

Brexit – What to do before March 29, 2019

Hopefully the UK and the EU will agree on a reasonable divorce settlement by the deadline of March 29, 2019. But if they do not, there will be a “No Deal Brexit” and the UK will simply cease to be a part of the EU as of that date. There are several things EUTM holders can be doing prior to that date to save costs and simplify procedures.

As regards EUTM trademark rights, the UK and the EU have spent the last year or so negotiating a very sensible draft procedure whereby EUTM registrations will - automatically and at no cost - generate a corresponding UKTM. UKIPO, the UK trademark authority, has published on January 17, 2019 a contingency plan in the event of a “No Deal Brexit”. Happily for trademark owners, this contingency plan continues the spirit of the negotiated draft, but basically pulls it forward to March 29, 2019.

According to this contingency plan:

1. All EUTMs registered by March 29, 2019 will automatically generate a new UKTM for free. The trademark owner can opt out of this
2. All EUTM applications still pending at March 29, 2019 can be refiled as UKTM applications until December 29, 2019 claiming the priority date of the EUTM. National application fees will apply.
3. Pending cases continue based on amended rights, if necessary (more information will come before March 29, 2019)
4. Representatives of pending cases can continue the representation of that case

Things to do before March 29, 2019:

1. Renewals: EUTMs can be renewed up to six months prior to the renewal date. That means you can advantageously renew EUTM registrations through September 29, 2019, and avoid having to renew a separate UKTM registration
2. Windup any pending oppositions by March 29, 2019 if possible to avoid costly amendments
3. And of course, register any marks if there is some technical issue holding them up. This is in particularly relevant for pending RCDs (see below).

The contingency plan will be fleshed out in the coming weeks. In particular it will be interesting to learn about pending oppositions against EUTM applications – will the opponent have to lodge a new UK opposition against the applicant's new UKTM application? What if the opposition against the EUTM is based only on UK rights?

Representation before the EUIPO and the UKIPO

The issue of whether UK attorneys can continue to represent clients before the EUIPO and whether EU attorneys can continue to represent clients before the UKIPO has not been worked out entirely. One thing the EU and the UK have agreed on thus far is that current representatives can continue representation of the case. For instance a UK representative who lodged an opposition can continue to represent the opponent after Brexit in that case. If there is a “No Deal Brexit” it is highly unlikely that UK representatives will be able to represent clients in new EUTM applications or oppositions.

Registered Community Designs and a No Deal Brexit

For RCDs (Registered Community Designs, the functional equivalent of the Design Patent in the U.S.), basically the same rules would apply in a No Deal Brexit: existing registrations will be given a free UK design right, and existing applications can be refiled as national designs by December 29, 2019. It would be advantageous to resolve any issues with pending applications in good time before March 29, 2019 such that they can be registered by then.

Read the contingency plan