

Brexit Newsletter



Implications of the No-Deal-Brexit for trademarks and designs

The British Parliament has voted against the withdrawal agreement between the United Kingdom (UK) and the European Union (EU) that should have regulated the withdrawal from the EU with a transition period. This means that probably the UK will leave the EU on March 29, 2019 without a withdrawal agreement.

These circumstances have in particular implications for European Union trademarks and Community designs because they do not cover the UK anymore after the withdrawal of the UK from the EU.

The Government of the UK has already provided a guideline concerning this topic (<https://www.gov.uk/government/publications/trade-marks-and-designs-if-theres-no-brexiteal/trade-marks-and-designs-if-theres-no-brexiteal>).

1. EU trademarks and Community designs

According to this guideline, EU trademarks and Community designs which are ongoing on the day of the withdrawal of the UK from the EU will automatically be “cloned”. This means that national British trademarks respectively designs will be registered that correspond to the respective EU trademark or the respective Community design. Thereby, the proprietors of EU trademarks and Community designs obtain the same protection in the UK as before by the EU trademark and the Community design. This covers the seniority. In the case that no protection is required in the UK, there exists the possibility to opt out and the national right will be deleted. However, all this applies only for EU trademarks and community designs that were already registered on the date of the exit.

2. Pending EU trademark and Community design applications

Pending applications will not be „cloned“. They will lose their territorial effect in the UK. However, for a period of 9 months from exit, proprietors of EU trademark and Community design

applications which are ongoing at the date of exit will be able to file corresponding national applications which will obtain equivalent protection as the EU right. This covers the seniority.

3. International Registrations

These same provisions outlined above will apply to international registrations of trademarks and designs designating the EU.

4. Unregistered Community designs

Unregistered Community designs that enjoy protection in the EU for three years after their disclosure in the EU should continue to be protected and enforceable in the UK for the remaining period from the three years after the exit.

Furthermore, it is planned to create an unregistered design right in the UK (that does not exist yet in the UK) for designs first disclosed in the UK.

5. Exhaustion

Currently, the UK is part of a regional European Economic Area (EEA) exhaustion scheme, meaning that IP rights are considered exhausted once they have been put on the market anywhere in the EEA by, or with the consent of, the right holder.

Intellectual property-protected goods placed on the EEA market by, or with the consent of, the right holder after the UK has exited the EU will continue to be considered exhausted in the UK. However, this does not apply vice versa. Goods placed on the UK market by or with the consent of the right holder after the UK has exited the EU will not be considered exhausted in the EEA anymore. This means that businesses exporting or importing these goods from the UK to the EEA might need the right holder's consent.

<https://www.gov.uk/government/publications/exhaustion-of-intellectual-property-rights-if-theres-no-brexiteal/exhaustion-of-intellectual-property-rights-if-theres-no-brexiteal>

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