

Impact of the United Kingdom's withdrawal from the European Union on the European Union trade mark and the Community design

– Frequently asked Questions and Answers –

The United Kingdom submitted on 29 March 2017 the notification of its intention to withdraw from the Union pursuant to Article 50 of the Treaty on European Union. This means that, unless a ratified withdrawal agreement¹ establishes another date, all Union primary and secondary law will cease to apply to the United Kingdom from 30 March 2019, 00:00h (CET) ('the withdrawal date').² The United Kingdom will then become a 'third country'.³

Preparing for the withdrawal is not just a matter for EU and national authorities but also for private parties.

In view of the considerable uncertainties, in particular concerning the content of a possible withdrawal agreement, all stakeholders concerned are reminded of legal repercussions, which need to be considered when the United Kingdom becomes a third country.⁴

Subject to any transitional arrangement that may be contained in a possible withdrawal agreement, as of the withdrawal date, the EU rules in the field of trademarks and designs no longer apply to the United Kingdom.

The main consequences are addressed in the following Questions and Answers (Q&A). The Q&A apply *mutatis mutandis* to European Union designs.

N.B:

– The Q&A does not consider future – and so far unknown – specific bilateral (EU-UK) or unilateral (UK and/or EU) arrangements. Nor are any of the elements set out in the EU's guidelines issued for the negotiations under Article 50 Treaty on European Union taken into account.

– The Q&A reflect the current understanding of the EU Intellectual Property Office of the law in the event of the UK's withdrawal without any modification of the applicable EU legislation and, in particular, of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (EU Trade Mark Regulation) and the Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (Community Design Regulation). The answers are therefore given without prejudice to interpretation of the law which

¹ Negotiations are ongoing between the EU and the United Kingdom with a view to reaching a withdrawal agreement.

² Furthermore, in accordance with Article 50(3) of the Treaty on European Union, the European Council, in agreement with the United Kingdom, may unanimously decide that the Treaties cease to apply at a later date.

³ A third country is a country not member of the EU.

⁴ The EU is trying to agree solutions for some of the issues that might arise. The essential principles of the EU's position on intellectual property rights (including geographical indications) are available here: https://ec.europa.eu/commission/publications/position-paper-intellectual-property-rights-including-geographical-indications_en.

might result from future case law of the Grand Board of Appeal, the General Court, and the Court of Justice. The answers have, in particular, not been submitted to the Management Board of the EU Intellectual Property Office pursuant to Art. 153(1)(l) of the EU Trade Mark Regulation and consequently not been adopted by the Executive Director of the EU Intellectual Property Office as Guidelines for the examination in the Office.

- A. Ownership of EU Trade Marks**
- B. Scope of Protection of EU Trade Marks**
- C. Maintenance of Rights conferred to EU Trade Marks**
- D. Capacity to act and representation before the EU Intellectual Property Office**
- E. English in the Proceedings before the EU Intellectual Property Office**
- F. Priority and Seniority Claims**
- G. Absolute Grounds of Refusal and Invalidity**
- H. Relative Grounds of Refusal and Invalidity**
- I. Revocation for non-use**
- J. EU Designs**
- K. Glossary**

A. Ownership of EU Trade Marks

1. Can UK nationals and UK-based companies own an EU trade mark?

Yes, any natural or legal person can be proprietor of a EU trade mark/file a EU trade mark application, irrespective of its nationality or establishment (Art. 5 EU Trade Mark Regulation). Nothing will change in this regard.

2. Which law regulates the ownership of EU trade marks owned by UK nationals and UK-based companies?

In principle, it is the law of the EU Member State, in which, according to the Register, the proprietor has its seat or domicile on the relevant date or, in the absence of a seat or domicile, in which the proprietor has an establishment on the relevant date, that regulates the ownership of their EU trade marks (Art. 19(1) EU Trade Mark Regulation).

However, in the cases which are not provided for by Article 19(1) EU Trade Mark Regulation, it is the law of the Member State where the Office is situated (Spanish law) that applies (Art. 19(2) EU Trade Mark Regulation).

B. Scope of Protection of EU Trade Marks

3. Are EU trade marks protected in the UK?

EU trade marks are protected in the EU and not in third countries (Art. 1(2) EU Trade Mark Regulation).

As from the withdrawal date, EU trade marks registered prior to that date will cease to be protected in the UK. Likewise, EU trade marks registered as of the withdrawal date, are not protected in the UK, irrespective of whether they were filed before or after that date.⁵

4. Can the (former) 'UK part' of an EU trade mark be transformed into a UK trade mark (application)?

EU law does not offer any legal basis which would allow for a prospective (that is before the withdrawal date) 'partial transformation' of an EU trade mark into a UK trade mark (application). Nor does it allow for such transformation to be made retroactively (that is as of the withdrawal date).⁶

⁵ Continuity of protection in the UK of EU trade marks registered (or applied for) before the withdrawal date depends upon UK law. The EU's position for the negotiations with the UK under Art. 50 Treaty on European Union (see European Commission, Position paper on IP Rights, 20 September 2017, [Doc. No TF50 \(2017\) 11/2](#), at point I.1.) is that this continuity of protection should be 'automatic'.

⁶ Continuity of protection in the UK of EU Trade Marks applied for or registered before the withdrawal date depends upon UK law. The EU's position for the negotiations with the UK under Art. 50 TEU (see European Commission, Position paper on IP Rights, 20 September 2017, [Doc. No TF50 \(2017\) 11/2](#), at point I.1.) is that this continuity of protection should be 'automatic'.

5. Is an EU trade mark court's pan-EU injunction effective in the UK after the date of withdrawal?

Measures taken by a EU trade mark court as of the withdrawal date will apply only to the territory of EU Member States (Art. 121(2) EU Trade Mark Regulation). Such measures do not any longer have effect in the UK on the basis of EU law.

Measures taken by a EU trade mark court, or becoming final, as of the withdrawal date, which relate to infringement acts committed before the withdrawal date, will be enforceable in the UK only as a matter of, and under the conditions set by, domestic (international private) law.

6. Are UK courts competent in EU trade mark matters as of the withdrawal date?

As from the withdrawal date, UK courts are not any longer competent for taking measures with effect in the EU or as regards the validity of EU trade marks (Art. 123-126 EU Trade Mark Regulation).⁷

Disputes on the infringement and the validity of EU trade marks involving EU trade mark owners established in the UK have to be settled by EU trade mark courts (Art. 125 EU Trade Mark Regulation).

7. Can an EU trade mark/EU trade mark application be converted into a UK trade mark application?

An EU trade mark/EU trade mark application can only be converted into a trade mark (application) of an EU Member State (Art. 139(1) EU Trade Mark Regulation).

In consequence, EU trade marks registered, and EU trade mark applications filed, either before, on or after the withdrawal date cannot be converted into UK trade mark applications, if the conversion request was made after that date.

C. Maintenance of Rights conferred to EU Trade Marks

8. Can use of the EU trade mark in the UK as of the withdrawal date maintain the rights conferred by the mark?

Use of the EU trade mark in the UK does – as from the withdrawal date – not qualify any more as use 'in the EU' (or for exports from the EU to third countries, Art. 18(1) EU Trade Mark Regulation).

Use of the EU trade mark in the UK as of the withdrawal date does not count for the purpose of maintaining the rights conferred by the EU trade mark.

⁷ UK courts cannot refer questions for preliminary reference rulings to the Court of Justice of the European Union (Art. 267 TFEU).

9. Can use of the EU trade mark in the UK before the withdrawal date maintain the rights conferred by the trade mark?

Use of the EU trade mark in the UK before the withdrawal date constitutes, in principle, use 'in the EU' (or for exports from the EU to third countries, Art. 18(1) EU Trade Mark Regulation).

Use of the EU trade mark in the UK before the withdrawal date counts for the purpose of maintaining the rights conferred by the mark – provided that, and in so far as, it relates to the relevant period for which use has to be shown.

D. Capacity to act and representation before the EU Intellectual Property Office

10. Can persons established in the UK (or their employees) file an application for an EU trade mark?

For the sole act of filing an application for registration of an EU trade mark no representation is needed (Art. 119(2) *in fine* EU Trade Mark Regulation). Persons established in the UK or their employees can thus file an application for an EU trade mark.

11. Do persons established in the UK need to be represented before the EU Intellectual Property Office?

Except for the act of filing an application for registration of a EU trade mark, persons without a domicile, a principal place of business, or an effective establishment in the EU need to be represented in the proceedings before the EU Intellectual Property Office (Art. 119(2) EU Trade Mark Regulation).

12. Can persons established in the UK be represented by an employee?

Except for the act of filing an application for registration of a EU Trade Mark, persons without a domicile, a principal place of business, or an effective establishment in the EU cannot be represented by an employee (Art. 119(3), (2) EU Trade Mark Regulation).

13. Can UK nationals qualified as lawyers represent a party to the proceedings before the EU Intellectual Property Office?

A UK national who (i) is a legal practitioner qualified in one of the Member States of the European Economic Area (EEA) and (ii) is established in the EEA, and (iii) is entitled to act as representative in trade mark matters in that EEA Member State, can represent a party to the proceedings before the EU Intellectual Property Office (Art. 120(1)(a) EU Trade Mark Regulation).

Where these three cumulative conditions are not fulfilled, a UK national qualifying as a lawyer cannot represent a party to proceedings before the EU Intellectual Property Office.

14. Can UK nationals (other than lawyers) represent a party to the proceedings before the EU Intellectual Property Office as ‘professional representatives’?

Nationality of an EEA Member State is a necessary condition for representing parties before the EU Intellectual Property Office as professional representative (Art. 120(1)(b), (2)(a) EU Trade Mark Regulation). In consequence, UK nationals lose the capacity to represent parties before the EU Intellectual Property Office as from withdrawal date.

An exception applies to UK nationals fulfilling the following three cumulative criteria: (i) be established in the EEA, (ii) be qualified as a legal practitioner in one of the EEA-Member States, (iii) be entitled to act as representative in trade mark matters in that EEA-Member State (Art. 120(1)(a) EU Trade Mark Regulation).⁸

E. English in the Proceedings before the EU Intellectual Property Office

15. Is English a language of the EU Intellectual Property Office?

English is one of the languages of the EU Intellectual Property Office pursuant to Art. 146(2) EU Trade Mark Regulation. The UK’s withdrawal from the EU does not affect this rule.

16. Can English be a language of EU Intellectual Property Office proceedings?

English being both one of the official languages of the EU (Art. 1 Reg. 1/58) as well as one of the languages of the EU Intellectual Property Office (Art. 146(2) EU Trade Mark Regulation), EU trade mark applications can be filed in that language, and English can also become language of proceedings before the EU Intellectual Property Office (Art. 146(1), (3) EU Trade Mark Regulation).

F. Priority and Seniority Claims

17. Can the priority of a UK mark be claimed for an EU trade mark as of the withdrawal date?

The priority (six months from the filing date) of a trade mark duly filed in any state of the Paris Convention and the WTO Agreement can be claimed for EU trade mark applications (Art. 34 EU Trade Mark Regulation). The priority of a UK mark can thus be claimed for an EU trade mark as of the withdrawal date.

18. Can the seniority of a UK mark be claimed for a EU trade Mark/EU trade mark application as of the withdrawal date?

No, claiming seniority of a national mark for a EU trade mark/EU trade mark application is only possible from a trade mark registered in a EU Member State (Art. 39(1) and 40(1) EU Trade Mark Regulation).

⁸ The further exception laid down in Art. 120(4) EU Trade Mark Regulation, which is to be interpreted strictly, can only apply on an individual basis – and is not apt to redress the present situation arising from a Member State’s withdrawal from the EU.

19. Can an EU trade mark's seniority of a UK mark be enforced in the UK as of the withdrawal date?

As from the withdrawal date, the EU trade mark will cease to be protected in the UK (Art. 1(2) EU Trade Mark Regulation) and the EU Trade Mark Regulation ceases to apply to the UK. Therefore, the effect of seniority in the event of surrender or expiry of the UK mark from which seniority has been claimed (Art. 39(3) EU Trade Mark Regulation) cannot be any longer claimed in the UK on the basis of EU law.

G. Absolute Grounds of Refusal and Invalidity

20. Can EU trade mark (applications) filed as of the withdrawal date be rejected or invalidated on absolute grounds applying on account of their possible meanings in English?

English is the (second) official language of two EU Member States (Ireland and Malta). In addition, English terms will often be familiar to a significant part of the relevant public in other EU Member States due to their widespread use in trade and advertising.

An EU trade mark (application) filed as of the withdrawal date can be rejected or invalidated on absolute grounds of refusal applying on account of its meaning in English.

21. Is an EU trade mark/EU trade mark application filed as of the withdrawal date rejected or invalidated where an absolute ground of refusal or invalidity only exists in the UK?

Absolute grounds of refusal and invalidity of an EU trade mark need to exist with regard to (part of) the EU (Art. 7(2) EU Trade Mark Regulation) – not with respect to third countries such as the UK as of the withdrawal date.

An EU trade mark/EU trade mark application filed as of the withdrawal date is thus neither rejected nor invalidated where an absolute ground of refusal only exists in the UK.

22. Is distinctiveness acquired through use in the UK relevant for the registration of a EU trade mark application or the invalidation of a registered EU trade mark?

Distinctiveness acquired through use in the UK is not relevant for EU trade mark (applications) filed as of the withdrawal date. Acquired distinctiveness of a mark needs to be shown in the part of the EU affected by the EU trade mark application's lack of inherent distinctiveness (Art. 7(2),(3) EU Trade Mark Regulation).

H. Relative Grounds of Refusal and Invalidity

23. Is the perception of the English-speaking public relevant for the finding of a relative ground of refusal (such as likelihood of confusion)?

English is the (second) official language of two EU Member States (Ireland and Malta). In addition, English terms will often be familiar to a significant part of the relevant public in other EU Member States due to their widespread use in trade and advertising.

The perception of the English-speaking public can thus be relevant for the finding of a relative ground of refusal (such as likelihood of confusion).

24. Can earlier rights protected in the UK (registered UK trade marks or unregistered rights such as passing off) be invoked in proceedings before the EUIPO against an EU trade mark/EU trade mark application?

Earlier rights have to be protected in the EU, either by EU law or by the law of an EU Member State (Art. 8(2), (4), (6), 60(2) EU Trade Mark Regulation).

As from the withdrawal date, earlier rights protected in the UK can thus not be invoked in proceedings before the EUIPO against EU trade marks or EU trade mark applications filed before, on or after the withdrawal date.^{8a} This extends to pending invalidity and opposition proceedings, which have been initiated before the withdrawal date: earlier rights must continue to produce their effects in the EU at the date on which a decision is taken by the EU Intellectual Property Office on the opposition or on the invalidity request on relative grounds.⁹

An exception applies to oppositions, invalidity requests and requests for assignment regarding an EU trade mark /EU trade mark application filed by an authorized agent because the marks protected by Art. 8(3) EU Trade Mark Regulation are not limited to those of the EU and its Member States.¹⁰

25. Can an EU trade mark application be rejected, or a registered EU trade mark be invalidated, on the basis of an earlier EU trade mark where the relative ground of refusal or invalidity only exists in the UK?

Relative grounds of refusal need to exist in the EU (Art. 7(2) EU Trade Mark Regulation by analogy) at the date on which the EU Intellectual Property Office takes a decision on an opposition or an invalidity request based on relative grounds.¹¹

As from the withdrawal date, relative grounds of refusal existing only in the UK do not lead to a rejection of a EU Trade Mark application or an invalidation of a registered EU Trade Mark.

I. Revocation for non-use

26. Is use of the EU trade mark in the UK sufficient for being genuine use in the EU?

The general principles established by the case-law apply,¹² subject to the fact that use of the EU trade mark in the UK qualifies as use 'in the EU' only as far as it relates to the (relevant) period before the withdrawal date (Art. 18(1) EU Trade Mark Regulation).¹³

^{8a} Where a EU Trade Mark Court needs to adjudicate, after the withdrawal date, upon a dispute for an alleged infringement of an EU trade mark by the holder of an earlier UK right which occurred before the withdrawal date, Article 9(2) EUTMR remains applicable. However, as from the withdrawal date, for the purpose of any invalidity claim in judicial proceedings against a EU trade mark, including pending proceedings, it is noted that earlier rights protected in the UK cease to be earlier rights within the meaning of Article 8(2), Article 8(4), Article 8(6), Article 60(1) and Article 60(2) EUTMR. It is also noted that EU trade marks will cease to be protected as such in the UK (see question 3)

⁹ 08/05/2013, C-268/12 P, Zydus, EU:C:2013:296, § 31-34.

¹⁰ 09/07/2014, T-184/12, Heatstrip, EU:T:2014:621.

¹¹ Earlier rights invoked in opposition and invalidity proceedings based on relative grounds must also continue to produce its effects in the EU at the date on which a decision is taken (08/05/2013, C-268/12 P, Zydus, EU:C:2013:296, § 31-34).

The significance of the use of an EU trade mark in the UK for the overall assessment of genuine use in the EU will progressively decrease – from potentially sufficient¹⁴ to entirely irrelevant – along the five years period following the withdrawal date.

J. EU Designs

27. Is the situation with respect to Community design different from that of EU Trade Marks?

In principle not. The foregoing answers given with regard to EU Trade Marks apply *mutadis mutandis* to the Community Design Regulation.

28. Do designs made available to the public in the UK as of the withdrawal date still matter for the assessment of an EU design's novelty and individual character?

Yes. The priority of a design for the purposes of assessing an EU design's novelty and individual character does not depend upon its disclosure in the EU (Art. 7 Community Design Regulation).

29. Can a design disclosed in the UK be protected as an unregistered Community design?

Yes, provided that the disclosure of the design in the UK occurred before the date of withdrawal (Art. 11(1), 110(5) Community Design Regulation). However, its territorial scope of protection ceases to extend to the UK as from the withdrawal date (Art. 1(3) Community Design Regulation).

A design disclosed in the UK as of the withdrawal date cannot any longer be protected as an unregistered Community design (Art. 11(1) Community Design Regulation).

¹² That is more than merely token use within the relevant 5-years-period, to be assessed globally, in disregard of territorial borders within the EU (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 44), taking into account, in particular time, volume, scale and frequency of the use in light of the nature of the goods and services and the economic sector concerned (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 36, 42 ; 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 40-42).

¹³ Only a judgment of the Court of Justice of the European Union will ultimately clarify whether use of the EU Trade Mark in the UK before the withdrawal date continues to qualify as use 'in the EU' after the UK's withdrawal from the EU.

¹⁴ See e.g. 30/01/2015, T-278/13, now, EU:T:2015:57, § 47-53.

K. Glossary

- **Community Design Regulation:** Council Regulation (EC) No [6/2002](#) of 12 December 2001 on Community designs
- **Withdrawal date:** date of the withdrawal of the UK from the EU (30 March 2019)
- **EEA:** European Economic Area
- **EUIPO** (European Union Intellectual Property Office): EU registration authority for EU Trade Marks and RCDs
- **EU trade mark:** European Union trade mark, which has to be applied for registration at the EUIPO
- **EU Trade Mark Regulation:** [Regulation \(EU\) 2017/1001](#) of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark
- **TEU:** [Treaty on European Union](#)
- **TFEU:** [Treaty on the Functioning of the European Union](#)
- **UK:** United Kingdom