



HIDDLESTON  
TRADE \* MARKS

# Brexit – The Implications for the UK leaving the EU

The UK formally left the EU on 31 January 2020. However, the UK and EU have ratified a Withdrawal Agreement under the terms of which there will be a transitional period currently due to expire on 31 December 2020 ("the Exit Day"), during which the UK will effectively be treated as a continuing EU Member. In other words, until the Exit Day, EUTM Applications and Registrations will continue to extend to the UK.

However, at that point, a European Union Trade Mark (EUTM) will no longer extend to the UK.

You should therefore be aware of the following:

- After 31 December 2020, the UK will automatically create a UK equivalent right to any registered European Union Trade Mark Registration or Registered Community Design retaining the same details and filing dates.
- However, in relation to pending EUTM Applications and Registered Community Design Applications, the Applicant will need to apply to register a comparable UK Trade Mark right in a 9-month priority period from the Exit Day. If such an Application is filed, the subsequent Application will retain the original filing date from the EUTM and any priority date claimed in relation to that Application. This must be for the identical Mark and goods and services identical or contained within the specification for the EUTM.

## Opting-Out

Of course, a registered proprietor of an EUTM may have entered into an agreement in return for obtaining EUTM Registration agreeing not to use or register its Mark in the UK. In these circumstances, a registered proprietor can "opt-out" of the creation of an automatic UK right but it has to file a specific request to opt-out.

Hiddleston Trade Marks  
Polhill Business Centre  
London Road | Polhill | Halstead  
Sevenoaks | Kent TN14 7AA  
United Kingdom

T | +44 (0) 1959 546 212  
F | +44 (0) 1959 532 676  
E | [info@hiddlestons.com](mailto:info@hiddlestons.com)  
[www.hiddlestons.com](http://www.hiddlestons.com)

*Cont'd over*





HIDDLESTON  
TRADE x MARKS

# Brexit – The Implications for the UK leaving the EU

## UK Registration Numbers

An automatically created UK right will retain the last 8 digits of the EUTM prefixed by UK009. For instance, an EUTM Registration No. 00340513 would be renumbered for the UK right UK00900340513.

## Seniority

Under the EUTM system, an EUTM Application or Registration can claim "Seniority" from an earlier National Registration in an EU Member State. In these circumstances, the subsequent EUTM can claim priority in relation to that country from the earlier filing date of the National Registration. Proprietors can then allow the National Registration to lapse.

As at the Exit Day, in the case of any EUTM which claims Seniority from an earlier UK Registration, the newly created UK right will retain the priority date from the earlier possibly lapsed UK Trade Mark Registration.

## Licences, Security Interests

Any licence or security interest such as a charge which has been recorded against the EUTM will automatically be recorded against the equivalent UK right. However, care should be taken that the original Licence Agreement allows for the creation of a licence in relation to the subsequent UK right. In addition, the rights afforded under UK Trade Mark Law are not directly in line with that of EUTM Registrations and care should be taken to review the Licence Agreement.

## Pending Proceedings

As at the Exit Day, any UK prior rights forming the basis of an opposition or cancellation action against an EUTM will automatically fall away. If the opposition/cancellation action is based solely upon a UK right, the proceedings will conclude. If the proceedings are based upon rights in other EU Member States, the proceedings will continue minus the UK right.

## Proof of Use

Where an opposition to an EUTM Application is based upon an EUTM Registration which is over 5 years old, the Applicant can request proof of use. If so, the opposition can only continue for those goods/services for which proof of use is provided.

In EUTM proceedings, an Opponent will be able to rely upon proof of use in the UK prior to the Exit Day. Although guidelines from the IPO indicate that the relevance of such proof of use will diminish over time in establishing the requisite proof of use across the EU.

Again, in UK opposition proceedings, the Opponent will be able to rely upon proof of use elsewhere in the EU prior to the Exit Day.

Hiddleston Trade Marks  
Polhill Business Centre  
London Road | Polhill | Halstead  
Sevenoaks | Kent TN14 7AA  
United Kingdom

T | +44 (0) 1959 546 212  
F | +44 (0) 1959 532 676  
E | [info@hiddlestons.com](mailto:info@hiddlestons.com)  
[www.hiddlestons.com](http://www.hiddlestons.com)

Cont'd



HIDDLESTON  
TRADE x MARKS

# Brexit – The Implications for the UK leaving the EU

## Reputation

In opposition proceedings in the UK and EU, it is possible to oppose an EUTM Application or UK Application on the basis that the proprietor had a reputation in the UK in relation to a UK Trade Mark Registration and the EU in relation to an EUTM Registration and use of the later Mark without due course would take unfair advantage or be detrimental to the distinctive character of the earlier Marks.

In EUTM opposition proceedings, however, the Opponent will not be able to rely upon reputation generated in the UK both before and after the Exit Day. However, in UK opposition proceedings, evidence of reputation elsewhere in the EU in relation to an opposition based upon an EUTM Registration generated prior to Exit Day will be relevant but not evidence of reputation generated after Exit Day.

## Conversion

An EUTM Registration or Application that has been refused or withdrawn may be converted into equivalent National Applications in each or some of the EU Member States retaining the original filing date. Such an Application for conversion has to be filed within 3 months of the EUTM ceasing to have effect.

As at Exit Day, therefore, there may be a small number of EUTM Registrations or Applications which will be in the 3-month period provided for the purposes of a request for conversion into a National Application including a National UK Application.

The UKIPO will not create an automatic UK right in connection with such cases. However, the Applicant can file a request for the creation of such a right as a conversion from the EUTM. Such an Application would have to be filed within the 3-month period from the date that the EUTM ceased to have effect.

## Renewal

Once a new UK right is created, a separate renewal application will in the future have to be filed to renew both the UK Trade Mark Registration separate from the existing EUTM Registration. However, since the UK right will retain the original filing date and the renewal period for both the UK and EUTM Registration is 10 years, both will retain the same renewal date.

## Trade Marks that expire before the Exit Day

Under EUIPO practice, an EUTM Registration can be renewed late during the 6-month period following the renewal date upon payment of an additional fee.

As such, in relation to EUTM Registrations which expired in the 6-month period prior to the Exit Day, the UKIPO will create an equivalent UK right but mark this as "expired".

It is important to note that if the Registered Proprietor wishes to renew the UK right, he/she will also have to renew the EUTM Registration. In these circumstances, no renewal application will need to be filed separately in relation to the UK right. However, if the renewal fees are not paid in relation to the EUTM Registration, the UK right will finally lapse.

Hiddleston Trade Marks  
Polhill Business Centre  
London Road | Polhill | Halstead  
Sevenoaks | Kent TN14 7AA  
United Kingdom

T | +44 (0) 1959 546 212  
F | +44 (0) 1959 532 676  
E | [info@hiddlestons.com](mailto:info@hiddlestons.com)  
[www.hiddlestons.com](http://www.hiddlestons.com)

Cont'd



HIDDLESTON  
TRADE ✕ MARKS

# Brexit – The Implications for the UK leaving the EU

## Other IP Rights:

### Community Design Rights

A UK Design right equivalent to a Community Design right will be automatically created as at Exit Day.

### Certification and Collective Marks

As at the Exit Day, the UKIPO will create automatically a comparable UK right to any existing EU Certification and Collective Marks.

Certification Marks provide a guarantee that goods or services bearing the Mark meet a defined standard or possess a particular characteristic. Collective Marks on the other hand indicate that the goods or services originate from a particular Association.

However, it is a requirement for the registration of both Certification and Collective Marks that the Applicant will provide governing regulations. In the case of EU Certification and Collective Marks, these may not be in English. The UKIPO, when creating the new equivalent UK right, will not automatically import onto the UK Trade Marks Register the governing regulations. However, in the event of proceedings, the UKIPO may contact the proprietor requesting a translated version of the regulations.

### Other Considerations

It is possible to obtain an EU-wide injunction to prevent the infringement of a European Union Trade Mark Registration. As at the Exit Day, where an injunction is in place based upon an existing EUTM, the terms of that injunction will be treated as if they applied to the comparable UK right.

Hiddleston Trade Marks  
Polhill Business Centre  
London Road | Polhill | Halstead  
Sevenoaks | Kent TN14 7AA  
United Kingdom

T | +44 (0) 1959 546 212  
F | +44 (0) 1959 532 676  
E | [info@hiddlestons.com](mailto:info@hiddlestons.com)  
[www.hiddlestons.com](http://www.hiddlestons.com)

Cont'd



HIDDLESTON  
TRADE \* MARKS

# Brexit – The Implications for the UK leaving the EU

## Recommendations

- It can take between 6-8 months for an EUTM Application to proceed to registration even if no official objections or oppositions are met. As such, if you are interested in obtaining protection in both the EU and UK, and do not believe that you will obtain registration as an EUTM by 31 December 2020, you should consider filing a UK Trade Mark Application. A UK Trade Mark Application can proceed to registration in about 5-6 months.
- Since use in the UK in the future will no longer protect an EUTM Registration, you should review any EUTM Registrations for which use has primarily been in the UK to see whether it is possible to expand use to other parts of the EU.
- You should check the terms of any licences or security interests recorded against the EUTM Registration to determine whether they should also be recorded against the comparable UK Registration.
- You should review on-going EUTM opposition and cancellation proceedings to consider whether any cases based solely upon UK prior rights should be expedited.
- In relation to new EUTM opposition and cancellation proceedings, consider adding other rights, apart from a UK right, as a basis of opposition.
- Consider diarising 9 months from the Exit Day to ensure all necessary EUTM Applications are re-filed in the UK.
- Check to see whether any automatically created UK rights should be surrendered after the Exit Day pursuant to the terms of any Settlement Agreement relating to the EUTM.
- Check renewal dates for EUTM Registrations which may be due within 6 months of the Exit Day. If the proprietor wishes to retain the UK right, he may need to renew the EUTM.
- Review existing Co-Existence and Settlement Agreements to see whether they are still appropriate and cover the UK. Consider jurisdiction and governing law clauses for such Agreements.
- If you own a Domain Name, consider whether these should be transferred to another entity.

*If you have any questions, please feel free to contact us either on 01959 546212 or by email at [mark.hiddleston@hiddlestons.com](mailto:mark.hiddleston@hiddlestons.com).*

Hiddleston Trade Marks  
Polhill Business Centre  
London Road | Polhill | Halstead  
Sevenoaks | Kent TN14 7AA  
United Kingdom

T | +44 (0) 1959 546 212  
F | +44 (0) 1959 532 676  
E | [info@hiddlestons.com](mailto:info@hiddlestons.com)  
[www.hiddlestons.com](http://www.hiddlestons.com)