

FC5¹ Trade Mark Law: Course Description

Course summary

This intensive two-day course is designed to help prepare trainee patent attorneys for the Foundation Certificate (FC) Patent Examination Board (PEB) paper on Trade Mark Law for which candidates are expected to: demonstrate knowledge of UK and European Community trade mark law, relevant case law, and a basic knowledge of Community Trade Mark (CTM) rights and international convention, in particular the Madrid Protocol for the International Registration of Marks, EU law and the Paris Convention. Candidates will be expected to be able to recall the relevant principles, laws and rules, and/or apply them to one or more given scenario(s).

The underpinning knowledge will be presented via lectures linked to handout notes on the main topics of the syllabus. There will be opportunities for individual and small group practice of questions from recent exams so that participants can learn, with feedback from the tutor, on how to apply their knowledge to exam questions. The tutor will also provide advice on exam technique and the examiners' expectations.

Content

The course comprises sessions on UK trade mark law, passing off, European Community trade mark law, leading decided cases of the Court of Justice of the European Union (CJEU), the Madrid Protocol and Paris Convention. These cover the main topics in the FC5 syllabus (see **Annexe A**). There is also a session on exam technique and closing advice on post-course final preparations for the exam. Below we set out a summary of the content of each session and expected learning outcomes.

¹ Formerly the P7 paper.

Pre-course preparation

Summary

Annexe B sets out guidance on pre-course preparation. Through reading the FC5 syllabus and instructions to and content of past papers, participants will understand what the syllabus covers, the expected depth of knowledge and the format and challenge of the exam. While the course lectures and notes will cover the key areas of the syllabus, it would be helpful for participants to read the materials set out in **Annexe B** before start of the course, so that they are well prepared.

Expected learning outcomes

At the completion of pre-course preparation, participants will be able to:

- describe the scope of the FC5 syllabus, the syllabus themes and the level of knowledge expected on each;
- recall the format of the exam, including numbers of questions they are required to answer, and the exam instructions and regulations; and
- participate in discussions on passing off, the UKTMA, CTMR, Madrid Protocol, Paris Convention and EC Treaty on the basis of their pre-course reading.

Session 1: Overview of FC5 and Suggestions on Exam Technique

Session summary

In this session, the tutor will provide, through a presentation, an overview of the FC5 syllabus, the format of the exam, what the examiner is looking for and advice on exam technique. Throughout the course, participants will practise past questions and receive feedback from the tutor and the group.

Expected learning outcomes

At the end of this session, participants will be able to:

- recognise what the examiner expects in question answers and how to structure answers;
- recount how many questions need to be answered in each Part of the paper and how marks are distributed across the paper; and
- recall strategies for managing time pressures during the exam and structuring answers.

Session 2: UK Trade Mark Law

Session summary

In this session, participants will gain general knowledge of UK Trade Mark law, including: what may be registered; applying for a trade mark; grounds for refusal; effects of a registered trade mark; infringing acts; registrable transactions; licences; official examination procedure; amendment of applications; opposition procedure; duration and renewal; revocation and invalidity. Teaching will be through lectures by the tutor linked to handout material on the topics, including the relevant sections of the UKTMA and Rules. There will also be practice of past questions.

Expected learning outcomes

At the end of this session, participants will be able to describe and explain - demonstrating this by applying this knowledge to their answers to past exam questions - their understanding of the:

- characteristics of trade marks;
- process of trade mark registration in the UK; and
- rights conferred by trade mark registration.

Session 3: Passing Off

Session summary

In this session, participants will gain general knowledge of the law of passing off, including what is passing off and what elements must be present. Teaching will be through a lecture by the tutor, linked to handout material and introduction to some leading cases.

Expected learning outcomes

At the end of this session, participants will be able to describe and explain - demonstrating this by applying this knowledge to their answers to past exam questions - their understanding of:

- what is the leading case on passing off – *Reckitt & Colman Ltd v Borden Inc [1990] 1 All E.R. 873* (also known as the Jif Lemon case);
- what must be present for passing off to be demonstrated – a) goodwill/reputation; b) misrepresentation; and, c) damage; and
- how passing off is proved in a trade mark opposition.

Session 4: EU Trade Mark Law

Session summary

In this session, participants will gain general knowledge of specified articles of the EC Treaty affecting trade mark law. Teaching will be through a lecture by the tutor linked to handout material on the topics including the relevant articles and practice of past questions.

Expected learning outcomes

At the end of this session, participants will be able to describe and explain - demonstrating this by applying this knowledge to their answers to past exam questions - their understanding of:

- the sources and different types of EU trade mark law;
- articles 35-36 of the EC Treaty on the doctrine of free movement of goods;
- article 101 of the EC Treaty on prohibited agreements
- article 102 of the EC Treaty on the abuse of a dominant position.

Session 5: Community Trade Mark (CTM) Law

Session summary

In this session, participants will gain general knowledge of CTM law and working knowledge of relevant articles of the CTMR, including what is a CTM; rights conferred; grounds for refusal; opposition; infringing acts; right of priority; official examination; registration; duration and renewal; revocation and invalidation; enforcement through Community Trade Mark courts; comparison with national rights and the Madrid Protocol. Teaching will be through a lecture by the tutor covering these topics, linked to handout material and copies of the relevant articles of the CTMR and Implementing Regulation. There will also be practice of past questions.

Expected learning outcomes

At the end of this session, participants will be able to describe and explain - demonstrating this by applying this knowledge to their answers to past exam questions - their understanding of:

- the rights conferred by and advantages of a CTM;
- grounds for refusal;
- registration procedure;
- infringement
- enforcement of CTM rights;
- revoking and invalidating; and
- comparison between the CTM, national rights and the Madrid Protocol.

Session 6: EC Decisions

Session summary

In this session, participants will gain working knowledge of the underlying principles of the leading CJEU decisions on trade marks: *Sabel v Puma*; *Canon v MGM*; and *Windsurfing Chiemsee*. Teaching will be through a lecture by the tutor on these cases, linked to handout material on each case as well as practice of past questions.

Expected learning outcomes

At the end of this session, participants will be able to describe and explain - demonstrating this by applying this knowledge to their answers to past exam questions – key CJEU decisions on trade marks.

Session 7: Paris Convention

Session summary

In this session, participants will gain outline knowledge of articles 4 and 6bis of the Paris Convention for the Protection of Intellectual Property. Teaching will be through a lecture by the tutor linked to handout material on the topic including the text of the relevant articles of the Paris Convention and practice of past questions.

Expected learning outcomes

At the end of this session, participants will be able to describe and explain - demonstrating this by applying this knowledge to their answers to past exam questions - their understanding of:

- the article 4 provision on priority; and
- the article 6bis provision on well-known marks

Session 8: International Registrations under the Madrid Protocol

Session summary

In this session, participants will gain basic knowledge of the provisions of the Madrid Protocol, including: what it and how it works; registration procedure at WIPO; registration procedure during the national phases; effects of registration; central attack; transformation and replacement. Teaching will be through a lecture by the tutor linked to handout material on the topic including the relevant articles of the Madrid Protocol. There will also be practice of past exam questions.

Expected learning outcomes

At the end of this session, participants will be able to describe and explain - demonstrating this by applying this knowledge to their answers to past exam questions - their understanding of:

- how the Madrid Protocol; works and its advantages;
- making applications and the national phase;
- the effects of registration;
- ways of responding to central attack; and
- how international registration can replace national registration.

Session 9: Final preparations for the exam

Session summary

In this closing session, the tutor will advise on how participants can best prepare for the FC5 paper in the intervening weeks before the exam. There will be guidance on further practice of past exam papers and on materials to read, and a recap of key points on exam technique.

Expected learning outcomes

At the end of this session, participants will be able to:

- plan their final stages of revision and practice for the FC5 exam; and
- identify areas where they need to do further reading and practice.

ANNEXE A: EXTRACTS² FROM THE FC5 SYLLABUS

CONTENT THEMES	LEGAL PROVISIONS	
	International Law	UK Law
1. The law relating to registrable trademarks	<p><u>Council Regulation (EC) No. 207/2009 of 26 February 2009 on Community Trade Mark (CTMR)</u></p> <p>CTMR 1 – Community trade mark CTMR 4 – Signs of which a Community trade mark may consist CTMR 7 – Absolute grounds for refusal CTMR 8 – Relative grounds for refusal</p>	<p><u>The Trade Marks Act 1994 (UKTMA)</u></p> <p>UKTMA 1 – Trade marks UKTMA 3 – Absolute grounds for refusal of registration UKTMA 5 – Relative grounds for refusal of registration UKTMA 6 – Meaning of earlier trade mark</p>
2. Ownership of trade marks	<p>CTMR 5 – Persons who can be proprietors of Community trade marks</p>	<p>UKTMA 2 – Registered trade marks</p>
3. The law relating to the application process	<p>CTMR 6 – Means whereby a Community trade mark is obtained CTMR 25 – Filing of applications CTMR 26 – Conditions with which applications must comply CTMR 27 – Date of filing CTMR 28 – Classification CTMR 36 – Examination of the conditions of filing CTMR 37 – Examination as to absolute grounds for refusal CTMR 38 – Search CTMR 39 – Publication of the application CTMR 81 – <i>Restitutio in integrum</i></p>	<p>UKTMA 32 – Application for registration UKTMA 33 – Date of filing UKTMA 34 – Classification of trade marks UKTMA 37 – Examination of application UKTMA 38 – Publication, opposition proceedings and observations UKTMA 39 – Withdrawal, restriction or amendment of application</p>
4. Opposition and Observations	<p>CTMR 40 – Observations by third parties CTMR 41 – Opposition</p>	<p>UKTMA 38 – Publication, opposition proceedings and observations</p>
5. Priority and seniority	<p>CTMR 29 – Right of priority CTMR 30 – Claiming priority CTMR 34 – Claiming the seniority of a national trade mark CTMR 35 – Claiming seniority after registration of the Community trade mark</p>	<p>UKTMA 35 – Claim to priority of Convention application</p>
6. Duration of registration	<p>CTMR 45 – Registration CTMR 46 – Duration of registration CTMR 47 – Renewal CTMR 81 – <i>Restitutio in integrum</i></p>	<p>UKTMA 42 – Duration of registration UKTMA 43 – Renewal of registration</p>
7. A Registered Trade Mark as a form of property	<p>CTMR 16 – Dealing with Community trade mark as national trade marks</p>	<p>UKTMA 22 – Nature of registered trade mark UKTMA 24 – Assignment of registered trade mark UKTMA 25 – Registration of transactions affecting registered trade mark UKTMA 28 – Licensing of registered trade mark</p>

² You should read the syllabus to understand the Learning Outcomes related to each Content Theme.

CONTENT THEMES	LEGAL PROVISIONS	
	International Law	UK Law
8. The law relating to infringement of registered trade marks	CTMR 9 – Rights conferred by a Community trade mark CTMR 10 – Reproduction of Community trade marks in dictionaries CTMR 12 – Limitation of the effects of a Community trade mark CTMR 13 – Exhaustion of the rights conferred by a Community trade mark CTMR 95 – Community trade mark courts CTMR 96 – Jurisdiction over infringement and validity CTMR 97 – International jurisdiction CTMR 98 – Extent of jurisdiction CTMR 99 – Presumption of validity – Defence as to the merits CTMR 100 – Counterclaims	UKTMA 9 – Rights conferred by registered trade mark UKTMA 10 – Infringement of registered trade mark UKTMA 11 – Limits on effect of registered trade mark
9. Revocation and invalidation of registered trade marks	CTMR 51 – Grounds for Revocation CTMR 52 – Absolute grounds for invalidity CTMR 53 – Relative grounds for invalidity	UKTMA 46 – Revocation of registration UKTMA 47 – Grounds of invalidity of registration
10. Conversion	CTMR 112 – Request for the application of national procedure CTMR 113 – Submission, publication and transmission of the request for conversion CTMR 114 – Formal requirements for conversion	
11. European Community law affecting trade marks	<u>Treaty on the Functioning of the EU (EU)</u> EU 34 – Quantitative restrictions on imports and all measures having equivalent effect shall be prohibited between Member States EU 35 - Quantitative restrictions on exports and all measures having equivalent effect shall be prohibited between Member States EU 36 – Not to constitute a means of arbitrary discrimination or a disguised restriction on trade between Member States EU 101 – Prohibited as incompatible with the common market: all agreements between undertakings EU 102 – Abuse by one or more undertakings of a dominant position	
12. Passing off in the UK		UKTMA 2 – Registered trade marks

CONTENT THEMES	LEGAL PROVISIONS	
	International Law	UK Law
13. The Madrid Protocol	<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 83 – Fees for international application and registration</p> <p>MP Art 94 – Transformation of an international registration into national or regional applications</p>	
14., The Paris Convention	<p><u>Paris Convention for the Protection of Industrial Property</u></p> <p>PC6bis - Famous marks</p>	
15. Case law	<ul style="list-style-type: none"> i. Sabel BV v Puma AG, Rudolf Dassler Sport (C-251/95) [1997] ECR I-6191 ii. Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C-39/97)[1998] ECR I-5507, [1999] RPC 117 iii. 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 	

ANNEXE B: HOW TO PREPARE FOR FC5 AND THE COURSE

A. Essential pre-course work

A1. Read the FC5 syllabus to understand its scope and the level of knowledge expected.

- The syllabus is available from the Patent Examination Board website.

A2. Familiarise yourself with past P7 exam papers, Examiner's Reports, Mark Scheme (for 2014 onwards) and Sample Pass Scripts to understand the format and requirements of the exam.

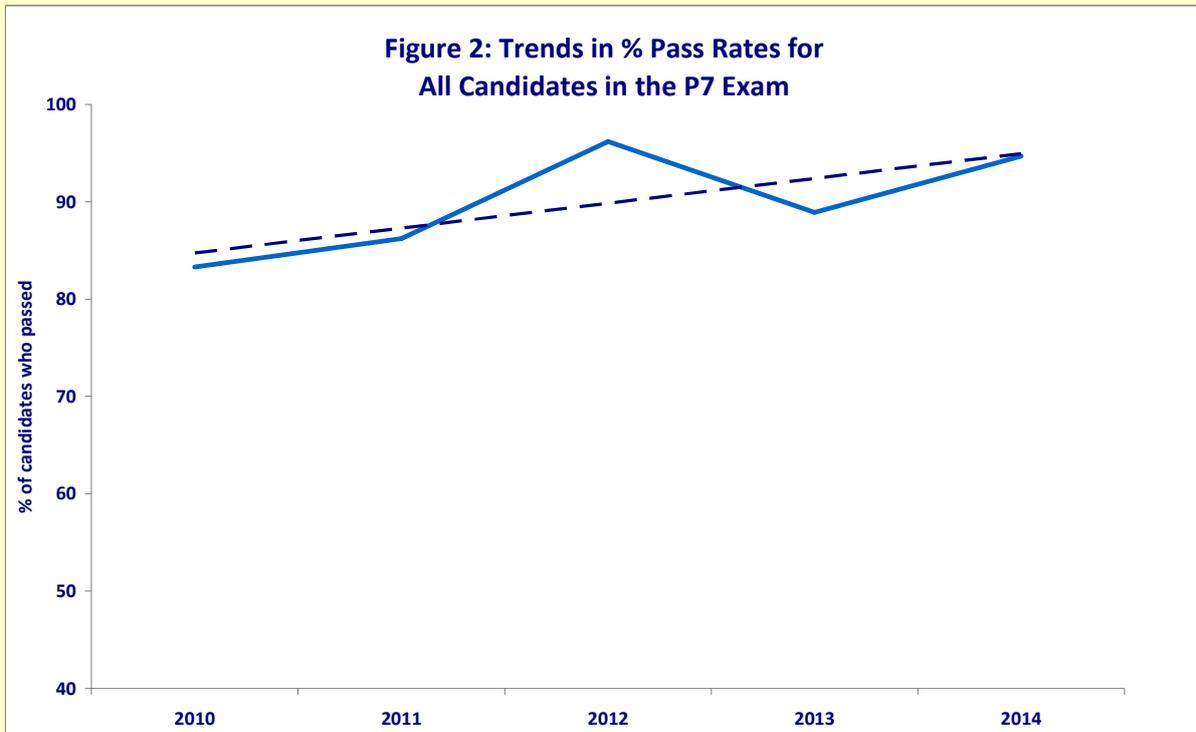
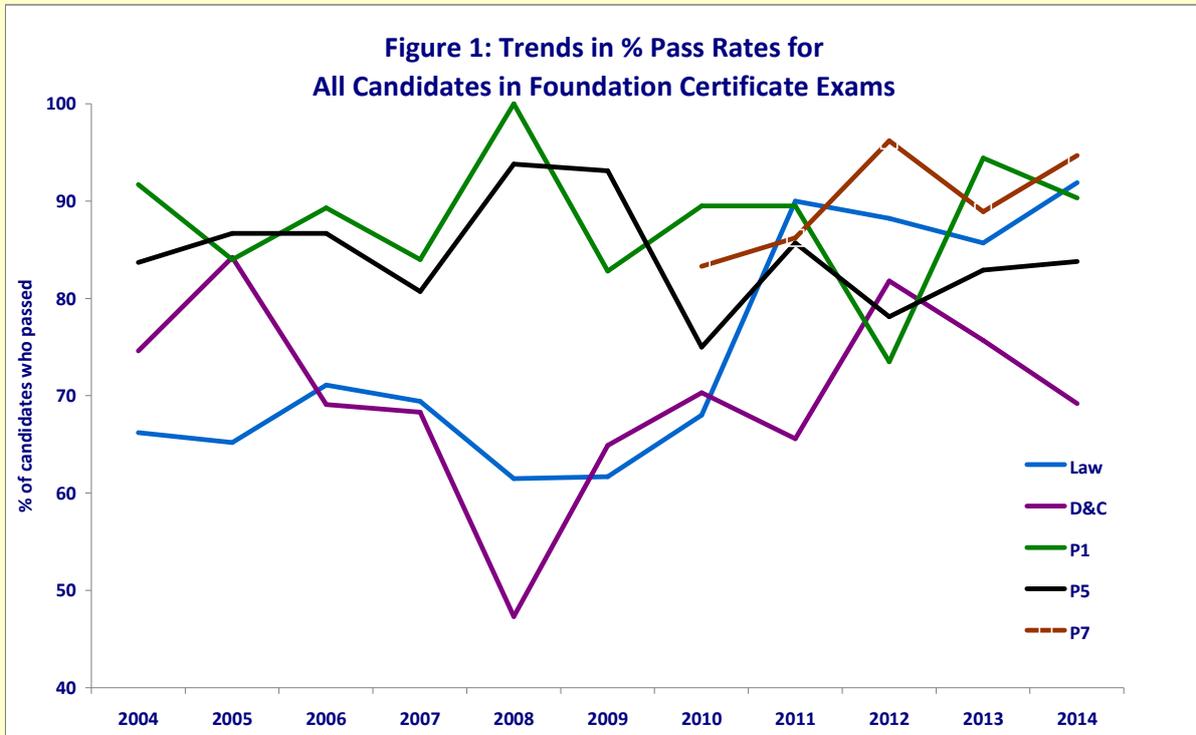
- Exam papers, Examiner's Reports, the Mark Scheme and Sample Pass Scripts are available from the Patent Examination Board website.

B. Recommended pre-course reading

1. It is recommended that you read CIPA's publication ***Principles of Trade Mark Law for Patents Candidates: Foundation Level Training Manual*** available from <http://www.cipa.org.uk/pages/info-textbooks> and two introductory books and revision tools on IP law which have chapter relevant to all Foundation courses: ***Intellectual Property Law*** by Jennifer Davis (OUP, latest edition) chs 4-5 on passing off and trade marks; and, ***Intellectual Property Law Concentrate: Law Revision and Study Guide*** by Tim Press (OUP: latest edition), ch. 9 passing off and trade marks
2. Relevant articles of the ***Treaty on the Functioning of the European Union (formerly the Treaty of Rome)***: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2010:083:0047:0200:EN:PDF>
3. Relevant Sections of the ***UK Trade Marks Act 1994 and UK Trade Marks Rules 2008***: <http://www.ipo.gov.uk/tmact94.pdf> plus <http://www.ipo.gov.uk/tmrules2008.pdf>
4. Relevant articles of ***Community Trade Mark Regulation and Implementing Regulation***: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:EN:PDF> plus <http://oami.europa.eu/ows/rw/resource/documents/CTM/regulations/2868en-codified.pdf>
5. Leading decisions of the Court of Justice of the European Union: ***Sabel BV v Puma AG, Rudolf Dassler Sport (C-251/95)*** (<http://www.ipo.gov.uk/c25195.pdf>); ***Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C39/97)*** (<http://www.ipo.gov.uk/c3997.pdf>) ; ***Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) and Boots-und Segelzubehör Walter Huber (C-108/97) Franz Attenberegger (C-197/97) Joined Cases*** (<http://www.ipo.gov.uk/c10897.pdf>) .
6. Introduction to the law of ***Passing Off in the United Kingdom*** (see 1 above).
7. Relevant articles of ***the Protocol Relating To The Madrid Agreement Concerning The International Registration Of Marks***: http://www.wipo.int/madrid/en/legal_texts/trtdocs_wo016.html
8. Relevant articles of ***the Paris Convention For The Protection Of Industrial Property***: http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html
9. ***UKIPO Manual of Trade Marks Practice***
10. OHIM website ***Trade Mark Practice***
11. The ***CIPA Informals' lectures*** on Trade Marks available from the Informals section of the CIPA website.

ANNEXE C: TRENDS IN OVERALL PASS RATES FOR TRADE MARK LAW

Figure 1, drawing on PEB data for all candidates, indicates that, since 2010, the pass rate for the Trade Mark Law (P7) exam has fluctuated year to year: from a low of 83% in 2010 to a high of 96% in 2012. **Figure 2** indicates that the linear trend for passing has been upwards towards over 90%.



In 2014, the PEB published (**Figure 3**) the distribution of marks for all the candidates who took the P7 exam.

Figure 3: The mark distribution of P7 exam candidates in 2014



This is the first year PEB has published this information, so we do not know whether mark distribution in 2014 was typical. Analysis of the marks indicates a wide spread in marks, but more than two-fifths of candidates achieving strong passes, with 70 marks or more.