



Brexit Q&A

Intellectual Property

In the latest in our Brexit Q&A series, Caroline Pigott, solicitor and chartered trade mark attorney at HGF, and convener of our Intellectual Property sub-committee, answers some questions you might have about the things you will need to take into account in the area of intellectual property after the end of the transition period on 31 December 2020.

Q: Hi Caroline. Thank you for answering our questions. First of all, how prepared do you feel for the end of the transition period?

A: Thanks for having me. I think practitioners and businesses are quite well prepared. However, whether they 'feel prepared' is another matter. Some elements of how intellectual property rights will change after the end of the TP have been in the public domain for some time. However, there are other aspects which are still to be settled on – and that's far from ideal.

Q: What will the main changes be for solicitors working in the area of intellectual property after 31 December 2020?

A: I think the biggest change will be the loss of 'Rights of Representation' before the EUIPO. After the end of the TP, UK-based practitioners will no longer meet the criteria to represent clients before the EUIPO in respect of trade mark or design matters. To address this, many Scottish solicitor/IP firms have entered into commercial arrangements with EU businesses in order to assist with EUTM and design work from 1 January 2021. Alternatively, Scottish practitioners can outsource the management of IP assets to a firm which is able to represent their clients before both the UK and EUIPO offices. I think the key message is that if solicitors are still managing EUTMs/RCDs on behalf of their clients but will lose their Rights of Representation in the coming weeks, they should look at transferring the assets to a firm which can manage both the EU rights and the UK clones (which I will talk about in a moment). This is a high priority and should be done before 31 December 2020 to ensure the clients' rights can be enforced and defended where necessary.

I just mentioned the 'UK clones'. This is the other big change after the end of the TP. All EUTMs and RCDs registered at 31 December 2020 will automatically be cloned to create an equivalent UK right. Solicitors should be aware that the UK IPO services are to be disrupted from 2300 on 31 December 2020 until 1300 on 4 January 2021. This is to allow the IPO to work on the database of over 2 million new rights. Whilst the purpose of the 'clones' is to ensure that owners have comparable rights to those pre-Brexit, the other effect on solicitors and IP practitioners will be more portfolio management, more renewals and inevitably, more questions from clients. There are certainly opportunities for IP solicitors coming out of the TP but many of the changes are administrative and don't directly add value to the client's IP rights.

Q: Will any alternative international legal frameworks apply or will we see new UK legislation governing this area?

A: The existing international frameworks are not affected. The domestic UK legislation is currently harmonised with the EU but also fits into international treaties where the UK is an independent signatory. These include the Berne Convention (copyright), the Madrid Protocol (international trade marks), the Hague Agreement (international designs) and of course, the Paris Convention, which covers all types of IP and dates back to 1883, long before the EU even existed! The domestic legislation is being amended. For example, references to the EEA are being replaced by references to the UK.

Q: What will the process be for registering new trade marks and designs?

A: New UK trade marks and designs are unaffected. Applications will be made in exactly the same way. In the EU, the main change will be that many Scottish-based practitioners will not be able to file new EU trade marks or designs on behalf of their clients, having lost Rights of Representation on 31 December 2020. Solicitors should work with their



clients to project manage the client's IP portfolio, even if that means instructing another firm to file and prosecute trade marks or designs in the EU.

Q: What will happen with ongoing applications for EU trade marks and designs as at 31 December?

A: If an application is pending at the end of the TP, it will not be protected in the UK and no clone will be generated. Applicants will have until 30 September 2021 to file an equivalent application in the UK, for the same mark and for the same, or a narrower specification. So long as the application is filed within the 9 month period, the applicant will retain the EU filing date. The UK application will incur standard costs and will not be linked with the pending EU right or have the same prefix application number. For clarity, it is possible to apply for the UK trade mark after 30 September 2021 but the filing date will be generated on a real time basis. On a related point, I think it's worth mentioning that for matters pending at the EUIPO on 31 December 2020, like oppositions, UK-based representatives may continue to act in the matter until its conclusion.

Q: What about the new rules for Address for Service in the UK?

A: These changes are very significant and it's important that IP practitioners understand the impact. The UK IPO conducted a consultation in July/August 2020 regarding whether the rules should be amended so that an Address for Service is required to be in the UK, Gibraltar or the Channel Islands. The IP sub-committee responded to this consultation, supporting the proposed amendments because it provides a greater degree of reciprocity and much-needed support for the UK IP profession. Happily, the UK IPO has confirmed that from 1 January 2021, the rules will be amended and addresses in the EEA will no longer be accepted. The exception to these new rules relate to the 'cloned' rights, where an EEA address is allowed for 3 years following 1 January 2021, as set out in the Withdrawal Agreement.

Q: What will happen with Geographical indications?

A: Up until now, the GI schemes have all been operated at EU level. The UK Government is introducing its own scheme which will be run by DEFRA from 1 January 2021. The scheme is for protected 'geographic origins', 'designated origins' and 'traditional specialities'. Any product which is currently protected under an EU GI scheme will remain protected under the UK scheme automatically. Producers who already have EU GI protection can make use of the new UK GI logos from 1 January 2021 but are not obliged to do so until 1 January 2024. From 1 January 2021, separate GI applications are required for each of the UK and EU. For any GI where protection is granted in the UK after the end of the TP, the new UK GI logos have to be used straight away. Further guidance is still to be issued by the Government on how to apply to the UK and EU schemes. This is expected at the end of the TP.

Q: Where should I look for further information and advice?

A: The UK IPO has released a number of guidance pages. These include the following:

- [UK IPO guidance on trade marks](#)
- [UK IPO guidance on unregistered designs](#)
- [New UK GI scheme](#)
- [UK IPO guidance on designs](#)
- [UK IPO new UK address for service rules](#)
- [UK IPO guidance on copyright](#)

If solicitors have enquiries or need assistance regarding trade mark or design matters, CITMA (Chartered Institute of Trade Mark Attorneys) operates a database of trade mark attorneys similar to the Law Society of Scotland's 'find a solicitor' page. This can be found at <https://www.citma.org.uk/find-a-chartered-trade-mark-attorney.html>

I'm not a patent attorney and so we haven't talked about patents today. However, for patent queries, CIPA (Chartered Institute of Patent Attorneys) has a database of patent attorneys at <https://www.cipa.org.uk/find-a-patent-attorney/>.

Q: What other advice would you offer?

A: I think solicitors can find it difficult to ask for help. There are some fundamental changes on the horizon and many practitioners will need to outsource services which may have previously been carried out in-house. There is nothing

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wrong with this. The most important thing is continue to foster and maintain client relationships and none of the pending changes should cause this to suffer. There is significant value in the strategic advice offered by Scottish-based IP practitioners and the new framework offers a real opportunity for professional collaboration across IP practice.