

WHAT DOES BREXIT MEAN FOR EU TRADEMARKS?

February 2021

The Transition Period relating to the UK's exit from the European Union has ended on 31st December 2020. Thus, from the 1st of January 2021 all EU Trademarks and International Registrations designated within the EU, ceased to enjoy protection within the United Kingdom.

As of the 1st of January 2021, European Trademarks ("EUTM") will no longer protect trademarks in the UK. Under the Withdrawal Agreement Act, on the 1 January 2021, the UK Intellectual Property Office has created a comparable UK trademark ("UKTM") for all right holders with an existing EU trademark.

Existing EUTMs will still protect trademarks in all EU member states. UK businesses are still able to apply at the EU Intellectual Property Office for an EUTM. There will be no changes to UK-registered trademarks as a result of the UK leaving the EU.

On all pending EUTM applications, applicant will have the ability to register the same trademark, as a UK right, within nine months after the end of the transition period, this being up to and including **30 September 2021**.

Key points for Intellectual Property rights owners to be aware of:

- For EU trademarks and international trademarks designating EU that are registered by the 31 December 2020, no further actions are needed to be taken in respect of the extracted UK registration until the first renewal date after 31 December 2020.

At this point, payment of renewal fees in the UK Intellectual Property Office ("UK IPO") will be needed in order to preserve the extracted UK right.

- For EU trademark applications that are pending as from **31 December 2020**, owners can preserve the benefits of the application in the UK by filling up to 30 September 2021, an application to register the same mark in the UK, in respect of some or all of the same goods and services, while maintaining the same dates of filing, priority and seniority.

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- Where a new trademark registration covering the UK starting 1 January 2021, **an application should be filed for a UK national trademark**.
- As from 1 January 2021, the UK IPO created a comparable UKTM for all right holders with an existing EUTM with no additional registration fee, no assessment of absolute or relative grounds for refusal and no UK registration certificate will be issued. Details about the new UKTM will be available online on www.gov.uk/search-for-trademark.

Effects of Brexit in pending EUTM applications as at December 31, 2020

- EUTMs will not be automatically converted into national UKTMs. Filing a separate trademark application in the UK will be necessary in order to obtain trademark protection. The owner of the EUTM application will have 9 months (ending on September 30, 2021) to “opt in” for an equivalent UK application. Usual fees will be paid to the UK IPO.
- There will be no notifications of such right to “opt-in”, so this 9 month period will need to be monitored.

Renewal of EUTM and national UKTM

- Where an EUTM renewal date falls after the 31 December 2020, early payment of the renewal fee at the EU IPO will have no effect in respect of the new UK Trademark.
- The newly created UKTM will need to be renewed separately to UK IPO to enjoy protection in the UK for another 10 years.

The purpose of this legal briefing is to provide a general guideline on the subject and not to be considered, in any way, as legal advice. It is advisable to seek professional and legal advice on this subject before proceeding with any general information provided to you. For further clarifications and advice please contact us at legal@economideslegal.com.

Xenia Kasapi, LL.B., LL.M., MCI Arb
Advocate
xenia.kasapi@economideslegal.com