

## **DRAFT PROPOSED FORM TO BE SUBMITTED ON BEHALF OF THE IPLA IN RESPONSE TO THE UK CONSULTATION REGARDING ADDRESS FOR SERVICE**

### **Address for Service: Call for views**

Current rules say that an application for a patent, trade mark or design must include a correspondence address, or 'address for service' (AfS). This must be within the UK, the European Economic Area (EEA), or the Channel Islands. Similar rules also apply for other proceedings before the Office.

The Transition Period (TP) relating to the UK's exit from the European Union (EU) ends on 31 December 2020. At that point the UK will no longer be treated as if it is a member state of the EU. EU laws governing rights of representation before the EU Intellectual Property Office (EUIPO) will not apply to UK IP representatives. Under the Withdrawal Agreement, UK trade mark attorneys will no longer have rights of representation before the EUIPO, except for actions pending at that date. These arrangements raise questions about whether the EEA AfSs should continue to be permitted before the IPO.

**The IPO is now proposing to amend the AfS rules to remove the reference to the EEA. This would apply to patents, trade marks, registered and unregistered designs. The rule changes would permit AfSs only if they are in the UK or Channel Islands (for ease, referred to as 'UK' below).**

The rule changes will apply to certain actions received after the end of the TP. These actions are: filing applications, requests for hearings and requests to start potentially contentious proceedings. Any party to those proceedings must also provide a UK AfS.

The changes will not apply to applications or actions pending before the IPO at the end of the TP, where an EEA AfS has been provided before the end of the TP.

The changes will not apply immediately to 'comparable rights' or re-registered designs. These are trade marks and designs which are on the EUIPO's register when the TP ends, and which are copied to the UK IPO's register. A UK AfS will not be required for these rights or designs until 3 years after the TP. This is in line with Article 55(2) of the [Withdrawal Agreement](#). This applies even if proceedings are initiated against them.

The rules we are proposing to amend are:

- **Rules 23 and schedule 1 of the Design Right (Proceedings before Comptroller) Rules 1989.**
- **Rule 103 of the Patents Rules 2007.**
- **Rule 42 of the Registered Design Rules 2006; and**
- **Rule 11 of the Trade Mark Rules 2008.**

We will also need to amend the forms, most of which can be amended by directions.

Any legislative change may come into force as soon as the TP ends. This is however subject to the Parliamentary timetable.

To note that this call for views is specifically about AfS requirements. It does not cover rights of representation. Most applicants for patents choose to appoint a representative. Many applicants for both trade marks and designs do not. We are not proposing to change this situation.

**Please provide your details below.**

* Full name	<input type="text" value="Peter Robert Brownlow"/>
Company name	<input type="text" value="Intellectual Property Lawyers Association"/>
* Email address	<input type="text" value="peter.brownlow@twobirds.com"/>

**\* Where are your offices located? (Please select all that apply).**

- UK
- EU/EEA
- Rest of world

**\* What is your relationship with the IPO?**

- You represent your own IP
- You represent your client's IP
- You represent your employer's IP
- A professional representative body

**\* What areas of IP does your business operate in? (Please select all that apply)**

- Patents
- Trade marks
- Registered designs
- Unregistered designs

**\* How many people does your business employ?**

- I'm the only employee
- 2 – 10
- 11 – 49
- 50 – 249
- 250+

Prefer not to say

I don't know

\*

When the Transition Period ends on 31st December 2020, UK representatives will no longer be able to act before the EUIPO.

**\* How supportive are you of the general proposal to amend the AfS rules for applications to the UK IPO by removing reference to the EEA?**

Very supportive

Supportive

Neutral

Not very supportive

Not supportive at all

**Please explain your answer**

The Intellectual Property Lawyers association represents UK law firms who advise on intellectual property law including trade mark filing and advice. We strongly support this change which is vital in protecting the work of our member firms and maintaining the expertise of UK IP lawyers. It will help provide a level playing field between UK and EEA practitioners and ensure the UK legal profession can remain competitive.

As previously indicated, the rules we are proposing to amend are:

- **Rules 23 and Schedule 1 of the Design Right (Proceedings before Comptroller) Rules 1989.**
- **Rule 103 of the Patents Rules 2007;**
- **Rule 42 of the Registered Design Rules 2006; and**
- **Rule 11 of the Trade Mark Rules 2008.**

We will also need to amend the forms, most of which can be amended by directions.

**Please indicate any other rules you recommend we should consider.**

NONE

**\* Overall, what impact do you believe the change to the AfS rules will have on your business?**

Very positive

Positive

No impact

Negative

Very negative

I don't know

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Please explain your answer.

The Intellectual Property Lawyers association represents UK law firms advising on intellectual property law which includes filing UK trade marks and trade mark advice generally. The change to the AFS rules will help ensure a level playing field between UK and EEA practitioners and protects jobs in the British legal industry. Without this change the UK would leave open the doors to EEA practitioners by allowing those attorneys unrestricted access to the UKIPO whilst UK attorneys will have lost their rights to appear before the EUIPO.

**If you currently have ongoing cases with a non-UK AfS, how many are you likely to change to a UK address?**

**Patents** None 1-10 11-20 21-50 51-100 100+ N/A I don't know

**Trade marks** None 1-10 11-20 21-50 51-100 100+ N/A I don't know

**Designs** None 1-10 11-20 21-50 51-100 100+ N/A I don't know

The rules changes will not apply to comparable rights for a period of 3 years after the end of the transition period, in line with Article 55(2) of the Withdrawal Agreement. We are considering what transitional provisions are necessary.

**What transitional provisions do you believe should be included?**

- A period of three months from the end of the transition period would be sufficient for any existing applicant or registered right holder to provide a UK AfS.
- We propose that any new applications filed after the end of the transition period must be required to provide a UK AfS.
- We would also recommend that a UK AfS should be required for any contentious proceedings relating to a comparable right
- At the end of the three year period for comparable rights which have not been involved in contentious proceedings a UK AfS should be provided.

**Do you believe the provision of a contact email address should be a statutory requirement?**

Yes

No

I don't know

**Please explain your answer.**

Provision of a contact email address should be a statutory requirement in order to ensure that Applicants and their representatives can be fully informed of any changes to their rights and/or receive third party notifications relating to those rights. In our opinion this is necessary to avoid unnecessary delays and uncertainty in proceedings before the UKIPO and Courts, which inevitably leads to increased costs. The current COVID crisis demonstrate the importance and necessity of reliable electronic communication.

**To what extent do you agree that the address for service, for EP patents designated in the UK, should remain as the representative registered at the EPO instead of the patent owner?**

- Agree
- Somewhat agree
- Somewhat disagree
- Disagree
- I don't know

**Please explain your answer.**

The default Address for Service should remain as the patent owner's address (as per current practice). The EPO representative could be based anywhere in Europe and may not be authorised to accept service in the UK. The patent owner should be required to nominate a UK-based representative as address for service, unless the owner has a UK presence.

**Do you have any further comments on this proposal? Please explain below**

Clarification on changes to UK Address for Service rules shortly after the close of this call for views is really important in order to allow firms time to prepare and implement any necessary changes on behalf of clients.