

An easier way for high volume EUTM owners to manage the Brexit transition

What happens on 1 January 2021?

On 1 January 2021, the UK ends its transition period following departure from the EU on 31 January 2020 and leaves the unitary EU Trade Mark (EUTM) system. The following measures will take effect:

- EUTMs will no longer have effect in the United Kingdom.
- Any owner of a registered EUTMs, or equivalent IR designation, will be automatically granted a matching UK trade mark registration.
- Any owner of a pending EUTMs will have the option to file a new UK trade mark application before 30 September 2021 and claim the same priority as the earlier EUTM.

EUTM owners will need to capture and manage UK successor rights, as well as ensuring that new UK priority applications are accurately filed during the nine-month priority window.

What is DOCKY?

DOCKY is a product designed to support EUTM owners in capturing and managing UK successor rights. The key benefits of DOCKY are improved risk management across the Brexit transition, reduced administrative burden on clients, and specialist local IP support for in house teams with no existing UK expertise.

The DOCKY process:

- Clients provide a list of all entities within the corporate group that may own EUTMs.
- Fieldfisher's DOCKY team will identify and import all relevant EUTM rights into our trade mark management system in advance of 1 January 2021.
- All automatically created UK successor rights will be identified, key renewal dates captured and Fieldfisher's

London office will go on record at the UKIPO as address for service. This will ensure that critical correspondence is not missed.

- All pending EUTMs will be docketed and instructions confirmed as to whether matching UK priority applications are required.

Charges and Limitations

- DOCKY is only available to corporate groups owning more than 100 registered EUTMs or 20 pending EUTMs.
- DOCKY is provided at no charge for current Fieldfisher corporate clients and for publicly listed corporates in which no single party has a >25% controlling stake.
- For privately held businesses, or listed businesses with controlling stakeholders, DOCKY is available subject to a one off charge of £2,000 (ex VAT).
- EUTM rights will be imported automatically by reference to publicly available commercial data. EUTM rights will not be manually audited against official registers following import.
- A full audit of EUTM rights will be available for an additional charge of £2,000 (ex VAT) plus £500 (ex VAT) per 100 rights. If this option is requested, the audit will be carried out during the first six months of 2021 and ahead of the 30 September 2021 deadline for claiming priority on new UK applications.
- UK successor applications filed to claim priority from pending EUTMs will be charged to DOCKY clients at a significantly reduced fee of £240 (ex VAT) plus official fees for each new application. Our fees exclude costs arising in the event of objections from the UKIPO or third parties.

For further information, please discuss with your usual Fieldfisher contact.



Leighton Cassidy

Partner, Intellectual Property

+44 (0)20 7861 4669
IP@Fieldfisher.com



Harriet Seymour

Partner, Intellectual Property

+44 (0)20 7861 4899
IP@Fieldfisher.com



Hastings Guise

Partner, Intellectual Property

+44 (0)20 7861 4235
IP@Fieldfisher.com



Amy Reynolds

Partner, Intellectual Property

+44 (0)20 7861 4551
IP@Fieldfisher.com