

Brexit - The Calm after the Storm (IP rights only)

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The crucial date 31 December 2020 has passed and we are now a month into 2021. Even though, in the last two months, the relationship between the UK and the EU had highly dramatic moments, from an IP point of view, things went smoothly and with an incredible velocity, that we would not have predicted, if asked. It feels like the calm after the storm.

The UKIPO has managed to update the UK register with all EU comparable rights – more than 2 Million trade marks and designs. All cloned UK trade marks and designs deriving from EU rights were visible on the register within the first week of January 2021. Commercial database providers are still not able to list all the cloned marks, which is why when using these tools for searching, this needs to be taken into consideration.

The UKIPO has introduced a few new procedures and online tools to make the management of the EU comparable rights easier for rights owners and representatives. In our last article we have explained in detail when it is necessary and when it is recommendable to change to a UK, Gibraltar or Channel Islands representative or address for service. For holders or representatives who want to change the address for service for more than 50 rights, it is now possible to file bulk change of address requests.

The UKIPO has also introduced the forms to opt-out from the creation of a

comparable right. There are two separate forms for trade marks, one for opting-out of holding a comparable trade mark and one for opting-out of holding a comparable trade mark that was based on an International Registration. There is also a form to opt-out of holding comparable design rights. These procedures are without office fees, but when opting-out, it is necessary to inform interested third parties, for the opting-out to become effective.

It has been confirmed that comparable rights will not receive any registration certificates. This has led to a tiny gap in the rules, that we were able to clarify in the meantime. This gap regards trade mark applications in territories such as Jersey, Kiribati, St. Helena or the Solomon Islands, which require a UK trade mark as a basis and a certificate is needed. The issue that arose was whether comparable rights would qualify as a basis for such territories, and if a certificate could be released for such purpose. In the meantime, UK IPO has made the decision that certificates for comparable rights can be requested for that purpose at an additional fee of £20.

The EUIPO, on the other hand, has been slightly slower when implementing the consequences of the end of the Brexit transition period. This has especially been the case regarding proceedings such as oppositions or cancellations that were based on a UK right only. The EUIPO is still in the process of declaring the conclusion of these proceedings. We have received confirmation that concerned parties should treat such proceedings as still pending and ask for extensions of any deadlines if necessary.

Some patience is also required when it comes to information about cancellations of EUTMs and the consequences for their cloned UK comparable rights. Currently, cloned UK rights that are based on EUTMS subject to a cancellation, are listed in the UK register with the status 'registered' and with a note "The existing EU trademark to which this comparable right corresponds is subject to invalidation or revocation action, the outcome of which may be applied to this trademark.' This regardless if the cancellation decision for the EUTM dates before 1 January 2021 or after, or if the appeal deadline ended shortly before or after 1 January 2021, or is still ongoing or if an appeal is pending. We believe that this is a matter of processing information and we will monitor the situation, also because we are curious to see when UKIPO will follow EUIPO cancellation decisions.

As a result, we believe that the long preparation and the clarity in communication

of both offices has led to a smooth transition that has allowed IP practitioners to enter into a new routine.