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Newsletter

Preparing for Brexit: Important Trade Mark Considerations

In view of the upcoming new Brexit-deadline of 31 January 2020 and the recent UK election results, this newsletter addresses certain Brexit-related questions concerning trade marks designating the EU as protection territory.

In general, we hereby note that because the impact of a Brexit with or without the present Withdrawal Agreement will in this area be the same except for its timing,¹ we will use the terms “Brexit” and “Brexit-day” as referring to either scenario. In addition, we emphasize that Brexit-preparations require private stakeholder action and strongly recommend that trade mark holders undertake or review any necessary contingency planning at the earliest.

I. Legal Framework

In the EU, trade marks can be obtained by registering a European Union trade mark (“EUTM”) with the European Union Intellectual

Property Office (“EUIPO”), and/or by registering a national trade mark with the responsible authorities of the EU member states. Alternatively, owners can also obtain international brand protection in designated territories including the EU and the UK by registering, on the basis of an existing national or EU registration that serves as “home mark,” an ITM with the World Intellectual Property Organization (“WIPO”).

In terms of legislation, the basis for EUTM registration is Regulation (EU) 2017/1001 (the “EUTM Regulation” or “EUTMR”), national trade mark registration has been harmonized at the EU-level by Directive (EU) 2015/2436, and ITM registration is based on the so-called “Madrid Protocol.”² In the UK, applications must be filed with the UK’s Intellectual Property Office (“UKIPO”) on the basis of the Trade Marks Act 1994 (“TMA”), the Trade Marks Rules 2008 and various standalone regulations.³ Furthermore, the UK has prepared for the possibility of a “no-deal” Brexit by enacting the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 and the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019.⁴

II. General Impact of Brexit

As highlighted by the EUIPO,⁵ all EU law will as a result of Brexit cease to apply to the UK. In terms of trade marks, this means that:

- **existing EUTMs** registered in accordance with EU law **will no longer have effect in the UK;**
- **pending EUTM-applications** and future EUTM-registrations **will no longer cover the UK;**

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¹ In particular, any impact will apply immediately in case of a “no-deal” scenario and as of 1 January 2021 at the earliest in case of a Brexit on the basis of the Withdrawal Agreement.

² See [EUTMR](#); [Directive \(EU\) 2015/2436](#); and [Madrid Protocol](#).

³ See [TMA](#) and [Trade Marks Rules](#).

⁴ See [Trade Marks Regulations 2019](#); and [International Trade Marks Regulations 2019](#).

⁵ See [EUIPO Notice to Stakeholders](#).

- **existing seniority claims** in EUTMs based on UK trade mark rights **will no longer have effect in the EU**; and
- **existing ITMs** having designated the EU as area of protection **will no longer have effect in the UK**.

We hereby note that owners of EUTMs will however remain fully protected in the remaining EU member states, and that UK brand owners will still be able to obtain EU-wide protection by registering either an EUTM or an ITM that designates the EU. Furthermore, ongoing UK Court cases relating to existing EUTMs will continue to be heard under the EUTMR.

III. EUTM Rights in the UK

III.A. UK Equivalent for Existing EUTMs

To ensure the continued protection, in the UK, of trade mark rights under registered EUTMs, the UKIPO will immediately as of Brexit-day, automatically and at no extra cost replace such rights by an equivalent “comparable trade mark”. This equivalent will also be created for EUTMs that expired within six months before Brexit-day, but the continued enforceability thereof will require a timely late renewal action with the EUIPO for the corresponding EUTM.

In this regard, some notable features of the “comparable trade marks” are that they will:

- keep the original filing date, priority date and, where appropriate, UK seniority dates of the corresponding EUTMs;
- be assessed by taking into account any previous use and reputation of the corresponding EUTM anywhere in the EU;
- be subject to a first renewal, in the UK and at a separate UKIPO-renewal fee, on the existing renewal date of the corresponding EUTMs; and
- be “independent” in that they could be assigned, licensed or challenged (before the UK Court and UKIPO Tribunal) separately from the corresponding EUTMs.

III.B. Refiling of Pending EUTMs in UK

As for EUTM-applications that remain pending on Brexit-day, applicants will have the right to “refile”, within 9 months after Brexit and subject to the standard UK fees, an application with the UKIPO for an identical UK trade mark (“UKTM”)

that will be examined under UK law. The new application must relate to the same sign, and seek protection for some or all of the goods and services contained within the pending EUTM-application. In addition, the UKTM-application will have the original filing date, priority date and, where appropriate, UK seniority dates of that EUTM-application.

IV. ITMs Designating the EU

To ensure the continued protection in the UK of rights under registered ITMs that designate the EU but not the UK individually, the UKIPO will similarly replace such trade marks, automatically as of Brexit-day and at no extra cost, by an equivalent “comparable trade mark.” Such trade mark will keep the original EUIPO-registration date but will otherwise be fully independent in that it will have to be maintained, assigned, monitored or renewed separately from the corresponding ITM.

In addition, UK ITM-applicants will after Brexit only be able to use an EUTM as “home mark” if they are also a national of, are domiciled in, or have a real and effective industrial or commercial establishment in an EU member state. As such, UK trade mark owners that fail to meet those requirements will need to use, and possibly first obtain, a registered UKTM as “home mark” for such ITM-applications.

V. Conclusion

In sum, the above shows that while Brexit may not immediately affect the continued protection and enforceability in the UK of existing EUTMs and ITMs up to their renewal date – for which vigilance is in order – registration within the UK could be required for pending EUTM applications, post-Brexit UK-trade mark protection and post-Brexit ITM applications. Furthermore, trade mark owners that are domiciled or have a seat in the UK should take into account that they will have to be duly represented before the EUIPO in all proceedings under the EUTMR other than the filing of an EUTM-application.

The Intellectual Property Practice of ODC has extensive experience in providing trade mark law advice and can therefore assist all businesses with each of the above-mentioned and other legal issues that they would encounter in that respect. Do not hesitate to contact us should you have any questions or require such assistance.

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