



Brexit trade mark Q&A

What does Brexit mean for my clients' EU registrations?

Although the UK left the EU on 31 January 2020, EU law continues to apply to the UK during the transition period as a result of the Withdrawal Agreement. Presently the transition period is due to expire on 31 December 2020.

UK legislation provides for the automatic extension of any EU/IR-EU registrations to the UK at the expiry of the transition period.

In order to identify UK rights which arise from an EU registration (which will be called 'comparable trade mark (EU)'), the number allocated to the comparable mark will be the last 8 digits of the EUTM prefixed with UK009.

In order to identify UK rights which arise from an EU designation of an International Registration (which will be called 'International trade mark (EU)'), the number allocated to the comparable mark will be the last 8 digits of the EUTM prefixed with UK008. Please note that these new UK rights will sit outside of the main International registration going forward and will need to be maintained separately.

What does Brexit mean for my clients' pending EU applications?

For pending EU/IR-EU applications, legislation provides that if an application remains pending at the end of the transition period, applicants will need to file a fresh UK application within 9 months of the end of that period to maintain the same filing/priority date as the EU application. There will be no automatic extension of EU applications to the UK. We docket this date on each active case once matters are on to our records.

I am not even sure our clients operate in the UK?

If your clients have an EU registration but no specific interest in the UK marketplace, then arguably they are not affected by the decision of the UK to leave the EU. It is important to check your clients' interests in the UK market and any potential future plans, as the newly formed UK comparable mark may become vulnerable to cancellation for non-use.

Our clients have an EU registration but only sell in the UK – what now?

UK legislation provides for the automatic extension of any EU/IR-EU registrations to the UK at the expiry of the transition period.

If your clients are using the mark in the UK, then their ongoing use in the UK, will support the validity of the 'new' UK comparable mark.

The potential vulnerability occurs to the remaining EU registration, if the registration is more than five years old. In this scenario, the remaining EU registration could be vulnerable to a non-use challenge.

Best practice is to have conversations with your clients now to understand the geographic scope of their use in Europe. We generally advise that use in three EU member states is needed to prevent a non-use cancellation action of an EU registration being successful, but this is a very fluid measure.

What are the countries currently covered by an EU trade mark?

The EUTM member states: are Austria, Belgium, Bulgaria, Croatia, Republic of Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the UK.

However the scope of the EU application also extends to: Åland Islands, Martinique, Guadeloupe (included St. Barthélemy and French part of Saint-Martin), French Guiana, Réunion, Azores, Madeira, Ceuta and Melilla, the Canary Islands, and Gibraltar, the Isle of Man, and Jersey.

Extension of an EU trade mark is automatic in the Falkland Islands where the mark is also registered in the UK.

After Brexit, my clients are likely to have an interest in mainland Europe and the UK – what is the best approach to protect the brand?

In this instance, separate EU and UK applications will be needed. This could either be through national filings before the EU and UK Offices or through the designation of the EU and UK under the Madrid system. We can of course continue to support your clients' EU and UK filings.

Do I need an EU/UK trade mark watching service?

Neither the EUIPO nor the UKIPO conduct examination on relative grounds as is the case before the USPTO. Consequently, it has always been our recommendation for clients to operate a watching service before the EU and UKIPO. This recommendation does not change.

Does this have any impact on my Community registered designs (CRD)?

The UK remains part of the EU registered community design system throughout the transition period. Registered community designs (RCD) will continue to extend to the UK during this time. Comparable UK designs will be created at the end of the transition period under the terms of the Withdrawal Agreement.

The impact of Brexit on community designs will mirror the impact on trade marks and similar provisions are in place. The cloning process will replicate the trade mark cloning process, although designs register so quickly it is anticipated that there will be very few pending applications at the time that the transition period ends. There will however be the same nine month period from the end of the transition period to apply in the UK for duplication of the EU application if required.

Does this have any impact on unregistered designs (UCD)?

The UK will remain part of the EU unregistered community design system throughout the transition period. This means that two- and three-dimensional designs (including, for example, clothing designs and patterns) disclosed in the UK or an EU Member State can be automatically protected in both territories as unregistered Community designs. This right provides three years of protection from copying.

In accordance with the Withdrawal Agreement, unregistered community designs arising before the end of the transition period will continue to be protected in the UK for the remainder of their three-year term.

Designs disclosed in the UK after the end of the transition period may be protected in the UK through the supplementary unregistered design, which will protect two- and three-dimensional designs for three years.

How can we best track action and dates arising?

Get Barker Brettell onboard to help. Barker Brettell has a Renewals and Records team who specialise in monitoring action and dates arising to ensure deadlines are met. Using Barker Brettell's services will allow you to receive updates of any advancements and assistance whenever required.

Does this have any impact on patents?

No, the EPO system is not an instrument of the European Union and Brexit does not have any impact on patent protection in the UK and Europe.

Does this have any impact on the Unitary Patent Court?

No, this was always outside the remit of the EU IPO.