

After Brexit – Information Regarding Your IP Rights

The United Kingdom (UK) officially left the European Union (EU) on 31 January 2020 and then entered into a transition period. This transition period will end on 31 December 2020. As a consequence, new rules will take effect on 1 January 2021.

In the following, we would like to answer some of the most frequently asked questions concerning how Brexit affects existing IP rights.

Does Brexit affect my patent protection in the UK or Europe?

The European Patent Organisation (EPO) is not a body of the EU and therefore Brexit does not affect European patents. Applicants can continue to apply to the European Patent Office for patent protection, which will include the UK. Existing European patents and patent applications covering the UK are also unaffected.

How does Brexit affect my EU trade mark (“EUTM”) registrations?

From 1 January 2021, any EUTM registration will be cloned onto the UK Register. The new “cloned” UK right will have its own prefix designation (“009”, or “008” if the EUTM registration is derived from an International Registration, added to show that it is a “cloned” registration) and will come into

force on 1 January 2021. If you own an existing right, you do not need to do anything at this stage.

Where EUTM applications are still pending on 31 December 2020, the applicants will have the opportunity to refile national UK trade mark applications with the UK Intellectual Property Office (UKIPO) using the normal application process and official fees, but the UK Intellectual Property Office will recognise the original filing/priority/seniority dates of the original EUTM application.

That is, EUTM applications which are pending on 31 December 2020 will not be automatically granted equivalent UK trade mark rights, but applicants will be able to:

- register a comparable UK trade mark within a time period of **nine (9) months** after 31 December 2020;
- retain the earlier filing date of the pending EUTM;
- claim any valid international priority on the pending EU application, along with any UK seniority claims recorded against it.

In sum, businesses, organisations or individuals that have pending applications for a EUTM at the end of the transition period will have a period of nine (9) months from the exit day to apply in the UK for the same protections. We will keep you informed of this deadline in a timely manner.

What will happen to my registered community design registrations?

From 1 January 2021, any registered and published community designs (RCDs) and protected international design registrations designating the EU will be cloned onto the UK register. The new "cloned" UK rights will come into force on 1 January 2021. In the UK Register each RCD and protected international design registration designating the EU will have its own prefix designation ("009") added to show that it is a "cloned" registration. These rights will retain the filing, registration, priority and renewal dates of the registered community designs. If you own an existing right, you do not need to do anything at this stage.

Where RCD applications are still pending on 31 December 2020, the applicants will have the opportunity to refile with the UK Intellectual Property Office (UKIPO) using the normal application process and official fees but the UKIPO will recognize the original filing/priority dates of the original RCD application.

Will there be a cost for the creation of any equivalent UK rights after Brexit?

There will be no official charge for the creation of equivalent rights for holders of registered EUTMs and community designs. However, there will be future costs to contend with, as comparable rights will need to be renewed in the UK separately from your EUTMs and separately from your registered community designs (RCDs).

What are the considerations regarding the renewal of EU registrations for designs or trade marks?

For rights that are due for renewal in 2021 or later, you need to consider whether you wish to renew the ongoing EUTM right, or the re-registered UK right, or both. The re-registered UK designs and UK trade marks will retain the existing renewal dates of the original protective rights. We will keep you informed of the relevant deadlines in a timely manner.

What are the implications regarding trade mark use?

Consider making a distinct division in your records in relation to evidence of use of your trade marks, clearly distinguishing between EU and UK use, from 1 January 2021.

What are the implications regarding oppositions/cancellation actions?

Existing EUTM oppositions and cancellation actions will be affected by Brexit. At the moment, it appears that an opposition pending before the EUIPO against an EUTM application will cease to have effect in the UK on 1 January 2021. The opposition will therefore continue before the EUIPO against the EUTM application now covering 27 member states.

If the owner of that application then files a daughter UK cloned application, once that application is published, a new opposition will be required to be filed within the usual 2 month UK opposition deadline. If the original EU opposition was based on an EUTM registration, there should be a cloned UK daughter registration on which to base the new UK opposition.

Finally, since the UK becomes a third country on 1 January 2021, any pending first instance opposition based on a UK national trade mark right will automatically fail on 1 January 2021.

With regard to pending cancellation actions against EUTM registrations, the situation is different. The UKIPO has stated that for registered EUTMs which are going through cancellation actions on 1 January 2021, they will create comparable rights.

However, as per the Withdrawal Agreement Act, they will accept the result of a cancellation action on the comparable right, if the grounds for the cancellation are applicable in the UK.

As in the case of oppositions, any pending cancellation action based on a UK national trade mark right will automatically fail on 1 January 2021.

Further information can be found at the following website:

- ▶ <https://www.gov.uk/government/news/intellectual-property-and-the-transition-period>

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