

Update on Brexit

14 November 2018

On 14 November 2018, the UK government and the European Commission agreed in principle the terms of an Agreement between the UK and the EU setting out the terms of an orderly withdrawal of the UK from the European Union. The full text of the Withdrawal Agreement can be viewed in [this link](#), with matters relating to intellectual property being set out in particular in Articles 54 to 61.



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Update

It cannot be guaranteed that the Withdrawal Agreement will be implemented by the UK parliament and the remaining 27 member states of the EU but, subject to its implementation, the main points relating to trade marks and designs (patents being largely unaffected as the EPO system is independent of the EU) are as follows:

- + The holders of EU Trade Marks and Designs registered before the end of the 'transitional period' (currently 31 December 2020 but potentially extendable) will become the holders of comparable registered and enforceable rights in the UK without the need for any re-examination (Article 54 (1)) or the need to make any payment (Article 55 (1)).
- + The corresponding UK rights will bear the same original filing date and, where appropriate, the same priority or seniority dates as the original EU Trade Marks and Designs (Articles 54 (5) (a) and 54 (6) (a)).
- + If an EUTM Registration or EU Registered Design is declared invalid, revoked and/or cancelled in the EU as the result of proceedings which were ongoing on the last day of the transition period, the corresponding right in the United Kingdom should also be declared invalid, revoked, or cancelled, except where the grounds for invalidity or revocation do not apply in the UK (Article 54 (3) second paragraph).
- + Where a new UK TM Registration is created corresponding to an existing EUTM Registration, the new UK registration will not be liable to revocation on the ground that the corresponding EU trade mark had not been put into genuine use in the UK before the end of the transition period, currently envisaged to be the end of 2020 (Article 54 (5) (b)). Use elsewhere in the EU during that relevant period will be taken into consideration.
- + The UK and the EU have agreed that the UK should provide equivalent national protection for marks and designs protected at the EUIPO under the Madrid Protocol for Trade Marks or Hague Convention for Designs (Article 56).
- + The holder of an unregistered Community design which arose before the end of the transition period shall become the holder of an enforceable intellectual property right in the UK affording the same level of protection as that provided for in the EU. The term of protection of that right in the UK will be at least equal to the remaining period of protection of

the corresponding unregistered Community design (Article 57).

- + Owners of an application for an EU trade mark or design filed before the end of the transition period will have a nine-month priority period from the end of the transition period to file an application in the UK for the same trade mark or design, with the resulting UK application enjoying the same filing date and where, appropriate, the same priority date as the original EU application irrespective of when the EU application was filed (Article 59).

At Abel & Imray, we have already established an office in Spain which will allow us to continue to represent clients before the EUIPO in all IP matters irrespective of when or in what circumstances Brexit takes place.

We shall of course keep you updated as and when we have further news to report. If you have any questions in the meantime, please get in touch with your usual Abel & Imray contact, or e-mail: brexit@abelimray.com

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