



HERE COME THE CLONES... The BREXIT Effect on Trademarks

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BREXIT is near and the clones are coming! As of January 1, 2021, trademarks registered at the European Union Intellectual Property Office (“EUIPO”), including those granted designations in the EU through the Madrid Protocol system, will no longer provide protection in the UK. The Brexit Withdrawal Agreement provides for a transition period that ends on December 31, 2020. Until that time, EU trademark laws and rights continue to have effect in the UK.

Under the current regime, trademark registrations may be obtained in Europe by filing a single European Union Trademark (EUTM) application or a Madrid application designating the EU. An EUTM registration provides trademark protection in all 28 member states of the European Union, including the UK.

Starting January 1, 2021, trademarks registered at the EUIPO, including those granted designations in the EU through the Madrid system, will automatically generate a corresponding or “cloned” UK national trademark registration, allowing protection to continue in the UK after Brexit. The UK cloned registration will keep the original EUTM filing and priority dates. The cloned UK registration will be a fully independent trademark registration although a separate UK registration certificate will not be issued (but details of the UK registration may be obtained at <gov.uk>). For the purposes of renewal, the cloned UK registration will retain the existing renewal date of the corresponding EUTM. A separate renewal fee will apply to the UK registration and the original EU registration which must be paid to the respective IP offices.

Subject to some restrictions, there is a mechanism by which trademark owners can opt out of this cloning process. Such requests may only be filed as of January 1, 2021, and, if accepted, the comparable UK registration will be treated as if it had never been created or registered under UK law.

For pending EU trademarks, including designations of the EU under the Madrid Protocol system, that are not yet registered by December 31, 2020, a “clone” UK application will only be created if a request, along with the appropriate fee, is filed with the UK Intellectual Property Office (“UKIPO”) before September 30, 2021. The request and fees are similar to the filing of a new UK application but the application will retain the filing date of the pending EUTM, as well as any priority claims. The request must be for the same trademark and for the same goods/services that are identical to, or contained within, the corresponding EU application.

Similar changes are going to affect industrial design protection in the EU, as reported [here](#).

It would be prudent for companies conducting and considering business in the UK to review their EU and UK trademark rights to ensure that they are adequately protected, and should consider re-filing or taking additional measures in the UK as necessary, particularly if a registration may be vulnerable to cancellation for non-use or does not cover the current or full scope of goods/services associated with the respective trademark.

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