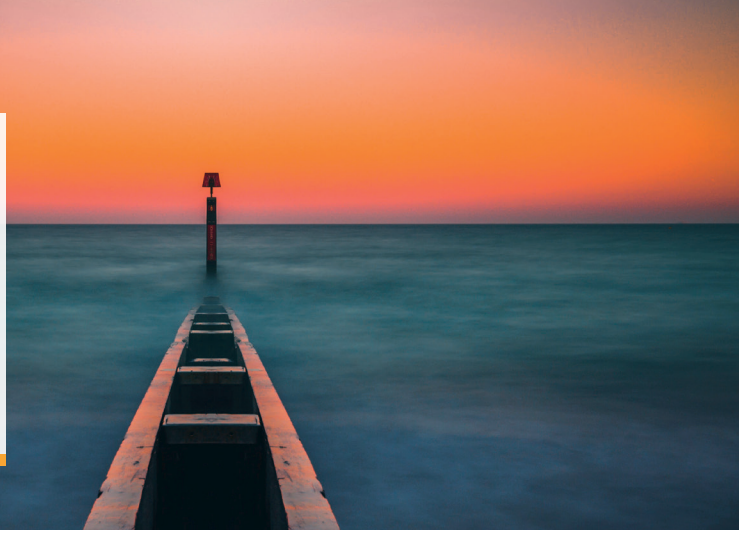
Brexit and IP action points



After Brexit comes into effect on 31 January 2020, a transition period will run until 31 December 2020. During this period, the UK will continue to be treated as an EU member state, giving IP owners further time to prepare. Please consider the following:

Action: *during the transition period*

- ☐ At the end of the transition period, EU trademark (EUTM) and design (RCD) registrations, including registered EU designations in International Registrations (IRs) will be automatically cloned into corresponding UK national registrations. Plan to complete any pending applications in good time before the end of the transition period.
- ☐ Add UK designations to new IRs, or new extensions of existing IRs designating the EU, if the UK market is important to you. You will not then need to refile pending EU applications as national UK applications after the transition period ends.

Action: *after the transition period*

- ☐ At the end of the transition period, there will be a further nine-month period for refiling UK counterparts of pending EUTM and RCD applications, including IRs. During this period, the applicant will be able to retain the original filing date of the EUTM or RCD. Pending EU applications should be refiled in the UK as soon as you have assessed pending rights: A large number of UK applications are expected before the due date in 2021, potentially delaying the progress of UK applications.
- ☐ Update records: Novagraaf will be onboarding and checking EU registered rights that have been automatically cloned into UK registrations for the portfolios we manage on your behalf. Check, however, whether cloned UK registrations need updating regarding recorded licences or security interests. You can also use this as an opportunity to "prune" the wider portfolio by marking cloned rights in the UK that need not be retained upon renewal.
- ☐ Monitor renewals deadlines: Any EU renewal due after the transition period has ended will also require a UK renewal (you can't avoid the fee by renewing early). Please note, however, that you will not be able to renew the comparable UK right from any EUTM that is due for renewal, but has not been renewed, at the end of the transition period, until that EU renewal is made (including in the grace period). If the EUTM is not renewed, the comparable UK right ultimately will die with it.
- ☐ Closely watch for guidance about EUTM and RCD disputes that started, but did not conclude, before Brexit.

General IP:

- ☐ Check all IP agreements and update where appropriate.
- ☐ If relevant, record nine-month priority window to refile EU geographical indications (GIs).
- ☐ Transfer .eu domains to an EU-based entity.
- ☐ Check Customs applications for action (AFAs) covering the EU and refile for the UK where appropriate.
- ☐ Deferment of publication of pending EU designs (RCDs or IRs) beyond the end of the transition period will result in the application/s not being automatically cloned into a UK right, and needing to be refiled claiming the original filing date.
- ☐ Examine the impact on your business of EU Regional Exhaustion rules potentially no longer covering the UK. As the situation is not entirely clear within the Withdrawal Agreement, the final rules on exhaustion may ultimately depend upon the formal trade terms negotiated between the parties. We will continue to monitor the situation and will keep you informed of developments.

How can Novagraaf help?

Novagraaf is a Europe-wide firm, with offices in the UK, as well as across the European Union, meaning we can act for you, even when changes in representation rules come into effect after Brexit. If you have any questions about your IP portfolio pre- or post-Brexit, please get in touch. In addition to general advice, we can assist with a detailed IP portfolio audit to identify specific rights where you may need to take action, as well as duplicate rights or potential gaps in your coverage in Europe.

Get in touch

Contact us at customerservice@novagraaf.com or subscribe to our newsletter at www.novagraaf.com to receive future updates on Brexit.

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