

IP ALERT – Brexit News: Trade Marks and Designs

January 2019

After the UK Parliament's vote against the Withdrawal Agreement on January 15, 2019, the likelihood of a no-deal Brexit has significantly increased.

There are essentially two possible short-term scenarios:

- a) In the event of no-deal, there will be no transition until December 31, 2020, which would have provided IP right owners with more time to prepare the strategies to be adopted. Rather, the UK will leave the EU on March 29, 2019.
- b) The UK Government could request an extension of the Article 50 period beyond March 29, 2019 or unilaterally revoke the Article 50 notification.

In any case, the UK Government already published an information note on September 24, 2018 on the consequences for Trade marks and Designs in the event of a no-deal scenario.

Such note was updated on January 17, 2019 and published along with three additional notes on patents, exhaustion and cross-border and copyright.

We will focus here below on the consequences of a no deal-Brexit in connection with EU trademark registrations and applications and Community registered and unregistered designs.



Continued Protection of Registered EU Trade Marks and Community Designs in the UK

Right holders with an existing EU trade mark registration or registered Community design will have a new UK equivalent right granted that will come into force at the point of the UK's exit from the EU.

According to the UK government, the new UK right will be provided "with minimal administrative burden". This implies, however, that right holders will have to perform some kind of administrative act in order to obtain such UK right. For the time being, no precise information is available.

The trade mark or design will then be treated as if it had been applied for and registered under UK law.

This means that these trade marks and designs:

- will be subject to renewal in the UK;
- can form the basis for proceedings before the UK Courts and the Intellectual Property Office's Tribunal; and
- can be assigned and licensed independently from the EU right

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Continued Protection of International Registrations designating the EU and of International registered designs through the international Madrid and Hague systems.

These same provisions will apply to international registrations designating the EU filed with the World Intellectual Property Organization. This will give the possibility of obtaining continued protection in the UK from the exit date onwards for trade marks and registered designs filed through the Madrid and Hague Systems that designated the EU.

Pending EUTM and Community Design Applications

For a 9-month period following the exit of the UK, business, organizations and individuals with EU trade mark and Community design applications that are pending as of the exit date will be able to refile with the UK Intellectual Property Office under the same terms for a UK equivalent right, using the normal application process for registered trade marks and registered designs in the UK.

This means that for a period of 9 months from exit, the UK government will recognize filing dates and claims to earlier priority and UK seniority recorded on the corresponding EU application.

Right holders taking this step will be responsible, however, the cost of refiling the application in accordance with the UK application fee structure.

Unregistered Community designs : will continue to be protected for the remaining period until the Brexit

A new unregistered design right will be created in the UK

The unregistered Community design provides three years of protection from the date that the design is first made available to the public ('disclosed') within the EU.

The UK government will ensure that all unregistered Community designs which exist at the point that the UK leaves the EU will continue to be protected and enforceable in the UK for the remaining period of protection of the right.

In addition to this, the UK will create a new unregistered design right in UK law that mirrors the characteristics of the unregistered Community design. This means that designs which are disclosed after the UK exits the EU will also be protected in the UK under the current terms of the unregistered Community design. This new right will be known as the supplementary unregistered design right.

Correspondence addresses and representation before the EUIPO

UK withdrawal will have consequences on the rights of representation before the EUIPO for EU trade marks and Community designs.

Applicants that are not domiciled or do not have a seat in Europe (EEA) will have to be represented before the European Union Intellectual Property Office (EUIPO) in all proceedings other than the mere

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filing of an application by a qualified professional representative established in the EEA (EU, Norway, Iceland and Lichtenstein).

Casalonga, with offices in France, Germany and Spain, in particular Alicante the Seat of the EUIPO, would be pleased to take over the representation before the EUIPO of any EU trade marks or Community designs on a courtesy basis.



Conclusion

Although it will be possible, after the effective Brexit date, to file a UK application within the 9 months based on a corresponding a EUTM Application (while keeping the EU application filing date) we do recommend to consider from now on, filing simultaneously an EUTM and a UK application in order to avoid to have to file a new UK application after the Brexit date.



Contact us:

For further information in this respect, please contact our team.



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