



Brexit: The UK is leaving the EU but not Europe!

What you need to know to maintain
European-wide IP protection



Before We Get Started...



Recording

A link to the recording and slides will be emailed to all registrants.



Questions

Type in the question box and we will answer in real time or during the Q&A.



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The Effect of Brexit on IP Rights after 1st January 2021

- Patents
- Copyright
- EU Registered designs (and pending applications)
- EU Registered Trade Marks (and pending applications)



Patents

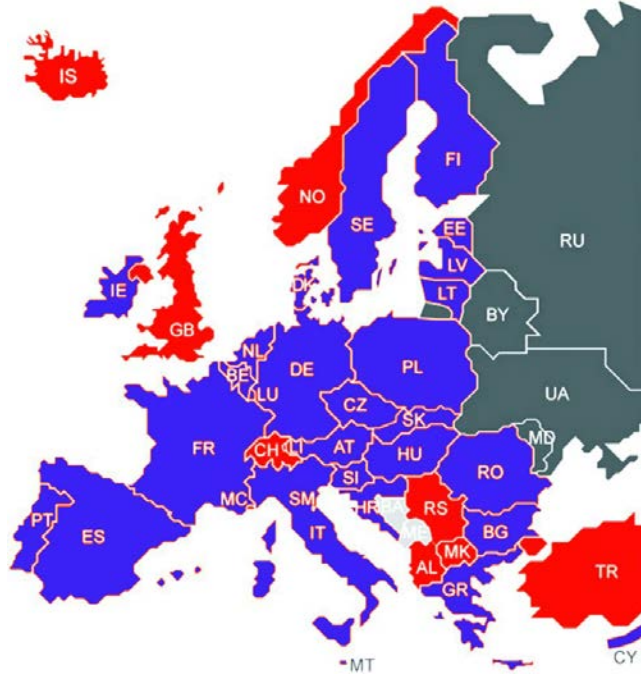




Patents

- **NOTHING CHANGES!**
- European patents can still be obtained covering the UK
- The European Patent Convention is not an EU law. It is an international convention, the terms of which are entered into individually by member states
- The Unitary Patent (the proposed EU patent system) has stalled, but even if this were to ever happen, it would be administered by the EPO as a designation in parallel with the national designations

EPC Contracting states v EU Member states





Copyright





Copyright

- Copyright is a national right that each country provides separately
- A substantial part of UK copyright law is derived from the EU copyright framework for uniformity of copyright protection across EU member states. Although references to EU law will change, no substantive changes will occur on 1st January 2021
- Copyright is subject to international reciprocal protection which will continue unchanged
- Some cross-border mechanisms will change -The reciprocal cross-border arrangements will be amended or brought to an end, as appropriate. The regulations are due to come into force on 1st January 2021. During the transition period, the EU and UK will negotiate a new relationship. Depending on the outcome of these negotiations, these regulations may be amended



Registered Designs





EU Registered Designs (Registered Community Design (RCD))

Registered Designs

- RCDs will be copied (cloned) to the UK register
- The filing and registration date of a cloned UK design registration will correspond to the date of the RCD
- There will be no charge levied by the UKIPO for this and no certificate will be issued
- A UK address for service must be provided based on new law being implemented
- The cloned UK design registrations will be numbered with the prefix 9, e.g. RCD 001234567 -0004 becomes 90012345670004
- The cloned UK design registration will be a fully independent UK design registration that can be challenged, assigned, licensed or renewed separately from the original RCD



EU Registered Designs

Registered Designs – International (the Hague Agreement)

- RCDs based on International registrations will be cloned to the UK register in the same manner as for EU filed RCDs
- The cloned UK design registrations will be numbered with the prefix 8 e.g. RCD number D012345-0001 becomes 801234500010000



EU Registered Designs

Pending EU Design Applications

- Pending RCD applications will not automatically extend to the UK
- A UK application can be filed to benefit from the EU priority date
- The new UK application must be for the same design that is identical to the corresponding EU application
- The new UK design application will be examined under UK law
- The deadline for filing such a new UK design application is **30th September 2021**



EU Registered Designs

Pending Design Applications – International (the Hague Agreement)

- Pending international applications designating the EU will not automatically extend to the UK
- A UK design application can be filed to benefit from the international priority date
- The new UK design application must be for the same design that is identical to the corresponding international application
- The new UK design application will be examined under UK law
- The deadline for filing such a new UK design application is **30th September 2021**



EU Registered Designs

- If the owner does not wish to hold the cloned UK design registration, the owner can opt out of holding it by providing short notice of the RCD with details of any persons with a registered interest in the right
- The result of this cloning procedure will be a number of duplicate UK rights e.g. the owner owns a UK national registration and an EU originating registration
- Any licence or security interest that refers to an RCD and authorises acts in the UK will be treated as if it applies to the cloned UK design registration .
- The assignor or the assignee will have the right after 1st January 2021 to apply for the registration of the cloned UK design registration in the name of the assignee



EU Registered Designs

Renewals

- Where an RCD or international registration renewal date falls after 1 January 2021, early payment of the renewal fee at EUIPO or WIPO, before 1st January 2021, will have no effect in respect of the cloned UK design registration
- A cloned UK design registration with a renewal date falling at any time after 1st January 2021 will be subject to a UK renewal action and fee.
- Renewal deadline for the cloned UK design registration will be calculated from the EU or international registration dates
- If the renewal date of the RCD or international registration falls due within 6 months from 1st January 2021, a notice will be sent by the UKIPO on or around the renewal date, informing the owner that the registration of the RCD or international registration has expired, and a further six month renewal period with no surcharge will be given for the renewal of the cloned UK design registration
- If the renewal fee is not paid for the cloned UK design registration in time, restoration is possible



EU Registered Designs

Late Renewals

- If the renewal date of the RCD or international registration falls due within 6 month prior to 1st January 2021 and has not been paid, a cloned UK design registration will be created with an expired status and will automatically renew if the renewal fee is paid for the RCD or international registration in the extension period.
- Owners must inform the UKIPO by **30th September 2021** that their corresponding international registration has been late-renewed at WIPO by sending an email to:

WIPOrenewaltrademarks@ipo.gov.uk



Registered Trade Marks





EU Registered Trade Marks

Registered Trade Marks

- Registered EU trade marks will be copied (cloned) to the UK register
- The filing and registration date of a cloned UK trade mark registration will correspond to the date of the EU registration
- There will be no charge levied by the UKIPO for this and no certificate will be issued
- A UK address for service must be provided based on new law being implemented
- The cloned UK trade mark registrations will be numbered with the prefix UK009 with the first zero dropped e.g. EU registration 012345678 becomes UK00912345678
- The cloned UK registration will be a fully independent UK trade mark that can be challenged, assigned, licensed or renewed separately from the original EUTM



EU Registered Trade Marks

Registered Trade Marks – International designations (Madrid Protocol)

- EU designations of International Registrations will be copied (cloned) to the UK register if they have been subject to a statement of protection issued by the EUIPO
- The filing and registration date of a cloned UK trade mark registration will correspond to the date of the international registration
- There will be no charge levied by the UKIPO for this and no certificate will be issued
- A UK address for service must be provided based on new law being implemented
- The cloned UK trade mark registrations will be numbered with the prefix UK008 e.g. EU designation of International Registration W00123456 becomes UK00800123456
- Each cloned UK right will be treated as if applied for and registered under UK law, and may be challenged, assigned, licensed or renewed separately from the original international registration



EU Registered Trade Marks

Pending EU Trade Mark Applications

- Pending EU trade mark applications will not automatically extend to the UK
- A new UK trade mark application can be filed to benefit from the EU priority date
- It must be for the same mark and must be for goods and services that are identical to, or contained within, the corresponding EU application
- The new UK trade mark application will be examined under UK law
- The deadline for filing a new UK trade mark application is **30th September 2021**



EU Registered Trade Marks

Pending EU Trade Mark Applications – International designations (Madrid Protocol)

- Pending designations not subject to a statement of protection issued by the EUIPO will not automatically extend to the UK
- A new UK trade mark application can be filed to benefit from the international priority date
- It must be for the same mark and must be for goods and services that are identical to, or contained within, the corresponding EU trade mark application
- The new UK trade mark application will be examined under UK law
- The deadline for filing a new UK trade mark application is **30th September 2021**
- International (EU) trade marks that have been subject to a notice of refusal issued by the EUIPO prior to 1st January 2021 cannot be used for the purposes of claiming an earlier date when filing a new UK trade mark application



EU Registered Trade Marks

- If the owner does not wish to hold the cloned UK trade mark registration, the owner can opt out of holding it by providing short notice of the EU trade mark with details of any persons with a registered interest in the right
- The result of this cloning procedure will be a number of duplicate UK rights e.g. the owner owns a UK national registration and a registration based on an EU registration or an EU designation of an international registration
- Any use of the mark in the EU, whether inside or outside of the UK, which has been made prior to 1st January 2021, will count as use of the comparable UK right. This also applies to reputation
- Any seniority claim based on an earlier UK or international (UK) trade mark registration which has been recorded against an international (EU) designation will be retained by the cloned UK trade mark registration. The retention of existing priority and seniority dates in cloned UK trade mark registrations will be automatic. This also applies to new UK applications based on a pending EU or international application



EU Registered Trade Marks

- Any licence or security interest that refers to an EU trade mark registration and authorises acts in the UK will be treated as if it applies to the cloned UK trade mark registration .
- The assignor or the assignee will have the right after 1st January 2021 to apply to have the registration of the cloned UK trade mark registration in the name of the assignee
- Conversion - Registered EUTMs that have been cancelled or surrendered or have expired and applications for EUTMs that have been refused or withdrawn, may be converted into a new UK trade mark application. Requests for conversion to the UK received by EUIPO after **31st December 2020** will be deemed to be inadmissible



EU Registered Trade Marks

Renewals

- Where an EU trade mark registration renewal date falls after 1st January 2021, early payment of the renewal fee at EUIPO, before 1st January 2021, will have no effect in respect of the cloned UK trade mark registration
- A cloned UK trade mark registration with a 10-year renewal date falling at any time after 1st January 2021 will be subject to a UK renewal action and fee
- Renewal deadline for the cloned UK trade mark registration will be calculated from the EU or international registration dates
- If the renewal date of the EU trade mark registration or international trade mark registration falls due within 6 months from 1st January 2021, a notice will be sent by the UKIPO on or around the renewal date, informing the owner that the registration of the EU trade mark or international designation has expired, and a further six month renewal period with no surcharge will be given for the renewal of the cloned UK trade mark registration
- If the renewal fee is not paid for the cloned UK trade mark registration in time, restoration is possible



EU Registered Trade Marks

Late Renewals

- If the renewal date of the EU trade mark registration or international trade mark registration falls due within 6 month prior to 1st January 2021 and has not been paid, a cloned UK trade mark registration will be created with an expired status and will automatically renew if the renewal fee is paid for the EU trade mark registration or international trade mark registration in the extension period
- Owners must inform the UKIPO by **30th September 2021** that their corresponding international trade mark registration has been late-renewed at WIPO by sending an email to WIPOrenewaltrademarks@ipo.gov.uk

EU Registered Trade Marks

Cancellation and opposition



- Where an EU trade mark registration or international designation is subject to a cancellation action, the result of a cancellation action will be honoured on the cloned UK trade mark registration
- If a pending or future opposition against an EU trade mark application is based on prior rights only in the UK, the opposition will fail after 1st January 2021
- If a pending or future opposition against a UK trade mark application is based on a prior EU registered trade mark, this prior right will continue as a cloned UK trade mark registration and hence the opposition continues
- Use of the EU registered trade mark in the UK will no longer support an EU trade mark registration in defence to a non-use cancellation action



EU Registered Trade Marks and Designs Representation

- UK practitioners will lose the right of representation before the EUIPO – except for “ongoing proceedings”
- The SLWUK office will still provide EUIPO services through a partner firm in Ireland
- A new law is being enacted in the UK requiring all proprietors to have a UK representative or address for service. Hence, there will be a requirement for a UK representative to be appointed for EU trade marks and designs cloned in the UK



EU Registered Trade Marks and Designs

Practical/docketing issues

- Registered EU trade marks and designs need to have cloned UK registrations created with the same filing and registration dates and hence the same renewal dates. Note the new number formats identified (9, 8, for designs and UK009 or UK008 for trade marks)
- Any EU renewal falling due after 1st January 2021 must be set up as a UK renewal. Early payment of the EU renewal does not avoid payment of the UK renewal
- Renewals due in 6 months from 1st January 2021 can be paid in the 6 month grace period without incurring the additional fee
- Renewal fees due in 6 months prior to 1st January 2021 can be paid late at the EUIPO or WIPO to renew the cloned UK registration – beware the requirement to notify the UKIPO by of **30th September 2021**
- Pending EU trade marks (including those being opposed) require a new UK trade mark application matter to be created with a filing deadline of **30th September 2021** and with the EU application priority date date



In Summary

- Brexit represents a significant change in the IP landscape in Europe for trade marks and designs
- While the legal position has reasonable clarity, the commercial and political position is still far from clear: an exit agreement has still not been agreed, with the threat of a 'no-deal' exit from the EU a real possibility
- Brexit will clearly impact on cross border movement of goods and services in Europe, but the extent of this impact is dependent on an exit agreement



Thank you for your interest.

Questions?



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