

THE IMPACT OF BREXIT ON IP LAW IN THE EU

The future of the unitary rights – trademark and design

Yann BASIRE

Associate Professor, University of Haute-Alsace
Lecturer, CEIPI

Eléonore GASPAR

Duclos, Thorne, Mollet-Viéville & Associés
Paris, France

CNCPI, CEIPI, Paris Bar & AFPI - 2018 Seattle
May 19, 2018

1. INTRODUCTION

- Context (EUIPO's notice)
 - UK = “third country”
 - EUTM still valid in the 27 member states
 - No effect in the UK anymore
- Draft agreement on the withdrawal from the EU
 - Art. 50 to 57: IP law
 - Green provisions / Yellow provisions / White provisions

2. TRANSITION PERIOD

- Transition Period: December 31, 2020 (Art. 121)
- Scope (Art. 122):
 - continuity of protection in 28 countries
 - Union law: same effects in the UK
 - Court of Justice (Art. 126)

3. TITLES – POST DECEMBER 31, 2020

- Titles registered before the end of the Transition Period
- Titles still pending at the end of the Transition Period
- Unregistered Community Designs created before the end of the Transition Period

3.1 Titles registered before the end of the Transition Period

- Matters agreed
 - conversion into equivalent national titles in the UK (Art. 50.1)
 - no re-examination
 - same filing and priority dates (Art. 50.5)
 - Same seniority date for UK trad when appropriate
 - same renewal date (Art. 50.4)
 - maintenance of the UK trademarks/designs in the international registrations (Art. 52)
 - same period of protection for designs (Art. 50.6)

3.1 Titles registered before the end of the Transition Period

- Matters to be negotiated (Art. 51)
 - Free conversion?
 - Automatic conversion?

3.2 Titles still pending at the end of the Transition Period

- Matters agreed
 - 9-month period to file a trademark in the UK (Art. 55)
 - same filing and priority dates
 - same seniority date

3.2 Titles still pending at the end of the Transition Period

- Matters to be negotiated
 - free application?
 - new examination by the UKIPO?

3.3 Unregistered Community Designs created before the end of the Transition Period

- Matters agreed (Art. 53)
 - continued protection
 - equivalent protection in the UK
 - for the same duration
 - for the same level of protection

4. ONGOING PROCEEDINGS

- Opposition or invalidity proceedings based on previous UK rights
- Silence of the draft withdrawal agreement
- Actions dismissed because of the disappearance of the subject matter of the dispute?
 - rules of Procedure of the Court of Justice of the European Union (Art. 149)
 - rules of Procedure of the General Court (Art. 131)
- Cancellation as the result of ongoing proceedings :
 - cancellation of the converted English title (Art. 50.3)
 - except if the grounds for invalidity or revocation of the EUTM or Registered Community design do not apply in the UK

5. TRADEMARK USE

- Genuine use
 - matters agreed: for converted UK titles, no revocation for lack of use before the end of the Transition Period
 - uncertainties:
 - starting point for use in the UK?
 - protection of a EUTM only used in the UK before the end of the Transition Period?

6. REPUTATION

- Continuity of the protection in the UK
- Reputation acquired in the UK on the date of the end of the Transition Period
- The continuing reputation of that trademark shall be based on the use of the mark in the UK

7. REPRESENTATION

- Silence of the draft withdrawal agreement
- Art. 120(1) of the EUTM regulation
- Will the UK become a member of the EEA?

- Change of representative ?

THANK YOU FOR YOUR ATTENTION



Gaspar@dtmvparis.com

Duclos, Thorne, Mollet-Viéville & associés

dtmv
& associés



Yann.basire@ceipi.edu

Twitter: @yannbasire