

## **BREXIT AND IP – UPDATE ON TRADE MARKS – DECEMBER 2018**

### **Key Highlights - Trade Marks**

- There is a proposed transitional period and status quo is likely to be maintained until 31 December 2020;
- Thereafter, or in the event of a no deal Brexit on 29 March 2019, EU Trade Mark Applications/Registrations will no longer cover the UK in territorial scope;
- National UK applications/registrations for trade marks unaffected.

### **Do you need to refile trademarks in UK currently covered only by EU registration?**

- UK Government has stated formally in a technical notice that no EU IP holder will lose rights;
- The Withdrawal Agreement states cloned UK equivalent registrations will be created mirroring existing EU trade mark registrations, maintaining filing, registration and renewal dates, and priority dates or seniority claims relating to UK;
- To be automatic with minimal administrative burden – UK IPO will send notice of new registration details automatically, at no cost;
- The technical notice states this is the case whether deal or no deal scenario arises;
- Trade Mark applications will not have automatic cloned UK registration created – EU IP holder will have nine months to re-file at their own cost in line with national legislation to maintain EU filing date and no notification will be sent.

### **Issues**

- EU trade mark applications filed now may not be registered by 29 March 2019 if no deal or even 31 December 2020 (the proposed end of the transition period under the current Withdrawal Agreement) if opposed;
- If no deal scenario arises, UK IPO may be approaching creation of cloned rights after the event, rather than before (it is currently proposed cloned registrations will be created in the transition period) and this could create uncertainty in the interim period if need to enforce rights in the UK;
- There is no notification what will happen to International Registrations filed by UK businesses utilising an EU application or registration as the home base application or registration – will it automatically be amended to cloned UK registration? WIPO has been silent on the point to date;
- The Technical Notice issued by this government is not legally binding – given the uncertain political situation, a new government could be in place at Brexit.

## Recommendations

- While refiling for marks covered by existing EU trade mark registrations is not recommended, as cloned registrations should issue automatically, it is recommended to file new trade marks as both EU and UK Trade Mark applications, in case an EU trade mark application is not registered by the date the UK exits (the six month priority period could be used to expand to EU);
- File any new International registrations on the basis of a UK home application or registration and do not base such an application on an EU registration.
- If you do not use a mark the subject of an EU trade mark registration in the UK and it is over five years old, the cloned registration could become vulnerable to a non-use cancellation after creation. IP holders should review use for marks the subject of cloned UK registrations to assess if vulnerable – if so, and the UK remains of future interest, consider filing UK national trade mark application.

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