

Brexit Agreement: Implications of the End of the Transition Period for Madrid System Users

July 23, 2020

The Agreement on the Withdrawal of the United Kingdom (UK) from the European Union (EU) provides for a transition period ending on December 31, 2020. The Government of the UK has indicated the steps that it will take to deliver continued protection in the UK to marks in international registrations with effect in the EU before the end of the transition period.

International registrations under the Madrid System that the European Union Intellectual Property Office (EUIPO) has neither refused nor protected on January 1, 2021

Holders of an international registration designating the EU that the EUIPO has neither refused nor protected on January 1, 2021, will be able to apply for a national trademark registration with the Office of the United Kingdom (UKIPO) in the nine months after January 1, 2021. The initial date of the designation of the EU will be preserved.

The same applies for holders whose international registration or subsequent designation of the EU, 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 EU is inscribed in the International Register.

International registrations under the Madrid System protected in the EU before January 1, 2021

Following the end of the transition period, a comparable national trademark, recorded on the Register of the United Kingdom, will be created for every international registration protected in the EU before the end of the said period.

Where protection results from multiple designations of the EU in one international registration (e.g. a designation made in the international application and a subsequent designation) one comparable national trademark will be created for each designation.

These newly created comparable UK trademarks will be independent from the international registration and governed by UK law. Holders will have to manage them directly with the UKIPO.

Rights of holders of existing international registrations

The end of the transition period will not negatively affect the rights of holders of existing international registrations for which the EU is the Contracting Party of the holder and who are nationals of or domiciled in the UK or have a real and effective industrial or commercial establishment in this country. The same will apply to international applications filed with the EUIPO by UK nationals or entities before the end of the transition period.

Centralized management under the Madrid System for a comparable United Kingdom trademark

After the end of the transition period, the holder may subsequently designate the United Kingdom in the international registration that prompted the creation of a comparable United Kingdom trademark. Under Article 4*bis* of the Protocol, that International Registration would replace the comparable United Kingdom trademark, allowing the holder to regain the advantages of centralized management. The holder may request the UKIPO to take note of this replacement in the Register of the United Kingdom.

The same would apply to a United Kingdom registration for which the holder has claimed the earlier date of a designation of the European Union. The holder may subsequently designate the United Kingdom in the international registration concerned after the mark has been registered in the United Kingdom and Article 4*bis* of the Protocol would apply accordingly.

However, holders must be aware that, while a comparable United Kingdom right will be created automatically, a subsequent designation of the United Kingdom would be subject to examination by the UKIPO and be published for opposition.

For further information, please refer to UKIPO form TM28, Application to record a concurrent registration, to record that a protected International Trademark (UK) replaces a registered UK Trade Mark.

Continuing to use the Madrid System as a UK national or legal entity after the transition period

The UK is a Contracting Party to the Madrid Protocol, therefore you are and will continue to be entitled to file through the UKIPO as the Office of origin and, as the new holder, claim entitlement through the United Kingdom in a request for the recording of a change in ownership.

However, take note that you will no longer be entitled to file through the EUIPO as Office of origin or claim entitlement through the European Union as the new holder in a request for the recording of a change in ownership after the end of the transition period.

- Find out more about [basic requirements for filing an international application](#).
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Find out more

- Information Notice No.54/2020 [PDF](#)
- [Guidance issued by the Government of the United Kingdom](#)