

EU Trade Marks following Brexit

In Europe, a trade mark registration system exists through which a single European Union trade mark (“**EUTM**”) application may be filed before the European Union Intellectual Property Office and if granted, will extend registered trade mark rights simultaneously in all EU member states, including the United Kingdom (“**UK**”). With the UK set to leave the EU and the continuing uncertainty around Brexit, the Trade Marks (Amendment etc.)(EU Exit) Regulations 2019 (the “**Regulations**”) have been introduced in the UK to provide certainty for the rights of owners of registered EUTM’s and registered international trade marks that have designated the EU (as a place of registration) following the UK’s departure from the EU. The Regulations have been approved by the UK government and will come into force when the UK leaves the EU.

If the EU and the UK reach an agreement on the terms of the UK’s withdrawal from the EU (the “**Withdrawal Agreement**”) before the 31st October 2019 a transitional period for the UK’s exit from the EU will be provided and the UK will be bound by EU rules until the 31st December 2020 (unless extended) (“**Deal**”).

In the event that the European Parliament and UK Parliament do not agree to approve a Withdrawal Agreement before the 31st October 2019, the UK will exit on this date without any agreement (“**No Deal**”).

What does this mean for existing registered EUTM’s

Whether the UK leaves the EU with a Deal or No Deal, the Regulations provide that the holder of an existing EUTM at the time of the UK’s exit from the EU, will have a new UK equivalent right granted and will be registered on the UK trademark register. There will be no charge applicable for the new UK equivalent trade mark to be provided.

This means that in the event of a Deal, all EUTM’s registered as at 31 December 2020 will automatically be protected and in the event of a No Deal, all EUTM’s registered as at 31st October 2019 will also be automatically protected.

Any holder of a EUTM that may not want to receive a new comparable UK registered trade mark can chose not to receive one by giving notice of opting out.

It is important to note that a new UK equivalent right may become vulnerable to revocation proceedings if it has not been used in the UK or the EU in the five years prior to the UK’s exit from the EU.

What does this mean for International trademark registrations designating the EU?

International trade mark registrations which have designated the EU and are registered prior to exit day, will also have a new UK equivalent trade mark granted. This will have the same filing, priority and registration date as the international trade mark registration. It will be a new UK equivalent trade mark that will be granted and not a UK designation. No charge will be applicable for the issuing of this equivalent right.

What does this mean for pending EUTM’s and EU designations of International Registration?

EUTM applications and international trade mark registration applications which have designated the EU and which are pending at the date of exit, will not be granted a new UK equivalent right.

The owner of such EUTM applications or EU designations will be required to re-file an application with the UK Intellectual Property Office if they want to secure protection in the UK.

For a period of 9 months from the date of exit, the UK government will recognise filing dates and claims to earlier priority recorded on the corresponding EUTM application or corresponding EU designation. Refiling fees will be applicable.

We are advising our client's to review their trade mark portfolio and to consider whether they require a new UK equivalent right or whether giving notice to opt out would be more appropriate.

To review the Regulations further please refer to <http://www.legislation.gov.uk/uksi/2019/269/contents/made> or for more information or advice, please contact any member of the FOD team.