07/30/2020 Events

The Agreement on the Withdrawal of the United Kingdom (UK) from the European Union (EU) provides for a transition period ending on December 31, 2020. The Government of the UK has indicated the steps that it will take to deliver continued protection in the UK to marks in international registrations with effect in the EU before the end of the transition period.

International registrations under the Madrid System that the European Union Intellectual Property Office (EUIPO) has neither refused nor protected on January 1, 2021

Holders of an international registration designating the EU that the EUIPO has neither refused nor protected on January 1, 2021, will be able to apply for a national trademark registration with the Office of the United Kingdom (UKIPO) in the nine months after January 1, 2021. The initial date of the designation of the EU will be preserved.

The same applies for holders whose international registration or subsequent designation of the EU, as the case may be, is inscribed in the International Register after the end of the transition period, but with a date earlier than January 1, 2021. In this case, the said nine-month period will be counted from the date on which the international registration or subsequent designation of the EU is inscribed in the International Register.

International registrations under the Madrid System protected in the EU before January 1, 2021

Following the end of the transition period, a comparable national trademark, recorded on the Register of the United Kingdom, will be created for every international registration protected in the EU before the end of the said period.

Where protection results from multiple designations of the EU in one international registration (e.g. a designation made in the international application and a subsequent designation) one comparable national trademark will be created for each designation.

These newly created comparable UK trademarks will be independent from the international registration and governed by UK law. Holders will have to manage them directly with the UKIPO.

Centralized management under the Madrid System for a comparable United Kingdom trademark

After the end of the transition period, the holder may subsequently designate the United Kingdom in the international registration that prompted the creation of a comparable United Kingdom trademark. Under Article 4bis of the Protocol, that International Registration would replace the comparable United Kingdom trademark, allowing the holder to regain the advantages of centralized management. The holder may request the UKIPO to take note of this replacement in the Register of the United Kingdom.

The same would apply to a United Kingdom registration for which the holder has claimed the earlier date of a designation of the European Union. The holder may subsequently designate the United Kingdom in the international registration concerned after the mark has been registered in the United Kingdom and Article 4bis of the Protocol would apply accordingly.

However, holders must be aware that, while a comparable United Kingdom right will be created automatically, a subsequent designation of the United Kingdom would be subject to examination by the UKIPO and be published for opposition.

We should mention that, currently, in the International Register of Trademarks are registered 75 trademarks from the Republic of Moldova with effects in the European Union.

For further information, please access:

https://www.wipo.int/madrid/en/news/2020/news_0015.html?utm_source=WIPO+Newsletters&utm_campaign=4aa067d9bb-EMAIL_CAMPAIGN_2020_07_27_12_12&utm_medium=email&utm_term=0_bcb3de19b4-4aa067d9bb-256583301 [1]

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