



III: Maintaining valid registrations and clearing new marks

Use considerations for trade marks

I understand that both EU and UK trade mark registrations are vulnerable for non-use challenge 5 years from registration.

What's the effect on this?

The UKIPO will consider any use of the corresponding (or 'parent') EUTM, in the EU made prior to exit day (whether inside or outside of the UK), as use of the UK clone.

Therefore, for any part of the five-year period that falls prior to exit day, use of the corresponding EU Trade Mark in the EU will be considered, regardless of whether such use was inside or outside of the UK.

Use of an EUTM in the UK post exit date will not qualify as use 'in the EU' (or for exports from the EU to third countries). However, use of the EUTM in the UK before exit date constitutes use 'in the EU' for the purposes of assessing genuine use.

In all cases, there are shades of use and we will advise on each case as to the sufficiency of the use.

What if I have an EUTM which is over 5 years old and I haven't been using at all in the EU pre-Brexit?

Brexit has no effect

Both the EUTM and any cloned UK TM are likely to be vulnerable to non-use revocation.

Renewals

Will there be changes in my renewal programme?

Yes

After Brexit, each granted EUTM will have a cloned UKTM and you may choose to clone your pending EUTMs in the period allowed for that. The UK clones will need to be renewed separately from the EU registrations. TM renewals fall every 10 years in the UK and the EU.

The same applies to EU registered designs. Design renewals fall every 5 years in the UK and the EU.

Recent guidelines from the UKIPO suggest that the cloned right will need to be renewed separately, even in cases where the corresponding EUTM registration has already been early renewed in the six month period prior to exit day. This is contrary to the advice

	<i>previously issued by the UK government which stated that cloned right would retain the renewal date of the corresponding EUTM.</i>
Do I have to increase my budget?	<p>Probably</p> <p>After Brexit, the cloned UK rights have to be renewed independently of the EU right.</p> <p>You may have filed in the UK already so the clones are not needed. This won't change your budget.</p> <p>The EUIPO have issued no plans to reduce fees after the rights cease to cover the UK.</p> <p>Renewing both the new UK clone and the previous EU right will lead to a budget increase but UK renewals are not expensive.</p> <p><i>We can advise on this and review portfolios to ensure optimum use of IP budgets across renewals and acquisition of new rights.</i></p>

IP Clearance searches after Brexit

If I am clearing a mark for use in the UK, I can save money by just checking the UK register, right?	<p>Not yet</p> <p>Because applications which were pending at the EUIPO before Brexit, or registrations which were under cancellation, or EUTM rights that are subject to reinstatement, late renewal, or conversion could resurface later as cloned rights we recommend continuing to keep an eye on the EUIPO register. The UKIPO has also confirmed that any equivalent UK rights created by the cloning of an EU designation of an International Trade Mark will not be entered onto the UK Register by exit day and has not yet confirmed when it expects the UK Register to be updated to include these marks.</p> <p><i>We can advise case by case the risk that anything found on the EUIPO could give rise to a cloned UK right.</i></p>
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