



Intellectual Property in the UK

A Guide for ASEAN Business

The Association of Southeast Asian Nations (ASEAN) is a growing economy, currently ranked as the 7th largest economy in the world. Foreign direct investment (FDI) inflows into Asia reached US\$440 billion in 2013. UK-ASEAN trade, investment and technology cooperation is expanding rapidly alongside this, creating new business opportunities for companies from both countries. Two way flows of trade are important for all our economies.

The UK has an advanced and sophisticated IP legislative framework that has recently scored very highly in several assessments of IP environments ([Taylor Wessing 2013 IP report](#) and [GIPC 2014 Report](#)); the Intellectual Property Office (UK IPO) covers both rights granting for patents, trade marks and design rights, and leads on IP policy for all IP rights, including copyright. Businesses can enforce their IP rights in the UK through the UK court system, local government Trading Standards divisions and border measures.

The UK and the European Union IP systems

The UK is a member state of the EU. This enables companies to obtain IP protection at a national-level through the UK IPO or at EU-level (also enabling access to protection in other EU member states). The most appropriate choice for companies will vary depending on the business.

Both the UK and the EU are signatories to most major international IP treaties and conventions, [meaning that IP rights can be applied for through the Patent Cooperation Treaty (PCT), Madrid Protocol and other international routes].

When considering how to obtain IP protection in the UK and the EU it is strongly advised to discuss your strategy with an experienced IP attorney or other specialist service provider. UK attorneys can advise on the most appropriate strategy and directly prosecute patents, designs and trade marks through both the UK and European application channels. Attorneys can be located via search functions on the websites of the [Chartered Institute of Patent Attorneys](#) (CIPA) or the [Institute of Trade Mark Attorneys](#) (ITMA).

Patents

A patent can be granted in the UK for something that is inventive, new and useful. Applicants must not publicly reveal inventions before they apply for a patent in the UK.

Applicants can apply for patents in three ways

- 1) Directly at the **UK IPO**. The full process can take several years, but the UK IPO may try to provide the applicant with an initial search report within months. If certain circumstances are met, it is possible to speed up certain aspects of the application process.
- 2) Through the **European Patent Office (EPO)**. These applications are processed as a single application, but upon grant result in a bundle of national patents that cover specified territories. Note that there is no single patent which provides protection across the entire EU. Designating the UK will result in a patent covering the UK. Renewal fees for this patent will be paid to the UK IPO and enforcement taken through the UK courts. EPO fees vary depending upon

circumstances and are explained on their website: www.epo.org.

- 3) Via the **Patent Cooperation Treaty (PCT)** where a single application filing requests protection in a number of territories. The initial filing fee stands at CHF1330 (approx. £942) with certain deductions for e-filing. At the end of the international phase of a PCT application an applicant can enter the national phase in the UK and/or the regional phase at the EPO in order to gain patent protection in the UK.

Once granted a patent covering the UK can give protection for up to 20 years from the filing date of the application, provided the appropriate fees have been paid to the UK IPO.

Designs

In the UK has several types of design right protection. Successful registrations will be granted for new designs with an individual character. Examiners look at technical function, morality and protected emblems. If no objections or questions are raised an application will usually be registered within 4 weeks. Application fees at the UK IPO are £60 for a single design.

Registered design protection can also be obtained for all 28 EU countries – including covering the UK – by way of a single application to the Office for the Harmonisation in the Internal Market (OHIM).

A UK registered design can last for 25 years and must be renewed every five years (including payment of a renewal fee).

In certain circumstances both the UK and EU provide automatic protection for unregistered designs. However, the level of protection is lower than for registered designs. To be eligible for unregistered design protection in the UK there must be a “connection” with the UK or EU (e.g., residency, business formation etc) and/or be “known” (e.g., through trading or selling).

Trade Marks

Applicants can apply for trade marks in three ways

- 1) Directly at the **UK IPO**. Single class electronic application fees are £170. Paper application fees are £200 with a fee of £50 for each additional class. Examination reports are usually sent to the applicant within 15 days of the filing date and marks without oppositions or objections from the examiner will normally be registered in 16 weeks.
- 2) Through OHIM for trade mark rights covering the UK and other EU Member States. OHIM applications can be made online in one of the 23 official languages used in the EU (including English – which is also an official operating language of OHIM).
- 3) Via international registration under the Madrid Protocol.

Mechanisms for oppositions and post-registration reviews are available both in the UK and through OHIM. In the UK opposition and post-registration procedures can be appealed to an “appointed person” (experienced legal practitioners that the parties agree can resolve their dispute without resorting to further legal action) or through the courts.

UK law also provides some protection to unregistered trade marks through the principle of “passing off”. Here a business may be able to stop someone using a similar trade mark to theirs on other goods and services without formal registration of a trade mark. Passing off cases can be more difficult to defend than a registered trade mark. In order to be successful you will need to show the court that the mark is yours, that you’ve built up a reputation in the mark and that you’ve been harmed in some way by the other person’s use of the mark.

Copyright

There is no official registration mechanism for copyright in the UK. Protection is available but it will vary according to the type of copyright work. Certain exceptions and limitations to copyright have been outlined by UK and EU law. These allow use without the copyright owner’s permission in specific and limited circumstances. Protection of copyright will be subject to these limitations and exceptions. But commercial uses

of works will usually require permission from the rights owner and often payment of license fees to a company, individual or collective rights management organisation (or “collecting society”).

Enforcement

Infringement of IP rights in the UK can be subject to civil or criminal penalties. Businesses have several options for enforcing IP rights, including:

- **Civil litigation:** The type of court will depend on the size of the claim. The specialist *Intellectual Property Enterprise Court* (IPEC) hears most IP cases in the England & Wales. A small claims track exists for lower value claims. The *High Court* hears larger and more complex cases. Courts can award injunctions and damages, and order the losing party to pay reasonable costs incurred by the other side.

There is no automatic right of appeal to first instance decisions. Decisions can be appealed to the *Court of Appeal* and the *UK Supreme Court* if a judge grants permission. Scotland has a separate court system to the rest of the UK.

- **Trading Standards & criminal enforcement:** Trading Standards are officials working for local government and support on consumer law. They also act against infringement of IP rights. Trading Standards are part of the criminal justice system and have powers to directly prosecute cases through the criminal courts. Other UK agencies responsible for IP crime enforcement include police forces and the National Crime Agency (for organised crime).

Most criminal sanctions are made against trade mark and copyright infringement where there has been commercial gain from the infringement. Criminal sanctions have recently been introduced for intentional copying of a registered design right. There are no criminal sanctions for patent infringement. Criminal offences may lead to sentences of up to 10 years in prison, as well as awards of damages and confiscation orders.

- **Border enforcement:** Detentions of suspected IP-infringing goods at UK borders is available for rights owners provided they [record their trade marks](#) with the relevant EU authorities. UK border enforcement cannot detain products coming from other EU Member States but only goods entering the UK from outside the EU.
- **UK IPO opinions service:** The UK IPO provides a non-binding opinion on patent validity and infringement. An IPO opinion is an independent assessment of the main issues in a dispute, prepared by a senior examiner. This opinion can help to negotiate a settlement or decide whether to proceed with full legal proceedings. IPO opinions do not award damages but can lead to the revocation of a patent considered invalid. Reviews of opinion decisions are possible in some cases.
- **Non-official & informal enforcement channels:** These include online take-down procedures provided by e-commerce platforms and other websites; cease-and-desist letters (which should only be sent following advice from qualified legal professionals); and arbitration based on dispute resolution clauses in contracts.

Every effort has been made to ensure that the information provided is accurate, however we accept no responsibility for any errors, omissions or misleading statements in this factsheet. This information should be used as a guide only. It should not be used as a substitute for direct professional advice.

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