

Brexit Update: EUIPO Confirms Business As Usual

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Following approval of the Withdrawal Agreement, the UK left the EU on 1 February 2020. We are currently in the transitional period (the "Transitional Period"), during which time EU law shall continue to apply to the UK.

This application of law extends to the EU Trade Mark ("EUTM") and Registered Community Design ("RCD") Regulations and their implementing instruments. Accordingly, until the end of the Transitional Period, the prosecution and management of trade marks and designs – including but not limited to existing arrangements for the rights of representation – before the EU Intellectual Property Office ("EUIPO"), will remain unaffected.

The Transitional Period is due to end on 31 December 2020 – although this may be subject to extension by agreement. Owners of, and applicants for, EUTMs and RCDs should use the coming months to plan their portfolio strategy during and after the Transitional Period.

Existing EUTM and RCD registrations

Grant of 'comparable' rights

The Withdrawal Agreement confirms that holders of EUTM and RCD registrations will be granted automatically and free-of-charge 'comparable' UK rights. Such 'comparable' UK rights will have the same filing and renewal date, and same priority and seniority claims, as their respective EU rights. The UK Intellectual Property Office ("UKIPO") has confirmed it will create records for the 'comparable' UK rights at the end of the Transitional Period.

Renewal

As the 'comparable' UK rights will not come into existence before the expiry of the Transitional Period, the UKIPO will be unable to send renewal notices six months ahead of the deadline. However, holders of 'comparable' UK rights due to expire before 30 June 2021 (i.e. six months after

the end of the Transitional Period) will receive a renewal notice as soon as possible after 1 January 2021, and will have six months from the notice date in which to pay the renewal fee (without any additional payment for late renewal).

- If an EUTM or RCD registration is due to expire on or after 1 January 2021, a separate renewal fee will be payable to the UKIPO. Opting to renew early at the EUIPO will not avoid the additional renewal fee.

Opting out

Owners of existing EUTMs and RCDs who do not wish to own a 'comparable' UK right will be able to opt out after the expiry of the Transitional Period, provided that the right has not been used, assigned, licensed, or otherwise been the subject of any agreement or proceedings instigated by, or with the consent of, the owner. To request an opt out, a short notice including details of any parties with an interest in the right (a template of which will be made available on 1 January 2021) requesting removal from the register must be submitted to the UKIPO.

Requirement of UK address for service

The Withdrawal Agreement confirms that there is no need to nominate a UK-based address for service for the first three years after the end of the Transitional Period in respect of the 'comparable' UK rights. However, the Withdrawal Agreement makes no provision regarding a UK address for service for all other rights on the UK register, i.e. existing rights and rights registered after 31 December 2020.

Currently, the UKIPO does not require a UK address for service for any rights, but if the UKIPO changes this policy, registrants and applicants for UK rights (excluding 'comparable' UK rights for the first three years after the Transitional Period) would need to arrange for the appointment of a UK address for service. The UKIPO would likely to give a specified period within which this needs to be completed.

Pending and proposed EUTM and RCD applications

Separate application to the UKIPO

The Withdrawal Agreement confirms that pending EUTM and RCD applications as at the expiry of the Transitional Period will not be automatically transposed onto the UKIPO register. Instead, applicants will have nine months to apply for a 'comparable' UK right, based on the EU application. The details must be the same, otherwise the 'priority' claim to the EU application will not be accepted.

It should be noted that deferred RCDs (whereby publication of the RCD is deferred for up to 30 months) will be treated as equivalent to a pending application, meaning that a separate application to the UKIPO will be required if publication is not requested and processed before 31 December 2020. As a result, applicants for RCDs (and 'comparable' UK rights) are likely to face a shortened deferment period – either through pressure to publish before the end of the Transitional Period, or because deferment in the UK is only for a maximum of 12 months.

Impact on filing timescales

Straight-forward applications for EUTMs are normally progressed from filing to registration within around six months, and RCDs are normally processed and registered within weeks of filing.

Statistics demonstrate that, year on year, the EUIPO receives a greater number of EUTM and RCD applications, and 2020 is unlikely to be an exception. Given the above, the EUIPO is likely to be under significant pressure – caused by increasing numbers of applications received, and also requests from applicants (and representatives) – to accelerate the EUTM or RCD registration process (insofar as this is possible), to avoid the need for a further application (and the costs thereof) for a separate UK right.

We recommend that applicants should:

- not delay unnecessarily in filing their applications for EUTMs and RCDs to allow sufficient time for any issues (deficiencies, queries, oppositions, etc.) to be addressed
- gather any necessary supporting documentation (e.g. certified copies of priority documents) before filing, or promptly thereafter, to ensure that any deficiencies identified do not disproportionately delay completion of the application process
- actively monitor the progress of pending EUTM and RCD applications (including deferred RCDs) to ensure that registration (and, if necessary, publication) is completed before the end of the Transitional Period.

Ongoing EUIPO proceedings

Oppositions and invalidations

For a time, the EUIPO suspended proceedings based on earlier rights originating from the UK, pending the outcome of the Brexit negotiations. This left parties in a difficult position, unable to progress proceedings in the usual manner, and in a precarious negotiating position given the lack of EUIPO deadlines to spur settlement discussions.

However, the EUIPO has now confirmed that all proceedings that involve grounds of refusal pertaining to the UK, earlier rights originating from the UK, or parties/representatives domiciled in the UK, will continue to run as normal until the end of the Transitional Period – a welcome communication as suspended actions can now recommence.

UK-based grounds for refusal

There are few grounds of refusal likely to pertain only to the UK: for example, applications facing refusal for being descriptive in the UK are also likely to require evidence of acquired distinctiveness in other English-speaking territories of the EU, such as the Republic of Ireland and Malta.

Whilst applicants facing such grounds may consider tactically seeking extensions, in order to avoid having to file supporting evidence in respect of the UK before the end of the Transitional Period, the Withdrawal Agreement confirms that, if the relevant EUTM or RCD is declared invalid or revoked as a result of EUIPO proceedings ongoing at the expiry of the Transitional Period, the 'comparable' UK right will also be declared invalid or revoked, unless the relevant grounds do not apply in the UK –

thereby meaning registrants are likely to have to adduce evidence in respect of the UK in any event.

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National Law Review, Volume X, Number 38

Source URL: <https://natlawreview.com/article/brexit-update-euipo-confirms-business-usual>