



The Potential Effect of Brexit on your Trade Mark Portfolio

What Should you Consider?

Following the UK general election on 8th June 2017, formal Brexit negotiations between the UK and the EU commenced on 19th June.

While no decisions have been taken in relation to post-Brexit intellectual property, this is a sensible time to start considering the potential effect of Brexit on your trade mark portfolio.

We do not expect Brexit to have any immediate impact on domestic UK trade marks as the legislation in the UK will remain essentially unchanged.

The effect on European Union Trade Marks (EUTMs) will be more significant. Existing EUTMs will cease to have effect in the UK, although we anticipate there will be transitional provisions enabling the UK rights that derive from existing EUTMs to be preserved. The exact nature of those transitional provisions remains to be seen. New EUTMs following Brexit will not cover the UK.

However, it should be recognised that the UK continues to be a full member of the EU until Brexit, which is currently scheduled for 29th March 2019. As things stand, nothing will change until then for EUTMs.

The immediate priority for EUTM owners should be to review your portfolio. You should identify the

marks that are most significant to your UK business, for example, house marks or key brands that you use in the UK. Particular attention should be paid to marks that you already enforce in the UK or that you would seriously consider enforcing in the UK.

Once those marks have been identified, and assuming that they are only protected in the UK via EUTMs, you should consider whether to re-file those marks in the UK now. The main justification for doing so is to ensure continuity of protection and enforceability in the UK for your key brands upon Brexit. In particular, re-filing avoids uncertainty over whatever process for preserving EUTM rights in the UK is decided upon.

Having fresh UK national rights also avoids uncertainty over use requirements. For example, where a mark currently registered as an EUTM only has been used in the EU but not in the UK, there is a question whether that use will support any derivative UK rights upon Brexit. If not, this could create a cancellation risk for the derivative UK right. Again we expect transitional provisions on this point but their content is not yet known.



We also suggest that trade mark owners considering new EUTMs should consider parallel UK filings from now on.

So we are not advocating blanket re-filings or parallel new filings in the UK for all EUTMs. However, for marks that have value in the UK, re-filing or parallel new filings now are the safety first options. You should also review any agreements, such as licences and coexistence agreements, based on EUTMs or with effect in the EU to ensure that they will continue to cover the UK, if appropriate, after Brexit.

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Need advice?

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