

Brexit planning

Trade Marks

July 2020

Brexit: Trade Mark Checklist

United Kingdom, July 2020

This article pulls together the implications for trade mark owners now that the UK has left the EU. We run through the scenarios for EU Trade Mark Applications, EU Trade Mark Registrations and IRs designating the EU, and provide practical guidance in the tables, below. This includes practical issues for trade mark owners.

The EU Commission Draft text of the Agreement on the New Partnership between the EU and the UK dated 18 March 2020 includes under Title IX Intellectual Property a section on trade marks. However, these do not appear to result in changes to previous guidance on trade mark protection post Brexit.

Key Facts

On Exit Day (31 December 2020, 11 p.m. UK time), all EU primary and secondary legislation will cease to bind the UK.

Some EU law has been incorporated in UK law (European Union (Withdrawal) Act 2018):

- UK statutes implementing EU law will remain in effect unless amended or repealed by S.I. or primary legislation (e.g. the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019).
- The UK must continue to follow CJEU or UK court/ tribunal decisions on the interpretation of EU law made prior to Exit Day.
- The UK may continue to take into account CJEU decisions on the interpretation of EU law made after Exit Day.

EU Trade Marks and International Registrations designating the EU

[EU Trade Mark Registrations and registered International Registrations designating the EU – Automatic Cloning on Exit Day](#)

On Exit Day, EU Trade Mark Registrations and IRs designating the EU will no longer cover the territory of the UK and related territories such as Gibraltar. The remainder of the EU Trade Mark Registration/EU designation retains its full protection for the rest of the European Union.

In the UK, a new so-called UK comparable trade mark registration comes into existence on Exit Day. This will happen automatically and at no cost to the rights holder. This mark is identical to the EU trade mark registration/EU designation but limited to the UK territory.

The UK comparable trade mark registration is treated as if the trade mark had originally been filed as a UK trade mark.

Trade mark owners who do not wish to retain trade mark protection in the UK via the UK comparable trade mark may be able to opt out of UK trade mark protection.

UK businesses can continue to seek EU Trade Mark protection by filing new EUTMs and IRs and non-UK businesses can continue to seek UK domestic trade mark protection by filing a new UK national application.

[EU Trade Mark Applications and pending International Registrations designating the EU – New applications required post Exit Day](#)

On Exit Day, EU Trade Mark Applications and pending EU designations will no longer cover the territory of the UK. The remainder of the EU Trade Mark Application/pending EU designation will proceed in relation to the territory of the remainder of the European Union.

If trade mark protection is required in the UK, then a new UK trade mark application can be filed with the UK Intellectual Property Office (UKIPO). Provided that this trade mark application is filed within nine months of Exit Day and is identical to the EU Trade Mark Application/EU designation, it is possible to claim the priority/filing date of the (corresponding) EU Trade Mark Application/EU designation. UK application fees will be payable.

[International Trade Mark Applications based on EU Trade Marks](#)

From Exit Day, UK businesses and individuals will no longer be able to base new International Registrations on EU Trade Marks unless they have a domicile or a real and effective industrial or commercial establishment in an EU Member State. However, WIPO Information Notice 02/2020 confirms that all pending and existing IRs based on EU Trade Marks will maintain the EUIPO as Office of Origin where the holder is UK based (https://www.wipo.int/edocs/madrdocs/en/2020/madrid_2020_2.pdf).

Existing Trade Mark Registrations and UK comparable trade mark

	EU Trade Mark Registration/ IR designating the EU – Registered designation (EU designation)	UK comparable trade mark	UK Trade Mark Registrations (no change unless set out below)	Check list – consider prior to Exit Day
On Exit Day		<p>A new UK national trade mark registration comes into existence ("UK comparable trade mark"). This registration replicates the rights the EU trade mark (EUTM or EU designation) used to have in the UK and it is treated as if it had been applied for and registered under UK law.</p> <p>The UK comparable trade mark will be independent from the original EU right (it can be challenged, assigned, licensed, renewed separately).</p>		
Territorial scope of protection	Protection in the EU27 only. Protection for the territory of the UK and related UK territories (e.g. Gibraltar) will cease.	<p>Protection is for the territory of the UK, only.</p> <p>It does not automatically extend to Gibraltar.</p>		Check whether protection in Gibraltar is required.
Law governing ownership of trade mark	EU Trade Mark Registration will be governed by Spanish law if the owner of the mark is not based in an EU member state	Ownership of the new UK national trade mark registration will be governed by UK law.		Check whether change in the law governing ownership of the EU Registration requires action.
Priority/UK seniority	UK seniority will fall away	<p>The mark will retain its EU priority/ filing date and/or UK seniority date/claim.</p> <p>The original UK trade mark/IR designating the UK on which the seniority claim was based will not be revived.</p>		
Intent to use requirements	None.	Arguably, the UK comparable trade mark may be treated as if the trade mark owner had declared an intention to use the mark when it was filed.		Check that an intention to use the mark in the UK exists for all goods/ services.
Formalities	None	No formalities for the trade mark owner known at this stage; the UK right will be created automatically. Notifications will be sent to EUTM owners advising them of the cloned UK right.		
Fees	None	None		
Proof of trade mark registration	EU Trade Mark Registration Certificate	None. Details of the mark will be accessible on the UKIPO database in due course.		
Opt-out options		<p>It is possible for trade mark owners to opt out of owning a UK comparable trade mark. Opt out is only possible after Exit Day.</p> <p>The UK comparable trade mark will be treated as if it had never been filed or registered under UK law.</p> <p>Opt out is not available</p> <ul style="list-style-type: none"> – if the mark has been used in the UK; – if the mark is subject to an assignment/ licence / agreement; – if the mark is subject to litigation. 		Review agreements to ensure that there are no limitations on ownership of a UK trade mark.

	EU Trade Mark Registration/ IR designating the EU – Registered designation (EU designation)	UK comparable trade mark	UK Trade Mark Registrations (no change unless set out below)	Check list – consider prior to Exit Day
Renewal	Renewal fees paid <i>prior</i> to Exit Day will only cover the UK comparable trade mark if the renewal date pre-dates Exit Day.	If the EU TM renewal date falls <i>after</i> Exit Day then the renewal fee has to be paid to the UKIPO. The UK comparable trade mark retains the renewal date of the corresponding EU Registration but fees have to be paid separately for the EU Registration (to the EUIPO) and for the UK comparable trade mark (to the UKIPO).		Ensure renewal fees are paid to the correct Office.
Licences, Security interests, assignments		Licences, security interests, assignments will be treated as if they applied to the UK comparable trade mark and retain their legal effect in the UK. Trade mark owners may have to inform licensees of the UK comparable trade mark. Licences/security interests registered with the EUIPO are not automatically registered with the UKIPO. Such transactions must be registered within <i>12 months of Exit Day</i> .		Check whether any EU rights are affected by licences, security interests, assignments. Inform licensees of potential UK comparable trade mark.
Earlier Rights	From Exit Day, EU rights can <i>no longer</i> be enforced against UK rights. From Exit Day, UK rights can <i>no longer</i> be enforced against EU rights.	UK comparative trade marks cannot be enforced against EU rights.		
Use requirement Reputation	Use of the EU trade mark/EU designation in the UK prior to Exit Day may count as use in the EU. It is expected that the significance of this use will gradually decrease from potentially sufficient to entirely irrelevant, depending on the extent to which it covers the relevant five year period. Relevance of use in the UK is a question that will ultimately have to be decided by the CJEU. From Exit Day, use in the UK (and outside the EU) will no longer be taken into account. Reputation of the EU trade mark/EU designation in the UK may be taken into account up until Exit Day, but not post Exit Day.	Use of the corresponding EU trade mark/EU designation in the EU <i>prior</i> to Exit Day counts as use of the UK comparable trade mark. <i>Post</i> Exit Day, use in the EU (and outside the UK) will no longer be taken into account. Equally, reputation of the corresponding EU trade mark/EU designation will be taken into account up until Exit Day but not post Exit Day.		
Cancellation proceedings	Pending EU cancellation proceedings which are based on earlier UK rights, only, will be dismissed. We understand that this is being challenged and are monitoring the situation. Each party will be ordered to pay their own costs.	EU cancellation actions pending on Exit Day may have to be re-filed in the UK against the UK comparable trade mark. In the Withdrawal Agreement, the UK accepted that cancellation decisions would be honoured but reserved its right to divert from this rule if the ground for cancellation did not apply to the UK.	UK cancellation actions based on earlier EU registered rights will continue. The law applicable prior to Exit Day applies. – but actions/remedies taken or granted will only apply to the 'cloned' UK registration/designation.	Consider whether pending EU cancellation actions may have to be re-filed in the UK.

	EU Trade Mark Registration/ IR designating the EU – Registered designation (EU designation)	UK comparable trade mark	UK Trade Mark Registrations (no change unless set out below)	Check list – consider prior to Exit Day
Pan-EU Injunctions	From 1 January 2021, pan-EU injunctions will only apply to the EU territory (not in the UK).	After 1 January 2021, any EU-wide injunctions will not apply to the comparable trade mark UK.		
Exhaustion of rights	Goods placed on the UK market may not be considered exhausted in the EEA. There may be restrictions on parallel import of goods from the UK into the EEA. Businesses are advised to check with EU right holders to confirm whether permission is needed.	For an interim period, the UK will continue to recognise the EEA exhaustion regime. Goods placed on the EEA market will continue to be considered exhausted in the UK: – no change to rules affecting imports into the UK; and – parallel imports of goods can continue from the EEA.		Check whether permission of EU right holders is required to export goods from the UK to the EEA post Exit Day.
EUIPO remains Office of Origin for existing IRs based on EUTMs	EUTM continues to function as a base for existing IRs for entities/individuals based in the EU as well as for UK entities/individuals not otherwise based in the EU			Check representation before the EUIPO if the EUIPO is Office of Origin and documents in support of an IR are due to be filed through the EUIPO as Office of Origin
EUTM base for IR after Exit Day	After Exit Day, EUTMs can only function as base registration for IRs if the owner of the EUTM is based in the EU			Check whether UK TM filing is in place to serve as IR base if required

Pending Trade Mark Applications

	EU Trade Mark Application / IR designating the EU – pending designation (EU designation)	UK comparable trade mark	UK Trade Mark Application (no change unless set out below)	Check list – consider prior to Exit Day
On Exit Day	EUTM/IR application continues to apply to the EU27. The EU Trade Mark Application/EU designation will no longer extend to the UK and its related territories.			
Action to be taken		A new UK trade mark application has to be filed. Details of the UK trade mark application (mark, ownership, goods/services) must match those of the corresponding EU trade mark application to qualify for the earlier filing date.		Consider whether new UK trade marks will have to be filed that correspond to EU trade mark application/pending EU designation.
Timing	None	Within nine months of exit day		
Fees	None.	Usual UK Trade Mark filing fees: £170 online filing fee for one class (electronic filing) £50 each additional class		
Priority UK seniority	UK seniority cannot be claimed / will fall away.	The new filing claiming 'priority' from an EUTM application it will retain its EU priority/filing date and/or UK seniority date/claim. The original UK trade mark/ IR designating the UK on which the seniority claim was based will not be revived.		

	EU Trade Mark Application / IR designating the EU – pending designation (EU designation)	UK comparable trade mark	UK Trade Mark Application (no change unless set out below)	Check list – consider prior to Exit Day
Intent to use requirements	None.	Under UK law, any trade mark applicant has to declare their intent to use the mark in the UK in respect of all goods and services covered by the application.		
Examination		The application will be examined as if it had been filed as a UK domestic trade mark application.		
Opposition proceedings	<p>Pending opposition proceedings which are only based on earlier UK rights may be dismissed. We understand that this is being challenged and are monitoring the situation.</p> <p>If the pending opposition is dismissed, each party will likely be ordered to pay their own costs.</p>	Pending EU opposition proceedings based on earlier UK rights only may have to be re-filed in the UK.	Pending opposition proceedings based on earlier EU trade mark registrations/ EU designations will continue to be heard in line with the law applicable prior to Exit Day – but actions/ remedies taken or granted will only apply to the 'cloned' UK mark.	
EUIPO remains Office of Origin for IRs based on EUTMs	EUTM continues to function as a base for IRs for entities/individuals based in the EU as well as for UK entities/ individuals not otherwise based in the EU			Check representation before the EUIPO if the EUIPO is Office of Origin and documents in support of an IR are due to be filed through the EUIPO as Office of Origin
EUTM base for IR after Exit Day	After Exit Day, EUTMs can only function as base registration for IRs if the owner of the EUTM is based in the EU			Check whether UK TM filing is in place to serve as IR base if required

Key Contacts



Alex Vowinckel

Senior Associate
(Qualified in Germany)
T +44 20 7067 3799
E alex.vowinckel@cms-cmno.com



Louise Gellman

Partner
T +44 20 7524 6193
E louise.gellman@cms-cmno.com



Sarah Wright

Partner
T +44 20 7067 3217
E sarah.wright@cms-cmno.com



Law . Tax

Your free online legal information service.

A subscription service for legal articles
on a variety of topics delivered by email.

www.cms-lawnow.com

CMS Legal Services EEIG (CMS EEIG) is a European Economic Interest Grouping that coordinates an organisation of independent law firms. CMS EEIG provides no client services. Such services are solely provided by CMS EEIG's member firms in their respective jurisdictions. CMS EEIG and each of its member firms are separate and legally distinct entities, and no such entity has any authority to bind any other. CMS EEIG and each member firm are liable only for their own acts or omissions and not those of each other. The brand name "CMS" and the term "firm" are used to refer to some or all of the member firms or their offices.

CMS locations:

Aberdeen, Algiers, Amsterdam, Antwerp, Barcelona, Beijing, Belgrade, Berlin, Bogotá, Bratislava, Bristol, Brussels, Bucharest, Budapest, Casablanca, Cologne, Dubai, Dusseldorf, Edinburgh, Frankfurt, Funchal, Geneva, Glasgow, Hamburg, Hong Kong, Istanbul, Johannesburg, Kyiv, Leipzig, Lima, Lisbon, Ljubljana, London, Luanda, Luxembourg, Lyon, Madrid, Manchester, Mexico City, Milan, Mombasa, Monaco, Moscow, Munich, Muscat, Nairobi, Paris, Podgorica, Poznan, Prague, Reading, Rio de Janeiro, Riyadh, Rome, Santiago de Chile, Sarajevo, Seville, Shanghai, Sheffield, Singapore, Skopje, Sofia, Strasbourg, Stuttgart, Tirana, Utrecht, Vienna, Warsaw, Zagreb and Zurich.

The content in this document is for general purposes and guidance only. It does not constitute legal or professional advice and should not be relied on or treated as a substitute for specific advice relevant to particular circumstances. For legal advice, please contact your main contact partner at the relevant CMS member firm.

cms.law