

The Executive Director

**Communication No 2/20 of the Executive Director of the Office
of 10 September 2020**

**on the impact of the United Kingdom's withdrawal from the European Union
on certain aspects of the practice of the Office**

THE EXECUTIVE DIRECTOR OF THE EUROPEAN UNION INTELLECTUAL
PROPERTY OFFICE,

Having regard to the Treaty on the European Union (TEU), and in particular Article
50(3) thereof,

Having regard to 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⁽¹⁾ (WA), and in particular Recital 4, Article 126 and Article 127, and
Article 97 thereof,

Having regard to Regulation (EU) 2017/1001 of the European Parliament and of the
Council of 14 June 2017 on the European Union trade mark⁽²⁾ (EUTMR), to
Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing
Regulation (EU) 2017/1001⁽³⁾ (EUTMDR) and to Commission Implementing
Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing
certain provisions of Regulation (EU) 2017/1001⁽⁴⁾ (EUTMIR),

Having regard to Council Regulation (EC) 6/2002 of 12 December 2001 on Community
designs, as amended⁽⁵⁾ (CDR) and to Commission Regulation (EC) 2245/2002 of 21
October 2002 implementing the Council Regulation as amended⁽⁶⁾ (CDIR),

Having regard to Article 157(4)(a) EUTMR and to Article 97 CDR;

Whereas:

(1) The United Kingdom (UK) has withdrawn on 1 February 2020 from the European
Union (EU) pursuant to Article 50 TEU, and has become a third country. While
Union law continues to apply to and in the UK during a transition period, that

¹ OJ L 29, 31.1.2020, p. 7

⁽²⁾ OJ L 154, 16.6.2017, p. 1.

⁽³⁾ OJ L 104, 24.4.2018, p. 1.

⁽⁴⁾ OJ L 104, 24.4.2018, p. 37.

⁽⁵⁾ OJ L 386, 29.12.2006, p. 14.

⁽⁶⁾ OJ L 193, 25.7.2007, p. 13.

transition period ends on 31 December 2020 pursuant to Articles 126 and 127 WA. As from the day following the end of the transition period, that is 1 January 2021, EU law will cease to apply to and in the UK, unless and to the extent that such continued application is explicitly provided for by the WA.

- (2) As from 1 January 2021, the EU legislation in the field of trade marks and designs will no longer apply to the UK and in the UK, unless and to the extent that such continued application is explicitly provided for by the WA.
- (3) Pursuant to Article 157(4)(a) EUTMR, the Executive Director shall take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the Office.
- (4) This Communication, which complements the information already provided to users, rights holders and stakeholders on 18 June 2020,⁷ intends to give further guidance on the way in which the Office will apply, in its practice, the relevant provisions of EU legislation in the field of EU trade marks (EUTMs) and registered Community designs (RCDs) as from 1 January 2021.
- (5) This Communication is adopted with a view to dealing with the specific circumstance of the end of the transition period, that is on the terms and conditions laid down in the WA.
- (6) Communication 2/19 of 22 February 2019, as amended on 12 April 2019, which was adopted in view of the UK's possible 'withdrawal without agreement' became devoid of purpose with the entry into force of the WA on 1 February 2020.

HAS ADOPTED THE FOLLOWING COMMUNICATION:

I. Scope and Purpose

1. This Communication sets out the most important consequences caused by the end of the transition period, on the terms and conditions laid down in the WA, upon the current practice of the Office as regards proceedings relating to EUTMs and RCDs.
2. This Communication reflects general instructions and will need to be adapted to the particularities of specific cases. It is not a legislative text and therefore does not have the same binding effect. It rather informs users and stakeholders about the way in which the Office intends, without prejudice to Article 166(7) EUTMR, to handle the specific circumstance that the EUTM and RCD Regulations will,

⁷ Notice to Stakeholders of the European Commission and the EUIPO of 18 June 2020 (https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/Brexit/EC_EUIPO_Notice_trademarks_and_designs_18_June_2020_en.pdf).

save explicit exceptions provided for in the WA, cease to apply to the UK as from the end of the transition period.

3. This Communication informs rights holders and professional representatives, in particular, about the way in which the Office will deal with the fact that the end of the transition period on the terms of the WA will *ex lege* (Article 50(3) TEU, Recital 4 WA, Articles 126 and 127 WA) result, as from 1 January 2021, in a loss of rights as regards the protection of rights and the capacity to act in proceedings before the Office.
4. Within its specific scope of application, that is, the consequences of the end of the transition period on the terms of the WA, this Communication supersedes the general practice of the Office as regards proceedings relating to EUTM and RCDs laid down in the Guidelines for Examination before the Office or in other previous Decisions and Communications of the Executive Director.

II. Notifications to rights holders and professional representatives

5. Except in the cases specifically mentioned in this Communication, the Office will not issue any (prior or subsequent) individual notification to EUTM and RCD applicants, rights holders and professional representatives whose rights might be *ex lege* affected by the end of the transition period.

III. Seniorities (Articles 39 and 40 EUTMR)

6. Seniority claims based on UK trade marks filed until the end of the transition period will be processed and published. Seniority claims based on UK trade marks filed as from 1 January 2021 will be refused.
7. The Office will not process individual entries in the EUTM register cancelling any UK seniority claims in any EUTMs under Article 111(3)(r) EUTMR given that UK seniority claims will *ex lege* cease to have effect in the EU once the transition period has ended.

IV. Conversions (Article 139 EUTMR)

Pending requests for conversion to the UK

8. Requests for conversion to the UK received by the Office until the end of the transition period will be accepted as admissible and will be transmitted to the UK's Intellectual Property Office (UKIPO), provided that the conversion request fulfils all the conditions set out in the EUTM Regulations, including the payment of the conversion fee.

9. If the conditions governing the request received by the Office until the end of the transition period are not fulfilled, the Office will notify the applicant of any deficiencies in the formal requirements. If the deficiencies are remedied within the period specified by the Office, the conversion request shall be accepted as admissible, even if the deficiencies are remedied after the end of the transition period.

Requests for conversion to the UK received as from 1 January 2021

10. A request for conversion to the UK received by the Office as from 1 January 2021 will be refused as inadmissible, even when the request is received within the three month period set out in Article 139(4), (5) and (6) EUTMR.

V. Earlier rights in *inter partes* proceedings

11. As from 1 January 2021, UK rights cease *ex lege* to be 'earlier rights' for the purposes of inter partes proceedings (opposition, EUTM invalidity, RCD invalidity)⁸. Further, the territory and public of the UK will no longer be relevant for the purposes of assessing a conflict between an earlier EU right and a later EUTM, EUTM application or RCD.
12. Regardless of their procedural status at first instance, actions in inter partes proceedings based solely on UK rights that are still pending on 1 January 2021 will be dismissed for lack of valid basis. Each party will be ordered to pay their own costs.
13. If either party is domiciled (natural persons) or has its seat or establishment (legal persons) in the UK and is without a professional representative as from 1 January 2021, the decision dismissing the action will be notified directly to the party, without raising any admissibility or formality deficiency to remedy the lack of representation (as an exception to Section VI below).
14. As regards the proof of use of earlier EUTMs, evidence relating to the UK and to a period of time prior to 1 January 2021 will be relevant to maintain the rights in the EUTM and will be taken into account. The significance of that use for the overall assessment of genuine use in the EU will progressively decrease – from potentially sufficient to entirely irrelevant – depending upon the extent to which it covers the period for which use has to be established in the case at hand. The same applies to actions for the revocation of an EUTM for non-use.

⁸ Except if invoked under the opposition ground Article 8(3) EUTMR, the EUTM invalidity ground Article 60(1)(b) EUTMR or the RCD invalidity ground Article 25(1)(b) CDR, where rights protected outside the European Union may also be eligible basis for action.

15. Conversely, evidence relating to the UK can no longer sustain, or contribute to, the protection of an EUTM (*for example*, in the context of proving reputation of an EUTM under Article 8(5) EUTMR) as from 1 January 2021, even if that evidence predates 1 January 2021. The EUTM must be reputed 'in the EU' at the moment of decision taking. Where the fulfilment of a condition for a ground of action (*for example*, proof of a link between the marks at issue and any of the risks of injury under Article 8(5) EUTMR) has only been established in the UK, this will not warrant upholding the opposition or the invalidity request.

VI. Representation (Article 119 EUTMR and Article 77 CDR, Article 97 WA)

16. Natural or legal persons that have their domicile or principal place of business or a real and effective industrial or commercial establishment in the European Economic Area (EEA) do not have to be represented, regardless of their nationality.
17. Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the UK or in another country outside the EEA will have to be represented in all proceedings before the Office, other than the filing of an application for an EUTM or an RCD.
18. As representation is not mandatory for the act of filing of an application of EUTMs and RCDs, applicants based in the UK or another country outside the EEA do not need to appoint a representative for that purpose.

Registered rights as from 1 January 2021

19. Owners of registered EUTMs and RCDs based in the UK or another country outside the EEA do not need to be represented before the Office for the filing of a request to renew these rights.
20. Owners of registered EUTMs and RCDs based in the UK or another country outside the EEA are not required to appoint a representative, unless their right is, or becomes, subject of proceedings (such as a revocation, an invalidity or a register procedure) before the Office.

Proceedings as from 1 January 2021 where a representative has to be appointed

21. In all stages of the registration procedure relating to EUTM and RCD applications, including oppositions against EUTM applications, where representation is mandatory and the EUTM or RCD applicant based in the UK or another country outside the EEA has not appointed a professional representative, the Office will invite that applicant to appoint a representative as part of the formality examination. Where that applicant fails to remedy this deficiency, the EUTM or RCD application will be refused.
22. The same applies to all applications for the registration of transfers, licences, rights in rem, levies of execution, insolvency proceedings or similar proceedings,

where representation is mandatory. Where the applicant for these requests based in the UK or another country outside the EEA has not appointed a professional representative the Office will invite that applicant to appoint a representative. Where that applicant fails to remedy this deficiency, the application will be refused.

23. In opposition or cancellation proceedings, where representation is mandatory and the opponent or cancellation applicant based in the UK or another country outside the EEA has not appointed a professional representative, the Office will invite it to appoint a representative. Where that opponent or cancellation applicant fails to remedy this deficiency, the opposition or cancellation request will be rejected as inadmissible.
24. In cancellation proceedings, where representation is mandatory and the owner of the challenged registered EUTM or RCD based in the UK or another country outside the EEA has not appointed a professional representative, the Office will invite that owner to appoint a representative. Where that owner fails to remedy this deficiency, its procedural statements made as from 1 January 2021 will not be taken into account, and the Office will decide on the basis of the submissions which have been validly made before 1 January 2021. However, the registered EUTM or RCD will not be cancelled on account of the mere fact that its UK based owner is not represented.

Ongoing proceedings in which a UK representative was already representing a party at the end of the transition period (see also the explanatory note in annex)

25. Pursuant to Article 97 WA, where, in a procedure that has been initiated before the end of the transition period and is still pending before the Office at the end of the transition period ('ongoing procedure'), a representative was, at the end of the transition period, duly representing a party in that ongoing procedure ('representative on file'), the Office will not invite that party to appoint a new representative on account of the circumstance that its representative on file for that ongoing procedure does, as from 1 January 2021, *ex lege* no longer fulfil the legal requirements laid down in Article 120 EUTMR and Article 78 CDR ('UK representative'). This only applies to professional representatives (Article 97(2) WA, Article 120 EUTMR and Article 78 CDR), not to an employee of the represented party (Article 119(3) EUTMR and Article 77(3) CDR).
26. In an ongoing registration procedure, that is where an application for the registration of a EUTM or RCD has been filed at the Office and that EUTM or RCD applied for has not been registered, or rejected by a final decision of the Office, or withdrawn by the EUTM and RCD applicant, at the end of the transition period, the Office will not invite the EUTM and RCD applicant to replace his UK representative on file at the end of the transition period, provided that the representative was duly appointed to represent the applicant in that ongoing registration procedure. In this regard, it is immaterial whether the ongoing registration procedure is, at the end of the transition period, at the stages of examination, re-examination, opposition, or appeal. The continuity of representation in ongoing registration proceedings includes all operations concerning the EUTM and RCD application which are requested *before* its

registration such as formalities, classification, priority issues, restrictions, amendments, divisions, and requests for conversion of the EUTM application.

27. In an ongoing opposition procedure, that is where the notice of opposition has been filed at the Office and the opposition has not been allowed or rejected by a final decision of the Office, withdrawn or become devoid of purpose, at the end of the transition period, the Office will not invite the opponent to replace his UK representative on file, provided that the representative was duly appointed to represent the opponent in that ongoing opposition procedure.
28. In an ongoing revocation, invalidity or register procedure (such as requests for transfer, rights in rem, license, renewal, change of name, division, surrender, request for conversion), that is where the corresponding request has been filed at the Office and that request has not been accepted or rejected by a final decision of the Office, withdrawn or become devoid of purpose, at the end of the transition period, the Office will not invite a party to that ongoing procedure to replace his UK representative on file, provided that that representative was duly appointed to represent that party in that ongoing revocation, invalidity or register procedure concerned.
29. A registration, revocation, invalidity, register, or – as regards the opponent – an opposition procedure is considered to have been brought before the Office at the point in time on which the Office has received the formal application or formal request starting that procedure. This applies irrespective of the question whether or not the application or request is subsequently found to be deemed not filed, e.g. for lack of payment in time, or to be inadmissible.
30. Where the UK representative on file at the end of the transition period had been duly appointed for an ongoing procedure, the Office will proceed according to points 26 to 28 above irrespective of whether or not that UK representative has already performed concrete procedural acts in that ongoing procedure prior to the end of the transition period.
31. The Office will proceed according to points 26 to 28 above, independently of the concrete stage of the ongoing procedure at the end of the transition period. Provided that the UK representative on file at the end of the transition period was duly appointed for the ongoing procedure concerned, it is immaterial whether that UK representative had been appointed when the ongoing procedure concerned was initiated or at one of the subsequent stages, including the appeal stage before the Boards of Appeal, of that ongoing procedure.
32. Where the UK representative on file at the end of the transition period had been duly appointed for an ongoing procedure, the Office will proceed according to points 26 to 28 above irrespective of a change of name or change of address of the represented party in the subsequent course of the ongoing procedure concerned. The same applies where that party's legal form is changed in the course of the ongoing procedure concerned, provided that this change does not modify that party's legal identity. Where that party to the ongoing procedure is replaced in the course of that ongoing procedure the UK representative may not become a representative of the successor in right. The Office will invite the

successor in right to appoint a representative, where representation is mandatory.

33. Where the UK representative on file at the end of the transition period had been duly appointed for an ongoing procedure, the Office will proceed according to points 26 to 28 above irrespective of the circumstance that that UK representative changes his address, affiliation to a particular law firm, or association of representatives in the course of that ongoing procedure.

VII. Representatives (Article 120 EUTMR and Article 78 CDR, Article 97 WA)

Legal requirements

34. In order to represent parties before the Office, legal practitioners pursuant to Article 120(1)(a) EUTMR need to (i) be qualified in one of the EEA Member States, and, (ii) be established or have a place of business within the EEA, and (iii) be entitled to act as a representative in trade mark or design matters in the Member State of the EEA in which they are qualified. Legal practitioners do not have to be nationals of an EEA Member State. Consequently, legal practitioners that have their place of business in the UK and/or are qualified and entitled to act as a representative in trade mark or design matters before the UK Intellectual Property Office (UKIPO), will no longer be able to represent parties as legal practitioners before the Office as from 1 January 2021.
35. In order to represent parties before the Office, professional representatives pursuant to Article 120(2) EUTMR need to (i) be nationals of an EEA Member State, (ii) have a place of business or employment in the EEA, and (iii) be entitled to act as representative in trade mark and design matters in one of the EEA Member States. As in the case of legal practitioners, professional representatives need to have a place of business or employment in any EEA Member State, as long as their qualification and entitlement to act are in the same EEA Member State. Consequently, professional representatives that (i) are UK nationals, and/or (ii) have a place of business or employment in the UK, and/or (iii) are entitled to act as a representative in trade mark and design matters before the UKIPO will no longer be able to represent parties as professional representatives before the Office as from 1 January 2021.
36. An exception in that regard applies to ongoing procedures (Article 97 WA and points 25 to 33 above).
37. An employee of a natural or legal person is only entitled to represent parties before the Office where the employee has its place of business or employment in the EEA (Article 119(3) EUTMR and Article 77(3) CDR).
38. Associations of representatives (Article 74(8) EUTMDR) exist by definition only to the extent that the associates (minimum two) are valid representatives.

Consequence as from 1 January 2021

39. Except where the conditions for continued representation in one or several ongoing procedures are met (on this see point 45 below), the consequences, as from 1 January 2021 for any UK representative are the following:
40. The Office will invalidate the ID number assigned to the UK representative, preventing any further actions to be carried out by the holder of the ID number.
41. The UK representative will be automatically removed from all EUTM and RCD related files. Where the removal concerns more than one file, no separate notifications will be issued for each individual IP right, instead a notification will be issued identifying a list of all the affected IP rights.
42. Subsequently, the UK representative will be deleted from the Office's database of representatives. Where applicable, the UK representative will also be removed from the Office's list of professional representatives, and the corresponding amendment of the list of representatives will be published in the Official Journal of the Office (Article 120(5) EUTMR and Article 64(6) CDIR).
43. Where a current account is linked to the UK representative, that current account will be closed. Closure shall not take place until at least 30 days after the end of the transition period to cater for deferred payments of application fees (if any are pending). The UK representative 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.
44. Associations of representatives with an address in the UK, that do not have the minimum requirement of two linked registered valid association members, and these members have each already obtained individual ID numbers from the Office assigned to the address of the association⁹, will be automatically deleted from the Office's database of representatives.
45. Where, and to the extent that, the UK representative conserves his capacity to act in ongoing proceedings (see points 25 to 33 above), the Office will not take the measures referred to in points 26 to 28 above with regard to the ongoing procedure concerned. The UK representative will only be automatically removed from the ongoing procedure's file upon closure of that procedure. The ID number assigned to the UK representative will remain valid for the ongoing procedure concerned, as to enable that UK representative to carry out the actions required for the representation in that procedure, and only be fully invalidated when the UK representative is no longer acting as representative in any ongoing procedure. That UK representative's current account will, where applicable, not

⁹ Guidelines, Part A, Section 5, Paragraph 3.4.3 -Associations of Representatives-
<https://guidelines.euipo.europa.eu/1803468/1787894/trade-mark-guidelines/3-4-3-associations-of-representatives>

be closed until at least 30 days after the closure of the last ongoing procedure in which he is acting as representative. That UK representative's name will remain on the Office's database of representatives and, where applicable, from the Office's list of professional representatives for the purpose of the ongoing procedure and only be deleted when that UK representative is no longer acting as representative in any ongoing procedure.

Updating of existing files and requests for exemptions received before the end of the transitional period

46. Where legal practitioners or professional representatives within the meaning of Article 120(1)(b) EUTMR request a change of establishment from the UK to another EEA Member State, the Office may require the submission of evidence that real and effective business is being carried out from the new place of establishment.
47. Legal practitioners must, where the original qualification and entitlement to act were based on their qualifications as a Solicitor or Barrister in the UK, submit evidence of qualification in an EEA Member State other than the UK that entitles them to act as a representative in trade mark or design matters. Professional representatives must, where the original entitlement to act as a representative in trade mark and design matters was evidenced by a certificate issued by the UK Intellectual Property Office (UKIPO), submit a new certificate issued by the central industrial property office of an EEA Member State other than the UKIPO.
48. Any request for exemption¹⁰ pursuant to Article 120(4) EUTMR and Article 78(4) CDR received before the end of the transition period will be refused by the Office as inadmissible where the requestor currently complies with the UK nationality requirement or currently possesses the entitlement to act before the UKIPO.

VIII. Entitlement to file an International Application based on an EUTM (Article 184(5)(f) EUTMR and Article 2(1)(ii) Madrid Protocol)

49. An applicant is entitled to file an international application with the EUIPO as office of origin if it is a national of, or has a domicile or a real and effective industrial or commercial establishment in, an EU Member State.

¹⁰ For more information on exemptions see Guidelines, Part A, Section 5, Paragraph 2.3.4 <https://guidelines.euipo.europa.eu/1803468/1789816/trade-mark-guidelines/2-3-4-exemptions>

As from 1 January 2021

50. EU nationals domiciled, or with or a real and effective industrial or commercial establishment, in the UK will be entitled to file an international application with EUIPO as office of origin.
51. UK nationals domiciled, or with or a real and effective industrial or commercial establishment, in an EU Member State will be entitled to file an international application with EUIPO as office of origin.
52. However, a UK national with no domicile or no real and effective industrial or commercial establishment in an EU Member State will no longer be entitled to file an international application through the EUIPO as office of origin.

IX. Entry into force

53. This Communication enters into force on 10 September 2020.



Christian Archambeau

Executive Director

Annex: Explanatory Note on Article 97 WA

**Annex to Communication 2/20 of the Executive Director of the Office
of 10 September 2020 on the impact of the United Kingdom’s withdrawal from the
European Union on certain aspects of the practice of the Office**

Explanatory Note

Continued representation in ‘ongoing procedures’ before the EUIPO

(Article 97 WA)

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A. Basics of Article 97 WA and Main Consequences of its Application

1. Personal application: 'UK representatives' no longer fulfilling the requirements to act

Article 97 WA concerns natural⁽¹⁾ **persons** who – as a consequence of the UK's withdrawal from the EU and the following inapplicability of EU law, including the EUTMR and the CDR, to and in the UK – *ex lege* **no longer fulfil the requirements to act as representatives before the EUIPO** (EU/EEA establishment and/or EU/EEA nationality requirements laid down in Article 120 [EUTMR](#) and Article 78 [CDR](#)).

For ease of reference, these persons are referred to in the following as 'UK representatives'.

Article 97 WA applies to professional representatives within the meaning of Article 120 EUTMR and Article 78 CDR, not to an employee of a party in the proceedings before the EUIPO (Article 119(3) EUTMR and Article 77(3) CDR).

2. Temporal application: as from the end of the transition period

Article 97 WA applies as from the end of the transition period (which started on 1 February 2020 and will end on 31 December 2020). Therefore, Article 97 WA applies as from 1 January 2021⁽²⁾.

Until that point in time, the representation in procedures before the EUIPO is exclusively governed by the EUTM and CD Regulations, in particular Article 120 EUTMR and Article 78 CDR. UK representatives are treated as if the UK were still a Member State of the EU ('business as usual').

3. An exception to the general rule that UK representatives lose their capacity to act

The general rule is that as from the end of the transition period UK representatives are no longer entitled to represent parties in the proceedings before the EUIPO, as they no longer fulfil *ex lege* the establishment and/or nationality requirements laid down in Article 120 EUTMR and Article 78 CDR.

Article 97 WA provides for the (only⁽³⁾) **exception** to that rule. UK representatives no longer meeting the requirements of Article 120 EUTMR and Article 78 CDR as a

⁽¹⁾ 'A person who is authorised to represent a natural or legal person before EUIPO' mentioned in Article 97 WA necessarily refers to the natural persons authorised to represent before the EUIPO according to Articles 120(1) and (2) EUTMR and Articles 78(1) and (2) CDR, as confirms also a comparison with Article 91(1) WA.

⁽²⁾ Article 126 and Articles 127(1), (3) and 132(1) WA.

⁽³⁾ [Article 55\(2\) WA](#) provides no legal basis for a continued representation by UK representatives before the EUIPO, as it is clear from its wording (the provision concerns the requirement of a rights holder's correspondence address in the UK for a UK trade mark, not a representation requirement for proceedings before the EUIPO), its context (the provision concerns the automatic grant of a right in the UK 'comparable' to a registered EU IP right without any need for re-examination or introducing an application or for undertaking an administrative procedure), and its purpose (continuity of protection in the UK for EU-rights holders without any administrative burden). In addition, where the WA refers to a registration procedure

consequence of the end of the transition period may continue to represent parties (continued representation) in those procedures that had already been brought before the EUIPO before the end of the transition period (ongoing procedures)⁽⁴⁾.

The EUIPO has to apply that exception where the conditions laid down in Article 97 WA are met⁽⁵⁾. However, as an exception from the general rule, those conditions cannot be interpreted broadly.

4. Purpose: no obligation to appoint a new representative amid an ongoing procedure

The purpose of Article 97 WA is not to keep a UK representative 'in business' after the end of the transition period and the ensuing *ex lege* loss of capacity to represent parties before the EUIPO. Article 97 WA is rather one of several specific provisions in the WA on ongoing (judicial and administrative) proceedings, which are designed to ensure the UK's 'orderly withdrawal', to 'prevent disruption', and to 'provide legal certainty to citizens and economic operators as well as to judicial and administrative authorities'⁽⁶⁾.

Continued representation according to Article 97 WA is to **avoid that a party to an ongoing procedure**, already under way before an EUIPO decision-making instance at the end of the transition, **would be obliged to appoint a new representative for that procedure** for the sole reason that the representative already appointed no longer fulfils the conditions set out in Article 120 EUTMR or Article 78 CDR as the legal consequence of the end of the transition period.

This purpose is not only apparent from the specific legislative context of Article 97 WA but – above all – from its very wording. **Article 97 (1st subparagraph) WA** precisely refers to the situation that the person who was (i) 'authorised to represent', (ii) representing 'a party', (iii) in 'a procedure brought before EUIPO' before the end of the transition period may after the end of the transition period (iv) 'continue' to represent (v) 'that party' (vi) in 'that procedure'.

5. Consequences for UK representatives and the EUIPO

- (i) No capacity to act where Article 97 (1st subparagraph) WA does not apply

The UK representative **lacks capacity to act** (Article 120 EUTMR or Article 78 CDR) where the conditions of Article 97 (1st subparagraph) WA are not fulfilled.

before the UKIPO (that is only in respect of pending EUTM and RCD *applications*), it does not provide for any procedural or representation-related rules (see Article 59(1) WA). **Article 54(3) WA** for its part has an exclusively substantive scope of application (setting the principle that a revocation or invalidation of an EUTM and a RCD entails, in principle and *ex lege*, the same consequence for the corresponding 'comparable' UK) and does not contain any procedural or representation-related rule.

⁽⁴⁾ Article 97 WA uses 'proceedings' (heading and 2nd subparagraph) and 'procedure' (1st subparagraph) interchangeably as confirmed by a comparison with other language versions (e.g. the French, German, Spanish and Italian texts, which each use the same term – '*procédure*', '*Verfahren*', '*procedimiento*', '*procedimento*' – throughout that article).

⁽⁵⁾ UK representatives will also be able to directly rely upon that exception as the wording of Article 97 WA appears to meet the requirement of Article 4(1)(2nd sentence) WA.

⁽⁶⁾ Recital 5 WA.

Therefore, the EUIPO in such cases should **remove ex officio** the corresponding entry of that UK representative **from the register** and, where applicable, also from the **list of professional representatives** (Article 120(1)(b) EUTMR, Article 78(1)(b) and (c) CDR). In particular, Article 97 WA – according to its clear wording – does not offer a legal basis for keeping a UK representative as the rights holder’s representative on the register *in the absence of an ongoing procedure concerning that right* at the end of the transition period – and even less for a UK representative to represent or rights holder in a procedure initiated after the end of the transition period. An interpretation to the contrary would, in addition, make that provision devoid of purpose.

- (ii) Full capacity to act in an ongoing procedure where Article 97 (1st subparagraph) WA applies

Where the conditions of Article 97 (1st subparagraph) WA apply, its second subparagraph confers the UK representative concerned a **right to be treated as an ‘EU/EEA representative’** who complies with the establishment/nationality requirements of Article 120 EUTMR / Article 78 CDR, with the same rights and the same corresponding duties ⁽⁷⁾. Any restriction to the UK representative’s continued representation needs to equally weighted between ‘EU/EEA representatives’ in the same situation. The UK representative’s continued representation of a party in the ongoing procedure cannot be restricted on account of their UK place of establishment or UK nationality.

That right is, however, explicitly **limited to** the situation of **‘representing** a party before the EUIPO in the proceedings referred to in the first subparagraph [of Article 97 WA, that is: **in an ongoing procedure**’].

For the UK representative, this has three consequences:

- (i) a **full capacity to act within** the procedural frame of the **ongoing procedure** concerned in order to effectively represent the party that they had already been representing before the end of the transition period;
- (ii) **no representation-related right outside** – and beyond the purpose of – **the ongoing procedure**;
- (iii) **need to appoint a new (additional) representative** meeting the requirements of Article 120 EUTMR / Article 78 CDR for any **new procedure** brought before the EUIPO after the end of the transition period in which representation is mandatory (Article 119(2) EUTMR / Article 77(2) CDR).

For the EUIPO, this entails the following corresponding obligations:

- (i) **keep the UK representative on the case file** of the ongoing procedure, treat them **as the party’s duly appointed representative for the purpose of that ongoing procedure** – and throughout (‘all stages’) – until that procedure is brought to an end (unless the mandate is terminated earlier for reasons such as replacement or resignation);

(7) ‘shall in every respect be treated as a professional representative authorised to represent a natural or legal person before the EUIPO in accordance with Union law’.

This obligation applies *ex lege* and does not depend upon any confirmation to be made by the represented party or by the UK representative.

- (ii) Obligation to **amend** the entry of the UK representative in the **register** with regard to the 'affected rights' and, where applicable, the **list of representatives** (Article 120(1)(b) EUTMR, Article 78(1)(b) and (c) CDR) to the effect that their capacity to represent is limited to the continuation of ongoing procedures already brought before the EUIPO before the end of the transition period.
- (iii) Obligation to **communicate directly with the rights holder**, or to **issue a deficiency** where representation is mandatory (Article 119(2) EUTMR / Article 77(2) CDR), in any **new procedure** brought before the EUIPO after end of the transition period in which representation is mandatory (Article 119(2) EUTMR / Article 77(2) CDR).

B. Main Conditions for Applying Article 97 WA

1. Procedure before the EUIPO

As the procedure before the EUIPO is not defined in Article 97 WA⁽⁸⁾, it is to be determined by reference to the EUTMR and the CDR, which (i) establish the rules for representation with regard to ‘all proceedings provided for by [those] Regulation[s]’⁽⁹⁾ and (ii) define the decision-making instances competent for taking decisions in connection with ‘the procedures laid down in [those] Regulation[s]’⁽¹⁰⁾.

- (i) First instance procedures

The **following** (first instance) **procedures** are set out in the **EUTMR** and the **CDR**.

- The **registration procedure** covers the different ‘pre-registration’ stages in the procedure for registration of an EU trade mark (EUTM) application and a Community design application (Chapter IV EUTMR / Title V CDR⁽¹¹⁾).
 - The registration procedure starts with the filing of an application for registration (Article 30(1) EUTMR; Article 35(1) CDR).
 - The registration procedure ends with i) the registration and publication of the EUTM application (Article 51(1) EUTMR) or Community design applied for (Articles 48 and 49 CDR), the ii) refusal of the application for registration (Article 51(1) EUTMR, Articles 48 and 49 CDR) either by the examiner (Article 42(1) EUTMR; Article 47(1) CDR) or by the Opposition Division (Article 47(5) EUTMR), or iii) the withdrawal of the application for registration by the applicant (Article 49(1) EUTMR).
 - The registration procedure comprises in all cases (that is for both EUTM applications and Community designs applications) an examination stage (Article 41, 42, 76 and 85 EUTMR; Article 45 CDR) carried out by an examiner⁽¹²⁾. In the case of EUTM applications, that examination stage is provisionally closed with the publication of the EUTM application (Article 44(1) EUTMR) but can be reopened *ex officio* at any time before the registration of the EUTM applied for (Article 45(3) EUTMR), for example, following receipt of third party observations (Article 45(1) EUTMR) or observations received by a Board of Appeal (Article 30(1) EUTMDR).
 - For EUTM applications, the registration procedure can include (from the EUTM applicant’s perspective) an opposition stage. Where a notice of opposition is filed against that application (Article 46(1) EUTMR), the end of the registration procedure becomes conditional upon i) a decision of the

⁽⁸⁾ Article 54(3) WA indicates – in the different context of continued protection of an EUTM and RCD in the UK – that invalidity and revocation constitute such procedures.

⁽⁹⁾ Article 119(2) EUTMR / Article 77(2) CDR.

⁽¹⁰⁾ Article 159 EUTMR / Article 102 CDR.

⁽¹¹⁾ ‘Registration procedure’.

⁽¹²⁾ Article 159(a) and Article 160 EUTMR; Article 102(a) and Article 103 CDR.

Opposition Division⁽¹³⁾ allowing (Article 47(5) EUTMR) or rejecting the opposition (Article 51(1) EUTMR), ii) a withdrawal of opposition, iii) the loss of purpose of the opposition (e.g. withdrawal of application or disappearance of earlier right)⁽¹⁴⁾.

- The registration procedure includes all other 'register' operations concerning the EUTM and Community design application, which are requested before its registration, as these are intrinsically linked to the application for registration. This concerns operations such as formalities, classification, priority issues, restrictions, amendments, divisions, and requests for conversion of the EUTM application (Articles 49 and 50 and Article 139(1) EUTMR), transfers (Article 20(9) EUTMR) etc⁽¹⁵⁾.
- **Post-registration procedures**, namely:
 - **Opposition** with respect to the representation of the opponent (holder of an earlier right opposing the contested EUTM application): that procedure starts with the filing of a notice of opposition (Article 46(1) EUTMR) and ends i) with the decision of the Opposition Division⁽¹⁶⁾ allowing or rejecting the opposition, ii) with the withdrawal of opposition, or iii) its loss of purpose (e.g. withdrawal of application or disappearance of earlier right).
 - **Revocation** and **invalidity** procedures against registered EUTMs / Community designs, which start with filing of application for revocation or for invalidity (Article 63 EUTMR; Article 52 CDR) and end with i) the Cancellation/Invalidity Division's⁽¹⁷⁾ decision to allow or to reject the revocation/invalidity request (Article 64(5) EUTMR; Article 53(3) CDR)⁽¹⁸⁾, ii) the withdrawal of revocation / invalidity request, iii) the loss of purpose (e.g. surrender of contested EUTM or disappearance of earlier right).
 - **Register** procedures concerning registered EUTMs / Community designs (inscription of transfer, rights in rem, licence, etc; renewal; change of name; division; surrender; request for conversion). The respective procedures start with the filing of a corresponding request (Articles 20(5), 29(1), 53(1), 54(1), 55(1), 56(1) and 139(1) EUTMR; Article 28 et seq. CDR) or declaration (Article 57(2) EUTMR; Article 51 CDR) and end with i) the

⁽¹³⁾ Articles 159(b) and 161(1) EUTMR.

⁽¹⁴⁾ While it is true that the examination and opposition stages differ in several procedural respects (applicable rules: e.g. Article 95(1) EUTMR; partially different purpose: protection of public v private interests; competent decision-making instances of the EUIPO), these differences do not appear to be material for the EUTM applicant's representation. What matters in this perspective in view of applying Article 97 WA is not to disrupt the EUTM applicant's continued representation in the course of the registration procedure, which is composed of different – and sometimes even overlapping – stages. From that applicant's perspective, the opposition is not a separate procedure within the meaning of Article 97 WA but a stage within the same registration procedure. This is different for the opponent (see post-registration procedures below).

⁽¹⁵⁾ The consideration in the previous footnote also applies here.

⁽¹⁶⁾ Articles 159(b) and 161(1) EUTMR.

⁽¹⁷⁾ Articles 159(d) and 163(1) EUTMR; Article 105(1) CDR.

⁽¹⁸⁾ When final, in the case of EUTMs, the decision 'on the application' is entered in the Register (Article 64(6) EUTMR) – for RCDs this is only if they are declared invalid (Article 53(3) CDR).

registration/publication or the rejection of request by the Department in charge of the Register⁽¹⁹⁾ or with ii) the withdrawal of request.

(ii) The second instance appeal procedure

Although the **appeal** procedure – that is the review of decisions taken in the first instance procedures above⁽²⁰⁾ carried out by the Boards of Appeal⁽²¹⁾ – can be seen as a separate procedure⁽²²⁾, there is functional **continuity** between the EUIPO's first instance procedure (as set out in the previous subsection) and the related appeal procedure before the Boards of Appeal⁽²³⁾.

For representation purposes, the appeal procedure is thus to be considered to be an additional 'stage' of the procedure brought before the EUIPO, not as a separate procedure within the meaning of Article 97 WA.

A **procedure before the EUIPO**, within the meaning of Article 97 WA, would thus comprise **two stages**:

- the 'basic' (registration, opposition⁽²⁴⁾, revocation, invalidation, or register) procedure brought before the EUIPO's first instance decision-making body and
- the subsequent related appeal procedure brought before the Board of Appeal.

Therefore, there is continuation of the 'basic' (registration, opposition⁽²⁵⁾, revocation, invalidation, or register) procedure where that procedure becomes – after the completion of the appeal procedure before the Boards of Appeal – again pending before the competent first instance decision-making body⁽²⁶⁾.

While Article 91 WA relating to continued representation in the procedures as regards the procedures before the General Court (GC) and the Court of Justice (CJ) appears to be neither directly applicable to the administrative procedures before the EUIPO, nor even transposable to Article 97 WA, it comforts the understanding outlined above as regards the continuity of representation between 'the basic' (registration, opposition⁽²⁷⁾,

⁽¹⁹⁾ Articles 159(c) and 162(1) EUTMR; Article 104 CDR.

⁽²⁰⁾ Articles 66(1) and 165(1) EUTMR; Article 55(1) and Article 106 CDR.

⁽²¹⁾ Articles 159(e) and 165(1) EUTMR; Article 106 CDR.

⁽²²⁾ Starting with the filing of notice of appeal (Article 68(1) EUTMR; Article 57 CDR) and ending by the i) decision terminating the appeal procedure (Article 71(1) EUTMR; Article 60(1) CDR) ii) the withdrawal of appeal, or iii) loss of purpose (e.g. withdrawal of underlying request, disappearance of earlier right). That procedure can also continue even after the issuing of a decision by the Board of Appeal where that decision has been annulled or altered by the EU Courts, see Article 72(6) EUTMR and Article 61(6) CDR; Article 35(4) EUTMDR and 27/06/2013, T-608/11, Instruments for writing, EU:T:2013:334, § 32-34).

⁽²³⁾ Article 71 EUTMR and Article 60 CDR: BoA does (i) either remit a case for further prosecution to the instance that adopted the decision under appeal (ii) or decides itself by using 'any power within the competence' of the first instance decision-making body that took the decision under appeal.

⁽²⁴⁾ As regards the opponent (see Section B.1.(i) above).

⁽²⁵⁾ As regards the opponent (see Section B.1.(i) above).

⁽²⁶⁾ This can be the result of an explicit remittal by the BoA to the first instance department whose decision was subject to the appeal (Article 71 EUTMR and Article 60 CDR) but also be the mere consequence of the fact that the appeal concerned only parts of the procedure brought before the first instance.

⁽²⁷⁾ As regards the opponent (see Section B.1.(i) above).

revocation, invalidation, or register) procedure and the related appeal procedure before the EUIPO's decision-making instances.

(iii) Court procedure

The procedure for annulment of the Board of Appeal decision before the EU Courts (GC and CJ) does **not** belong to the procedure brought before the EUIPO. Representation before the EU Courts is governed by Article 91 WA. However, a Court procedure in which a decision of the Board of Appeal is reviewed as to its legality might lead to the result that the corresponding 'basic' EUIPO-procedure becomes pending again before the Boards of Appeal and needs thus to be continued before the EUIPO. This occurs, in particular, where the Board of Appeal decision contested before the EU Courts is annulled or altered⁽²⁸⁾.

This entails the following consequences as regards representation.

A UK representative who, before the end of the transition period, represented a party in the appeal proceedings before the EUIPO that led to the Board of Appeal decision, which is contested before the EU Courts, can continue to represent that party in the continuation of the proceedings before the EUIPO following an annulment or alteration of the contested Board of Appeal decision⁽²⁹⁾.

However, a UK representative who represented a party in a court procedure at the end of the transition period, but was not representing that party in the administrative appeal proceedings before the EUIPO that led to the decision, which is contested before the EU Courts, has therefore, on that account, no right to continued representation where the EU Court annuls or alters the Board of Appeal decision and the procedure becomes again pending before the instances of the EUIPO.

2. Brought before the EUIPO and Ongoing

(i) 'Brought before' the EUIPO before the end of the transition period

The 'basic' (registration, opposition⁽³⁰⁾, revocation, invalidation, or register) procedure needs to have been brought before the EUIPO before the end of the transition period (that is, save extension, on 31 December 2020 at the latest).

⁽²⁸⁾ Article 72(6) EUTMR and Article 61(6) CDR; Article 35(4) EUTMDR and 27/06/2013, T-608/11, Instruments for writing, EU:T:2013:334, § 32-34.

⁽²⁹⁾ Articles 72(6) and 61(6) EUTMR (EUIPO must take the necessary measures to comply with the judgment).

⁽³⁰⁾ As regards the opponent (see Section B.1.(i) above).

A procedure is 'brought before' the EUIPO (or 'initiated' ⁽³¹⁾) at the moment at which that procedure 'has been formally registered with [the EUIPO]' ⁽³²⁾. The relevant act is thus the reception by the EUIPO of the application or the request starting the 'basic' first instance (registration, opposition ⁽³³⁾, revocation, invalidation, or register) procedure.

- Registration: application for registration (Article 30(1) EUTMR; Article 35(1) CDR).
- Opposition ⁽³⁴⁾: notice of opposition (Article 46(1) EUTMR).
- Revocation and invalidity: application for revocation or for invalidity (Article 63 EUTMR; Article 52 CDR).
- Register: corresponding request (Articles 20(5), 29(1), 53(1), 54(1), 55(1) and 56(1) EUTMR; Article 28 et seq. CDR) or declaration (Article 57(2) EUTMR; Article 51 CDR).

This is a formal requirement (registration of the application or request with the EUIPO) and does not depend on the question whether the application or request is admissible or well-founded. In view of the purpose of Article 97 WA (representation), it is also immaterial whether or not the application or request is afterwards found to be 'deemed not filed', for example, if payment has not been made on time.

(ii) Ongoing ('that procedure') after the end of the transition period

That 'basic' procedure – that is the application/request made to the EUIPO – needs still to be pending before the EUIPO after the end of the transition period.

This is the case where, and to the extent that, the application or request at the basis of the procedure (i) is still existent (that is not withdrawn or devoid of purpose) and/or (ii) has not yet been settled by a final – and no longer appealable – EUIPO decision.

In particular, a procedure brought before the EUIPO is still 'ongoing' in the following two situations:

- where the decision on the appeal does not, or only partially, settle the underlying 'basic' (registration, opposition ⁽³⁵⁾, revocation, invalidation, or register) procedure, which is thus continued before the EUIPO's first instance decision-making body;
- where the decision of the EU Courts annulling or altering the Board of Appeal decision does not, or only partially, settle either the appeal procedure under judicial review or its underlying 'basic' (registration, opposition ⁽³⁶⁾, revocation, invalidation,

⁽³¹⁾ Compare the wording used in Article 92(1) WA ('an administrative procedure shall be considered as having been initiated at the moment at which it has been formally registered with the Union institution, body, office or agency' (although this provision does not directly apply to proceedings before the EUIPO, as Article 97 WA is *lex specialis* in this respect).

⁽³²⁾ Article 92(2) WA: 'For the purposes of this Chapter' [to which Article 97 WA belongs] 'an administrative procedure shall be considered as having been initiated at the moment at which it has been formally registered with the Union institution, body, office or agency.'

⁽³³⁾ As regards the opponent (see Section B.1.(i) above).

⁽³⁴⁾ As regards the opponent (see Section B.1.(i) above).

⁽³⁵⁾ As regards the opponent (see Section B.1.(i) above).

⁽³⁶⁾ As regards the opponent (see Section B.1.(i) above).

or register) procedure, which are thus continued either before the Board of Appeal or before the EUIPO's first instance decision-making body.

3. Representing a party before the end of the transition period

The UK representative needs to have been at the end of the transition period (that is, in principle, 31 December 2020 at the latest):

- authorised: duly appointed by the party and fulfilling the requirements (Article 120 EUTMR; Article 78 CDR);
- for that procedure.

In this regard, the following applies.

- The UK representative needs to have been appointed as representative for the concrete procedure at hand. In other words, the UK representative's mandate needs necessarily to cover representation in the procedure concerned.
- It is immaterial whether the procedure at hand is, at this point in time, pending before the EUIPO's first instance decision-making body or before the Board of Appeal. It is thus also irrelevant whether the UK representative has only been appointed at opposition⁽³⁷⁾ or appeal stage.
- While the representative needs to be duly appointed at the end of the transition period for the ongoing procedure, they do not necessarily need to have already performed concrete procedural acts in that procedure prior to the end of the transition period. This could occur where the application for registration of the EUTM or Community design is filed before the end of the transition period and objections (formalities / priority issues / absolute grounds, etc.) are raised after the end of the transition period. Similarly, this could occur in *inter partes* procedures brought by the applicant (opponent, revocation/invalidity applicant) before the EUIPO close to the end of the transition period and notified to the 'defendant' (owner of contested right) only after the end of the transition period.

4. 'Continued' representation after the end of the transition period

Continued representation implies a 'triple identity' at and after the end of the transition period:

- identity of the UK representative (as a natural person), which is not affected by that representative's change of address or affiliation to a particular law firm or association of representatives;
- identity of the represented party:

⁽³⁷⁾ As regards the EUTM applicant (see Section B.1.(i) above).

- this condition is fulfilled in the event of a mere change of name and/or address, or of the party's legal form where such change does not – according to the applicable law – modify that party's legal identity;
- this condition is not fulfilled in the event of 'replacement of a party' ⁽³⁸⁾ (of a party's successors to right):
- identity of the procedure (that is the 'basic' – registration, opposition, revocation, invalidation, or register – procedure, including the related appeal procedure).

⁽³⁸⁾ Compare Article 174 RoP-GC ('Replacement of a party): 'Where an intellectual property right affected by the proceedings has been transferred to a third party by a party to the proceedings before the Board of Appeal of the Office, the successor to that right may apply to replace the original party in the proceedings before the General Court.'