

CLIENT ALERT

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BREXIT - EUTM REGISTRATIONS AND CLONED UNITED KINGDOM REGISTRATIONS

by Steven D. Lustig

The Brexit transition period ended on December 31, 2020. As of January 1, 2021, the United Kingdom will have left the European Union trademark and design system.

Although European-wide rights such as European Trademarks (EUTMs) will now cease to have effect in the United Kingdom, identical U.K. trademark rights will be automatically created or “cloned” from corresponding European Union trademark registrations. Note, however, that U.K. rights from EUTM applications that are pending as of December 31, 2020 will not be created automatically, and the owner will need to file an application for the rights in its EUTM application to be extended to the U.K.

For registrations, this “cloning” or “comparable rights” process will be automatic – and it will be free of costs.

Cloned U.K. rights will mirror the corresponding European Union rights, to ensure continuity of protection for existing rights holders. The cloned U.K. trademark rights will therefore share the filing date, registration date, and any priority/seniority dates from the corresponding EUTMs. The goods and services covered by the U.K. trademark rights will also be identical.

On the other hand, the cloned U.K. rights will require future renewals to be filed separately from the corresponding EUTM. The U.K. Intellectual Property Office has not finalized its renewal fees for such maintenance tasks. That information is expected soon.

The cloned U.K. rights for existing International Registrations (IRs) designating the EU will similarly be independent from the international registration system and will no longer be administered by WIPO. So these too will require renewals to be filed separately from the corresponding International Registrations.

Insofar as owners of IRs designating the EU will receive cloned U.K. rights outside the scope of their Madrid registrations, owners will have a second option for maintaining their U.K. rights. Such owners may designate the U.K. in their IR, and request “replacement” of the cloned or comparable right once subsequent designation is granted. Such a “replacement” subsequent designation will still benefit from the earlier protection in the U.K. The owner of the “replacement” subsequent designation would then be able to renew through WIPO, without renewing the separate U.K. registration.

Pending EUTMs and IRs designating the EU can also receive a cloned U.K. right, but the process will require an application and will not be automatic. In order for the cloned U.K. right to share the same filing date as the EU application, the application for the cloned U.K. right must be filed by September 30, 2021.

Many United Kingdom intellectual property attorneys will be creating files for the new cloned rights if the corresponding EUTMs or IRs were handled by their offices.

If EUTMs or IRs designating the European Union have not been managed by United Kingdom intellectual property attorneys, then these registered rights will require representation by U.K. attorneys to facilitate renewals and maintenance of rights, and U.K. counsel will be required to file any new applications to clone rights in pending EU applications or IR extensions designating the EU.

ABOUT THE AUTHOR



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