Without action at UK level, IP rights which are designated as applying across the EU (EU trade marks, Community plant variety rights, Community registered designs and Community unregistered designs) would all have been at risk of termination in relation to the territory of the UK once the definition of “EU” no longer included the UK. The same would apply to those rights, qualification for which involves activity within the EU (such as EEA sui generis database rights). However, the EU-UK Withdrawal Agreement provides for replacement rights to be granted in the UK by the UK Government for all existing EU-level rights. Specific statutory instruments have been made to provide for these replacement rights and, going forward, beyond the end of transition, for any new rights required to continue protection in the UK in areas previously provided by rights that existed only at EU level (such as unregistered Community design rights). This legislation comes into effect when the Brexit transition period comes to an end at 11pm on 31 December 2020.

**Brexit statutory instruments**

In addition to EU withdrawal legislation, the UK Government has made statutory instruments which adapt UK IP legislation to take account of the UK leaving the EU by amending references and also making provision for the various replacement rights or recognition of existing rights post-Brexit. We have included links to the relevant statutory instruments in the text on each type of IP right. However, see also *The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020* which amends errors in SIs already made and updates the SIs by substituting the term “IP completion day” for the various references to the “exit day”. Most of the SIs were originally drafted contemplating the possibility of a no-deal and no transition period situation, and so were to take effect on exit day, that being the day on which the UK left the EU (31 January 2020). The term
“IP completion day” does not refer to intellectual property, but to the interim period (transition period) completion day which is defined in the UK’s European Union (Withdrawal Agreement) Act 2020 as 11.00 pm on 31 December 2020. These amendments ensure that the provisions in the existing regulations take effect by reference to IP completion day rather than exit day.

The statutory instruments will come into force along with the other Brexit-related legislation at the end of the transition period. They will have the effect of replacing any IP rights that would otherwise be lost as explained in the introductory paragraph above.

For example, EU trade mark rights in the UK will be replaced by “a comparable trade mark (EU)” with the same priority date and all other administrative details as the EUTM from which it originated.

In brief summary, the following rights existing at the end of the transition period will be dealt with as follows:

- Rights provided for in the UK by virtue of EU trade marks will be replaced with “comparable trade marks (EU)”;
- Rights provided for in the UK by virtue of Community registered designs will be replaced with “re-registered designs”;
- Rights provided for in the UK by virtue of unregistered Community designs will become “continuing unregistered Community designs” (note: there will also be a new type of unregistered design right to replace the cover given currently in the UK by the unregistered Community design right, which will be known as the “supplementary unregistered design right”);
- Rights provided for in the UK by virtue of Community plant variety rights (“CPVRs”) will be recognised in the UK as if they were UK plant breeders’ rights (“PBRs”), so long as the CPVR was granted at least two months before the end of transition;
- Rights provided for in the UK by virtue of Geographical indications will continue to be recognised across the UK and EU, but there will be an entirely new UK regime for future applications; and
- Rights provided for in the UK by virtue of EEA sui generis database rights will be recognised in the UK and EEA. For database rights arising after the end of transition, separate EEA and UK rights will apply.

### Trade marks

#### Basic scheme

At the end of transition, registered EU trade marks existing at that point, no longer have effect in the UK, but are replaced by equivalent UK registered trade marks, termed “comparable trade marks (EU)”. This was a requirement of the Withdrawal Agreement and provision has been made for this via statutory instruments: The Trade Marks (Amendments etc.) (EU Exit) Regulations 2019 and Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019.

EU trade marks will still be valid in the remaining EU Member States. The UK Government has published a guidance note: EU trade mark protection and comparable UK trade marks from 1 January 2021 (30 January 2020).

#### Existing EU trade marks

**Conversion:** EU trade marks (“EUTM”) that are registered in the EUTM register at the end of transition, in so far as they have effect in the UK, are to be treated on and after the end of transition as UK registered trade marks, but will be referred to as “a comparable trade mark (EU)”. Such rights will be deemed registered as of the filing date of the corresponding EUTM. This is important, as there will be no publication of the new registration, and no new certificate will be issued. This means that sections 40(3) and 40(4) Trade Marks Act 1994 (“TMA”) will not apply to a comparable trade mark (EU).

**Ownership:** Ownership of the UK element of the EUTM will not change once this right is automatically converted to a comparable trade mark (EU). Although there are likely to be delays due to the overwhelming amounts of marks to be converted, the registrar has said that it will enter the details of the comparable trade mark (EU) in the UK register using the English language version of the specification for goods or services used for the corresponding EUTM.

**Opt-out:** It is possible for EUTM owners to opt out of the process, but if they do not, their trade mark rights in the UK will convert automatically to a comparable trade mark (EU). To opt out, the owner of an EUTM may at any time after the end of transition serve notice on the UK registrar that the EUTM is not to convert. This is subject to the following conditions after the end of transition:

- the comparable trade mark (EU) cannot have been put to use in the UK by the owner or with his consent;
• the comparable trade mark (EU) (or any right under it) cannot have been made subject of an assignment, licence, security interest or any other agreement or document except for an assent by an estate’s personal representatives; and
• the comparable trade mark (EU) must not be the subject of proceedings initiated by the proprietor or with his consent.

An opt-out notice must identify the EUTM and any person who has an interest in the EUTM which had effect before the end of transition and which was recorded in the EUTM Register. However, the notice will be of no effect unless the EUTM owner certifies that such a person has been given no less than three months’ notice of the owner’s intention to opt out or is not affected at all (or consents to the opt-out if affected). Once an opt-out notice is served, the comparable trade mark (EU) ceases to have effect in the UK from the end of transition and any details of the comparable trade mark (EU) will be removed from the UK register.

Comparable trade marks (EU)

Renewals: Once a comparable trade mark (EU) is entered into the register, if it is due to expire within six months from the end of transition, then the owner may renew the trade mark. However, if the owner fails to renew such a mark within those six months, then the registrar will notify the owner and the owner may renew the registration within six months from the date of the notice. If the trade mark is not renewed, then it will be removed from the UK register. If a comparable trade mark (EU) is removed because it is not renewed, then the rules relating to restoration of a UK trade mark apply.

Relative grounds in opposition proceedings in case of non-use: In UK opposition proceedings, an opponent can rely on its registration of an earlier trade mark. However, that earlier trade mark must have been put to genuine use in the UK within the five-year period before the date on which the opposed application is published. Where the earlier mark is a comparable trade mark (EU), if the five-year period expires before the end of transition, then use of the corresponding EU trade mark in the UK or the EU can be relied on. On the other hand, if the end of transition falls within the five-year period, then the use of the corresponding EU trade mark in the UK or the EU in the part of the period falling before the end of transition can be relied on by the owner.

Non-use as a defence in infringement proceedings: The owner of a UK trade mark that is over five years old can only prevent infringement of its mark to the extent that the trade mark is not liable to revocation for non-use at the date that the infringement proceedings are brought. The defendant may request that the trade mark owner provides proof that during the five-year period before the date of the commencement of the infringement proceedings the trade mark owner had made genuine use of its mark in the UK. Where the alleged infringement is of a comparable trade mark (EU), then if the five-year period expires before the end of transition, then the use of the corresponding EU trade mark in the UK or the EU can be relied on by the owner. On the other hand, if the end of transition falls within the five-year period, then the use of the corresponding EU trade mark in the UK or the EU in the part of the period falling before the end of transition can be relied on by the owner.

Non-use in the revocation of a comparable trade mark (EU): Section 46 of the TMA states that the registration of a UK trade mark may be revoked if: (i) it is not put to genuine use within five years from the date of registration; and (ii) use has been suspended for an uninterrupted period of five years; but (iii) the registration will not be revoked if use is commenced or resumed after the relevant five-year period, but before the application for revocation is made (ignoring any use made in the three months before the application for revocation).

Where there is a revocation action against a comparable trade mark (EU), if the five-year period expires before the end of transition day, then the use of the corresponding EU trade mark in the UK or the EU can be relied on by the owner. On the other hand, if the end of transition falls within the five-year period, then the use of the corresponding EU trade mark in the UK or the EU in the part of the period falling before the end of transition can be relied on by the owner. Similar provisions will apply to reliance on the use of EU trade marks in the EU, when the existence of an earlier comparable trade mark (EU) is relied on when seeking a declaration of invalidity of a UK trade mark registration.

Reputation of a comparable trade mark (EU):

The reputation of a trade mark in the UK may be relied upon: (i) to oppose a trade mark on relative grounds; or (ii) to claim infringement of a trade mark that has a reputation in the UK. Where the reputation of a comparable trade mark (EU) is to be considered in respect of any time before the end of transition, then the reputation of the corresponding EUTM in the EU may be considered.

Priority and seniority dates: The relevant date for determining the priority date of a comparable trade mark (EU) is the date from which priority is claimed for the corresponding
EUTM (ie the date on which the application was filed in a Convention country which is the basis of the claim of priority). Seniority may be claimed from a UK trade mark from which the corresponding EUTM claimed seniority. Thus, if the senior trade mark is allowed to lapse, the comparable trade mark (EU) continues to have the same rights as the owner would have had as if the UK senior mark had continued to be registered.

**Rights associated with EUTMs**

While the above paragraphs set out the position for the actual mark on the registry, questions remain as to what happens to related rights, such as assignments, licences, security interests, and the continuity of these related rights. We set out the status of these rights after exit day below.

**Assignments of an existing EUTM not recorded at the end of transition:** Where there is an assignment of an EUTM (or a right under it) but the assignment has not been registered at the EUIPO before the end of transition, then the assignee of the corresponding EUTM (or a right in it), or the owner of the comparable trade mark (EU), may apply to the UK registrar to record the assignment against the comparable trade mark (EU). The usual rules apply in relation to the effects of non-registration of the assignment, ie the assignment is ineffective against a person with a conflicting interest in ignorance of the assignment; and no award of costs for the claimant in infringement proceedings, unless the assignment was registered within six months of the date of the assignment.

**Licences of an existing EUTM:** Where an existing EUTM is subject to a licence before the end of transition which licenses the use of the EUTM in the UK and does not expire at the end of transition, then (subject to any agreement between the licensor and the licensee to the contrary) the licence continues to apply to the comparable trade mark (EU) in the UK (subject to the terms of the licence as may be modified in order to be applicable in the UK).

Whether or not the licence has already been recorded against the EUTM, an application to register the licence against the comparable trade mark (EU) may be made to the UK registry by the licensee or the owner of the comparable trade mark (EU). If the licence had not been recorded against the EUTM before the end of transition, then the usual rules apply in relation to the effects of non-registration, ie the licence is ineffective against a person with a conflicting interest in ignorance of the licence; the licensee does not have the statutory rights of a licensee in relation to infringement actions; and no award of costs for the claimant in infringement proceedings unless the licence was registered within six months of the date of the licence. Where the licence has been recorded against the EUTM before the end of transition, then the effects of non-registration do not apply until 12 months after the end of transition.

**Security interests in an existing EUTM:**

Where an existing EUTM (or any right under it) is the subject of a security interest before the end of transition and the security interest does not terminate at the end of transition, then reference to an EUTM in a document that creates security over the EUTM is to be read as including a reference to the comparable trade mark (EU). Whether or not the security interest has been recorded against the EUTM, an application to register the security interest may be made by the holder of the security interest over the comparable trade mark (EU) or by the owner of the comparable trade mark (EU). It is foreseeable, as is usual with the registration of security interests, that the holder of the security interest will seek to ensure that registration is appropriately made.

If the security interest had not been recorded against the EUTM before the end of transition, then the usual rules apply in relation to the effects of non-registration, ie the security interest is ineffective against a person with a conflicting interest in ignorance of the security interest. Additionally, where the security interest has been recorded against the EUTM before the end of transition, then the effects of non-registration do not apply until 12 months after the end of transition.

**Continuity of rights:** References to an existing EUTM in any document made before the end of transition shall, unless there is evidence that the document was not intended to have effect in the UK, be read on and after the end of transition as including references to a comparable trade mark (EU). Subject to any agreement to the contrary, if before the end of transition the owner of an EUTM has consented to the use or other act relating to the EUTM which would infringe the comparable trade mark (EU) on or after the end of transition, then the owner will be treated as having given consent to do that use or act in the UK on or after the end of transition.

**Trade mark litigation**

If, at the end of transition there are proceedings pending in the UK courts which relate to an EUTM, then the EU Trade Mark Regulation 2017/1001 will continue to apply as
if the UK were still a Member State (not Arts 128(2) (4) (6) and (7) or 132, which relate to counterclalm for revocation or invalidity of an EUTM). In infringement proceedings, the UK court may grant an injunction to prevent use of the comparable trade mark (EU) in the UK. In proceedings that involve a counterclaim for revocation/declaration of invalidity, the UK court may revoke or make the declaration of invalidity in relation to the comparable trade mark (EU). If before the end of transition there is an injunction in force that prohibits use of an EUTM in the UK, then the injunction continues to have effect in the UK, subject to any order of the court to the contrary.

Registration and renewal of expired EUTMs

An EUTM that has expired within six months before the end of transition is to be treated as if it were an existing EUTM. Thus, a comparable trade mark (EU) derived from an EUTM which expired in the six months prior to the end of transition can be entered onto the UK register, but the mark will remain expired unless and until it is renewed. If an expired EUTM is renewed in accordance with Article 53 of the EUTM Regulation (2017/1001) (ie in the six months before expiry or the six months following expiry), then the UK registrar must renew the comparable trade mark (EU) for a period of 10 years to the same extent as the EUTM is renewed (eg for the same goods and services).

EUTM applications

If an applicant has filed an application for an EUTM prior to the end of transition which has not been granted or refused prior to the end of transition, then if the applicant (or his successor in title) files an application for an identical UK mark for some or all of the same goods or services within nine months from the end of transition, then the UK mark takes its application date or priority date (under Article 32 EUTM Regulation) from that for the equivalent EUTM. If an EUTM application claims seniority from a UK trade mark registration, then a UK application which is based on the EUTM application can also claim that seniority, provided that the application for the UK mark is made within nine months of the end of transition. The applicant will have to pay the filing fees for the UK trade mark application.

Restoration of EUTM and applications

If an EUTM is removed from the EU register prior to the end of transition, but is restored to the EUTM register after the end of transition, then the owner of the EUTM may, within six months from the date of restoration, file at the UK registry a request that the EUTM is treated as an existing EUTM at the end of transition and is able to benefit from the provisions relating to comparable trade marks (EU). If an application for an EUTM has been refused before the end of transition and the application is restored on or after the end of transition and the applicant (or its successor in title) applies to register a UK trade mark for some or all of the same goods or services, then the application is treated as if the EUTM application was pending at the end of transition (and so can claim the same right to priority and or seniority as the EUTM), but the nine-month period for filing the UK application is calculated from the date of restoration.

Collective and certification marks

When collective marks or certification marks are filed at the European Intellectual Property Office ("EUIPO") or the UK Registrar, then the relevant regulations of use of that collective or certification mark must also be filed. An EU collective mark or an EU certification mark which becomes a comparable trade mark (EU) will be treated as a UK collective mark or a UK certification mark as the case may be. The owner of such a comparable trade mark (EU) must, after notification from the UK registrar, file at the UK registry the regulations of use that had been filed at the EU IPO before the end of transition (with a translation to English if appropriate). If the regulations of use are not filed, then the comparable trade mark (EU) will be removed from the register.

International trade marks protected in the EU

Similar provisions apply to an international trade mark which is protected in the EU (Article 189(2) EUTM Regulation) as they do to EUTMs. Under the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, the UK right is called a comparable trade mark (IR). The comparable trade mark (IR) is deemed to be registered in the UK from the date of registration of the international registration in the EUIPO if the EU was designated in the original international application filed at the World Intellectual Property Organisation ("WIPO") or, if a request for extension of the international registration to the EU was made subsequently to WIPO, from the date of the recordal of that request.

Other amendments

Amendments have also been made in relation to: payment of fees, amendments to the 1994 Act by removing references to the EU and amendments to the Trade Mark Rules 2008. Certain legislation is also revoked, including the EU Trade Mark Regulation 2017/1001.
Copyright

Brexit-related changes to copyright in the UK are dealt with by the Intellectual Property (Copyright and Related Rights) (Amendment) (EU Exit) Regulations 2019.

Although copyright law is not harmonised across EU, elements introduced through the Information Society Directive and other Directives, which are already transposed into UK law, will remain valid after exit day unless the UK Government choses to alter the law. Some key issues are that the country of origin principle will not include the UK, which means that separate clearance of rights will be required on a per-country basis for UK broadcasters to broadcast in the EEA. UK subscribers will no longer benefit from online content portability and that sui generis database rights will not (post-transition) arise in relation to databases created or owned by non-EEA entities/citizens. The UK Government has published guidance Changes to copyright law from 1 January 2021 (30 January 2020) – see more on database rights below. The UK Government is keen to negotiate some form of mutual recognition for broadcasting rights and continued portability. Member States have 24 months to implement the Directive on Copyright in the Digital Single Market from 15 April 2019, but since this implementation period is outside the transition period, the UK Government has stated that is not obliged to implement the Directive and has no plans to do so (see the Secretary of State for Business, Energy and Industrial Strategy’s response to a written question, in Hansard on 21 January 2020).

Copyright – the qualification test: the EU legislative test to qualify for copyright protection is “author’s own intellectual creation” where an element of creativity is required. However, old doctrine of UK courts was the application of “labour, skill and judgment”. The UK test is arguably easier to achieve. CJEU decisions Cofemel and Brompton Bicycle have now incorporated the “intellectual creation” test into UK copyright law (it was already there in relation to copyright in databases (s.3A CDPA)). There is a debate as to whether the UK courts may return to the “sweat of the brow” test post-transition.

Sui generis database rights

EEA sui generis database rights, by definition, only arise/exist in relation to databases created or owned by EEA entities/citizens under Article 11 Database Directive as confirmed in the European Commission Notice to stakeholders - Withdrawal of the United Kingdom and EU rules in the field of copyright (28 March 2018): “[the sui generis database right] ... “shall apply to a database whose makers or right holders are nationals of a Member State or who have their habitual residence in the territory of the Community. [...] Where such a company or firm has only its registered office in the territory of the Community, its operations must be genuinely linked on an ongoing basis with the economy of a [Member State].”

The UK Government’s guidance on copyright Changes to copyright law from 1 January 2021 (30 January 2020) also covers sui generis database rights mentioned above, as does the UK Government guidance Sui generis database rights from 1 January 2021 (30 January 2020). The Withdrawal Agreement allowed for these rights, if they arise before the end of the transition period, to be maintained in the UK for at least the same period as they would have done, but for Brexit whether their creators are UK or EEA-based and sui generis database rights existing at the end of the transition period which were created by UK-based entities will continue to be effective in the EEA. At the end of the transition period, new sui generis database rights in the EEA will not arise where the creators are not EEA-based. An equivalent right in the UK, giving the same protection as was available prior to the end of transition under EEA sui generis database rights, will be created by the UK Government in the UK for databases created by UK entities (Intellectual Property (Copyright and Related Rights) (Amendment) (EU Exit) Regulations 2019) In terms of protecting rights in the EEA in relation to databases created by UK entities post-transition, the UK Government has previously recommended that UK rights owners consider relying on other forms of protection, such as restrictive licensing agreements or copyright (where applicable), for their databases, as these will no longer qualify for sui generis database right in the EEA post-transition. One solution may be to ensure that databases are created by both a UK national an EEA one to ensure protection in both the UK and the EEA.

Geographical indications

Geographical indications (GIs) protected in the EU prior to the end of the transition period will continue to be able to be used in the UK by the persons to whom they are granted, from the end of the transition period, without any re-examination, and will be granted at least the same level of protection under the law of the United Kingdom, unless or until they cease to be protected in the EU. This also applies to protected designations of origin, traditional specialities that are guaranteed and traditional terms for wine.
The European Commission's publication Questions and Answers on the United Kingdom's withdrawal from the European Union published on 31 January 2020, states that “This agreement will also benefit the geographical indications bearing a name of UK origin (eg Welsh lamb): they will also obtain protection under UK law in the United Kingdom and maintain the existing protection under EU law in the EU”.

The UK will have a new regime for GIs in the UK from 1 January 2020 – see the UK Government guidance Protecting food and drink names from 1 January 2021 and the statutory instrument Agricultural Products, Food and Drink (Amendment etc.) (EU Exit) Regulations 2020.

In the same way that trade marks already registered as EU trade marks before the end of transition will be replaced in the UK by equivalent rights post-transition, geographical indications (GIs) (by this we refer to protected designations of origin, geographical indications and traditional specialities guaranteed) registered under the EU scheme prior to the end of transition will continue to apply across the remaining EU states post-transition and will also be replaced in the UK by rights under the new UK GI scheme.

However, those GIs first registered under the EU scheme from 1 January 2021 will not apply in the UK (this includes all GIs, once registered, where applications were still pending at 1 January 2021). After 1 January 2021, applications for protection made under the EU scheme for Great Britain (GB) localised GIs, ie applications made by producers from England, Scotland and Wales, will be treated as “third country” applications by the EU scheme.

From 1 January 2021, the UK will set up its own GI scheme which will be managed by the Department for Environment, Food and Rural Affairs (DEFRA). The scheme will be open to producers from the UK and from other countries worldwide. New GIs can be registered under the scheme from 1 January.

The UK scheme will cover the geographical names of food, drink and agricultural products (including beer, cider and perry), spirit drinks, wine and aromatised wine. These are the same categories protected under the EU scheme, as under the Withdrawal Agreement, the relevant EU regulations will be incorporated as UK law (unless the UK and the EU come to a different agreement as a result of free trade negotiations). The UK scheme will use the designations of Protected Designation of Origin (PDO), Protected Geographical Indication (PGI) and Traditional Speciality Guaranteed (TSG), which again mirrors the designations available under the EU scheme.

The UK Government has issued guidance (Protecting food and drink names from 1 January 2021 (28 September 2020)) on the new scheme, which also provides additional clarification on the interrelationship between this scheme and the EU scheme. From 1 January 2021, the EU scheme will no longer apply to the UK as it does to members of the EU – see the comments made by the European Commission in its Notice to stakeholders – Withdrawal of the United Kingdom and EU rules in the field of geographical indications (6 July 2020).

**Current EU scheme:** UK GIs registered under the EU scheme before the end of the transition period should continue to receive protection in the EU, but applications that are pending with the EU at the end of the transition period will no longer cover the UK.

Under the current (and continuing) EU scheme, to register a product name as a geographical indication, EU producers have to address their application to national authorities for scrutiny. The Member State concerned thereafter forwards the application to the European Commission, who examines the request following the procedures laid down in the above listed EU legislation.

For non–EU product names to be registered as geographic indications in the EU, producers send their applications either directly, or via their national authorities, to the European Commission. From 1 January 2021, Great Britain producers (but not Northern Ireland producers – see below) will be treated as a “third country” under the EU scheme, and will first need to secure protection for new GIs under the UK scheme before applying under the EU scheme. The criteria applied to determine registration of an application from a GB producer are otherwise the same as those which apply to products originating from the EU as outlined in the relevant EU regulations. Once registered, a GB GI under the EU scheme will benefit from the same level of protection as EU GIs.

**Protection in Great Britain under the new UK scheme:** From 1 January 2021, producers will need to apply for a new GI in Great Britain under the UK scheme.

According to the Withdrawal Agreement (and unless an alternate agreed position is reached regarding GIs), the EU regulations that govern the EU scheme will be directly retained in UK law (save for any amendments made by a statutory instrument to deal with deficiencies). Therefore, the criteria for obtaining protection
under the UK scheme should in theory be the same as that required under the EU scheme, though in practice it is possible that the criteria could be applied differently.

Under Article 54 of the Withdrawal Agreement, where a GI ceases to be protected under the EU scheme after 1 January 2021, the UK is not obliged to continue to provide protection for the GI either.

According to the UK Government guidance, DEFRA will publish further guidance relating to the application process.

On 22 October 2020, the UK Government published a draft statutory instrument, Agricultural Products, Food and Drink (Amendment etc.) (EU Exit) Regulations 2020 (Draft), which amends deficiencies to the retained EU regulations which govern the scheme for geographical indications.

**Protection in Northern Ireland (NI):** For new applications for protection in Northern Ireland and the EU from 1 January 2021, an application will need to be made under the EU scheme. Northern Ireland producers will need to make a separate application under the UK scheme for protection in Great Britain. Unlike EU producers, Northern Ireland producers will not need to be protected first under the EU scheme before applying for protection under the UK scheme.

In addition, registered GIs in relation to products that can be produced anywhere on the island of Ireland (including Irish Whiskey, Irish Cream and Irish Poteen) will continue to be protected and protectable under both the EU and the new UK schemes.

**New UK regime logos:** There are logos for each of the three UK designations that can be downloaded and used from 1 January 2021. For food and agricultural GI products produced and for sale in Great Britain and registered from 1 January 2021, the relevant UK logo must appear on the packaging and marketing material from the date of registration. As for food and agricultural GI products produced and for sale in Great Britain and registered under the EU system before 1 January 2021, producers will have until 1 January 2024 to amend the packaging and marketing materials to display the relevant UK logos.

As is the case under the EU scheme, displaying the UK logos will be optional in relation to wine and spirit GIs.

For food and agricultural GI products of EU origin and of Northern Ireland origin (ie that are not produced in Great Britain), the use of the UK logos will be optional from 1 January 2021. In accordance with the draft statutory instrument as at the time of writing, EU and Northern Ireland producers that have food and agricultural GI products registered under the EU scheme, even if is also registered under the UK scheme, can continue to use the EU logos on their products for sale in Great Britain from 1 January 2021 and beyond 1 January 2024.

**Continued use of EU logos:** Food and agricultural GI products of EU origin must, under existing EU regulations, display the relevant EU logos. The same will continue to apply to food and agricultural GI products of Northern Ireland origin that are registered under the EU scheme.

As noted above, for food and agricultural GI products produced and for sale in Great Britain that were protected under the EU scheme before the end of the transition period, the EU logo may continue to be used until 1 January 2024, after which these producers will need to add the UK logos to the relevant packaging and marketing materials. Great Britain GI products that are protected in the EU can continue to use the EU logo on products sold in GB (but it will no longer be mandatory under the EU regulations) in addition to the mandatory UK logo.

**International protection:** In February 2020, the Geneva Act of the Lisbon Agreement came into force. This treaty establishes the Lisbon System, an international registry for GIs through which registration can be obtained via a single application to WIPO. The EU acceded to the Geneva Act in November 2019, which enabled the Geneva Act to come into force.

The Geneva Act currently applies to the UK during the transition period. However, the UK will not be obliged in its own scheme to continue to protect geographical indications registered through the Lisbon System after the transition period ends (unless the UK ratifies the Geneva Act independently after the transition period). It seems unlikely that the UK will independently ratify the Geneva Act, as this issue is not addressed in the UK Government guidance on geographical indications. Further, under Art 54(2) of the Withdrawal Agreement, where protection in the EU is derived from international agreements to which the EU is a party, the same level of protection does not need to be provided in the UK.

The UK Government guidance on GIs does state that reciprocal international protection of UK GIs will continue after 1 January 2021, if protection is granted under an EU free trade agreement where the UK has signed a continuity agreement. The UK Government guidance lists the Andean Community (being a free trade area comprising Bolivia, Colombia,
Ecuador and Peru, Chile and Switzerland as examples, and recent developments in the UK Government negotiations mean that a level of protection will also continue in Japan and Korea. Reciprocal international protection of UK GIs will also continue where protection is granted under other EU third country sectoral agreements (agreements that are not free trade agreements) where the UK has signed a continuity agreement.

It remains to be seen in the upcoming months whether the UK Government’s international negotiations mean that reciprocal international protection of UK GIs will have the same jurisdictional coverage as the UK previously had in the EU. If continuity agreements to EU free trade agreements cannot be agreed before 1 January 2021, then the UK is likely to miss out on a level of reciprocity of protection for UK GIs going forward, unless and until alternate agreements can be made.

**Designs**

Changes to the design regime in the UK necessitated by Brexit are covered by the *Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019*. Below we set out the impact of the end of transition on both registered Community designs (“RCDs”) and unregistered Community designs (“UCDs”).

**Registered community designs**

If a design is registered on the RCD register and published in the Community Design Bulletin before the end of transition, it will be treated in the same way as if it were a UK registered design. It will be automatically entered on the UK register at no cost and termed a “re-registered design”. See *The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019*. The priority date and any other assessment dates will remain the same. The same applies to designs registered for the EU under the Hague System, although these will be termed “re-registered international design” instead. The Hague System for the International Registration of Industrial Designs will remain open for UK businesses to access as the UK has already ratified this agreement in its own right.

Just as with trade marks, design owners can opt out, at any time from the end of transition onwards, from the automatic conversion of its design rights. However, if the application for a design right is pending on exit day despite having a filing date, the rights holder will have to re-file its application at the UKIPO as a UK application within nine months from the day after exit day. The new application will then be given the same filing date as the RCD application. The same applies if the RCD application is deferred.

There will be the opportunity to opt-out of the replacement right (as there is with the trade mark arrangements). Details of how to do this and the limitations, as well as guidance on the above, are set out in UK Government guidance: *Changes to EU and international designs and trade mark protection from 1 January 2021* (30 January 2020).

**Unregistered community designs**

Like RCDs, UCDs created before the end of the transition period will automatically convert into an equivalent UK right post-transition. These new equivalent rights will be called “continuing community unregistered designs”. These rights will expire on the same day as it expires in the EU27, meaning that the last rights that are created will expire three years from the end of transition.

A new right, the “supplementary unregistered design” will be introduced in the UK to fill the gap left by the unregistered community design right. It is important to note that the separate UK unregistered design right is not exactly the same, hence the need for this new right. The supplementary unregistered design right will protect designs where they are disclosed in the United Kingdom or countries or territories that are designated by statutory instrument.

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Where designs are first disclosed, will be significant post-transition. UCDs arise when the design is first made available in the EU. Qualification for the new UK right, supplementary unregistered design, will be dependent on first disclosure in the UK, or other qualifying country, but first disclosure in the EU will not establish the right and may destroy the novelty in the design, should registered rights be sought subsequently. See the UK Government’s guidance, *Changes to unregistered designs from 1 January 2021* (30 January 2020).

**.eu Domain names**

The registry for .eu domain names (“EURid”) issued guidance on 3 February 2020, stating that “During the transition period UK residents and citizens will continue to be able to hold and register a .eu domain name”. According to Article 4(2)(b) of Regulation (EC) No 733/2002, as amended by Regulation (EU) 2019/517, as of 19 October 2019, the following persons are eligible to register .eu domain names:

- a Union citizen, independently of their place of residence;
- a natural person who is not a Union citizen and who is a resident of a Member State;
• an undertaking that is established in the Union; or
• an organisation that is established in the Union, without prejudice to the application of national law.

As from the end of the transition period (currently this would be from 1 February 2020), the plan outlined below will apply in relation to .eu domain names that have GB/GI as the registrant’s residence country code:

**New registrations:** EURid will not allow the registration of any new domain name with GB or GI as the residence code, unless the registrant’s citizenship country code is an EU27 Member State.

**.eu domain names with GB or GI as the registrant’s residence country code at the end of the transition:** GB and GI registrants will receive communications of their non-compliance with the .eu regulatory framework prior to the transition. They will be given the opportunity to comply with the framework – EURid’s notice contains examples of actions which can be taken by GB and GI registrants. Those who do not demonstrate compliance with the .eu regulatory framework will be deemed ineligible to hold a .eu domain name and their domain name will be withdrawn.

**.eu domain names with GB or GI as the registrant country code on WHOIS, but are on hold on at the end of transition:** If there is a legal court case pending, these domain names will remain unregistered until judgment. However, they will be suspended and cease to function. The rules mentioned above in relation to the registrant’s residence country code apply to these domain names as well, with the difference that EURid will withdraw the domain name as soon as practicable after having received a final court decision.

**.eu domain names with GB or GI as the registrant country code on WHOIS, but in quarantine status at the end of transition:** No transfers from quarantine will be possible between, unless the registrant has a citizen country code of an EU27 Member State. Transfer to a registrant not in GB or GI will remain possible.

For any EU citizens that have a registered domain name, they will have to ensure that their registration data is updated to comply with the eligibility criteria of Article 20 of Regulation 2019/517. Similarly, any UK citizens that are resident in an EU27 Member State will remain eligible for an .eu domain name on the basis of the Article 20 criteria. It is therefore crucial for domain name holders to act to ensure that their domains are not withdrawn from the register.

**Patents**

**European patents and UK national patents**

UK designated European patents (“EPs”) will continue to apply in the UK and it will still be possible to apply for EPs at the European Patent Office. UK entities will be able to apply for European patents as normal for any designations. Nationally granted UK patents will also be available. The statutory instrument, *Patents (Amendment) (EU Exit) Regulations 2019* amends UK patent law to ensure that those aspects of the law which currently are based on EU legislation will, after the UK leaves the EU, be incorporated into UK law so as to operate on a national basis.

**The UPC**

The main impact of Brexit on patent litigation has been on the establishment of the Unified Patent Court (“UPC”). Although the UK ratified the **UPC Agreement** which will bring the UPC into existence, it subsequently withdrew its ratification and withdrew from the UPC system. Germany’s ratification and its deposition is the final ratification now needed for the UPC sunrise period to be triggered. Germany’s ratification had been delayed by a complaint about the UPC Agreement in the German Constitutional Court and the court’s decision that the legislation had not be passed with a sufficient majority. The legislation has now been passed with the required two thirds majority, and at the time of writing we await the formal ratification of the UPC Agreement by Germany. It is currently expected that the UPC system will commence in 2022. For more information see our UPC and unitary patent hub [here](#).

**Pan-European patent enforcement post-transition**

The fact that the UK is not in the EU (and not in the UPC system) will not affect the ability of UK businesses with European patents (EPs) designated to participating EU Member States to use the UPC to enforce patents or seek declaratory relief, unless they have chosen to opt these patents out of the UPC’s jurisdiction. UK entities will of course also be able to apply for European patents with unitary effect (otherwise termed unitary patents (UPs)) which will be under the exclusive jurisdiction of the UPC – although UPs will not cover the non-participating EU Member States (Spain, Croatia and Poland, and now the UK), nor any non-EU European Patent Convention States (eg Turkey,
Switzerland, Norway), for which EPs (or of course national patents) will still be available. EPs in those jurisdictions will need to be litigated nationally as they will be outside the jurisdiction of the UPC. Other EPs designated for UPC participating states will be under the jurisdiction of the UPC unless opted out (see below), although during an initial UPC transition period of 7 years (which could be increased by another 7 after an assessment at the 5 year point) the UPC and national courts will have dual jurisdiction over non-opted out EP in relation to infringement and revocation. Thus there will still need to be a multi-jurisdictional approach to patent enforcement, even with the UPC in place.

The UPC has advantages (central enforcement) and disadvantages (central revocation) for patentees and their competitors alike. Assuming that the UPC does “go live” in 2022 as looks increasingly likely (in particular now that the Commission’s Communication Making the most of the EU’s innovative potential – An intellectual property action plan to support the EU’s recovery and resilience (published 25 November 2020) has confirmed the Commission’s wish to support the UPC and hasten its establishment), UK businesses with UPs and EPs will still be able to use the UPC for enforcement of their patents in participating EU states.

However, given concerns about how the UPC will operate in the early years and the uncertainty over the approach of its judiciary and the interpretation of the rules of procedure, some patent proprietors may choose to opt-out their European patents from the UPC system. This will be possible in advance of the system coming into effect during a “sunrise period” which will be announced once the provisional application phase of the UPC Agreement has commenced. The opting out of EPs combined with the existence of EPC states which will not be in the unitary patent/Unified Patent Court system will mean that a multi-jurisdictional approach will continue; businesses are still likely to pursue litigation in multiple jurisdictions across Europe (including the UK) outside of the UPC system. Pan-European enforcement strategies will thus remain important post-Brexit transition and post the introduction of the UPC. Thus it will still be critical to have advisers who are expert in handling multiple cross-border disputes and managing local lawyers in jurisdictions within Europe or beyond. See our jurisdiction and opt-out page of HSF’s UPC and UP hub on our website for more information on the UPC and our article on considerations for opt-out published in Managing IP Magazine, as well as our PLC Magazine article on preparing your patent portfolio for the advent of the UPC and the UP which are also linked on our UPC and UP hub.

Supplementary protection certificates
Supplementary Protection Certificates (“SPCs”) are UK national rights granted by the Intellectual Property Office (“IPO”) under rules determined by an EU Regulation.

The UK Government’s guidance Changes to SPC and patent law from 1 January 2021 (30 January 2020) confirms that the Withdrawal Agreement ensures that SPC applications which are pending at the end of the transition period will be examined under the current framework. Any SPC which is granted post-transition, based on those pre-end of transition applications, will enjoy the same level of protection as SPCs granted before the end of transition. An SPC that has already taken effect will remain in effect after 31 December 2020. SPCs granted but not yet in force will come into force at the end of the associated patent term as normal. The current EU law states that an SPC can only be granted if the product is protected by a patent and covered by a marketing authorisation (“MA”), in the Member State where SPC protection is being sought. This continues through the transition period and will stay the same post-transition.

To get an SPC in the UK, a patent valid in the UK will be a pre-requisite and a MA which allows the product to be sold on the UK market at the time the SPC is applied for. MAs already in place (granted by the EMA) prior to the end of transition will convert automatically into UK MAs at the end of transition. Post-transition, new MAs for the UK will be granted by the Medicines and Healthcare products
Regulatory Agency ("MHRA"). This is not a reciprocal process, however, and UK post-transition MAs granted by the MHRA will not automatically become EU MAs - the latter will need to be applied for separately at the EMA. An SPC filed after the end of the transition period will get the same term of protection as it would if filed before. This will still be calculated based on the first authorisation to place the product on the market in either the UK or the EEA.

The manufacturing waiver was introduced by EU law in July 2019 via Regulation (EU) No 2019/933 of the European Parliament and of the Council of 20 May 2019 amending Regulation (EC) No 469/2009 concerning the supplementary protection certificate for medicinal products. This Regulation enables third parties to manufacture SPC-protected products without requiring the consent of the SPC holder, but only for export outside the EU or for storing in the EU for sale on the EU market after the SPC has expired, without infringing the SPC. The UK Government conducted a consultation on the form legislation should take to allow for this waiver post-transition and the final form of the legislation needed and amended its original proposals to allow the waiver to apply to allow third parties to manufacture in the UK for export to countries outside the UK or EU; and, in the final six months of the SPC term to manufacture for storing for sale in the UK or EU after the SPC expires. The “EU export” logo required by the EU Regulation will be replaced by a “UK export” logo but there will also be a power to make secondary legislation to define further requirements for this logo wording if this one does not provide sufficient protection. See the The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020.

The Withdrawal Agreement sets out a provision for dealing with pending applications for SPCs in the United Kingdom, stating that Regulation (EC) No 1610/96 of the European Parliament and of the Council of 20 May 2009 concerning the supplementary protection certificate for plant protection products, for medicinal products, or applications for the extension of the duration of such certificates, submitted to an authority in the United Kingdom before the end of the transition period where the administrative procedure for the grant of the certificate concerned or of the extension of its duration was ongoing at the end of the transition period and that any certificate granted pursuant to this “shall provide for the same level of protection as that provided for in Regulation (EC) No 1610/96 or Regulation (EC) No 469/2009”. The UK has made a statutory instrument, Supplementary Protection Certificates (Amendment) (EU Exit) Regulations 2020, to provide for this.

For more on the MA process post-transition see our blog post Marketing Authorisations in the Post-Brexit World.

There has been no provision made under the Unitary Patent Regulation (EU) No 1257/2012 for “unitary SPCs”, nor under the UPC Agreement. It appears that SPCs on unitary patents will therefore need to be obtained through separate applications in each country for which protection is required (as currently for EPs).

However, any assessment of the validity of an SPC (on either an EP or a UP) will be made by the UPC unless the EP involved has been opted out. It is possible that there may be some sort of unitary SPC available in the future, but this would require a central administrative body and further legislation and so is unlikely to be in place before the end of the currently envisaged transition period.

The need for an EU-wide mechanism for granting or enforcing SPCs is being considered by the European Commission which mentions the possibility of introducing a unified SPC grant mechanism and/or creating a unitary SPC title in its recently published Communication: Making the most of the EU’s innovative potential – An intellectual property action plan to support the EU’s recovery and resilience (25 November 2020).

Paediatric extensions

With regards to the six-month paediatric extensions granted by EU Regulation 1901/2006, the UK Government’s guidance Changes to SPC and patent law from 1 January 2021 (30 January 2020) states that if you have already been granted a paediatric extension to an SPC at the end of transition or have an application for one pending before the IPO, the existing requirements will still apply.

This means that proof of MAs in all EEA states will still be needed before the extension can be granted and existing extensions can still be challenged on this basis.

From 1 January 2021, the availability of the paediatric extension will be determined based on equivalent provisions in the UK’s Human Medicines Regulations 2012. The process of applying for an extension will remain the same. One will still be able to make the request at the same time as filing the SPC application, or at any point up to two years before the SPC expires. The requirement for extension will be the same, but evidence of authorisation covering the product across the EEA will no longer be needed.
Plant variety rights

Community plant variety rights

Rights provided for in the UK by virtue of Community plant variety rights will be recognised in the UK as if they were UK plant breeders’ rights so long as the CPVR was granted at least two months before the end of transition. Rights holders must apply to the Animal and Plant Health Agency (“APHA”) for the equivalent UK rights if applications for EU rights have not been granted by 31 October 2020 or if they are granted during the period between that date and the end of the transition period, according to the UK Government guidance: Plant variety rights and marketing plant reproductive material from 1 January 2021. For further details see this guidance and the statutory instrument made in relation to CPVRs: Animal Health, Invasive Alien Species, Plant Breeders’ Rights and Seeds (Amendment etc.) (EU Exit) Regulations 2019 and Plant Breeders’ Rights (Amendment) (EU Exit) Regulations 2020.

Exhaustion of IP rights

IP rights are considered exhausted in the EEA once goods which incorporate the IP rights or are marketed by reference to them have been put on the market anywhere in the EEA by the rights holder or with its permission. Thus, the rights holder cannot rely on his IP rights to prevent movement of those goods within the EEA. After the end of the transition period, the UK will no longer be part of the EEA and such EEA exhaustion would not automatically apply to goods put on the market in the UK and nor would rights in goods put on the market in the EEA be regarded as exhausted in the UK. This would create an opportunity for the enforcement of rights at the border (in both directions) so limiting the movement of goods between the EEA and the UK.

Goods moving from the EEA to the UK post-transition: As a partial resolution to the potential problem of the restriction of movement of goods by virtue of the assertion of IP rights, the UK Government has made The Intellectual Property (Exhaustion of Rights) (EU Exit) Regulations, states that anything which was, immediately before the end of the transition period, an enforceable EU right relating to the exhaustion of rights of the owner of an IP right under Arts 34 to 36 of the TFEU or Articles 11 to 13 of the Agreement on the EEA, and is retained EU law by virtue of section 4 of the European Union (Withdrawal) Act 2018, has the same effect on and after the end of the transition period, despite the UK not being a Member State, as it had immediately before the end of the transition period. “Enforceable EU right” includes any right created or arising by or under the Treaties, and all remedies and procedures provided for by or under the Treaties which are given legal effect or are used in the UK without further enactment and such rights are recognised and available in UK domestic law and are enforced, allowed and followed accordingly (section 2(1) of the European Communities Act 1972).

As a result, there are consequential amendments to the relevant IP statutes. For example, section 12(1) of the Trade Marks Act 1994 will be amended to state that “a registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market in the United Kingdom or the European Economic Area under that trade mark by the proprietor or with his consent”. Section 17(3) of the Trade Marks Act 1994 will be amended to state that “nothing in subsection (2) shall be construed as affecting the importation of goods which may lawfully be imported into the United Kingdom by virtue of anything which forms part of retained EU law as a result of section 3 or 4 of the European Union (Withdrawal) Act 2018”. Similar amendments will be made to sections 7A(4) and 24G(5) of the Registered Designs Act 1949 and to Sections 18(2) and 27(5) of the Copyright, Designs and Patents Act 1988 (“CDPA”).

Goods moving from the UK to the EEA: In the UK Government’s guidance, Exhaustion of IP rights and parallel trade from 1 January 2021 (30 January 2020), there is reference to the fact that goods put on the market in the UK by or with the consent of the right holder after the transition period “may no longer be considered exhausted in the EEA” and the advice to UK IP rights holders to consider whether they wish to use their rights to prevent exports to the EEA and to exporters to check that the goods they are exporting may require permission from the rights holder post-transition. The Withdrawal Agreement states that goods in the distribution chain at the end of the transition period will be allowed to continue to end-users without interference and thus rights in goods
which were exhausted before the end of transition will continue to be exhausted – but this is a reference to actual goods already put on the market, not to a continuing exhaustion for similar goods put on subsequently. Thus, unless provision to the contrary is negotiated at the last minute in the final trade agreement, for goods newly put on the market in the UK post-transition, right holders in the EEA will be able to prevent their movement into the EEA using EEA/EU-wide rights or national rights in EU Member States.

The UK Government has passed a statutory instrument which would allow for a new scheme for the enforcement of intellectual property rights at the border where previously the EU scheme applied (Customs Enforcement of Intellectual Property Rights (Amendment) (EU Exit) Regulations 2019).

Licensing

Although there is provision in the Withdrawal Agreement for the EU to be “understood” as including the UK in any interpretation of EU law during the transition period, the same does not directly apply to individual contractual and other arrangements and nothing is agreed as to how to approach this post-Brexit. The effect of the territory of a licence being specified as the “EU” or whether a licence of EU-wide right covers the replacement right in the UK post-transition will be a matter of contractual interpretation: see the section of the HSF Brexit Legal Guide: Contract and other obligations.

For clarity, those who license (in or out) EU-wide IP rights or have the EU as a designated territory in any agreement where the UK is a key territory should take every opportunity to ensure that all parties are in agreement as to what this means during the transition period and importantly beyond. New agreements should provide specifically for the effect of Brexit.

Disputes

It is likely there will be cases before the CJEU in progress at the end of the transition period, including references from the UK courts, that may affect EU rights that will become UK rights. Rulings made by the CJEU in a specific case will be binding on the point dealt with. Generally, EU law predating the end of transition is likely to be applied by UK courts in so far as relevant to retained EU law or, potentially, the scope of UK rights intended to mirror EU rights in the UK, although the Court of Appeal and the Supreme Court will be free to depart from EU precedent. See the section of the HSF Brexit Legal Guide: The UK’s new legal order post-Brexit: A new class of UK law.

In addition, the Withdrawal Agreement is directly effective in the UK in so far as it creates or gives rise to rights, powers, liabilities, obligations and restrictions (by virtue of section 7A of the European Union (Withdrawal) Act 2018, introduced by the European Union Withdrawal Agreement Act 2020 section 5. To this extent, the Articles dealing with the IP rights that the UK has promised to provide will be binding on the UK courts.

There will be changes to the law on choice of court and enforcement of judgments, but arbitration rules are unaffected: see the section of the HSF Brexit Legal Guide: Disputes.

Finally, any provisions in trade agreements between the EU and third countries relating to intellectual property ceased to be legally binding on the relevant third countries on 31 January 2020, although it is expected that most third countries will continue to treat the UK as if it were an EU Member State until the end of transition. The UK has been working to “roll over” these agreements in direct agreements with the third countries that have free trade agreements with the EU, which would preserve the status quo and has had some success in achieving this. See the section of the HSF Brexit Legal Guide: Trade: The future relationship between the UK and the EU.

Any of these matters may need to be considered in the event that a licensing dispute arises. Disputes relating to the validity or use of an intellectual property rights will continue to be dealt with primarily before the national or European body responsible for the grant of the right and the courts of a relevant country where that right is being exercised/the CJEU.

On a practical level, see also the statutory instrument: Patents, Trade Marks and Designs (Address for Service) (Amendment) (EU Exit) Rules 2020 which provide that from the end of the UK-EU transition period the recorded address for service of documents in proceedings relating to patents, trade marks, and registered and unregistered designs must be in the UK, Gibraltar or the Channel Islands except in certain specified circumstances.

Key contacts

Sophie Rich  
Partner, Joint Global Head of IP  
T +44 20 7466 2294  
sophie.rich@hsf.com

Jonathan Turnbull  
Partner  
T +44 20 7466 2174  
jonathan.turnbull@hsf.com

Laura Deacon  
Of Counsel  
T +44 20 7466 2045  
laura.deacon@hsf.com

Rachel Montagnon  
Professional Support Consultant  
T +44 20 7466 2217  
rachel.montagnon@hsf.com

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