

Warsaw, October 16, 2020

Ladies and Gentlemen,

We would like to kindly inform you that on **January 1, 2021**, the transitional period which was the result of the UK's withdrawal from membership in the European Union will end.

Brexit and all related changes also affect the situation of IP rights, including EU trademarks and Community industrial designs.

1) Registered EU trademarks and Community industrial designs

If the Client is the owner of an EU trademark or industrial design that has valid protection rights on December 31, 2020, or the Client's trademark is registered by that date, then from January 1, 2021, for such trademarks and designs, the Intellectual Property Office The United Kingdom (UKIPO) will automatically create their counterparts in the UK national trademark and design register starting with "UK009" followed by the trademark/design number from EUIPO. The rightholders will not have to take any steps or incur any additional costs.

Importantly, the filing date, registration date, priority date and the scope of goods and services of the trademarks in question will be preserved.

Thus, trademarks and designs belonging to entities that had protection rights in the above-mentioned period will be protected both in the European Union and in the United Kingdom.

If the rightholder is not interested in protection rights in the UK, he may waive these rights using the opt out system.

2) Extension of protection rights

In the event that the designated protection period will near its expiry date and the owner of the trademark or design will wish to extend its protection, he will be obliged to pay two independent fees for this purpose – one to EUIPO and the other to UKIPO.

3) EU trademarks and Community industrial designs still in application proceedings

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If the trademark or design was applied for before January 1, 2021, but the registration process has not been completed by then, the further registration process will only cover the territory of the European Union.

If the applicant would like his trademark to be protected also on the territory of Great Britain, he must submit an appropriate application to UKIPO within 9 months from the date of Great Britain's exit from the EU, i.e. by September 30, 2021. If the application is submitted on time, the filing date of the trademark/design in EUIPO will be kept.

In the same way, the protection rights can be extended to the UK, in the case of an application for an international mark that was designated to the European Union, but did not obtain protection by January 1, 2021.

The further registration procedure will be conducted then in accordance with the laws in force in Great Britain.

However, it should be noted that in order for such an application to be recognized, the trademark/design must be identical to the one applied for before the EUIPO and must cover the same list of goods and services.

4) Use of the trademark

In accordance with the provisions of the agreement on the withdrawal of Great Britain from the European Union, the use of the trademark, which took place until January 1, 2021 (in Great Britain but also in other EU countries), will be considered as using a British trademark. The 5-year obligation of use of the trademark will apply to the use in Great Britain from the date of Brexit.

5) Registration of trademarks/designs after January 1, 2021.

If an entity wishes to obtain a protection right after January 1, 2021, on the territory of the European Union and the United Kingdom, it must submit two separate applications – one before the EUIPO and the other before the UKIPO.

6) Unregistered industrial designs

Industrial designs that will exist less than 3 years on January 1, 2021 will enjoy the same protection that they would enjoy in the EU for the rest of their designated time. The UK plans to create its own system for unregistered designs - the Supplementary Unregistered Design Right.

7) Geographical indications

Geographical indications that are protected on the territory of the European Union will continue to be protected in the United Kingdom, which plans to create an independent system.

8) Patents

Brexit will not affect European patents, as well as applications that have been filed through the European Patent Office and are valid in the UK.

9) Copyrights

The main rules of copyright law will not be affected by Brexit, as the UK is a member of the Berne Convention. However, some issues will need to be regulated by separate agreements between the countries and Great Britain, such as e.g. collective rights management.

10) Customs offices

After January 1, 2021, decisions to protect intellectual property rights at the border of the European Union will not be effective in relation to the United Kingdom. UK Customs will not be able to block goods suspected of infringing IPRs unless a separate application is made to UK Customs for IPR protection at the border.

With the above in mind, we recommend you to take appropriate action to protect your intellectual property rights, verify your current rights, consider whether you want to offer your goods and services in the UK and therefore whether there will be a need to protect your rights on that territory. At the same time, we encourage you to contact our Law Firm to obtain additional information in connection with changes related to Brexit. Our experts are at your disposal and will provide you with appropriate substantive and legal support.

We invite you to contact us at the address: kulikowska@kulikowski.pl