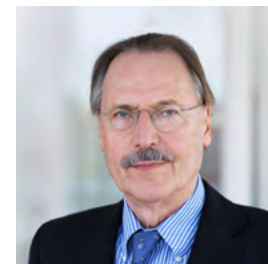


# IP Report

## Patents, Trademarks and Designs



**BARDEHLE  
PAGENBERG**



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### **Brexit: Address for service in proceedings before the IP Office of the United Kingdom**

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

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**In proceedings before the IP Office of the United Kingdom (UKIPO), representation by a lawyer or trademark attorney is not mandatory. However, parties to such proceedings must have an address for service. Such an address may currently exist anywhere in the EU or the EEA. The UKIPO has just announced that from January 1, 2021, onward for all new proceedings an address for service in the UK (or the Channel Islands or Gibraltar) will be required. Exceptions apply for comparable trademarks and re-registered designs resulting from exiting trademarks and designs registered at the EUIPO.**

**We have previously reported extensively about the effects of Brexit on existing European Union trademarks and design (see most recently [here](#)). The UK Government recently published guidance concerning the need of an address for service in proceedings before the IP Office of the United Kingdom (UKIPO).<sup>1</sup> We hereafter explain the situation as it will exist after 31 December 2020, i.e. when the transition period ends.**

#### **1. Current situation**

Currently, for all proceedings before the UKIPO an address for service in a Member

State of the European Union or in a Member State of the European Economic Area (EEA) (which extends to all EU Member States and Iceland, Liechtenstein, and Norway) is required. In effect this means that persons participating in such proceedings with an address for service in these Member States may represent themselves or be represented by a lawyer or professional representative with an address for service in any of these Member States.

#### **2. The Withdrawal Agreement**

Article 55 (2), second sentence, of the Withdrawal Agreement provides as follows:

“2. [...] Holders of intellectual property rights referred to in Article 54(1) shall not be required to have a correspondence address in the United Kingdom in the 3 years following the end of the transition period.”

#### **3. The situation as from 1 January 2021**

From 1 January 2021 onward persons participating in proceedings before the UKIPO will need an address in the UK or in Gibraltar or the Channel Islands (hereafter only: UK). This means that addresses in the EU or the EEA will no longer be accepted. The changes will not only apply to applications filed from that date, but also affect procedures relating to existing rights as explained hereafter.

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<sup>1</sup> <https://www.gov.uk/guidance/address-for-service-for-intellectual-property-rights-from-1-january-2021>

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### 3.1 New applications

From January 1, 2021, persons filing an application for a patent, a trademark or a design at the UKIPO you must have an address for service in the UK. This also applies to applications for trademarks and designs which will be filed claiming an EUIPO filing date as set out in Article 59 of the Withdrawal Agreement.

Companies filing their IP rights directly may have an establishment or subsidiary in the UK which could be indicated as the address. For persons having up to now filed applications in the UK through a lawyer or professional representative located in the EU or EEA but not in the UK, the requirement for an address for service in the UK now means in practice that they must appoint a UK representative, or representatives elsewhere, such as in Ireland, who have offices in the UK (including Northern Ireland).

### 3.2 Exceptions for comparable trademarks and re-registered designs

Pursuant to the Withdrawal Agreement, the UKIPO will create over 2 million UK rights based on existing EU registrations of trademarks and designs ('comparable trademarks' and 're-registered designs'). According to Article 55 (2) of the Withdrawal agreement, as referred to above, the UKIPO cannot require a UK address for service for these rights during the period of three years following January 1, 2021. Proprietors of comparable trademarks or re-registered design may change their address for service during the period of three years and can choose a new address anywhere in the EU or EEA or in the UK.

The limitation in the Withdrawal Agreement also means that the UKIPO will not require a UK address for service in any new contentious proceedings relating to these comparable rights, even if those proceedings will be started on or after 1 January 2021. These proceedings include oppositions, invalidations and rectification proceedings, including such actions brought on the basis of a comparable or re-registered right.

The exception for comparable trademarks and re-registered designs does not apply to comparable trademarks created from international trademarks registered under the Madrid Protocol and to re-registered designs created from international designs registered under the Geneva Act of the Hague Agreement designating the EU.

### 3.3 European Patents

Granted European Patents which designate the UK are transferred onto the UK Register automatically. No validation is required. They are transferred with the applicant's details only, as the UKIPO must have authorization (power of attorney) before it can recognise the appointment or change of any representative. This is current practice and will not change.

From 1 January 2021, if proprietors of a European Patent wish to appoint a representative, they will need to have an address in the UK. There may be occasions where there is already a UK address for service for a European Patent, for example, the address of a UK representative who acted before the European Patent Office. The UKIPO will still need authorization for that representative, showing that the representative is entitled to act on behalf of the proprietor in the UK.

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### 3.4 Challenging and defending rights

Registered trademarks, designs and granted patents may be challenged by means of revocation or invalidity proceedings.

Pending trademark applications may be challenged once published by means of an opposition. In case of such a challenge being brought against such an IP right on or after January 1, 2021, and where currently the address for service is outside the UK, an address for service in the UK must be provided in order to be a party in those proceedings. Similarly, in order to bring an opposition, an address for service in the UK must be provided, unless the challenge is based on a 'comparable right'. Also in cases of a challenge of a granted patent, an address for service in the UK must be provided.

### 3.5 Post-registration actions

With regard to registered trademarks or designs, a UK address for service is not needed for actions to update the register. This is in line with current processes which do not require a valid address for service. These include renewals, surrenders, adding details of a licence agreement, change of address, or correcting an error or omission in the register.

With regard to granted patents, renewal does not require a UK address for service. This is in line with the current renewal arrangements which do not require a valid address for service. For all other actions relating to granted patents, a UK address for service will be required.

A UK address will be required for all registered or granted rights if the request involves changing the nature of the right. This applies, for example, to requests for a division of a registered trademark.

### 3.6 Actions started before 1 January 2021

A UK address for service will not be required in the following scenarios:

#### a. Pending applications

For applications filed before 1 January 2021, a current non-UK address for service can be retained. However, if a proceeding is initiated against an IP right, such as an opposition against a trademark application, on or after 1 January 2021, a UK address will be required.

#### b. Proceedings that were ongoing before 1 January 2021

Where proceedings started before, and are still ongoing on, January 1, 2021, and where the party had an address for service in the EU or in the EEA, an address for service in the UK will not be required. This includes proceedings such as oppositions, invalidations, or revocations. In these pending proceedings, if a change of address is necessary, the change may also be made to an address in the EU or the EEA. If the previous address was in the UK, the new address must also be in the UK.

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### **c. Requests for *ex-parte* hearings, extensions of time and divisions relating to IP applications filed before 1 January 2021**

For requests of a hearing, an extension of time, or a request to divide an application, relating to an application filed prior to 1 January 2021, even if the request itself is made on or after 1 January 2021, a UK address for service is not required. Also, if a request is made after 1 January 2021 to divide an application filed before 1 January 2021, the new divisional application will be able to retain the same address for service as the original application.

If a trademark application was opposed before 1 January 2021, and as a request to divide the application is filed on or after 1 January 2021, the existing address for service may be retained for the original application and the divisional application.

### **d. Deferred designs**

Design applications filed at the UKIPO with a request for deferment of publication expiring after 31 December 2020, the existing address for service may be maintained, also for the request of publication.