

EUIPO General Additional Guidance for Right Holders and Representatives

This General Additional Guidance highlights the most important practical consequences set out in [Communication No 2/2019](#) of the Executive Director of the Office of 22 February 2019 on certain aspects of the Office practice with respect to United Kingdom's withdrawal from the European Union which has, in turn, to be read in conjunction with the [Notice to stakeholders of EU trade marks and registered Community Designs of 5 December 2017](#) and with the [EUIPO's Q&A document on the Impact of the United Kingdom's withdrawal from the European Union](#) .

I. GENERAL IMPACT on EUTMRs and RCDs

Scope of protection

Is the scope of protection of my EU trade mark affected?

As from withdrawal day, EU trade marks will, in principle(*), no longer be protected in the UK as a matter of EU law (Art. 1(2) EU Trade Mark Regulation). The UK's withdrawal from the EU will thus limit the EU trade marks' territorial scope of protection to the territory of the remaining 27 EU Member States.

(*) Continuity of protection in the UK of EU trade marks registered (or applied for) before the withdrawal day depends therefore exclusively upon the conditions established by the law of the UK.

Proceedings (ex parte / inter partes)

What happens with pending oppositions and invalidity requests based upon an earlier UK right? (NEW)

Before the withdrawal day, opposition, EUTM invalidity, and RCD invalidity proceedings which are still in an early procedural stage, which are based solely on UK rights, and which, due to time constraints, would not reach the decision stage before withdrawal day, will be suspended. As from the withdrawal day, any opposition or invalidity request based solely on a UK right will be dismissed.

International Registrations (new section)

Can an UK national with no domicile in an EU Member State file an international application through the EUIPO as office of origin?

No. To be entitled to file an international application based on an EUTM through the EUIPO, an applicant has to either be a national of an EU Member State, or have a domicile or a real and effective industrial or commercial establishment in an EU Member State. Therefore, a UK national who is

domiciled in the UK will not be entitled to file an international application through EUIPO as office of origin.

However, an UK national domiciled in an EU Member State, or an EU national domiciled in the UK, will be entitled to file an international application with the EUIPO as office of origin.

What will happen with an international registration of a trade mark designating the EU after the withdrawal day?

After the withdrawal day, any international registration designating the EU (as designated country) will only be valid in the EU27 Member States and will no longer have effect in the UK as a matter of EU law. Continuity of protection in the UK of international registration designating the EU depends therefore exclusively on the conditions established by the law of the UK.

II. APPLICANT & OWNER

Ownership & capacity to act

Can persons established in the UK be represented by an employee?

Except for the act of filing an application for registration of a EU Trade Mark, and without prejudice to the specific case mentioned in the second sentence of Art. 119(3) EU Trade Mark Regulation, persons without a domicile, a principal place of business, or an effective establishment in the EU cannot be represented by an employee (Art. 119(3), (2) EU Trade Mark Regulation).

I am an owner of an EUTM or a RCD and my representative is no longer entitled to act before the Office. Do I need to designate a new valid representative?

No. As a matter of principle, and in order to maintain your IP rights in the EUIPO's register, you do not need to designate any representative. The same applies when requesting the renewal of an EUTM or an RCD.

However, you must appoint a representative for all proceedings before the Office except for the filing of the application if you do not have your place of business, real and effective establishment or domicile in the European Economic Area (that is the 27 Member States of the EU, Norway, Iceland, and Liechtenstein). For these proceedings, the Office will invite you to appoint a representative where needed.

How do I have to manage the payment of fees with the EUIPO, if my UK representative can no longer act before the Office?

In case certain fees need to be paid, and your new representative has not been yet appointed, you can directly pay these according to the methods of payment published on EUIPO's website:

- EUTM Fees & payments: <https://euipo.europa.eu/ohimportal/en/fees-and-payments>
- RCD Fees & payments: <https://euipo.europa.eu/ohimportal/en/rcd-fees-and-payments>

Can I renew my EUTM or RCD without a representative?

Yes, any natural or legal person – including those having their domicile or principal place of business outside the EEA – can request the renewal of an EUTM or a RCD itself without a need to be duly represented.

However, as from the withdrawal day, any national or legal person having their domicile or principal place of business in the UK will need to be duly represented by an EEA representative for any other request or procedure before the EUIPO related to its EUTM or RCD IP right concerned.

Impact on User Area & EUTM/RCD files

I am a UK national or a UK-based company. What will change for me in the EUIPO's online tools?

In eSearch plus, UK representatives designated in your EUTM/RCD files will appear as “not valid”. In other tools no change will occur, with the limitation following from Art. 119(2) EU Trade Mark Regulation (that is mandatory representation except for the act of filing an application for registration of a EU trade mark).

I am a UK national or a UK-based company. Will my User Area be affected?

If you already have an owner ID number created before the Office, you do not need to modify your account in the User Area – but you will be considered as a third country user, with the limitation following from Art. 119(2) EU Trade Mark Regulation (that is mandatory representation except for the act of filing an application for registration of a EU trade mark).

I am a UK national or a UK-based company. How will my current account opened before the Office be affected?

The current account will, in principle, not be affected.

However, if the holder of the current account is a UK representative, the current account will be closed as this representative will no longer be entitled to act before the EUIPO. In such case, the representative concerned will be informed of the closure of the current account and will be contacted by the Office in order to process the refund of any outstanding account balance.

For further details on Fees & payments please consult: [Fees & payments](#).

I am a UK national or a UK-based company. How can I communicate with the Office?

As from the withdrawal day, applicants or owners based in the UK will be considered as third country users.

Where the UK-based applicant or owner has appointed a valid professional representative, the Office will send notifications solely to the representative according to the means of communication selected by this representative.

Where the UK-based applicant or owner has not appointed a valid representative, the Office will send to that UK-based applicant or owner notifications by electronic means, fax or post (depending on the contact information available).

If you are currently an eComm user, you will continue to be able to use this functionality of the User Area, with the limitation following from Art. 119(2) EU Trade Mark Regulation (that is mandatory representation except for the act of filing an application for registration of a EU trade mark).

We strongly recommend that you consult the Guidelines Part A – General rules – Section 1 - [Means of Communication, Time Limits](#).

III. REPRESENTATIVES

Representation & capacity to act

I am a UK representative. How will my current account be affected?

A current account linked to a representative who is no longer entitled to act before the Office will be closed. Closure shall not take place until at least 30 days after the withdrawal day in order to cater for deferred payments of application fees (if any are pending). The representative concerned will be informed of the closure of the current account and will be contacted by the Office to process the refund of any outstanding account balance.

Consequently, the payments of all debits due after the closure of the account will not be paid through the current account, but by bank transfer or through a new authorised current account. The account holder must ensure the timely payment of any outstanding debits following the closure of the current account. The lack of said payment may lead to a loss of rights.

For further details on Fees & payments, consult: [Fees & payments](#).

Impact on User Area & EUTM/RCD files

I am a UK representative. What will be the changes in the EUIPO's online tools?

In eSearch plus, you will no longer be able to manage the EUTMs/RCDs files of your portfolio and the representative will appear as "not valid". In the EWS portal, you will not be able to create yourself as UK representative of any type. In other tools, no change will occur except for the limitation following from Art. 119(2) EU Trade Mark Regulation (that is mandatory representation except for the act of filing an application for registration of a EU trade mark).

I am a UK representative. Will my User Area be affected?

Yes. As from the withdrawal day, your User Area will no longer be operational.

We recommend that you make a local copy of your communications and any other data you find relevant. The data on published EUTMs and RCDs will continue to be available in eSearch plus and can also be downloaded using “EUIPO download”, which is accessible to all users.

If you wish to communicate with the Office through the User Area as from the withdrawal date, we recommend that you create a new valid user account.

I am a UK representative. How will the Office communicate with my clients?

As from the withdrawal date, applicants or owners based in the UK will be considered as third country users.

Where the UK-based applicant or owner has appointed a valid professional representative, the Office will send notifications solely to the representative according to the means of communication selected by this representative.

Where the UK-based applicant or owner has not appointed a valid representative, the Office will send them notification by electronic means, fax or post (depending on the contact information available). If the UK-based applicant or owner is currently an eComm user, they will continue to be able to use this functionality of the User Area, subject to the limitation following from Art. 119(2) EU Trade Mark Regulation (that is mandatory representation except for the act of filing an application for registration of a EU trade mark).

We strongly recommend that you consult the Guidelines Part A – General rules – Section 1 - [Means of Communication, Time Limits](#).

I am a UK professional representative. Where can I find more info?

See Section VII of the [Communication N° 2/2019 of the Executive Director of the Office](#)

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