

# **D YOUNG & CO** **INTELLECTUAL** **PROPERTY**

## **IP after Brexit – A Practical Guide to UK & EU Trade Mark and Design Practice**

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# Speakers



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# Webinar Agenda – Trade Marks

- UK Trade Mark application overview (direct and WIPO applications)
  - No objections raised
  - Citations raised
  - Absolute Ground and/or specification queries raised
- EU Trade Mark application overview (direct and WIPO applications)
  - No objections raised
  - Search report issued
  - Absolute Grounds and/or specification queries raised
- UK Trade Mark Opposition overview
- EU Trade Mark Opposition overview
- UK Trade Mark Revocation overview
- EU Trade Mark Revocation overview

# Webinar Agenda - Designs

- UK Registered Design application overview
- EU Registered design (RCD) application overview
- Filing requirements differences - RCDs vs UK designs
- Registered Community Design vs. Unregistered Community Design
- Existing EU Unregistered Designs post Brexit

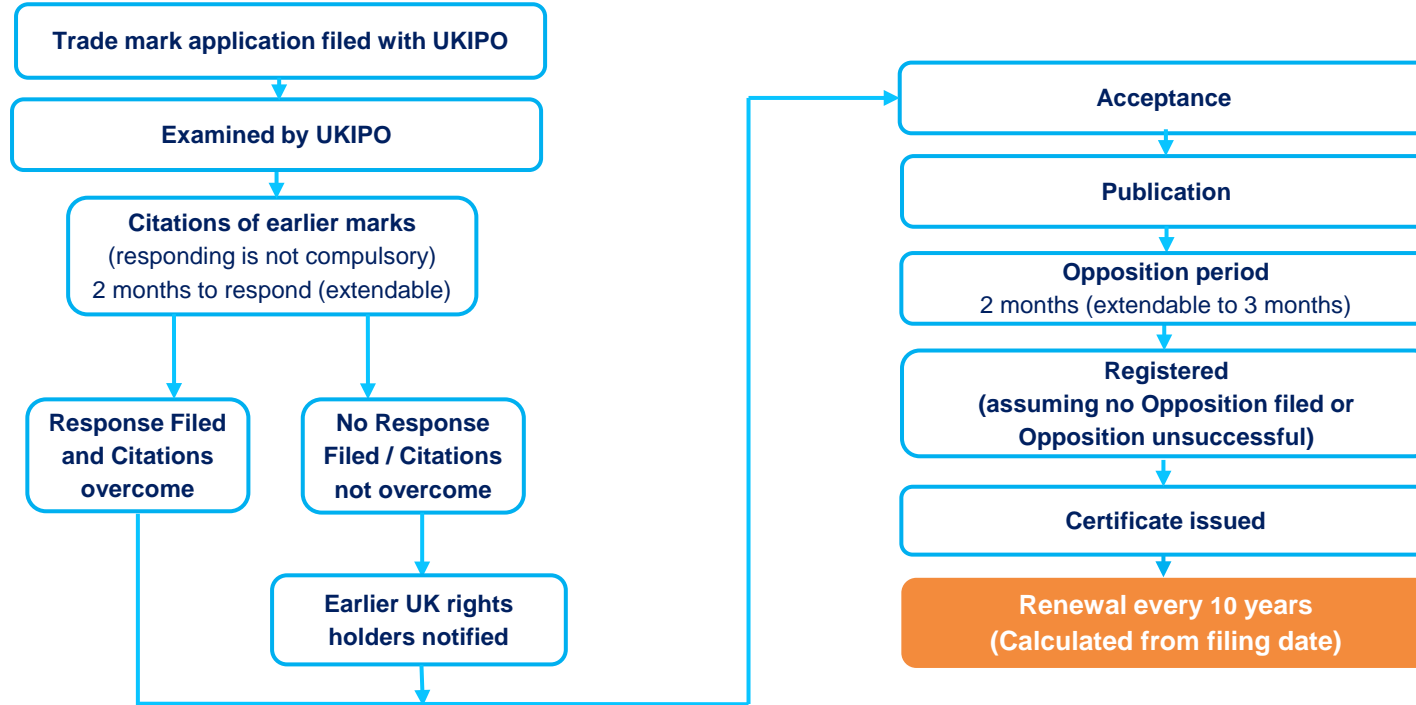
# UK Trade Mark Application Overview

## Examination – No Objections Raised



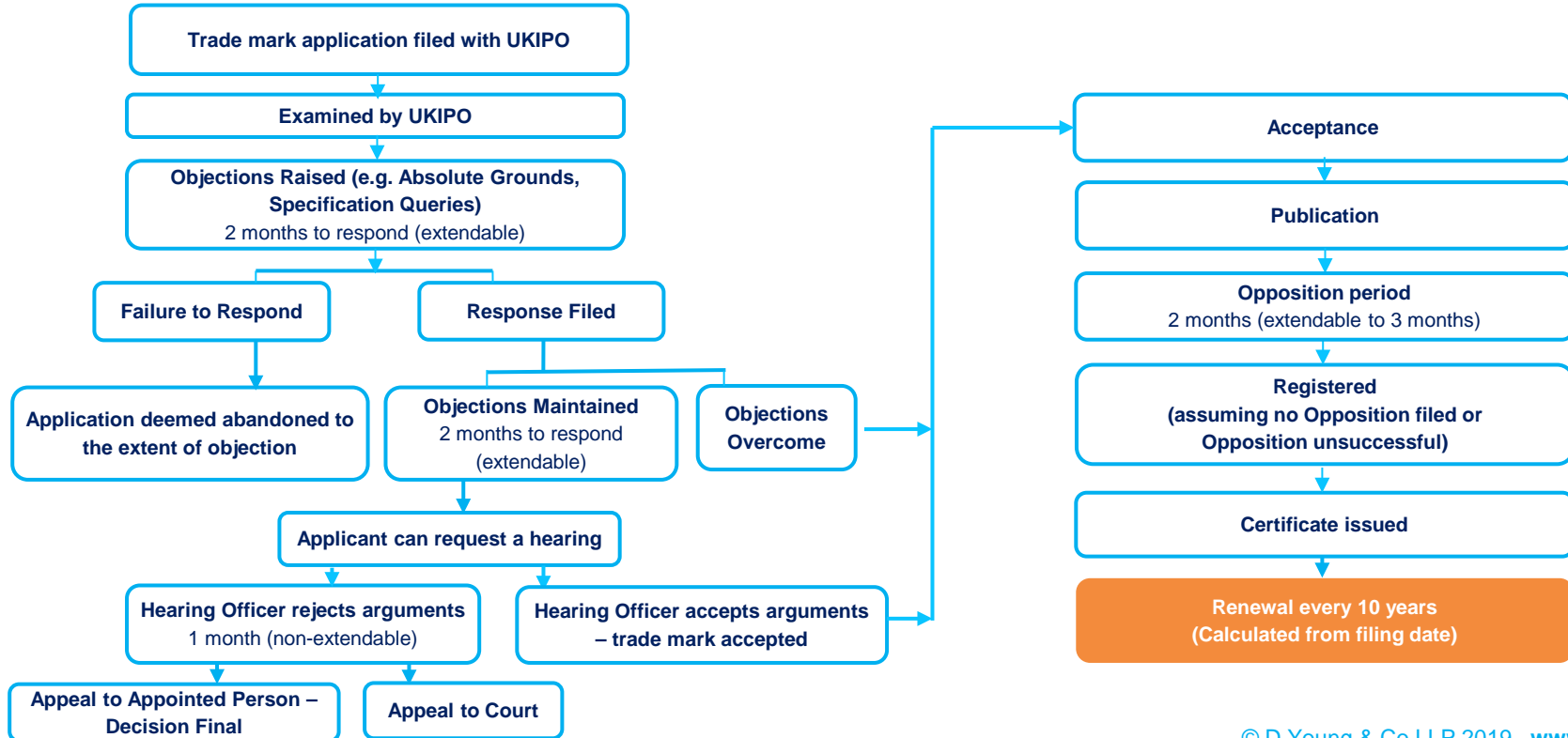
# UK Trade Mark Application Overview

## Examination – Citations of Earlier Marks Raised



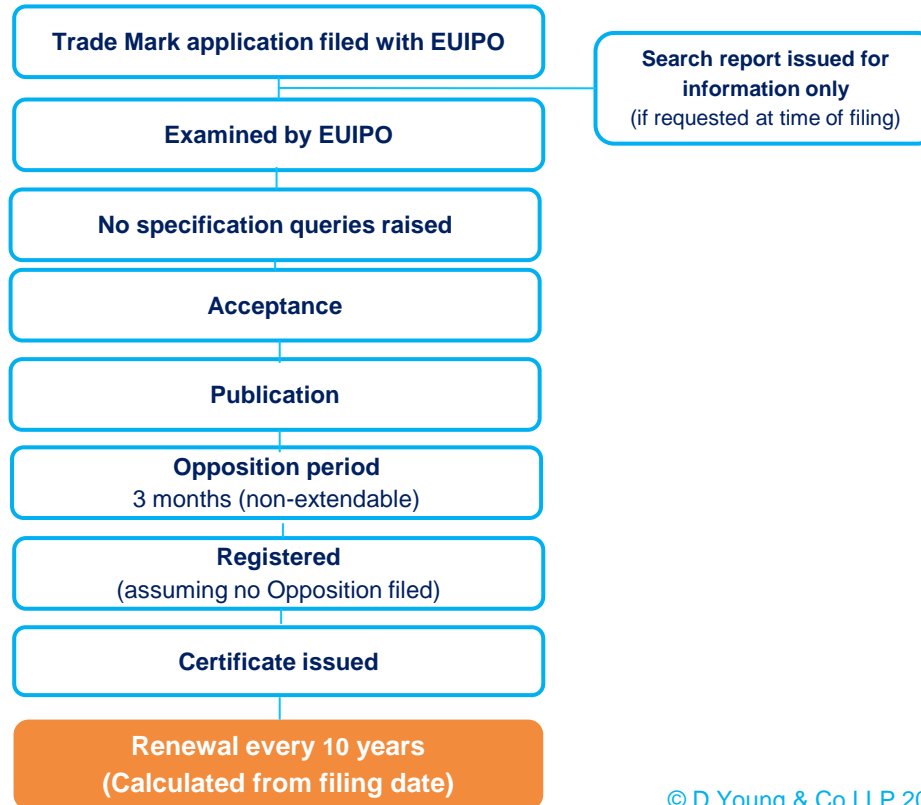
# UK Trade Mark Application Overview

## Examination – Absolute Grounds and/or Specification Queries Raised



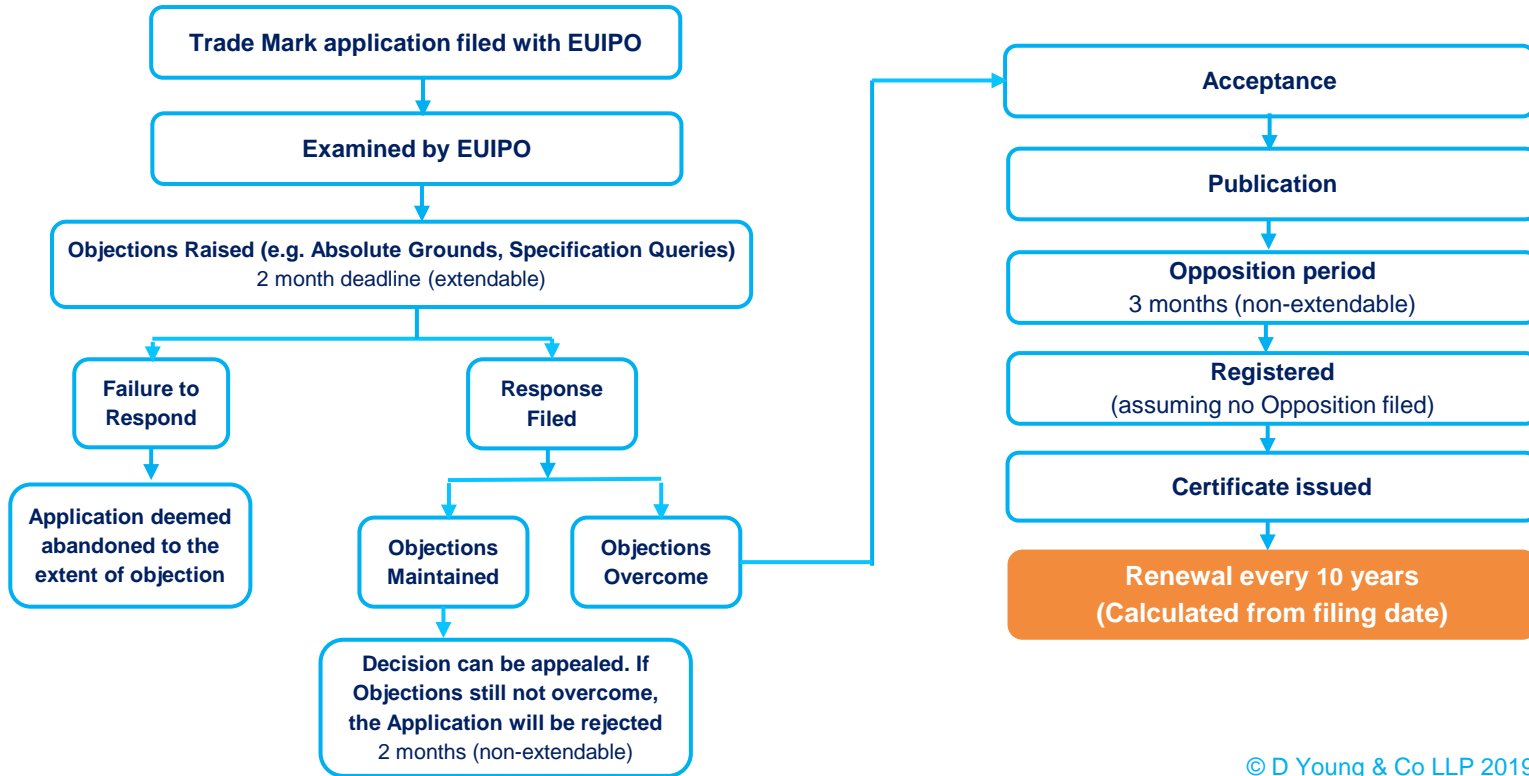
# EU Trade Mark Application Overview

## Examination – No Objections Raised





# Examination – Absolute Grounds and/or Specification Queries Raised



# UK Trade Mark Opposition Overview

**Notice of Threatened Opposition**  
(extends Opposition period by 1 month)

**Notice of Opposition**

**Applicant files Defence and Counterstatement**  
(non-extendable deadline of 2 months unless cooling off period is requested)

OR

**Optional Cooling off period**  
9 month negotiation period extendable to another 9 months.  
Consent of both parties required (maximum 18 months)

**Opponent files evidence  
(including proof of use, if requested)**  
2 month deadline (extendable under exceptional circumstances)

**Applicant files evidence / written submissions**  
2 months (extendable under exceptional circumstances)

**Opponent notifies IPO if it intends to file  
evidence of fact in reply; further 1 month period to file evidence**  
(extendable under exceptional circumstances)

**Evidence rounds concluded. Parties request  
hearing or decision from the papers**

**Written submissions**  
(Deadline 28 days)

**File an appeal**  
28 days – extendable with fee and  
detailed reasoning

**Hearing**

**Decision issued**

# EU Trade Mark Opposition Overview



# UK Trade Mark Revocation Overview

Application to Registrar for revocation on grounds of non-use

Application will be examined by the UKIPO and either rejected or accepted

Proprietor will receive application for revocation and file Notice of Defence and Counterstatement  
Deadline 2 months

Applicant's evidence/submissions in support  
Deadline 2 months

Proprietor's evidence/submissions in reply  
Deadline 2 months

Applicant's evidence/submissions in reply

Hearing or decision from the papers

Decision issued

File an appeal - Deadline 28 days

Deadlines are extendable at the discretion of the UKIPO. Substantial reasons will need to be given for any additional ones.

Written submissions – Deadline 28 days

# EU Trade Mark Revocation Overview

**Application for revocation on grounds of non-use**

**Application will be examined by the EUIPO and either rejected or accepted**

**Proprietor will receive application for revocation and file proof of genuine use of the mark/proper reasons for non-use**  
Deadline 2 months (extendable)

If Proprietor does not file evidence of genuine use, and there are no proper reasons for non-use, mark will be revoked

**Applicant's observations in reply**  
Deadline 2 months (extendable)

**Proprietor's observations in reply**  
Deadline 2 months (extendable)

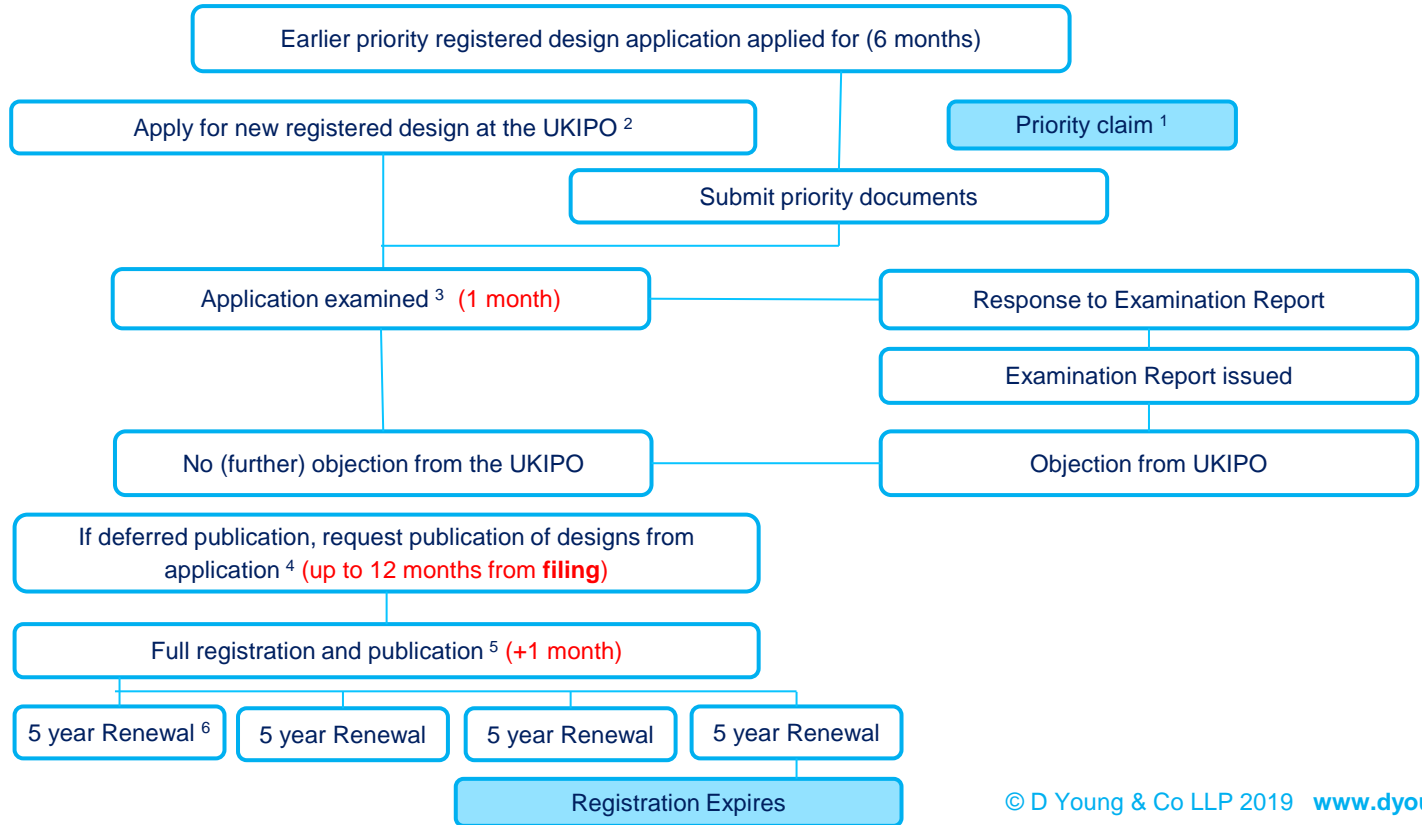
If one of the parties does not file observations, the Office will make a decision on the basis of the evidence before it

**Additional rounds of observations may be granted in exceptional cases**

**Decision issued**

**File an appeal**  
2 months to file Notice of Appeal, another 2 months to file Statement of Grounds of Appeal

# UK Registered Design Applications



25 years maximum

# EU Registered Design (RCD) Applications

Earlier priority registered design application applied for (6 months)

Apply for new registered design at the EUIPO <sup>2</sup>

Priority claim <sup>1</sup>

Submit priority documents

Application examined <sup>3</sup> (0-3 months)

Response to Examination Report

Examination Report issued

No (further) objection from the EUIPO

Objection from EUIPO

If deferred publication, request publication of designs from application <sup>4</sup> (within 27 months from **earliest priority date**)

Full registration and publication <sup>5</sup> (up to 30 months from **earliest priority date**)

5 year Renewal <sup>6</sup>

5 year Renewal

5 year Renewal

5 year Renewal

Registration Expires

25 years maximum

# Filing requirements differences - RCDs vs UK designs

Requirement Country:	UK	EU
Applicant Name/Address/Nationality	Yes	Yes
Designer Name	x	x
Designer Address	x	x
Designer Nationality	x	x
Statement on how Applicant derived rights from Designer(s)?	x	x
Is there a Novelty grace period?	Yes	Yes
If yes, how long is it?	12 months preceding the priority date of the design application	12 months preceding the priority date of the design application
Is it possible to defer publication and long for?	Yes up to 12 months if requested at filing	Yes up to 30 months if requested at filing
Duration	25 years from filing date	25 years from filing date
Renewal fees payable post-grant?	Yes	Yes
Representation	Drawings or photos (1)	Drawings or photos
Max number of views per design	12	7 (and up to 3 additional non-protected views)
Need to include views showing a product from all sides?	x	x
Are dotted lines permitted?	Yes	Yes
Are multiple designs permitted in single application?	Yes – any combination of designs	Yes – same Locarno classification
Is Locarno Classification limiting?	x	x
Are designs permitted in Locarno Classification 32?	Yes	Yes
Party to Hague Agreement?	Yes	Yes
When can priority be claimed	On the date of filing	Date of filing or within 1 month
When to file certified copy of earlier filing	Within 3 months of filing	Within 3 months of filing



# Registered Community Design vs. Unregistered Community Design

## Registered Community Design

- Right attained through registration
- **Protection for up to 25 years (renewable in 5 year periods)**
- Monopoly right - right enforceable against designs creating the same overall impression. No need to prove that the competitor had knowledge of the registered design
- **Existence of registration on public record**

## Unregistered Community Design

- Automatically subsisting right
- **Protection for 3 years from date of disclosure in the EU**
- Right enforceable against copies only - need to show that competitor had knowledge of the design
- **Need to prove entitlement to the right**

# Existing EU Unregistered Designs post Brexit

- Existing EU unregistered design rights (unregistered Community design rights) will continue to be recognised in UK after exit date until their expiration.
- New unregistered design right in UK law which mirrors the characteristics of the unregistered Community design – called ‘supplementary unregistered design right’.
- Clarity required over whether use of supplementary unregistered design right must be in the EU or whether use in the UK would amount to disclosure.

# Existing EU Registered Designs post Brexit

## Group 1

- EU Registered Design (published)
- International 'Hague' Design designating EU (published and deemed accepted by EUIPO)

An equivalent UK registered design right will be created by UKIPO automatically

## Group 2

EU Registered Design pending application  
EU Registered Design (unpublished - subject to deferment)\*  
International 'Hague' Design designating EU and either:

- pending application
- unpublished - subject to deferment
- published but not yet deemed accepted by EUIPO

Owner will have nine months from exit date to apply for new UK registered design registration at the UKIPO

# Benefits of UK national trade marks and designs

- UK rights relatively inexpensive but valuable addition to IP portfolio
- UK is worlds 5<sup>th</sup> largest economy and an important market
- US Chamber of Commerce Global IP index just rated UK 2<sup>nd</sup> in the world\*
- UK attorneys are qualified by examination on law and procedure

# Representation in the UK, Germany and EU

- Business as usual.
- We represent clients in the UK, Germany and the EU.
- D Young can *continue* to act in the EU:
  - We have an office in Munich, Germany. Jana joined the firm as a Partner in 2018;
  - We are able to represent clients before the UKIPO, DPMA and EUIPO;
  - We have litigation specialists in both our London and Munich offices, and we are able to do UK, German and EU litigation;
  - We have represented clients before the EUIPO since it was formed in 1994. We have represented clients before the UKIPO for over 125 years. We are qualified by examination to represent clients before these offices.
  - [www.dyoung.com/knowledgebank/ip-brexite](http://www.dyoung.com/knowledgebank/ip-brexite)

# Post-webinar questions



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Slides and a recording this webinar will be emailed to you later this week. We welcome invitations to give this presentation and other IP subjects of interest in person.

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