

# Patent Examination Board

## Foundation Certificate Syllabus

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### Trade Mark Law FC5 (P7)

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## **1. Guidance for Candidates**

The Patent Examination Board is an examination agency which has been accredited by IPReg to offer an examination only route for the Foundation Level Qualifications for patent attorneys. FC1 UK Patent Law is one of five examinations within the PEB Foundation Certificate. Together, the five examinations of the PEB Foundation Certificate:

- a) provide a structure which is benchmarked within the QAA Frameworks for Higher Education Qualifications of UK Degree-Awarding Bodies (2014) as being at Level 6 – a professional graduate-level certificate.
- b) develop an understanding and appreciation by the candidates of all the Intellectual Property Law and Professional Ethics Subjects set out in Schedule A of the IPReg Accreditation Handbook
- c) equip candidates with the transferable skills set out in Schedule B of the IPReg Accreditation Handbook

You should refer to the Qualifying Examination Foundation Certificate Programme Specification for full information on the Foundation Certificate including:

- QAA Credits of study
- QAA Level 6 Benchmarking
- IPReg Intellectual Property Law and Professional Ethics subjects
- IPReg General Transferable Skills
- Meeting the Minimum Competence Standard required for a Pass in the Foundation examinations.

The Foundation Certificate is structured to be equivalent to 60 QAA credits (where one credit is 10 hours of study). Each Foundation Certificate examination equates to 12 credits of study. You should, therefore, expect to spend around 120 hours of study in preparation for this examination.

## **2. The Syllabus**

### **Summary**

To be successful in this examination, you will need to:

- demonstrate an understanding and appreciation of the Trade Mark topics set out in Schedule A of the IPReg Accreditation Handbook. You will thus need to demonstrate knowledge of UK trade mark law, relevant case law, and a basic knowledge of European Union Trade Mark (EUTM) rights and international conventions, in particular the Madrid Protocol for the International Registration of Marks, EU law and the Paris Convention.
- demonstrate that you have acquired the transferable skills set out in Schedule B of the IPReg Accreditation Handbook. Candidates should refer to Transferable Skills for more information but in summary, the transferable skills may be demonstrated by being able to recall the relevant principles, laws and rules, and/or apply them to one or more given scenario(s).

The **Content** states the topics which are covered and gives the related IPReg trade mark law topics in brackets.

The **Learning Outcomes** describe what you will have to demonstrate in the examination to show that you have the required knowledge and transferable skills. The section 'Meeting the requirements for a Pass' in the Foundation Programme Specification explains how the Learning Outcomes link to the minimum Pass requirements.

The final column list the key sections of the **legal provisions** relevant to the content and learning outcomes, namely:

**EUTMR** – EU Regulation No. 2017/1001 of 14 June 2017 on the European Union Trade Mark

**MP** – Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

**PC** – Paris Convention for the Protection of Industrial Property

**TMA** – Trade Marks Act 1994 (1994 c.26) including amendments introduced by the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 and Intellectual Property (Exhaustion of Rights) (EU Exit) Regulations 2019

**TMD** – Directive (EU) 2015/2436 of 16 December 2015 to approximate the laws of the Member States relating to trade marks

**EU IPO 2/20** – Communication No 2/20 of the Executive Director of the [EU Intellectual Property] Office of 10 September 2020 on the impact of the United Kingdom's withdrawal from the European Union on certain aspects of the practice of the Office

**WA** – Agreement on the Withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community

**ExR** – Intellectual Property (Exhaustion of Rights) (EU Exit) Regulations 2019 (SI 265/2019)

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	<b>Content</b>	<b>Learning outcomes</b>	<b>Legal Provisions</b>
1	<p><b>The international protection of trade marks</b></p> <p>(Strategic creation and management of trade mark portfolios, registration and maintenance in other key jurisdictions and on the internet, the law of passing off and the legal protection for unregistered trade marks in other key jurisdictions)</p>	<p>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.</p> <p>b) Describe the protection afforded to Well Known Marks by the Paris Convention.</p>	<p>PC - art 6bis – Well Known Marks</p>
2	<p><b>The Madrid Protocol</b></p> <p>(Registration, registering and maintaining a trade mark via the Madrid Protocol)</p>	<p>a) Outline the dependence of the International Registration on a home registration/application, including the requirement for a home registration/application when filing</p> <p>b) Describe how to make an application for an International Registration via a national office</p> <p>c) Outline the procedure from filing through to registration</p> <p>d) Outline the renewal process for an International registration</p> <p>e) Describe the mechanism for central attack and the consequences of a successful attack</p>	<p>MP art 2 – Securing Protection through International Registration</p> <p>MP art 3 – International Application</p> <p>MP art 3bis – Territorial Effect</p> <p>MP art 3ter – Request for Territorial Extension</p> <p>MP art 4 – Effects of International Registration</p> <p>MP art 4bis – Replacement of a National or Regional Registration by an International Registration</p> <p>MP art 5 – Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties</p> <p>MP art 6 – Period of Validity of International Registration; Dependence and Independence of International Registration</p> <p>MP art 7 – Renewal of International Registration</p> <p>MP art 8 – Fees for international application and registration</p>

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		<p>f) Describe how and why an International Registration may be transformed into national registrations</p> <p>g) Identify which of the G20 countries are members</p>	<p>Article 9 - Recordal of Change in the Ownership of an International Registration</p> <p><i>Article 9bis</i> - Recordal of Certain Matters Concerning an International Registration</p> <p>MP art <i>9quinquies</i>: – Transformation of an international registration into national or regional applications</p>
3	<p><b>Laws of Member States of the Madrid Protocol</b></p> <p>UK EU (unitary right) France Germany Ireland Italy Spain USA China Japan</p> <p>(Registration, registering and maintaining a trade mark via the Madrid protocol)</p>	<p>a) Outline the specific requirements for registering and maintaining registered trade marks in the listed countries through the Madrid Protocol, including:</p> <ul style="list-style-type: none"> <li>• any requirement to pay registration fees once an application has been accepted for registration</li> <li>• any requirement of intent to use the mark</li> <li>• whether the office can refuse a registration, ex-officio, on relative grounds</li> <li>• the start and length of any opposition period</li> <li>• the length of the period after which a mark can be revoked for non-use</li> <li>• any maintenance requirements beyond paying a renewal fee</li> </ul>	<p>In particular:</p> <p><b>US Designations:</b> Section 8 of the Lanham Act. (15 United States Code, Section 1058)</p> <p><b>EUIPO Designations:</b> Note in particular ‘Opposition and Observations’ below</p>
4	<p><b>Trade Marks in the European Union:</b></p> <p>EU (unitary right)</p>	<p>a) Demonstrate a broad appreciation that the law of the EUIPO and EU member states is harmonized with that of the UK (and the</p>	<p>EUTMR / TMD (awareness only, except where otherwise specified)</p>

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	<p>France Germany Ireland Italy Spain</p> <p>(Registering and maintaining a trade mark via EUIPO)</p>	<p>differences specifically highlighted in this syllabus)</p> <p>b) Outline the legal protection for unregistered trade marks in the listed EU countries</p> <p>c) Outline the conversion process for converting a European Union trade mark application or registration into national applications</p> <p>d) Describe the circumstances in which conversion may be requested.</p> <p>e) Describe the consequences or effect of conversion.</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 art 139 – Request for the application of national procedure EUTMR art 141 – Formal requirements for conversion EUTMR art 202 – Conversion of Madrid Protocol designations EUIPO 2/20 – VI para 10 – Conversion EUIPO 2/20 – VI para 16 to 24 – Representation</p>
5	<p><b>Passing off in the UK</b></p> <p>(The law of passing off and the legal protection for unregistered trade marks in the UK)</p>	<p>a) Outline the ingredients of a successful passing off action</p> <p>b) Define and identify the subsistence of goodwill in the UK, and differentiate goodwill from mere knowledge or repute of a sign.</p> <p>c) Understand how goodwill may be transferred and extinguished.</p> <p>d) Identify and explain the requirements for demonstrating misrepresentation, including ‘reverse’ passing off, the acquisition of secondary meaning, and the use of similar signs in non-competing fields of commercial activity</p> <p>e) Identify different types of damage, and know the requirements for implying damage</p> <p>f) Understand passing off law as it applies to non-conventional signs including functional items and packaging.</p>	<p>TMA s.2 – Registered trade marks</p>

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6	<p><b>Absolute grounds for refusal.</b></p> <p>(Registration, absolute grounds for refusal of registration in the UK and EUIPO)</p>	<p>a) Outline what cannot be registered as a trade mark, in respect of both conventional and non-convention trade marks.</p> <p>b) Outline the registrability of English words in EU member states.</p>	<p>TMA s.1 – Trade marks TMA s.3 – Absolute grounds for refusal of registration EUTMR art 7 – Absolute grounds for refusal</p>
7	<p><b>Relative grounds for refusal</b></p> <p>(Registration, relative grounds for refusal of registration in the UK and EUIPO)</p>	<p>a) Define an earlier trade mark</p> <p>b) Outline what cannot be registered as a trade mark, in respect of both conventional and non-convention trade marks.</p>	<p>TMA s.5 – Relative grounds for refusal of registration TMA s.5A -Grounds for refusal relating to only some of the goods or services TMA s.6 – Meaning of earlier trade mark EUTMR art 8– Relative grounds for refusal EUIPO 2/20 - V – Earlier rights in inter partes proceedings</p>
8	<p><b>The application process</b></p> <p>(Registering and maintaining a trade mark in the UK)</p>	<p>a) Describe how to make a UK trademark application</p> <p>b) List the requirements for obtaining a filing date for an application</p> <p>c) Describe the procedure from filing through to registration, including any available extensions of time</p> <p>d) Outline how goods and services are classified for the registration of trade marks</p> <p>e) Outline how an application for a UK trade mark may be amended or restricted.</p> <p>f) Explain the consequences of falsely representing a trade mark as registered</p> <p>g) Apply the above to scenarios</p>	<p>TMA s.32 – Application for registration TMA s.33 – Date of filing TMA s.34 – Classification of trade marks TMA s.37 – Examination of application TMA s.39 – Withdrawal, restriction or amendment of application TMA s.60A – Similarity of goods and services TMA s.95 – Falsely representing trade mark as registered EUTMR arts 42 / 193 – Examination as to absolute grounds for refusal EUTMR arts 43 / 195 – Search</p>

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9	<p><b>Opposition and Observations</b></p> <p>(Registering and maintaining a trade mark in the UK and EUIPO)</p>	<p>a) Describe when and how third party observations may be filed</p> <p>b) List the grounds for opposition and who may file an opposition</p> <p>c) Outline the opposition process.</p>	<p>TMA s.6A – Raising relative grounds in opposition in cases of non-use</p> <p>TMA s.38 – Publication, opposition proceedings and observations</p> <p>EUTMR art 44 / 190 – Publication of the application</p> <p>EUTMR art 45 / 193 – Observations by third parties</p> <p>EUTMR art 46 / 198 – Opposition</p>
10	<p><b>Priority and seniority</b></p> <p>(International and trans-national options for trade mark protection)</p>	<p>a) Describe the requirements for claiming priority when filing an application</p> <p>b) Apply the above to scenarios</p> <p>c) Determine whether a later application can validly claim priority from an earlier application</p> <p>d) Describe the requirements for claiming seniority for a European Union trade mark application or registration</p> <p>e) Compare the effects of a priority claim with those of a seniority claim</p>	<p><u>PC</u> arts 1, 4</p> <p>EUTMR arts 39 / 191 – Claiming the seniority of a national trade mark</p> <p>EUTMR arts 40 /192 – Claiming seniority after registration of the European Union trade mark</p> <p>EUIPO 2/20 - III para 7 – Seniorities</p>
11	<p><b>Duration of registration</b></p> <p>(Registering and maintaining a trade mark in the UK)</p>	<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 restoration process for a UK trade mark registration and the implications of a successful restoration</p>	<p>TMA s.42 – Duration of registration</p> <p>TMA s.43 – Renewal of registration</p> <p>TMA s.80 - Hours of business and business days</p>
12	<p><b>A Registered Trade Mark as a form of property</b></p>	<p>a) Define who may be the proprietor of a registered trade mark</p>	<p>TMA s.2 – Registered trade marks</p> <p>TMA s.22 – Nature of registered trade mark</p>



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	(Intellectual property transfer, commercialisation and licensing (including negotiation, international perspective, jurisdiction, arbitration))	<ul style="list-style-type: none"> <li>b) Outline how a trade mark registration shall be dealt with as an object of property</li> <li>c) Explain the effect of registration of a transfer and the implications of non-registration</li> <li>d) Describe licensing and the procedure for applying for such licences</li> </ul>	<p>TMA s.24 – Assignment of registered trade mark  TMA s.25 – Registration of transactions affecting registered trade mark  TMA s.28 – Licensing of registered trade mark</p>
13	<p><b>Infringement</b></p> <p>(Infringement, relative grounds for refusal of registration, defences)</p>	<ul style="list-style-type: none"> <li>a) Identify the acts which infringe a trade mark registration</li> <li>b) List the statutory exceptions to infringement</li> <li>c) Identify the remedies available to trade mark owners against infringers</li> </ul>	<p>TMA s.9 – Rights conferred by registered trade mark  TMA s.10 – Infringement of registered trade mark  TMA s.11 – Limits on effect of registered trade mark  TMA s.11A – Non-use as defence in infringement proceedings  TMA s.12 – Exhaustion of rights conferred by registered trade mark.  TMA s.14 – Action for infringement  TMA s.15 – Order for erasure, &amp;c. of offending sign  TMA s.16 – Order for delivery up of infringing goods, material or articles.</p> <p>EUTMR art 9 / TMD art 10 – Rights conferred by a trade mark  EUTMR art 15 / TMD art 15 – Exhaustion of the rights conferred by a trade mark  WA art.61 – Exhaustion of rights  ExR r.2 - Exhaustion of intellectual property rights</p>
14	<p><b>Revocation and invalidation</b></p> <p>(Invalidity, revocation &amp; use)</p>	<ul style="list-style-type: none"> <li>a) List of the grounds for revocation and who may file an application for revocation</li> <li>b) List the grounds of invalidity and who may file an application for declaration of invalidity</li> </ul>	<p>TMA s.46 – Revocation of registration  TMA s.47 – Grounds of invalidity of registration  EUTMR art 59 – Absolute grounds for invalidity  EUTMR art 60 – Relative grounds for invalidity  EUIPO 2/20 - V –Earlier rights in inter partes proceedings</p>

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		c) Describe the consequences or effect of revocation or invalidation of a registration	
15	<p><b>Case law on Registered Trade Marks</b></p> <p>(Laws and procedures relating to the protection of trade marks (domestic, international and comparative), absolute grounds for refusal of registration, relative grounds for refusal of registration)</p>	a) Describe the legal principles established by the named leading cases.	<p>Non-conventional trade marks – registrability:</p> <ul style="list-style-type: none"> <li>i. Sieckmann v German Patent and Trademark Office (C-273/00)</li> </ul> <p>Absolute Grounds – main cases on the definition of “distinctiveness”:</p> <ul style="list-style-type: none"> <li>ii. Nichols plc v Registrar of Trade Marks, (C404/02)</li> <li>iii. Procter &amp; Gamble Company v OHIM (C-383/99)</li> <li>iv. OHIM v Wm. Wrigley Jr. Company (C-191/01)</li> <li>v. Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) and Boots- und Segelzubehör Walter Huber (C-108/97),</li> </ul> <p>Non-conventional trade marks – limits of the protection available from trade mark law:</p> <ul style="list-style-type: none"> <li>vi. Koninklijke Philips Electronics NV v Remington Consumer Products Ltd, (C-299/99)</li> <li>vii. Société des Produits Nestlé SA v Cadbury UK Ltd, ECJ (C-215/14) and Ch D [2016] EWHC 50</li> <li>viii. Linde AG, Winward Industries Inc. and Rado Uhren AG (Joined Cases C-53/01 to 55/01),</li> </ul>

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			<p>Relative Grounds – Procedure for assessing "similarity" of marks and goods/services:</p> <ul style="list-style-type: none"><li>ix. Sabel BV v Puma AG, Rudolf Dassler Sport (C-251/95)</li><li>x. Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C-39/97)</li><li>xi. Lloyd Schuhfabrik Meyer &amp; Co. GmbH v Klijsen Handel BV (C-342/97)</li></ul> <p>Infringement – requirement for “prejudicial use”:</p> <ul style="list-style-type: none"><li>xii. Arsenal Football Club plc v Mathew Reed ECJ (C-206/01) and CA [2003] EWCA Civ 696</li><li>xiii. Adam Opel AG v Autec AG (C-48/05)</li></ul>
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### **3. Reading**

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

Other books and/or websites can be used to support your learning, including any current undergraduate-level textbook on Intellectual Property law. Although it is not an exhaustive list, other sources of information include:

- *UKIPO Manual of Trade Marks Practice*
- *EUIPO Guidelines for Examination*
- *WIPO Guide to the International Registration of Marks under the Madrid Agreement and the 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.