

## Important changes to the address for service rules at the UKIPO – updated guidance 26 November 2020

The UK government has now published draft secondary [legislation](#) to enact changes in the address for service rules in the UK with effect from 1 January 2021. The UKIPO has also published further detailed [guidance](#) as to how the new changes will be applied in practice.

The proposed changes are complex and contain a number of exceptions. Based on the draft legislation and UKIPO's updated guidance, we set out below tables listing actions where, respectively, (a) the UKIPO advises that it will, after the end of 2020, be necessary to have an address for service in the UK (reference in this note to the UK includes the Channel Islands and Gibraltar), (b) it will still be possible to have a European Economic Area (EEA) address for service and (c) there is no change to existing rules. The tables cover the main areas and are not intended to cover exhaustively all possible cases. If you have any queries on any particular case, please do feel free to contact us to discuss.

In general, as from 1 January 2021, an address for service recorded at the UKIPO for any patent, trade mark or registered design must be in the UK, unless it is covered by one of the exceptions listed in Table 2 below. The majority of actions taken before the UKIPO require an address for service, as detailed in Table 1. However, it will continue to be possible to take some limited actions before the UKIPO without an address for service, as set out in Table 3. **Abel + Imray strongly recommend that an address for service of a suitably qualified professional representative be appointed at the UKIPO for all patents, trade marks and registered designs, to avoid any inadvertent loss of rights.** From 1 January 2021, this must be a UK address with a few exceptions (see below).

Abel & Imray is a pan-European firm with offices in both the UK and the EU. We will continue to act in relation to any right and in respect of any proceedings before the UKIPO, the EPO and the EUIPO before and after 1 January 2021.

**Table 1: UK address for service required from 1 January 2021**

	Action	Comments on Requirements
1	Filing any new application directly at the UKIPO on or after 1 January 2021.	<p>The requirement for a UK address for service relates to all new patent, trade mark and registered design applications filed at the UKIPO, including applications filed in the nine months after 31 December 2020 which claim “priority” from EUTM and RCD applications and designations which were still pending or unpublished at the EUIPO at the end of the transition period. This will include PCT applications for which the UK is the competent Receiving Office (including those for which the International Bureau acts as Receiving Office for PCT applications for which the UKIPO is the competent office).</p> <p>For Madrid or Hague applications designating the UK, the UKIPO will maintain its current practice, that is to say it will <b>not</b> require a UK address for service unless and until the holder is required to make a response to the UKIPO, for example, where the UKIPO raises an objection or notifies the owner of an opposition.</p>
2	Defending a revocation action or invalidity action filed against a UK granted patent, registered trade mark or registered design on or after 1 January 2021 (with a temporary exception for defending UK comparable trade marks and re-registered designs cloned from EUTMs and RCDs filed directly at the EUIPO).	<p>It will be necessary to have a UK address for service to defend revocation or invalidity actions commenced at the UKIPO on or after 1 January 2021.</p> <p>However, there will be a temporary exception for UK registrations cloned from EU registrations, which were originally filed directly at the EUIPO. For those UK registrations, it will be possible to defend proceedings brought on or after 1 January 2021 and before 1 January 2024 using an EEA address for service. For proceedings commenced in relation to such cloned registrations on or after 1 January 2024, it will be necessary to have a UK address for service.</p> <p>The new legislation treats UK trade mark and design registrations cloned from Madrid and Hague designations differently. In relation to those registrations, it will be necessary to have a UK address for service for defending any challenge brought on or after 1 January 2021.</p>

		The UKIPO's practice on missed deadlines for filing defences is strict and the failure to file a UK address for service where necessary under the new rules may lead to the irretrievable loss of the registration in question.
3	Defending a pending UK trade mark application or designation against an opposition filed on or after 1 January 2021.	In all cases, it will be necessary to have a UK address for service to defend an opposition filed on or after 1 January 2021. If a UK address for service is not filed by the deadline for a defence set by the UKIPO, the application is likely to be deemed irretrievably withdrawn by the UKIPO.
4	Filing an opposition against a third party trade mark application or designation on or after 1 January 2021.	A UK address for service will be required for filing any trade mark opposition at the UKIPO on or after 1 January 2021.
5	Filing for invalidity of a registered trade mark or registered design on or after 1 January 2021 unless the earlier registration relied on is a UK registration that is cloned from an EUTM or RCD filed directly at the EUIPO.	Applicants for a declaration of invalidity of a registered trade mark or design will have to have a UK address for service. There is one exception to that general rule - an applicant for invalidity can file an invalidity action using an EEA address for service where the earlier registration relied on is cloned from an EUTM or RCD filed directly at the EUIPO.
6	Filing for revocation of a registered UK trade mark on or after 1 January 2021.	It will be necessary to have a UK address for service.
7	Filing for invalidity of a UK patent on or after 1 January 2021.	It will be necessary to have a UK address for service.

8	<p>Applying to record or give notice of certain changes against a pending UK patent application or a granted UK or European (UK) patent on or after 1 January 2021; including the following:</p> <ul style="list-style-type: none"><li>surrendering a patent;</li><li>recording an assignment, licence or security interest;</li><li>recording your change of address when you are the proprietor of the patent; and</li><li>correcting an error or omission in the register</li></ul>	<p>It will be necessary to have a UK address for service.</p>
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**Table 2: EEA address for service still permissible after 1 January 2021**

	Action or right	Comments on Requirements
1	Continuing to prosecute a UK patent, trade mark or registered design application filed before 1 January 2021 where the application had an EEA address for service as of 31 December 2020.	Where a UK patent, trade mark or registered design application filed before 1 January 2021 had, as of the end of December 2020, an EEA address for service, it will be possible to continue to prosecute the UK application using an EEA address for service and to substitute a new EEA address for service in respect of the same proceedings, if desired. This will include filing a divisional patent application. However, if new proceedings (e.g. an opposition) are brought against the application on or after 1 January 2021, then a UK address for service will be required to defend those proceedings.
2	Continuing with proceedings (e.g. oppositions, invalidations and revocations) which were ongoing before 1 January 2021 where the relevant party had an EEA address for service as of 31 December 2020.	In this these cases, it will be possible to retain an address for service in the EEA until the resolution of the proceedings, irrespective of whether the proceedings are finished by the end of 2023 or not. In these specific cases, it will also be possible to change the address for service to another EEA address while the proceedings are still pending.
3	European patents designating the UK which are granted before 1 January 2021.	Until 31 December 2020, the UKIPO will accept an address for service anywhere in the EEA for a granted European patent which designates the UK. It appears this address for service will remain valid after 31 December 2020, unless new proceedings involving the patent are instigated, as detailed in Table 1 above, when it will become necessary to provide a UK address for service.

**Table 3: No new address for service requirements**

	Action or right	Comments on Requirements
1	Registered and granted registrations not facing any challenge	<p>The UKIPO will not require patent, trade mark or registered design owners to appoint a UK address for service unless and until the registered or granted registration is challenged (see for example point 2 in the Table 1 above).</p> <p>For UK registrations that are cloned from EU registrations, it will be possible to record a different EEA address for service, at least until the end of 2023.</p>
2	Granted European patents designating the UK which are granted after 31 December 2020.	<p>Granted European patents which designate the UK are transferred onto the UK Register automatically. This normally occurs on the date of grant. No “validation” is required and there is therefore no requirement to appoint an address for service and this will continue to be the case after 31 December 2020.</p> <p>However, European patents are transferred onto the UK Register with the proprietor’s details only, because the UKIPO must have authorisation before it can recognise any representative. To ensure official communications from the UKIPO (e.g. renewal reminders and loss of rights notices) are received and handled in a proper manner, many patent owners voluntarily appoint an address for service. After 1 January 2021, any address for service which is voluntarily recorded at the UKIPO for a granted European patent will have to be in the UK.</p>

3	Renewing an IP registration	<p>It will continue to be possible to pay renewal fees for a granted or registered UK registration without having a UK address for service.</p> <p>In most cases, however, it is recommended that the owner of a patent, trade mark or design should appoint an address for service to ensure that official communications from the UKIPO are reliably received and acted on in a timely manner. As noted in point 2 above, it will not be possible to specify a non-UK address for service for this purpose, except in the case of UK comparable trade mark and design registrations derived from EU marks and designs.</p>
4	<p>Recording certain changes against trade marks and designs (but <b>not</b> patents) including the following:</p> <ul style="list-style-type: none"><li>surrendering a registration;</li><li>recording a licence;</li><li>recording your change of address when you are the holder of the registration; and</li><li>correcting an error or omission in the register</li></ul>	<p>These actions were not previously subject to address for service requirements under the corresponding trade mark and design rules and the UKIPO is not proposing to make a UK address for service necessary under the new rules.</p>

# Abel+Imray

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