

Patent Examination Board

Foundation Certificate Syllabus

Trade Mark Law FC5 (P7)

Contents

Guidance for Candidates

The Syllabus

Reading

The Examination

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. FC5 Trade Mark 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 understanding of the intellectual property law and professional ethics subjects set out in Schedule A of the IPReg Accreditation Handbook and the professional ethics applicable to IP practitioners: IPReg's Overarching Principles and Code of Conduct; standards of care and duties to clients, conflicts of interest, client confidentiality, financial activity, professional integrity;
- 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)

Amendments to this syllabus made since the previous published version are indicated by **highlighted** text.

	Content	Learning outcomes	Legal Provisions
Candidates will demonstrate ability to meet the learning outcomes, including by applying their knowledge and understanding to a given scenario.			
1	The international protection of trade marks (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)	Explain: a) 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, including combinations thereof. b) the protection afforded to Well Known Marks by the Paris Convention.	PC - art 6bis – Well Known Marks
2	The Madrid Protocol (Registration, registering and maintaining a trade mark via the Madrid Protocol)	Explain: a) the dependence of the International Registration on a home registration/application, including the requirements for a base registration/application. b) the procedure from filing through to registration c) the renewal process for an International registration d) the mechanism for central attack and the consequences of a successful attack e) how and why an International Registration may be transformed into national registrations	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 MP art 6 – Period of Validity of International Registration; Dependence and Independence of International Registration

PEB Foundation Certificate
Trade Mark Law FC5 (P7)

	Content	Learning outcomes	Legal Provisions
		State which of the G20 countries are members (ignore the African Union).	MP art 7 – Renewal of International Registration MP art 8 – Fees for international application and registration Article 9 – Recordal of Change in the Ownership of an International Registration <i>Article 9bis</i> - Recordal of Certain Matters Concerning an International Registration MP art 9 <i>quinquies</i> : – Transformation of an international registration into national or regional applications
3	Laws of Member States of the Madrid Protocol UK EU (unitary right) France Germany Ireland Italy Spain USA China Japan (Registration, registering and maintaining a trade mark via the Madrid protocol)	Outline the specific requirements for registering and maintaining registered trade marks in the listed countries through the Madrid Protocol, namely: a) any requirement of intent to use the mark b) whether the office can refuse a registration, ex-officio, on relative grounds c) the start and length of any opposition period d) any requirement to pay registration fees once an application has been accepted for registration e) the length of the period after which a mark can be revoked for non-use f) any maintenance requirements beyond paying a renewal fee	In particular: US Designations: Section 8 of the Lanham Act. (15 United States Code, Section 1058) EUIPO Designations: Note in particular ‘Opposition and Observations’ below

PEB Foundation Certificate
Trade Mark Law FC5 (P7)

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4	Trade Marks in the European Union: (Registering and maintaining a trade mark via EUIPO)	a) Demonstrate a broad appreciation that the law of the EUIPO and EU member states is harmonized with that of the UK (and the differences specifically highlighted in this syllabus) b) Outline the legal protection for unregistered trade marks in the following EU countries: France Germany Ireland Italy Spain c) Explain: - the conversion process - the circumstances in which conversion may be requested. - the consequences or effect of conversion.	EUTMR / TMD (awareness only, except where otherwise specified) <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. 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
5	Passing off in the UK (The law of passing off and the legal protection for unregistered trade marks in the UK)	Explain: a) the ingredients of a successful passing off action b) the subsistence of goodwill in the UK, differentiating goodwill from mere knowledge or repute of a sign. c) how goodwill may be transferred and extinguished. d) the requirements for demonstrating misrepresentation, including ‘reverse’ passing off, the acquisition of secondary meaning, and	TMA s.2 – Registered trade marks

PEB Foundation Certificate
Trade Mark Law FC5 (P7)

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		the use of similar signs in non-competing fields of commercial activity e) different types of damage, and know the requirements for implying damage f) passing off law as it applies to non-conventional signs including functional items and packaging.	
6	Absolute grounds for refusal. (Registration, absolute grounds for refusal of registration in the UK and EUIPO)	Explain: a) the law on what can and cannot be registered as a trade mark, in respect of both conventional and non-convention trade marks including - packaging - shape marks other than packaging - names of pharmaceuticals, plant varieties, and appellations of origin. using the principles and methodology established by the case law below. b) the registrability of English words in EU member states.	TMA s.1 – Trade marks TMA s.3 – Absolute grounds for refusal of registration EUTMR art 7 – Absolute grounds for refusal
7	Relative grounds for refusal (Registration, relative grounds for refusal of registration in the UK and EUIPO)	Explain: a) the concept of an earlier right b) requirements concerning the ‘use’ of earlier rights. c) the grounds for mounting a successful opposition, invalidity or infringement action,	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

PEB Foundation Certificate
Trade Mark Law FC5 (P7)

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		whether based on confusion, dilution, free-riding, or other relative grounds. - using the principles and methodology established by the case law below.	
8	The application process (Registering and maintaining a trade mark in the UK)	Explain: a) the requirements for obtaining a filing date for an application b) the procedure from filing through to registration, including any available extensions of time c) in outline, how goods and services are classified for the registration of trade marks (there is know need to know Nice class numbers) d) how an application for a UK trade mark may be amended or restricted. e) the consequences of falsely representing a trade mark as registered	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
9	Opposition and Observations (Registering and maintaining a trade mark in the UK and EUIPO)	Explain: a) the system for third party observations b) the grounds for opposition and who may file an opposition c) in outline, the opposition process.	TMA s.6A – Raising relative grounds in opposition in cases of non-use TMA s.38 – Publication, opposition proceedings and observations EUTMR art 44 / 190 – Publication of the application EUTMR art 45 / 193 – Observations by third parties EUTMR art 46 / 198 – Opposition

PEB Foundation Certificate
Trade Mark Law FC5 (P7)

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10	Priority and seniority (International and trans-national options for trade mark protection)	Explain: a) the requirements for claiming priority when filing an application b) rules on whether a later application can validly claim priority from an earlier application c) the requirements for claiming seniority for a European Union trade mark application or registration d) the effects of a priority claim or a seniority claim, and be able to compare the two.	<u>PC</u> arts 1, 4 EUTMR arts 39 / 191 – Claiming the seniority of a national trade mark EUTMR arts 40 /192 – Claiming seniority after registration of the European Union trade mark EUIPO 2/20 - III para 7 – Seniorities
11	Duration of registration (Registering and maintaining a trade mark in the UK)	Explain: a) the term that a trade mark registration is in force and the renewal process for maintaining the trade mark registration b) the restoration process for a UK trade mark registration and the implications of a successful restoration	TMA s.42 – Duration of registration TMA s.43 – Renewal of registration TMA s.80 - Hours of business and business days
12	A Registered Trade Mark as a form of property (Intellectual property transfer, commercialisation and licensing (including negotiation, international perspective, jurisdiction, arbitration))	Explain: a) the law on who may be the proprietor of a registered trade mark b) how a trade mark registration shall be dealt with as an object of property c) the effect of registration of a transfer and the implications of non-registration d) the concept of licensing, and the requirements for granting and registering licences	TMA s.2 – Registered trade marks TMA s.22 – Nature of registered trade mark 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

PEB Foundation Certificate
Trade Mark Law FC5 (P7)

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13	Infringement (Infringement, relative grounds for refusal of registration, defences)	Explain: a) the acts which infringe a trade mark registration b) the statutory and case-law exceptions to infringement c) the remedies available to trade mark owners against infringers	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, &c. of offending sign TMA s.16 – Order for delivery up of infringing goods, material or articles 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
14	Revocation and invalidation (Invalidity, revocation and use)	Explain: a) the grounds for revocation and who may file an application for revocation b) the grounds of invalidity and who may file an application for declaration of invalidity c) the consequences or effect of revocation or invalidation of a registration	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

PEB Foundation Certificate
Trade Mark Law FC5 (P7)

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15	Case law on Registered Trade Marks (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)	a) Explain and apply the legal principles established by the named leading cases	Non-conventional trade marks – registrability: vi. Sieckmann v German Patent and Trademark Office (C-273/00) Absolute Grounds – main cases on the definition of “distinctiveness”: vii. Nichols plc v Registrar of Trade Marks, (C404/02) viii. Procter & Gamble Company v OHIM (C-383/99) ix. OHIM v Wm. Wrigley Jr. Company (C-191/01) x. Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) and Boots- und Segelzubehör Walter Huber (C-108/97) Non-conventional trade marks – limits of the protection available from trade mark law: xi. Koninklijke Philips Electronics NV v Remington Consumer Products Ltd, (C-299/99) xii. Société des Produits Nestlé SA v Cadbury UK Ltd, ECJ (C-215/14) and Ch D [2016] EWHC 50 xiii. Lego Juris v OHIM (C-48/09) Relative Grounds – Procedure for assessing "similarity" of marks and goods/services: xiv. Sabel BV v Puma AG, Rudolf Dassler Sport (C-251/95) xv. Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C-39/97) xvi. Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV (C-342/97) Infringement – requirement for “prejudicial use”: xvii. Arsenal Football Club plc v Mathew Reed ECJ (C-206/01) and CA [2003] EWCA Civ 696 - xviii. Adam Opel AG v Autec AG (C-48/05)

3. Reading

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

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 such as current undergraduate-level textbooks on intellectual property law.

- *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 **2** and 10 marks.
- Each question in Section B carries 20 marks.