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DRAFT AGREEMENT BETWEEN THE UK AND THE EU

The European Commission published, on 19 March 2018, a Draft Agreement on the withdrawal of the UK from the EU.

The Agreement should enter into force on 30 March 2019 and regulate the relationship between the UK and the other EU Member States during a transition period lasting until 31 December 2020. During this period, the UK will no longer be a Member State of the EU and will not participate in any EU decisions. Nevertheless, the UK will still benefit from the advantages of the single market, the custom union and all European common politics. During this transition period, the UK will also have to apply all European regulations like any other EU Member State.

The Draft Agreement, containing 168 articles, is extremely detailed. It is colored, showing in green the points already agreed and in white the points where agreement has not yet been reached. Articles 50 to 57 relate to intellectual property.



Registered trademarks and designs; granted plant variety rights

According to the draft, holders of registered EU trademarks and community designs will enjoy exactly the same protection at the end of the transition period through national UK trademarks and designs. The same is true for international registrations of trademarks and designs designating the European Union and for granted Community plant variety rights. The filing and priority dates as well as the renewal dates are kept identical for the UK national rights.

How the national protection will be obtained, with or without filing a separate application, with or without an additional fee, however, is still under discussion.

In any case, a continued protection may thus be obtained for all rights that were registered or granted before the end of the transition period.

A similar continued protection is provided for holders of unregistered Community designs. The duration of the national UK design will be at least equal to that of the unregistered Community design.

If the registered EU right (trademark or design) is declared invalid, revoked or cancelled as a result of an administrative or judicial procedure engaged before the end of the transition period, the corresponding UK national right shall also be declared invalid, revoked or cancelled as of the same date as the registered EU right, except if the grounds for invalidation do not apply in the UK.

The use requirements for trademarks on the UK territory will be appreciated after the end of the transition period for the national UK trademark.

If a trademark has acquired a reputation in the EU, the corresponding national UK trademark will benefit from this reputation up to the end of the transition period and thereafter only if said reputation is based on use in the UK.

Pending applications for trademarks, designs and plant variety rights

If an EU trademark application is still pending at the end of the transition period (end of December 2020), there will be no automatic continued protection. This may be the case when an opposition has been filed and the decision is not yet final.

The applicant will have nevertheless, during a 9-month period following the end of the transition period, the right to file a national UK trademark application claiming the priority and filing dates of the EU application.

The same applies to pending applications for Community designs.

In the case of pending applications for plant variety rights, a similar procedure applies, but only during a 6-month period from the end of the transition period.

Data bases

A continued protection has been agreed for undertakings having their registered office in the UK or the operations of which are linked on an ongoing basis with the economy of the UK or of an EU Member State.

Geographical indications; designations of origin

For these rights, no agreement has yet been reached regarding the continued protection. Discussions are still ongoing.

Patents

The draft agreement contains no provisions relating to European patents. These patents are namely granted by the EPO, an international organisation outside the European Union.

Brexit will have no bearing on European patents designating the UK.

In the same way, the draft agreement contains no provision relating to the future Unified Patent Court (the UPC) since it is an international jurisdiction.

It remains to be seen if the UK will finally ratify the UPC Agreement before effectively leaving the EU, i.e. before 30 March 2019. Ratification by the UK and Germany are still required in addition to France, for allowing entry into force of the UPC Agreement.

The draft agreement does not directly mention the Unitary patent (the European patent with unitary effect) which is a Union law creation, under an enhanced cooperation.

IP ALERT – Brexit Update

It is not clear today how a Unitary patent could cover the UK territory after Brexit, even if the UPC Agreement has come into force beforehand.

The Draft agreement mentions in its Article 122 that the UK will not participate in any enhanced cooperation within the framework of which no acts have been adopted before the date of entry into force of the Agreement, i.e. before 30 March 2019.

It is questionable whether this statement will allow a Unitary patent to cover the UK territory after Brexit.

Supplementary Protection Certificates (SPC)

Article 56 of the Draft agreement, only mentions pending applications for supplementary protection certificates in the UK. The corresponding provisions have not yet been agreed upon and are still under discussion.

Supplementary protection certificates for medicinal products already granted are not mentioned.

Conclusion

With respect to trademarks and designs registered prior to 30 March 2019, the continued protection in the UK is provided for, although the modalities have not yet been defined. For trademarks and designs still pending as of such date, however, there will be no automatic protection. We recommend therefore, for any new trademark applications or designs, or pending ones that are unlikely to register prior to 30 March 2019, to consider filing national UK trademark and design applications simultaneously with the EU filings. By doing so, the continued protection of those rights in the UK will be obtained more quickly and more easily, already now and for the future post-Brexit situation.

Please ask for our special offer for preparing and filing a trademark application in the EU and Great Britain.



Contact us:

For any question you may have, please do not hesitate to contact our team.



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IP ALERT – Brexit Update



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