

Butterworths Intellectual Property Law Series Morcom on Trade Marks

Sixth Edition

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Preface

When the 5th edition of *The Modern Law of Trade Marks* was published, voting in the EU Referendum had not taken place. Since the result on 26 June 2016, there has been continuous political activity and argument and there has been a considerable amount of legislation. As is widely known, the outcome, through the passing of the European Union (Withdrawal) Act 2018, and more recently of the European Union (Withdrawal Agreement) Act 2020, has been that the UK ceased to be an EU Member State on 31 January 2020. The Withdrawal Agreement, though not actually specified by date in the 2020 Act, is the one that was concluded by the UK with the EU representatives, and published by the Government in October 2019. This contained provision for a ‘Transition Period’, that ended on 31 December 2020, during which the UK was treated for some purposes as if it were still an EU Member State. Although there was provision in the Withdrawal Agreement for a possible extension of this period, the Government insisted that UK law prohibited any extension. Of particular relevance, so far as Trade Marks are concerned, is Title IV of Part 3 of the Withdrawal Agreement, containing specific and detailed provisions for the purpose of preserving the UK rights of proprietors of previously registered unitary EU trade marks and other unitary IP rights. Those provisions are all discussed in the relevant chapters of this new edition. Mention must also be made of the UK Government’s action to implement the required provisions of the EU ‘recast’ Harmonisation Directive of 2015. The relevant statutory instrument came into force on 14 January 2019, making many important amendments to the Trade Marks Act 1994 and the Trade Marks Rules 2008, which still apply. Furthermore, since that time and because of the approaching exit of the UK from the EU, many more statutory instruments have been passed, making detailed amendments to the Act and Rules up to 31 December 2020. Although so far as we are aware, the Trade Marks Act 1994 and the Trade Marks Rules 2008, as reproduced as Annexes I and II, are now up to date at the time of concluding the preparation of this 6th Edition, even as we have proceeded they are described as ‘unofficial’ on the UK Intellectual Property Office website.

The significance of the statutory instrument implementing the 2015 Directive, in particular, is that this, and earlier UK legislation implementing EEC/EU Directives, remain in effect as ‘EU-derived domestic legislation’, as provided by s 2 of the European Union (Withdrawal) Act 2018 (as amended) and thus remains part of UK law. These provisions, as well as other applicable EU derived laws, remain a part of UK law as ‘direct EU legislation’, under s 3 of the 2018 Act, at least for the time being.

Preface

One aspect of leaving the EU, which can be regarded as clear, is that EU trade marks, whether registered or the subject of separate applications pending at 31 December 2020, have ceased to have effect as such in the UK after that date. For the UK they have become the subject of registered or pending rights under UK law. We have continued to follow the excellent work that has been done, and which is continuing, by the UK Intellectual Property Office.

Even now, as we conclude our work, and look forward to the publication of our Sixth edition, there are more than a few references to the CJEU from national courts, and some appeals from the General Court, which remain pending. Since decisions of the CJEU and the General Court relating to provisions of trade mark law under applicable Directives and Regulations are expected to remain relevant for a considerable time, and in view of the international interest in matters of EU law, this edition has retained the section on the EU trade mark.

As always, I remain greatly indebted to my co-authors, Ashley Roughton and Thomas St Quintin, for their very considerable contributions to this new edition. We have also received invaluable assistance from many others including, in particular, officials at the UK Intellectual Property Office, colleagues in Hogarth Chambers and IPKat bloggers. We extend our thanks to them all, and to our publishers LexisNexis and their excellent editors.

We hope that users of this book will continue to find it of assistance in understanding the complexities of the law, including the recent amendments of the UK law implementing the 2015 EU Directive. There are two main requirements for traders: one is the need to secure adequate protection for their own trade marks, but the other is the need to avoid infringing the rights of other businesses, in other words ‘to keep out of trouble’ and if possible out of court. Our aim is to provide information which will assist businesses, as well as lawyers and attorneys, in achieving such aims.

Every effort has been made to ensure that this new edition is correct as it stands at the date of this Preface.

*Christopher Morcom QC
Hogarth Chambers
May 2021*

Christopher Morcom’s invaluable contributions and indefatigable dedication to this book throughout its editions are admirable and deserving of acknowledgment. His mastery of trade marks law, practice and procedure has earned him the highest respect and yet he is extremely modest, almost to a fault. It took some persuading, therefore, to convince Christopher that the title of this newest edition should be changed in recognition of the centrality of his role in shaping and developing the book. It is with absolute pleasure that we now introduce the Sixth edition as the newly retitled *Morcom on Trade Marks*.

*Ashley Roughton
Thomas St Quintin
May 2021*