



BREXIT UPDATE: EU TRADE MARKS AND DESIGNS - LESS THAN 20 DAYS TO GO...

With less than 20 days to go until the end of the transition period (31 December 2020), and a trade deal between the European Union and United Kingdom remaining elusive, it is now urgent that EUTM and RCD owners have suitable measures in place to ensure that they are fully prepared for the transition process and have taken all appropriate steps to ensure the continued management and protection of their valuable rights in the UK, post-transition.

As a firm, we are committed to supporting brand owners (and their advisers) throughout the transition process, and in doing so, we are offering a free and simple transitional service aimed at safeguarding their EUTM and RCD rights. We are also offering substantially discounted filing fees for new UK trade mark and design applications based on EUTM applications/designations and RCDs that are currently pending and/or are pending at the end of the transition period.

EXISTING EUTM REGISTRATIONS AND RCDs ON 31 DECEMBER 2020

On 31 December 2020, all EUTM registrations and RCDs (including all granted EU designations under the Madrid Protocol or Hague Agreement) will be cloned automatically by the UKIPO¹, creating a new, independent UK trade mark registration / registered design (UK Clone), with the same filing/priority/renewal dates as its originating EUTM or RCD.

In order to help safeguard these new rights, we are offering colleagues and clients the following comprehensive transitional services, free of charge:

- Verification of the existence and accuracy of each new UK Clone at the UKIPO;
- Recordal of our firm as UKIPO representative for each new UK Clone; and
- Docketing of each new UK Clone on our trade mark and designs management system.

If, in addition, you would also like us to appoint our firm as EUIPO representative for (and docket) any originating EUTM registration or RCD, we would of course be very happy to do so at no additional charge.

In order to provide these free transitional services, we will require the following information in respect of each originating EUTM and RCD registration:

- The registration number of the originating EUTM registration, RCD or International (Madrid/Hague) registration designating the EU;
- The current expiry/renewal date of the originating EUTM registration, RCD or International (Madrid/Hague) registration designating the EU; and
- The current name and address of the registered owner.

PENDING EUTM AND RCD² APPLICATIONS ON 31 DECEMBER 2020

Owners of pending EUTM applications or designations on 1 January 2021 will have nine months to apply for a corresponding UK trade mark, using the same filing/priority date as the pending EU base application. These new UK

¹ Note that no official UKIPO fees are payable, and that if desired (for example, due to a contractual restriction/obligation), it will be possible for EUTM / RCD owners to opt out of receiving their new UK Clone.

² The same rules will apply to RCDs. However, as RCD applications are not subject to formal examination by the EUIPO, the likelihood of having numerous, pending RCD applications on expiry of the transitional period (31 December 2020) is arguably low, save where publication has been deferred.



applications will be subject to the normal UKIPO application and examination procedures, and standard UKIPO filing fees will apply.

In terms of our own fees, we are offering clients a substantial discount on our standard UK fees for filing and prosecuting new UK trade mark applications that are based on pending EUTM applications. Full details are available on request.

In order to provide these discounted filing services, we will require the following information in respect of each originating EUTM (and RCD) application:

- The application number of the originating EUTM application, RCD or International (Madrid/Hague) registration designating the EU;
- The application/priority date of the originating EUTM application, RCD or International (Madrid/Hague) registration designating the EU; and
- The current name and address of the applicant.

NEW EUTM AND RCD APPLICATIONS AFTER 31 DECEMBER 2020

After 31 December 2020, we will continue to offer and provide the full range of EUTM and RCD services, via our Madrid Office. For ease of administration and consistency of service, clients can therefore continue to retain/appoint us as their local representative before both the UKIPO and EUIPO for their trade mark and registered design matters.

NEXT STEPS

If you and/or your clients are interested in subscribing to our transitional services, please express your interest by sending a brief e-mail to us at trademarks@penningtonslaw.com.

If you have any specific questions or concerns regarding the impact of Brexit on EU or UK intellectual property rights more generally, including in relation to licensing or franchising arrangements, or IP disputes, please do not hesitate to contact a member of the team.

FIND OUT MORE

For further information, please contact:



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