

# PATTISHALL

*insights*

JULY 2020

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“ WHEN THE NEW  
UK REGISTRATIONS  
ARE CREATED,  
THE UK WILL NOT  
ISSUE CERTIFICATES. ”

## UK Trademarks After Brexit

By Bradley Cohn



*An EU registration protects it,  
So the wise trademark owner collects it,  
But one is left to surmise,  
As the question does arise,  
What happens to these marks after Brexit?*

There has been a lot of discussion and uncertainty about the status of trademark rights following the UK's recent separation agreement with the European Union. Main issues and suggested solutions are outlined below.

### Trademarks already registered with the EU IPO

As of January 1, 2021, EU trademark registrations, known as European Union Trade Marks (“EUTMs”) will no longer protect rights in the UK. Instead, as of that date, the UK Intellectual Property Office will automatically create comparable UK trade mark registrations to match the corresponding existing EUTMs. No input, submission, or payment is required by the trademark owner. Whatever EUTMs you own on December 31, 2020, you will receive an identical, corresponding UK registration as of January 1, 2021.

The newly issued UK registrations will: (a) have the same status as if they had been originally registered in the UK; (b) have the EU registration filing date; (c) retain the original priority or UK seniority date; and (d) be an independent right, separate from the EUTM.

When the new UK registrations are created, the UK will not issue certificates. The details will be posted on the UK Intellectual Property Office web site.

It is possible to opt out of the comparable UK trademark right, for example if there are contractual reasons to do so. Opt-out can be requested after the comparable right has been created.

Naturally, after December 31, 2020, EUTMs will continue to protect trademarks in the remaining EU member countries.

## Pending EU Applications

EU trademark applications that are pending as of January 1, 2021, will not automatically be transformed into UK rights.

If you have an EUTM application that is still pending on January 1, 2021, you will be able to apply to register a comparable UK trade mark in the 9-month period beginning January 1, 2021. If you do that, the comparable UK trademark application will: (a) retain the earlier filing date of the pending EU application, and (b) retain any valid international priority you had on the pending EU application, along with any UK seniority claims recorded against it. To file the comparable UK trademark, you will need to pay the application fees required by the UK Trademark Office. The comparable UK application will be examined under UK law. The application for the comparable UK trade mark must cover the same trade mark, goods, and services as in the pending EUTM application. If it does not, the trademark owner will not be able to claim the earlier EU filing date/priority date.

A potential problem arises if you file a UK trademark application in the nine-month period after January 1, 2021, that does not correspond to a pending EU trademark application. During that same nine-month period, someone else could theoretically obtain a UK comparable trademark with the benefit of the filing date of a corresponding EU trademark application that was pending as of January 1, 2021. In that circumstance, the other party's UK comparable trademark application — because it is based on a prior pending EU application — will have seniority over your UK application.



EU TRADEMARK APPLICATIONS THAT ARE PENDING AS OF JANUARY 1, 2021, WILL NOT AUTOMATICALLY BE TRANSFORMED INTO UK RIGHTS.



## Non-Use Vulnerability

EUTMs are subject to non-use cancellation if the registered mark is not used in the EU within a period of five years preceding the filing of a non-use action. For an EUTM challenged on non-use grounds, any use made in the UK before December 31, 2020, will be taken into account in determining if there has been use in the EU in the five-year period.

Similarly, use in the EU before December 31, 2020, will count as use in the UK in any non-use challenge against a corresponding UK registration that issued from an EU registration. This means that the five-year grace period of non-use for a comparable UK trademark may restart as of January 1, 2021, even if there has never been any use of the EU trademark in the UK. For example, the owner of an EUTM that is in use in only Greece and Italy as of December 31, 2020, can obtain a comparable UK trademark that cannot be challenged successfully for non-use in the UK until at least January 1, 2026.

## Pending Opposition or Invalidation Proceedings

Any EU opposition or invalidity proceeding pending as of December 31, 2020, that is based solely on a UK right, will be dismissed.

Any EU opposition or invalidity proceeding pending as of December 31, 2020, involving a non-UK right, will proceed.

For EUTMs that are being challenged as of December 30, 2020, the UK Trademark Office will create comparable UK trademarks. But the UK Trademark Office will respect the eventual decision of the EU. For example, if the EU decides a pending opposition proceeding against the owner of an EUTM application, the UK Trademark Office will cancel any comparable trademark that it had issued from that EU application.

## International Registrations

Some trademark owners have International Registrations that extend protection, through the Madrid system, to the European Union EUTM system.

An International Registration that was extended to and issued for the EU on or before December 31, 2020, will likely continue to offer protection in the UK. As of the date of this article, however, the form and extent of that protection is unknown. The UK Intellectual Property Office and WIPO (which administers the International Registration system) are still discussing options for such International Registrations. One solution would have

corresponding UK rights created that would be incorporated into the International Registration system; another option would see the corresponding rights be UK national registrations.

In any event, beginning in January 1, 2021, an International Registration extended to the EU will cover only EU member states, and not the UK.

## Action Items

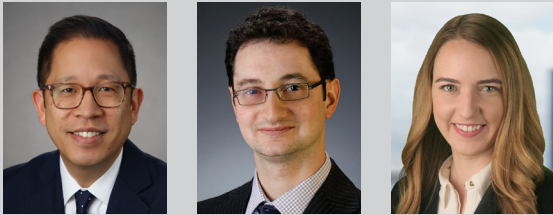
Trademark owners with EUTM registrations or pending applications will have protection in the UK after Brexit, but steps should be taken to avoid pitfalls. Key takeaways include:

- Renew in 2020 any EUTM registration where the renewal period begins in 2020. If you wait until 2021, the corresponding UK registration will have to be renewed separately.
- Update your portfolio records after January 1, 2021, to reflect any UK registrations issued from corresponding EUTM registrations or International Registrations.
- Watch pending EUTM applications to see if any corresponding UK applications need to be filed in early 2021.
- If you are considering registration of a mark in the UK in the nine months after January 1, 2021, conduct an appropriate search of the EUTM registry as a first step. ■

# *firm* UPDATE

## U.S. Supreme Court decision in *United States Patent and Trademark Office et. al. v. Booking.com B.V.*

- Thad Chaloeintiarana, Phillip Barendolts, and Jacqueline Prom



On June 30, 2020, the U.S. Supreme Court issued an 8-1 decision affirming the Fourth Circuit's ruling that BOOKING.COM is a registrable trademark and rejecting the USPTO's per se rule that would render BOOKING.COM ineligible for registration regardless of evidence of consumer perception. In support of her majority opinion, Justice Ginsburg cited the Brief for the Coalition of .Com Brand Owners as Amici Curiae filed by Thad, Phil and Jacquie. The Court ruled in favor of the position advocated in the brief.



## APPOINTMENTS

- **Ashly Boesche**  
Ashly has been appointed Co-Chair of the Illinois Intellectual Property Alliance Membership Committee.

## PRESENTATIONS

- **Thad Chaloeintiarana**  
Thad spoke on "*Booking.com* A Closer Look" in an International Trademark Association Webinar on May 7.
- **Jonathan Jennings**  
On July 15, Jonathan spoke on domain name enforcement strategies in a Strafford webinar entitled "UDRP, URS, ACPA and Beyond: Domain Name Enforcement, Brand Protection Strategies, Recent Decisions."

## PUBLICATIONS

- **Jonathan Jennings**  
The June issue of *Law Lore & Practice*, the newsletter of the Pharmaceutical Trade Marks Group (PTMG), published Jonathan's U.S. Update article on the TTAB's determination in a recent case of whether a mark was merely descriptive.



# *firm* NOTEWORTHY

## Expert Guides - Trade Mark 2020

**Robert Sacoff** and **Joseph Welch II** have been recognized as leading practitioners in Trade Marks.

## Law.com

**Thad Chaloeintiarana** was quoted in the article "A Dot-Com Amicus Army Is Volunteering for Booking.com" on the *National Law Journal* website, Law.com on April 17.

## IP Stars, *Managing Intellectual Property*

The Pattishall Firm was "Highly Recommended" in Trade Mark practice in Illinois. **Brett August**, **Bradley Cohn**, **David Hilliard**, **Jonathan Jennings** and **Janet Marvel** were named as "IP Stars" in Illinois. **Brett August**, **David Hilliard**, **Jonathan Jennings** and **Janet Marvel** also were selected as "Trade Mark Stars" in Illinois. **Bradley Cohn** and **David Hilliard** were named as "Copyright stars" in Illinois.



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