



Client Alert

March 11, 2019

BREXIT: How Will It Affect Your European Union Trademark or Patent?

With the BREXIT date of March 29, 2019 fast approaching, the looming question remains, of what happens if there is no agreement in place by the time the United Kingdom (UK) leaves the European Union (EU)?

For patent owners, the news is good: European patents are governed by the European Patent Convention, which is not limited to the EU, therefore, BREXIT will not affect these patent rights. Owners of national UK patents and international patent applications filed through the PCT system will remain unaffected as well.

Trademark and design patent owners, however, will be affected and should be aware of the implications of BREXIT. European Union trademarks (EUTMs) and Registered Community Designs (RCDs, which are the functional equivalent of the US Design Patent) are only valid within the EU, so after the withdrawal of the UK, they will no longer have any effect in the UK.

If a No-Deal BREXIT

Fortunately, the UK and the EU have negotiated a contingency plan in the event of a “no-deal BREXIT.” The UK Intellectual Property Office (UKIPO) has confirmed that it will provide for protections of registered IP assets in the UK through the creation of automatically generated UK trademarks (UKTMs) or designs with the same filing date as the corresponding EU right. The UKTMs or designs will be treated as though they had been applied for and registered under UK law. For example, they will be subject to renewal in the UK; can form the basis for proceedings before the UK courts and the Intellectual Property Office’s Tribunal; and may be assigned and licensed independently from the EU right. The EUTM and RCD will remain in force.

Regardless of what occurs by March 29, 2019, if an agreement with the EU is reached, or BREXIT takes place with no agreement, a UK trademark registration or design patent shall be automatically granted with minimal administrative burden as a mirror to the EUTM or RCD, ensuring that a loss of rights does not occur. EUTM or RCD rights holders can opt out of receiving a UK registered trademark or design. This applies to registrations only and not to pending applications.

Other Details to Note

EUTM and RCD rights holders will be notified that a new UK right has been granted by publishing a notification and guidance on www.gov.uk. Applicants with pending applications for EUTMs or RCDs will NOT be notified, and within nine months after exit, will need to consider whether they want to refile with the UK Intellectual Property Office to obtain protection in the UK. New applications for UKTMs or designs will be eligible to be filed in the UK, as they are currently. Provisions will be made regarding the status of legal disputes involving EUTMs or RCDs which are ongoing before the UK courts.

Next Steps

In preparation for a no-deal BREXIT on March 29, 2019, rights owners should consider renewing any eligible EUTMs or RCDs before this date, to avoid having to pay duplicate (EU and UK) fees after the exit. Registrants should also consider reviewing current and future licensing or coexistence agreements to determine whether the UK should be separately identified in the geographical scope.

If the UK and the EU are able to reach an agreement by March 29, 2019, EUTMs and RCDs will remain valid in the UK until the end of the transition period, which will end on December 31, 2020. COJK will contact you regarding the renewal of any COJK-managed EUTM or RCD that is eligible for renewal before BREXIT on March 29, 2019. If you have questions about how BREXIT affects your IP rights, please contact your COJK attorney. COJK will keep you apprised of any further developments as they become available.

This client alert is not intended to provide legal advice, and no legal or business decision should be based on its content. Questions concerning issues addressed in this client alert should be directed to an attorney.