

Madrid Protocol Concerning the International Registration of Marks

United Kingdom: Implications of the End of the Transition Period for International Applications and Registrations

1. The Agreement on the Withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community provides for a transition period ending on December 31, 2020 (please, refer to Information Notice No. 2/2020). The Government of the United Kingdom has informed the International Bureau of the World Intellectual Property Organization (WIPO) of the steps that it will take to deliver continued protection in the United Kingdom, after the end of the transition period, to marks in international registrations with effect in the European Union before this period has ended.
2. Following the end of the transition period, a comparable United Kingdom trademark, which will be recorded on the Register of the United Kingdom, will be created for every international registration granted protection in the European Union before January 1, 2021. Where protection results from multiple designations of the European Union in one international registration, for example, a designation made in the international application and a subsequent designation, a comparable United Kingdom trademark will be created separately for each designation. These newly created comparable United Kingdom trademarks will be independent from the international registration and governed by the United Kingdom law. Therefore, holders will have to manage them directly with the Intellectual Property Office of the United Kingdom (UK IPO).
3. Holders whose international registrations are still pending before the European Union by the end of the transition period, will be able to apply for trademark registration with the UK IPO in the nine months after January 1, 2021, and preserve the date of the designation of the European Union. The same applies for holders whose international registration or subsequent designation of the European Union, as the case may be, is inscribed in the International Register after the end of the transition period, but with a date earlier than January 1, 2021. In this case, the said nine-month period will be counted from the date on which the international registration or subsequent designation of the European Union is inscribed in the International Register.
4. For further details, please refer to guidance issued by the Government of the United Kingdom, which is available at the following address: <https://www.gov.uk/guidance/changes-to-international-trade-mark-registrations-after-the-transition-period>.

5. Finally, it should be noted that the end of the transition period will not negatively affect the rights of holders of existing international registrations for which the European Union is the Contracting Party of the holder and who are nationals of or domiciled in the United Kingdom or have a real and effective industrial or commercial establishment in this country. However, after the end of the transition period, they will no longer be able to claim entitlement through the European Union in an international application or, as the transferee, in a request for the recording of a change in ownership. Instead, since the United Kingdom is a Contracting Party to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, they may continue to claim entitlement through the United Kingdom and, for example, file an international application with the UK IPO, as the Office of origin.

6. For further information, please refer to the frequently asked questions on the implications of the end of the transition period for international applications and registrations, available at the following address: <https://www.wipo.int/madrid/en/faq/>.

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