

Brexit: Implications for Trade Marks and Domain Names



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Introduction

Following the expiry, on 31 December 2020, of the Brexit transition period, the UK is no longer a member of the European Union (EU).

The following pages set out how Brexit has affected rules and legislation relating to trade mark and domain name protection in the UK and elsewhere, and how Brexit impacts on that protection.

Dehns and Europe

For over 100 years Dehns has served its clients by securing and defending Intellectual Property Rights internationally and, in particular, in Europe. Dehns is a European firm; as part of our commitment and focus to provide a pan-European service to our clients, we established an office in Germany more than 40 years ago.

More recently, since the result of the original referendum in June 2016, we have worked to ensure that our UK and EU attorneys are still able to provide a full and comprehensive service to our clients across Europe and internationally, including handling all of our clients' European IP matters after Brexit, whether they relate to patents, designs or trade marks.

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Trade Marks

UK Trade Marks

The UK Intellectual Property Office (UK IPO) continues to handle applications for the registration of trade marks in the UK in accordance with the previous practice. However, anyone who filed a new UK Trade Mark application between 1 January and 30 September 2021 should bear in mind that an EUTM that was pending on 31 December 2020 might have formed the basis of a corresponding new UK trade mark application any time up until 30 September 2021. As any such UK applications were effectively back-dated to the EUTM filing date, this means that one cannot rule out the possibility that an earlier conflicting UK right now exists.

Changes to the UK IPO Address for Services Rules

Under new rules which came into force on 1 January 2021, all new UK trade mark, design and patent applications, and certain other UK IPO proceedings, need a UK (or Channel Islands or Gibraltar) Address for Service. This means that anyone wishing to file new UK applications, or initiate new proceedings in respect of an existing UK application or registration before the UK IPO must, if they are not themselves located in the UK, Channel Islands or Gibraltar, provide the name and address of an attorney or representative who is. The UK IPO no longer accepts an Address for Service in the EEA in such circumstances.

Do I need to do anything now?

That depends on what UK rights you hold. Since 1 January 2021, new applications for the registration of an EU Trade Mark (EUTM) have not extended to the UK. Existing registered EUTMs were automatically cloned to create comparable UK rights. It is not currently necessary for the owners of these comparable UK rights to have an Address for Service in the UK. However, from 1 January 2024, the UK IPO will require a UK, Gibraltar or Channel Islands Address for Service for any new contentious proceedings relating to a comparable right, including oppositions, invalidation/ cancellation actions or rectifications.

The position is different for comparable UK trade marks created from International trade marks designating the EU. The owners of such marks require a UK, Gibraltar or Channel Islands Address for Service for any new proceedings directed against or based on that right which were initiated on or after 1 January 2021.

UK IPO proceedings that were started before 1 January 2021 may continue with a UK or EEA Address for Service.

What can Dehns do for me?

Dehns can continue to represent you in all matters before the UK IPO in the usual manner. We can also:

- handle any new UK trade mark, design or patent applications
- handle any new proceedings before the UK IPO in respect of existing UK trade mark, design or patent applications/ registrations
- handle the renewal of any existing UK trade mark, design or patent registrations
- assume responsibility for any comparable UK rights created on 1 January 2021, and attend to their renewal.

European Union Trade Marks (EUTMs)

A European Trade Mark (EUTM) registration is obtained from the EUIPO (the European Union Intellectual Property Office, based in Alicante, Spain), and is a unitary right which automatically covers all Member States of the European Union. Once filed, an EUTM application is examined by the EUIPO to ensure that it satisfies certain official requirements. If requested at the time of filing the application, the EUIPO will carry out a search of the EUTM register and/or the national registers of certain EU Member States, the results of which are sent to the Applicant for information purposes only. After an EUTM application has passed the examination stage, it is published. If no opposition is filed during the publication period, or an opposition is filed but successfully overcome, the EUTM will proceed to registration, thereby providing the owner with trade mark protection throughout the EU for a period of ten years, renewable every 10 years.

Who can act as a representative before the EUIPO?

Any natural person who is a national of an EEA Member State, has his/her place of business or employment in an EEA Member State, and is entitled to represent natural or legal persons before the national IP Office of an EEA Member State, may act as a representative before the EUIPO. There is no requirement that the representative satisfy each of these requirements in the same EEA Member State.

Who is entitled to own an EUTM?

Any natural or legal person, including authorities established under public law, can be the proprietor of an EUTM. There is no requirement that the owner of an EUTM be a national of, or domiciled in, a Member State of the EEA. The UK's exit from the EU has not changed anything in terms of a person's or entity's entitlement to own an EUTM.

Are my EUTMs still protected in the UK?

Any EUTM (including International Trade Mark Registrations protected in the EU), that was registered or protected before or on 31 December 2020 ("exit day"), was automatically cloned, on 1 January 2021, to create a comparable national UK right, with the same filing date and, if appropriate, priority/seniority dates as the EU registration/designation. This was done at no cost to the trade mark owner. The same applied to any EUTM that expired in the 6 months prior to 1 January 2021 and was still within the 6 month grace period during which late renewal was possible. In this case, the comparable UK right held an 'expired' status, and its continued effect in the UK was dependent upon late renewal of the corresponding EUTM.

A comparable UK right derived from an EUTM or EU designation of an International Registration (IR) has the same renewal date as the EUTM/IR, except where the EU was the subject of a subsequent designation of an IR, in which case the UK renewal date is calculated on the basis of the date of the subsequent designation. As of 1 January 2021, EUTMs/International Registrations and their comparable UK rights must be renewed separately. For any renewal that fell due between 1 January and 30 June 2021, the UK IPO has automatically granted a 6-month grace period, during which the comparable UK registration can be late-renewed at no additional cost.

The owner of any EUTM application (including an International Trade Mark designating the EU) that was pending on 31 December 2020, had until 30 September 2021 to file a new UK application corresponding to the EUTM. The new UK application was effectively back-dated to the filing date of the EUTM application, and also retained any priority/seniority dates claimed under the EUTM application/designation.

EUTM registrations continue to confer protection in the EU Member States.

What has happened to any proceedings that were pending before the EUIPO on 31 January 2020?

Since 1 January 2021, it has no longer been possible to oppose or seek to invalidate an EUTM on the basis of UK rights.

Any existing EUTM oppositions or invalidity actions that were pending before the EUIPO on 31 December 2020 and were based solely on a UK right (or UK rights) have been dismissed. To the extent that any such actions included grounds based on rights in one or more EU27 country, these have continued as normal.

What about Trade Mark proceedings that were based on EUTMs and were still pending before the UK IPO on 31 December 2020?

Trade Mark opposition or invalidity proceedings before the UK IPO which were still ongoing on 31 December 2020, in which the holder of an EUTM has brought an action against a UK trade mark, have continued as normal and have been, or will be, decided on the basis of the law as at 31 December 2020.

Will my UK comparable right be affected by the outcome of any EUTM proceedings that are concluded after 31 December 2020?

That depends on what type of action it is.

Where an EUTM registration is subject to a **Cancellation or Invalidity action** that was still ongoing before the EUIPO on 31 December 2020, a new UK comparable right will have been automatically created, but the final decision in the EUIPO action will affect the new UK right as well, **unless the grounds for cancellation or invalidity do not apply in the UK**. For example, a successful invalidity action against an EUTM registration based solely on earlier German rights would not result in the UK comparable registration being cancelled, but a successful non-use cancellation action against an EUTM registration would result in the UK registration also being cancelled.

Where an EUTM application is subject to an **Opposition** which was pending on 31 December 2020, the outcome will not affect any comparable UK application which was filed between 1 January and 30 September 2021.

Will use of my mark in the UK still be enough to maintain my EUTM registration?

Use of an EUTM in the UK (including for export purposes) before 1 January 2021 does constitute use “in the European Union” for the purpose of maintaining the rights conferred by the EUTM, but only where, and insofar as, such use relates to the relevant period for which use has to be shown. This means that use in the UK will, in due course, cease to constitute genuine use for the purposes of maintaining an EUTM.

Will use of my mark in the EU be enough to maintain my comparable UK registration?

For the purposes of avoiding a non-use challenge, any use of a comparable UK right in the EU (whether in the UK or not) prior to 1 January 2021 counts as use of the comparable UK right. Where the 5-year non-use period includes time before 1 January 2021, use in the EU will be considered. Where the 5-year non-use period includes any time after 1 January 2021, use outside of the UK within that period will not be taken into account.

Do I need to do anything now?

You do not need to do anything in order to ensure the continued protection of any existing EUTM registrations. These continue to confer protection in the EU Member States (provided they are renewed), and have already been cloned to create comparable UK rights, as explained above.

If you have any EUTMs that were pending on 31st December 2020, and you wish to pursue protection of those marks in the UK, fresh UK applications will be required. As referred to above, they will need a UK Address for Service.

If you own an EUTM that has only been used in the UK, you should think about extending that use to current EU Member States to ensure that your EUTM does not become vulnerable to cancellation.

How can I obtain protection for my trade marks in the UK and EU now that the UK is no longer a member of the EU?

On 1 January 2021, EUTM applications ceased to extend to the UK. Therefore, should you wish to protect any new trade marks in the UK, you will need to file a UK application (or designate the UK under an International Application/ Registration). If protection is required in the EU Member States, you will need to file a separate EUTM application (or designate the EU under an International Application/Registration).

What can Dehns do for me?

As we have offices in the UK and the EU, Dehns is able to handle all new and existing UK and EU trade mark matters.

International Trade Marks

The Madrid System is governed by the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Protocol). The system is administered by the World Intellectual Property Organization (WIPO). As this is an international treaty, it is independent of the UK's membership of the EU.

The Madrid System allows for the central filing of an application for the international registration of a trade mark, designating any number of the 108 Contracting Parties. Where an International Application complies with the applicable requirements, the mark is recorded in the International Register and published in the WIPO Gazette of International Marks. WIPO then notifies each Contracting Party in which protection has been requested. Each designation is then examined by the relevant national Intellectual Property Office according to local law/practice and, if successful, protection is granted in that territory.

Both the UK and EU are Contracting Parties to the Madrid Protocol.

There has not been any change to the Madrid System, the UK's participation in that system, or the practice before the various Offices carrying out services in relation to International Trade Mark Registrations, as a result of Brexit.

Who can act as a representative before WIPO?

The Madrid System does not provide for any requirement as to professional qualification, nationality, residence or domicile in order to be appointed as a representative before WIPO.

Therefore, there is no official list of representatives before WIPO. However, before you can file an International Application, you need to have already registered, or have filed an application to register, the same mark in your "home" IP office. The International Application has to be submitted through this same IP Office, which then certifies the Application and forwards it to WIPO. Your WIPO representative must therefore be able to file applications in the territory of your "home" IP office.

Are my International Registrations still protected in the UK?

The provisions outlined above in the context of EUTMs also apply to EU designations of International Registrations. EU designations of International Registrations that were protected before 31 December 2020 have been automatically re-registered as national UK Trade Mark registrations (not UK designations), retaining the filing date and, if appropriate, priority/seniority date(s) of the EU designation. Again, protection for the remaining EU Member States remains unaffected.

EU designations of International Registrations that were pending on 31 December 2020 have not been automatically re-registered in the UK. Until 30 September 2021, their owners were able to re-apply for UK protection, retaining the benefit of the EU designation (and, if applicable, priority) date.

Do I need to do anything now?

If none of your International Registrations are protected as EUTMs, then you do not need to do anything, as they will not have been affected by the UK's exit from the EU. In particular, it is important to note that International Registrations that specifically designate the UK are unaffected by the UK leaving the EU.

If you own an International Registration that is protected as an EUTM, you do not need to do anything to ensure its continued protection in the EU and UK. As explained above, your International Registration continues to confer protection in the EU Member States, and has already been cloned to create a comparable UK right that is entirely separate from the International Registration.

If you own an International Application/Registration with an EU designation that was pending on 31 December 2020, and wish to pursue protection in the UK, you will need to re-apply for UK protection either by filing a UK application (ensuring a UK Address for Service is included) or by applying to extend the International Application/Registration to the UK.

With reference to the UK IPO's new Address for Service rules, please note that the provisions allowing for the three-year retention of an EEA Address for Service do not extend to UK trade marks created from International Registrations designating the EU, and the owners of such rights will require a UK, Gibraltar or Channel Islands Address for Service if any new proceedings directed against or based on such a right are initiated on or after 1 January 2021.

How will I obtain protection for my trade marks in the UK under an International Registration following Brexit?

New International Applications designating the EU and filed on or after 1 January 2021 do not extend to the UK. Thus, if protection is required in the UK, separate EU and UK designations under the International Application will be required if you do not already have a UK application or registration. In many cases, UK clients will already have a UK application for, or registration of, the relevant mark, as this will be needed to serve as the "home" application/registration upon which the International Application will be based.

What can Dehns do for me?

Thanks to having offices in the UK, EU and EEA, we can continue to file and prosecute International Applications based on either UK, EU or Norwegian applications/registrations, and represent clients before the UK, EU and Norwegian IP Offices and before WIPO in connection with such matters, instructing attorneys in designated territories in the event of local representation being required.

We are able to continue filing and prosecuting International Applications based on UK applications/registrations and designating any of the 108 Contracting Parties, and continue representing clients before the UK IPO and WIPO in connection with those Applications, in the usual manner. Since we have offices in Germany and Norway, and therefore continue to satisfy the requirements for acting as representatives before the EUIPO, we are also able to continue handling International Applications/Registrations based on EUTMs on behalf of our clients, and handle the prosecution of EU and Norwegian designations before the EUIPO where necessary.



Domain Names

According to the current eligibility criteria for .eu domain names that came into force on 19 October 2019, an owner must be:

- An EU citizen, independently of their place of residence; or
- A natural person who is not an EU citizen but who is a resident of an EU Member State; or
- An undertaking that is established in the EU; or
- An organisation that is established in the EU, without prejudice to the application of national law.

When the Brexit transition period ended, EURid (the registry manager of .eu domain names) suspended all .eu domain names owned by UK citizens and companies.

Until 31 March 2021, the owner of a suspended .eu domain name could update its contact data at EURid to demonstrate compliance with the above-mentioned criteria. Thereafter, on 1 April 2021, the status of all remaining suspended .eu domain names was changed to 'withdrawn'. The owner of a withdrawn .eu domain name may still update its contact data at EURid. However, on 1 January 2022, all remaining withdrawn .eu domain names will be revoked and will subsequently become available for general registration.

Other Consequences

Litigation and Pan-EU Injunctions

UK courts can no longer adjudicate on EU trade marks (except in the case of certain proceedings that were on-going on 31 December 2020), nor can they issue pan-EU injunctions. Similarly, new pan-EU injunctions granted by EU courts no longer apply to the UK.

However, any pan-EU injunction that was issued by the court of an EU member state before 1 January 2021 will still be recognised and enforced by the UK courts. Where an injunction prohibits an act in the UK which would, had an EUTM still been in force in the UK, have infringed that EUTM, the injunction will be treated as if it applied equally to the newly created comparable UK right, for as long as the comparable right remains valid and effective in the UK. However, existing injunctions may be potentially subject to challenge in circumstances where a UK court would not have deemed there to be an infringement in the UK. It remains uncertain whether a pan-EU injunction granted by a UK court prior to 31 December 2020 will be recognised and enforced by the courts of EU member states.

Any proceedings relating to EUTMs that were ongoing in the UK courts on 1 January 2021 will continue to be heard as if the UK were still a member of the EU, though any actions taken or remedies granted by the UK court shall apply to the comparable UK right(s) only.

Any EUTM owner wishing to apply for an injunction in respect of an infringement occurring in one or more EU Member States and in the UK must now bring two separate sets of proceedings – one before a designated EUTM court and one before the UK courts

Contracts, Agreements, Undertakings etc.

Parties to, or beneficiaries of, co-existence agreements, licences, undertakings, consents or other contracts/agreements where the territorial scope, jurisdiction and/or governing law are defined by reference to the “European Union”, should, if they have not already done so, consider whether these agreements need amending, or whether new agreements need to be drawn up, in order to ensure that they still accurately reflect the original intention of the parties. In cases where the issue of the territorial scope of an Agreement may be in doubt post-transition period, clients should seek legal advice as soon as possible.

Agreements such as co-existence agreements and licences that covered EUTMs are, in the absence of evidence that said documents were not intended to have effect in the UK, deemed to cover the comparable UK rights. This means that if, for example, the owner of an EUTM had, prior to 1 January 2021, consented to you doing something in the UK, they will not be able to bring an infringement action against you after that date, based on the comparable UK right.

Licences/Security Interests

A licence of a registered EU right that applied to the UK prior to 1 January 2021 continues to apply to the UK with respect to the comparable UK right under the same terms, subject to any modifications that might be required for their application in the UK.

However, registrable transactions that were recorded against an EUTM as at 31 December 2020 have not been automatically recorded against the comparable UK registration. So, where a licence or security interest has been recorded on the EUTM register, and subject to any contractual provisions to the contrary, the transaction may need to be re-recorded against the comparable UK registration.

Exhaustion of Rights

As the UK is no longer part of the European Economic Area (EEA), an IP owner's rights in the EEA are no longer exhausted in situations where the goods have already been placed on the market in the UK, and the IP rights owner is still able to prevent those goods from being re-sold anywhere in the EEA.

However, for the time being at least, IP rights that were/are exhausted both in the EEA and in the UK before 1 January 2021 remain exhausted both in the EEA and in the UK. This means that where an IP rights owner had, prior to 1 January 2021, lost its right to control the distribution and resale of its goods that had already been placed on the market within the EEA by or with the consent of the rights owner, the UK continues to recognise the exhaustion of that right. The UK Government is deciding which system of exhaustion to adopt.

Applications for Action (AFAs) under the EU Customs Regulation

Rights holders who wish their rights to be enforced by Customs in the UK and EU require two separate AFAs – one for the UK and one for the EU27 countries. A UK AFA must be filed via UK Customs using the new form which is available on the [GOV.UK](https://www.gov.uk) website. A Union AFA must be filed via the Customs office of one of the EU27 or via the EUIPO's IP Enforcement Portal.

With regard to existing AFAs filed prior to 1 January 2021, the following apply:

- An existing AFA covering the UK and filed via UK Customs will remain in place until the AFA expires.
- An existing Union AFA covering the UK that was filed via the Customs office of one of the EU27 is no longer valid in the UK. Should the rights holder wish their rights to be enforced by UK Customs, they will need to file a new UK AFA via UK Customs.
- An existing Union AFA submitted to Customs in one of the EU27 countries remains valid in the EU27.
- An existing Union AFA filed via UK Customs is no longer valid in the EU27. Should the rights holder wish their rights to be enforced by Customs in some or all of the EU27 after, they will need to file a new Union AFA via Customs in one of the EU27.

Should you require any further advice or guidance on post-Brexit IP implications and how Brexit may impact your IP, please do not hesitate to contact us:

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