



Brexit's Impact on Canadian Owners of EU Trademarks

March 11, 2020

By Janice Bereskin and Wynnie Chan

On January 29, 2020, the European Union (EU) Parliament approved the Brexit Withdrawal Agreement to officially end the UK's membership of the European Union on Jan 31, 2020. UK's departure from the EU marked the beginning of an implementation or "Transition Period" that will last until December 31, 2020. During this time, the UK will be treated as if it were a member of the EU whereby the UK will continue to apply EU law and recognize its obligations under international treaties. With respect to intellectual property, during the Transition Period, intellectual property owners will retain the same the rights they had before UK's exit. Any European Union trademarks (EUTMs) for example, whether filed locally with the EU Intellectual Property Office (EUIPO) or through an international filing system (Madrid System) will remain in force in the UK.

On January 1, 2021 however, EUTMs will no longer extend protection to the UK. Owners of EUTMs trademarks should therefore be aware of how their rights are impacted and what to do to embrace for changes after the Transition Period.

For owners of *registered* EUTMs, on January 1, 2021, such registrations will be automatically "cloned" into a comparable local UK registration with the same sign, goods and services, filing and priority and seniority dates as their EU registration. The new UK registration will be treated as though the owner had filed and registered the mark in the UK and so its legal status would be the same as the registered EUTM. No fees will be required for the clone. However, after the Transition Period, any renewals, changes in title or challenges to the validity of the UK registration would have to be dealt with separately from the EUTM and through the UK's trademark office (UKIPO). For any owners who do not wish to have their registrations cloned into a UK registration, they can "opt out" after January 1, 2021 by submitting a request with the UKIPO.

Applicants of *pending* EUTM applications will have the option of filing a comparable UK application with the UKIPO after January 1, 2021 and retain the priority filing date of the EUTM, provided that, such application is filed by September 30, 2021. To benefit from the earlier filing date of the pending EUTM, the mark must be identical to the EUTM and cover the same goods and services. Applicants will need to pay a filing fee to the UKIPO.

Owners of international registrations (IR) with an EU designation as of December 31, 2020 should be able to maintain protection in the UK after the Transition Period and no further action may be required. Applicants who hold pending international applications designating EU as of January 1, 2021 will likely need to consider adding the UK as a separate country of designation. Currently, it is unclear what procedures need to be followed as the UKIPO and WIPO are currently discussing these measures. Further details will follow when they become available.

It would be prudent for all companies doing business in the UK to review their EU and UK trademark rights to ensure that they are adequately protected, and consider re-filing or taking additional measures in the UK as necessary. Even though older EU registrations will remain in force in the UK after the Transition Period, both EU and UK registrations could be vulnerable to cancellation based on non-use. In addition, since the scope of goods and services of older registrations may not reflect current business practices, there could be multiple advantages to directly filing in the UK.

Content shared on Bereskin & Parr's website is for information purposes only. It should not be taken as legal or professional advice. To obtain such advice, please contact a Bereskin & Parr LLP professional. We will be pleased to help you.