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# Brexit: Our handy guide to Trade Marks



# Key dates

**31 Jan  
2020**

The UK leaves the EU and will no longer take part in the running of the EU. However, it will effectively remain in the EU single market during the “transition period”.

**1 Feb  
2020**

The start of the “transition period”, during which time it will be “business as usual” for owners of EU rights. During this period, EU marks will continue to be effective in all 27 Member States of the EU and the UK and accordingly it is open to the owner of EUTMs to lodge opposition against UKTMs on the basis of EU rights and/or bring infringement proceedings based on those rights.

**31 Dec  
2020**

End of the “transition period” unless the UK and the EU agree an extension of one or two years. An extension appears unlikely at the moment in view of the UK government’s stated intention not to seek an extension, but it remains a possibility.

Assuming no extension, the UK will create new equivalent UK trade mark registrations which correspond to existing EU registrations (please see below for further details).

**1 Jan  
2021**

From this date onwards (assuming no extension to the “transition period”), marks registered or protected at the EUIPO will no longer extend to the UK.

In order to seek registration of a mark in the UK, it will be necessary to file either a UK application or designate the UK under an International Registration.

**Jan-Sept  
2021**

Again assuming no extension to the “transition period”, there will be a nine-month priority period in which owners of pending EUTM applications and designations can file for corresponding UK applications, retaining the original filing date and where appropriate, the international priority date enjoyed by the EU applications or designations.

# EU Rights after Brexit Existing Registrations

## An existing EUTM Registration

The UK will unilaterally create new UK registrations with exactly the same details, including the same filing date and, where appropriate, the same international priority date. Your EUTM will continue to be protected in the remaining 27 Member States of the EU (“EU27”).

There is no official fee to pay for this new UK registration and no official form to file. The process will be entirely automatic.

The new equivalent UK registrations derived from EUTMs filed directly at the EUIPO will have the following numbers:

**UK009[+ last eight digits of the EUTM number]**

As an example, EUTM No 17998701 will give rise to the new equivalent UK registration number UK00917995701

## An existing UK registration

Brexit will not affect UK TM registrations.

Be aware, however, that after the end of the transition period you will not be able to oppose an EUTM application on the basis of a UK right (see below for further details).

## An existing UK designation under an International Trade Mark Registration filed under the Madrid Protocol

These rights will remain in place and are not affected by Brexit.

## An existing Protected EU designation under an International Trade Mark Registration filed under the Madrid Protocol

The UK will create national UK registrations (note **not** new UK designations) corresponding to EU designations under the Madrid Protocol.

If it is desired to keep all rights under the umbrella of the International Registration, the resulting UK registration can then be replaced by a subsequent UK designation.

The new equivalent UK registrations derived from designations of the EU under International Registrations will have the following numbers:

**UK008[+ last eight digits of the EUTM number]**

As an example, International Registration (EU) No. 917273 will give rise to the new equivalent UK registration number UK00800917273

# EU Rights after Brexit

## Pending applications

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EUTM application which has not achieved registration before the end of the transition period, due to end on 31 December 2020

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At the end of the transition period, there will be a nine-month period in which to file a new UK application with exactly the same details as the corresponding EUTM application. The new UK Application will have the same filing date and, where appropriate, the same international priority date. It does not matter when the original EU application was filed or on what date within the “priority period” the new application is filed.

To give an example:

A pending EU application was filed on 1 June 2019 claiming priority from a US application filed on 1 March 2019. The UK application corresponding to the EU application is filed on 31 August 2021. In this case, the UK application will be deemed to have a filing date of 1 June 2019 and will be deemed to enjoy the international priority date of 1 March 2019.

The UK will **not** remind owners of the need to file new UK applications and, if UK protection is required, you will need to ensure that you take action before the end of the nine-month period.

Where we are the responsible Attorneys for the relevant EU applications we will contact you with further details.

# EU Rights after Brexit Renewals

## EUTMs or EU designations due for renewal **before** the end of the transition period

If the EUTM or EU designations is renewed before the end of the transition period, the first renewal date for the new equivalent UK registration will be ten years from the expiry date of the corresponding EUTM or the EU designation.

To give an example:

An EUTM is due for renewal on 31 October 2020. Assuming it is renewed, then the first renewal date for the equivalent UK registration will be 31 October 2030 and there will be no need to renew the UK registration retrospectively from 31 October 2020.

## EUTMs or EU designations due for renewal **before** the end of the transition period but where the renewal fee is paid late, after the end of the transition period

In this case, the late renewal of the corresponding EUTM registration will automatically renew the new equivalent UK registration.

To give an example:

An EUTM is due for renewal on 1 November 2020. However, the official fee (and late renewal surcharge) is only paid on 1 February 2021. In this case, the first renewal deadline for the equivalent UK registration will be 1 November 2030 and there will be no need to renew the UK registration retrospectively from 1 November 2020.

## EUTMs or EU designations due for renewal **after** the end of the transition period

In this case, it will be necessary to pay separately the renewal fee for the new UK registration, even if you have paid the EU renewal fee before the end of the transition period.

To give an example:

An EUTM is due for renewal on 1 February 2021 and the official renewal fee is paid at the EUIPO on 1 December 2020. In this case, it will be necessary to pay the renewal fee for the equivalent UK registration to enjoy further protection until 1 February 2031.

The UK has said that it will not charge any additional “late” fee in the first six months after the end of the transition period for the renewal of any new UK registration.

# EU Rights after Brexit Ongoing proceedings commenced before Brexit

## An opposition against an EUTM application based solely on a UK registration

After the end of the transition period, it will not be possible to oppose an EU application on the sole basis of a UK right and pending oppositions based on solely on UK rights will be dismissed at that time by the EUIPO.

It would be advisable depending on whether your client is the opponent or the applicant in this scenario to try, respectively, to ensure that proceedings are terminated as soon as possible or extended as long as possible.

## An opposition against a UK Application based on an EU registration or an EU designation

The UKIPO has advised that it will be possible to continue with the opposition against the UK application on the basis of the new corresponding UK registration created at the end of the transition period.

The same will apply in principle to an opposition based on a pending EU application or designation but remember that you will need to file for a new UK application corresponding to the EU application in the nine months after the end of the transition period (please see above).

## Issues relating to genuine use of an EUTM in the course of a UK opposition

In UK opposition proceedings based on an earlier right which is outside the grace period, it is open to the Applicant to request that the Opponent provide evidence of genuine use of that mark. In that case, the opposition can only proceed on the basis of those goods and services for which the Opponent can provide genuine use.

During the five years after the end of the transition period, it will be possible to rely, in UK opposition proceedings based on a new UK equivalent registration, on use in the rest of the EU which occurred before the end of the transition period.

To give an example:

An opposition is filed in February 2021 against a UK application filed in November 2020. The basis for the opposition is a new UK equivalent registration based on an existing EUTM which

had, as of November 2020, been put to genuine use in Germany, Austria and the Benelux. In the UK opposition proceedings, it will be possible to rely on the genuine use made of the mark in Germany, Austria and the Benelux in the period November 2015 to November 2020. In those circumstances, it will not be necessary to show that the mark on which the opposition is based had been used in the UK in the same period.

Be aware, however, that the ability to rely on use outside the UK will only be possible for that part of the relevant five year period which was **before** the end of the transition period. In that part of the relevant five-year period **after** the end of the transition period, only use in the UK will count.

To give an example:

An opposition is filed against a new UK application filed on 1 January 2024 based on a new equivalent UK registration which had, as of the end of the transition period only been used in Germany, Austria and the Benelux but has never been used in the UK. In these opposition proceedings, the Opponent would still be able to rely on the use of the mark in Germany, Austria and the Benelux but only in the period between 1 January 2019 and 31 December 2020, i.e. for just two years within the relevant five-year period.

It will be seen from these examples, that the further we are into the five year period after the end of the transition period, the less weight will be accorded to the use outside the UK before the end of December 2020.

# EU Rights after Brexit

## Future proceedings after the end of the transition period

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### What rights will count in UK opposition proceedings after the end of the transition period?

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For proceedings filed after 1 January 2021, it will only be possible to file an opposition against a UK application on the basis of UK rights.

The owners of EU marks should therefore ensure that their marks are adequately protected in the UK in the future.

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### What rights will count in EU opposition proceedings after the end of the transition period?

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After the end of the transition period, it will only be possible to oppose an EU application on the basis of a right having effect in the EU27. UK rights will no longer have effect in the EU after the end of the transition period.

# EU Rights after Brexit Representation

## Will Attorneys based in the EEA be able to represent clients before the UKIPO after the end of the transition period?

Yes, for the first three years after the end of the transition period, at least for the new equivalent UK rights. Where an EEA Attorney is the representative for an existing EUTM or EU designation at the end of the transition period, they will automatically be entered in the UK register as the representative for the new equivalent UK registration.

It is not yet clear what the position will be for existing UK registrations (i.e. existing registrations which are not created as equivalents to EU rights) or indeed new UK applications filed after the end of the transition period.

What happens to the rights of representation for EEA Attorneys before the UKIPO in the future is likely to depend on the future commercial relations agreed between the UK and the EU.

## Will UK firms be able to represent clients before the EU after the end of the transition period?

UK Attorneys will continue to be able to represent their client in any EUIPO proceedings which are still ongoing at the end of the transition period until those proceedings are finally determined.

In principle, UK Attorneys will not, other than in ongoing proceedings (please see above), be entitled to act before the EU after the end of the transition period. In practice, however, most UK firms, including Abel & Imray, have taken steps to establish new offices in the EU in order to be able to continue to represent clients before the EUIPO.

Please feel free to contact us if you have any questions or wish to discuss your portfolio in more detail.

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