

Post-Brexit UK Intellectual Property Protection

December 7, 2020

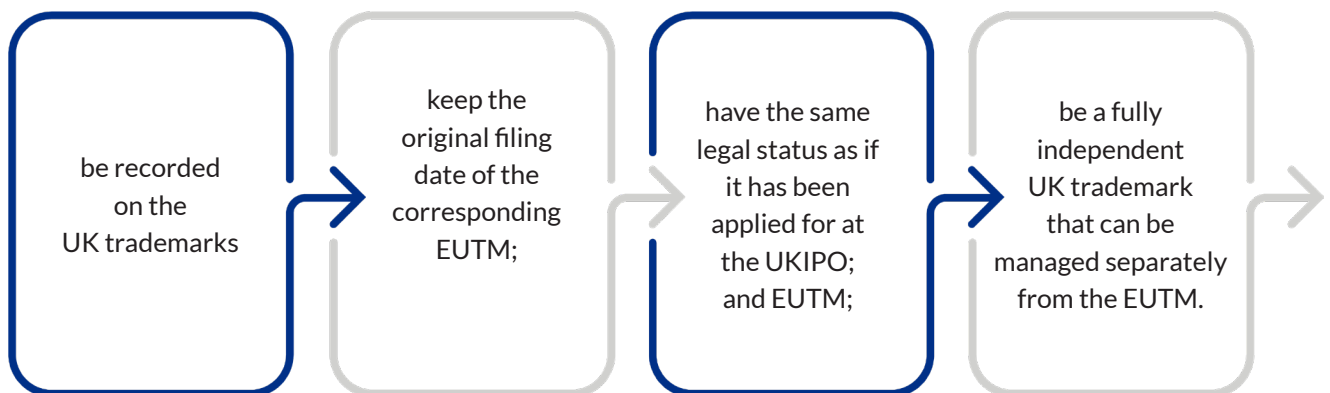
As the Brexit transition period ends at the end of this month, ensuring intellectual property rights remain adequately protected is at the forefront of many of our clients' minds.

We have pulled together our five most frequently asked questions in relation to Brexit, trademarks and registered designs.

FAQ: POST- BREXIT EU TRADEMARKS

1. Will I still have protection in the United Kingdom under my existing EU trademark (EUTM) registration?

- Whilst existing EUTMs will no longer be protected in the United Kingdom, the UK Intellectual Property Office (UKIPO) will automatically create a comparable UK trademark for all right holders with an existing EUTM.
- This means if you hold an existing EUTM, your trademark will:



- To be eligible for a comparable UK trademark:
 - your EUTM must have been registered before 1 January 2021; and
 - the new standalone UK trademark will need to be renewed separately from the EUTM, directly with the UKIPO.

2. Will I have to apply for and pay for the new UK trademark?

No! The new UK registration will be created automatically and free of charge.

Please note that the UKIPO has confirmed that a UK registration certificate will not be received. Instead, details will be available on the register, which can be searched online [here](#).

3. What happens to my EUTM application on 1 January 2021?

- Holders of pending EUTM applications will need to apply to register the comparable UK trademark within nine months of the end of the transition period i.e. up to and including 30 September 2021.
- You can keep the original EUTM application date for your UK application.
- The UK application must relate to the same mark.
- The specification must contain goods/services that are identical to, or contained within, the EUTM application.
- The usual application fees will apply to register the mark.

4. What if I don't need protection in the United Kingdom?

We are advising all of our clients to consider whether they need a separate UK mark. Key things to help you decide are whether your business is active in the United Kingdom or whether a separate UK mark could breach any existing agreements you have in place with third parties.

If you decide you do not require a standalone UK trademark you can opt out, and the comparable right will be treated as if it had never been applied for or registered. Although, if you have initiated proceedings based on the comparable UK right or have assigned/licensed the mark, you cannot choose to opt out.

Opt-outs cannot be requested until 1 January 2021. If you wish to opt out of a UK trademark, please contact us.

5. What about the EU designation under my international trademark registration?

Similarly with EUTMs, any international trademark that designates the European Union will no longer enjoy protection in the United Kingdom. Instead the UKIPO will create a comparable UK trademark in relation to each EU designation, which has protected status immediately before 1 January 2021.

If an EU designation has not been subject to a statement of protection before this, it will be treated in a similar way to the EUTM application (i.e. you will have to apply for protection before 30 September 2021.)

As with EUTMs, there will be no cost for the comparable right, and the filing and registration date will remain identical to the international registration.

International registration holders should note that the comparable UK trademark will not be a designation but an independent UK registration, so it needs to be managed independently of the international registration.

FAQ: POST-BREXIT REGISTERED COMMUNITY DESIGNS

1. What happens to my Registered Community Design (RCD) on 1 January 2021?

On 1 January 2021, existing RCDs will only cover remaining EU states. The UKIPO will automatically create a comparable UK registered design that will:

be treated as if it had been applied for and registered with the UKIPO;

retain the same application and registration dates as the original RCD, including inheriting any priority dates;

be fully independent from the RCD and may be challenged, assigned, licensed or renewed separately from the original RCD; and

be re-registered at the UKIPO at no cost to the RCD holder and with minimal administrative burden.

2. Will my RCD application automatically be transferred to the UKIPO?

RCD applications will not automatically be transferred. To ensure you obtain a comparable UK registered design you must:

- apply to register a UK design in the nine months after the end of the transition period, up to and including 30 September 2021;
- ensure the application relates to the same design filed in the pending RCD application;
- flag the original filing date of the pending RCD; and
- pay the relevant fees under the UK fee structure.

3. What about renewals?

Like RCDs, UK registered designs can be renewed every five years up to a maximum of 25 years. A comparable UK registered design must be independently renewed from the RCD, including a separate renewal fee that must be paid to the UKIPO. The renewed design will retain the existing renewal date of the original RCD.

The UKIPO will send a renewal reminder to any UK registered design holders whose renewal dates fall more than six months after the end of the implementation period.

For any 'new' UK registered designs that expire within the six month period falling after 1 January 2021, a reminder will be sent on the date of expiry, and you will have a further six months starting from the date of notice to renew the design.

4. Will the UKIPO honour EU deferred publication periods?

An applicant can request the EUIPO to defer publication of a design by up to 30 months. Any RCD that has been deferred on exit day will be treated as being equivalent to a pending application (i.e. the applicant will have to file an application for registration in the United Kingdom by 30 September 2021 to retain the original EU filing date.)

However, the United Kingdom currently only allows applicants to defer publications by up to 12 months.

If you have less than 12 months of your EU deferral period left on the date of filing in the United Kingdom, and you are seeking to retain the earlier RCD application date, the UKIPO will defer your application until the date of the corresponding RCD application.

If you have more than 12 months left in your deferral period on the date of filing in the United Kingdom, the UKIPO will still only defer the UK application for a period of 12 months from the date of the UK application.

If you would prefer for your RCD and UK applications to be published on the same day, and the deferral period of the RCD is later than the UK application would allow for, you can wait to file in the United Kingdom 12 months before the expiry of the RCD deferral period. For example, if a RCD was filed at the EUIPO and deferred for 30 months on 31 December 2020, the deferral period would end on 20 June 2023. Instead of filing by 30 September 2021, you could file the equivalent design in the United Kingdom on 20 June 2022 and defer for 12 months.

5. What if I don't need protection in the United Kingdom for my designs?

Similarly to trademark holders, RCD holders can opt out of an automatic UK registered design creation but only from 1 January 2021; any opt-outs requested before then will be invalid. To opt out, a notice must be submitted in the required form confirming that any interested parties have been notified.

Any RCD holders who have assigned, licensed or entered into an agreement in relation to the design, or who have launched proceedings based on the design, must not exercise the opt-out right.

If you are thinking about opting out, then please contact us to discuss next steps.

If you have any questions about any of the above information, please do not hesitate to contact [Sarah Simpson](#) to discuss your brand protection queries.

CONTACTS

For more information, please contact Katten's [Intellectual Property](#) practice or any of the following attorneys:



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