

EU Trade Marks & Brexit



The UK left the EU on the 31 January 2020 and entered the Transition Period. The Transition Period ended on 31 December 2020.



What happened to my registered EUTM when the Transition Period ended?

On 1 January 2021, the UK Intellectual Property Office (UKIPO) automatically created a comparable UK trademark for every registered EUTM. Each comparable UK trademark:

- is recorded on the UK trade mark register;
- has the same legal status as if it had originally been applied for and registered with the UKIPO;
- has the original EUTM filing date;
- has the original priority or UK seniority dates; and
- is a fully independent UK trade mark that can be challenged, assigned, licensed or renewed separately from the original EUTM.

There was no payment for the comparable UK trade mark. UK registration certificates are no longer given but you can access details about the trade mark on UKIPO website: <https://www.gov.uk/search-for-trademark>

What are the similarities/differences between a EUTM and the comparable UK trade mark?

Renewal fees/dates – Each of the EUTM and the new comparable UKTM has their own separate renewal fees and the renewal dates correspond. You are required to pay renewal fees for both the EUTM and the UKTM.

Priority/seniority – A priority date claimed under the Paris Convention that is recorded against the corresponding EUTM is inherited by the comparable UK trade mark. As with any seniority claim.

Use and reputation – Any use of the mark in the EU made before 1 January 2021, whether inside or outside the UK, counts as use of the comparable UK right.

Licences & Securities – Any licence or security interest that refers to a EUTM and authorises acts in the UK is treated as if it applies to the comparable UKTM.

Let us Introduce Ourselves



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Assignment – Where a EUTM has been the subject of an assignment before 1 January 2021, that was not recorded in the EUTM register, the comparable UKTM will be granted to the assignor. The assignor or the assignee has the right after 1 January 2021, to apply for the registration of the comparable UKTM in the name of the assignee.

Jurisdiction & Injunctions – As the UK is no longer under the jurisdiction of the EU legal system governing trade marks, any EU-wide injunctions do not apply to the comparable UKTM. However, where an injunction was in place on 1 January 2021, prohibiting actions in the UK which would infringe an existing EUTM, the terms of that injunction are treated as if they also apply to the comparable UKTM.

Representation – UK based professional representatives are no longer able to act for clients before the EUIPO. Therefore, any EUTM holders who had a UK based professional representative will need to appoint a new EU based professional representative.