

# Brexit - your Trade Mark checklist



It is likely to be some time before the UK clarifies what changes (if any) will be made to the practical working of its IP system, and no changes are likely to take effect soon. In the short term Boult Wade Tennant recommends taking steps to re-assess Trade Mark portfolios in light of the Brexit result, and keeping in regular touch with your usual adviser. Some of the issues that are likely to arise are discussed below.

- 1** As we write in summer 2016, there is no urgency. Remember that the UK is expected to be a member of the EU until mid-2018 at the earliest. At the moment, and until the actual leaving date [ALD] is reached, all EU rights should apply equally to the UK as to France, Germany and Italy and all other member states. Do not make hasty decisions. Different Trade Mark owners will have different needs. There is no one-size-fits-all response.
- 2** Expect that the UK will be leaving the EU, in or after 2018, unless there is a significant political change. An EUTM covers the EU, and so it will not cover the UK if the UK is not part of the EU, though we confidently expect there will be transitional processes, as discussed below. For brand new marks, when choosing how to protect yourself in the UK, from now on, do not only use pan-EU protection if the UK is particularly important to your business. Consider seeking UK national protection for fresh brands, in parallel to pan-EU protection.
- 3** If you already have an EUTM, we expect that a mechanism will be created to continue its protection in the UK as-of the EUTM's date, including preserving any priority or seniority date, after the ALD. We can speculate that this might involve one of:-
  - a.** An EUTM registration simply being deemed by the UK legislation to continue to cover the UK, with no action being required;
  - b.** Administrative re-registration of an EUTM for the UK, eg by application of a stamp or simple form, with only minor action being required;
  - c.** Conversion of an EUTM into a UK national Trade Mark, involving re-examination by the UKIPO, with significant action being required.
- 4** The UK Government has not decided which of these, or which other strategies, will be adopted, and the timing of the mechanism is also not known. A "transition date" might be set, which could be a close or a distant date; or it might be decided that a EUTM ceases to cover the UK when it is due for renewal, which will mean a gradual process.



**5** You could simply wait to see what mechanism is adopted by the UK government; or you could take pre-emptive action now to create a parallel right to your EUTM by filing a UK national Trade Mark. UK registrations are usually cost-effective and rapid, and it might be convenient to have the UK national right already registered and in place before the likely rush as the ALD approaches. This is prudent if you want to take all possible steps in advance, to limit the effect of Brexit. It will bring certainty. However, it might be a belt-and-braces, depending on how the transition mechanism works. If the UK is not a key market for you, or if you do not expect a particular mark to be relevant to your business in the near future, then a national UK registration might not be appropriate.

**6** Therefore, our recommendation is to consider the following strategies, from this point on:-

- a.** If you have UK applications as well as EUTMs, do not give up the applications: try to progress them to registration.
- b.** If you have UK registrations as well as EUTMs, do not let them lapse: renew them. Renewal is low cost.
- c.** If you have filed an EUTM in the last six months, consider filing a UK national mark claiming priority from the EUTM (if it was the mark's first filing).
- d.** If you are choosing a new mark for the business, consider filing it at the UKIPO as well as at the EUIPO.
- e.** If you are using the International Registration (Madrid Protocol), designate the UK as well as the EUTM.
- f.** If you are filing an International Registration (Madrid Protocol) as a UK-based applicant, base it on a UK national instead of on a EUTM.
- g.** If you have a .eu domain name, make sure you also have a .com or .co.uk.
- h.** If you have any agreements or licences which refer to the EU, they still cover the UK and will continue to do so for some years. At the moment, nothing has changed. However, this is a good opportunity for the parties to review the terms generally. We particularly encourage reviewing older agreements which might have been worded to include or exclude new countries joining the EU, but which might not have been worded to include or exclude countries leaving the EU.
- i.** If you have an EUTM registration which is or will soon be more than five years old, keep records of how it is being used in the marketplace and in which specific countries of the EU it is being used. Ideally, you will gather evidence of use in at least two EU countries besides the UK. Caselaw has increasingly expressed interest in EUTMs being used on a regional and ideally pan-EU level, rather than a national level, and a Brexit will reinforce this trend. Also, the time may come when evidence of use of a mark in the UK alone cannot support an EUTM registration, specifically because the UK is no longer part of the EU. If a mark has been registered as an EUTM but is only for use in eg the UK and France, therefore, we recommend considering French national protection as well as UK national protection.

**7** Discuss your IP portfolio regularly with your Boulton Tennant adviser. The law is changing, but we will be able to keep you up to date with suggestions for your personal needs.

This checklist is dated July 2016 and it will be updated regularly: please ensure you are using the latest version, which will be on our website.



This information has been prepared by Boulton Tennant.

For further information please contact your usual adviser.

Verulam Gardens  
70 Gray's Inn Road  
London WC1X 8BT  
United Kingdom

telephone  
+44 (0)20 7430 7500

facsimile  
+44 (0)20 7430 7600

email [boulton@boulton.com](mailto:boulton@boulton.com)  
website [www.boulton.com](http://www.boulton.com)

Offices also in Reading,  
Oxford, Cambridge and Munich

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