



Brexit trade mark Q&A

What does Brexit mean for my clients' EU registration?

Nothing changes until March 2019. Up until that point, your clients' EU registration provides them with the same protection in the United Kingdom as it always has done. After March 2019, we are confident that there will be a mechanism to convert protection afforded under the EU system in to UK national protection. The exact nature of the mechanism and any associated official fee is currently known.

What does the Brexit vote mean for my clients pending EU applications?

This is arguably an area of greater uncertainty, as it is not yet known what will happen to EU applications which are still pending at the point when the UK formally leaves the EU. However, bar an opposition, any EU applications currently pending should be granted well in advance of March 2019.

If the UK market is particularly important to your clients, it may be beneficial to consider filing a standalone national UK application or adding the UK to any Madrid application filed. For clients who want to mirror their EU protection with a national UK application, we have a flat fee charging rate for Brexit applications and you should ask your regular contact for further details.

We would stress, that this duplication should not be necessary but if your clients are particularly cautious, it is an option we can assist with.

I am not even sure our clients operate in the UK?

If your clients have an EU registration but no specific interest in the UK marketplace, then arguably they are not affected by the decision of the UK to leave the EU.

Our clients have an EU registration but only sells in the UK – what now?

We are confident that there will be a mechanism to convert protection afforded under the EU system in to UK national protection. If your clients are using the mark in the UK, then their ongoing use in the UK, will support the validity of the 'new' UK mark.

The potential vulnerability occurs to the remaining EU registration, if the registration is more than five years old. In this scenario, the remaining EU registration could be vulnerable to a non-use challenge. Best practice is to have conversations with your clients now to understand the geographic scope of their use in Europe. We generally advise that use in three EU member states is needed to prevent a non-use cancellation action of an EU registration being successful.

What are the countries currently covered by an EU trade mark?

The EUTM member states: are Austria, Belgium, Bulgaria, Croatia, Republic of Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the UK.

However the scope of the EU application also extends to: Åland Islands, Martinique, Guadeloupe (included St. Barthélemy and French part of Saint-Martin), French Guiana, Réunion, Azores, Madeira, Ceuta and Melilla, the Canary Islands, and Gibraltar, the Isle of Man, and Jersey.

Extension of an EU trade mark is automatic in the Falkland Islands where the mark is also registered in the UK.

After Brexit, my clients are likely to have an interest in mainland Europe and the UK – what is the best approach to protect the brand?

In this instance, separate EU and UK applications would be needed. This could either be through national filings before the EU and UK Offices, or through the designation of the EU and UK under the Madrid system. We can of course continue to support your clients' EU and UK filings.

Do I need an EU/UK trade mark watching service?

Neither the EUIPO nor the UKIPO conduct examination on relative grounds as is the case before the USPTO. Consequently, it has always been our recommendation for clients to operate a watching service before the EU and UKIPO. This recommendation does not change.

Does this have any impact on my Community registered designs (CRD)?

Yes, the effect will be the same as for the EUTM, in that a mechanism will be needed to protect the UK portion of the CRD. Fortunately, UK law already provides for a national UK registered design (UKRD) regime which mirrors the RCD regime in all substantive areas including both the requirements for validity and the rules for infringement.

Does this have any impact on unregistered designs (UCD)?

Yes and the situation is likely to be complex. For instance, UCD protects the appearance of the whole or a part of a product (so 2D or 3D designs) whereas UK unregistered design protection (UKUDR) only protects shape/configuration excluding surface decoration (so effectively only 3D designs). The validity requirements for UCD are that the design must be novel and have individual character over prior designs, whereas for UKUDR the design must be original (i.e. not copied) and not commonplace. Added to that, the rights exist for different time periods. Matter specific advice should be sought.

Does this have any impact on the Unitary Patent Court?

No, this was always outside the remit of the European IPO.