

Transfer of Patents, Trade Marks and Designs

If you have acquired or transferred intellectual property rights, e.g. patents, trade marks and/or designs, you should be aware that there are various registers in which the proprietor(s) of these rights should, in most cases, be recorded. It is in your interests to make sure that you are now substituted as the registered proprietor.

Under the laws of most jurisdictions, the transfer of a patent or patent application or a registered trade mark or trade mark application from one proprietor to another should be recorded without delay in order to secure the title of the new proprietor against third parties. If a transfer is not recorded then a third party "without notice" could obtain conflicting rights in the intellectual property. Furthermore, **in the UK**, unless the transfer is recorded **within six months** of the transfer taking place, the costs recoverable by the new proprietor in any subsequent infringement action will be reduced in the following manner.

If a transfer is recorded within six months of the transfer taking place, the new proprietor will be able to apply for his costs in proceedings for all infringement occurring after the date of transfer. If the transfer is *not* recorded within six months of the date of the transfer, the new proprietor will only be able to apply for costs in proceedings for infringement occurring after the date of recordal of the transfer.

Many other countries also have penalties for late recordal of transfers.

It is important to record the transfer of a European patent application at the EPO before grant and also to record the transfer of a PCT application at WIPO before entering the national/regional phase in order to avoid the very substantial costs of recording the transfer separately at the national or regional patent offices of each of the designated jurisdictions.

It is often not possible for us to file a request for recordal of a transfer immediately we receive the transfer document. Issues such as consideration and stamp duty often have to be resolved before we can file the request for recordal. It is therefore important that you send transfer documents to us for recordal *as soon as possible* after the transfer has taken place.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com. Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

London
33 Gutter Lane
London
EC2V 8AS
Tel: 020 7776 5300
Fax: 020 7776 5399

Bristol
22-24 Queen Square
Bristol
BS1 4ND
Tel: 0117 945 1234
Fax: 0117 926 5692

Manchester
Bridgewater House
Whitworth Street
Manchester M1 6LT
Tel: 0161 247 7722
Fax: 0161 247 7766

Cambridge
Newnham House
Cambridge Business Park
Cambridge CB4 0WZ
Tel: 01223 420383
Fax: 01223 423792