

AkzoNobel

Brexit

AIPPI Zeist – 13 maart 2019

Joost van Ooijen

Een monster?



Of Splendid Isolation Part II?

The United Kingdom will leave the European Union on 29 March 2019 and begin to chart a new course in the world. The Government will have delivered on the result of the 2016 referendum – the biggest democratic exercise in this country’s history. And it will have reached a key milestone in its principal mission – to build a country that works for everyone. A country that is stronger, fairer, more united and more outward-looking.



“one of the best places in the world to protect your IP”

The Intellectual Property Office (IPO) continues to contribute fully to the government’s work towards exiting the EU. It has a clear goal of ensuring an effective IP regime that supports UK innovation and creativity. The UK will remain one of the best places in the world to obtain and protect your IP.

Goods and services

English (en)

32 Energy drinks containing caffeine; Beer.



Trade mark information

Name	BREXiT	Filing date	06/09/2016
Filing number	015801384	Registration date	
Basis	EUTM	Expiry date	
Date of receipt	06/09/2016	Designation date	
Type	Figurative	Filing language	Polish
Nature	Individual	Second language	English
Nice classes	32 (Nice Classification)	Application reference	
Vienna Classification	24.07.01, 24.07.23, 26.13.99 (Vienna Classification)	Trade mark status	Appeal pending 
		Acquired distinctiveness	No

Owners

Brexit drinks Ltd

Brexit en IE

Tijdslijn en Context

Deal – withdrawal agreement

No Deal

Praktische implicaties

Tijdslijn (2016-2018)

- 23 June 2016 – Brexit referendum
- 29 March 2017 – Article 50 triggered
- 13 July 2017 – European Withdrawal Bill published
- 30 January 2018 – EUIPO Issue Q&A on ‘no deal’ Brexit
- 26 June 2018 – European Union (Withdrawal) Act 2018
- 12 July 2018 – White Paper on the Future Relationship Between the United Kingdom and the European Union
- 14 November 2018 – EU Draft Withdrawal Agreement finalised, as agreed by UK/EU negotiators

Tijdslijn (2019-?)

- 15 January 2019 – House of Commons rejects Withdrawal Agreement
- 17 January 2019 – UK IPO guidance on ‘no deal’ Brexit (update in March)
- 12 March 2019 – House of Commons (again) rejects Withdrawal Agreement
- 13 March 2019 – Vote for Hard Brexit
- 14 March 2019 – (Potential) Vote for Extension of Article 50
- 29 March 2019 – UK due to leave the EU (if Article 50 is not extended or withdrawn)
- 31 December 2020 – Expiry of “transition period” under Draft Withdrawal Agreement

Some facts and figures

- Trade marks and Designs primarily affected by Brexit:
 - Copyrights: relevant EU legislation has been in the form of Directives already implemented into UK law
 - Patents: based on the EPC system
- 1,7 million EU trade marks and registered Community designs
- 200.000 international trade mark and design registrations covering the EU
- At a given time, approx. 85.000 pending EUTM applications in the EU system







Context

- Biggest European market Decorative Paints
- Key Marine, protective and Yachts market (hosting International Paints Ltd entity).
- Turnover: €950m (2017)
- 59 legal entities in UK, including x2 delisted PLC entities and 29 trading entities
- 43 overseas entities also supported from UK (UK entities are shareholders)
- 8 production sites (Ashington)
- 3,600 employees

Withdrawal agreement

Streking Withdrawal Agreement

- UK will continue to protect all existing registered European Union Trade Marks, Registered Community Designs, and Unregistered Community Designs when leaving the EU, maintaining priority and seniority.
- This will be creating over 1.7 million comparable UK rights, which will be granted **automatically** and **free-of-charge**.
- Transition period until **31 December 2020** during which EU law will continue to apply in the UK.

Highlights Withdrawal Agreement

- Cloned Trade mark and Design rights – no action and no cost
- Seniority and priority maintained
- Procedures: effects of procedure ongoing on the last day of transition period extend to corresponding right in UK, except if grounds for revocation or invalidity do not apply in UK
- Exhaustion remains as is until end of transition period
- Unregistered Design: UK legislation to follow

No deal

Framework of no deal documents

- **The European Union (Withdrawal) Act 2018**

- **Technical Notices – 24 September 2018**
 - Trade marks and designs
 - Patents
 - Copyrights
 - Exhaustion

- **Business Guidance – complement Technical Notices**
 - Copyrights – 26 October 2018
 - Trade marks – 1 March 2019
 - Patents – 8 March 2019

- **Statutory legislation (between 23 July 2018 and 31 January 2019)**
 - Six Statutory Instruments; (1) Design Right (Semiconductor Topographies); (2) Exhaustion, (3) Trade marks, (4) Patents, (5) Copyrights and Related Rights, (6) Designs and International Trade Marks

Merken & modellen – verleende rechten (i)

➤ Kloon van EU recht

- Zonder kosten, zonder actie
- Rechthebbenden krijgen (digitaal) bericht “*we will notify rights holders that a new UK right has been granted by publishing a notification and guidance on our website*”. NB: geen certificaat
- EUTM nummer met prefix UK009
- Aantekening van licenties en zekerheidsrechten vereist

➤ Opt out regeling

- Via special formulier – post Brexit
- Niet mogelijk als merk gebruikt na Brexit, onderwerp van overeenkomst of geschil
- Verplichting “interested parties” te informeren

Merken & modellen – verleende rechten (ii)

➤ Use and reputation

- Pre-Brexit use in EU (inside or outside UK) constitutes use in UK for Comparable trade mark (EU)
- Pre-Brexit use in UK constitutes use of EUTM
- Similar approach for reputation

➤ Prioriteit en senioriteit

- Priority automatically inherited
- Seniority claim based on earlier UK or International (UK) trade mark recorded against an EUTM will be automatically retained by the comparable UK trade mark

➤ Renewals, bijzondere regeling voor:

- EUTMs expired 6 months prior to exit date within late renewal date: late renewal will have effect on Comparable trade mark (EU), without having to pay renewal fees for Comparable trade mark (EU)
- Comparable trade mark (EU) to expire within 6 months post exit day: late renewal option at no cost

Merken en modellen – varia

- **Aanvragen:** binnen 9 maanden na exit actie vereist, reguliere procedure tegen betaling. Wel prioriteit en senioriteit.

- **Geschillen :**
 - No pan-EU injunctions possible post Brexit before UK Courts (acting as EU Courts).
 - Pending cases will continue to be heard under the EU TM Regulation, yet applicable to Comparable Trade Mark (EU) only (idem for counterclaims)
 - Pending oppositions and invalidity requests before EUIPO based upon earlier UK right which do not reach decision stage before withdrawal day will be suspended (and post Brexit cases based on UK rights will be dismissed).

- **Onregistreerde modellen** blijven beschermd. UK gaat regelgeving invoeren.

- Zelfde regels gelden voor **EUTM designations under the Madrid system** (designation wordt registration).

Andere IE rechten

Octrooien

- UK national patents and European patents - via the European Patent Office (EPO) - are unaffected by Brexit; independent from EU membership.
- UK will explore whether it would be possible to remain within the UPC and UP system. If the UK needs to withdraw from the system it will ensure that UP protection in the UK is replaced by “continued protection in the UK”.
- No changes to SPCs: part of UK law

Copyrights

- Changes, i.a. in relation to Portability of online content services, Collective Rights management, Mutual recognition of orphan works

Uitzendrechten: <https://www.gov.uk/government/publications/broadcasting-and-video-on-demand-if-theres-no-brexit-deal/broadcasting-and-video-on-demand-if-theres-no-brexit-deal>

Andere IE rechten (ii)

Domein namen

- .eu domain names require EU based owner

Database rights

- Sui generis database rights are a EU law creation, and post-Brexit a database created in the UK would no longer be protected in the EEA.
- UK originating sui generis database rights will no longer be enforceable in the EEA.

Geografische aanduidingen

- A new UK GI scheme which will be established "broadly mirror the EU regime and be no more burdensome to producers".
- UK will no longer be required to recognise EU GI status and EU producers would be able to apply for UK GI status. To protect UK GIs in the EU, it would be necessary to file an applications on a third country basis.

Licenties, zekerheden, overdrachten

Licenses, security interest

- Any licence or security interest that refers to an EUTM and authorises acts in the UK will be treated as if it applies to the comparable UK trade mark.
- Where a license or security interest is already registered in the EUTM register before exit day, the period within which such transactions must be recorded on the UK register in respect of the UK comparable trade mark will be extended to 12 months from exit day.
- Also Consents remain applicable to comparable UK trade mark

Assignments in progress

- Where an EUTM has been the subject of an assignment prior to exit day which has not been recorded in the EUTM register the comparable trade mark will be granted to the assignor
- The assignor or the assignee will have the right after exit day to apply for the registration of the comparable trade mark in the name of the assignee

Praktische implicaties

Exercities

- Verwerken extra rechten in systemen
- Opt out
 - Screening portfolio
 - Actual use in UK?
 - Check third party interests
- Review (key) Letters of Consent / Prior Rights Agreements etc.

En...

- EUTM aanvragen
- Lopende assignments van EUTMs
- Lopende procedures voor EUIPO en UK courts
- Licenties en zekerheidsrechten
- .eu domeinnamen in naam van UK entiteiten
- Overeenkomsten met EU definitie



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Thank you