

# PATTISHALL

*insights*

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“ WHEN THE UK EXITS THE EUROPEAN UNION, NO ONE IS QUITE SURE WHAT WILL HAPPEN TO EU TRADEMARK REGISTRATIONS, BUT THERE ARE SOME PRETTY GOOD INDICATIONS. ”

## BREXIT: WHAT TRADEMARK OWNERS NEED TO KNOW NOW

*By Janet A. Marvel*

When the UK exits the European Union, no one is quite sure what will happen to EU trademark registrations, but there are some pretty good indications. On February 28, the EU Commission published the *Draft Withdrawal Agreement on the Withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community*. The draft is essentially a codification of the EU Commission's proposals to date about how to handle Brexit as it applies to IP law.

The draft provides that EU trademark registrations and granted applications will *automatically* extend into UK registrations with the same scope of protection, registration date, priority and seniority as the underlying EU application. Assuming the draft is adopted in the final treaty, companies will not need to file separate applications for their EU registered marks in the UK.

Nonetheless, many U.S. companies are taking a belt and suspenders approach. U.S. company UK filings have increased exponentially. Conversely, UK company EU filings have dropped significantly.

There are some questions about how use in the UK versus use in other EU countries will affect your ability to maintain your registrations. Currently, use in one EU member country may establish use in all member countries. So even if a mark has been used only in Germany, for

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example, its registration may still be valid in the UK. Conversely, even if a mark has only been used in the UK, its registration may still be valid in, for example, Germany.

Post-Brexit use in the UK will not maintain an EU registration. Pre-Brexit UK use likely will constitute use of the EU-registered mark before Brexit – meaning the EU registration should not be vulnerable to a non-use cancellation for a further 5 years after Brexit. The UK will have a new rule post-Brexit (whether automatically created or not) – use outside the UK that would have maintained the EU right including in the UK will no longer support rights in the UK.

Open questions remain regarding use requirements for oppositions and cancellations, costs linked to maintaining validity in the UK, as well as handling of pending EU cases at the time of Brexit.

### So what should you do now?

- If you already have an EU registration, you probably don't need to file an application for a UK registration for the same mark.
- If you are launching an important product, you should file in both the UK and the EU. Note that your EU application may not transfer post-Brexit to the UK if it is still being examined on the split date.
- Keep track of proof of genuine use and reputation in both the EU and the UK.
- Include specific reference to the UK in European agreements. Amend existing agreements as necessary in this regard. It is uncertain whether a contract covering the EU before Brexit will still be deemed to include the UK post-Brexit. Moreover, you may not want to include the UK post-Brexit. It is valuable to consider all of these contingencies.
- If you want to try to register a mark in the EU based on acquired distinctiveness arising in part from use in the UK, you should probably file an EU application now. After Brexit, evidence of use in the UK will become irrelevant. Note however that use solely in the UK probably will not be enough to establish pre-Brexit acquired distinctiveness in the EU, and proving EU acquired distinctiveness can be hard to do.

NOTEWORTHY

**Illinois Super Lawyers 2018**

David Hilliard has been recognized as one of the Top 100 Super Lawyers in Illinois for ten years, the only lawyer so honored in the Intellectual Property field.

**Leading Lawyers Magazine**

Brett August, Thad Chaloeintiarana, Bradley Cohn, David Hilliard, Jonathan Jennings and Joseph Welch II have been selected as Illinois “Leading Lawyers.”

**Managing IP – Americas IP Awards**

Pattishall McAuliffe is proud to receive the 2018 “Trade Mark Contentious Midwest Firm of the Year” award from Managing IP, which was announced at the publication’s awards ceremony in New York on March 15th.

**Saul Lefkowitz Moot Court Competition**

Ashly Boesche coached the 2018 Chicago-Kent team to a first place victory at the National championship. Her team won best oral argument and second place for their brief. No other team placed in all three categories. Ashly has taken Team Chicago-Kent to the National Finals for the fourth time in her five years of coaching.

**WORLD TRADEMARK REVIEW (WTR) 1000**

Pattishall McAuliffe received the top Gold Band ranking for both the United States and Illinois in the 2018 WTR 1000 report. **Bob Sacoff** was nationally ranked Silver for “enforcement and litigation.” In Illinois rankings: **Jonathan Jennings** was ranked Gold for “enforcement and litigation” and “prosecution and strategy;” **Brett August, Phil Barendolts, Bradley Cohn, Janet Marvel, Bob Sacoff** and **Joe Welch** were ranked Silver for “enforcement and litigation;” **Janet Marvel** was ranked Silver for “prosecution and strategy;” **Belinda Scrimenti** was ranked Bronze for “prosecution and strategy;” **Thad Chaloeintiarana** was ranked Bronze for “enforcement and litigation;” and **David Hilliard** was honored as one of the two “Intellectual Property Luminaries.”

WTR writes, “The trademark team at Pattishall McAuliffe comprises outstanding legal professionals that work together brilliantly. Its lawyers are devoted to their work and adept at handling complex and sensitive situations. They operate at a consistently high level.’ The ‘extremely responsive and reliable’ boutique ‘has a very loyal base of clients, great bandwidth and a deep bench’. ‘It ... has a new group of attorneys coming up through the ranks, who are being well trained by its veterans’. ‘Its terrific practice is clearly a destination of choice for both trademark prosecution and litigation.’”

PRESENTATIONS

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**Jessica A. Ekhoﬀ**  
Jessica gave a presentation for Lawyers for the Creative Arts entitled “Making Your Mark—Trademark 101 for Creatives” on March 27.

- Phillip Barendolts**



Phil gave a presentation on design protection for Consumer Products in the Health, Beauty and Sports Equipment Industries at the AIPLA Design Rights Boot Camp on April 23 in Arlington, VA.

- Jonathan S. Jennings**

Jonathan will speak at a Straﬀord webinar program entitled “URS, UDRP, ACPA and Beyond: Domain Name Enforcement in the new gTLD Era” on June 26.

- Robert W. Sacoff**

Bob spoke on “Design Law” at the *Northwestern Law Journal of Technology & Intellectual Property* Annual Symposium on April 6.

PUBLICATIONS

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**Seth I. Appel**  
Seth’s case note, “First Amendment Protects Registration of Scandalous Marks in the U.S.,” was published in the February edition of *AIPPI e-News*.

- Ashly Boesche**

Ashly’s article “Team Nike!” was published in the March/April 2018 edition of *Landslide Magazine*.

- Jonathan S. Jennings, Kristine Bergman and Jacquelyn Prom**

Jonathan authored, with the assistance of Kristine and Jacquie, the 2018 update to the Illinois chapter of the International Trademark Association’s online book *U.S. State Trademark and Unfair Competition Law*.

- Belinda J. Scrimenti and Jacquelyn Prom**

Belinda and Jacquie coauthored the chapter on “State Trademark and Unfair Competition Law Remedies” in the new 3rd Edition of the ABA IP Section book *Trademark Infringement Remedies* published by Bloomberg/BNA.



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