

What will happen to registered EU trade mark rights after 31 December 2020?

It is important to note that as the UK leaves the European Union, EU trade marks (EUTMs) will still be valid in the other 27 member countries of the EU: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czechia, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain and Sweden.

However, the UK has entered a transition period (due to last until 31 December 2020), after which time registered EUTMs will no longer extend to the UK. These rights will be automatically 'cloned' by the UK Intellectual Property Office (UKIPO) to create equivalent UK rights which will ensure continued protection and enforceability in the UK. Trade marks will continue to be protected and enforced in the UK. Although marks will be fully independent of the EUTM, they will still retain all the same dates recorded for the EUTM, and therefore will also be valid.

That being said, trade marks are vulnerable to cancellation by third parties if they are not used within the countries in which they are registered. For EU and UK trade marks, this cancellation period is five years from when the mark was entered on the trade mark register, or for any subsequent continuous period of five years. To prove use of a trade mark, samples of the way in which a trade mark is used are needed (i.e. marketing; promotional and advertising material; copies of web pages; invoices etc.).

Following the end of the transition period, it is worth noting that use of a trade mark only in the UK will, after a period of time, no longer be sufficient to keep an EUTM registered if attacked by a third party for non-use.

Whilst UK evidence will be valid proof of use for a period of time, this will gradually be given less and less weight and will only be acknowledged to show use in the period before Brexit. After this, evidence of use in at least one of the other 27 member countries of the EU (listed above) will need to be relied upon in order to prove use in the European Union.

Once the UK part of an EU registration has been converted into a fully independent UK mark, examples of the way in which a trade mark is being used in the UK will need to be kept in order to prove use in the United Kingdom.

If you have any questions, please contact your usual Mathys & Squire adviser, or for more information on this topic, please contact brexit@mathys-squire.com.