

## **Design Patent Registrations after Brexit and Updates to Design Rights in China**

Article By:

Michael D. Van Loy, PhD

Joshua D. Berk

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As we noted in [Are Design Patents Missing From Your IP Portfolio](#), a design patent protects the visual ornamental characteristics of an article and can be an important part of a company's patent portfolio. Like other patent rights, design patent applications may be filed internationally to expand the number of countries in which a company's designs are protected.

Determining where to obtain protection for a company's designs generally depends on a number of factors, such as where products featuring the designs are being sold, planned to be sold, or likely to be copied, where competitors are located, where products featuring the designs are manufactured, and the local patent requirements. Regardless of these considerations, obtaining protection in Europe and China can be valuable for a company looking to expand the breadth of protection for its designs. Thus, it is important to be aware of some of the recent changes to design laws in those jurisdictions.

### **Design Protection in Europe after Brexit**

To obtain protection for designs in Europe, companies generally have two main options: (1) file a Registered Community Design ("RCD"); and (2) file separate design patent applications in individual jurisdictions. RCDs are generally the more popular option due to various advantages, including that they provide a single registration that covers all countries that make up the European Union. With Brexit, however, the protection offered by RCDs has changed.

The United Kingdom officially left the European Union as of January 31, 2020 and entered an 11-month transition period that ended on December 31, 2020. Importantly, as of January 1, 2021, RCDs no longer cover the UK. Unfortunately, this means that the costs associated with registering designs across all of Europe, including the UK, will increase for both new filings and for companies that had originally filed only an RCD.

For example, companies looking to protect a design through registration in both Europe and the UK will now need to file both a RCD and a UK design application. As a result, there will be an increased cost to file and obtain protection in both the European Union countries and the UK.

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For any RCD that is already registered, the UK Intellectual Property Office (“UKIPO”) will automatically create a corresponding “cloned” UK design registration. A cloned UK registration created in this manner keeps the original filing and priority date of the original RCD, and forms a fully independent UK design registration that can be challenged, assigned, licensed, or renewed separately from the original RCD. A cloned UK design registration based on a RCD will be allocated a number consisting of the full registration number of the RCD, prefixed with the digit “9.”

Although the cloned UK design registration is created at no cost, annuities will be due and payable to the UKIPO to remain in force. If a company already has a UK design registration for the same design, it may choose not to pay the annuities for the cloned UK design registration, resulting in termination of the cloned UK design registration. Companies should carefully consider whether their cloned UK design registrations are identical to their already pending UK design registrations, and whether their cloned UK design registration would add any alternative protection.

While the UKIPO will now create a cloned registration for RCDs that are already registered, the UKIPO will not automatically create a cloned UK design registration for any RCD that is still pending or otherwise not registered as of January 1, 2021. Instead, companies seeking protection in the UK based on a pending RCD are required to re-file the design application with the UKIPO by September 30, 2021. It is important for companies to pay attention to these deadlines to achieve their desired level of protection in Europe.

## **Recent Updates to Design Protection in China**

Europe is not the only jurisdiction bringing changes to its design patent laws in 2021. Approved on October 17, 2020 and effective June 1, 2021, the China Congress passed the Fourth Amendment to the Chinese Patent Law to strengthen the protection for design patents in China. As noted in Mintz’s [Overview of USPTO Webinar: Understanding Patenting in China](#), the Fourth Amendment extends the design patent protection term from 10 years to 15 years in addition to permitting protection of partial designs and making design patent applications available for domestic priority claims within six months of their filing date.

Not only does the extended patent term strengthen the protection of designs in China, but it also moves China closer to joining the Hague Agreement, as it will become aligned with the design patent term provided by many other jurisdictions and the requirements of the Hague System. Joining the Hague Agreement will also allow China to be designated as part of an international design application under the Hague System. In some instances, this approach may provide a more cost effective and streamlined way to obtain design patent protection in China. Companies will still need to consider local drawings requirements when filing an international design application under the Hague System.

Again with the theme of harmonization, permitting protection of partial designs aligns the scope of protection provided by many other jurisdictions. It also expands the scope of protection provided by design patents in China, as protection may be obtained for components or portions of an overall device or product. Additionally, protection may be obtained for designs that are not necessarily tied to a specific product—for example, graphical user interfaces may no longer be required to be tied to a specific phone, tablet, or computer. These changes to the Chinese patent law contribute to a strengthened and more valuable design right in China. As a result, companies should carefully craft their design patent strategy to obtain the appropriate level of design protection in China.

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