

Brexit and EU trademarks and designs

Updated: January 2021

Brexit took effect on January 1, 2021 and will significantly affect portfolios of EU trademarks and designs going forward. This article addresses the practicalities of Brexit, and outlines what EUTM and RCD holders should be aware of. The following subjects are addressed:

1. Brexit and EUTM Registrations
2. Brexit and EUTM Applications
3. Brexit and EUTM and UKTM Renewals
4. Brexit and EUTM Conflicts
5. Brexit and IR designations of the EUTM
6. Brexit and RCDs

1. BREXIT AND EUTM REGISTRATIONS

All holders of an EUTM automatically received a free, cloned UKTM on January 1, 2021. The UKTM has the same filing and renewal dates, related registration number (starting with "UK009"). NJORD will remain the attorney of record of the UKTM for at least three years, presumably indefinitely. Brexit and EUTM Registrations are easy.

Examples of new numbering	
Existing EU trade mark	Comparable UK trade mark
000000977	UK00900000977
000025197	UK00900025197
000340513	UK00900340513
017867542	UK00917867542

2. BREXIT AND EUTM APPLICATIONS

For all EUTM applications pending as at January 1, 2021, the applicant has the option to reapply for an UKTM, keeping the same prior dates. The UK application will have to be filed within 9 months, that is, by September 30, 2021. NJORD will be able to file the UK application and keep it combined with the EUTM for renewals and maintenance.

Brexit and EUTM Applications are relatively easy, although not as easy as Brexit and EUTM Registrations. Our fees are competitive and will be GBP 150 at least until September 30, 2021. The official fees are GBP 170, so the total cost for filing will be GBP 320, currently about US\$ 425. Additional classes cost GBP 50 (we do not charge class fees).

3. BREXIT AND RENEWALS

As from January 1, 2021, owners of an EUTM registration automatically received a free, corresponding UKTM with the same renewal deadline as the EUTM.

NJORD Law Firm has been practicing before the UKIPO for many years, and will continue to represent clients there for at least the next three years, presumably indefinitely. This includes renewals. We offer a combined EUTM + UKTM renewal with a single invoice and a 10% volume discount.

Classes	Official fees EUTM (EUR)	Official fees UKTM (£)	Attorneys fees (EUR)	Total in EUR	Approx. US\$
1	850	200	450	1525	1820
2	900	250	450	1635	1940
3	1050	300	450	1845	2190
4	1200	350	450	2055	2440

Brexit means that renewals are more expensive due to the extra official fees, but in reality Brexit and EUTM/UKTM renewals can be easy.

4. BREXIT AND EUTM CONFLICTS

Brexit will mean that existing EUTM conflicts might have to be opened under a parallel UK proceedings. There are the following scenarios

1. EUTM opposition against us as applicant
2. EUTM opposition lodged by us as opponent
3. EUTM cancellation action against our EUTM registration
4. EUTM cancellation lodged by us

4.1 EUTM OPPOSITION AGAINST US AS APPLICANT

If the UK is important for the client, we will have to file a new UKTM application by September 30, 2021, preserving the EUTM filing date. Our UKTM application will be processed and published for opposition, and the opponent will have to lodge an opposition against this UKTM application in order to preserve their rights. Note that if the EUTM opposition is based only on UK rights, the opposition against our EUTM will cease.

4.2 EUTM OPPOSITION LODGED BY US AS OPPONENT

Here the counterparty will have to file a new UKTM application by September 30, 2021. We will have to watch for this, and lodge an opposition against this UKTM application in order to preserve our rights.

4.3 EUTM CANCELLATION ACTION AGAINST OUR EUTM REGISTRATION

As per the Withdrawal Agreement Act, the UKIPO will honour the result of a cancellation action on the comparable right. The cancellation will only have effect if the grounds are applicable in the UK. We will check each individual cancellation action to see if the grounds are applicable in the UK.

4.4 EUTM CANCELLATION LODGED BY US

As per the Withdrawal Agreement Act, the UKIPO will honour the result of a cancellation action on the comparable right. This means that we will not need to launch a separate cancellation action on the comparable right after 1 January 2021. The cancellation will only have effect if the grounds are applicable in the UK.

5. BREXIT AND IR DESIGNATIONS OF THE EUTM

In a perfect world, an EU designation would automatically hatch a UK designation within the IR and that would be that. But this is not a perfect world and so what will happen is that owners of an IR with an EU designation, where the Statement of Grant of Protection has issued, have received a new UKTM registration as of January 1, 2021. This UKTM registration has the same dates as the EU designation, and will have the same number, with the prefix of UK008. For EU designations where the Statement of Grant of Protection has not been granted, the owner has to file a new UKTM application. This will have to be done by September 30, 2021 in order to keep the filing date of the EU designation. We can file this UKTM for you (cost is 320 GBP, about US\$ 425).

Clients can either stop there, with an IR and a UKTM registration to manage, or you can make a new UK designation within the IR, and then we can file a form to record the replacement of the UKTM. That way your client ends up with only the IR to manage going forward.

NJORD Law Firm will take over the attorneyship of any of these new UKTM registrations free of charge.

6. BREXIT AND RCDS

The basics of Brexit and the EUTM outlined above also apply to Registered Community Designs RCDs. There will be free, cloned UKRD. NJORD will be able to renew these together with the RCD. The re-registered UKRD will have the same number, prefaced with "900"

Examples:

Examples of new numbering:	
Existing RCD number	Re-registered UK design number
004048098-0004	90040480980004
000000021-0001	90000000210001

7. HELPFUL LINKS

EU Commission:

WITHDRAWAL OF THE UNITED KINGDOM AND EU RULES IN THE FIELD OF EUROPEAN UNION TRADE MARKS AND COMMUNITY DESIGNS
UKIPO:

Guidance: EU trade mark protection and comparable UK trade marks from 1 January 2021

Guidance: International EU protected designs after 1 January 2021

Guidance: Changes to international trade mark registrations after 1 January 2021

Guidance: Changes to EU and international designs and trade mark protection from 1 January 2021

Guidance: Intellectual property after 1 January 2021

WIPO:

No deal brexit explainer

Form: Application to record a concurrent registration

INTA:

INTA's Brexit Brands Toolkit

INTA Brexit Task Force Analyzes Drafts of EU-UK Future Relationship

IPKat:

UK IPO Brexit Transition Guidance declares business as usual for IP, for now...