

Brexit, Schmexit: How Resilient is Your Trademark Portfolio and Enforcement Strategy?

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On January 31, 2020, the United Kingdom (UK) withdrew from the European Union (EU).

From February 1, 2020, to December 31, 2020, the UK and EU are in a "Transition Period," where there will be no change to the process of obtaining EU trade marks (EUTMs) or design marks (collectively, "trademarks"), nor will respective UK and EU laws affect the resulting

protection of European trademarks in the United Kingdom.

However, the Transition Period likely ends this year (unless the UK legislates to extend it). Therefore, brand owners should evaluate their long-term protection and enforcement strategies in the UK and EU.

Current EU Trademark Registrations

No action is required to obtain a UK registration based on a current EU trademark registration. Trademarks registered with the European Union Intellectual Property Office ("EUIPO") before December 31, 2020 (and that do not expire before December 31, 2020) will be imported into to the UK system and registry, providing EU trademark registrants, *unless they opt-out*, with a UK registration automatically. However, no certificates of registration will be issued for comparable UK rights without paying an additional fee. Details of the UK registrations will be available online.

EU renewals (*i.e.*, extensions of validity) filed *before* December 31, 2020, will also automatically extend to the UK registration. Thereafter, maintenance requirements for EU registrations and their UK registration counterparts must be separately handled.

Furthermore, brand owners will need to be prepared the separately monitor and enforce their EU and UK registrations and to assess any existing licenses and security interest agreements for their applicability and enforceability upon Brexit.

Current EU Trademark Applications

Unlike EU registrations, pending EU trademark applications will not be imported into the UK system or registry.

There will be a nine-month window (or until September 30, 2021) to file a UK application and claim the filing date of an identical EU application that was still pending at the end of the Transition Period.

Brand owners interested in both EU and UK protection should consider filing a separate UK application, both with pendency periods in mind and in light of other obstacles to registration that might hinder reliance on an EU application for UK protection.

International Trademark Registrations

During the Transition Period, international applications and registrations of trademarks protected via the Madrid system designating the EU will continue to extend into the UK. After the Transition Period, applicants must separately designate the UK. The World Intellectual Property Organization (WIPO) informed users that the UK has agreed to take measures to ensure international registrations will continue to extend into the UK after the Transition Period, automatically, but specific details of those measures have yet to be finalized.

.eu Domains

Business owners should remember that after the expiration of the Transition Period, .eu domains can only be held by an EU citizen or a natural person, business, or undertaking that is resident or established in the EU. It would be prudent to review domain name portfolios ahead of 2021 to ensure the necessary domains can be maintained or acquired.

Conclusion

Anyone with questions or concerns about whether the implications of BREXIT will affect their business should consider obtaining legal advice. Our IP team, with its extensive network of European and the United Kingdom associates, can help.

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