



## Brexit: trade mark update

 by **Ferosa-Fae Hassan**

Regular readers will recall our recent ENSight where we reported that a draft agreement had been published which, to a degree, addressed the uncertainty trade mark owners are facing about the impact of Brexit on their trade mark rights. We said that while it had been agreed that Brexit will be implemented in a manner that preserves trade mark rights, discussions on the charges and administrative procedures for the creation of a corresponding UK right were ongoing.

The United Kingdom Intellectual Property Office (“UKIPO”) has now provided some clarity on how EU trade mark registrations will be treated when the UK leaves the EU. This guidance covers the following two scenarios:

- **Conclusion of a withdrawal agreement**

In the event that the UK and EU enter into a withdrawal agreement, the UKIPO update says that all existing EU trade mark registrations will enjoy continued protection as the UK leaves the EU. This will be achieved by the creation of over 1.7-million comparable UK rights, which will be granted **automatically** and at **no charge** to the trade mark holder.

- **No withdrawal agreement**

In the event that the governments do not conclude a withdrawal agreement prior to the UK’s exit, the UKIPO’s guidance says that the UK Government will seek to “minimise disruption for business and to provide for a smooth transition”. This seems to show that that the government’s objective is to ensure continued protection of trade mark rights. However, the specific mechanics and costs on how this would be achieved are uncertain at this point.

In light of these recent developments, we encourage trade mark owners to renew their existing EU trade mark registrations so as to allow for continued protection in the UK post-Brexit.

Because the current update makes no mention on pending trade mark applications, the position in the draft agreement still stands: trade marks that are pending registration at the end of the transitional period (31 December 2020) will be protected in the remaining 27 EU member countries only. However, the trade mark applicant will be entitled to file a corresponding application in the UK within nine months of the end of the transitional period (by 30 September 2021), which will be deemed to have the same filing date as the EU application. Again, discussions are ongoing regarding the procedure and costs associated with this.

It is vital for trade mark owners who conduct business in the EU to reevaluate their present and future activities in the UK. In view of the most recent developments, those who want to protect their trade marks in both the EU and a post-Brexit UK may, at this stage, consider filing their trade marks in the EU only, since it is more than likely that these applications will proceed to registration before the end of the transitional period (if no oppositions are encountered). However, because there still is much uncertainty on how trade marks will be treated post-Brexit and whether or not a withdrawal agreement will be concluded, the cautious approach would be to file a separate national trade mark application in the UK. As we mentioned before, the approach taken will have to be evaluated on a case-by-case basis, dependent on business strategy, budget and level of prudence.

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