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The European Union Trade Mark and the UK after Brexit

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On the 31 December 2020, the Brexit Transition period ended and the UK separated from the European Union.

After Brexit, with the UK excluded, an European Union Trade Mark ("EUTM") covers twenty seven members of the European Union namely Austria, Belgium, Bulgaria, Croatia, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, Netherlands, Portugal, Romania, Spain, Sweden, Cyprus, the Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia and Slovenia.

While the registration and maintenance of an EUTM remains efficient and cost effective in providing trade mark protection in the European Union ("EU"), brand owners will want to know how Brexit impacts existing and intended future trade marks in the EU and the UK.

Below are some important changes:

EUTM Registrations	Registered EUTMs on Brexit replicated to UK registrations, referred to as Comparable registrations beginning by **UK009**, the remainder of the registration number identical to the existing EUTM registration. All information, including priority, seniority, application and registration dates as well as the specifications in the Comparable registration are identical to the EUTM registration. Replication of Comparable registrations was automatic, no additional action is required and no additional official fees apply. No registration certificate will issue, however, details of the Comparable registration are available online on UK IPO. Comparable registrations have the equivalent legal status to national UK trade mark registrations. Assuming that the UK is not relevant or if a UK registration had already existed before Brexit and the Comparable registration is not required, one can formally apply to the UK IPO to "opt out" thereby removing the Comparable registration. In our view the most practical approach, which requires no action, is to do nothing further. On renewal either UK registration – or both – can be renewed or allowed to lapse.
EUTM Applications	EUTMs not yet registered on Brexit will only proceed to registration in respect of the twenty seven EU member* countries excluding the UK. Applicants of pending EUTMs are therefore required to re-apply for the Comparable UK rights during a nine-month period on payment of a fee to the UK IPO, the deadline being 30 September 2021. All original EUTM filing details and dates will be retained and the application will undergo the usual examination process by the UK IPO.
Licences, assignments, changes of name and	Licences and security interests recorded against an EUTM prior to Brexit will apply equally to the Comparable registration.

address, security interests	Assignments recorded against an EUTM prior to Brexit will apply equally to the Comparable registration. If an EUTM was assigned to another party prior to Brexit but the change of ownership from Assignor to the Assignee was not recorded on the EUTM register, the Comparable registration will remain in name of the Assignor requiring an application to record the assignment on the UK register.
Pending cancellations against UK registrations	A trade mark is vulnerable to cancellation for non-use if it has not been use for a certain period of time. This non-use term for both the UK and EUTM is five years calculated from the date of registration. Pending cancellations filed prior Brexit and on the basis of prior EUTMs will continue before the UK IPO. If the corresponding EUTM is cancelled or invalidated pursuant to proceedings which commenced prior Brexit, the Comparable UK registration will also be cancelled or invalidated.
Pending EUTM and UK oppositions	Pending EUTM oppositions filed prior Brexit and only on the basis of prior UK rights will terminate as of 1 January 2021 with an order for each party to pay their own costs. Pending UK oppositions filed prior Brexit and on the basis of prior EUTMs and/or International registrations designating the EU, will continue before the UK IPO. The ruling will, however, only be applicable to the Comparable UK mark.
Enforcement	After Brexit: – EUTMs will no longer be considered earlier rights in the UK; – UK rights cannot be enforced in the EU, EUTMs cannot be enforced in the UK relying instead on the Comparable registration.
Renewals	The renewal term remains ten years from the date of application. Renewal of the EUTM and Comparable registrations will require the payment of two separate fees and two separate attendances at the respective offices.

Contact the Werksmans IP team with any questions concerning the implications of Brexit and your trade marks.

- * namely Austria, Belgium, Bulgaria, Croatia, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, Netherlands, Portugal, Romania, Spain, Sweden, Cyprus, the Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia and Slovenia.



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