

## Paper T6

### Advanced Community Trade Mark and International Trade Mark Law and Practice

<b>Element</b>	<b>Description</b>
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<i>Level</i>	<i>Advanced</i>
<i>Prerequisites</i>	A. the Trade Mark Foundation paper T2; or B. Patent Foundation Paper P1 and the Common Foundation Papers;
<i>Aim</i>	To test candidates understanding of the law and practice relating to the registration, enforcement and exploitation of Community trade mark rights and International trade mark rights under the Madrid Protocol. To test knowledge of the Madrid Agreement insofar as it compares with the Madrid Protocol.
<i>Knowledge and skills</i>	<u>Community Trade Mark:</u> <ul style="list-style-type: none"><li>• Understand relevant Community Trade Mark legislation and apply the principles contained within it.</li><li>• Understand and apply the concepts of absolute grounds for refusal.</li><li>• Analyse and assess grounds for opposition, revocation and invalidity.</li><li>• Understand and apply post registration procedures.</li><li>• Identify and advise on Infringement and Passing Off, including procedures and remedies.</li><li>• Understand, advise on and prepare Evidence.</li><li>• Understand and advise on appeal procedures.</li></ul> <u>Madrid Protocol:</u> <ul style="list-style-type: none"><li>• Understand relevant Madrid Protocol legislation and apply the procedures and principles contained within it.</li><li>• Analyse and assess grounds for opposition, revocation and invalidity.</li><li>• Understand and apply post registration procedures.</li></ul>

<p><i>Competencies tested</i></p>	<ul style="list-style-type: none"> <li>• Understand, assess and analyse complex professional issues.</li> <li>• Identify key points in complex professional issues.</li> <li>• Understand, assess, and analyse instructions from clients.</li> <li>• Give advice to clients framed according to the audience.</li> <li>• Apply the relevant Laws and Rules to a given set of circumstances.</li> <li>• Consider, assess and analyse different options for clients, and be able to propose the most appropriate recommendations in accordance with a given set of circumstances.</li> <li>• Re-assess the client's position as new information comes to light.</li> <li>• Be able to identify information which is missing from that provided in order to give an opinion to a client.</li> <li>• Provide practical advice to a client in order to improve their position.</li> <li>• Draft and prepare documents for use in registration, enforcement and exploitation of trade mark rights.</li> <li>• Compare and contrast options for filing trade mark applications.</li> </ul>
<p><i>Knowledge required (detailed knowledge unless otherwise specified)</i></p>	<p><b><u>Community Trade Mark</u></b></p> <p><u>Application Procedure</u></p> <ul style="list-style-type: none"> <li>• Who may apply</li> <li>• Basis of application</li> <li>• Application Form</li> <li>• Language</li> <li>• Representation</li> </ul> <p><u>Classification</u></p> <ul style="list-style-type: none"> <li>• A general (non-detailed) knowledge of the classification of goods and services</li> <li>• Practice relating to multi-class applications</li> </ul>
	<p><u>Convention priority:</u></p> <ul style="list-style-type: none"> <li>• Requirements, effect, supporting documents and deadlines</li> </ul> <p><u>Seniority</u></p> <ul style="list-style-type: none"> <li>• Requirements, effect, supporting documents and deadlines</li> </ul>

## Collective Marks

### Registrability and absolute grounds for refusal

- Definition of a trade mark
- Capable of being represented graphically
- Distinctiveness
- Colours
- Geographical marks
- Letters and numerals
- Surnames
- Foreign words
- Specially protected emblems
- Contrary to public policy/deceptive
- Evidence of use

### Community and National Searches

#### Community Trade Marks Bulletin

- What information is published
- Post-publication observations

#### Opposition

- Grounds for opposition
- Language
- Admissibility
- Procedure including drafting of documents and evidence
- Deadlines
- Cooling-off period
- Costs

#### Revocation and Invalidation

- Grounds for revocation and invalidity
- Procedure including drafting of documents and evidence
- Deadlines
- Consequences of revocation and invalidity
- Costs

#### Community Trade Marks as objects of property

- Transfer
- Licensing

- Rights in renewal
- Bankruptcy or like proceedings

#### Maintenance/Formalities

- Duration of registration and renewal procedures
- Use of a Community Trade Mark
- Change of name or address
- Voluntary limitation of specification
- Surrender
- Amendment of a trade mark
- Correction of errors
- Inspection of files
- A general knowledge of fees (non-detailed)

#### Legal Actions and Disputes

- Effect of trade mark registrations
- Community Trade Mark Courts
- Jurisdiction
- Presumption of validity
- Counterclaims
- Applicable law
- Sanctions
- Specific rules on related actions
- Effects on the laws of the member states
- Costs

#### Appeals

- Procedure
- Deadlines

#### Conversion

- Requirements of conversion
- Deadlines

#### Oral Proceedings and taking of evidence

#### Notifications

#### Time limits

#### Official Journal of the Office

#### Reported Cases

- Including decisions of the European Court of Justice

#### Treaty of Amsterdam

- Articles 28, 29, 30, 81 and 82

#### National Trade Mark Law

- Outline knowledge of national trade mark laws of member countries of the European Union insofar as it relates to the Community trade mark.

#### **International Trade Marks**

##### Madrid Protocol

#### Application Procedure

- Who may apply
- Basis of application
- Office of origin
- Language
- Representation
- Contracting parties
- WIPO

#### Classification

- A general (non-detailed) knowledge of the classification of goods and services
- Practice relating to multi-class applications

#### Convention priority

- Requirements, effect, supporting documents and deadlines

#### Procedure

- Substantive requirements
- Examination by WIPO
- Examination by Contracting Parties
- Irregularities
- Grounds for refusal
- Remedying defects and irregularities
- Publication
- Registration
- Duration and Renewal
- Opposition

	<ul style="list-style-type: none"> <li>• Time limits</li> </ul> <p><u>Maintenance/Formalities</u></p> <ul style="list-style-type: none"> <li>• Dependence and Independence</li> <li>• Central attack</li> <li>• Ceasing of effect</li> <li>• Transformation</li> <li>• Replacement</li> <li>• Change of name or address</li> <li>• Correction of errors</li> <li>• Subsequent designations</li> <li>• Limitation, renunciation and cancellation</li> <li>• Transfers</li> <li>• A general knowledge of fees (non-detailed)</li> </ul> <p><u>Treaty of Amsterdam</u></p> <ul style="list-style-type: none"> <li>• Articles 28, 29, 30, 81 and 82</li> </ul> <p><u>National Trade Mark Law</u></p> <ul style="list-style-type: none"> <li>• Outline knowledge of national trade mark laws of member countries of the European Union.</li> </ul> <p><u>Other topics</u></p> <ul style="list-style-type: none"> <li>• WIPO Gazette of International Marks</li> <li>• International Register</li> <li>• Comparison of the Madrid Agreement with the Madrid Protocol</li> <li>• Comparison of Madrid system with national filings</li> <li>• Reported cases including decisions of the European Court of Justice</li> </ul>
<p><i>Assessment method and criteria</i></p>	<p>4 hour unseen examination, answering 4 out of 6 questions (each with 25 marks) relating to problem-solving given a set of circumstances and/or drafting documents for use in registration, enforcement or exploitation of trade mark rights and/or explanation of legal points.</p> <p>The pass mark is 50%.</p>