

Brexit: Trade Mark Checklist

UPDATED (22 January 2020): if the Withdrawal Bill is passed in the UK and the Withdrawal Agreement entered into between the UK and EU, the various changes detailed below will take place at the end of the implementation period (currently expected to be 31 December 2020) – not at the end of January 2020.

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”).</p> <p>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, licenced, renewed separately).</p>		31 December 2020
Territorial scope of protection	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.

	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
Priority / UK seniority	UK seniority will fall away.	The mark will retain its EU priority/ filing date and/or UK seniority date. The original UK trade mark / IR designating the UK on which the seniority claim was based will not be revived.		
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.		
Fees	None.	None.		
Proof of trade mark registration	EU Trade Mark Registration Certificate	None. Details of the mark are accessible on the UKIPO database.		

	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
Opt-out option		<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.
Renewal	Renewal fees paid prior to Exit Day will only cover the UK comparable trade mark if the renewal date pre-dates Exit Day.	<p>If the renewal date falls after Exit Day then the renewal fee has to be paid to the UKIPO.</p> <p>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).</p>		Ensure renewal fees are paid to the correct Office.

	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
Licences, Security interests, assignments		<p>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.</p> <p><i>Trade mark owners have to inform licensees of the UK comparable trade mark.</i></p> <p>Licences/ security interests registered with the EUIPO are <i>not automatically registered</i> with the UKIPO.</p> <p>Such transactions must be registered within <i>12 months of Exit day.</i></p>		<p>Check whether any EU rights are affected by licences, security interests, assignments.</p> <p>Inform licensees of potential UK comparable trade mark.</p>
Earlier Rights	<p>From Exit Day, EU rights can <i>no longer</i> be enforced against UK rights.</p> <p>From Exit Day, UK rights can <i>no longer</i> be enforced against EU rights.</p>	UK comparative trade marks cannot be enforced against EU rights.		

	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
Use requirement Reputation	<p>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 period. Relevance of use in the UK is a question that will ultimately have to be decided by the CJEU.</p> <p>From Exit day, use in the UK (and outside the EU) will no longer be taken into account.</p> <p>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.</p>	<p>Use of the corresponding EU trade mark/ EU designation in the EU prior to Exit day counts as use of the UK comparable trade mark.</p> <p>From Exit day, use in the EU (and outside the UK) will no longer be taken into account.</p> <p>Reputation of the corresponding EU trade mark/ EU designation will be taken into account up until Exit day but not post Exit day.</p>		

	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
Cancellation proceedings	<p>Pending EU cancellation proceedings which are based on earlier UK rights, only, will be dismissed.</p> <p>Each party will be ordered to pay their own costs.</p>	EU cancellation actions pending on Exit day will have to be re-filed in the UK against the UK comparable trade mark.	UK cancellation actions based on earlier EU registered rights will continue. The law applicable prior to Exit day applies.	Consider whether pending EU cancellation actions will have to be re-filed in the UK.
Pan-EU injunctions	New pan-EU injunctions will only apply to the EU territory (not in the UK).	Pan-EU injunctions existing on Exit day will be treated as if they applied to the comparable UK trade mark.		
Exhaustion of rights	<p>Goods placed on the UK market may not be considered exhausted in the EEA.</p> <p>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.</p>	<p>In the event of a no-deal Brexit and 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:</p> <ul style="list-style-type: none"> - no change to rules affecting imports into the UK; - 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.

	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
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	The EU Trade Mark Application/ EU designation will no longer extend to the UK and its related territories.			31 December 2020
Action to be taken		<i>A new UK trade mark application has to be filed.</i> 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.	<i>Within 9 months of exit day</i>		
Fees	None.	Usual UK Trade Mark filing fees: £170 online filing fee for one class [electronic filing] £50 each additional class		

	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
Priority / UK seniority	UK seniority cannot be claimed / will fall away.	The mark it will retain its EU priority/ filing date and/or UK seniority date. The original UK trade mark/ IR designating the UK on which the seniority claim was based will not be revived.		
Intent to use requirement	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 & 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	Pending opposition proceedings which are only based on earlier UK rights will be dismissed. Each party will be ordered to pay their own costs.	Pending EU opposition proceedings based on earlier UK rights, only will 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.	

	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
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.