

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>Any opposition before the EUIPO based solely on UK based rights (either registered or unregistered) that is still pending as of exit day, 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 if the ‘parent’ EUIPO is ultimately rejected after exit day.</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. Used where?</p>	<p>For EUTM oppositions, if the opponent’s mark has been used somewhere in the EU, in the last five years, things should be ok provided you are over certain thresholds.</p>

	<p>With regard to the UK specifically, the EUIPO has confirmed that evidence relating to the UK that occurred prior to exit day will be relevant in the assessment of genuine use and will be taken into account. The EUIPO has added that the significance of use in the UK for the overall assessment of genuine use of an EUTM “<i>will progressively decrease – from potentially sufficient to entirely irrelevant – depending upon the extent to which it covers the period for which use has to be established for the case at hand</i>”.</p> <p>In relation to oppositions before the UKIPO based on the cloned UK right deriving from an EUTM, the UKIPO will take account of any use in the EU (both including and excluding the UK) for the five years prior to exit day when considering whether the cloned UK right has been put to genuine use.</p> <p><i>For the future, we have a separate section below on how Brexit affects the non-use maths.</i></p>
<p>What if I am the party who has filed an opposition?</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 trade mark oppositions

<p>After Brexit, can I oppose a UK TM application based on my UK TM?</p>	<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>
<p>After Brexit, can I oppose a UK TM application based on my EUTM?</p>	<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>However, any opposition against a UK national application based on an earlier EUTM that was filed prior to exit day and is still pending will continue before the UKIPO “on the basis of the law as it stood prior to exit day”. This is in contrast to the position the EUIPO is taking in relation to pending oppositions based on earlier rights in the UK.</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>

<p>After Brexit, can I oppose an EUTM application based on my UK TMs (registered or unregistered)?</p>	<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>
<p>After Brexit, can I oppose an EUTM application based on my EUTM?</p>	<p>Yes</p> <p>Such oppositions are unaffected by Brexit.</p> <p><i>Reddie & Grose can work with you on such contentious proceedings before the EUIPO.</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>For EUTM oppositions, if the opponent’s mark has been used somewhere in the EU, in the last five years, things should be ok provided you are over certain thresholds.</p> <p>With regard to the UK specifically, the EUIPO has confirmed that evidence relating to the UK that occurred prior to exit day will be relevant in the assessment of genuine use and will be taken into account. The EUIPO has added that the significance of use in the UK for the overall assessment of genuine use of an EUTM, “<i>will progressively decrease – from potentially sufficient to entirely irrelevant – depending upon the extent to which it covers the period for which use has to be established for the case at hand</i>”.</p> <p>In relation to oppositions before the UKIPO based on the cloned UK right deriving from an EUTM, the UKIPO will take account of any use in the EU (both including and excluding the UK) for the five years prior to exit day when considering whether the cloned UK right has been put to genuine use.</p> <p><i>For the future, we have a separate section below on how Brexit affects the non-use maths.</i></p>
<p>What if I am the party who has filed an opposition?</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 existing cancellation (invalidation and revocation) actions

<p>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.</p> <p>What happens now?</p>	<p>Brexit has no effect</p> <p>The action carries on at UKIPO unaffected.</p>
<p>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.</p> <p>What happens now?</p>	<p>The proceedings will continue</p> <p>The action carries on at the EUIPO. Use in the UK will be taken into account by the EUIPO in the overall assessment of whether the EUTM has been put to genuine use, with the proviso that its significance “<i>will progressively decrease – from potentially sufficient to entirely irrelevant – depending upon the extent to which it covers the period for which use has to be established for the case at hand.</i>”</p> <p>Use in the other EU Member States will be considered in the usual way.</p>
<p>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.</p> <p>What happens now?</p>	<p>Brexit has no effect</p> <p>The action carries on at UKIPO unaffected.</p>
<p>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.</p>	<p>The proceedings will continue</p> <p>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”.</p>
<p>I have an EUTM / 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.</p> <p>What happens now?</p>	<p>Any invalidity action against either an EUTM or Community design, that is based solely on UK rights and is still pending at exit day, will be rejected.</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.</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</i></p>

	before Brexit day to avoid the need to file a separate invalidity action against the cloned UK right.
What if I am the party who has filed a cancellation action?	<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

After Brexit, can a UK TM / design face an invalidation action based on an earlier UK TM / design?	<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>
After Brexit, can a UK TM / design face an invalidation action based on an earlier EUTM / design?	<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 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>
After Brexit, can an EUTM / design face an invalidation action based on an earlier UK TM / design?	<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>Yes</p> <p>This is unaffected by Brexit.</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>