

MOFO BREXIT BRIEFING

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Brexit and Your European Trademarks

By Amanda Phillips, Joyce Liou, and Jennifer Lee Taylor

The United Kingdom has voted by a narrow majority to leave the European Union (“Brexit”). But the process of Brexit will take time, and the implications for our clients’ businesses will also unfold over time. Our MoFo Brexit Task Force is coordinating across all of our offices and working with clients on their key concerns and issues, now and in the coming weeks and months. We will also be providing MoFo Brexit Briefings on a range of key issues. We are here to support you in any and every way that we can.

The European Union Trademark (“EUTM”) is possibly the most widely used vehicle worldwide to protect trademark rights. A single application filed in the European Union Intellectual Property Office (“EUIPO”) in Alicante, Spain provides protection in the 28 member countries of the European Union (“EU”). In view of the UK Brexit vote on June 23, 2016, you might be wondering what this means for trademarks that you have protected via an EUTM.

First and foremost, you should know that as of now, your trademark rights are secure. Last week’s vote was only the first step in a multi-stage process which would culminate with the United Kingdom withdrawing as an EU member state. Your EUTM will protect your trademark rights in the United Kingdom until the United Kingdom formally exits the EU.

As for the long term, EU trademark practitioners currently think that it is highly likely that the final terms of the United Kingdom’s exit from the EU will include some mechanism to address the protection of EUTMs in the United Kingdom. The simplest solution would be for the United Kingdom Trademark Office to register as United Kingdom national registrations any marks that were previously registered as EUTMs, while preserving their priority dates. But this could create conflicts within the United Kingdom trademark registry and may not be feasible. Further, the costs, procedures, and timeline for such a transition have not been worked out, and the scope of such an administrative undertaking would be enormous.

Because of these uncertainties, and in order to minimize any risks associated with this changeover, anyone who owns EUTMs and views the United Kingdom as an important market may want to consider filing for United Kingdom trademark registrations now, rather than waiting to see what happens when the United Kingdom formally exits the EU. And for new trademarks, we recommend filing in both the EU and the United Kingdom if the United Kingdom will be an important market for you. This increases costs only slightly and clearly secures a priority date for the United Kingdom.

We encourage you to reach out to us with any questions on your filing strategies.

Please do not hesitate to call with any question or concern you have. We're here to help.

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