

EU and UK Trademarks and Designs If There's No Brexit Deal

February 7, 2019

The validity of EU trademark registrations in the UK after Brexit remains uncertain as negotiations continue. Trademark owners understandably are fearful that their EU trademarks will no longer be recognized in the UK when the UK officially withdraws from the EU. While policy-makers continue to deliberate, however, the UK government is preparing for a “no deal” scenario. To help provide some guidance on the impact of a “no deal” situation to EU trademark holders, the UK government recently issued updated official guidance entitled “Trade marks and designs if there's no Brexit deal,” which provides some assurances to trademark holders that their trademark assets will remain protected.

For background, a business, organization or individual that owns an EU trademark registration (EUTM) or registered Community Design currently has that right protected across all EU member states including the UK. If the UK withdraws from the EU, the question remains: will an EU trademark or design registration remain valid in the UK, or should a rights holder consider making new UK trademark filings, and, if so, when?

In relevant part, the latest UK governmental guidance provides that owners of an existing EU trademark or design registration will have a new UK “equivalent right” granted that will come into force at the point of the UK's exit from the EU. The UK is promising to provide the “equivalent right” with “minimal administrative burden,” and the resulting UK-specific rights will then be treated as if they had been applied-for and registered under UK law. This means that the new UK equivalent right (i) will be subject to renewal in the UK; (ii) can form the basis for proceedings before the UK Courts and the Intellectual Property Office's Tribunal; and (iii) can be assigned and licensed independently from the EU right. Under this guidance, registered right holders will be notified that the new UK equivalent right has been granted, but can opt out if they do not wish to retain the new UK equivalent right.

With respect to pending EU trademark and design applications, the guidance provides that after exit, the applicant of the pending EU application will have a period of nine months from the date of exit to refile with the UK Intellectual Property Office under the same terms (i.e. retaining the date of the EU application for priority purposes) for a UK equivalent right, using the normal application process in the UK. Applicants with pending applications for an EU trademark or a design will **not** be notified, and after exit will need to consider whether they should refile with the UK Intellectual Property Office to obtain protection in the UK.

Trademark owners should note that the guidance is merely just that, and is not yet law. The specific details of any transfer from current EU trademarks into the new UK “equivalent right” are still not official. While it is difficult to envision a situation where no equivalent right will be available even if there is a “hard exit,” EU trademark owners concerned about the protection and enforceability of their trademark rights in the UK should continue to watch the Brexit negotiations very closely. We at NGE continue to closely monitor the situation.



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