

Trademark Offices Implement New Post-Brexit EU and UK Policies for EU Trademarks

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With the United Kingdom (U.K.) finally saying, “See EU later,” the U.K. and European Union (EU) transition period following Brexit ended December 31, 2020. As such, the “Withdrawal Agreements” between the EU and U.K. will now govern the continued protection of existing EU trademark rights in the U.K.

For registration owners in the EU Intellectual Property Office (EUIPO), as of December 31, 2020, the procedure is (hopefully) relatively painless. The U.K. will automatically create a corresponding U.K. registration for each EU registration without any application procedure or fees. These corresponding U.K. registrations will keep the same filing/priority date as the original EU registration. Once issued, the U.K. corresponding registration will become an independent registration with the same status as a national U.K. registration, which can be enforced, challenged, assigned, licensed, and renewed separately from the original EU registration.

Troutman Pepper will add each of these U.K. corresponding registrations to our clients’ trademark portfolio docket so that clients will receive notices for upcoming deadlines, as well as including the registrations in portfolio reports. The Withdrawal Agreements apply assignments, licenses, security interests, and other agreements to any U.K. corresponding registration, unless evidence in the document shows that it was not intended to have effect in the U.K. As such, we advise clients to review documents to confirm they will not exclude a corresponding U.K. registration, while also amending such documents to affirmatively add them to avoid any potential ambiguity.

For owners of applications pending in the EUIPO, as of December 31, 2020, the procedure is a little more complicated. The U.K. will not create U.K. applications. Rather, a corresponding U.K. national application claiming the EU filing or priority date must be filed on or before September 30, 2021. The usual U.K. intellectual property official fees will be payable. Troutman Pepper will contact our clients shortly with existing EU applications to confirm instructions on whether to file corresponding U.K. applications based on pending EU applications. We strongly advise not to wait until the deadline to avoid examination delays.

The Withdrawal Agreements will also have an impact on the renewal of registrations, the fame, reputation, and use of a mark, as well as dispute proceedings. Troutman Pepper attorneys, in combination with EU and U.K. counsel, bring decades of experience protecting our client’s valuable trademark rights in the EU and U.K., as well as an understanding of how the Withdrawal Agreements could impact those rights. We view this as an excellent time to review your trademark portfolio with our attorneys to ensure your trademark portfolio protection aligns with your strategic business goals and plans.

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