

EUIPO Trade Mark and Design Education Programme Programme of Studies

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ETMD
EDUCATION PROGRAMME

TABLE OF CONTENTS

PROGRAMME OF STUDIES	4
1. INTRODUCTION.....	4
2. ABSOLUTE GROUNDS FOR REFUSAL.....	4
2.1. GENERAL PRINCIPLES AND ARTICLE 7(1)(A) EUTMR.....	4
2.2. ARTICLE 7(1)(B), (C) AND (D) EUTMR	5
2.3. ARTICLE 7(1)(E), (F), (G), (H) AND (I) AND ARTICLE 7(3) EUTMR	5
2.4. ARTICLE 7(1)(J), (K), (L), AND (M) EUTMR	6
3. COLLECTIVE AND CERTIFICATION MARKS; REGISTERING TRADE MARKS AND ENTRIES IN THE REGISTER	6
3.1. COLLECTIVE AND CERTIFICATION MARKS	6
3.2. REGISTERING TRADE MARKS	6
3.3. ENTRIES IN THE REGISTER.....	7
4. PROCEDURAL AND EVIDENTIARY ISSUED	7
5. SELECTED ISSUES.....	8
6. RELATIVE GROUNDS FOR REFUSAL.....	8
6.1. GENERAL PRINCIPLES	8
6.2. ARTICLE 8(1)(A) AND (B) EUTMR.....	9
6.3. ARTICLE 8(5) EUTMR.....	9
6.4. ARTICLE 8(3), (4) AND (6) EUTMR	9
7. REVOCATION AND INVALIDITY	10
8. APPEALS AND ACTIONS BEFORE THE COURT OF JUSTICE.....	10
9. REGISTERED COMMUNITY DESIGNS	11
9.1. INTRODUCTION TO COMMUNITY DESIGN LAW	11
9.2. APPLICATION FOR A COMMUNITY DESIGN.....	11
9.3. DESIGN INVALIDITY PROCEEDINGS	11

PROGRAMME OF STUDIES

The programme of studies covers all areas of EU trade mark and Community design law, including general principles regarding proceedings before the EUIPO; examination of absolute grounds for refusal; responding to the Office's actions; opposition and cancellation proceedings; mediation; appeal proceedings; actions for annulment before the General Court and the Court of Justice of the European Union; and trade mark enforcement issues. The part dedicated to design law will provide an introduction to registered Community designs, the application procedure and design invalidity proceedings.

The list of topics below may be subject to change for organisational reasons.

1. Introduction

This module gives participants an overview of the EU legal sources with the emphasis on the instruments specifically applied by the EUIPO. By providing an outline of the main characteristics of the EUTM and EUIPO organisation and structure, it will help students throughout the Programme.

- The sources and hierarchy of sources (Treaty, Charter of Fundamental Rights, the Regulations, the preamble of the Regulations and its interpretation, case-law of the Court of Justice of the European Union and of the trade mark courts of the Member States, the Guidelines for Examination, Communications of the Executive Director, Common Communications of the Office and the Member States).
- European administrative law and principles of procedural law generally recognised in the Member States.
- Brief history of the Regulations and the Office, including issues relating to the enlargement of the European Union.
- Characteristics of the European Union trade mark:
 - unitary character
 - coexistence with other trade mark systems
 - territorial aspect (enlargement and reduction of the European Union)

This module aims to improve the participants' competencies in the following:

- Determining the correct sources of EU trade mark and Community design law to be applied to specific cases.

2. Absolute grounds for refusal

This module aims to improve the participants' competencies in the following:

- identifying all potential absolute grounds for refusal;
- drafting effective responses to trade mark objection letters;
- effectively attacking or defending EUTMs on absolute and relative grounds for refusal.

2.1. General principles and Article 7(1)(a) EUTMR

This module provides an insight into the general principles applicable to absolute grounds for refusal, overview of signs that may not conform to the requirements of Article 4 EUTMR

- Public interest in trade mark law
- Languages to be taken into consideration
- Letters of non-Roman alphabets.
- Abstract distinctive character
- Representation of sign.

2.2. Article 7(1)(b), (c) and (d) EUTMR

This module examines those types of trade marks that are more controversial on the grounds of distinctiveness, descriptive character and customary nature. The Common Practice of Distinctiveness is another central theme of this module.

- Word marks:
 - single letters, single numerals, acronyms, sequence of letters
 - slogans
 - geographical names
 - subject title and the downside of being famous
 - sports events
- Colours and colour combinations:
 - technical function of colours
 - generic colours
 - colours applied in relation to service marks
- Figurative trade marks:
 - definition of simple or common elements
 - pictograms
 - geometrical figures
 - labels
 - typographic symbols
- Convergence Project 3: Common Practice of Distinctiveness — figurative marks containing descriptive/non-distinctive words.
- Distinctiveness of shape trade marks:
 - toys
 - shape of the product or packaging
- Position marks
- Store design
- Sound marks, audiovisual marks and multimedia marks

2.3. Article 7(1)(e), (f), (g), (h) and (i) and Article 7(3) EUTMR

This module focuses on potential objections based on this Article, using the available case-law; it is intended to resolve the frequent doubts that arise in the context of trade mark examination.

Moreover, it also combines theory and practice regarding acquired distinctiveness through use to provide participants with comprehensive knowledge of how their clients can benefit from Article 7(3) EUTMR.

- Article 7(1)(e) EUTMR
- Public policy and accepted principles of morality
- Deceptive trade marks
- Conflict with national and international emblems:
 - the notion of 'heraldic imitation'
 - comparing flags: how to assess additional elements that are not present in the official flag

- protection of flags, armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations
 - official signs and hallmarks indicating control and warranty
 - authorisation
 - protection of badges, emblems or escutcheons other than those covered by Article 6*ter* of the Paris Convention
 - Red Cross, Red Crescent, Olympic symbol, etc.
- Acquired distinctiveness through use

2.4. Article 7(1)(j), (k), (l), and (m) EUTMR

This module focuses on how to assess whether trade mark applications may be in conflict with designations of origin and geographical indications, or with traditional terms for wines, traditional specialities guaranteed and earlier plant variety denominations.

- Protected Designations of Origin /Protected Geographical Indications
- Traditional Specialities Guaranteed
- Traditional Terms for Wine
- Plant Varieties.

3. Collective and certification marks; Registering trade marks and Entries in the Register

This module aims to improve the participants' competencies in the following:

- selecting appropriate types of trade mark according to the needs of the clients;
- preparing high-quality trade mark applications.
- Managing entries and amendments in the EUIPO Register.

3.1. Collective and certification marks

This module explores the differences between collective and certification marks and individual trade marks from the EUIPO's perspective. It describes the different functions of these kinds of trade marks and the special provisions in the EUTMR.

- Collective and certification trade marks:
 - function
 - owners
 - special provisions.

3.2. Registering trade marks

This module too contains both online and face-to-face components. The online theoretical part identifies the issues to take into account when preparing trade mark applications, while the face-to-face workshops give participants practical experience of using relevant EUIPO tools.

- Filing strategies:
 - national trade marks
 - international trade marks and the Madrid Protocol
 - European Union trade marks

- Pre-filing considerations and searches:
 - clearance
 - coexistence agreements
 - acquiring an earlier right
 - types of trade mark
- Formalities concerning an application and priorities and seniorities (how to claim and how to prove, including reference to CP4):
 - priority
 - exhibition priority
 - seniority
- Classification of trade marks:
 - representation of the sign
 - Article 3(3) EUTMIR
 - Vienna Classification
 - Nice Classification — classification of goods and services and scope of protection, including method of interpretation of specification
 - wording of list of goods and services
 - meaning of ‘including’, ‘in particular’, ‘especially’, ‘namely’, etc.
 - correct use of punctuation
- Examination

3.3. Entries in the Register

This module summarises the requirements for the most frequent Register operations and some of the entries related to the management of EUTMs as objects of property.

- Division
- Post-registration seniority claims
- Modification of the sign
- Limitation of the list of goods and services
- Surrender
- Conversion
- Changes of name and address
- Transfers:
 - proof of transfers: what is required?
 - the issue of bankruptcy
 - partial assignments, assignment in the course of asset purchase agreements
- Licences
- Security interests
- Registration and renewal.

4. Procedural and evidentiary issued

This area provides an overview of general principles applicable in all proceedings before the EUIPO.

The module aims to improve the participants’ competencies in the following:

- Presenting cases without procedural errors and with well-structured evidence;
 - Managing the procedural issues arising during opposition, invalidity and appeal proceedings.
- General principles regarding proceedings before the Office:
 - means of communication and notification
 - time limits

- language of proceedings
- translation of evidence
- representation
- inspection of files
- admissibility of complementary evidence
- *restitutio in integrum*
- continuation of proceedings
- stay of proceedings, including cooling-off
- suspension of proceedings
- The right to be heard, the right of defence and the obligation to state reasons.
- Exercising discretion and the notion of misuse of powers.
- *Res judicata* in proceedings before the Office; dealing with repeated requests.
- Requests for confidentiality.
- The notion and scope of well-known facts and practical experience

5. Selected issues

This module covers a series of issues of interest to IP practitioners. These issues will be scattered throughout the course and will provide participants with an opportunity for in-depth discussion.

- New challenges in protecting brands in the online environment.
- Comparative advertising and online infringement/web-blocking orders
- Domain name infringement and the Uniform Domain Name Dispute Resolution Policy
- Exhaustion of rights/parallel imports.
- Articulation with other legal acts, such as the Customs Directive or the Enforcement Directive.
- Anti-counterfeiting and the role of the European Observatory on Infringements of Intellectual Property Rights
- Intellectual Property, Public Health and Plain Cigarette Packaging
- Trade mark protection and freedom of expression

6. Relative Grounds for refusal

This module aims to improve the participants' competencies in the following:

- effectively attacking or defending EUTMs on absolute and relative grounds for refusal;
- managing the procedural issues arising during opposition, invalidity and appeal proceedings.

6.1. General principles

This module explores the various common general principles applicable in proceedings based on relative grounds for refusal. A central theme is the assessment of proof of use, in particular the various factors required to prove genuine use and the principles of assessment.

- Proving legal standing in proceedings before the Office
- Definition of earlier rights (Article 8(2) EUTMR)
- Admissibility of oppositions
- Opposition proceedings
 - legal standing of opponent and multiple opponents
 - transfer of legal standing
 - statement of grounds
- Substantiation of earlier trade mark
- Proof of use

- time
- place
- extent
- nature
- overall assessment
- justified reasons for non-use
- sign used in a form that differs from its registration

6.2. Article 8(1)(a) and (b) EUTMR

This module summarises double identity requirements and contains an in-depth analysis of the various factors for assessing the likelihood of confusion pursuant to Article 8(1) EUTMR.

- Double identity
- The relevant public and its level of attention
- Comparison of goods and services
- Comparison of signs
 - dominant elements
 - weak and non-distinctive elements
 - negligible elements
- Distinctive character of the earlier trade mark
- Global assessment — other criteria, such as coexistence, family of trade marks, enhanced distinctive character

6.3. Article 8(5) EUTMR

A comprehensive analysis of the requirements for successfully invoking Article 8(5) EUTMR in opposition proceedings, completed by practical workshops that put the knowledge acquired into practice.

- Assessing reputation
- Assessing the risk of injury:
 - taking unfair advantage of distinctiveness or repute
 - detriment to distinctiveness
 - detriment to repute
- Due cause
 - freedom of expression and parody

6.4. Article 8(3), (4) and (6) EUTMR

This module will explore all the requirements for successfully invoking Article 8(3) EUTMR and analyse the justifications that the agent or representative might put forward to defend his or her actions.

- Definition of agent
- Where must the principal have a trade mark? Must that trade mark be registered?
- Identity and similarity of goods and services and of the signs
- Justification of the agent as defence.

In addition, it will analyse the most important aspects of Article 8(4) EUTMR, such as the types of rights covered by it, use requirements and national protection.

- What rights can be invoked
- Use of more than mere local significance
- Differences between Article 8(4) and 8(6) EUTMR
- Relying on EU or national law — content of the law and how to prove it (from the perspective of Article 8(4) EUTMR)
 - passing-off
 - civil law/unfair competition

7. Revocation and invalidity

This module examines the procedural particularities of cancellation proceedings and the most common/controversial grounds for revocation and invalidity.

This module aims to improve the participants' competencies in the following:

- effectively attacking or defending EUTMs on absolute and relative grounds for refusal;
 - managing the procedural issues arising during opposition, invalidity and appeal proceedings.
- Procedural issues in cancellation proceedings
 - legal standing of applicant and multiple applicants
 - transfer of legal standing
 - statement of grounds
 - Revocation
 - becoming a generic term
 - Invalidity based on absolute grounds
 - bad faith and repetitive applications
 - Invalidity based on relative grounds
 - other rights

8. Appeals and actions before the Court of Justice

This module covers all issues related to the Boards of Appeal and appeal proceedings, and the most significant aspects of proceedings before the CJEU from the particular perspective of an IP lawyer.

It aims to improve the participants' competencies in the following:

- effective dispute resolution before the Boards of Appeal,
 - filing a request for annulment before the General Court;
 - understanding the system of judicial review before the Court of Justice.
- Role, nature and functioning of the Boards of Appeal
 - Jurisdiction of the Boards of Appeal and scope of review
 - Formalities
 - Appeal proceedings
 - legal standing of appellant and multiple appellants
 - transfer of legal standing
 - ancillary appeal
 - Additional evidence before the Boards of Appeal
 - Conciliation and mediation.
 - Competences of the General Court and of the Court of Justice
 - The system of judicial review — questions of law and questions of fact
 - The specific Rules of Procedure of the General Court and of the Court of Justice in IP cases

- The hearing

9. Registered Community Designs

This module aims to improve the participants' competencies in the following:

- preparing high-quality design applications.
- drafting effective responses to Community design objection letters.
- identifying all potential grounds for Community design invalidity;
- effectively attacking or defending Community designs on grounds for invalidity.

9.1. Introduction to Community design law

This module provides an introduction to and overview of the notion of design and the protection of designs at different territorial levels.

- The notion of designs
- Community designs and registered versus non-registered designs
- National designs
- International designs and the Hague System.

9.2. Application for a Community design

This module presents practical procedural issues for considering before and during the preparation of an application for a Community design and some aspects to bear in mind once the design is registered.

- Pre-filing considerations and searches
- Application procedure
 - filing an application at the Office
 - allocation of a filing date
 - examination of the substantive requirements
 - representation of the design
 - mandatory requirements
 - optional elements
 - multiple applications
 - payment of fees
 - withdrawals and corrections
 - registration, publication and certificates
- Corrections and changes in the Register and in the publication of Community designs.

9.3. Design invalidity proceedings

This module presents the principles applying to design invalidity proceedings with the emphasis on those aspects specific to Community designs.

- Introduction
- General principles.