

**THE JOINT EXAMINATION BOARD**  
**SYLLABUS – PAPER T5**  
**BASIC OVERSEAS TRADE MARK LAW AND PRACTICE**

**NOTE:**

Candidates will not be expected to display knowledge of amendments to any statutes or rules or new case law published subsequent to the three months immediately preceding the date of any particular examination.

This paper is designed to ensure that the practitioner is capable of advising generally on the protection available for trade marks under overseas legislation in various pre-specified countries. It does not presume a detailed knowledge of peculiarities of local law or practice in the countries concerned.

**National Laws**

For the countries listed below, candidates will be expected to know:

- The legal bases for application
- Any special documents required for filing
- Whether there is an official examination or search
- The application procedure
- Whether letters of consent are accepted as a means to overcome relative grounds for refusal
- Whether it is possible to oppose and, if so, on what grounds
- The opposition procedure in outline
- Whether it is possible to cancel a registration and, if so, on what grounds, including the period of non-use required as a basis for cancellation
- Whether protection in these countries may be obtained under the Madrid Agreement, the Madrid Protocol or the European Community Trade Mark Regulation

- Whether there is provision for recordation of licences and, if so, the effect of recordation *vis a vis* both the parties to the licence and third parties
- Whether there is any requirement for proof of use of a trade mark to enable an application to proceed to registration or to maintain a registration in force.

### **List of countries**

- |             |                              |
|-------------|------------------------------|
| • France    | • Japan                      |
| • Germany   | • Mexico                     |
| • Spain     | • New Zealand                |
| • Benelux   | • Norway                     |
| • Italy     | • People's Republic of China |
| • Eire      | • Singapore                  |
| • Denmark   | • South Africa               |
| • Australia | • Switzerland                |
| • Brazil    | • Taiwan                     |
| • Canada    | • Thailand                   |
| • Hong Kong | • USA                        |

### **International Conventions**

Candidates will be expected to have a similar level of knowledge to that set out above concerning the provisions of the Madrid Arrangement for the International Registration of Marks, the Madrid Protocol for the International Registration of Marks, and the Community Trade Mark Regulation to that required for the national laws of the countries listed above.

They will be expected to know which of the countries mentioned above are members of these conventions.

In addition, they will be expected to know what is meant by the concepts of:

- Transformation and conversion under, respectively, the Madrid Protocol and the Community Trade Mark Regulation, when transformation or conversion may come about and, in outline, the procedures involved;
- Central attack under the Madrid Arrangement and under the Madrid Protocol for the International Registration of marks;

Candidates should also be able to compare any of these International Conventions with each other and with national laws.

### **EC Law**

Candidates will be expected to know the principal provisions of European Community Law affecting trade marks, namely, Articles 28, 29, 30, 81 and 82 of the Treaty of Amsterdam, and to understand the doctrines of free movement of goods and exhaustion of rights.

### **Other matters**

Candidates will be expected to know:

- The provisions of Articles 3 (equal treatment) and 4 (priority) of the Paris Convention for the Protection of Intellectual Property
- What is meant by a pre-rights (or prior-rights) Declaration

April 2005