

Brexit & Trade marks:

Our handy guide in the event of a “no-deal” Brexit and how we can help

We know that extended Brexit debate and negotiations can be unsettling for our UK and international clients and colleagues and we have produced this handy guide to reassure you of the facts.

Non-UK agents can contact john.austin-brooks@abelimray.com to request a Word version of this guide to use with their client communications

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Existing rights

What you have	What you want	What to know and how we can help
<p>We have an existing EUTM (EU trade mark) Registration</p>	<p>Not to lose our rights in the UK</p>	<p>Do not worry as the UK will unilaterally create new UK registrations with exactly the same details, including the same filing date and, where appropriate, the same international priority date. Your EUTM will continue to be protected in the remaining 27 Member States of the EU (“EU27”).</p> <p>There is no official fee to pay for this new UK registration and no official form.</p> <p>The new UK registration will have the following number in the UK:</p> <p>UK009[+ last eight digits of the EUTM number]</p> <p>As an example, EUTM No 17998701 will give rise to the new UK00917995701</p>
<p>We have an existing UK registration</p>	<p>Not to lose our rights in the UK</p>	<p>Do not worry as Brexit will not affect UK TM registrations. Be aware, however, that after Brexit you will not be able to oppose an EUTM application on the basis of an UK right (see below).</p> <p>If you would like to discuss seeking protection in the EU or elsewhere, please let us know. After Brexit, we will continue to act before both the UKIPO and the EUIPO.</p>
<p>We have an existing EU designation under an International Trade Mark Registration filed under the Madrid Protocol</p>	<p>Not to lose our rights in the UK</p>	<p>Do not worry as the UKIPO will create national UK registrations (not new UK designations) corresponding to EU designations under Madrid.</p> <p>The number allocated to new UK trade mark registrations will be as follows: The last eight digits of the International Registration number prefixed with UK008. E.g. IR 917273 will become UK00800917273 in the UK</p>

		If it is desired to keep all rights under the umbrella of the International Registration, the resulting UK registration can then be replaced by a subsequent UK designation.
We have an existing UK designation under an International Trade Mark Registration filed under the Madrid Protocol	Not to lose our rights in the UK	Do not worry as these rights will remain in place and are not affected by Brexit.
An EU registration which is due for renewal after Brexit	To know whether I will have to renew the new UK registration separately.	Yes, it will be necessary to pay the renewal fee for the new UK registration which is due for renewal after Brexit even if you have paid the EU renewal fee before Brexit. The UK has said that it will not charge any additional “late” fee in the first six months after Brexit for the renewal of any new UK registration
An EU registration which was due for renewal before Brexit but where we have not paid the renewal fee	To know whether paying the renewal fee and the official surcharge for late payment to the EUIPO will effectively renew the new UK registration	Yes, once the corresponding EUTM registration has been renewed, that will automatically renew the new UK registration.

Pending applications

What you have	What you want	What to know and how we can help
<p>We have a pending EUTM application which is unlikely to reach registration before Brexit</p>	<p>We want to register our mark in the UK and preferably with rights back to the filing date of the EU application</p>	<p>Do not worry. You have time to plan.</p> <p>Whenever Brexit takes place, you will have a nine-month period following Brexit to file a new UK application with exactly the same details as the corresponding EUTM application. The new UK Application will have the same filing date and, where appropriate, the same international priority date.</p> <p>The UK will not remind you so you need to ensure that you take action before the end of the nine-month period.</p> <p>For marks where we are the responsible Attorneys for the EU application we will contact you with further details.</p>

Ongoing proceedings commenced before Brexit

What you have	What you want	What to know and how we can help
<p>An opposition against an EUTM application based solely on a UK registration</p>	<p>To know what will happen</p>	<p>After Brexit, it will not be possible to oppose an EU application on the sole basis of a UK right and pending oppositions based on solely on UK rights will be dismissed by the EUIPO. They are currently being suspended to see when Brexit will take place.</p> <p>If you are concerned by a lack of protection for your marks outside the UK, please contact us to discuss your options.</p>

<p>An opposition against a UK Application based solely on an EU registration</p>	<p>To know what you will happen</p>	<p>Do not worry as the UKIPO has advised that it will be possible to continue with the opposition against the UK application on the basis of the new corresponding UK registration created after Brexit. The same will apply in principle to an opposition based on an EU application but remember that you will need to file for a new UK application corresponding to the EU application in the nine months after Brexit (please see above).</p>
<p>An opposition against a UK application based on an EUTM which is outside the grace period but which has only been used outside the UK</p>	<p>To know whether I can rely on my use in the rest of the EU in UK opposition proceedings after Brexit.</p>	<p>Yes, it will be possible to rely on your use in the rest of the EU in UK oppositions in the first five years after Brexit.</p> <p><i>To give an example.</i> You have opposed a UK application filed in 2018 on the basis of an old EUTM and you have only used the mark in Germany, Austria and the Benelux in the period 2013 to 2018. In the UK opposition proceedings you will be able to rely on that use outside the UK on the basis that it was relevant use at the relevant time.</p> <p>Be aware, however, that as we approach the end of the five-year period after Brexit, the weight of use outside the UK will begin to diminish. After more than five years have elapsed from the date of Brexit, use outside of the UK is unlikely to be considered as genuine use in UK proceedings.</p>

Future proceedings commenced after Brexit has taken place

What you have	What you want	What to know and how we can help
An EU registration but no UK registration	To know whether I can oppose a UK application on the basis of my EU registration	<p>No. You will only be able to oppose in the UK on the basis of a right having effect in the UK – either a UK registration or application or a UK designation</p> <p>Please discuss with us seeking protection of your marks in the UK.</p>
A UK registration but no EU registration	To know whether I can oppose an EU application on the basis of my UK registration	<p>No. You will only be able to oppose an EU application on the basis of a right having effect in the EU. UK rights will no longer have effect in the EU after Brexit.</p> <p>Please discuss with us seeking protection of your marks in the EU and elsewhere. After Brexit and whatever happens, we will continue to act directly before the EUIPO for our clients.</p>

How we can help

Our team of experienced trade mark attorneys, includes members who are European and Chartered UK trade mark attorneys, and registered trade mark agents in Ireland. We work with and protect the intellectual property for numerous brands around the world. The team is jointly led by partners Caroline Brooks and Simon Bentley.



Caroline has experience of advising clients of all sizes on both domestic and international trade mark matters. Caroline has been recognised as one of the IP Stars of 2018, 2017 and 2016 by Managing IP, and has been described as *"An absolute pleasure to work with - very attentive and accommodating to client's needs and strategies when it comes to IP filings, searches and oppositions"* (Legal 500).

Caroline manages several extensive worldwide trade mark portfolios, and has considerable experience of obtaining and enforcing trade mark rights in a variety of jurisdictions. She has an excellent track record of obtaining good commercial outcomes for her clients in disputes without recourse to expensive legal proceedings. Caroline regularly deals with the UK, European Union, International and foreign trade mark systems, and also advises on domain names, design rights, copyright and passing off issues. She is fluent in French and has some knowledge of Japanese and German.

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Simon is experienced in all aspects of trade mark work and advises frequently on contentious issues, including domain name and company name disputes, being described as *"technically supreme and an encyclopaedia of trademark knowledge"* (World Trade Mark Review) and *"particularly strong on contentious matters"* (Legal 500).

He has a wealth of experience in acting before the EUIPO since the very early days of the EUTM system. He will continue to practise before the EUIPO after Brexit from our Spanish office on the basis of his Irish nationality and Irish qualifications. Simon has lectured on trade mark and design matters both in the UK and abroad in recent years including lectures at various International Conferences and Seminars of the Chartered Institute of Trade Mark Attorneys (CITMA). He was for a number of years elected to and served on the Council of CITMA and was previously the chair of both its Designs and PR & Communications Committees.

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