

## **Trade marks and designs if there's no Brexit deal**

### **Summary**

How holders of EU and UK trade marks and registered and unregistered Community designs would be affected if the UK leaves the EU in March 2019 with no deal.

### **Detail**

If the UK leaves the EU in March 2019 without a deal, find out how this would affect:

- EU trade marks
- registered Community designs
- unregistered Community designs
- correspondence addresses and confidentiality for UK trade marks and designs

This is one of four notices covering intellectual property. The other notices cover:

- [patents](ADD WEBLINK)
- [exhaustion](ADD WEBLINK)
- [cross-border copyright](ADD WEBLINK)

A scenario in which the UK leaves the EU without agreement (a 'no deal' scenario) remains unlikely given the mutual interests of the UK and the EU in securing a negotiated outcome.

Negotiations are progressing well and both we and the EU continue to work hard to seek a positive deal. However, it's our duty as a responsible government to prepare for all eventualities, including 'no deal', until we can be certain of the outcome of those negotiations.

For two years, the government has been implementing a significant programme of work to ensure the UK will be ready from day 1 in all scenarios, including a potential 'no deal' outcome in March 2019.

It has always been the case that as we get nearer to March 2019, preparations for a no deal scenario would have to be accelerated. Such an acceleration does not reflect an increased likelihood of a 'no deal' outcome. Rather it is about ensuring our plans are in place in the unlikely scenario that they need to be relied upon.

This series of technical notices sets out information to allow businesses and citizens to understand what they would need to do in a 'no deal' scenario, so they can make informed plans and preparations.

This guidance is part of that series.

Also included is an [overarching framing notice](<https://www.gov.uk/government/publications/uk-governments-preparations-for-a-no-deal-scenario/>) explaining the government's overarching approach to preparing the UK for this outcome in order to minimise disruption and ensure a smooth and orderly exit in all scenarios.

We are working with the devolved administrations on technical notices and we will continue to do so as plans develop.

## **Purpose**

If the UK leaves the EU in March 2019 without a deal, find out how this would affect:

- registered Community designs
- unregistered Community designs
- correspondence addresses and confidentiality for UK trade marks and designs

## **Continued protection of registered trade marks and designs in the UK**

### **Before 29 March 2019**

EU trade marks and registered Community designs are intellectual property rights. They are granted by the EU Intellectual Property Office and are governed by EU regulations, including [Regulation (EU) 2017/1001 on the EU trade mark](<https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017R1001&from=EN>) and [Regulation (EC) No 6/2002 of 12 December 2001 on Community designs](<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex:32002R0006>). A business, organisation or individual that owns an EU trade mark or registered Community design (the right holder) has that right protected across all EU member states including the UK.

Right holders can also hold trade marks and registered designs through the international Madrid and Hague systems. These systems allow users to file one application, in one language, and pay one set of fees to protect trade marks and registered designs in up to 113 territories including the EU. Trade marks and registered designs obtained through these systems are also protected in the UK. An estimated combined figure of 1.7 million EU trade marks and registered Community designs are in force (2017 figures), along with over 200,000 international trade mark and design registrations covering the EU.

### **After March 2019 if there's no deal**

The government will ensure that the property rights in all existing registered EU trade marks and registered Community designs will continue to be protected and to be enforceable in the UK by providing an equivalent trade mark or design registered in the UK.

Businesses, organisations or individuals that have applications for an EU trade mark or Community design which are ongoing at the point of the UK's exit from the EU will have a period of nine months from the date of exit to apply in the UK for the same protections, retaining the date of the EU application for priority purposes.

The government will work, including with the World Intellectual Property Organization, to provide continued protection in the UK after March 2019 of trade marks and designs filed through the Madrid and Hague systems and which designate the EU.

Right holders with an existing EU trade mark or registered Community design will have a new UK equivalent right granted that will come into force at the point of the UK's exit from the EU. The new UK right will be provided with minimal administrative burden. The trade mark or design will then be treated as if it had been applied for and registered under UK law. This means that these trade marks and designs:

- will be subject to renewal in the UK
- can form the basis for proceedings before the UK Courts and the Intellectual Property Office's Tribunal
- can be assigned and licensed independently from the EU right

After exit, business, organisations and individuals with EU trade mark and Community design applications which are ongoing at the date of exit will be able to refile with the Intellectual Property Office under the same terms for a UK equivalent right, using the normal application process for registered trade marks and registered designs in the UK.

Applying for registered trade mark or registered design protection in the UK can be done via post or online. The online form and instructions for applying by post can be found [here](<https://www.gov.uk/how-to-register-a-trade-mark>) for trade marks and [here](<https://www.gov.uk/apply-register-design>) for registered designs.

This means that for a period of nine months from exit, the government will recognise filing dates and claims to earlier priority and UK seniority recorded on the

corresponding EU application. Right holders taking this step will need to meet the cost of refiling the application in accordance with the UK application fee structure.

The UK is also working, including with the World Intellectual Property Organisation, to provide continued protection in the UK from March 2019 onwards for trade marks and registered designs (filed through the Madrid and Hague Systems, and designating the EU as the area where they apply). This also includes practical solutions for pending applications.

## **Implications**

EU trade mark and registered Community design rights holders (businesses, organisations or individuals) may want to be aware of the following implications which will apply in a 'no deal' scenario:

- existing registered EU trade marks or registered Community designs held will continue to be valid in the remaining EU member states
- protection of existing registered EU trade marks or registered Community designs in the UK will be through a new, equivalent UK right which will be granted with minimal administrative burden
- right holders will be notified that a new UK right has been granted. Any business, organisation or individual that may not want to receive a new comparable UK registered trade mark or design will be able to opt out
- provision will be made regarding the status of legal disputes involving EU trade marks or registered Community designs which are ongoing before the UK courts and more information will be provided on this before the point at which the UK exits the EU
- applicants with a pending application for an EU trade mark or a registered Community design at the point of exit will be able to refile, within nine months from the date of exit, under the same terms for a UK equivalent right, retaining the EU application date for priority purposes
- applicants with pending applications for an EU trade mark or a registered Community design will not be notified and after exit will need to consider whether they refile with the Intellectual Property Office to obtain protection in the UK

- new applications will be eligible to be filed in the UK for UK trade marks and registered designs as they are now, and at [the cost specified in the UK fee structure](<https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trade-mark-forms-and-fees>)
- UK applicants, like EU and third country applicants, will continue to be able to apply for protection in the EU through an EU trade mark or registered Community design as they do currently

The government is working, including with the World Intellectual Property Organisation, to provide for continued protection in the UK from exit day onwards of registered trade marks and registered designs filed through the Madrid and Hague systems which designate the EU.

### **Continued protection of unregistered Community designs**

#### **Before 29 March 2019**

Unregistered Community Designs are intellectual property rights [governed by an EU Regulation](<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex:32002R0006>). A business, organisation or individual that owns an unregistered Community design (the right holder) currently has that right protected across all EU member states including the UK.

Unregistered Community designs protect a range of design features including two- and three-dimensional aspects such as surface decoration and product shape. The unregistered Community design provides three years of protection from the date that the design is first made available to the public ('disclosed') within the EU. The unregistered Community design is entirely separate from the UK's own design right, which protects product shape and configuration for a maximum period of fifteen years.

#### **After March 2019 if there's no deal**

The government will ensure that all unregistered Community designs which exist at the point that the UK leaves the EU will continue to be protected and enforceable in the UK for the remaining period of protection of the right.

In addition to this, the UK will create a new unregistered design right in UK law which mirrors the characteristics of the unregistered Community design. This means that designs which are disclosed after the UK exits the EU will also be protected in the

UK under the current terms of the unregistered Community design. This new right will be known as the supplementary unregistered design right.

Those UK unregistered design rights which exist at the point of exit will continue to be protected and the UK unregistered right will continue to exist for designs first disclosed in the UK. The UK will amend legislation to ensure that it functions effectively once the UK is no longer part of the EU system for designs.

## **Implications**

UK, EU and third country designers will be provided with continued protection for those designs first disclosed in EU27 member states and already protected by an unregistered Community design right at the point that the UK exits the EU. Through the new supplementary unregistered design right, designs which are disclosed in the UK after the UK exits the EU will be protected in the UK under the current terms of the unregistered Community design.

From that point:

- existing unregistered Community designs will continue to be valid in the remaining EU member states
- protection of existing unregistered Community designs in the UK will be provided for with no action required by the right holder
- provision will be made regarding the status of legal disputes involving unregistered Community designs which are ongoing before UK courts

## **Actions for businesses and other stakeholders**

The protection of existing unregistered Community designs in the UK will continue through a new equivalent right which arises automatically and with no action required by the right holder. For eligible designs disclosed after exit, the supplementary unregistered design right will arise automatically.

Businesses may wish to seek legal advice on how these arrangements could affect their business model or intellectual property rights.

## **Correspondence addresses and confidentiality for UK trade marks and designs**

**Before 29 March 2019**

UK withdrawal is expected to have consequences on the rights of UK businesses, organisations and representatives to represent themselves, and on their choice of representatives in relation to EU trade marks and registered Community designs. This notice does not cover those arrangements. Businesses, organisations or individuals that have EU trade mark or design applications or registrations at the EU Intellectual Property Office and have appointed UK-based representatives to act on their behalf, should check the information in the notices published by the EU Intellectual Property Office - [Notice to holders of and applicants for European Union trade marks and to holders of and applicants for Community designs]([https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/news/Brexit\\_preparedness\\_notice\\_on\\_IP.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/news/Brexit_preparedness_notice_on_IP.pdf)), and Part D of FAQ: ['Impact of the United Kingdom's withdrawal from the European Union on the European Union trade mark and the Community design']([https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/news/QandA\\_brexit\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/news/QandA_brexit_en.pdf)). They may also want to consider speaking to their current representative to find out what arrangements they have in place.

This notice also does not cover rules relating to legal professional representation and address for service requirements relating to intellectual property rights protected at the national level in individual European Economic Area (EEA) states.

When a business, organisation or individual (right holder) applies for a UK trade mark or design at the UK Intellectual Property Office, they must supply an address for service which is within the EEA (which currently includes the EU and hence the UK). UK right holders generally have a UK address for service, either because they appoint a UK-based intellectual property representative to act for them and represent their interests before the Intellectual Property Office, or they represent themselves. Some EEA business, organisations or individuals may also have a UK address for service, if they have appointed a UK intellectual property representative. There are, however, some UK businesses, and many from outside the UK, who have an address for service within the EEA but outside the UK.

Legal professional privilege is given to communications between registered intellectual property representatives and their clients. This means that in legal proceedings in the UK, for example, such communications are considered confidential and will not, generally, be shared with those on the other side of the dispute. This privilege is provided for in the UK's intellectual property legislation.

For trade marks and designs, legal professional privilege is given to trade mark attorneys registered in the UK. It extends to those intellectual property representatives who are not based in the UK but are on the 'list of representatives'

for the EU Intellectual Property Office for trade marks and designs. This list reflects the EEA geographical area.

### **After March 2019 if there's no deal**

There will be no immediate changes to the UK address for service and privilege rules.

### **Implications**

There will be no immediate implications for UK, EU or third country businesses. The current rules will remain in place at the point the UK exits the EU.

### **Actions for businesses and other stakeholders**

There are no immediate actions for UK, EU or third country businesses. The current rules will remain in place at the point the UK exits the EU.

### **More information**

The government will be working closely with business representatives, trade associations and other stakeholders on the implications of our plans.

In order to prepare the UK's statute book for its exit from the EU the UK government will be passing technical changes through statutory legislation in Parliament over the coming months, using powers under the EU Withdrawal Act 2018. The government will be publishing detailed guidance alongside any legislative changes and will work closely with business representatives, trade associations and stakeholders on the implications.

The Intellectual Property Office has also published a [factsheet on intellectual property rights and EU exit](<https://www.gov.uk/government/news/ip-and-brex-it-the-facts>).

This notice is meant for guidance only. You should consider whether you need separate professional advice before making specific preparations.

It is part of the government's ongoing programme of planning for all possible outcomes. We expect to negotiate a successful deal with the EU.

The UK government is clear that in this scenario we must respect our unique relationship with Ireland, with whom we share a land border and who are



co-signatories of the Belfast Agreement. The UK government has consistently placed upholding the Agreement and its successors at the heart of our approach. It enshrines the consent principle on which Northern Ireland's constitutional status rests. We recognise the basis it has provided for the deep economic and social cooperation on the island of Ireland. This includes North-South cooperation between Northern Ireland and Ireland, which we're committed to protecting in line with the letter and spirit of Strand two of the Agreement.

The Irish government have indicated they would need to discuss arrangements in the event of no deal with the European Commission and EU member states. The UK would stand ready in this scenario to engage constructively to meet our commitments and act in the best interests of the people of Northern Ireland, recognising the very significant challenges that the lack of a UK-EU legal agreement would pose in this unique and highly sensitive context.

It remains, though, the responsibility of the UK government, as the sovereign government in Northern Ireland, to continue preparations for the full range of potential outcomes, including no deal. As we do, and as decisions are made, we'll take full account of the unique circumstances of Northern Ireland.

Norway, Iceland and Liechtenstein are party to the Agreement on the European Economic Area and participate in other EU arrangements. As such, in many areas, these countries adopt EU rules. Where this is the case, these technical notices may also apply to them, and EEA businesses and citizens should consider whether they need to take any steps to prepare for a 'no deal' scenario.