

ISSUE 03 | BREXIT EDITION

INSIDE THIS ISSUE

1 **Brexit checklist**

In light of the major changes we have created a short checklist of some key steps that we recommend rights holders consider taking now.

2 **Brexit latest**

The UK has left the EU and the transition period has come to an end. Major changes have occurred and there are approximately two million new comparable rights on the UKIPO Register: here we summarise the major day to day changes.

3 **Brexit news**

Further analysis on the recent major changes that affect pending actions at the EUIPO before 31 December 2020, use and reputation in the UK going forward and changes to geographical indications from 1 January 2021.



The New Year finally seems to bring some light at the end of the Covid-19 tunnel. The UK's vaccine roll out is in full flow and a return to some sort of normality seems likely in the not too distant future. A trade deal with the European Union has finally been agreed and the post-Brexit landscape is now upon us.

The UKIPO has already undertaken the herculean task of seamlessly creating more than two million comparable rights: more on this in our article on [page 3](#). The UKIPO has also published a detailed list of the significant changes due to Brexit on their website.

In light of these major changes, we have created a short checklist of some key steps that we recommend rights holders consider now.

Brexit checklist

- For pending EUTMs, consider whether you want to take advantage of the extended priority window to file for a UK comparable right, retaining the filing and priority date of the original EUTM – there is a deadline of **30 September 2021** to do this;
- For rights that are due for renewal in 2021, consider whether you wish to renew the ongoing EU right, the re-registered or comparable UK right, or both;
- Consider making a division in your records of evidence of use of your Trade Marks, clearly distinguishing between EU and UK use, from 1 January 2021;
- Consider notifying any licensees or holders of security interests that the UK re-registered or comparable rights are now in effect.
- Use the opt-out if needed to comply with your contractual obligations.

With the addition of our full service offices in Berlin and Frankfurt and Boulton Wade, S.L. in Madrid Spain we remain best placed to assist our clients through these challenging times. If you have any questions about the effects of Brexit, or any of the above, please contact your usual advisor.



Author: Henry Schlaefli, Trade Mark Attorney

Brexit latest

On 31 December 2020 the Brexit Transition Period finally ended, after the UK left the European Union (EU) on 31 January 2020.

On the first working day of 2021, the UK Intellectual Property Office (the UKIPO) confirmed that it successfully created more than two million comparable UK re-registered trade marks and re-registered UK designs, on its database. This mammoth task has taken place without any cost to rights holders and we extend our thanks to the UKIPO for their efforts in seamlessly incorporating the data of one of the world's largest trade mark registers into the UK domestic register (itself already a register of a significant size).

For any EU Trade Marks that were still pending prior to 31 December 2020 and for any pending EU Design applications (or those still subject to deferred publication) there is now an extended window to file a new UK application preserving the original filing and priority date of the original EU right, for those who wish to do so. The deadline to do this is now **30 September 2021** and official UK application fees are applicable.

Naming and searching

The new re-registered rights are now showing on the UK register and the UK has adopted a related naming convention to the EU rights from which they originate:

The last eight digits of the existing EU Trade Mark number have been used with the addition of the prefix "UK009". For International Registrations designating the EU the whole EU number has been used but prefixed with "UK008". It is thus immediately obvious to all, when reviewing a UK Trade Mark Registration, whether there is an EUTM alongside it and, if so, whether that is a designation or a standalone registration.

For Registered Designs, similarly, the UK has taken the registered Community design number prefixed with a "9" and for International Registrations designating the EU and Design View number prefixed with "8" (zeros have also been added to make it a 14 digit number).

The UKIPO has also expanded its search function so that comparable UK rights can easily be found. It is also worth noting that when conducting UK clearance searches, until the

30 September 2021 extended priority window ends, it will still be necessary to search the EUIPO register for any pending EUTMs that could still become UK comparable rights, as of their original dates.

Opting out

The concept behind the "comparable rights" is that, it is as if they have always existed alongside the EUTMs to which they correspond. As with any registration, it is possible to surrender an unwanted re-registered or comparable UK right, or to allow it to lapse by non-payment of renewal fees. However, each of those steps would mean that there had once been a UK registration which has ceased to have effect. There may be some rare cases where it is important that it had never existed at all. Thus, it is also now possible to opt out of the re-registered or comparable UK right. Opting out will mean that the re-registered UK design or comparable UK trade mark will be treated as if it had never been applied for or registered under UK law. Opting out is likely to appeal only to parties with special contractual agreements.

You may not exercise an opt out if you have assigned, licensed or entered into an agreement in relation to the re-registered UK design or comparable UK trade mark, or if you have already launched proceedings based upon it.

Opting out requires the submission of a special notification to the UKIPO and the relevant forms are now available on the UKIPO website.

Renewals

Maintenance of the re-registered UK designs and comparable UK trade marks will require payment of renewal fees to the UK Intellectual Property Office (UKIPO).

The re-registered designs and comparable trade marks **retain their existing renewal dates** of the original rights, such that they have the same ten-year term. As a corollary, this means that comparable UK trade marks based on subsequent EU designations of International registrations, no longer being connected to WIPO, run from their own designation date for renewal purposes, such that they have a ten-year term.

Re-registered UK designs and comparable UK trade marks have been created for Registered Community Designs, International (EU) Designs, Registered EU Trade Marks and International (EU) Trade Mark applications that were listed as lapsed on 31 December 2020 but that are still within the 6 month

grace period for payment of the overdue renewal fee with an additional fee. The created re-registered and comparable rights still have a **lapsed** status. Both can be renewed together by the payment of the overdue renewal fee and additional fee to the EUIPO/WIPO, in relation to the original EU/International right.

For newly created UK comparable rights that expire six months after 1 January 2021 the UKIPO will send a reminder on the actual date of expiry or as soon as practicable after that date. For that six-month period, which is the usual late-renewal six-month term, the usual additional charge for late payment is being waived.

Address for service

The address for service for the new UK comparable rights will initially be the same as that of the originating EU/International right (if there is one), since this information will be copied automatically from the EUIPO register. The Withdrawal Agreement guarantees the rights of that representative to remain for those newly created registrations, for three years; whereas all new applications now require an address for service located in the UK, Gibraltar, or the Channel Islands.

Other changes of note

There are a number of other changes, all of which are set out on the UKIPO's website [here](#). In particular there is important guidance regarding use requirements and maintenance of the UK comparable rights, reputation based on use outside the UK and in respect of pending cancellation actions. Please see our articles on **pages 5 and 6**.

How we can help?

Boult Wade Tennant's ability to assist clients with UK and EU rights post Brexit has not changed. As many of you know, in addition to our four offices in the UK, we have full service offices in Berlin, and Frankfurt in Germany, as well as Boult Wade, S.L. in Madrid Spain. We are here to help so if you have any questions about Brexit please contact us at boult@boult.com or via your usual adviser.



Authors: Henry Schlaefli, Trade Mark Attorney and Catherine Wolfe, Partner



Brexit news

Post-Brexit: pending actions at European Intellectual Property Office and how they have effect in the United Kingdom

Among the challenges facing business owners post-Brexit is a certain amount of red tape created by year-end split of EU block registrations (EUTMs) into an EU27 registration plus a UK “comparable right”.

Some of those registrations will have been under attack by means of an ongoing cancellation action as at 31 December 2020. If an EUTM is under attack this way, it will still have “registered” status until there is a decision on the cancellation action. That means that the owner will benefit from the generation of the UK comparable right, but with a note against it to the effect that there is an ongoing cancellation action in the EU. Whatever happens to the EUTM will generally also happen to the UK comparable right: if the EUTM is cancelled, the UK right will be cancelled too, on the same grounds. This will happen as soon as the UK Office is notified – by anyone – that the EU decision has become final.

There is an exception to this process called a “derogation”. If your EUTM has been cancelled on grounds which do not apply in the UK (say an earlier German registration only) then you can apply for derogation, and the UK Office will take a view as to whether your comparable right should stay registered. If you own the EUTM and you are the person who notifies the UK Office of the EUTM cancellation, you must send the derogation request with the cancellation notification. If on the other hand the UK Office becomes aware of the cancellation action by another means, it will write to you and give you one month to apply for derogation.

It is a good idea at this stage to keep an eye on any pending EUTM cancellation actions, so that at the end of those proceedings you will be able to take a view as to whether you will be entitled to seek derogation, and thus keep your UK comparable right.



Author: Felicity Hide, Partner

Use and reputation after the Brexit transition

An uninterrupted period of 5 years’ non-use in the UK usually renders a mark vulnerable to challenge.

However, with the newly created comparable UK rights (“UK clone”), this could be unfair. Therefore, use of the mark anywhere in the EU and/or in the UK, made in the five years **before** 1 January 2021, will still count for the next five years, to support both the UK clone and to support the EUTM. Use of the mark in the EU (outside of the UK) **after** 1 January 2021 will not support the UK clone, though of course it will support the EUTM registration. Similarly, use of the mark in the UK **after** 1 January 2021 will not support the EUTM, though it will support the UK clone.

Therefore a UK clone cannot be cancelled for a lack of UK use until 5 years after the end of the transition period, provided that the mark was in genuine use elsewhere in the EU at the end of the transition period.

Assessment of reputation

Reputation of a corresponding EUTM in the EU but not necessarily in the UK will be still be considered for the purposes of the UK clone if this use took place **before 1 January 2021**; and vice versa for EUTMs which had a reputation in the UK before Brexit.



Author: Naomi Jenkins, Trade Mark Attorney

Geographical Indications from 1 January 2021

Geographical Indication (GI) schemes protect the geographical names of food, drink and agricultural products. Now the transition period has ended, the UK has set up its own GI scheme, managed by the Department for Environment, Food and Rural Affairs (Defra), and it is open to producers from the UK and elsewhere.

The new UK scheme protects the geographical names of:

- food, drink and agricultural products;
- spirit drinks;
- wine; and
- aromatised wine.

It protects the following three designations of geographical indication:

- Protected Designation of Origin (PDO)
- Protected Geographical Indication (PGI)
- Traditional Speciality Guaranteed (TSG)

Existing products

All product names which were registered under the EU's GI schemes before the end of December 2020 now automatically have protection under the new UK GI schemes, as well as their continuing protection under the EU's GI schemes.

New product applications

From 1 January 2021, producers desiring the same scope of protection will need to apply separately: to the relevant UK scheme to protect a new product name in Great Britain, and/or to the relevant EU scheme to protect a new product name in Northern Ireland and the EU.

Producers in Great Britain will need to obtain protection under the new UK schemes before applying to the EU schemes.

Guidance on how to apply under the new scheme was published on 31 December 2020 and is available [here](#).

New GI logos

New UK GI logos to identify products protected under the new UK schemes are available to download and can now be used (since 1 January 2021).

Further information about the use of the logos can also be found at the link above.



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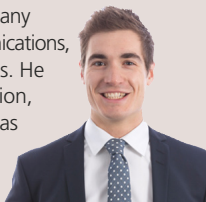


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