

THE JOINT EXAMINATION BOARD

PAPER T6 – ADVANCED COMMUNITY TRADE MARK AND INTERNATIONAL
TRADE MARK LAW AND PRACTICE PAPERThursday 9th November 2006

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. Time Allowed – **FOUR HOURS***

1. You should attempt **FOUR** questions out of the six presented.
2. All questions carry **25 marks**. If more questions than necessary are attempted, they will be marked in the order presented and answers over the required number will be ignored.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (T6), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not staple or join pages together in any way;
 - e. Do not state your name anywhere in the answers;
 - f. Write clearly, as examiners cannot award marks to scripts that cannot be read;
 - g. Reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.
6. This paper consists of 8 pages including this page.

Question 1:

You have recently been appointed to act on behalf of the as-yet-non-trading online internet flower delivery company ENCHANTED FLORIST and the files from the previous attorneys have been passed to you.

One of the files you acquired had an opposition pending against your client's CTM Application for ENCHANTED FLORIST. Unfortunately, you have just received notification that your client has been unsuccessful in the Opposition.

1. Prepare a detailed memorandum to your client advising them of the procedure and deadlines involved in filing an Appeal against the decision mentioning whether or not any official fees are payable. **(12 marks)**

The successful opposition was based on earlier national registrations in France, Estonia and Sweden of the Opponent and the Opposition decision upheld all those national registrations to be valid grounds of refusal against your client's CTM Application.

2. Set out the procedure and deadlines involved in requesting conversion. **(13 points)**

You are not required to advise on the merits of an Appeal or the potential grounds of Appeal.

Question 2:

Your client, a UK Company, has obtained a UK Trade Mark Registration for their trade mark. Your client has now instructed you to file a Madrid Protocol application designating, amongst other countries the European Union (Community Trade Mark).

1. Advise your client on the procedure for filing and obtaining registration of a trade mark under the International Registration. **(12 Marks)**
2. Explain OHIM's procedure for examining a designation of the European Union under the Madrid Protocol. **(13 Marks)**

Question 3:

You represent Tight LOK Limited (following a change of company name from Tight Lock Limited), a manufacturer of metal hardware and machine tools.

Tight LOK Limited is the applicant of a Community Trade Mark application for TIGHT LOK in respect of "metal hardware" in Class 6, "machine tools" in Class 7 and "hand tools" in Class 8. The application was filed on 26 August 2006.

Your client also owns the following trade mark registrations:

- A. TIGHT-LOCK in respect of "metal hardware" in Class 6 and "machine tools" in Class 7 in Latvia and Lithuania. Both registrations are in the name of Tight Lock Limited.
- B. TIGHT LOK in respect of "metal hardware" in Class 6, "machine tools" in Class 7 and "hand tools" in Class 8 in Malta. The registration is in the name of Shelf 123 Limited, which is a UK company wholly owned by your client.
- C. TIGHT LOCK in respect of "metal hardware" in Class 6, "machine tools" in Class 7 and "hand tools" in Class 8 in Norway in the name of Tight Lock Limited

Your client also has an application for the following trade mark:

- D. TIGHT LOK in respect of "metal hardware" in Class 6, "machine tools" in Class 7 and "hand tools" in Class 8 in Poland in the name of Tight Lok Limited.

Your client advises that the trade mark TIGHT LOK is not yet in use. Your client is currently using the trade mark TIGHT LOCK in the United Kingdom, France, Latvia, Lithuania and Poland in relation to "screws of metal". They aim to expand their range of products in the European Union under the new trade mark TIGHT LOK to all of the goods specified by the CTM application.

Your client is seeking to rationalise their existing trade mark portfolio. Your client understands that their national application and registrations can be absorbed into their CTM by way of "seniority".

They ask you to advise them in note form as to:

1. What is meant by 'seniority'?
2. How seniority can be claimed?
3. What are the benefits of claiming seniority?
4. Whether you envisage any problems in relation to any application for seniority.
5. Any other issues?

For the purposes of this question note that Latvia, Lithuania, Poland and Malta are Members of the European Union. Norway is a Member of the European Economic Area but not the European Union.

(25 marks)

Question 4:

You act for Shakespeare Plc, a leading manufacturer and supplier of medical devices and equipment across the European Union.

Your client has asked you to conduct searches to determine whether the trade mark TENDA is available for registration in the European Community in respect of 'medical devices and apparatus; medical needles; parts and fittings for all of the aforesaid goods' in International Class 10.

The search has revealed International Trade Mark Registration No. 800100 for TENDER covering 'surgical, medical, dental and veterinary apparatus and instruments; artificial limbs; eyes and teeth; orthopaedic articles; suture materials; parts and fittings for all of the aforesaid goods' in Class 10 (based upon United Kingdom Trade Mark Registration No. 2001000 of 1 January 1995) and designating European Community (on 1 June 2005 and granted protection 1 September 2006) and United States of America (on 1 October 2005). The registration is owned by Tiptoes Limited ("Tiptoes"), a UK company specialising in orthopaedic apparatus and devices.

Your client discloses that they have been using the trade mark TENDA in Austria, France, Germany, Spain and United Kingdom for at least 10 years in relation to medical needles used for the purposes of biopsy.

Your client advises that they are aware of Tiptoes as they have shared the same distributor in Austria and United Kingdom for the last 6 years. They regard their product range as commercially different from their own and they do not compete. Tiptoes appear to be using the trade mark TENDER in relation to a 'hip prostheses'.

Your client asks you to prepare notes for an urgent meeting with them this afternoon covering the following:

1. The validity of the earlier registrations owned by Tiptoes.
2. The available trade mark filing strategies together with your recommendation(s).
3. Any practical steps that can be taken by your client in order to improve their position.
4. Any other issues that your client needs to be aware of.

(25 marks)

Question 5:

Your client, Gamezone Ltd, is a gaming software company and launches a new range of products around the autumn of each year to capitalise on the Christmas sales. The rest of the year the client is heavily involved in devising new games software. Your client often asks you to file for any new names it proposes to use. Your client's preferred option to file for trade marks is the Madrid Protocol International Registration (IR) system because it is cheaper than national applications. It often files for proposed names in its main territories of interest, namely US and Japan.

One of its marks is an IR for the mark COMMANDANT which is a software game about guerrilla warfare in the Amazonian jungles of South America. This IR was filed in 2004 covering "computer software; computer games software" and was originally based on a UK application filed and registered in 1998. The IR designated the USA and Japan in its original application and the mark has since been protected in these countries.

Your client informs you that its COMMANDANT software is sold only in the USA and Japan and in both countries on a relatively small scale. The software is solely manufactured in Japan. However, it has now heavily updated the software for this game and plans to do a major marketing exercise to help increase its sales in these countries and also plans to expand into the whole of the EU by the end of 2007. As such it wants to extend its protection to the whole of the EU.

The client's watching service has just highlighted a recently filed Spanish application filed for the mark COMMODAT covering 'computer software relating to military strategy' in Spain owned by Soluciones Militares S.L. Your investigations reveal that Soluciones Militares S.L. is involved in providing software to the Spanish military for use in planning strategies for war and to practise war manoeuvres, but it has been difficult to find out much more precise information about the use of COMMODAT by the Spanish company because it has to keep its information about the Spanish military confidential. Your investigator has been told that the mark is used on a software program.

Write a letter to your client

1. Highlighting the potential problems your client faces (12 marks)
2. Advising on the options he has to secure his position and realise his plans. (13 marks)

Question 6:

Your client, Organidips Limited, is a large UK company that manufactures and sells a range of organic health foods predominantly in the European Union.

They have recently developed a new range of healthy snack dips. The design of the snack packaging is new and consists of the shape of a circular container with a central compartment containing a dip in the middle and pieces of vegetables, such as carrot, cucumber and pepper sticks surrounding the central compartment. The consumer would eat the snack by dipping the vegetable sticks into the dip.

Your client tells you that the product is unusual because the shape of the container is unique for this type of food and the container will consist of a bright colour denoting the flavour of the dip in the container. There would be three main flavours; sweet and sour (gold container), yogurt (silver) and cheese (bronze) dips. Your client informs you that the colours used are not common for this type of food. Both the shape of the packaging and the colours are important to the client.

You have already filed a CTM application for a three-dimensional line drawing of the shape of the container alone covering Class 30 'snack foods and dips' and Class 31 'fresh fruit and vegetables'. An official letter has been received refusing the application under Article 7(1)(b). A copy of the official letter is attached.

In preparation for a meeting with your client:

1. Makes notes to advise your client on the objection raised and ways in which this may be overcome. **(14 marks)**
2. What other steps the client should consider taking to try to protect its new product. **(11 marks)**

Ignore any issues of copyright and designs.

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Examination Division

**Notice of grounds for refusal of application for a Community Trade Mark
Issued under Article 7 of the Regulation and Rule 11(1) of the Implementing
Regulation**

Alicante, 03/10/2006

Name and address of applicant or representative
Trade Mark Attorneys LLP
UNITED KINGDOM

Application No: 005000123
Your reference: TMA/0008
Trade Mark: 3 dimensional device
Applicant: Organidips Limited
UNITED KINGDOM

On examination of your application it has been found that the trade mark is not eligible for registration because it does not comply with Article 7(1)(b) to the extent that:

The mark consists solely of a simple circular shape in the form of a tray with a central compartment representing a container."

The mark has been applied for, for the following:

Class 30 'snack foods and dips' and Class 31 'fresh fruit and vegetables'

Taking the sign as a whole and with no additional elements, this simple representation is devoid of distinctive character. The configuration of this container does not convey information about the origin of the product and neither is it normal for the consumers to identify the origin of such products by their shape or function. Therefore, the relevant public will not be able distinguish this sign as a trade mark, as it would not give an origin to the products designated.

Consequently, the mark applied for, taken as a whole, is devoid of any distinctive character to distinguish the goods in Classes 30 and 31 for which registration is sought within the meaning of Article 7(1)(b).

If you have any observations they should be submitted within two months of the date of this letter, failing which the application will be rejected.

A.N. Examiner