <p>The UK re-registered design retains the renewal date of the corresponding RCD but fees have to be paid separately for the RCD (to the EUIPO) and for the UK re-registered design (to the UKIPO).</p> <p>The UKIPO will send the renewal notice on the actual day of expiry or even afterwards. There will be an additional time period during which a design can be renewed late.</p>		<p>Ensure renewal fees are paid to the correct Office.</p> <p>Confirm that contact details registered with the EUIPO are up-to-date.</p>

	Registered Community Design (RCD)/ International Design designating the EU (EU designation)	UK comparable/re-registered design	UK Design Registration (no change unless set out, below)	Check list - consider prior to Exit Day
<b>Records of licences, security interests, assignments</b>		<p>Licences, security interests, assignments will be treated as if they applied to the UK re-registered design and retain their legal effect in the UK.</p> <p><i>Design right owners may have to inform licensees of the UK re-registered designs.</i></p> <p>Licences' security interests registered with the EUIPO are <b><i>not automatically registered</i></b> with the UKIPO.</p> <p>Such transactions must be registered within <b><i>12 months of Exit Day.</i></b></p>		<p>Check whether any EU rights are affected by licences, security interests, assignments.</p> <p>Inform licensees of new UK re-registered designs.</p>
<b>Earlier Rights</b>	<p>From Exit Day. EU rights can <b><i>no longer</i></b> be enforced against UK rights.</p> <p>From Exit Day, UK rights can <b><i>no longer</i></b> be enforced against EU rights.</p>	UK re-registered designs cannot be enforced against EU rights.	From Exit Day, UK rights can <b><i>no longer</i></b> be enforced against EU rights.	

	<b>Registered Community Design (RCD)/ International Design designating the EU (EU designation)</b>	<b>UK comparable/re-registered design</b>	<b>UK Design Registration (no change unless set out, below)</b>	<b>Check list - consider prior to Exit Day</b>
<b>Cancellation proceedings</b>	<p>Pending EU cancellation proceedings which are based on earlier UK rights, only, will be dismissed.</p> <p>Each part}' will be ordered to pay their own costs.</p>	<p>EU cancellation actions pending on Exit Day will have to be re-filed in the UK against the UK re-registered design.</p>	<p>UK cancellation actions based on earlier EU registered rights will continue. The law applicable prior to Exit Day applies.</p>	<p>Consider whether pending EU cancellation actions will have to be re-filed in the UK.</p>
<b>Pan-EU injunctions</b>	<p>New pan-EU injunctions will only apply to the EU territory (not in the UK).</p>	<p>Pan-EU injunctions existing on Exit Day will be treated as if they applied to the re-registered UK design.</p>		

## Pending Community Design Applications

	Community Design Application/ ER designating the EU - pending designation (EU designation)	UK comparable design	UK Design Application (no change unless set out, below)	Check list - consider prior to Exit Day
<b>On Exit Day</b>	Community Design Applications EU designations continue to apply to the EU27. The Community Design Application EU designation will no longer extend to the UK and its related territories.			31 December 2020
<b>Action to be taken</b>		<i>A new UK design application has to be filed.</i>  Details of the UK design application must match those of the corresponding Community Design Application to qualify for the earlier filing date.		Consider filing new UK designs corresponding to Community Design Applications' pending EU designations.
<b>Timing</b>	None.	<i>Within 9 months of Exit Day.</i> Owners of Community Design Applications will not be notified of the 9-month window by the UKIPO.		
<b>Fees</b>	None.	Standard UK Design filing fees.		

	<b>Community Design Application/ ER designating the EU - pending designation (EU designation)</b>	<b>UK comparable design</b>	<b>UK Design Application (no change unless set out, below)</b>	<b>Check list - consider prior to Exit Day</b>
<b>Priority</b>		The new filing claiming ‘priority’ from a Community Design Application will retain its EU priority/filing date.		
<b>Examination</b>		The application will be examined as if it had been filed as a UK domestic design application.		
<b>RCD: Deferred publication</b>	An RCD that is deferred on Exit Day will be treated like a pending application.	A new UK application will need to be filed (within 9 months of Exit Day.)  The new application will not be subject of a substantive examination (the EUIPO already examined it).		Check deferment period.
<b>UK registered design: deferred publication  Earlier RCD dates are retained</b>		The UK deferment period will need to be calculated.  There is currently no legal framework for deferment in UK legislation but the IPO permits deferment by up to 12 months.		Check deferment period.

	<b>Community Design Application/ ER designating the EU - pending designation (EU designation)</b>	<b>UK comparable design</b>	<b>UK Design Application (no change unless set out, below)</b>	<b>Check list - consider prior to Exit Day</b>
<b>UK registered design: deferred publication</b>  <b>Earlier RCD dates not retained</b>		<p>Application for deferment of publication in the usual manner.</p> <p>There is currently no legal framework for deferment in UK legislation but the IPO permits deferment by up to 12 months.</p>		<p>Check deferment period.</p>

## Unregistered design right

	<b>EU Community unregistered design</b>  (EU CUD)	<b>UK comparable unregistered design – new</b>  (UK CUD new)	<b>Supplementary unregistered design</b>  (SUD)	<b>UK unregistered design</b> (no change unless set out, below)  (UK CUD old)	<b>Check list - consider prior to Exit Day</b>
<b>On Exit Day</b>	EU CUD continues to apply to the EU27. The EU CUD will no longer extend to the UK and its related territories.	A new UK CUD comes into existence (“UK comparable unregistered design”).  This design replicates the rights the EU CUD used to have in the UK.  The UK CUD will be independent from the original EU right.			31 December 2020
<b>Qualifying design</b>	3- and 2-dimensional designs.	Identical to EU CUD.	3- and 2-dimensional designs.	Shape and configuration of 3- dimensional designs.	
<b>Territorial scope of protection</b>	Protection in the EU27 only. Protection for the territory of the UK and related UK territories will cease.	Protection is for the territory of the UK, only.	Protection is for the territory of the UK, only.		

	<b>EU Community unregistered design</b>  (EU CUD)	<b>UK comparable unregistered design – new</b>  (UK CUD new)	<b>Supplementary unregistered design</b>  (SUD)	<b>UK unregistered design</b> (no change unless set out, below)  (UK CUD old)	<b>Check list - consider prior to Exit Day</b>
<b>Coming into existence</b>	Disclosure in the EU27.		Disclosure in the UK (or any other qualifying country - e.g. in the EU should a future agreement with the EU provide so).	Currently: disclosure in the EU but outside the UK can be sufficient.  After Exit Day: disclosure in the UK (or qualifying country.)	Ensure disclosure of the design in the correct territory.
<b>Period of protection</b>	3 years.	Remainder of the 3-year term.	3 years.	15 years from the end of the year in which the design was first recorded or an article made.	