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INTELLECTUAL PROPERTY

B= BREXIT – ADVICE TO BRAND OWNERS

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The initial Brexit date of 29 March 2019 was re-scheduled to 31 October 2019 – deal or no deal.

Our advice to date concerning trade marks is that separate trade marks should be filed in the UK in addition to the EU to avoid the inevitable administrative delays at the UK Intellectual Property Office ("UKIPO") in the event of a "no deal" Brexit. This is particularly so if the UK is a trading partner and brand owners are advised to review current UK and EUTM trade mark portfolios and if there is no separate UK mark consider the following:

A "DEAL" BREXIT		All EUTM trade mark registrations will be considered in force and effect in the UK with a transition period until at least December 2020.
A "NO DEAL" BREXIT	**EUTM Registrations**	Registrations will automatically replicate to the UK as "comparable trade marks (EU)" identifiable by **UK009**. No further action is required, no additional official fees apply.
	EUTM Applications	It will be necessary to file an application to the UKIPO for the grant of a UK replica application on payment of a fee.
	Opposed EUTM's	It will be necessary to file an application to the UKIPO for a UK replica application on payment of a fee.
	Pending cancellation application against an EUTM	A new cancellation action may be required in the UK against the "comparable trade marks (EU)".
	Renewals	Two separate renewals will apply for the EUTM and the "comparable trade mark (EU)" when due.
	Non-use cancellations	A trade mark is vulnerable to cancellation for non-use by any interested third party if it has not been used for a period of five years or longer after registration. Currently, as an EUTM includes the UK any use of the mark within the UK could assist in defending a non-use cancellation against an EUTM. On Brexit, use in the UK from then will not be taken into account which brand owners should be aware of. It is not uncommon to refile trade marks that are vulnerable to cancellation, albeit it defensively.

*A EUTM covers all 28 member countries of the EU, namely Austria, Belgium, Bulgaria, Cyprus, The 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.

Should you require any clarity on the above or assistance with reviewing your current position in the EU please contact our Intellectual Property Team.



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View Profile