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Things We Almost Forgot About During the Pandemic: Brexit and Trademark Implications

BY [RACHEL KAMINETZKY](#) / ON FEBRUARY 17, 2021



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For the past eleven months, the world has been focused on one thing – the Coronavirus pandemic. And how could we not? COVID-19 has disrupted life as we knew it, effected virtually every industry, and prompted every email written in the past year to begin with some variation of “I hope you are staying safe during these unprecedented times”. And if our minds were not focused on trying to understand the latest CDC guidelines, our eyes were trained to the election polls as we anxiously followed the unfolding of political history.

Amidst the tumult that was the past year, some breaking news headlines that were relevant pre-pandemic have faded into the background. And justifiably so. If this were a March

Madness bracket, “pandemic” and “politics” would be straight line picks for championship airtime on any and every media outlet. However, as the dust starts to settle with the introduction of the vaccine, there is a moment to refocus on significant things we almost forgot about – and just in time.

On June 23, 2016, Britain voted to leave the European Union, which would later take formal effect on January 1, 2020.¹ As per the terms of the Withdrawal Agreement², Britain and the EU spent the most of 2020 negotiating the terms of the split and outlining their relationship in what has been dubbed the “biggest overnight change in modern commercial relations.”³ The “transition period” that lasted through December 31, 2020 has officially come and gone, and Brexit and all its implication are in full effect.⁴

While the repercussions of Brexit are vast and varied, one important consequence is the effect this withdrawal will have on trademarks registered through the EU. In the EU, mark owners can register their trademark to grant protective trademark rights in all member countries of the EU.⁵ This streamlined process has been favored by many companies and brands who have registered their marks with the European Union Intellectual Property Office because it is a one stop shop for protection in the then 28, now 27, countries party to the EU.⁶ So, what happens to a trademark when one country steps out?

Article 54(1) of the Withdrawal Agreement provides that for marks that have been filed and granted registration before the end of the transition period, the UK will automatically grant a comparable UK trademark as of the date it was filed with EUIPO.⁷ When these marks expire, trademark owners will have to then file a new and unattached registration in the United Kingdom Intellectual Property Office, should they seek renewal. Furthermore, any new marks that seek registration after January 1, 2021, when Brexit took full force, will have to file two separate trademark applications – one in the EUIPO and one in the UKIPO, which is subject to approval or rejection in both forums.⁸

The difficulty is what happens to marks that have applied for EUTM registration during the transition period (that is, between January 1, 2020 and December 31, 2020) but have yet to receive protective rights. There were roughly 85,000 pending trademarks in the EUIPO at the time Brexit went into effect on January 1, 2021.⁹ Intellectual Property focused law firms have compiled checklists¹⁰ and resources, and the International Trademark Association has released the *Brexit Brands Toolkit*¹¹ in anticipation of questions about what is expected to come next, but the punchline is this; you will have to register for a separate trademark in the UK.¹²

The trademark applications that were still pending on January 1, 2021 have been afforded a nine-month grace period to file another trademark application with the UKIPO that, if awarded registration, will receive a priority filing date of the date in which the original application was filed in the EUIPO.¹³ In other words, applicants have until September 30, 2021

to file for a comparable UK trademark to the one already pending in the EUIPO in order to receive a priority date of when the application was first filed.

In the scheme of trademark maintenance, this is frustrating, but not catastrophic. While it is certainly convenient to file one application for an EUTM that granted an owner rights in multiple countries, Brexit incentivizes international trademark owners to reevaluate where their marks are afforded protection and take stock of expiration and priority dates of those marks filed with the EU. So, as September 30th approaches, add international trademark maintenance to the spring cleaning list and assess whether a mark has been provided a comparable UK trademark or requires a new filing to collect rights in the UK.

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