



Cantor Colburn Client Alert

Brexit Update: Completion of United Kingdom's Exit from EU

This Client Alert updates you about the impact of Brexit on your trademark, design, and domain name registration portfolios in the European Union (EU) and the United Kingdom (UK).

As you may recall, at the beginning of 2020, the UK exited its membership in the EU. The UK is now in the final month of the Brexit transition period, which ends on December 31, 2020.

Here is what to expect as of January 1, 2021:

1. Existing EU Trademark Registrations (registered before January 1, 2021)

Your existing EUTM registrations will automatically receive from the UK Intellectual Property Office (UKIPO) a “cloned” (identical) UK trademark registration, at no cost to you. We are already coordinating with our network of vetted and preferred UK counsel to manage the new cloned registrations on your behalf, and to create files and docketing reminders for the new cloned registrations, again at no cost to you.

2. Pending EU Trademark Applications (pending as of January 1, 2021)

EUTM applications pending as of January 1, 2021 will not automatically be cloned into an equivalent UK application. In order to retain in an equivalent UK application with the EUTM application's filing date, Paris Convention Priority filing date (if applicable), and Seniority date (if applicable), you must file a separate UK trademark application within the 9 months following January 1, 2021 (*i.e.*, not later than September 30, 2021). Note that you will incur the usual fees and costs to file the separate UK application.

3. Existing UK Trademark Applications and Registrations

Existing UK applications and registrations will remain valid and in effect as of January 1, 2021 (*i.e.*, as if Brexit had not happened). However, since your EUTM registrations will now be cloned into UK trademark registrations, this may result in duplicative trademark registration coverage in the UK that you do not wish to maintain. While UKIPO is expected to offer some kind of “opt-out” procedure for these cloned trademark rights, the details have not yet been finalized nor is there any particular start date or deadline to opt out as of now.

The easiest (and least-expensive) way to avoid duplicative trademark coverage in the UK is to let one of the duplicate registrations expire in due course. Selecting which registration to let go, however, should take into account such factors as priority of filing date, and the respective coverage of classes and items within each class. We can assist you to make the most appropriate decision for your needs.

4. **European Union Registered Community Designs (RCDs), Registered International Designs (Hague System), and Unregistered Community Designs (UCDs)**

EU Community Design Registrations (“Registered Community Designs” or RCDs) and registered EU designations of International Design Registrations that publish prior to January 1, 2021 will have the same changes occur as for EU trademark registrations. That is, published RCDs and EU-designated Hague Registrations will automatically be cloned to create an equivalent design registration under UK law at UKIPO.

Community Design Applications and International Design Applications designating the EU which are pending on January 1, 2021 will need to follow the same procedures in the UK as for EUTM applications, discussed above.

Unregistered Community Designs (UCDs) still have an uncertain status in the UK after January 1, 2021, due to unresolved issues in the ongoing UK/EU negotiations, such as whether the UK’s novelty requirements will be deemed satisfied, and the degree to which UCDs must exist independently within the UK. For further guidance on RCDs and UCDs, please contact us.

5. **Trademark Opposition and Cancellation Proceedings Pending at EUIPO**

Trademark opposition or cancellation proceedings at EUIPO that are still pending as of January 1, 2021 will also be impacted by Brexit. A number of steps will need to be taken if you wish to (i) institute parallel UK proceedings against the cloned UK versions of the adverse party’s EUTM applications and/or registrations, and (ii) preserve the filing dates, priority dates, pleadings, etc. of the EUIPO proceedings.

For Further Information and Assistance

We realize that the end of the Brexit transition may be unexpected and worrisome to you, and we are here to help. After reviewing our comments above, if you still have questions about what Brexit means to you and to your business’s trademark or design rights in the UK and in the EU, please do not hesitate to contact us: Curt Krechevsky, ckrechevsky@cantorcolburn.com, and Michelle Ciotola, mciotola@cantorcolburn.com, for trademark-related questions, and Daniel Drexler, ddrexler@cantorcolburn.com, for design-related questions. All Cantor Colburn attorneys are accessible at +1 (860) 286-2929.

Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.