

THE JOINT EXAMINATION BOARD

PAPER T5

BASIC OVERSEAS TRADE MARK LAW & PRACTICE

18th November 1999

03.00 p.m. – 05.00 p.m.

Please read the following instructions carefully. This is a **TWO HOUR** paper.

1. You should attempt no more than **eight** questions from **Part A** and no more than **five** questions from **Part B**.
2. The number of marks allotted to each question is placed in brackets at the end of the question.
3. Where a question permits of reasons being given for the conclusion reached, such reasons should be given.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number and your Examination number. Write on one side of the paper only using **BLACK** ink. You must **NOT** staple pages together. You must **NOT** state your name anywhere in the answers.
5. Unless specifically requested answers are **NOT** required in letter form.
6. **NO** printed matter or other written material may be taken into the examination room.
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answers no marks will be awarded.
8. **NO** writing whatsoever, including numbering of pages, is allowed prior to the commencement of the examination or after it has finished.
9. Please put your answers in **QUESTION NUMBER ORDER** before placing in the envelope provided.

This paper consists of **four** pages including this page

PART A

- 1 Explain how the fee on a Madrid Protocol application is made up.
(5 marks)
- 2 What are the relevant non-use periods, and what are the consequences of failure to use during these periods, in the following countries:
Australia
Benelux
Brazil
Mexico?
(5 marks)
- 3 Your client's mark, filed in February 1999 in Singapore, has met with an official objection on the grounds of non-distinctiveness. What options are open to you to progress the application?
(5 marks)
- 4 What are the consequences of not observing any rules concerning the marking of goods in Canada, Mexico and USA?
(5 marks)
- 5 For each of the countries in the following list, indicate whether it is a party to: (a) the Paris Convention, (b) the Madrid Protocol, and (c) the Madrid Agreement
Ireland
USA
Taiwan
Switzerland
Portugal
(5 marks)
- 6 Outline the requirements for renewals in Japan and USA, including the time-scales for filing documents and any grace periods.
(5 marks)
- 7 What is the "cooling off period" in a CTM opposition, how long does it last, and what advantages are there in resolving the opposition during this period?
(5 marks)

- 8 What are the consequences of failing to record licences in Brazil and Thailand?
(5 marks)
- 9 What important changes of trade mark examination procedure were introduced by the Danish Patent Office from 1 January 1999, and what implications does this have for applicants?
(5 marks)

PART B

- 10 Outline the decision of the European Court of Justice in *Parfums Christian Dior vs. Evora*.
(12 marks)
- 11 Outline the relevant jurisdiction and procedure for the enforcement of Community Trade Mark registrations, including the provisions concerning injunctions.
(12 marks)
- 12 Your client owns a New Zealand trade mark registration dating from the 1940s which was renewed in 1995, but has never been used. Recently, you received a letter from Newco plc saying that they are interested in purchasing your client's trade mark registration as they wish to use it for their own product, which is due to be launched shortly. Your client has made it clear that he will take whatever action is necessary to prevent Newco from using the same mark. Advise your client.
(12 marks)
- 13 Article 8(1)(b) of the CTM Regulation provides that if a mark is opposed by the proprietor of an earlier mark, it shall not be registered "if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark". Discuss the meaning of "likelihood of association" and its significance in this context, by reference to any relevant decided cases.
(12 marks)
- 14 Your client has developed proposals for a new banking service which will be introduced during the next six months in the European Union and the USA. As well as choosing a name for the service, he has had a corporate logo designed. He now seeks your advice on what needs to be done before he can safely commence use of the name and logo. Outline the search strategy that you would recommend, with your reasons .
(12 marks)
- 15 Your client owns trade mark registrations in Class 30 covering "confectionery, ices, biscuits and frozen confectionery" in the UK, France, Benelux and Germany. He has sold chocolate bars and ice-creams under the mark in the UK, but only chocolate bars in France, Benelux and Germany. You have now been alerted to a CTM application by a Greek company to register a very similar mark for a wide range of goods in Class 30 including confectionery, ices, biscuits and frozen confectionery, as well as cafeteria services in Class 42. Your client wishes to oppose it. A search reveals that the Greek company owns Greek and German registrations covering "biscuits" which pre-date your client's rights. How would you advise your client?
(12 marks)