

ALL YOU NEED TO KNOW ABOUT BREXIT AND YOUR TRADE MARKS

With less than one month to go until the Brexit transition period is over, here are the key trade mark implications to be aware of come 1 January 2021.

1. What will happen to registered EU trade marks at the end of the transition period?

An EU trade mark will no longer provide a registered trade mark right in the UK. However, as part of the European Union (Withdrawal) Act, the UK Intellectual Property Office ("UK IPO") will automatically create a comparable and standalone UK trade mark for everyone who owns an existing registered EU trade mark as at 1 January 2021. This will also extend to EU trade marks which expired in the six months prior to 1 January 2021 (which are therefore within the six month "grace" period for late renewal).

The reference to "comparable" is slightly misleading, as the UK right will be granted for exactly the same mark and for the same goods and services as for the EU registration. The comparable registration will also have the same legal status as if it had been applied for, and registered under, UK law and will helpfully keep the original EU trade mark filing date (meaning the protection in the UK will be backdated to that earlier date).

The comparable UK registration will be granted automatically on 1 January 2021 free of charge.

2. Can I prevent the automatic granting of a comparable UK trade mark?

Yes. It may be possible to opt out of this automatic process, for example, to avoid unnecessary renewal fees being incurred where you already have an existing UK registration. These opt-out requests may only be made post 1 January 2021, directly to the UK IPO. Be aware that you will not be able to opt-out if you have used the right in the UK.

3. What will happen to pending EU trade mark applications at the end of the transition period?

A comparable UK trade mark registration will only be automatically granted for owners of EU registrations as at 1 January 2021. Anyone with an EU trade mark application pending on that date will need to apply for a comparable UK trade mark within nine months (with a deadline of 30 September 2021). Standard official filing fees will apply but helpfully again, the application will retain the earlier filing date of the pending EU trade mark.

4. Should I conduct a UK clearance search before filing for my comparable UK registration?

We would usually always recommend carrying out a clearance search before filing a new trade mark application, to ensure that you are aware of any risks presented by earlier rights holders.

However, where you are applying for a comparable UK registration (on the basis of a pending EU application), your application will take priority over any new UK applications which were filed after your EU filing date. Therefore, if you conducted an EU wide search at the outset and you were comfortable with the risks, you will be able to ignore any new applications/registrations which have been made in the UK after your EU filing.

Conversely, if you are looking to register a new UK registration in the nine month period between 1 January 2021 and 30 September 2021, be aware of pending EU applications, as these will take priority over your new UK application, even if the comparable application was put in after your new application.

5. How do I renew EU trade marks after the end of the transition period?

EU trade marks and their corresponding UK comparable trade marks will need to be renewed separately after 1 January 2021, meaning separate renewal fees will have to be paid to the EU Intellectual Property Office and the UK IPO. If we look after your trade marks, we will continue to remind you of any renewal deadlines and renewal fees as they fall due.

6. What rights will an EU registered trade mark provide in the UK following the end of the transition period?

In short, none. You can obtain the comparable UK registration (as referenced above) but from 1 January 2021, EU trade marks will not give rights in the UK.

7. What will happen to the status of any UK registered trade marks after the end of the transition period?

UK registered trade marks will be unaffected by Brexit.

8. I am in the process of trying to cancel a third party EU trade mark – will the third party's UK comparable mark now escape this action?

No, on the basis that the UK IPO will honour the outcome of the cancellation action in respect of any UK comparable right.

9. What about third parties seeking to challenge my non-use in the UK?

If you are an EU trade mark owner who has used the relevant mark in another Member State pre 1 January 2021, but not in the UK, your mark will not be vulnerable for cancellation on the grounds of non-use. This is because UK law will recognise your pre-Brexit EU use in the context of your UK comparable registration.

However, after 1 January 2021, use of an EU trade mark in the UK does not qualify as use "in the EU" for the purposes of maintaining the rights conferred by an EU trade mark.

10. Can UK nationals and UK-based companies own an EU trade mark after the end of the transition period?

Yes, UK nationals and UK-based companies can continue to own EU trade marks after 1 January 2021. Nothing will change in this regard.

11. Is it worth filing for an EU trade mark before 1 January 2021?

If you were to apply for an EU trade mark now, this would still be pending as at the expiry of the current transition period due to the timeframes involved in achieving registration in the EU. This means that you would need to apply for a comparable UK trade mark (it will not be granted automatically) and, as explained above, standard official UK filing fees will apply. Despite this, irrespective of the Brexit transition period, we would still (almost always) recommend that you commence the trade mark filing process as soon as possible, to obtain the earliest possible filing date (as your rights in the mark, once registered, will date back to that filing date).

Please get in touch with our IP team if you have any questions.



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