EU & UK Trademarks

Navigating the changing landscape post-Brexit

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As of January 31, 2020, the UK is no longer a part of the EU. What does this mean for companies with trademark registrations (patents are not affected) designating the EU but not the UK separately?

- There will be a transition period starting Jan. 31, 2020 and ending December 31, 2020, which could be extended by agreement. During this transition period, EU rules and laws will still apply in the UK, and trademark rights will remain in place in the UK also.
- After the transition period, owners of registered trademark rights in the EU will be automatically granted a corresponding registration in the UK, at no cost.
- Renewal dates will remain the same, and filing priority and seniority dates will also remain the same, all relying on the original corresponding dates in the EU registration.
- EU trademarks that have acquired a "reputation" (similar to "fame" under US trademark law) in the EU will no longer be able to enforce such rights in the UK without a showing of reputation in the UK specifically.
- Pending EU applications will NOT be granted a corresponding UK application. Applicants will have nine months to file an application in the UK, but may use their priority date from their EU application.
- It seems probable that International Registrations (filed through WIPO, under the Madrid Protocol) will be afforded protection in the UK and that the same provisions for EU registrations will apply.
- Representation, Pending Court Proceedings and Cancellation Proceedings may all continue in their current jurisdictions.

ACTION ITEMS:

Owners of Trademark Registrations in the EU but not the UK

- No action is necessary, unless the use of the mark is in the EU but not the UK. In that case, even though the UK will automatically grant a corresponding UK registration, that registration, if it is more than five years old, will be vulnerable to a nonuse cancellation action in the UK. In such cases, a corresponding application should be filed in the UK.

Owners of Pending Trademark Applications in the EU but not the UK

- Owner must file an application in the UK, but may use their EU priority date.

Questions? Contact Sean Detweiler.