



The Changes Coming To
Intellectual Property Protection in the UK
Due To Its Impending Brexit

Kevin A. Thompson
Ladas & Parry LLP

Outline

- Brexit – December 31, 2020
- Trademark Overview
- Copyright Overview
- Patent Overview
- Trade Secrets Overview

Brexit

- Public referendum – June 2016
- End of Membership – January 31, 2020
- Transition Period ends –
December 31, 2020

- Small chance of an extension if agreed to
by July 1, 2020

Trademark



European Union TM



EUTM Registrations

- As of December 31, 2020, all owners of EUTM registrations will receive a corresponding UK registration.
- Same duration as the EUTM registration.
- No paper certificate, the details will be available online.

Pending EUTM Applications

- Owners of Applications still pending as of December 31, 2020 will have 9 months to apply for a UK trademark (September 30, 2021).

Expired EUTM Registrations

- All registrations which expired in the 6 months before January 1, 2021 will have a corresponding UK registration created, but marked as expired.
- If renewed late, the UK registration will be renewed.
- If not renewed, it will be removed from the registry.

International registrations designating the EU

- The UK will take all necessary steps to ensure that international trademark registrations designating the EU and protected in the EU before expiration of the transition period will be protected in the UK.

Revocation for Non-Use

- UK registrations are vulnerable to cancellation for non-use for periods of five years. If the five year period includes time before January 1, 2021, use in EU member states will be considered.

Fame/reputation

- Before January 1, 2021, reputation in all EU member states will be considered. After that, only ongoing recognition within the UK will be considered.

Renewals

- Separate fees will need to be paid for EUTM and UK renewals. No separate reminder will be sent by the UK IPO for registrations due within 6 months of January 1, 2021.
- For these trademarks, a notice will be sent on or about the expiration date, and there will be a six month period for late renewal.

Pending Proceedings

- If an EU action is pending as of January 1, 2021, and the EU registration is later cancelled, the UK registration will also be cancelled, unless the grounds is not available under UK law.
- EU law will still apply to UK proceedings pending as of January 1, 2021, but UK courts will not be able to issue EU-wide injunctions.

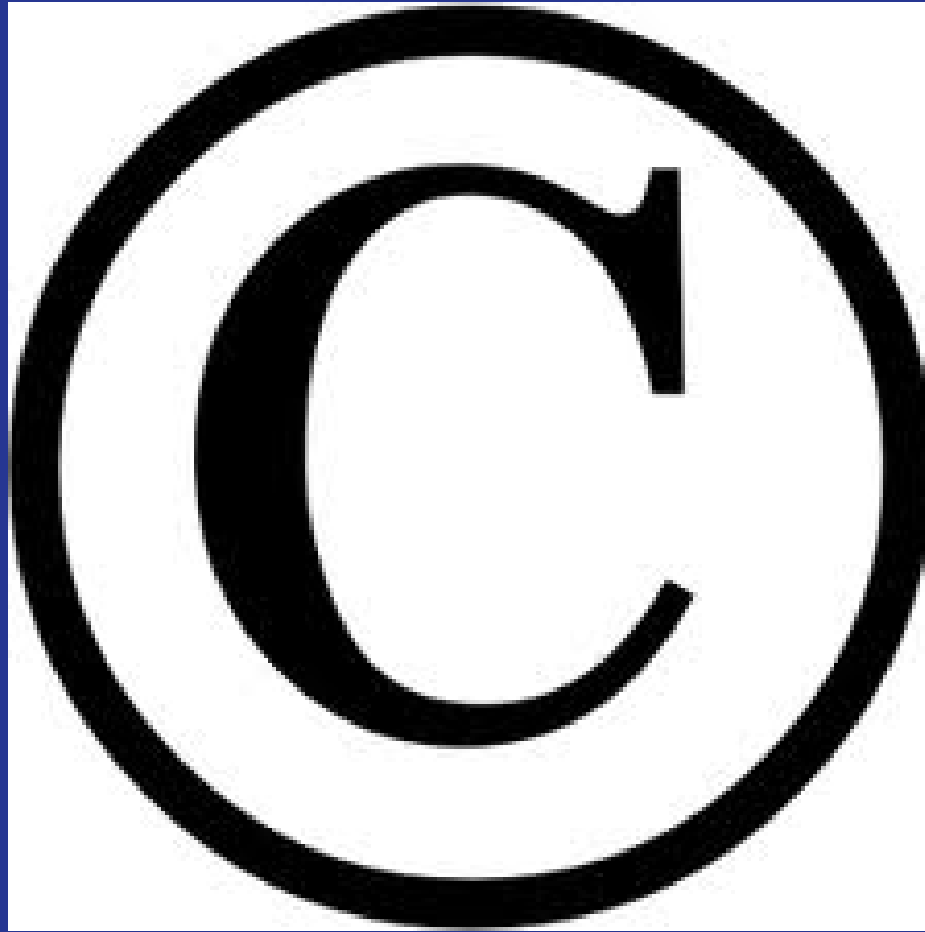
Exhaustion of TM Rights

- After a branded product is sold or transferred by the trademark owner or by others with the consent of the owner, the trademark right is exhausted.
- Once exhausted, it remains exhausted in both territories.
- Unclear what will happen if exhausted in one territory, but not the other, before January 1, 2021.

Licenses and Security Interests

- The Withdrawal Agreement does not apply to licenses or security agreements.
- The UK IPO says that licenses of an EUTM will continue to have effect in the UK, as if it applied to the created UK trademark.
- All licenses will need to be carefully reviewed, as well as any license recordals.

Copyright



Copyright

- EU law will still apply until December 31, 2020
- Decisions of the European Court of Justice will not be precedential after December 31, 2020, but precedents are not likely to be ignored.

Patent

- European Patent Office (EPO) is separate from EU membership. Members include EU member states and non-members. EPO patents are not affected by Brexit.
- Impact on Unitary Patents and decisions of the Unitary Patent Court are yet to be determined.

Designs

- Community designs will still protect designs in the UK until the end of the transition period. All rules applicable to EU trademarks will apply to Community designs.

Questions?

Thank You!

Kevin A. Thompson
LADAS & PARRY LLP

✉ kthompson@ladas.net

☎ +1.312.427.1300

www.ladas.com

