

Important considerations for EU trade mark owners, post-Brexit

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The European Union Trade Mark ("EUTM") (previously Community Trade Mark) extends to all 28 member states of the European Union, providing comprehensive protection for all brand owners within the EU. Presently the EUTM includes the UK; however, post-Brexit will see many changes, which may include the UK no longer being covered by the EUTM.



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The UK's decision to leave the European Union brings huge uncertainty to all business sectors and although there may be no immediate urgency, brand owners will now also need to gear up and strategize, ensuring adequate trade mark protection in the UK.

Change also brings opportunity and it is anticipated that trade mark squatters will take advantage where trade marks and brand owners appear susceptible. Forewarned is forearmed.

How long do we have?

Unless there is a further political change, it is anticipated that the UK will leave the European Union within the next two years - that is by 2018. The European Council requires formal notification of the UK's intention to leave, predicted to be given during October 2016. Once formally notified, there will be a period of negotiations between the UK and the European Union.

Consequences

The process concerning EUTM's is yet to be decided, however it is anticipated that one or more options may be introduced for trade mark protection to extend to the UK including:

1. Transitional provisions allowing pre-existing EUTM's to be re-designated or converted to UK National marks, including maintaining the original filing and priority dates and/or any relevant seniority claims.
2. A simple re-registration process of pre-existing EUTM registrations to national UK registrations.

3. The recognition of pre-existing EUTM's to UK national registrations without any further administrative action required.

Recommendations

For future EUTM applications and EUTM's that have been filed within the last six months, it is suggested that separate UK national applications also be filed. It would also be sensible for brand owners to also consider filing for national UK registrations for pre-existing EUTMs, particularly where the UK is an important market.

The trade mark examination and registration process in the UK is similar to the EUTM and is quick. Securing trade mark protection in the UK now will bring certainty while post-Brexit legislation is drafted. Taking action will also mitigate the post-Brexit flurry forcing brand owners to get their houses in order and the inevitable delays, if only by the sheer volume of requests that the UK registry will need to attend to.

The UK is one of South Africa's major trading partners and we will continue to monitor and advise clients so as to facilitate a smooth transition.

ABOUT DONVAY WEGIERSKI

Donvay Wegierski is director of Werksmans Attorneys. Her main practice areas are intellectual property and Africa. Donvay specialises in trade mark portfolio management, trade mark searching, filing and prosecution matters, trade mark oppositions, infringement and passing off matters, due diligence reports in IP commercial transactions; all of the aforesaid with particular emphasis on foreign and African trade marks, counterfeit goods, domain names, and company and close corporation name objections.

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