

THE JOINT EXAMINATION BOARD
FOUNDATION LEVEL
BASIC OVERSEAS TRADE MARK LAW - TS
23 November 2000
03.00p.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 conclusions 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 designations 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 any other written material may be taken into the examination room.
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answer, no marks will be awarded.

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

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Part A

1. A few months ago, you applied for registration of your client's mark in Spain and Italy and it has now been advertised in both countries. Explain what procedures remain to be completed in those two countries before registration is complete. Is there any other advice you would give your client before it commences use of the mark in either country?
(5 marks)
2. Outline the requirements and necessary information for filing trade mark applications in Canada and Mexico.
(5 marks)
3. Outline the procedures by which conflict with a third party mark can be raised in the national offices of the Benelux and Ireland.
(5 marks)
4. Who is entitled to be an applicant for a Madrid Protocol Application?
(5 marks)
5. Outline the procedures which follow the filing of an application in Portugal.
(5 marks)
6. Outline the registrability of geographical names under the First Council Directive of 27 December 1988 to Approximate the Laws of Member States relating to Trade Marks ("the Harmonization Directive"), mentioning any important decided cases.
(5 marks)
7. What are the renewal requirements for a Japanese trade mark registered prior to 1 April 1992, the date on which Japan adopted the International Classification of Goods and Services?
(5 marks)

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8. Outline the legal bases for filing an application to register a trade mark in the US Federal register.
(5 marks)
9. Your client's word-mark was applied for two months ago in the UK, and he now wishes to protect it in mainland China and Hong Kong. What advantages can be taken from the UK application for these two countries? Is there any special advice you would give your client in relation to protecting his mark in China and Hong Kong which would not apply to, say, France or Germany?
(5 marks)

Part B

10. Outline the decision of the ECJ in *Sebago Inc and Ancienne Maison Dubois et Fils SA v GB-Unic SA* ("Sebago").
(12 marks)
11. Compare and contrast "transformation" under the Madrid Protocol with "conversion" under the CTM Regulation.
(12 marks)
12. Your client has been selling writing instruments in the United Kingdom under the trade mark INKITTE for many years. The trade mark was registered by the client in the United Kingdom in 1969 and in France in 1997. The client is now setting up a distribution network with a view to selling writing instruments under the trade mark throughout the European Community. Outline the steps you would advise the client to take to safeguard her position in the Community before she commences use.
(12 marks)
13. Your client, a brick manufacturer, owns a registration of RUSTIC GOLD in Sweden, which covers "all goods in Class 19". You have now been approached by a Danish company who have applied to register RUSTICA in Sweden, also in Class 19 for "building components". Your client's mark has been cited against RUSTICA and the Danish company are now requesting a letter of consent from your client in order to allow their registration to proceed. They explain that their RUSTICA product is actually a range of door and window frames, and have offered to provide your client with a Priority Declaration in return for a letter of consent. Your client believes that there is no risk of confusion. Advise your client both generally and on the effects of a Priority Declaration, outlining the main conditions you would insist upon in this case. (You are not expected to draft any form of document.)
(12 marks)

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14. Briefly outline the nature and extent of trade mark rights that can be acquired by use of an unregistered trade mark in:

- (a) Italy
- (b) USA
- (c) Australia

(12 marks)

15. Write notes on trade mark aspects of the relabelling/repackaging of goods within the European Union.

(12 marks)