

JOINT EXAMINATION BOARD

PAPER P7

Principles of Trade Mark Law
Foundation Level

Syllabus for the examinations under the Examination Regulations pursuant to the
Rules for the Registration of Patent Agents

NOTE:

Candidates will not be expected to display knowledge of amendments to any Statutes or Rules or new case law published during the six months immediately preceding the date of any particular examination.

Candidates are expected to show for:

I. United Kingdom Trade Mark Law

- A. A general knowledge of the whole of the Trade Marks Act 1994.
- B. A working knowledge of the following sections of the Trade Marks Act 1994 and the associated Rules:
 - 1. Trade marks.
 - 2. Registered trade marks.
 - 3. Absolute grounds for refusal of registration.
 - 5. Relative grounds for refusal of registration.
 - 6. Meaning of “earlier trade mark”.
 - 9. Rights conferred by registered trade mark.
 - 10. Infringement of registered trade mark.
 - 11. Limits on effect of registered trade mark.
 - 22. Nature of registered trade mark.
 - 24. Assignment, &c. of registered trade mark.
 - 25. Registration of transactions affecting registered trade mark.
 - 28. Licensing of registered trade mark.
 - 32. Application for registration.
 - 33. Date of filing.
 - 34. Classification of trade marks.
 - 35. Claim to priority of Convention application.
 - 37. Examination of application.
 - 38. Publication, opposition proceedings and observations.
 - 39. Withdrawal, restriction or amendment of application.
 - 40. Registration.
 - 42. Duration of registration.
 - 43. Renewal of registration.
 - 46. Revocation of registration.
 - 47. Grounds for invalidity of registration.

Information of the Trade Marks Act 1994 can be found at <http://www.ipo.gov.uk/tm/legal/tmact94.pdf> and the Trade Mark Rules 2008 at <http://www.ipo.gov.uk/tmrules2008.pdf>

C A general knowledge of basic principles of the law of passing off. (suggested source *Passing Off: Law and Practice* by John Drysdale and Michael Silverleaf Publisher: Butterworths Law (31 Dec 1986) ISBN-10: 0406253404 ISBN-13: 978-0406253408

II Community Trade Mark Law

A A general knowledge of the whole of the Community Trade Mark Regulation (CTMR)

B A working knowledge of the below-listed Articles and associated Rules:

Preamble

Article 1 Community trade mark

Article 2 Office

Article 3 Capacity to act

Article 4 Signs of which a Community trade mark may consist

Article 5 Persons who can be proprietors of Community trade marks

Article 6 Means whereby a Community trade mark is obtained

Article 7 Absolute grounds for refusal

Article 8 Relative grounds for refusal

Article 9 Rights conferred by a Community trade mark

Article 10 Reproduction of Community trade marks in dictionaries

Article 13 Exhaustion of the rights conferred by a Community trade mark

Article 25 Filing of applications

Article 26 Conditions with which applications must comply

Article 27 Date of filing

Article 28 Classification

Article 29 Right of priority

Article 30 Claiming priority

Article 34 Claiming the seniority of a national trade mark

Article 35 Claiming seniority after registration of the Community trade mark

Article 36 Examination of the conditions of filing

Article 37 Examination as to absolute grounds for refusal

Article 38 Search

Article 39 Publication of the application

Article 40 Observations by third parties

Article 41 Opposition

Article 45 Registration

Article 46 Duration of registration

Article 47 Renewal

Article 51 Grounds for Revocation

Article 52 Absolute grounds for invalidity

Article 53 Relative grounds for invalidity

Article 81 *Restitutio in integrum*

Article 112 Request for the application of national procedure

Article 113 Submission, publication and transmission of the request for conversion

Article 114 Formal requirements for conversion

Information of the Basic Regulation (CTMR) can be found at

<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF> and of the Implementing Regulation (CTMIR or IR) can be found at <http://oami.europa.eu/ows/rw/resource/documents/CTM/regulations/2868en-codified.pdf>

III Case Law

- A A working knowledge of the underlying principles of the below-listed, leading ECJ decisions on trade marks (which now have precedence over equivalent UK cases):
Sabel v Puma, [1997] ECR I-6191
Canon v MGM, [1988] ECR I-5507, [1999] RPC 117
Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) and Boots- und Segelzubehör Walter Huber (C-108/97), Franz Attenberger (C-109/97) Joined Cases [1999] ECR I-2779

IV Outline of enforcement of CTM rights

- A A basic knowledge of the following Articles of the Community Trade Mark Regulation:
Article 95 Community trade mark courts
Article 96 Jurisdiction over infringement and validity
Article 97 International jurisdiction
Article 98 Extent of jurisdiction
Article 99 Presumption of validity — Defence as to the merits
Article 100 Counterclaims

V International Conventions

- A Madrid
A basic knowledge of the provisions of the Madrid Protocol for the International Registration of Marks (“the Madrid System”) as set forth in the below listed Articles
Article 2: Securing Protection through International Registration
Article 3: International Application
Article 3bis: Territorial Effect
Article 3ter: Request for “Territorial Extension”
Article 4: Effects of International Registration
Article 4bis: Replacement of a National or Regional Registration by an International Registration
Article 5: Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties
Article 6: Period of Validity of International Registration; Dependence and Independence of International Registration
Article 7: Renewal of International Registration
Article 16: Signature; Languages; Depository Functions

Notes:

The Basic Knowledge being sufficient to cover need for home registration/ application, filing at national office, central attack, transformation, and centralised post grant procedures.

Knowledge of the Madrid Agreement is no longer thought necessary for a UK Patents Candidate and following the repeal of Article 9sexies of the Agreement: Relations Between States Party to both this Protocol and the Madrid (Stockholm) Agreement

Information the on Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks can be found at http://www.wipo.int/madrid/en/legal_texts/trtdocs_wo016.html

B EC-EU Law

In broad outline the principal provisions of European ~~Community~~-Union Law affecting trade marks, of the [Treaty on the Functioning of the European Union \(formerly the Treaty establishing the European Community \[“Treaty of Amsterdam/Rome;”\]; amended by the Treaty of Lisbon\)](#) and to understand the doctrines of free movement of goods and exhaustion of rights; namely Articles:

[2834](#) Quantitative restrictions on imports and all measures having equivalent effect shall be prohibited between Member States.

[2935](#) Quantitative restrictions on exports, and all measures having equivalent effect, shall be prohibited between Member States.

[3036](#) not to constitute a means of arbitrary discrimination or a disguised restriction on trade between Member States.

[81101](#) prohibited as incompatible with the common market: all agreements between undertakings

[82102](#) abuse by one or more undertakings of a dominant position

Information on the Treaty [on the Functioning of the European Union](#) of ~~Amsterdam~~ ~~Consolidated-consolidated~~ text can be found at: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2010:083:0047:0200:EN:PDF>
http://eur-lex.europa.eu/en/treaties/dat/12002E/pdf/12002E_EN.pdf

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C Paris Convention

The provisions of Articles 4 (priority) and 6bis (famous marks) of the Paris Convention for the Protection of Intellectual Property

Information on the Paris Convention can be found at http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html

Assessment Method and Success Criteria

Unseen examination lasting two hours. The examination paper will comprise a series of questions set out in two parts.

The first part (Part A) comprises nine questions of which eight must be answered. Each question will carry five marks. These questions will be particularly directed at testing knowledge.

The second part (Part B) comprises six questions of which five must be answered. Each question will carry twelve marks. The questions will require knowledge and a demonstration of understanding of the law.

Candidates gaining 50% or more of the marks available for the paper will be deemed to have passed the examination.