

# Trade Marks – Brexit FAQs

**At the moment, no-one can be certain about the effect of Brexit on trade marks or the transitional arrangements that will be put in place. However, we set out below a series of FAQs relating to Brexit which are aimed at relaying what the current thinking in the relevant circles in the UK appears to be on a number of different issues of importance to clients.**



**Simon Bentley**  
Partner, London  
simon.bentley@abelimray.com

## **Will I have to file separate EU and UK applications after Brexit?**

The answer to that is almost certainly yes, unless the UK and the EU agree a common trade mark system covering both areas which seems unlikely at the moment.

## **What will happen to my existing EUTM registrations?**

The discussion over the last few months has not been about whether EUTM registrations will be transferred to the UK register but about the mechanics of achieving that aim. CITMA, the UK's trade mark professional body has been in discussions with the UK minister for IP and the following two options appear to be the most favoured (details in this – [link](#))

- + The “Montenegro” option – this is where all EUTM Registrations (please see the question below regarding pending Applications) would be automatically transferred onto the UK register without the owner having to file an official form to request transfer or pay any official fee. The transfer would allow the owner to retain the original filing date and, where appropriate, the original priority date.
- + The “Tuvalu” option – Existing EU Registrations would be transferred to the UK register but only if the owner makes a request within a certain timeframe and perhaps pays an official fee.

CITMA and all of the IP owners' organisations we are aware of are firmly in favour of the Montenegro option and it appears that such an arrangement may well be the UKIPO's favoured approach because it is administratively much simpler. It is also to be noted that the European Commission's Position Paper on Intellectual Property: [here](#) also advocates the administratively simple and cost-free transfer of EUTMs onto the UK register.

It is also expected but cannot be guaranteed that it will be possible to “resurrect” lapsed UK Registrations for which seniority claims have been accepted at the EUIPO.

## **What will happen if my EU application is pending or opposed when Brexit takes place?**

Although there is as yet no certainty about this issue, it appears that the UK is considering a position whereby pending EU applications (and, accordingly, any opposition proceedings relating to pending applications) remain with the EUIPO until the final determination of the EU application, with marks which achieve registration at the EUIPO then being transferred to the UK register as described above. There would also be the possibility of conversion into a UK application for an EUTM application which fails on account of earlier rights or inherent grounds which do not apply in the UK.

It is not yet known how the EUIPO would handle an opposition against an EU Application based solely on a UK right but we currently envisage that the EUIPO would terminate any pending opposition proceedings in those circumstances at the time of Brexit. The Opponent in these circumstances would presumably be able to (continue to) take action against a corresponding UK “child” Application or Registration which derived from the parent EU Application.

### **What will happen if my EU registration is facing a cancellation action when Brexit takes place?**

It is likely that any EUTM registration which is subject to cancellation proceedings before the EUIPO at the date of Brexit would be put on the UK register but marked to indicate that the fate of the UK registration is tied to EUIPO proceedings. If the ‘parent’ EUTM registration is subsequently cancelled on the grounds of non-use, then it is expected that the UK registration will also be automatically revoked. If the EUTM is cancelled for descriptiveness, lack of distinctiveness or conflict with an earlier right, then the UK ‘child’ registration would also be cancelled, but it is thought that there would be a possibility of conversion of the lost EU registration into a UK national application where the reason(s) for cancellation of the ‘parent’ EUTM did not apply in the UK.

As with pending opposition proceedings, it is not yet known how the EUIPO would handle cancellation proceedings brought against an EUTM Registration based solely on a UK right

but we currently envisage that EUIPO would terminate any cancellation proceedings in those circumstances at the time of Brexit. The Cancellation Applicant in these circumstances would presumably be able to (continue to) take action against a corresponding UK “child” Application or Registration which derived from the parent EU Registration.

### **Should I be filing separate UK applications now?**

We do not currently advise that clients file separate UK applications in addition to new EU applications as a blanket policy. However, there may be a justification for seeking separate registration in the UK for certain marks where, for example, one or more of the following factors apply:

- + the mark is of particular importance, i.e. it is the house mark
- + the UK represents a major part of the European market under the mark
- + it is likely that the mark will need to be enforced in the UK against third parties
- + the mark is currently only protected as an EUTM and is registered with the UK customs authorities to track counterfeit goods coming into the UK market
- + the mark is protected in the EU and is not used in the UK but where you still have an intention to use in the UK in the future

### **If my Registration is more than 5 years old, will I be able to rely on EU use to support a UK Registration and UK use to support an EU Registration?**

Assuming automatic transfer of EU marks onto the UK register takes place, there are clearly issues to be addressed concerning use of a mark. CITMA is arguing for the following solution to apply in the UK which seems to us to strike a reasonable compromise between owners of marks and third parties:

All newly created UK ‘child’ registrations would become vulnerable to a non-use cancellation action five years after the registration date of the ‘parent’ EUTM registration, i.e. not five years from the date of transfer to the UK register. To the extent that any relevant period for proving genuine use of a registration is prior to the date of Brexit, use of the mark anywhere in the EU should be acceptable to the UKIPO for the purposes of proving use during that period. After the date of Brexit only use in the UK would be valid.

To give an example, let’s assume that an EUTM achieved registration on 31 January 2017 and Brexit takes place on 29 March 2019. The date on which the UK ‘child’ Registration would become vulnerable to revocation would be 1 February 2022, i.e. after five years have elapsed following the date on which the ‘parent’ EU Registration was placed on the EU register. In the event that a party sought revocation of the UK Registration in this scenario on 1 February 2022, the owner of the mark would be able to rely on EU-wide use

#### **London**

20 St. Andrew Street  
EC4A 3AG, UK  
T +44(0)20 7242 9984  
F +44(0)20 7242 9989

#### **Cardiff**

3 Assembly Square  
Britannia Quay  
CF10 4PL, UK  
T +44(0)29 2089 4200  
F +44(0)29 2089 4201

#### **Bath**

Westpoint Building  
James Street West  
BA1 2DA, UK  
T +44(0)1225 469 914  
F +44(0)1225 338 098

during the period from 31 January 2017 to 29 March 2019 but only on UK use in the period after Brexit.

Unfortunately, it is not known at the moment how the EUIPO will handle matters in analogous circumstances, e.g. where the use being relied on to support an EU registration relates to the UK. It is hoped that the EUIPO will take into account use of an EUTM in the UK in the period prior to Brexit but that cannot be guaranteed.

In many cases, it will be advisable to ensure that marks are adequately protected by filing new applications and we can advise further on any given set of circumstances.

### **I have claimed the seniority of my UK registrations for my corresponding EU registrations. Should I let my UK registrations lapse?**

At the moment, we recommend that UK registrations for which seniority claims have been made and accepted at the EUIPO be maintained. That is because of the uncertainties surrounding the possibility of resurrecting lapsed UK registrations post-Brexit.

### **Will Abel & Imray continue to represent me before the EUIPO after Brexit?**

Yes, absolutely. We have already taken steps to ensure that we will be able to act before the EUIPO irrespective of what arrangements apply as between the EU and the UK after Brexit. In particular, two of our partners are qualified in Ireland in addition to the UK and we will be setting up a new office in the EU before Brexit takes place. Representation before the European Patent Office (the "EPO") will remain unaffected by Brexit.

### **What should I do about agreements and licences involving EU marks?**

Many clients will have trade mark agreements, including co-existence agreements, and/or licences having effect in the EU. Similarly, clients may have been involved in litigation relating to EU marks which gave rise to court orders and/or settlement agreements having effect in the EU.

It is advisable to review such agreements, orders and licences to determine whether they now need to be amended and/or supplemented to continue to give effect to the will of the parties and/or the courts. If you have any queries in this respect, please do not hesitate to let us know.

We also recommend that any agreements or licences made from now on are drafted in such a way as to cover not only Brexit but also the possibility of new member states acceding to the EU and/or other existing member states leaving in the future.

The team at Abel & Imray will keep you informed as developments emerge. Please do not hesitate to contact us for more information.