

IP Report

Trademarks and Designs



**BARDEHLE
PAGENBERG**



Prof. Dr. iur., J.D., LL.M.
Alexander von Mühlendahl
Attorney-at-Law
(*Rechtsanwalt*)

Brexit and Trademarks and Designs

Reported by *Prof. Dr. Alexander von Mühlendahl, J.D., LL.M.*

We have previously presented news and analyses regarding the effects of Brexit on trademark and design law (please see our firm's earlier reports [here](#) and [here](#)).

Today, starting with a summary of the provisions in the Withdrawal Agreement¹, we will present a more detailed analysis and description of the rules applicable in the United Kingdom as of January 1, 2021 to trademarks and designs registered or applied for prior to that date at the EUIPO.

We will provide information regarding the new UK trademarks (“*comparable trademarks (EU)*”) as well as the new UK design rights (“*re-registered designs*”) and, more specifically, on the following topics:

- international trademark and design registrations;
 - converting pending applications;
 - pending actions for declarations of revocation or invalidity;
 - unregistered designs;
 - pending actions for the infringement of EU trademarks and designs;
 - injunctions prohibiting the infringement of EU trademarks and designs;
 - genuine use and reputation in cases involving comparable trademarks (EU) or (IR);
 - professional representation.
- 1. The Withdrawal Agreement**
- According to Article 54 (1) (a) and (b) of the Withdrawal Agreement, proprietors of EU trademarks and Community designs registered prior to January 1, 2021 will become – automatically and without any fees to be paid – proprietors of comparable registered and enforceable trademarks and designs in the United Kingdom. These rights will retain their filing and priority dates.
- According to Article 54 (4) of the Withdrawal Agreement, the newly created UK trademark
- Formalities (new UK registration number, priority and filing date, appointed representatives);
 - list of goods and services;
 - assignments and licenses;
 - opt-out (i.e., what to do if you do not wish to become or remain proprietor of the comparable UK rights);
 - renewals (including late renewals);

BARDEHLE PAGENBERG
Partnerschaft mbB
Patentanwälte Rechtsanwälte

Prinzregentenplatz 7
81675 München
T +49.(0)89.928 05-0
F +49.(0)89.928 05-444
info@bardehle.de
www.bardehle.com

¹ Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community

IP Report

Trademarks and Designs



BARDEHLE
PAGENBERG

and registered design rights have the renewal date of the corresponding EU trademark or registered Community design as their first renewal date.

According to Article 54 (3) of the Withdrawal Agreement, where an administrative or court action for the revocation or invalidation of an EU trademark or the invalidation of a Community design was pending on December 31, 2020 and the contested EU trademark or Community design is subsequently declared revoked or invalid, the corresponding right in the United Kingdom will also be declared invalid or revoked. The date of effect of the declaration or revocation or invalidation in the United Kingdom will be the same as in the EU. However, the United Kingdom is not obliged to declare invalid or to revoke the corresponding right in the United Kingdom where the grounds for the invalidity or revocation of the European Union trademark or registered Community design do not apply in the United Kingdom.

According to Article 59 of the Withdrawal Agreement, proprietors of EU trademark applications pending on December 31, 2020 have the right to file, within the first nine months of 2021 (i.e., prior to October 1, 2021), applications for the same trademark in respect of goods or services which are identical with or contained within those for which the application has been filed with the EUIPO. The same right to file an application applies to proprietors of Community design applications (as well as Community design registrations with suspended publication). These applications shall be deemed to have the same filing date and date of priority as the corresponding application filed in the Union and, where appropriate,

the seniority of a trademark of the United Kingdom claimed in the proceedings before the EUIPO.

As regards trademarks registered under the Protocol to the Madrid Agreement and designs registered under the Geneva Act of the Hague Agreement with extension to the EU, Article 56 of the Withdrawal Agreement merely provides that the proprietors of these rights shall enjoy protection in the United Kingdom for their trademarks and designs, without setting out how that shall be achieved.

As regards designs protected as unregistered Community designs before 1 January 2021, Article 57 of the Withdrawal Agreement provides that the proprietors of such rights shall *ipso iure* become the holders of an enforceable intellectual property right in the United Kingdom, under the law of the United Kingdom, that affords the same level of protection as that provided for in Regulation (EC) No 6/2002 (the Community Design Regulation). The term of protection of that right under the law of the United Kingdom shall be at least equal to the remaining period of protection of the corresponding unregistered Community design under Article 11 (1) of that Regulation.

2. The implementation by the United Kingdom

Pursuant to corresponding authorizations in the 2018 Withdrawal Act, the UK Government adopted Statutory Instruments in 2019 (with a no-deal Brexit on the horizon) providing for the automatic “conversion” of existing EU trademarks and Community designs, in line with what was contained in

the draft Withdrawal Agreement.² Now, the UK Government proposes to amend these Statutory Instruments to align the laws applicable post-Brexit with the terms of the Withdrawal Agreement and the transition period expiring on December 31, 2020.³ The Statutory Instrument is still a draft, but it is expected that it will be adopted shortly. The UK Government has published a number of very helpful notes providing detailed guidance.⁴

2.1 Registration of comparable UK trademarks and re-registered designs

UK trademark registrations resulting from existing EU trademark registrations are called “**comparable trademarks (EU)**” in UK legislation. Comparable trademarks will retain their filing and priority date and any applicable seniority claims to pre-existing UK registrations. The UK registrations will retain the last eight digits of the EU registration number, to which “UK009” will be added. Thus, an EU trademark “018002837” will become “UK00918002837”.

The **list of goods and services** for which the comparable trademark will be registered will be taken from the English language version of the entry in the EUIPO register. Where the EU trademark application was not

filed in English, or where the second language indicated pursuant to Article 146 (3) EUTMR was not English, a “person having sufficient interest” (which would include the proprietor in any event) who considers that the English version is inaccurate may request a correction of the UK register by the substitution for an English translation of the relevant authentic text as determined in accordance with Article 147 (3) EUTMR. The authentic language is either the first language if one of the five languages of the EUIPO (English, French, German, Italian, Spanish), or, if the first language is not one of the five languages, the second language chosen by the applicant, which must be one of the five EUIPO languages.

EU collective marks and EU certification marks will become comparable UK collective or certification marks. Specific rules apply for the submission of English-language regulations governing the use of these marks.

UK design registrations resulting from existing registered Community design registrations are called “**re-registered designs**” in the UK legislation. Re-registered designs retain their filing and priority date. The UK registrations will retain their EU registration number, with a “9” added to the full EU RCD number. Thus, an EU RCD 002847681-0001 will become “90028476810001”.

² The Trademarks (Amendment etc.) (EU Exit) Regulations 2018, SI 2019/296; The Designs and International Trademarks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019/638.

³ The Intellectual Property (Amendment etc.) (EU Exit) Regulations, 2020/___ (Draft).

⁴ See, e.g., EU trademark protection and comparable UK trademarks from January 1, 2021, published January 30, 2020; Changes to EU and international designs and trademark protection from January 1, 2021, last updated June 26, 2020; Changes to international trademark registrations after January 1, 2020, last updated June 26, 2020; International EU protected designs after January 1, 2021, last updated June 26 2020; Changes to unregistered designs, published January 30, 2020.

2.2 Assignments and licenses

Where an EU trademark or a registered design was **assigned or transferred** prior to January 1, 2021 but the new proprietor was not recorded in the EUIPO register, a request to record the new proprietor may be submitted to the UKIPO by the assignee with corresponding evidence, or by the assignor. The new proprietor will then be entered in the UKIPO register.

Licenses granted for EU trademarks or designs with effect in the UK on December 31, 2020, whether or not recorded in the EUIPO register, continue to be effective in the UK as licenses under the comparable trademark or the re-registered design, unless the agreement provides otherwise. Licenses recorded in the EUIPO register will not be continued in the UK register. License agreements entered into before January 1, 2021, whether or not previously recorded in the EUIPO register, may be recorded in the UK register throughout the year 2021. The same rules apply to **security interests** recorded in the EUIPO register.

2.3 Opt-out

Proprietors of comparable UK trademarks or re-registered designs who do not wish to become or remain proprietors of the comparable UK rights, may “opt out” of the protection in the UK. There are slight differences between the opt-out requirements for comparable trademarks and for re-registered designs.

As regards **comparable trademarks**, an opt-out is not available if the comparable trademark has been put to use in the UK after December 31, 2020. Opt-out is not

available either if proceedings based on a comparable trademark have been initiated. As regards **re-registered designs**, an opt-out is not available if proceedings based on the re-registered design have been initiated.

Opt-out will be available as of January 1, 2021. Requests submitted before that date will not be valid. The UKIPO will create a template on its website which is to be used for declaring an opt-out. The declaration should be sent to a dedicated email address that will be provided by the UKIPO. The notice of opt-out must include the name and address of any person having an interest, recorded in the EUIPO register, in the existing EU trademark or design which had effect in the UK before January 1, 2021. The notice must certify that any such person has been given not less than three months’ notice of the intention to declare an opt-out, or that such person is not affected by or consents to the opt-out. When the opt-out is accepted, the UK registration will be removed from the UK register and the UK registration will be deemed never to have had any effect.

We are currently not aware of any deadline by which an opt-out must have been declared.

2.4 Renewals

EU trademarks are registered for a period of ten years from the filing date and may be renewed for additional periods of ten years. Renewal may be requested within six months prior to the expiry of the registration, and also, with a surcharge, within six months following the expiry of the registration. Registered designs are valid initially for five years from the filing date. The protection may be

IP Report

Trademarks and Designs



BARDEHLE
PAGENBERG

renewed for a maximum of four additional periods of five years. To registered designs, the same six months prior to and subsequent to the expiration date apply. The rules in the UK are substantially the same.

As regards comparable trademarks and re-registered designs, the UKIPO will be faced with a massive task regarding renewals of such re-registered rights. More than 1,400,000 EU trademarks will be converted into comparable UK trademarks, and some 700,000 registered Community designs will become re-registered UK designs. Of these registrations, some 10 % of trademarks are renewable each year, and some 20 % of the designs, which means that about 250,000 re-registrations become renewable in 2021, or more than 20,000 each month.

Where the expiration date of an EU trademark or design falls on a date prior to January 1, 2021, the renewal of the original EU trademark or design registration will also apply to the comparable UK trademark or design registration.

Where the registration expired in the six months prior to January 1, 2021, i.e. in the months from July to December 2020, and the renewal of the EU right had not been effected prior to January 1, 2021, the UKIPO will create a comparable UK trademark and design registration, with the status “expired”. If the original EU registration is subsequently renewed (at the EUIPO), the renewal will automatically apply to the comparable UK right. If the EU registration is not renewed, the comparable UK registration will be removed from the UK register with effect from January 1, 2021.

When the renewal date is subsequent to December 31, 2020, the renewal must be effected for the comparable UK trademark or design by requesting renewal at the UKIPO. For “normal” UK trademarks and designs, renewal may be effected within six months prior to expiry and also in the six months subsequent to expiry subject to a surcharge. The UKIPO sends out renewal notices for trademarks six months prior to the actual expiry date and, for designs, on or close to the expiry date. For a significant number of re-registered rights, and notably for those registrations with an expiry and renewal date within six months from January 1, 2021, the “normal” rule for renewals cannot apply because the UKIPO will not be in a position to send out timely renewal notices.

Having recognized these difficulties, the rules adopted by the UK Government provide that:

- For **re-registered** designs expiring in the first three months of 2021, the UKIPO will send out renewal notices at the point in time of expiry or as soon as practicable thereafter. Renewal may then be effected, without incurring any surcharge, within six months following the date of the notification.
- For **re-registered** designs expiring in April, May or June 2021, the UKIPO will send out renewal notices ahead of the date of expiry as well as a renewal notice at the date of expiry, and the registrations may be renewed in the six months following the second renewal notice without incurring any surcharge.
- For **comparable trademarks** expiring in the first six months of 2021, the UKIPO

will send out renewal notices at the point in time of expiry or as soon as practicable thereafter. Renewal may then be effected, without incurring any surcharge, within six months following the date of the notification.

- For registrations expiring after June 30, 2021, the normal procedure will apply (renewal in the six month prior to expiry, or in the six subsequent months with a surcharge), even though the UKIPO may not necessarily be in the position in all cases to send out renewal notices exactly six months prior to expiry.

“Date of notification” means the date of sending the notice of renewal, not the date of receipt. Renewal notices will be sent, by regular mail, to appointed representatives. If there is no appointed representative, the renewal notices will be sent to the proprietor.

2.5 International trademark and design registrations

There was some hope originally that the UK would agree with WIPO that, upon Brexit, previous designations of the EU would be continued as designations of the EU 27 and as separate designations of the UK. In the end, such a solution was not pursued. Instead, the UK Government decided that international registrations of trademarks (under the Protocol to the Madrid Agreement) and designs (under the Geneva Act of the Hague Agreement) designating the EU would be treated in the same manner as trademarks and designs registered at the EUIPO.

UK trademark registrations resulting from international registrations will be called

“comparable trademarks (IR)”, and registrations resulting from Hague registrations will be called “re-registered designs (IR)”.

The registration numbers under which the UKIPO will register comparable trademarks (IR) will be the last 8 digits of the international (EU) trademark prefixed with “UK008”. As regards re-registered designs (IR), the UKIPO will take away the “D” and add an “8” to the International (EU) registration number, as shown on EUIPO’s DesignView database, adding as many “o” as necessary to have a 15-digit number in total. Examples: An international trademark registration with the number “1227934” will become “UK0081227934”. An international design registration with the number “D200432” will become 820043200000000 on the DesignView database.

The rules explained above for automatic registration, opt-out and renewal also apply, *mutatis mutandis*, to comparable trademarks (IR) and re-registered designs (IR).

2.6 Converting pending applications for EU trademarks and designs and for international registrations into UK applications

Proprietors of EU trademark applications pending on December 31, 2020 and of Community design applications not yet registered and published on that date, as well as of Community design registrations with deferred publication not yet published on that date, may “convert” these applications (or registrations) into UK trademark or design applications, maintaining their EU filing and priority date (and any UK seniority date), by filing corresponding applications at the UKIPO within a period of nine months

after December 31, 2020, i.e. between January 1, 2021 and September 30, 2021.

The application must be for the same trademark and must be for goods or services which are the same as or a selection of those in the EU trademark application. The application may include additional goods and services, for which the priority of the UK filing date will be controlling.

The applications will be subject to the fees for UK trademark or design applications.

2.7 Pending actions for declarations of revocation or invalidity

Pursuant to Article 54 (3) of the Withdrawal Agreement, when actions are pending on December 31, 2020 before the EUIPO (or on appeal before the General Court or the Court of Justice) or before an EU trademark court or design court, including such a court in the UK, seeking a declaration of revocation or invalidation of an EU trademark or design, the outcome of such cases will also apply to the comparable trademark and re-registered design. Therefore, such cancellation proceedings will continue after December 31, 2020 as if the UK were an EU Member State. The UK registrations will be cancelled to the same extent (in whole or in part) as the original EU trademark or design.

The comparable trademark or the re-registered design will not be cancelled where the ground of revocation or invalidation would not apply if the action had been brought against the comparable trademark or the re-registered design. The principal situation under which the comparable UK trademark would continue would be cases where the application for a declaration of invalidation

was based on an earlier national right other than an earlier right existing in the UK. The situations under which a re-registered design would not be subject to cancellation would include, for example, a “relative” ground of invalidity in the sense of Article 25 (1)(e) CDR constituted by an earlier national trademark. The rules provide for a complex procedure for requesting that the comparable trademark or the re-registered design should not be cancelled. The onus is on the proprietor of the new UK right.

2.8 Unregistered designs

Unregistered Community designs are established as a result of a first disclosure of a design in the European Union. Unregistered Community designs are protected for three years. After December 31, 2020 these designs continue to be protected in the UK to the same extent and with the same substantive protection as before, as so-called “supplementary unregistered designs (SUD)”, for the remainder of the period of protection.

2.9 Pending actions for the infringement of EU trademarks and designs

When actions for the infringement of an EU trademark or a Community design are pending before an EU trademark or design court on December 31, 2020, the question arises whether courts in the EU 27 and in the UK will continue to have jurisdiction and what kind of relief they are entitled to grant.

Pursuant to Article 67 (1) of the Withdrawal Agreement, in the United Kingdom, as well as in the Member States in situations involving the United Kingdom, in respect of legal proceedings instituted before January 1, 2021, the provisions regarding juris-

diction of Regulation (EU) 2017/1001, the European Union Trademark Regulation, and of Regulation (EC) No 6/2002, the Community Design Regulation, continue to apply.

Thus, infringement actions brought prior to January 1, 2021 continue thereafter. However, while EU trademark and design courts in the EU 27 and in the UK will retain their jurisdiction, this does not answer the question of the relief they may grant, or, more generally, what the substance of their decisions will be. This is relevant because after December 31, 2020 EU trademarks and designs no longer apply in the UK, but are replaced by comparable UK trademarks and re-registered UK designs.

As regards cases pending before UK trademark and design courts, the UK Government has adopted provisions which give at least a partial answer to the question: In an infringement action, the UK court may prohibit the use of a sign infringing the comparable UK trademark or the use of a design infringing a re-registered design. In effect, the action for infringement of the EU trademark or design is automatically “converted” into an action for infringement of the comparable or re-registered right. In addition if a counterclaim is pending before the UK court seeking a declaration of revocation or invalidation of the asserted EU right, according to the UK legislation the court has the power to declare the revocation or invalidation of the comparable trademark or re-registered design.

UK legislation does not give an answer to the question of whether the UK court may also give judgment for the infringement of the EU trademark or design with effect in the EU 27 and may also revoke the asserted EU trade-

mark or design. Nevertheless, the statement in the Explanatory Memorandum accompanying the Statutory Instrument states: “The SI ensures that these cases continue to be heard, as if the UK were still a Member State with effect from [January 1, 2021], but also confirms that actions and remedies taken or granted by the Court are applicable to the comparable UK right only.”

Similarly, neither the Withdrawal Agreement nor any other provision of EU law gives an answer to the question whether an EU trademark or design court in the EU 27, while having jurisdiction also with effect to the territory of the UK, may take a decision finding infringement (or not) of the comparable trademark or the re-registered design. As regards pending counterclaims for revocation or validity, these continue under the rule explained above (see item 7).

2.10 Injunctions prohibiting the use of EU trademarks and designs

According to Article 67 (2) of the Withdrawal Agreement, in the UK as well as in Member States in situations involving the UK, judgments given in legal proceedings instituted before January 1, 2021 shall be recognized and enforceable in the UK and in the Member States.

As regards final judgments of EU trademark and design courts from a date prior to January , 2021, the UK Government has adopted legislation providing that – subject to any order of the court to the contrary – a relevant injunction will continue to have effect and be enforceable in the UK to prohibit the performance of acts which, at the time of the judgment, infringed an EU trademark or design. These injunctions will be deemed to

prohibit the infringement of a comparable trademark or a re-registered design deriving from an EU trademark or design.

2.11 Genuine use and reputation in cases involving comparable trademarks (EU) or (IR)

a. Genuine use

According to Article 54 (5) (b) of the Withdrawal Agreement, comparable UK trademarks are not liable to revocation on the ground that the corresponding EU trademark had not been put into genuine use in the UK before January 1, 2021.

The UK Government has implemented that obligation as follows:

If a period of five years of non-use expired prior to January 1, 2021, the comparable UK trademark is liable to revocation. If the effective Brexit day at the end of the transition period, on January 1, 2021, falls within the five-year period, in order for the comparable UK trademark to be liable to revocation, there must have been a continuous period of five years, including that part of the five years expired before January 1, 2021. In effect, that means that genuine use made of the EU trademark prior to January 1, 2021 must be taken into account when calculating the relevant period of five years.

The same rules apply when a comparable UK trademark is asserted in an opposition or invalidation proceedings against a later UK trademark or when an infringement action is based on a comparable UK trademark and the proprietor must prove genuine use within the relevant period of five years.

b. Reputation

According to Article 54 (5) (c) of the Withdrawal Agreement, the proprietor of a comparable UK trademark who had acquired reputation for the EU trademark in the EU prior to January 1, 2021 shall be entitled to invoke in the UK reputation-based rights by relying on reputation acquired in the EU by the end of the transition period, and thereafter the continuing reputation of that trademark shall be based on the use of the mark in the UK.

The UK Government has implemented this obligation by providing that, in cases where reputation is invoked by the proprietor of a comparable UK trademark, reputation in a period prior to January 1, 2021 shall be taken into account as if the reputation would be invoked by a registered EU trademark.

2.12 Professional representation

a. Representation before the EUIPO

Professional representation before the EUIPO is regulated in Regulation (EU) 2017/1001 and is, in principle, limited to professionals established in the EU. Thus, with the departure of the UK from the EU and the end of the transition period on December 31, 2020, professional representatives established in the UK may no longer act as representatives in proceedings before the EUIPO. As a transition measure, Article 97 of the Withdrawal Agreement provides that, where, before January 1, 2021, a person who is authorized to represent a natural or legal person before the EUIPO has represented a party in a procedure brought before that Office, that representative may continue to represent that party in that procedure. This

right applies to all stages of the procedure before the EUIPO.

The right to continue as representative ends with the conclusion of the procedure before the EUIPO, i.e. before the Board of Appeal if an appeal was brought. Representation before the General Court or the Court of Justice is not included. Some questions may arise to define “that procedure”. For example, the question may arise whether representation in the *ex parte* phase of the examination of an EU trademark also grants the right to represent in a subsequent opposition procedure.

b. Representation before the UKIPO

Under current UK law, there are no mandatory rules governing representation before the UKIPO. There is no requirement to appoint a representative for “foreign” participants in procedures before the UKIPO, and the requirement for having an address for service of communications from the UKIPO is satisfied by an address for service anywhere in the EU or in the European Eco-

nomie Area (which includes in addition to the EU Member States also Iceland, Liechtenstein, and Norway).

According to Article 55 (2) of the Withdrawal Agreement, proprietors of comparable UK trademarks and re-registered UK designs shall not be required to have a correspondence address in the United Kingdom in the three years after December 31, 2020. This means that the UK cannot change this during 2021 to 2023, but that “privilege”, which is limited to holders of rights previously registered in the EU in any event and does not extend to applications for registration, currently is not really a “privilege” because the UK has no such requirement.

Notably, and supplementing the information on professional representation previously available, where a representative had been appointed for the EU trademark or Community design, that same representative will automatically be recorded as the representative for the comparable trademark or re-registered design.

Remarks and Consequences

Proprietors of existing EU trademarks and designs and applications for such rights need to focus on their current and future perspectives for the United Kingdom. We will gladly assist you in this task!

As regards **professional representation**, we have explained that current representatives before the EUIPO will also be registered as representatives for the comparable trademark or the re-registered

design. However, we still recommend that holders of such rights explicitly instruct a representative to take over representation for the resulting UK trademark or design registration in order to avoid any loss of rights.

Proprietors of EU trademarks and designs automatically converted into comparable EU trademarks and re-registered designs must decide whether they wish or need to be

IP Report

Trademarks and Designs



BARDEHLE
PAGENBERG

protected in the UK. When these registrations expire in the near future, the focus must be on renewals.

Opt-out or non-renewal are available, should such protection not be desired.

As regards the possibility to convert pending EU trademark applications into UK trademark applications claiming the priority of the EU application within nine months (until September 30, 2021), proprietors should take into account the possibility of adapting the list of goods and services to the specific conditions in the UK.

What is very important: Any agreement relating to EU trademarks and designs, such as license agreements, security interests, etc. should be reviewed in order to determine whether such agreement, etc. applies to the UK and should be clarified, adapted or, if appropriate, re-negotiated to take into account the departure of the UK from the EU. **This also applies to demarcation agreements entered into in the past.**