

## EU trade mark protection and comparable UK trade marks from 1 January 2021

The Agreement of the Withdrawal of the United Kingdom from the European Union ended the transition period on 31 December 2020. Thus, as of 1 January 2021, international trade mark registrations protected in the European Union under the Madrid System are no longer protected in the United Kingdom.

It is worth mentioning that UK companies will still be able to apply to the EU Intellectual Property Office (EUIPO) for an European trade mark and there will be no changes to UK registered trade-marks as a result of leaving the European Union although it will require the applicant to have presence in any EU country. Besides, the Withdrawal Agreement provides some protection measures for the owners of EU trade marks registered or granted before the end of the transitional period.

The main one consists of the creation of a comparable UK trade mark for each international registration that has obtained protection in the European Union before 1 January 2021.

This comparable national trade mark will be registered and administered by the UK Intellectual Property Office (UKIPO) and, therefore, will be independent of the international registration. It will be ruled by the UK law, will retain the original filing date of the EU trade mark and will be fully independent of the original European trade mark.

Where the trade mark owner has obtained its protection in the EU as a result of several designations (e.g. through a designation in the original application and a designation filed subsequently), a comparable national trade mark will be created for each designation. This means that it is possible to hold different comparable UK trade marks in respect of a single international registration, but the rights of each of them are independent.

Additionally, if the application for an EU trade mark registration is pending on 1 January 2021, the intellectual property rights' owner may apply for registration of a comparable UK trade mark within the nine months after the end of the transitional period, i.e. up to and including 30 September 2021.

This will also apply to those whose application for international registration or subsequent designation was filed with a national office before 1 January 2021 but whose confirmation of such registration or subsequent designation is dated after that day. The difference is that the nine-month period will start to run from the date on which the international registration was recorded by the World Intellectual Property Organization (WIPO) or, for subsequent designations, from the date on which the application for EU protection was recorded in the International Register.

If you require further guidance please contact our Intellectual Property department lead by our Rocio Escámez.

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