

DIPLOMA CENTRE

Certificate in Trade Mark Law



MODULE 1: INTRODUCTION TO TRADE MARKS

SESSION 1	TIME	DELIVERY
Tuesday 9 November 2021	6:00pm – 8:30pm	Online only

- 1 Introduction to the Certificate in Trade Mark Law:**
Claire O'Mahony, Solicitor, RTMA
- 2 Introduction to intellectual property law:** what the term means and what it encompasses; Trade Marks, patents, copyright, designs; trade secrets and confidentiality; passing off; Section 6 definition; types of Trade Marks; different registration systems (Ireland, EUIPO, Madrid); the Nice Classification of goods and services explained.
Colette Brady, Partner, William Fry

2.5 hrs. Gen. CPD

MODULE 2: REGISTERING TRADE MARKS

SESSION 1 (cont.)	TIME	DELIVERY
Tuesday 9 November 2021	6:00pm – 8:30pm	Online only

- 3 Trade Mark applications:** How to file an application at the Patents Office, the EUIPO and through the Madrid System at the WIPO.
Elaine McGrath, Partner, Reddy Charlton

2.5 hrs. Gen. CPD

SESSION 2	TIME	DELIVERY
Tuesday 16 November 2021	2:00pm release	Online only

- 1 Registering non-conventional Trade Marks:** Thing to consider when filing or advising on same; case-law relating to shapes, colours, sounds, smells, slogans, names, surnames, geographical locations.
Kate McKenna, Legal Counsel, Frontline Ventures

1 hrs. Gen. CPD

MODULE 3: EXAMINATION, PUBLICATION AND OPPOSITIONS

SESSION 3	TIME	DELIVERY
Tuesday 23 November 2021	2:00pm release	Online only

- 1 The examination process:** Post-filing issues; classification issues; examination on absolute and relative grounds and the differences between the IPO and the EUIPO; objections that can arise and overcoming them; acquired distinctiveness. Descriptive marks, including geographical terms.
Barry Connolly, Senior Legal Counsel, Three
- 2 Publication and the importance of their date:** Observations at the Patents Office and at the EUIPO; Irish opposition – practice and procedure; opposition at the EUIPO – practice and procedure; conversion at the EUIPO; settling oppositions and related agreement.
Niamh Hall, Partner, FR Kelly

2 hrs. Gen. CPD

MODULE 4: REVOCATION AND INVALIDITY

SESSION 4	TIME	DELIVERY
Tuesday 30 November 2021	2:00pm release	Online only

- 1 Revocation and invalidity of Trade Marks:** Practice procedure in Ireland and the EUIPO; relevant case law examined.
Barry Connolly, Senior Legal Counsel, Three

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- 2 **What is 'use of the Trade Mark'?** What the courts say about genuine use; the case-law and concepts explained; proper reasons for non-use; acquiescence.
Glen Gibbons, BL

2 hrs. Gen. CPD

SESSION 5	TIME	DELIVERY
Saturday 4 December 2021	10:00am – 1:00pm	Online only

- 1 **Workshop 1: Consolidation of knowledge and preparation for the Trade Mark Agent exam.**
Topics: applications, oppositions, cancellations (revocation/ invalidity) and use issues as well as non-conventional marks, how to search Trade Mark registers, exam questions including the register and office practices.
Judy McCullagh, Partner, Finnegan Henderson Farabow Garrett & Dunner Limited

3 hrs. Gen. CPD

MODULE 5: INFRINGEMENT OF TRADE MARKS (registered and non-registered)

SESSION 6	TIME	DELIVERY
Tuesday 7 December 2021	2:00pm release	Online only

- 1 **Infringement of a registered trade mark:** How to enforce your trade mark rights and how to defend a claim for infringement; groundless threats under Section 24 assessed; the remedies and litigation forums available; anti-counterfeiting and customs protection; a word on ACTA.
Carol Plunkett, Partner, William Fry
- 2 **Defences to Trade Mark infringement:** What you can and cannot do with a third party's registered Trade Mark; the provisions of Section 15 of the Act explained; the proviso to Section 15 (2); tactical defences to consider.
Colette Brady, Partner, William Fry

2 hrs. Gen. CPD

SESSION 7	TIME	DELIVERY
Tuesday 14 December 2021	2:00pm release	Online only

- 1 **An overview of comparative advertising:** Comparative advertising as a defence to an infringement claim; relevant case law examined including the Dunnes -v- Lidl High Court decision
Patricia McGovern, Partner, DFMS Solicitors
- 2 **Exhaustion of rights and parallel imports in the trade mark world**
Patricia McGovern, Partner, DFMS Solicitors
- 3 **Passing-off:** Infringement of unregistered Trade Marks, the elements of the test; how to mount a successful claim for passing off; and the defences examined
Robin Hayes, Partner, Whitney Moore

3 hrs. Gen. CPD

SESSION 8	TIME	DELIVERY
Saturday 15 January 2022	10:00am – 12:30pm	Online only

- 1 **Workshop 2: Consolidation of knowledge and preparation for the Trade Mark Agent exam.**
Topics: Infringement, defences, passing off, remedies, litigation.
Judy McCullagh, Partner, Finnegan Henderson Farabow Garrett & Dunner Limited

2.5 hrs. Gen. CPD

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MODULE 6: TYPES OF TRADE MARKS

SESSION 9	TIME	DELIVERY
Tuesday 18 January 2022	2:00pm release	Online only
1 Dealing in Trade Marks: Assignments, licensing and ownership issues outlined and the procedures for filing records explained; changes to the register and surrender of a Trade Mark; renewals and restoration to the register. <i>Hazel Tunney, Trade Marks and Designs Partner, Tomkins</i>		
2 Collective and certification Trade Marks; Protected designations of origin and protected geographical indications. <i>Hazel Tunney, Trade Marks and Designs Partner, Tomkins</i>		
2 hrs. Gen. CPD		

MODULE 7: TRADE MARK PORTFOLIOS

SESSION 10	TIME	DELIVERY
Tuesday 25 January 2022	2:00pm release	Online only
1 Design Law in Ireland and the EU: An examination of designs; legislative background; The Hague Agreement; definition of designs and products; requirements for protection; registrability; how to file a design in Ireland/EU. <i>Colette Brady, Partner, William Fry</i>		
2 Design Law – registered v unregistered designs: Irish and Community Registered Designs (CRD) v unregistered designs; term of protection; invalidity; infringement defences; authorship and ownership of designs; recent case law update; overlap between designs, copyright and Trade Marks. <i>Colette Brady, Partner, William Fry</i>		
2 hrs. Gen. CPD		

MODULE 8: ADVANCED TRADE MARKS

SESSION 11	TIME	DELIVERY
Tuesday 1 February 2022	2:00pm release	Online only
1 Online infringement and web blocking orders relating to Trade Marks <i>Helen Johnson BL</i>		
2 Anti-counterfeiting mechanisms and filing an application for action <i>Mr Níall Tierney, Registered Intellectual Property Attorney, Tierney IP</i>		
3 Trade Mark and domain name protection: enforcement of rights through the UDPR <i>Colette Brady, Partner, William Fry</i>		
4 Plain packaging legislation, where are we at? <i>Mr Níall Tierney, Registered Intellectual Property Attorney, Tierney IP</i>		
3 hrs. Gen. CPD		

SESSION 12	TIME	DELIVERY
Tuesday 8 February 2022	2:00pm release	Online only
1 Managing a Trade Mark portfolio/ monitoring Trade Marks <i>Mary Bleahene, Partner, FR Kelly</i>		
1 hrs. Gen. CPD		

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SESSION 13	TIME	DELIVERY
Saturday 19 February 2022	10:00am – 1:00pm	Online only

1 **Workshop 3: Consolidation of knowledge and preparation for the Trade Mark Agent exam.**

Topics: Review of previous exam questions on the Trade Mark Agent exam.

Judy McCullagh, Partner, Finnegan Henderson Farabow Garrett & Dunner Limited

Colette Brady, Partner, William Fry

3 hrs Gen. CPD

ASSIGNMENT DUE DATE: 21 MARCH 2022

Please note that topics & dates may be subject to change. Draft timetable as of November 2021.

* Gen = General, M&PD = Management and Professional Development, Reg = Regulatory and eLearning = eLearning CPD credits. **CPD Note:** The number of hours of CPD that you may claim in relation to your diploma/certificate course will depend on the way in which you access each of the individual sessions. For further information please visit the course homepage on our website: www.lawsociety.ie/diplomacentre