

BREXIT and Intellectual Property Rights

- The European Union and the United Kingdom signed the Withdrawal Agreement on **January 24, 2020**. The European Parliament ratified it on **January 29, 2020**.
- The United Kingdom left the European Union on **January 31, 2020 at midnight**.
- A transition period of 11 months began on **February 1, 2020** and will end on **December 31, 2020**

Procedures and formalities at the end of the transitional period, or after December 31, 2020.

1 If the EU trademark, or the International registration designating the EU, is registered no later than December 31, 2020

- ⇒ The UK Office **automatically converts the trademark** (or design) **into a comparable national right** from the end of the transitional period. This procedure is **free of charge and without any administrative procedure** or application for registration on the part of the EU trademark owner.

The trademark that thus originates in the United Kingdom benefits from the **filing date or priority date of the EU trademark**.

The number of the comparable national right will be composed of the letters and numbers "UK009" followed by the number of the EU trademark.

- ⇒ Holders of these converted rights in the United Kingdom will be required to have a **mailing address in the United Kingdom** after a period of **3 years starting from December 31, 2020**. **To this end, we will naturally appoint one of our British colleagues to represent you before the UK Office.**
- ⇒ If a EU trademark is declared **invalid or lapsed** before December 31, 2020, it will **be declared invalid or lapsed in the United Kingdom as well**. However, if it is declared invalid after this date, due to reasons that do not apply in the United Kingdom, it will be maintained in the United Kingdom.

2 If the European Union trademark, or the International registration designating the EU, is filed but not registered by December 31, 2020 at the latest.

⇒ The applicant must then register its trademark (or design) in the United Kingdom. In this respect, the applicant has **9 months starting from December 31, 2020**, to file the trademark specifically in the United Kingdom.

If the European Office had already set a filing date, the trademark in the United Kingdom will have the same filing date.

⇒ Unregistered designs disclosed before the end of the transition period will be automatically protected in the UK under an intellectual property right enforceable in the UK, for a term at least equal to the remaining term of protection of the unregistered Community design.

⇒ Unregistered designs disclosed after the end of the transitional period may be protected by **a similar unregistered design right in the UK** (protection will be granted for 2D or 3D designs and for a period of 3 years from the first disclosure, as under the European system).

3 If the European Union trademark is filed after December 31, 2020

⇒ The European Union trademark application will not cover the United Kingdom.

⇒ If protection in the United Kingdom is desired, it will be necessary in this case to file a national trademark application with the UK Office (UKIPO) or an International trademark designating the United Kingdom.

4 If the International registration for the EU is filed after December 31, 2020.

⇒ The filing of an International trademark designating the European Union after December 31, 2020 will only cover the Member States. It will therefore not cover the United Kingdom.

⇒ If protection in the United Kingdom is desired, the United Kingdom will have to be specifically designated in the list of countries designated at the time of filing.

5 European Union trademarks expiring as of January 1, 2021

- ⇒ The **equivalent UK title thus created under §1 will be independent** from the European Union trademark and therefore has to be renewed separately.
- ⇒ Thus, **as of January 1, 2021**, the owner of the converted UK trademark will have **to renew this right separately from the renewal of the European Union trademark** if it wishes protection in the United Kingdom.
- ⇒ This renewal will entail the **usual fees** provided for under British law.
- ⇒ An early renewal (no later than December 31, 2020) of the European Union trademark **does not exempt** the owner from renewing separately the converted UK trademark if the expiration date is on or after January 1, 2021 (inclusive).

The Promark Law firm will keep you informed of the formalities to be carried out, as well as the corresponding deadlines and costs, if you wish to claim protection in the United Kingdom as of January 1, 2021 and if you are in one of the above mentioned situations.