



Trade Mark and Design Considerations Following the UK's EU Referendum

The UK population voted in the referendum on 23 June 2016 to leave the European Union (EU). This does not bring about any immediate changes to IP law. EU trade mark (TM) registrations and EU registered designs remain in force in the UK. This will continue at least until the moment that the UK leaves the EU. At that point, new laws that have not yet been devised are expected to take effect.

There is likely to be a process for converting the UK part of a subsisting EU right to a corresponding national right in the UK. The process will likely ensure that the national UK right retains the effective EU filing date. It is unclear what that process will be and what transitional provisions will be put in place to deal with matters such as the timing of conversion and the enforcement of rights in the interim. It is also unclear what considerations may be applied to the surviving UK TM registrations where validating use can be shown only outside of the UK (or vice versa for surviving EU registrations where use has hitherto been limited to the UK). It is possible, although perhaps unlikely, that successful conversion to a UK right may be made contingent on proving appropriate use in the UK. It is alternatively possible that, in the event of successful conversion, a newly converted UK TM registration may become instantly vulnerable to cancellation on grounds of non-use, if the original EU TM registration is over five years old and the mark has not been used in the UK.

In view of this, it would be prudent for trade mark and design owners to consider now obtaining concurrent protection for their TM and design rights in the UK and in the EU. This will be particularly relevant to those who view the UK as a key market for their goods or services, those whose products are regularly counterfeited and those who wish to maintain effective defensive protection for their trade mark in the UK, even though their mark is not currently used in the UK.

For newly arising TM and design rights where EU and UK filings have not yet been made, a relatively simple strategy is to apply for both EU and UK protection at the same time. Then, UK rights are secured at an early stage and are not dependent for their existence on an unknown future conversion procedure.

Those with existing EU trade mark registrations may wish to consider now filing a UK trade mark application to supplement the existing EU right. Similarly, those with existing EU design applications/registrations may also consider supplementing with a UK filing, though noting that

the novelty rules mean that such a UK filing must be made within one year of the design being disclosed.

For those with existing UK and EU registrations which protect the same trade mark or design, it would be appropriate to maintain the UK registrations (at the next renewal) in addition to the EU registrations.

Once the timing and conditions of the UK's exit from the EU are clearer, right owners will be able to consider their position and will have the extra flexibility of a secured UK right and may have avoided the need to undergo a conversion process.

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For more information, please contact:

Tom Albertini - talbertini@jakemp.com

James Fish - jfish@jakemp.com

John Leeming - jleeming@jakemp.com

Ben Mooneapillay - bmooneapillay@jakemp.com

Charlotte Stirling - cstirling@jakemp.com