

TM

Legal Challenges Post Brexit  
Trade Marks



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# Summary of Brexit trade mark issues

- Protection - effect on current protection and maintaining that protection
- Licensing - effect on existing agreements and things to consider for new arrangements
- Enforcement – effect on both on-going actions and previous decisions

# Current protection: EUTMs



- Most organisations have, at least in part, relied on European Union trade marks (EUTMs) for their UK protection
- EUTMs are unitary rights and unless arrangements are put in place will cease to cover the UK on Brexit
- There will almost certainly be a way of extending EUTM protection to cover the UK
- So should be possible to maintain rights in the UK at the point of Brexit

# Mechanism to keep EUTM rights in the UK

Model	Timing	Unilateral or bilateral	Initial cost to business	UKIPO resource	Post-division conflicts	Legal certainty
<b>EU plus</b> EUTM system becomes ETM system, covering EU & UK	Brexit	Bilateral	Low	Low	Low	High
<b>Jersey</b> UK treats EUTMs as covering UK	Brexit	Unilateral	Low	Low	Medium	Low
<b>Montenegro</b> EUTMs brought onto UK register as UKTMs	Brexit/ window	Unilateral	Medium-low	Medium-low	Medium	High
<b>Tuvalu</b> Option to bring EUTMs onto UK register as UKTMs	Brexit/ window	Unilateral	Medium	Medium	Medium	High
<b>Veto</b> Option to bring EUTMs onto UK register as UKTMs, but UKIPO retains veto	Brexit/ window	Unilateral	Medium-high	Medium-high	Low	Low
<b>Ireland</b> Option to bring EUTMs onto UK register as UKTMs at renewal. EUTM covers UK in interim	At renewal/ long window	Unilateral	Medium-low	Medium-low	Medium	Medium
<b>Conversion</b> Option to convert EUTMs into UK applications, with full examination as of filing date etc.	Brexit/ window	Unilateral	High	High	Low	Low

# Losing trade mark rights post Brexit



- Need to use trade marks to maintain registrations
  - If only operate in UK, won't be able to defend EUTM rights – when will this take effect?
  - If only operate outside UK, won't be able to defend UK rights – again, unclear when this will take effect
- Potential challenges (or ineffectiveness) of re-filed applications - EUTM, UK, other Member States

# Licensing issues (1)



- **Territory**

- Does licence cover the EU "as constituted from time to time" or "as at the date of the agreement"?
- If the former, need to amend licence to cover UK – chance to renegotiate terms?

- **Termination**

- Does Brexit give an "escape route"?
- e.g. no use in the UK, so new UK rights endangered
- e.g. trade barriers – or is that force majeure?

# Licensing issues (2)



- **Jurisdiction**

- If UK – where will judgments be enforceable? Depends on the Conventions / agreements the UK signs
- If outside the UK – will judgements be enforceable here?

- **Licensed rights**

- Are extended UK rights included in the licence?
- If so, implications for enforcement (non-exclusive licensee can sue – if licence recorded) and maintenance of rights (what if no use in the UK?)

# Enforcement issues



- What will happen to on-going trade mark infringement proceedings seeking EU-wide relief at Brexit?
  - In UK Courts?
  - In EUTM Courts in other Member States?
- What will happen to existing injunctions granted by UK Courts at Brexit?
- And EU-wide injunctions granted by non-UK Courts?
- Need to bring UK-specific actions – so increase in litigation?



Thank you **& Bird & Bird**

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