

### 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 and other intellectual property matters, please contact us or visit our website at [www.mewburn.com](http://www.mewburn.com).

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