

## **Dr Michael Edenborough QC – Written evidence (PBS0004)**

These submissions relate to intellectual property rights in general and trade marks and registered designs in particular.

Currently, UK trade mark practitioners, be they lawyers or trade mark attorneys, may represent clients before the EU Intellectual Property Office (the “EUIPO”) on trade mark and design matters, both at first instance and on appeal to the Boards of Appeal. As part of the reciprocal arrangements with the EU, EU27 lawyers and trade mark attorneys may act for clients before the UK Intellectual Property Office (the “UKIPO”) on trade mark and design matters. (Patents are treated separately and so fall outside the scope of this paper.)

Those arrangements remain in place until 31<sup>st</sup> December 2020. Thereafter, UK lawyers and trade mark attorneys will lose the right to represent clients before the EUIPO. However, EU27 lawyers and trade mark attorneys will retain the right to act for clients before the UKIPO. That plainly is unbalanced, as it gives an unwarranted advantage to EU27 lawyers and trade mark attorneys to act in matters before the UKIPO that is not reciprocated in the rights of representation before the EUIPO for UK lawyers and trade mark attorneys.

There can be no justification for this imbalance.

It would be sensible to remove the access of EU27 lawyers and trade mark attorneys to act before the UKIPO to match the rights of UK lawyers and trade mark attorneys to act before the EUIPO. The simplest way to achieve most of this objective is to require that the address for service for matters relating to UKIPO proceedings must correspond to an address in the UK. A more complete solution is to require any professional representative to be qualified in the UK. (Under UK law, unqualified people may act before the UKIPO, *e.g.* as a lay representative. However, only a qualified representative may act before the EUIPO as it is governed by a civil code, rather than the common law.)

If the EU were to allow UK lawyers and representatives to act before the EUIPO, then that could be matched by allowing EU27 lawyers and trade mark attorneys to act before the UKIPO.

There is a further related matter, namely that UK lawyers currently may act for clients before the General Court and Court of Justice in appeals from the EUIPO

on trade mark and design matters. This right will evaporate at the end of 2020. Again, similar reciprocal arrangements could be made.

Concerning trade mark matters in general, given that about a third of all EU trade marks are filed in English, it makes sense that native English-speaking lawyers and trade mark attorneys are involved in resolving issues relating to registrability and conflicts that so commonly turn on nuances of the English language. It is to the advantage of the EU that the resolution of such issues is assisted by those best placed to make those nuanced submissions to the relevant courts or tribunals that rule upon those issues. It is to the disadvantage of the EU to fetter artificially its ability to make the best possible ruling on such nuanced matters, especially when the consequences would affect the population and trading environment of the whole EU27.

*9 June 2020*