



WEBINAR SERIES 2020 – TOPIC 10/10 BREXIT UPDATE:

Legal Changes in Trademark and Design Law as of 1 January 2021 (English)

Webinar on 9 December 2020 – 5 p.m. to 6 p.m. CET

Speakers

LexDellmeier
intellectual property law firm

Alexandra Dellmeier

Rechtsanwältin / Attorney at Law (Germany)
Certified Intellectual Property Attorney

F. Andrea Breier, LL.M.

Rechtsanwältin / Attorney at Law (Germany)



Trademark Law Firm
of the Year in Germany 2019

Speakers & „Brexit“-Contacts



ALEXANDRA DELLMEIER

Attorney at Law / Certified IP Attorney
(Germany)

Rechtsanwältin / Fachanwältin für
Gewerblichen Rechtsschutz
23 years work experience

FREIA ANDREA BREIER

LL.M. (Intellectual Property)
Rechtsanwältin /
Attorney at Law (Germany)
15 years work experience





AGENDA

- I. Overview Brexit
 1. Situation until 31 December 2020
 2. Changes as of 1 January 2021
- II. Brexit – Impact on Trademarks
- III. Brexit – Impact on Designs
- IV. Conclusion
 1. Recommendation & Checklist
 2. Up-to-date Infos and Links
- V. Outlook on Webinars in 2021
- VI. Questions / Discussion



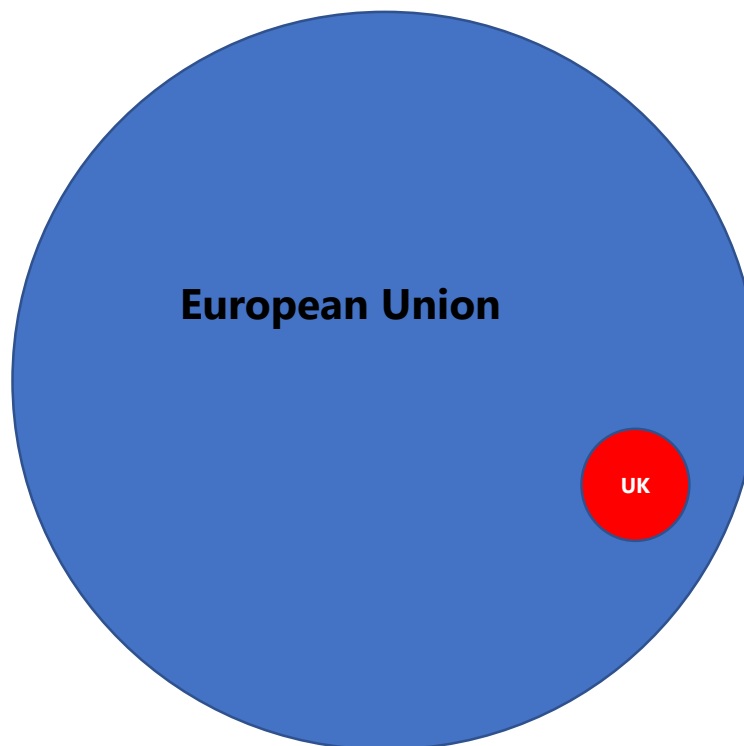
I. Overview Brexit

TRADEMARK

I. Overview Brexit

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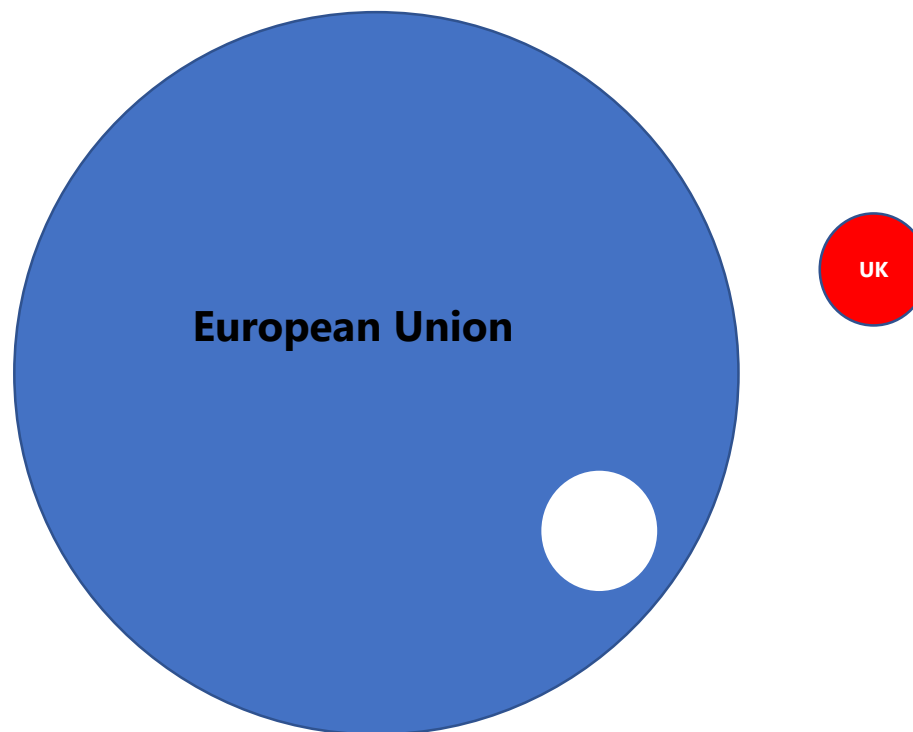
Geographical Scope of the EU until 31 January 2020



I. Overview Brexit

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Geographical Scope of the EU starting 1 February 2020

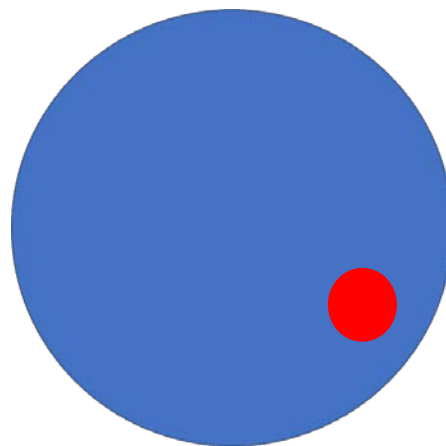


I. Overview Brexit

Brexit – Relevant Dates

BUT...

(Legal) Transition Period until 31 December 2020 → No changes



Starting 1 January 2021...

I. Overview Brexit – Changes starting 1 January 2021

European Union Trademarks (EUTMs) starting 1 January 2021*:

- a. Based on your EUTM that is **registered** with the EUIPO, the UKIPO will **automatically** create a comparable UK trademark. You will remain the owner of the existing EUTM and receive a national UK trademark **IN ADDITION**.

→ **EUTM + UK trademark**



* Also applicable regarding Registered Community Designs and applications

I. Overview Brexit – Changes starting 1 January 2021

European Union Trademarks (EUTMs) starting 1 January 2021*:

- b. Based on your EUTM **application not yet registered** with the EUIPO, you may **file** a corresponding UK trademark application with the UKIPO claiming the application and priority date of your EUTM application. You will remain the owner of the existing EUTM application and you can file an identical UK trademark application in addition.

→ **EUTM + possibility to file an identical UK trademark application**

ATTENTION: Need to act!



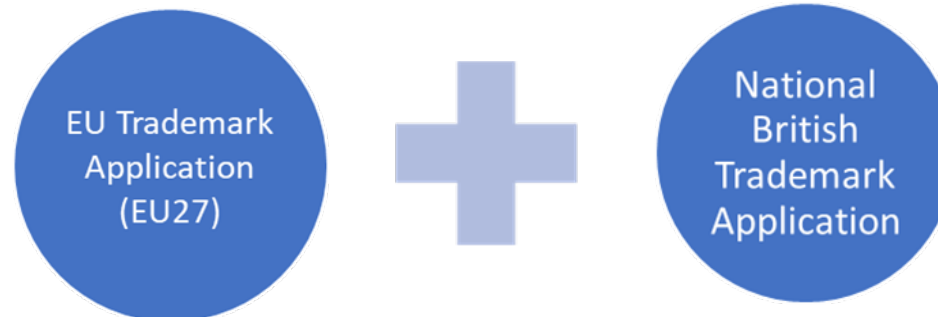
* Also applicable regarding Registered Community Designs and applications

I. Overview Brexit – Changes starting 1 January 2021

European Union Trademarks (EUTMs) starting 1 January 2021*:

- c. EUTM applications that you file with the EUIPO on 1 January 2021 and beyond, will not cover the UK. To gain protection there, you will have to file a completely independent UK trademark.

→ **EUTM application + additional UK trademark application (at the UKIPO or WIPO) necessary**



* Also applicable regarding Registered Community Designs and applications



II. Brexit – Impact on Trademarks

II. Brexit – Impact on Trademarks

II.

IMPORTANT Distinction

Registered
EU Trademark

31 December 2020

Applied for
EU Trademark

* Also applicable regarding Registered Community Designs and applications

II. Brexit – Impact on Trademarks

1. Effects of Brexit on registered EUTMs:

- Until 31 December 2020 protected in all 27 member states of the EU plus the UK
- Starting 1 January 2021 protected in all 27 member states of the EU, not in the UK

NOTE: Division of protection; the registered EUTM enjoys protection in the remaining 27 EU member states; the new national UK trademark gives protection in the UK

- As of 1 January 2021, use of an EUTM in the UK will no longer be considered use in the European Union
- Any such use of the mark until 31 December 2020 will, however, be considered relevant use
- Earlier national UK rights can no longer be used as basis of an opposition or invalidity proceeding against an EUTM or EUTM application

II. Brexit – Impact on Trademarks

2. Conversion of registered EUTMs into new, national UK trademarks:

- Starting 1 January 2021, the UKIPO will create a comparable UK trademark for all right holders with an existing EUTM (national file number: UK009 + last 8 digits of the EUTM)
- **NO** additional registration fee
- **NO** assessment of absolute or relative grounds for refusal
- **NO** UK registration certificate will be issued, but details about your new UK trademark will be available online on www.gov.uk/search-for-trademark

CONCLUSION:

Based on **ONE** EUTM, you will then own that **ONE EUTM + ONE** national UK trademark



II. Brexit – Impact on Trademarks

3. Scope of protection of UK trademark resulting from conversion:

- Same scope of protection as EUTM, but territorially restricted to the UK:
 - a. Identical mark
 - b. Identical specification of goods and services (or less)
 - c. Identical application and priority date
 - d. Identical renewal date

II. Brexit – Impact on Trademarks

3. Scope of protection of UK trademark resulting from conversion:

- **NO new 5-year grace period of non-use**, but where the 5-year period includes time before 1 January 2021, use in the EU will be considered
- A license or security interest recorded against an EUTM will continue to have legal effect in the UK (as if it applies to the new UK trademark)
- **Complete independency** of the new UK trademark from the EUTM it derived from
- **NOTE:** **Separate renewal** of the national UK trademark every 10 years **IN ADDITION** to renewal of the EUTM



II. Brexit – Impact on Trademarks

4. On 31 December 2020 not yet registered EUTM applications:

- Will **not** be **automatically** converted into national UK trademarks:
 - Filing of a separate trademark application in the UK will be necessary to obtain trademark protection there
- **ATTENTION: Need to act!**
- Address for service in the UK needed?
- Registration procedure **completely separate** from that for the corresponding EUTM application
- If application for UK trademark is filed on or before **30 September 2021:**
 - Identical application and priority date as the corresponding EUTM application

II. Brexit – Impact on Trademarks

5. Renewal of EUTM and national UK trademark resulting therefrom:

- Expiry date for EUTM = Renewal date

ATTENTION: Need to act!

Where an EUTM renewal date falls after 31 December 2020, **early payment** of the renewal fee at the EUIPO will have **no effect** in respect of the new UK trademark.

Thus, if you have renewed or intend to renew your EUTM between 1 July 2020 and 31 December 2020, but the actual expiry date is after 31 December 2020, the early payment will only renew the EUTM, but have no effect on the new UK trademark! The newly created UK trademark **will need to be renewed separately** to enjoy protection in the UK for another 10 years.



II. Brexit – Impact on Trademarks

5. Renewal of EUTM and national UK trademark resulting therefrom:

- **NOTE:**
 - Expiry date **on or before 31 December 2020:**
 - Renewal of the EUTM (including late renewal with additional fee) will **automatically renew** the new national UK trademark; no separate fee in UK
 - Expiry date **on or after 1 January 2021:**
 - **Separate** renewal fees are to be paid to the EUIPO (for the EUTM) and to the UKIPO (for the UK trademark)

ATTENTION: Need to act, no matter if the renewal fee for the EUTM has already been paid!



II. Brexit – Impact on Trademarks

6. Conversion of an International Trademark Registration designating the EU:

- **Status Quo:**

The European Union was designated for trademark protection in an International Registration and protection was granted by the EUIPO.

- **Effects of Brexit:**

- Regarding Brexit, the EU-designation of the International Registration will be treated like a „normal“ EUTM (see before, but official file number prefixed with „UK008“), that is:
- Until 31 December 2020 protection in all 27 member states of the EU **plus** the UK through the EU-designation of the International Registration

II. Brexit – Impact on Trademarks

6. Conversion of an International Trademark Registration designating the EU:

- **Effects of Brexit:**
 - Starting 1 January 2021 protection in all 27 member states of the EU, but not in the UK, through the EU-designation of the International Registration and **IN ADDITION** protection in the UK by way of the newly created **national UK trademark**
 - **NOTE:** The conversion will not create a UK-designation of the International Registration!

CONCLUSION: Based on **ONE** EU-designation of the International Registration, you will then own that **ONE** EU-designation of the International Registration + **ONE** national UK trademark

II. Brexit – Impact on Trademarks

6. Conversion of an International Trademark Registration designating the EU:

- The new national UK trademark will be identical to the EU-designation of the International Registration
- Renewal will have to be effected **at the UKIPO**, not WIPO
- If, by 31 December 2020, the International Registration has **not** (yet) been granted trademark protection in the European Union, a **separate national trademark application** must be filed with the UKIPO to gain protection in the UK (just like with „normal“ EUTM applications still pending on 31 December 2020)

ATTENTION: Need to act!



III. Brexit – Impact on Designs

III. Brexit – Impact on Designs

1. Registered Community Designs (RCDs):

- Essentially the same facts and procedure as for EUTMs:
 - Until 31 December 2020 protection of the **registered and published** RCD in all 27 member states of the European Union **plus** the UK
 - Starting 1 January 2021 protection of the **registered and published** RCD in the remaining 27 member states of the EU and **IN ADDITION** protection in the UK by way of a newly created national UK design (national file number: „9“ + complete EUIPO file number)

CONCLUSION: Based on ONE RCD, you will then own that ONE RCD + ONE national UK design

III. Brexit – Impact on Designs

1. Registered Community Designs (RCDs):

- International Design Registrations that have been granted design protection as RCDs in the European Union:
 - Regarding Brexit, the EU-designation of an International Design Registration will be treated like a „normal“ RCD (see before, but national UK file number: „8“ + official file number of the EUIPO + „0000“)

CONCLUSION: Based on ONE International Design Registration designating the EU, you will then own that ONE International Design Registration designating the EU + ONE national UK design

III. Brexit – Impact on Designs

1. Registered Community Designs (RCDs):

- The new, national UK designs are **completely independent** from the RCD or International Design Registration that they originated from and will need to be **renewed separately** (every 5 years up to a maximum of 25 years)
- RCD applications (including those filed by way of International Registration and those with deferred publication) that have **not yet been registered** on 31 December 2020 can be re-filed identically as national UK design applications until **30 September 2021** claiming the application and priority date of the original RCD application. Without such national application, your design **will not be protected** in the UK. The RCD, once registered, will not extend protection to the UK.

ATTENTION: Need to act!



III. Brexit – Impact on Designs

2. Unregistered Community Designs (UCDs):

- **Special Situation:**

UCDs that have come into existence automatically by first disclosure in the European Union (without being registered at the EUIPO) on or before 31 December 2020, will be protected for a total of 3 years from their coming into existence

- Until 31 December 2020 in all 27 member states of the EU **plus** the UK
- Starting 1 January 2021 in the 27 member states of the EU and **IN ADDITION** in the UK by way of an automatically created, national unregistered UK design



IV. Conclusion

TRADEMARK

IV. Conclusion

IV.

Recommendation, Checklist & To Do's



Review your trademark and design portfolio(s) – in December 2020 or latest January/February 2021



Clone your trademarks/designs (differentiate between applications and registrations) in your docketing system



Create new files for UK trademark(s)/design(s) in your docketing system



Download UK register extract after 4 January 2020, record new UK registration number and check & docket renewal deadlines

IV. Conclusion

Recommendation, Checklist & To Do's



Appoint UK counsel for UK trademarks/designs (counsel from other countries except the UK will not be able to represent in the UK and/or perform certain tasks – still under discussion with probably 3-year transition period); for security reasons – appoint UK counsel – just as in any other jurisdiction



Appoint EU counsel for EU trademarks/designs or record your company/yourself as an EU representative

NOTE: UK firms will not be able to further represent EU trademarks and designs as of 1 January 2021 – except for pending issues – boundaries under discussion

IV. Conclusion

Up-to-date information and links from official sources

- **European Intellectual Property Office (EUIPO):**

<https://euipo.europa.eu/ohimportal/en/Brexit-q-and-a>

- **United Kingdom Intellectual Property Office (UKIPO):**

<https://www.gov.uk/government/organisations/intellectual-property-office>

NOTE: The register and database of the UKIPO will NOT be working from 31 December 2020, 11 pm, until 4 January 2021, 4 pm, due to maintenance and duplication of UK marks/designs based on the EUIPO's database.



V. Outlook on Webinars in 2021

V. Outlook – Webinars in 2021

Webinar 1 in the Year 2021:

Wednesday, 3 February 2021, 5 p.m. to 6 p.m.: Intellectual Property Software (web- or server-based) for Trademarks, Designs, Utility Models and Patents (German)

held in cooperation with www.ip-servant.com and www.analog-it.de

... and more webinars to be announced in January 2021

All dates and topics with registration links:

<https://www.lexdellmeier.com/en/events>



VI. Questions and Discussion

TRADE MARK



**Thank you
for your
attention!**



Happy Holidays
Best Wishes
Happy New Year!



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Intellectual Property Law Firm
of the Year in Germany 2019

LexDellmeier
intellectual property law firm

Nymphenburger Str. 23 80335 Munich Germany



+49 + 89 55 87 987 - 0



+49 + 89 55 87 987 - 20



info@lexdellmeier.com



www.lexdellmeier.com

