

How Owners of a European Trademark Should Proceed to Preserve their UK Rights In View Of Brexit

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This brief article provides the basic information a European Trademark holder needs to know to protect their UK trademark rights in view of Brexit. Normally, US attorneys do not comment on foreign law because it is outside their authorization to practice. However, you may need simple clear advice, and this provides at a high level that simple clear advice.

What must you do prior to December 31, 2020, in view of Brexit, to preserve your UK rights? Nothing.

What should you do, if you have not already done so? You should engage with a UK trademark practitioner so they can represent you in the UK, to advise you on what you will have to do in the future and so the UK trademark practitioner can take those actions on your behalf to preserve your existing trademark rights in the UK.

The UK will automatically (without imposing any requirement on you) clone any European Trademark that was granted before December 31, 2020, to a UK Trademark. You do not need to immediately appoint a UK trademark attorney to preserve your trademark rights in the UK for such a granted European Trademark, but you should timely do so for the reasons noted above.

If you have a pending European Trademark Application, however, and you want to obtain a UK trademark registration, you need to have that Trademark Application re-filed in the UK, and you must have that re-filing done by September 30, 2021 if you want to retain the filing date any priority date of the pending European Trademark Application.

One of the things to watch out for is the split in annuities. For a granted European Trademark, you will have to pay Europe for the European rights, and pay the UK for the UK rights. That means you need to be aware that you will have to also pay the UK, to retain your rights in the UK.

Finally, for any new TM you want to register for Europe, you have the added complication of having to file in the UK, in case you decide you want protection in the UK, in addition to your European filing.