

European Intellectual Property Rights in Transition – What You Need to Know About the Effects of Brexit

On January 1, 2021 the United Kingdom (UK) will officially leave the European Union (EU). As a result, current owners of European IP rights, in particular trademark and design rights, and those considering such rights, need to be aware of procedures that have been established for maintaining registrations and filing applications going forward. These new mechanisms for maintaining and obtaining registered trademarks and designs in the UK and the EU will impact owners, licensors and licensees. Importantly, in contrast with the impact of Brexit on trademarks and designs, Brexit will have no impact on the maintenance or filing of utility patents in Europe because, despite Brexit, the UK will remain one of the 38 member states of the European Patent Convention of 1977.

Through the end of 2020, Community Trademarks (CTMs) and Registered Community Designs (RCDs) are effective in the UK. Beginning on January 1, 2021, however, CTMs and RCDs, as well as international design applications designating the EU, and international trademark applications designating the EU, will only be enforceable in the remaining 27 EU member states.

Registered Community Trademarks and Designs

On January 1, 2021, CTMs and RCDs, including designations for trademark applications under the Madrid Protocol and design applications under the Hague Agreement, that are registered by December 31, 2020 will automatically be protected as a corresponding UK trademark registration or a UK registered design. The UK re-registrations will retain the filing date, priority date, and renewal date of the corresponding CTM and

RCD. Owners of such EU registrations do not need to take action to obtain the UK re-registrations.

Renewals of CTMs and RCDs

Renewals of CTMs and RCDs, due on or after January 1, 2021 will require separate concurrent payments in the EU and the UK. Early payments or renewal fees in the EU will not be applied towards the UK renewal fees.

Pending Trademark and Design Applications

Unlike the automatic re-registration of CTMs and RCDs, applications for CTMs and RCDs that are pending at the end of 2020 will not be automatically reproduced as UK applications. Instead, applicants with pending applications for CTMs and RCDs must file parallel UK trademark applications or design applications by September 30, 2021 in order to retain the filing date and priority date of the corresponding EU applications. The applicant must pay the UK filing fees, and the application will be examined according to UK law.

New applications filed on or after January 1, 2021

Beginning on January 1, 2021, applicants seeking design or trademark protection in both the EU and the UK must file separate applications in both jurisdictions, or file an international application separately designating the EU and the UK.

In addition to understanding the procedures that have been established for maintaining and filing trademarks and designs, Brexit presents owners, licensors and licensees of IP rights in Europe with an opportunity to review their portfolios and determine the relevance of each registered and pending trademark and design. The potential additional expenses for parallel filings and maintenance of registrations, and the actual location of users and markets may become even more significant considerations in filings and maintenance of trademarks and designs in Europe.

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