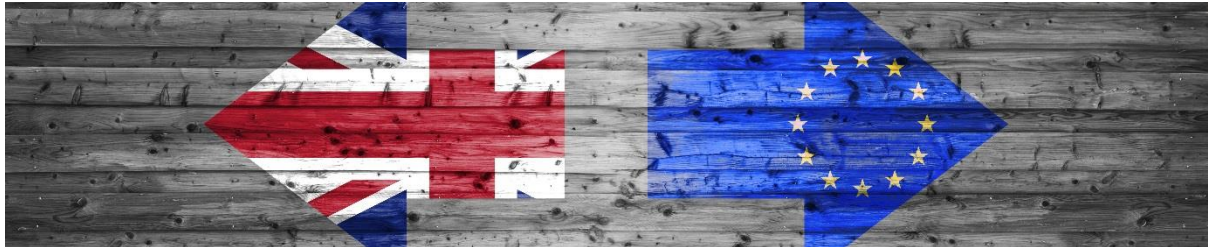


BREXIT, TRADE MARK REGISTRATIONS & YOUR PORTFOLIO



UPDATE 8 JAN 2019

You will be aware that the UK could leave the EU in the coming months, either with a deal or potentially without a deal. The following brief points set out how this could affect your trade mark portfolio and if you have any questions, please do not hesitate to contact us.

NATIONAL TRADE MARK REGISTRATIONS

- Only EU trade mark registrations will be affected. UK national trade mark registrations, or national registrations of other countries, are not affected and therefore if your trade mark portfolio only consists of such registrations, it will not be impacted.

EU TRADE MARK REGISTRATIONS

- When the UK leaves the EU, EU trade mark registrations will no longer cover the UK. There are **two scenarios** when this may happen:-
 - 1) **If a deal is not reached** with the European Union, this will occur on **29 March 2019**.
 - 2) **If a deal is reached** with the European Union, the Withdrawal Agreement currently sets out there will be a transition period (when everything will remain as is) until **31 December 2020**, before the UK leaves.
- Regardless of which scenario happens, the outcome in respect of your existing EU trade mark applications should remain the same. The wording of the Withdrawal Agreement has provisions setting out how UK rights under existing EU trade mark applications and registrations are to be treated, and the UK Government issued a Technical Notice on 28 September 2018 confirming that whether an agreement is reached or not, it intends to apply the provisions of the agreement.
- An existing EU Trade Mark registration will no longer cover the UK from the date of exit of the UK from the EU. A holder of such a registration will not lose its rights in the UK, however, as the UK Government will create a cloned UK trade mark registration from the EU trade mark registration. This will occur automatically and without cost and will mirror the details, including filing, priority, seniority and renewal dates of the existing EU registration. Murgitroyd will likewise create a separate record for the cloned UK registration and monitor its renewal deadline separately. We will send you notification of the details of the cloned UK registration and it will be reflected in any schedule we forward you after Brexit.

EUROPEAN PATENT AND TRADE MARK ATTORNEYS

- Likewise, an existing EU trade mark application will no longer cover the UK from the date of exit of the UK from the EU. However, **it will not lead to an automatic UK cloned application being created**. Instead, the Applicant will have a **nine month period** to file a new UK application, bearing the cost themselves and claiming cloned rights from the existing EU trade mark. No notification will be sent to applicants of the deadline to request such a cloned UK application. Murgitroyd will, for all EU applications we are responsible for at the date of exit, enter the nine month diary date on our system to ensure it is monitored and will write to you to advise of the deadline to file for a cloned application and seek your instructions as to whether one should be sought.
- Given that an EU application filed now will not secure registration prior to 29 March 2019, we recommend you file a UK application and then an EU application (bearing in mind you can take advantage of the six month priority period for new marks to file the EU application) when looking to undertake new filings.

USE OF A TRADE MARK TO SUPPORT AN EU REGISTRATION

- Please also note that after the UK exits the EU, use of a trade mark in the UK will not going forward in the long term be able to support an EU trade mark registration which is over five years old. If you therefore only trade under the mark in the UK, the EU trade mark registration could become vulnerable to cancellation by a third party for non-use. Commencing use in other EU territories such as Ireland or Germany, would remove this risk, or you could file a new EU application if it remains of interest. If this is of concern, please get in touch to discuss further.

FURTHER INFORMATION

- Further information is available on our website, murgitroyd.com, and we are happy to answer any queries you may have.

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