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CLIENT UPDATE

How Brexit Impacts Your Trademarks?

December 13, 2020

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If you operate in the EU and you are a Trademark Owner, you need to know how Brexit will affect your existing trademark registrations, as well as your pending applications.

Sounds complicated? Meitar will guide you through the process of maintaining your trademark rights in the UK after the Brexit transition period ends, and put your trademark in an optimal legal position while understanding all consequences and related costs.

In order not to lose your trademark rights, please find below our answers to our clients' most frequently asked questions:

Q: What is the Brexit effect on trademarks?

A: Protection of EU trademarks or International Registrations (IRs) designating the EU will no longer extend to the UK after the "effective day".

Q: What is the "effective day" of this change?

A: December 31, 2020. After this day, the Brexit transition period will end, and a trademark owner seeking protection in both EU and UK for new applications will have to file a separate application in each territory.

Q: Will current EU trademark registrations receive protection in the UK?

A: Yes. A trademark already registered in the EU on the Brexit effective day, will be "cloned" into an identical national UK trademark registration (same as for IRs designating the EU that have already received a Statement of Grant of Protection).

The automatically "cloned" UK trademark registration will keep the original filing date, priority date and renewal date of the underlying EU trademark, while being considered a fully independent right.

- No action is required;
- No costs for the automatic conversion;
- No separate Registration Certificate will be issued for the "cloned" registration;
- No local representative in the UK is necessary at this stage.

Q: Will current EU trademark applications receive protection in the UK?

A: Not automatically. Without any action, EU trademark applications still under examination or opposition on December 31, 2020 will not protect your trademark in the UK.

Q: What is required in order to retain trademark protection in the UK?

A: If your EU trademark application (or IR designating the EU) has not yet matured into a registration by the Brexit effective day, you can still protect your trademark rights in the UK, and even retain the same filing date and priority date of the original EU application. You will be required to:

- Apply for a national UK trademark application;
- Pay the UK Intellectual Property Office (UKIPO) filing fees of £170 for a trademark in one class of goods or services, and an extra £50 for each additional class;
- Claim the same protection and keep the same details of the corresponding EU application;
- Appoint a UK representative (if the trademark owner does not have a registered office in the UK or is not domiciled in the UK).

Q: Is there any "Grace Period" after the Brexit effective day?

A: Yes. It will be possible to convert the EU application into a UK application (and retain your prior rights as detailed above) within 9 months after the Brexit effective day, namely by September 30, 2021.

Q: Will there be any effect on UK national trademarks?

A: No. Nor will there be an impact on IRs designating the UK.

Q: Is it a must to hold an additional "cloned" UK trademark?

A: No. You may "opt out" and abandon the automatic "cloning" by submitting a request with the UKIPO after the Brexit effective day.

We would suggest that our clients take into consideration **various legal and commercial aspects** reflected by the above, such as in opposition or cancellation proceedings, as well as within the framework of current and future commercial agreements, investment agreements and M&As.

If you have any questions, please do not hesitate to contact us.

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