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REV2 – replaces the notice (REV1)
dated 22 January 2018

NOTICE TO STAKEHOLDERS

WITHDRAWAL OF THE UNITED KINGDOM AND EU RULES IN THE FIELD OF EUROPEAN UNION TRADE MARKS AND COMMUNITY DESIGNS

Since 1 February 2020, the United Kingdom has withdrawn from the European Union and has become a “third country”.¹ The Withdrawal Agreement² provides for a transition period ending on 31 December 2020.³ Until that date, EU law in its entirety applies to and in the United Kingdom.⁴

During the transition period, the EU and the United Kingdom will negotiate an agreement on a new partnership, providing notably for a free trade area. However, it is not certain whether such an agreement will be concluded and will enter into force at the end of the transition period. In any event, such an agreement would create a relationship which in terms of market access conditions will be very different from the United Kingdom’s participation in the internal market,⁵ in the EU Customs Union, and in the VAT and excise duty area.

Moreover, after the end of the transition period the United Kingdom will be a third country as regards the implementation and application of EU law in the EU Member States.

Therefore, all interested parties, and especially economic operators, are reminded of the legal situation after the end of the transition period (Part A below). This notice also

¹ A third country is a country not member of the EU.

² Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community, OJ L 29, 31.1.2020, p. 7 (“Withdrawal Agreement”).

³ The transition period may, before 1 July 2020, be extended once for up to 1 or 2 years (Article 132(1) of the Withdrawal Agreement). The UK government has so far ruled out such an extension.

⁴ Subject to certain exceptions provided for in Article 127 of the Withdrawal Agreement, none of which is relevant in the context of this notice.

⁵ In particular, a free trade agreement does not provide for internal market concepts (in the area of goods and services) such as mutual recognition, the “country of origin principle”, and harmonisation. Nor does a free trade agreement remove customs formalities and controls, including those concerning the origin of goods and their input, as well as prohibitions and restrictions for imports and exports.

explains certain relevant separation provisions of the Withdrawal Agreement (Part B below).

Advice to stakeholders:

To address the consequences set out in this notice, stakeholders, in particular holders of a European Union (EU) trade mark, of a registered Community design or of an unregistered Community Design pursuant to Union law, applicants for an EU trade mark or for a registered Community design or any business operator who can potentially rely on such Regulations, are in particular advised to assess the consequences of the end of the transition period in view of this notice.

In particular, natural or legal persons that are domiciled or have their principle place of business or real and effective industrial or commercial establishment in the United Kingdom should consider the need to designate in a timely manner a representative authorised in accordance with Union law for the purpose of representation before the European Union Intellectual Property Office.

Persons currently authorised to represent a natural or legal person before the European Union Intellectual Property Office should examine, in case they are UK nationals and/or their entitlement to represent in trade mark or designs matters is based on a UK qualification, whether they continue to meet the relevant requirements for professional representation before the European Union Intellectual Property Office.

Please note:

This notice does not address

- EU rules on other intellectual property rights;
- rules on exhaustion of intellectual property rights.

For these aspects, other notices are in preparation or have been published.⁶

A. LEGAL SITUATION AFTER THE END OF THE TRANSITION PERIOD

After the end of the transition period, the EU rules in the field of European Union trade marks and Community designs, in particular Regulation (EU) 2017/1001⁷ and Regulation (EC) No 6/2002⁸, no longer apply to the United Kingdom. This has in particular the following consequences:

⁶ https://ec.europa.eu/info/european-union-and-united-kingdom-forging-new-partnership/future-partnership/preparing-end-transition-period_en

⁷ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, OJ L 154, 16.6.2017, p. 1.

⁸ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, OJ L 3, 5.1.2002, p. 1.

1. TERRITORIAL SCOPE: APPLICATIONS AND RIGHTS

After the end of the transition period:

- any application for a European Union trade mark or for a registered Community design pending at the end of the transition period will no longer cover the United Kingdom;
- any right granted by the European Union Intellectual Property Office will only cover the EU Member States;
- unregistered Community designs made available to the public in the manner provided for in Union law (Regulation (EC) No 6/2002) will only be valid and have effect in the EU Member States.

2. TERRITORIAL SCOPE: INTERNATIONAL REGISTRATIONS HAVING DESIGNATED THE EUROPEAN UNION

Holders of international registrations of trade marks and designs having designated the European Union before the end of the transition period pursuant to the Madrid system for the international registration of marks and the Hague system for the international deposit of industrial designs, should consider that, as from that date, those international registrations will continue to be valid in the EU Member States only.

3. LAW REGULATING OWNERSHIP OF EUROPEAN UNION TRADE MARKS

After the end of the transition period, Spanish law will regulate the ownership of European Union trade marks as objects of property which are owned by proprietors whose seat or domicile is in the United Kingdom, unless the proprietors have a real and effective establishment in an EU Member State, in which case the law of that EU Member State will apply.⁹

4. USE OF THE EUROPEAN UNION TRADE MARK IN THE UNITED KINGDOM AND MAINTENANCE OF RIGHTS

After the end of the transition period, use of a European Union trade mark in the United Kingdom (including for export purposes) does not qualify any more as use “in the European Union”¹⁰ for the purpose of maintaining the rights conferred by the European Union trade mark.

However, use of a European Union trade mark in the United Kingdom (including for export purposes) before the end of the transition period constitutes use “in the European Union” for the purpose of maintaining the rights conferred by the European Union trade mark – provided that, and in so far as, it relates to the relevant period for which use has to be shown.

⁹ Paragraphs 1 and 2 of Article 19 of Regulation (EU) 2017/1001.

¹⁰ Article 18 of Regulation (EU) 2017/1001.

5. SENIORITY CLAIMS IN EUROPEAN UNION TRADE MARKS

After the end of the transition period, all existing seniority claims in European Union trade marks based on national trade mark rights in the United Kingdom will cease to have an effect in the European Union.

6. REPRESENTATION BEFORE THE EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE

6.1. Obligation to be represented before the European Union Intellectual Property Office

After the end of the transition period, natural or legal persons that are domiciled or have a seat in the United Kingdom only will have to be represented before the European Union Intellectual Property Office in accordance with Article 120(1) of Regulation (EU) 2017/1001 (on the European Union trade mark) and Article 78(1) of the Regulation (EC) No 6/2002 (on Community designs) in all proceedings provided for in those two Regulations, other than the filing of an application for a European Union trade mark or an application for a registered Community design. See however section 6 of Part B of this notice as regards ongoing procedures before the European Union Intellectual Property Office.

6.2. Persons authorised to represent a natural or legal person before the European Union Intellectual Property Office

After the end of the transition period, the following persons will no longer meet the requirement set out by Article 120 of Regulation (EU) 2017/1001 and Article 78 of Regulation (EC) No 6/2002:

- in the case of legal practitioners within the meaning of Article 120(1)(a) of Regulation (EU) 2017/1001 or Article 78(1)(a) of Regulation (EC) No 6/2002:
 - a legal practitioner qualified in the United Kingdom;
 - a legal practitioner qualified in one of the Member States of the European Economic Area and having his or her place of business in the United Kingdom;
- in the case of professional representatives within the meaning of Article 120(1)(b) of Regulation (EU) 2017/1001 or Article 78(1)(c) of Regulation (EC) No 6/2002:
 - a national of the United Kingdom;
 - a national of one of the Member States of the European Economic Area having his or her place of business or employment in the United Kingdom;
 - a national of one of the Member States of the European Economic Area, having his or her place of business or employment in the European Economic Area but who

currently meets the requirement of point (c) of Article 120(2) of Regulation (EU) 2017/1001 or point (c) of Article 74) of Regulation (EC) No 6/2002 because of his or her entitlement to represent natural or legal persons in trade mark or design matters before the central industrial property office of the United Kingdom.

See however section 6 of Part B of this notice as regards ongoing procedures before the European Union Intellectual Property Office.

B. RELEVANT SEPARATION PROVISIONS OF THE WITHDRAWAL AGREEMENT

1. CONTINUED PROTECTION IN THE UNITED KINGDOM OF REGISTERED RIGHTS

Article 54(1)(a) of the Withdrawal Agreement provides for the continued protection of European Union trade marks in the United Kingdom. After the end of the transition period, the holder of a European Union trade mark registered in accordance with Regulation (EU) 2017/1001 before the end of the transition period is to, without any re-examination, become the holder of a comparable registered and enforceable trade mark in the United Kingdom under the law of the United Kingdom consisting of the same sign, for the same goods or services, with the following characteristics:

- the trade mark shall enjoy the date of filing or the date of priority of the European Union trade mark and, where appropriate, the seniority of a trade mark of the United Kingdom claimed under Article 39 or 40 of Regulation (EU) 2017/1001;
- the trade mark shall not be liable to revocation on the ground that the corresponding European Union trade mark had not been put into genuine use in the territory of the United Kingdom before the end of the transition period;
- the owner of a European Union trade mark that has acquired a reputation in the Union shall be entitled to exercise in the United Kingdom rights equivalent to those provided for in point (c) of Article 9(2) of Regulation (EU) 2017/1001 and point (a) of Article 5(3) of Directive (EU) 2015/2436 in respect of the corresponding trade mark on the basis of the reputation acquired in the Union by the end of the transition period and thereafter the continuing reputation of that trade mark shall be based on the use of the mark in the United Kingdom¹¹.

Article 54(1)(b) of the Withdrawal Agreement provides for the continued protection of registered Community designs in the United Kingdom. After the end of the transition period, the holder of Community design registered and, where applicable, published following a deferral of publication in accordance with Council Regulation (EC) No 6/2002, before the end of the transition period is to, without any re-examination, become the holder of a comparable registered and enforceable

¹¹ Article 54(5) of the Withdrawal Agreement

registered design right in the United Kingdom under the law of the United Kingdom for the same design, with the following characteristics:

- the term of protection of such registered design right under the law of the United Kingdom is to be at least equal to the remaining period of protection under Union law of the corresponding Community registered design right;
- the date of filing or date of priority of such registered design right under the law of the United Kingdom will be that of the corresponding Community registered design right¹².

However, pursuant to Article 54(3) of the Withdrawal Agreement, if a European Union trade mark or registered Community design is declared invalid or revoked or is cancelled in the Union as the result of an administrative or judicial procedure which was ongoing on the last day of the transition period, the corresponding right in the United Kingdom is also to be declared invalid or revoked or be cancelled¹³. The date of effect of the declaration or revocation or cancellation in the United Kingdom shall be the same as in the Union.

A trade mark or registered design right which arises in the United Kingdom in accordance with point (a) or (b) of Article 54(1) of the Withdrawal Agreement is to have as its first renewal date the renewal date of the corresponding intellectual property right registered in accordance with Union law.

Article 55 of the Withdrawal Agreement provides for the procedure in view of the registration of the trade marks or registered design rights referred to in points (a) and (b) of Article 54(1) of the same agreement:

- the registration of the trade mark or of the registered design right is to be carried out free of charge by the relevant entity in the United Kingdom¹⁴, using the data available in the registries of the European Union Intellectual Property Office;
- holders of European Union trade marks and of registered Community design concerned are not to be required to introduce an application or to undertake any particular administrative procedure in the United Kingdom;
- holders of the trade marks or registered design rights arising in the United Kingdom in accordance with points (a) and (b) of Article 54(1) of the Withdrawal Agreement are not to be required to have a correspondence address in the United Kingdom in the 3 years following the end of the transition period.

¹² Article 54(6) of the Withdrawal Agreement.

¹³ The United Kingdom is not be 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 trade mark or registered Community design do not apply in the United Kingdom.

¹⁴ Without prejudice to renewal fees that may apply at the time of renewal of the relevant trade mark or registered design right (Article 55(4) of the Withdrawal Agreement).

Holders of the trade marks or registered design rights arising in the United Kingdom in accordance with points (a) and (b) of Article 54(1) of the Withdrawal Agreement are not prevented from surrendering such right in the United Kingdom in accordance with the relevant procedure under the law of the United Kingdom¹⁵.

2. CONTINUED PROTECTION IN THE UNITED KINGDOM OF INTERNATIONAL REGISTRATIONS DESIGNATING THE UNION

Article 56 of the Withdrawal Agreement requires the United Kingdom to take measures to ensure that natural or legal persons who have obtained protection before the end of the transition period for internationally registered trade marks or designs designating the Union pursuant to the Madrid system for the international registration of marks, or pursuant to the Hague system for the international deposit of industrial designs, enjoy protection in the United Kingdom for their trade marks or industrial designs in respect of those international registrations.

3. CONTINUED PROTECTION IN THE UNITED KINGDOM OF UNREGISTERED RIGHTS

Article 57 of the Withdrawal Agreement provides for the continued protection of unregistered Community designs in the United Kingdom.

The holder of a right in relation to an unregistered Community design which arose before the end of the transition period in accordance with Regulation (EC) No 6/2002 is in relation to that unregistered Community design ipso iure to become the holder 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 term of protection of that right under the law of the United Kingdom is to be at least equal to the remaining period of protection of the corresponding unregistered Community design under Article 11(1) of that Regulation.

4. RIGHT OF PRIORITY WITH RESPECT TO PENDING APPLICATIONS FOR EUROPEAN UNION TRADE MARKS AND REGISTERED COMMUNITY DESIGNS

Article 59(1) of the Withdrawal Agreement provides that, where a person has filed an application for a European Union trade mark or a Community design in accordance with Union law before the end of the transition period and where that application was accorded a date of filing, that person is to have, for the same trade mark in respect of goods or services which are identical with or contained within those for which the application has been filed in the Union or for the same design, the right to file an application in the United Kingdom within 9 months from the end of the transition period.

An application made pursuant to Article 59(1) of the Withdrawal Agreement is to 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 trade mark

¹⁵ Article 55(4) of the Withdrawal Agreement.

of the United Kingdom claimed under Article 39 or 40 of Regulation (EU) 2017/1001.

5. JURISDICTION IN RESPECT OF LEGAL PROCEEDINGS INSTITUTED BEFORE THE END OF THE TRANSITION PERIOD

Article 67(1)(b) of the Withdrawal Agreement provides that, after the end of the transition period, the provisions regarding jurisdiction of Regulation (EU) No 2017/1001¹⁶ and of Regulation (EC) No 6/2002¹⁷ apply in the United Kingdom, as well as in the Member States in situations involving the United Kingdom, in respect of:

- legal proceedings instituted before the end of the transition period; and
- proceedings or actions that are related to such legal proceedings pursuant to Articles 29, 30 and 31 (on lis pendens) of Regulation (EU) No 1215/2012¹⁸.

6. REPRESENTATION IN ONGOING PROCEEDINGS BEFORE THE EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE

Article 97 of the Withdrawal Agreement provides that, where, before the end of the transition period, a person who is authorised to represent a natural or legal person before the European Union Intellectual Property Office in accordance with Union law was representing a party in a procedure brought before the Office, that representative may continue to represent that party in all stages of that procedure before the Office.

For that purpose, such representative is in every respect to be treated as a professional representative authorised to represent a natural or legal person before the European Union Intellectual Property Office in accordance with Union law.

The websites of the Commission on EU rules on intellectual property (https://ec.europa.eu/growth/industry/policy/intellectual-property_en) and of the European Union Intellectual Property Office (<https://euipo.europa.eu/ohimportal/en>) provide general information concerning Union legislation applicable to Union trade marks and Community designs. These pages will be updated with further information, where necessary.

European Commission
Directorate-General for Internal Market,
Industry, Entrepreneurship and SMEs

European Union Intellectual Property
Office

¹⁶ See Articles 122 and seq. of Regulation (EU) No 2017/1001.

¹⁷ See Articles 79 and seq. of Regulation (EC) No 6/2002.

¹⁸ Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, OJ L 351, 20.12.2012, p. 1.