



((O)) **APRAM**

BREXIT : CONSEQUENCES ON TRADE MARKS AND DESIGNS

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BACKGROUND

- United Kingdom left the European Union on 31 January 2020
- United Kingdom is now in a ‘transitional period’ until **31 December 2020**
- Changes from 1 January 2021 (exit date) affect Trade Marks and Designs
- Other IP rights largely unaffected



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REGISTERED TRADE MARKS

- From exit day, all registered EUTM/ IR(EU) will be treated as if they have been applied for and registered under UK law



All registered EUTM/ IR(EU) will be cloned onto the UK Register as a comparable UK trade mark right

- Comparable rights will be recorded onto the UK Register automatically with no official fee payable
- Newly created rights will retain the same filing date as recorded against the corresponding EUTM/IR and any priority and/or seniority dates
- No need to update address for service



REGISTERED TRADE MARKS

- UK IPO will not issue registration certificates for newly created rights but details of the marks will be accessible on UK IPO website
- Newly created rights will retain same registration number as corresponding EUTM prefixed with 'UK009' ('UK008' for EU International designations)

i.e. EUTM N° 017867542 → UK00917867542
IR(EU)N° 00025197 → UK00800025917

- UK IPO will use English version of specifications of goods/services appearing on EUIPO Register

→ If English is neither first/second language of the EUTM, the owner of the newly created right will be able to request correction of any translation errors



INTERNATIONAL TRADE MARKS

For EU designations of International marks:

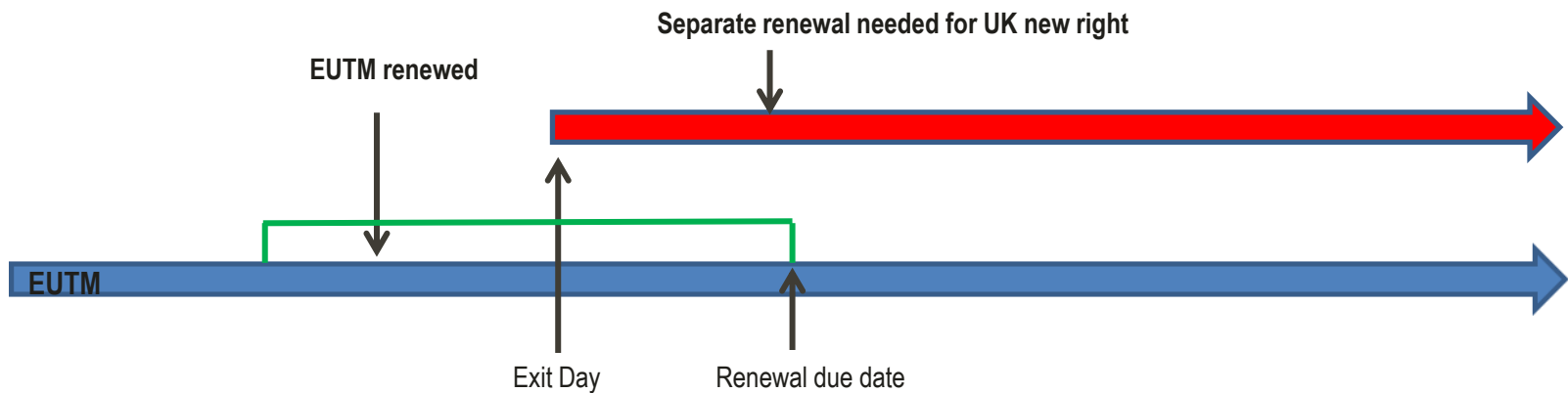
- the comparable right cloned onto the UK Register will be a UK national mark and **not** a UK designation of an International mark (NB: possibility of replacement of national right by IR designation)
- date of EU subsequent designation will be date for calculating next renewal
- could be several EU designations from the same International registration





RENEWALS

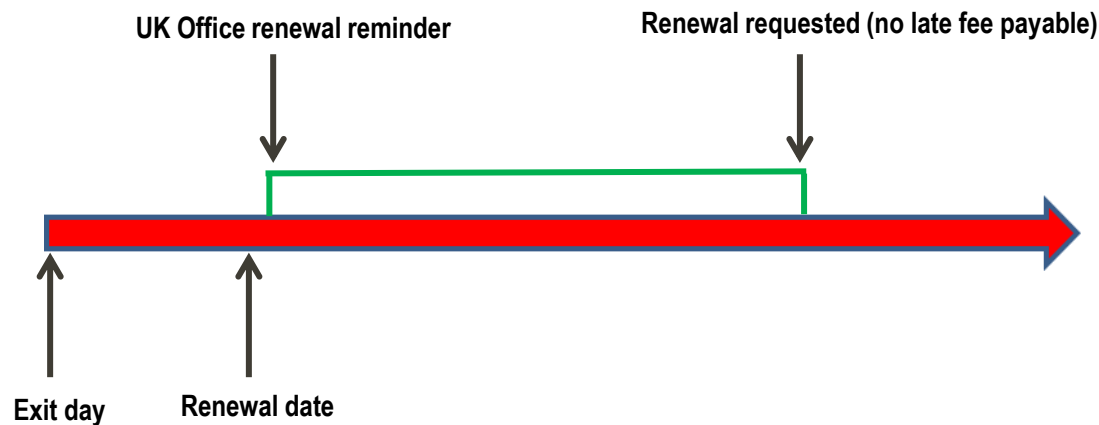
- The newly created right must be renewed separately
- If renewal of new UK right falls after exit day, it will be subject to separate renewal in the UK even though the corresponding EUTM/IR may have already been renewed in the 6 months prior to renewal date





RENEWALS

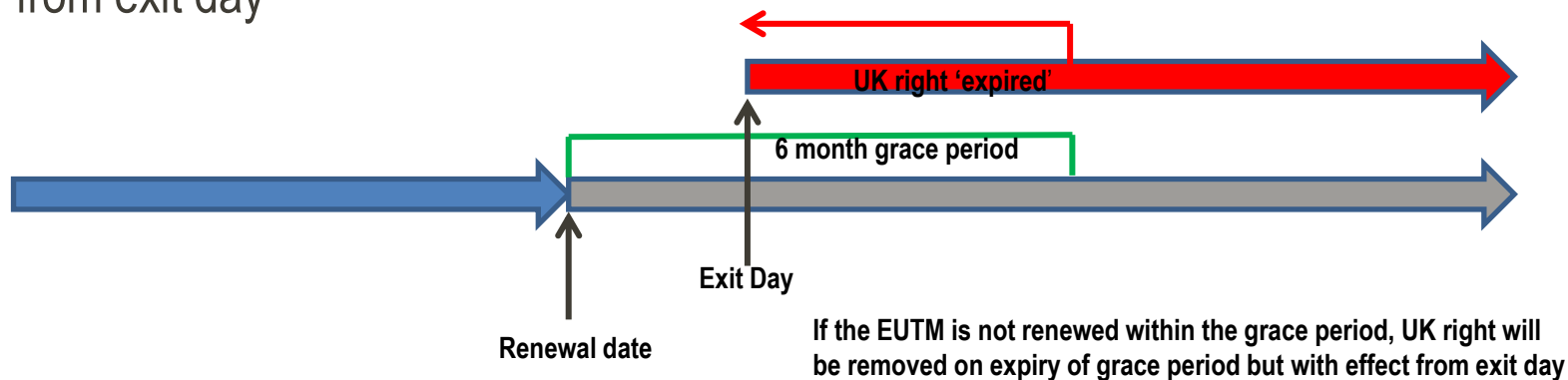
- For renewals of new UK rights that fall within 6 months after exit
 - UK IPO will send a renewal reminder on expiry date
 - Renewal may be made during 6 months from date the reminder is sent
 - No late renewal fee will be payable to UK IPO





RENEWALS

- EUTMs (or IR designating EU) that have expired prior to exit day but may still be late renewed in the 6 month grace period: will also be cloned onto the UK Register but marked 'expired'
- their continued effect will be dependent on late renewal of the corresponding EUTM/IR
- in the absence of late renewal of the EUTM/IR, the comparable UK right will be removed from the UK Register on expiry of the late renewal period but with effect from exit day





RECORDALS

- Rights that have been assigned, but for which the recordal has not been made before the EUIPO/WIPO will result in the cloned right being created in the name of the assignor
→ *record assignments before exit date*
- Ensure correct details on EU Register prior to exit (name, address, legal form)
- Recordal of licences and security interests will be required before the UK IPO within 12 months from exit day as these will not be carried over automatically from the EU Register





OPT OUT



- Possible to **opt-out** of holding the comparable UK right by submitting a notice to the UK IPO after exit
- But **not available** in cases where the comparable right has been:
 - assigned or licensed
 - is the basis for litigation
 - used in the UK
- Notify any affected parties



NON USE / REPUTATION

- Use made of a mark anywhere in the EU prior to exit day will be considered to include use of the comparable right in the UK
- Evidence relating to use of an EUTM in the UK prior to exit will be relevant to maintain the rights in the EUTM
- The significance of that use for the overall assessment of genuine use in the EU will progressively decrease – from potentially sufficient to entirely irrelevant
- A similar approach will be taken in relation to reputation BUT use in the UK before exit will **not** support EU reputation





PENDING APPLICATIONS

- From exit day, applicants of pending EUTM applications will be able to apply to register a corresponding UK trade mark for the identical mark and for goods and services which are identical to or contained within the corresponding EU coverage
- 9 month priority period from exit day for the re-filing of such applications to retain the EUTM filing/priority date along with any UK seniority claims



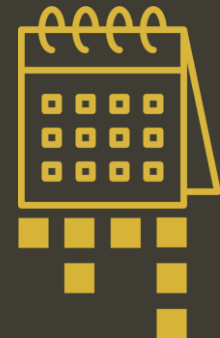
EUTM applicants will not be notified by EUIPO

If details of the UK mark differ from those of EUTM, the earlier filing / priority dates will not be granted



CONVERSION / RESTITUTIO IN INTEGRUM

- EUTMs that have been withdrawn/refused on exit day and for which conversion has been requested prior to exit day will be honoured by the UK IPO
- EUTMs that are restored after exit day will need to be notified to UK IPO by holder



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REGISTERED COMMUNITY DESIGNS

- RCD that are registered and published on exit day will be automatically cloned onto the UK Designs Register with no official fee payable
- Identical process as for trade marks, will be known as “re-registered designs”
- Retains the same registration number as the corresponding RCD prefixed with ‘9’ (‘8’ for EU International designations):

i.e. RCD N° 004048098-004 → UK9004048098-004

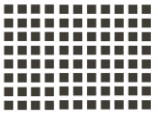
WO N° D069640-001 → UK8069640001



DEFERMENT

- Deferment may be requested for new UK registered design filings for remainder of 30 month EUIPO deferment period but within maximum of 12 months :

Pre-1 January 2021 filing date of deferred RCD	Amount of maximum RCD deferment period remaining at 1 January 2021	Post-January 2021 filing date of UK application	How long publication will be deferred
1 October 2018	3 months (ie until 1 April 2021)	1 March 2021	1 month (ie until 1 April 2021, when corresponding RCD deferment period expires)
1 January 2020	18 months (ie until 1 July 2022)	1 October 2021	9 months (ie until 1 July 2022, when corresponding RCD deferment period expires)
1 November 2020	28 months (ie until 1 May 2023)	1 October 2021	12 months (ie until 1 October 2022, when UK deferment period expires)
31 December 2020	30 months (ie until 31 June 2023)	31 March 2021	12 months (ie until 31 March 2022, when UK deferment period expires)



UNREGISTERED COMMUNITY DESIGNS (UCD)

- On exit day existing UCDs will cease to have effect in the UK
- UK government creating provision for an equivalent transitional right having the same effect in the UK:
 - will be known as a 'Continuing Unregistered Community Design' (CUD)
 - will be enforceable in the UK for the remainder of the 3 year term of the corresponding UCD





SUPPLEMENTARY UNREGISTERED DESIGNS (SUD)

- For designs disclosed after exit day, the UK government has created a new right to provide equivalent protection to a UCD:
 - will be known as a ‘Supplementary Unregistered Design’ (SUD)
 - will be created if a design is first disclosed in such a way that could have become known in the normal course of business to the circles specialized in the sector operating within the UK, and other qualifying territories (not EU...)



→ **Consider disclosure of new designs** to ensure protection is maximized

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DISPUTES

- Proceedings based on EU rights that are pending on exit day before UK courts or IPO will continue towards resolution on the basis of the law as it stood prior to exit day (but remedies limited to UK)
- Existing injunctions based on an EU right will continue to apply to the UK, EU-wide injunctions issued post exit will not apply to the comparable UK right
- Cross-border regimes on jurisdiction, enforcement and service apply to proceedings commenced prior to exit date (Recast Brussels Regulation)

Separate proceedings will be required in the UK post exit





DISPUTES

- All *inter partes* cases pending before EUIPO on exit day based solely on UK rights will be dismissed
- Applications under opposition will not be cloned onto the UK Register but EUTM subject to pending revocation or invalidity actions will be carried over
- EUIPO Cancellation decisions will invalidate newly created UK right **unless** can be shown that the basis for the decision does not apply to the UK

Consider dispute strategy before and post exit





RIGHTS OF REPRESENTATION

- No need to appoint UK representation for cloned rights for 3 years
- New UK rules regarding representation for new filings, contentious matters (renewals are excluded)
- Legal practitioners / professional representatives based in UK will no longer be able to act before EUIPO in new matters





CUSTOMS ENFORCEMENT



- AFAs covering UK filed via UK Customs are unaffected
- AFAs covering UK filed via Customs Office of one of the EU 27 Member States will no longer be recognized in the UK after exit day
 - A fresh AFA will need to be filed via UK Customs to cover the UK post exit
- AFAs covering EU 27 Member States filed via UK Customs will need to be refiled

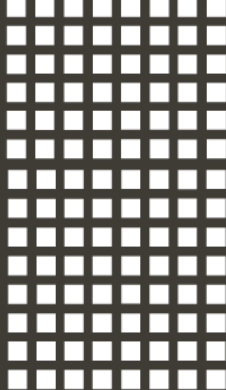


PARALLEL TRADE

- UK position: EEA-wide exhaustion will continue to apply in the UK
 - goods that have been first marketed in the EEA after exit day may be freely imported into / sold in the UK
- EU position: goods first marketed in the UK after exit day will **not** be exhausted
 - may be blocked from entering the EEA without consent



Consider impact of exhaustion regime on distribution agreements

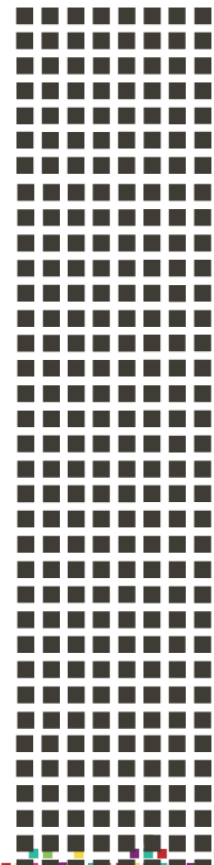


PRACTICAL CONSIDERATIONS

- **Audit portfolios (complete registration procedures, publication of designs, monitor sunrise priority period)**
- **Monitor renewal dates for both newly created UK and EU/IR rights**
- **Consider impact on trade mark use/ first disclosure of designs**
- **Notify licensees, check agreements, make necessary recordals**
- **Ensure adequate searching and watching**
- **Review enforcement and dispute strategies**

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**THANK YOU FOR YOUR
ATTENTION**

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