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Trademarks and Designs after Brexit

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Trademarks and Designs after Brexit

The law as stated during this webinar is up to date as of **5 July 2021**



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Agenda

- What trademark and design protection in the EU and UK looked like before Brexit, and what it looks like now
- Has the scope of trademark and design protection changed after Brexit?
- What are the ongoing practical implications for rights holders?
- What's on the horizon?

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Trademarks and Designs

Before and after....

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Trademarks before and after Brexit

Before

- EUTMs provided unitary protection across all 28 EU Member States
- Alternatively, national trademarks in each Member State were available
- Both an EUTM or national trademark can be designated under an international registration under the Madrid Protocol

After

- National trademarks (including UK marks) and international registrations designating the UK unaffected
- Existing EU trademarks and international registrations designating the EU:
 - continue to cover the EU 27
 - ceased to have effect in the UK as of 1 January 2021
 - were automatically cloned at no cost and with no re-examination to provide a corresponding UK right provided registered/granted on 31 December 2020 (a “comparable trademark”)
 - filing and priority dates for the newly created UK rights are the same as the corresponding EU marks. Terms will be the same

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Designs before and after Brexit

Before

- EU derived rights, covering all 28 EU Member States (including the UK):
 - Registered Community Design (RCD)
 - Unregistered Community Design (UCD)
- UK rights, covering the UK only:
 - UK Registered Design (UK RD)
 - UK Unregistered Design (UK UDR)
 - Copyright protecting designs in some limited instances
- International design designated to UK, EU or other member states of the Hague Agreement

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Designs before and after Brexit

After

- EU derived rights continue to cover the EU 27
- The UK element of these rights was 'split off' at the end of the transition period and automatically cloned into a corresponding UK right provided registered/granted/published on 31 December 2020
 - RCD → a 're-registered design'
 - UCD → a 'continuing unregistered design' (CUD)
- UK derived rights, covering the UK only
 - UK Registered Design (UK RD)
 - UK Unregistered Design (UK UDR)
 - Copyright (limited)
 - Supplementary Unregistered Design (SUD)

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What are the practical implications for rights holders?

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Trademarks and designs before and after Brexit

- Have registered rights transitioned over smoothly?
 - Generally yes, although the process has not been entirely issue free
- EUTM and RCD applications pending on 31 December 2020:
 - were not automatically cloned
 - must be re-filed
 - deadline is **30 September 2021** to claim priority of the EU counterpart
- Has the scope of trademark and design protection changed after Brexit?
 - **Designs** - generally no change in the scope of protection, except the need for duplicate filings in the EU and UK. However, a new Unregistered Community Design and the Supplementary Unregistered Design will be mutually exclusive
 - **Trademarks** - as for designs, generally no change

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Ongoing practical implications for rights holders

- Renewal of registered rights:

Trademarks:

- EUTMs, international registrations and UK national marks need to be renewed every ten years
- comparable trademarks (cloned rights in the UK) must be renewed separately
- Renewal dates:
 - EUTM and comparable trademark (EU): the same
 - International registration and comparable trademark (IR): can be different in case of a subsequent designation of the EU!
- where the renewal date for the EUTM is after 1 January 2021, early payment of the renewal fee to the EUIPO will have no effect in respect of the comparable UK trademark. A separate renewal fee will still have to be paid to the UKIPO

Registered Designs:

- As for trademarks

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Ongoing practical implications for rights holders

- **Trademarks** - use them or lose them:

- non-use of a trademark for an uninterrupted five-year period can render the mark vulnerable to challenge
- because EUTMs have been 'split' into their separate EU27 and UK elements, there are rules around how use is calculated
- use in the EU within the five years prior to 1 January 2021, which would have supported an EU trademark registration, will be sufficient for the corresponding UK application (and vice versa) for now
- the same approach is taken for assessing the reputation of a mark
- going forward, use and reputation will be treated separately, and any reputation in the EU will fade in the UK

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Ongoing practical implications for rights holders

- Applying for international registrations:

Trademarks:

- Process is still the same
- However, UK applicants can no longer use an EUTM as base mark for the international registration, unless they have a permanent establishment in the EU

Registered designs:

- Process is still the same

- Existing licences and security interests

- Deemed to apply to comparable mark and re-registered designs
- However, recordal was not automatic. 12-month period to record in the UK

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Ongoing practical implications for rights holders

- Managing your UK portfolio:

- From 1 January 2021, only an address for service in the UK, Gibraltar or the Channel Islands will be accepted for **new** applications, and new requests to start contentious proceedings, before the UKIPO
- A UK address for service for comparable trademarks and re-registered designs (or contentious proceedings relating to these) is not required until 1 January 2024
- Appointing UK representatives is, however, advisable
- EU trademarks and RCDs require an address for service in the EEA

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Contentious proceedings

- Proceedings before the UK courts and UK IPO ongoing on 31 December 2020 will continue to completion as if the UK was still an EU Member State. The courts will no longer be able to grant pan-EU remedies
- Pan-EU injunctions in place on 31 December 2020 will continue to cover the UK and will be treated as if they apply to the comparable UK mark
- Effect of cancellation of corresponding EUTM: if after the transition period an EUTM is declared invalid or revoked in proceedings started before the end of the transition period, the corresponding comparable mark will also be cancelled as of the same date unless the grounds for invalidity or revocation are not applicable in the UK

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**What's on the horizon for
trademarks and designs?**

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Horizon-scanning

Designs:

- the European Commission has launched a consultation on reforming design protection in the EU
- the proposals for reform are focused on modernising, clarifying and strengthening EU design protection rules and making design protection more accessible, affordable and attractive to designers across the EU
- the consultation is open until 22 July 2021, and adoption of revised legislation is planned for the second quarter of 2022

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Horizon-scanning

Trademarks:

- UK consultation on the future parallel trade regime
- post-Brexit asymmetrical position on exhaustion of IP rights
- the IP rights in goods placed on the EEA market by, or with the consent of, the rights holder **are** exhausted in the UK but the IP rights in goods placed on the UK market are **not** exhausted in the EEA
- what will the long-term position on parallel trade into the UK be? The current consultation will determine that
- options are the current asymmetrical regime, an international regime or a mixed regime
- the consultation closes on 31 August 2021
- the outcome will be important for rights holders in terms of the extent to which they can control the flow of goods into the UK using their IP rights

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Thank you for listening!

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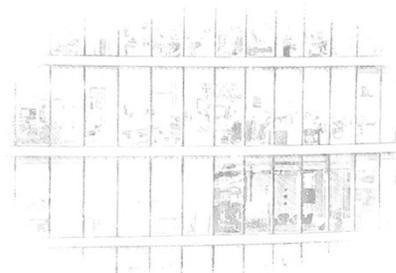
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- WN0421 IP issues for artificial intelligence (2021) - **Q2 2021**
- WN0521 Ambush marketing (2021) - **Q3 2021**
- WN0621 Extending the reach of copyright (2021) - **Q3 2021**
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