



Brexit Guidelines: your Trade Marks and Designs after the transition period

Following the withdrawal of the United Kingdom from the European Union, European Union Trade Marks (EUTMs) and Registered Community Designs (RCDs) no longer extend to the UK, but new national UK rights have been created.

EU trade mark and design law has ceased to apply in the UK but none of these changes will affect our ability at Maucher Jenkins to handle your European IP matters. We understand that you may still have questions and concerns and have addressed some of the most commonly asked questions below.

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Why Maucher Jenkins?

Maucher Jenkins is an Anglo-German firm with offices in the UK since 1937 and Germany since 1933. Over the years, we have grown these offices with a strong contingent of experienced British and German IP lawyers and attorneys and Registered European Lawyers (RELS). As a result, we are uniquely placed to offer our clients swift, responsive and fully tailored IP legal services in two of the most important jurisdictions in Europe.

Automatic comparable UK rights after 1 January 2021

All holders of EUTMs and RCDs registered before 1 January 2021 will automatically obtain a comparable UK registration ("UK comparable rights").

Each UK comparable right will:

- Is automatically recorded on the UK trade mark or designs register;
- has the same legal status as if you had applied for and registered it under UK law;
- keeps the original EUTM or RCD filing date;
- keeps the original priority or UK seniority dates; and
- is a standalone right, meaning it can be challenged, assigned, licenced and renewed separately.

UK registration certificates will not be issued but details about the UK comparable rights are available on the UK IPO website. We have created new records for these rights in our system and provide full details to clients.

How much will the automatic UK comparable right cost?

There are no fees for the creation of these new comparable UK registrations.

Can I opt out of owning an automatic UK comparable right?

Yes, it is possible for EUTM or RCD owners to opt out of owning a UK comparable right. This is primarily of interest where there is an agreement for co-use in different territories.

The opt-out option is **not** available if you have used your trade mark in the UK or your trade mark or registered design is subject to a licence/assignment/agreement or litigation.

We advise checking any IP-related agreements you may have to ensure that there are no provisions which would affect or limit your ability to obtain and hold UK registered rights for a particular brand or a design.

We would be happy to assist with this process. Please contact your usual attorney at Maucher Jenkins to discuss.

I have recorded licenses and security interests on my EUTMs or RCDs – what do I need to do?

Any licences, security interests and assignments currently recorded against EU rights are treated as if they apply to the UK comparable rights and retain their legal effect in the UK. However, any licences or security interests registered with the EUIPO will not be automatically registered with the UKIPO.

Please contact our team to find out more about how we can ensure that licenses and security interests are correctly recorded for your equivalent UK rights.

Does the UK comparable right extend to related UK territories?

No. The scope of protection is for the UK only so if you require protection in a related UK territory (for example, Gibraltar or the Channel Islands) please contact our team.

My EUTM claims seniority from a UK application. Will this date be retained?

No. All existing registered EUTMs are still valid in the remaining 27 EU countries after the Brexit transition period has ended but any UK seniority claimed for EUTM registrations and International Registrations designating the EU will no longer apply.

Do UK comparable registrations retain EU priority dates, filing dates and/or UK seniority dates?

Yes. Any EU priority/filing dates and/or UK seniority dates are retained by UK comparable rights. The original UKTM (or IR designating the UK) on which a seniority claim was based will not, however, be revived.

Are UK comparable trade mark registrations subject to use requirements?

A registered UKTM must genuinely be used in the UK for the registered goods and services. It may otherwise become vulnerable to non-use revocation by third parties for the goods and services for which it has not been used. If a UK registered mark is not used in the UK within 5 years of registration, or falls from use in the UK for a period of 5 years, it may become vulnerable to attack on those grounds.

However, for UK comparable registrations, use of the mark anywhere in the EU before 1 January 2021 will count as use of the UK comparable right for the purposes of proving genuine use. We therefore recommend that you keep records of any use of the mark in the EU as evidence should it become necessary to defend your new UK comparable registration from a third-party challenge.

My EU application is still pending - do I need to reapply in the UK?

If your application was still pending on 31 December 2020, you are entitled to file a corresponding UK application up until the end of **September 2021**.

This new UK application will retain the filing date of the EU application (and priority date if applicable). If you have requested deferred publication of your RCD, you can request deferred publication of the

UK application for up to 12 months from the UK filing date or the until the publication of the RCD, whichever expires first.

The cost of preparing and filing an application for a UK trade mark or design depends on the number of classes or designs. We offer discounted fees for filing multiple applications at the same time.

We can assist you in identifying applications that need to be re-filed in the UK and in getting any such replacement applications on file before the deadline.

Can I still enforce my EUTM rights against UKTM rights now that the transition period has ended?

No. EUTM rights can no longer be enforced against UKTM rights.

There is an exception, though, for proceedings commenced before the end of the transitional period. In those cases, courts in the UK can still issue decisions based on EUTM rights and issue EU-wide injunctions even after the end of the transition period.

Can I still enforce my UKTM rights or UK comparable TM rights against EU rights now that the transition period has ended?

No. UK rights or UK comparable rights cannot be enforced against EU rights. This is no more than a continuation of the status quo as UK national registrations have never been enforceable beyond the UK.

When do I have to renew my comparable right if the last renewal date fell before the end of the transition period?

If the renewal date fell **before** the end of the transition period (for example, a renewal at the EUIPO was due in June 2020) and the renewal fee was paid on time, then the comparable UK right does not need separate payment and retains the same 2020 renewal date.

However, if the renewal date falls **after** 31 December 2020, then the renewal fee for the UK comparable right also has to be paid to the UKIPO and a separate renewal fee for the EU registration will have to be paid to the EUIPO. This is the case even where the EU Renewal payment was made before 31 December 2020.

We will ensure that our clients are kept up-to-date and timely reminders are given for those portfolios where Maucher Jenkins handles the renewals.

How does Brexit change rights of representation and the capacity to act?

Any natural or legal person (including those having their domicile or principal place of business outside the EEA) can own an EUTM or RCD or file an application for an EUTM or RCD, request the renewal and pay the corresponding fee. No representation is needed.

However, as from 1 January 2021, owners of registered EUTMs and RCDs based in the UK (or another country outside the EEA) need to be represented by an EEA representative if their right is, or becomes,

the subject of proceedings (such as a revocation, invalidity or a register procedure) before the EUIPO. Only IP right holders domiciled outside the EU/EEA will be invited by EUIPO to appoint a representative, and only when such a need actually occurs.

Who can represent parties before EUIPO now?

From 1 January 2021, many UK attorneys and legal representatives will lose their capacity to represent parties before EUIPO. As an Anglo-German firm with professionals based and qualified in the EU, we have a continuing right to practice before the EUIPO, and are therefore well-equipped to continue to represent you in all EUIPO proceedings.

Please get in touch

We look forward to continuing to help you protect, defend and enforce your IP rights in the UK, Germany, the EU and beyond.

We would be delighted to assist you with any further questions you may have regarding your European IP matters, the impact of Brexit and representation of your EUTMs and RCDs and of your UK comparable registrations and replacement applications.

Please do not hesitate to contact us for further information:

Contact us >