

Foundation Certificate Syllabus

Trade Mark Law FC5 (P7)

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Effective from and including the 2018 examinations

1. Guidance for Candidates

Format of PEB syllabuses

PEB syllabuses contain:

- A **summary** which gives an overview of the examination content and scope.
- A **content** section which advises you what knowledge and/or skills you need for the examination.
- A **learning outcomes** section which describes what you will have to demonstrate in the examination to show that you have the required knowledge and/or skills.
- Lists of the key sections of the **legal provisions** relevant to the content and learning outcomes (where relevant).

- **Candidates should also refer to the Qualifying Examinations Foundation Certificate Programme Specification**

2. The Syllabus

Summary: To complete this examination successfully, you will need to demonstrate knowledge of UK and European Union trade mark law, relevant case law, and a basic knowledge of European Union Trade Mark (EUTM) rights and international convention, in particular the Madrid Protocol for the International Registration of Marks, EU law and the Paris Convention. You will be able to recall the relevant principles, laws and rules, and/or apply them to one or more given scenario(s).

The **Content** advises you what knowledge you need for this examination.

The **Learning Outcomes** describe what you will have to demonstrate in the examination to show that you have the required knowledge.

The final two columns list the key sections of the following **legal provisions** relevant to the content and learning outcomes.

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	Content	Learning outcomes	International Law	UK Law
1	The international protection of trade marks	<ul style="list-style-type: none"> a) Evaluate alternative ways in which a client's rights in a trade mark may be protected internationally, and specifically the strategic considerations for using the Madrid Protocol, the EU Trade Mark, and national filings b) Describe the protection afforded to Well Known Marks by the Paris Convention 	<u>Paris Convention for the Protection of Industrial Property</u> Article 6bis	
2	The Madrid Protocol	<ul style="list-style-type: none"> a) Outline the dependence of the International Registration on a home registration/application, including the requirement for a home registration/application when filing b) Describe how to make an application for an International Registration via a national office c) Outline the procedure from filing through to registration d) Outline the renewal process for an International registration e) Describe the mechanism for central attack and the consequences of a successful attack f) Describe how and why an International Registration may be transformed into national registrations g) Identify which of the G20 countries are members h) Apply (a) to (g) to a scenario 	<u>Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks</u> MP Art 2 – Securing Protection through International Registration MP Art 3 – International Application MP Art 3bis – Territorial Effect MP Art 3ter – Request for Territorial Extension MP Art 4 – Effects of International Registration MP Art 4bis – Replacement of a National or Regional Registration by an International Registration MP Art 5 – Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties	

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	Content	Learning outcomes	International Law	UK Law
			MP Art 6 – Period of Validity of International Registration; Dependence and Independence of International Registration MP Art 7 – Renewal of International Registration MP Art 8 – Fees for international application and registration MP Art 9 – Transformation of an international registration into national or regional applications	
3	The Madrid Protocol: Protection of trade marks in EU (unitary right), France, Germany, Ireland, Italy, Spain, UK, USA, China and Japan.	a) Outline the specific requirements for registering and maintaining registered trade marks in the listed countries through the Madrid Protocol, including: <ul style="list-style-type: none"> • any requirement to pay registration fees once an application has been accepted for registration • any requirement of intent to use the mark • whether the office can refuse a registration, ex-officio, on relative grounds • the length of opposition period • the length of the period after which a mark can be revoked for non-use • any maintenance requirements beyond paying a renewal fee 	<u>Section 8 of the Lanham Act. (15 United States Code, Section 1058)</u>	

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4	The European Union: Trade mark rights in France, Germany, Ireland, Italy, Spain and the UK, and the Conversion of EU Trade Marks	<ul style="list-style-type: none"> a) Outline the legal protection for unregistered trade marks in the listed EU countries b) Outline the conversion process for converting a European Union trade mark application or registration into national applications c) Describe the circumstances in which conversion may be requested d) Describe the consequences or effect of conversion 	<p><u>EU Regulation No. 2017/1001 of 14 June 2017 on the European Union Trade Mark (EUTMR)</u></p> <p><i>“Table on National Rights that Constitute ‘Earlier Rights’ in the Sense of Article 8(4) EUTMR”</i> in EUIPO Guideline “Rights under Articles 8(4) and 8(4a) EUTMR” for the listed EU countries.</p> <p>EUTMR 112 – Request for the application of national procedure EUTMR 113 – Submission, publication and transmission of the request for conversion EUTMR 114 – Formal requirements for conversion</p>	<u>The Trade Marks Act 1994 (UKTMA)</u>
5	Passing off in the UK	<ul style="list-style-type: none"> a) Outline the ingredients of a successful passing off action b) Apply (a) to a scenario 		UKTMA 2 – Registered trade marks
6	The law relating to registrable trademarks	<ul style="list-style-type: none"> a) Define a trade mark b) Outline what cannot be registered as a trade mark c) Describe the overlap with design protection d) Define an earlier trade mark e) Apply (a) to (d) to a scenario 	<p><u>EU Regulation No. 2017/1001 of 14 June 2017 on the European Union Trade Mark (EUTMR)</u></p> <p>EUTMR 1 – European Union trade mark</p>	<p><u>The Trade Marks Act 1994 (UKTMA)</u></p> <p>UKTMA 1 – Trade marks UKTMA 3 – Absolute grounds for</p>

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			EUTMR 4 – Signs of which a European Union trade mark may consist EUTMR 7 – Absolute grounds for refusal EUTMR 8 – Relative grounds for refusal	refusal of registration UKTMA 5 – Relative grounds for refusal of registration UKTMA 6 – Meaning of earlier trade mark
7	Ownership of trade marks	a) Define who may be the proprietor of a registered trade mark	EUTMR 5 – Persons who can be proprietors of European Union trade marks	UKTMA 2 – Registered trade marks
8	The law relating to the application process	a) Describe how to make a trademark application b) List the requirements for obtaining a filing date for an application c) Describe the procedure from filing through to registration, including any available extensions of time d) Outline how goods and services are classified for the registration of trade marks e) Outline how an application for a UK trade mark may be amended or restricted f) Apply (a) to (e) to a scenario	EUTMR 6 – Means whereby a European Union trade mark is obtained EUTMR 30 – Filing of applications EUTMR 31 – Conditions with which applications must comply EUTMR 32 – Date of filing EUTMR 33 – Classification EUTMR 41 – Examination of the conditions of filing EUTMR 42 – Examination as to absolute grounds for refusal EUTMR 43 – Search EUTMR 44 – Publication of the application	UKTMA 32 – Application for registration UKTMA 33 – Date of filing UKTMA 34 – Classification of trade marks UKTMA 37 – Examination of application UKTMA 38 – Publication, opposition proceedings and observations

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				UKTMA 39 – Withdrawal, restriction or amendment of application
9	Opposition and Observations	<ul style="list-style-type: none"> a) Describe when and how third party observations may be filed b) List the grounds for opposition and who may file an opposition c) Outline the opposition process 	EUTMR 45 – Observations by third parties EUTMR 46 – Opposition	UKTMA 6A – Raising relative grounds in opposition in cases of non-use UKTMA 38 – Publication, opposition proceedings and observations
10	Priority and seniority	<ul style="list-style-type: none"> a) Describe the requirements for claiming priority when filing an application b) Determine whether a later application can validly claim priority from an earlier application c) Describe the requirements for claiming seniority for a European Union trade mark application or registration d) Compare the effects of a priority claim with those of a seniority claim 	<u>Paris Convention for the Protection of Industrial Property</u> Articles 1, 4 EUTMR 34 – Right of priority EUTMR 35 – Claiming priority EUTMR 36 – Effect of priority EUTMR 39 – Claiming the seniority of a national trade mark EUTMR 40 – Claiming seniority after registration of the European Union trade mark	UKTMA 35 – Claim to priority of Convention application

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11	Duration of registration	<p>a) Define the term that a trade mark registration is in force and the renewal process for maintaining the trade mark registration</p> <p>b) Explain the <i>restitutio</i> process for a European Union trade mark registration and the restoration process for a UK trade mark registration and the implications of a successful application for <i>restitution</i> or restoration</p>	<p>EUTMR 51 – Registration</p> <p>EUTMR 52 – Duration of registration</p> <p>EUTMR 53 – Renewal</p> <p>EUTMR 104 – <i>Restitutio in integrum</i></p>	<p>UKTMA 42 – Duration of registration</p> <p>UKTMA 43 – Renewal of registration</p> <p>UKTMA 80 - Hours of business and business days</p>
12	A Registered Trade Mark as a form of property	<p>a) Outline how a European Union trade mark registration shall be dealt with as an object of property</p> <p>For a UK Trade Mark:</p> <p>b) Describe how a registered trade mark (or application) may be transferred</p> <p>c) Explain the effect of registration of a transfer and the implications of non-registration</p> <p>d) Describe licensing and the procedure for applying for such licences</p>	<p>EUTMR 19 – Dealing with European Union trade mark as national trade marks</p>	<p>UKTMA 22 – Nature of registered trade mark</p> <p>UKTMA 24 – Assignment of registered trade mark</p> <p>UKTMA 25 – Registration of transactions affecting registered trade mark</p> <p>UKTMA 28 – Licensing of registered trade mark</p>

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13	The law relating to infringement of registered trade marks	a) Identify the acts which infringe the right in a UK or a European Union trade mark registration b) List the statutory exceptions to infringement c) Identify the remedies available to trade mark owners against infringers For a European Union trade mark registration: d) Describe the circumstances in which a proprietor of a mark may object to the publication of the mark in a dictionary e) Describe the exhaustion of rights in a European Union Trade Mark Registration f) Outline the restrictions on a counterclaim for revocation or for a declaration of invalidity g) Apply (a) to (f) to a scenario	EUTMR 9 – Rights conferred by a European Union trade mark EUTMR 12 – Reproduction of European Union trade marks in dictionaries EUTMR 14 – Limitation of the effects of a European Union trade mark EUTMR 15 – Exhaustion of the rights conferred by a European Union trade mark EUTMR 17 - Complementary application of national law relating to infringement EUTMR 127 – Presumption of validity – Defence as to the merits EUTMR 128 – Counterclaims	UKTMA 9 – Rights conferred by registered trade mark UKTMA 10 – Infringement of registered trade mark UKTMA 11 – Limits on effect of registered trade mark UKTMA 14 - Action for infringement UKTMA 15 - Order for erasure, &c. of offending sign UKTMA 16 - Order for delivery up of infringing goods, material or articles.
14	Revocation and invalidation of registered trade marks	a) List of the grounds for revocation and who may file an application for revocation b) List the grounds of invalidity and who may file an application for declaration of invalidity	EUTMR 18 – Use of EU Trade Marks EUTMR 58 – Grounds for Revocation EUTMR 59 – Absolute grounds for invalidity	UKTMA 46 – Revocation of registration

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		c) Describe the consequences or effect of revocation or invalidation of a registration	EUTMR 60 – Relative grounds for invalidity EUTMR 62 – Consequences of revocation and invalidity	UKTMA 47 – Grounds of invalidity of registration
15	Case law on Registered Trade Marks	a) Describe the legal principles established by the named leading cases b) Apply the principles from these cases	<p>Non-conventional trade marks – registrability:</p> <ul style="list-style-type: none"> i. Sieckmann v German Patent and Trademark Office (C-273/00) <p>Absolute Grounds – main cases on the definition of “distinctiveness”:</p> <ul style="list-style-type: none"> ii. Nichols plc v Registrar of Trade Marks, (C404/02) iii. Procter & Gamble Company v OHIM (C-383/99) iv. OHIM v Wm. Wrigley Jr. Company (C-191/01) v. Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) and Boots- und Segelzubehör Walter Huber (C-108/97), <p>3D Designs – limits of the protection available from trade mark law:</p> <ul style="list-style-type: none"> vi. Koninklijke Philips Electronics NV v Remington Consumer Products Ltd, (C-299/99) vii. Société des Produits Nestlé SA v Cadbury UK Ltd, ECJ (C-215/14) and Ch D [2016] EWHC 50 	

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			<p>viii. Linde AG, Winward Industries Inc. and Rado Uhren AG (Joined Cases C-53/01 to 55/01),</p> <p>Relative Grounds – Procedure for assessing "similarity" of marks and goods/services:</p> <p>ix. Sabel BV v Puma AG, Rudolf Dassler Sport (C-251/95)</p> <p>x. Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C-39/97)</p> <p>xi. Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV (C-342/97)</p> <p>Infringement – requirement for “trade mark use”:</p> <p>xii. Arsenal Football Club plc v Mathew Reed ECJ (C-206/01) and CA [2003] EWCA Civ 696</p> <p>xiii. Adam Opel AG v Autec AG (C-48/05)</p>	

3. Reading

NB All the legal provisions and protocols referred to in this syllabus are essential reading.

Other books and/or websites listed here can be used to support your learning. It is not an exhaustive list and other sources of information can be used.

- *Foundation Level Training Manual: The Principles of Trade Mark Law for Patents Candidates* (2009) Rebecca Chambers Ed. Keith Farwell and Robert Weston, pub. CIPA
- *Intellectual Property Law* (4th ed, 2012) Jennifer Davies, pub. OUP
- *Intellectual Property Law Concentrate: Law Revision and Study Guide* (2013) Tim Press, pub. OUP
- *UKIPO Manual of Trade Marks Practice*
- *EUIPO website Trade Mark Practice*
- *WIPO Madrid Protocol*

4. The Examination

This syllabus is assessed via a three hour unseen examination. The pass mark is 50%.

The question paper is divided into Section A and Section B.

There are 100 marks available in total: 40 marks in Section A and 60 marks in Section B.

Candidates are instructed to attempt **all** questions in Section A and **three questions from four questions** in Section B.

- Each question in Section A is worth between 1 and 10 marks.
- Each question in Section B carries 20 marks.