

UK Brexit

Trademark and Design rights

WHAT HAPPENS ON 1 JANUARY 2021?

On 1 January 2021 (“Exit Day”) the UK Intellectual Property Office will automatically create comparable UK rights (“clones”) for all European trademarks (“EUTMs”) and designs (“RCDs”) that are registered at Exit Day. The clone will extend to those which have expired 6 months prior to Exit Day. These expired clones will have their status as expired, but if the underlying EUTM or RCD is renewed in the 6 months window for late renewal, then the cloned right will also be deemed as renewed.

The cloned rights will have the same filing, priority and renewal dates as the corresponding EUTMs or RCDs. The cloned registration number will have the same registration number of the respective European right with a prefix designation of 009 added to identify it as a clone right.

If on Exit Day you have a EUTM or RCD which is still pending, if UK rights are required you will need to apply to register for the same trade mark in the UK within a nine month window after the end of the transition period, namely by the 30th September 2021. You will still be able to keep the same filing details and the earlier filing date of the pending EUTM, so you will not lose any duration of rights in the UK, provided that the application is applied for before the deadline.

RENEWALS OF CLONED RIGHTS

Cloned rights will need a separate renewal fee paid to the UK IPO, and as stated it maintains the same renewal date as the corresponding European right. Under normal procedures, the UK IPO sends a renewal reminder to the address for service six months prior to the expiry date. This will happen for all renewal dates that fall due more than six months after Exit Date, however if the clone expires within six months from Exit Date the UK IPO will send to the address for service a renewal reminder on the expiry date. This will give the normal additional 6 months window for late renewal, however late fees will not be payable.

ADDRESS FOR SERVICE

The UK IPO will be amending its legislation to require an owner to have an Address for Service in the UK, therefore not allowing addresses in the European Economic Area to service as a valid address for service. Therefore it would be a good idea to ensure your rights have a UK Address for Service recorded against them.

For more information, please contact:
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