



II: Contentious proceedings – oppositions and cancellation actions

Effect on pending trade mark oppositions	
<p>I have a UK national TM application under opposition by someone owning a UK TM.</p> <p>What happens now?</p>	<p>No change</p> <p>Brexit has no effect - opposition carries on unaffected.</p> <p><i>We can continue to represent you in all UKIPO matters including existing UK oppositions.</i></p>
<p>I have a UK national TM application opposed by someone owning an earlier EU trade mark.</p> <p>What happens now?</p>	<p>No change</p> <p>Provided that the opposition was filed prior to exit day, the UK Government has confirmed that the proceedings will “continue towards resolution on the basis of the law as it stood prior to exit day”.</p> <p><i>We can continue to represent you in all UKIPO matters, including existing UK oppositions. R&G has a strong practice in contentious proceedings. We will be advising clients on particular cases handled by us. We are happy to review any other live opposition files.</i></p>
<p>I have a EUTM application opposed by someone owning an earlier UK TM or unregistered right in the UK. There’s no other ground of opposition.</p> <p>What happens now?</p>	<p>The position on these oppositions is not entirely clear at present and we are expecting guidance to issue from the EUIPO in the next two months. However, it seems logical to conclude that any opposition based solely on UK rights that has not reached a final decision by exit date will be dismissed.</p>
<p>I have a EUTM application opposed by someone owning an earlier EUTM.</p> <p>What happens now?</p>	<p>Nothing changes</p> <p>Brexit has no effect and the opposition carries on unaffected. EUIPO remains responsible for the opposition action.</p> <p>We are waiting for guidance as to what happens to the opportunity to acquire a UK cloned application.</p> <p><i>We will continue to represent you in all EUIPO matters, including existing oppositions.</i></p>
<p>I understand that marks have to have been used in the last five years to give valid opposition grounds.</p> <p>Used where?</p>	<p>If the opponent’s mark has been used somewhere in the EU (including the UK) in the last five years things should be ok, provided you are over certain thresholds.</p> <p><i>Any use in the UK after exit day will not be considered genuine use of an EUTM. However, use in the UK for the five years prior to exit day</i></p>

	<p><i>will still be taken into account in the assessment of genuine use of an EUTM.</i></p> <p><i>For the future, we have a separate section below on how Brexit affects the non-use maths.</i></p>
What if I am the party who has filed an opposition?	<p>It's the same as in our answers above.</p> <p>Just swap around to view from the eyes of those initiating the action, rather than receiving the action.</p>

Effect on new trade mark oppositions

After Brexit, can I oppose a UK TM application based on my UK TM?	<p>Yes</p> <p>And available grounds of opposition include any UK national rights that have been cloned from pre-Brexit EU rights.</p> <p><i>We can continue to represent you in all UKIPO matters including oppositions and have significant experience of fighting and settling oppositions.</i></p>
After Brexit, can I oppose a UK TM application based on my EUTM?	<p>No</p> <p>UK oppositions will need to be based on rights in the UK. These will of course include cloned UK rights arising from pre-Brexit EUTMs.</p> <p><i>The UK also recognises unregistered rights and it is now easier than ever to establish a case based on use of a mark in the UK, assisted by nationwide exposure through online sites accessed up and down the UK. We can advise on whether you could have use-based opposition rights aside from the trade mark registrations.</i></p>
After Brexit, can I oppose an EUTM application based on my UK TMs (registered or unregistered)?	<p>No</p> <p>EU oppositions will need to be based on rights that are effective in the EU. These include pan-EU TMs or national TMs registered in an individual EU member state.</p> <p><i>With that in mind, we have been assessing portfolios which have UK rights without any matching rights in either the EUIPO register or the register of at least one of the EU national countries outside the UK. A programme of filings outside the UK would provide basis to act against third parties trying to register a conflicting mark in the EUIPO after Brexit.</i></p> <p><i>We can also advise on unregistered rights acquired in EU countries and therefore possible grounds on which to base your opposition.</i></p>
After Brexit, can I oppose an EUTM application based on my EUTM?	<p>Yes</p> <p>Such oppositions are unaffected by Brexit.</p>

	Reddie & Grose can work with you on such contentious proceedings before the EUIPO.
I understand that marks have to have been used in the last five years to give valid opposition grounds. Used where?	If the opponent's mark has been used somewhere in the EU (including the UK) in the last five years things should be ok, provided you are over certain thresholds. <i>Any use in the UK after exit day will not be considered genuine use of an EUTM. However, use in the UK for the five years prior to exit day will still be taken into account in the assessment of genuine use of an EUTM.</i> For the future, we have a separate section below on how Brexit affects the non-use maths.
What if I am the party who has filed an opposition?	It's the same as in our answers above. Just swap around to view from the eyes of those initiating the action, rather than receiving the action.

Effect on existing cancellation (invalidation and revocation) actions

I have a UK TM registration and someone has applied to revoke it for non-use and the action is pending at the date of Brexit. What happens now?	Brexit has no effect The action carries on at UKIPO unaffected.
I have a EUTM registration and someone has applied to revoke it for non-use and the action is pending at the date of Brexit. What happens now?	Brexit has no effect The action carries on at EUIPO unaffected by whether your use before Brexit day was in the UK only or in another part of the EU.
I have a UK TM / design and someone has applied to invalidate it on the basis of an earlier UK TM / design and the action is pending at the date of Brexit. What happens now?	Brexit has no effect The action carries on at UKIPO unaffected.
I have a UK TM / design and someone has applied to invalidate it on the basis of an earlier EUTM / design and the action is pending at the date of Brexit.	The proceedings will continue Provided that the application for invalidity was filed prior to exit day, the UK Government has confirmed that the proceedings will "continue towards resolution on the basis of the law as it stood prior to exit day".
I have an EUTM / design and someone has applied to invalidate	Although definitive guidance on this point is still to issue from the EUIPO, it seems very likely that EUTM / design invalidation actions

<p>it on the basis of an earlier UK TM / design and the action is pending at the date of Brexit.</p> <p>What happens now?</p>	<p>based solely on earlier UK rights that have not reached final decision by exit date will be dismissed.</p> <p><i>Reddie & Grose will continue to monitor any cases that fall into this category as the impact on settlement could be significant. We are reviewing cases on our records and will update clients accordingly.</i></p>
<p>I have an EUTM / design and someone has applied to invalidate it on the basis of an earlier EUTM / design and the action is pending at the date of Brexit.</p> <p>What happens now?</p>	<p>Brexit has no effect</p> <p>The action carries on at the EUIPO unaffected.</p> <p>EUIPO remains responsible for the invalidation action.</p> <p>We await guidance on the cloning into UK rights, but we expect that if the parent EUTM is cancelled, in whole or in part, that the UK clone will be affected in the same way</p> <p><i>We can continue to represent you in all UK and pan-EU IP matters including existing revocation actions. If you have been thinking of starting an action at the EUIPO, you may want to expedite that to file before Brexit day to avoid the need to file a separate invalidity action against the cloned UK right.</i></p>
<p>What if I am the party who has filed a cancellation action?</p>	<p>It's the same as in our answers above.</p> <p>Just swap around to view from the eyes of those initiating the action, rather than receiving the action.</p>

Effect on new cancellation (invalidation) actions Revocation for non-use is different, please scroll down

<p>After Brexit, can a UK TM / design face an invalidation action based on an earlier UK TM / design?</p>	<p>Yes</p> <p>The earlier rights will include UK national rights that were cloned by the UKIPO as well as pre-existing UK granted rights.</p> <p><i>An eye will have to be kept on the EUIPO register in case something is there which is able to be cloned into a UK right at some point in the future – either because the transition window is open or because the earlier right was under challenge itself at the date of Brexit so the future was not at the time clear. Guidance is awaited on the cloning of those earlier rights.</i></p>
<p>After Brexit, can a UK TM / design face an invalidation action based on an earlier EUTM / design?</p>	<p>No</p> <p>UK invalidation actions will need to be based on rights in the UK, including cloned UK rights.</p> <p><i>An eye will have to be kept on the EUIPO register in case something is there which is able to be cloned into a UK right at some point in the future – either because the transition window is</i></p>

	<p><i>open or because the earlier right was under challenge itself at the date of Brexit so the future was not at the time clear. Guidance is awaited on the cloning of those earlier rights.</i></p>
<p>After Brexit, can an EUTM / design face an invalidation action based on an earlier UK TM / design?</p>	<p>No</p> <p>EU invalidation actions will need to be based on rights that are effective in the EU – pan-EU TM / design or national TM design in an EU member state.</p> <p><i>With that in mind, we have been assessing portfolios which have UK rights without any matching rights in either the EUIPO register or the register of at least one of the EU national countries outside the UK. A programme of filings outside the UK would provide basis to act against third parties were they to attempt to secure a registration of a mark in the EUIPO after Brexit.</i></p> <p><i>We can also advise on unregistered rights acquired in EU countries and therefore possible grounds on which to base an invalidation.</i></p> <p><i>For designs, the assessment is whether there is novelty in the registration under challenge. The publication of the earlier right is the significant date. This may lead to the expedition of publication of design filings.</i></p>
<p>After Brexit, can I invalidate an EUTM / design based on my EUTM / design?</p>	<p>Brexit has no effect</p> <p><i>Reddie & Grose are able to work with you on such contentious proceedings before the EUIPO.</i></p>
<p>What if I am the party who has filed a cancellation action?</p>	<p>It's the same as in our answers above.</p> <p>Just swap around to view from the eyes of those initiating the action, rather than receiving the action.</p>