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Trade Marks

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Update Brexit and trade marks – Madrid System set aside for International Registrations

The UK Government has laid to Parliament on 31 January 2019 additional draft regulations for Brexit ([The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019](#) ). Further to the documents regarding European Union Trade Marks – see our [Special Bulletin of 18 January 2019](#)  – the Government now, among others, addresses International Registrations designating the European Union.

The concept stays the same: International Registrations are cloned onto the national register and are treated as UK trade marks. They will be called *comparable trade marks (IR)*. Remember: Cloned EUTM will be called *comparable trade marks (EU)*.

British Government has thus chosen to leave the Madrid System as administered by WIPO. So far, rumors went that EU designations could continue as UK designations within one and the same International Registration; this concept is called „continuation of effect“ and has been seen in history (when Montenegro departed from Serbia-Montenegro). Now it is clear that a strictly national solution is preferred.

As soon as practically possible after Exit Day, „registered“ *EU designations* will be cloned automatically and free of charge with application date, priority, seniority, and all goods and services onto the national register, just like EUTMs will be cloned. „Registered“ means that the EU designation received the grant according to Art. 189 (2) EUTMR so that there is no (longer a) refusal of protection pending. Opting-out is possible as long as third party interests do not stand opposed. With expiry of the International Registration within six months after Exit Day, the Office

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will contact right owners by setting a grace period of renewal without surcharge of another six months. Infringement proceedings will continue with the cloned trade mark. A new grace period of non-use will not be granted.

For „*pending*“ *EU designations*, there will be a *fresh application period* of nine months. Exit Day is not relevant here but either the day of international registration at WIPO or the day of subsequent designation, each relating to the EU designation. The clone will run through normal examination at the Office, at standard fees. According to this system cloning will not be permissible if and to the extent the pending EU designation has been refused protection by EUIPO prior to Exit Day, and such refusal is not subsequently lifted.



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