

## THE JOINT EXAMINATION BOARD

## PAPER T6

ADVANCED COMMUNITY TRADE MARK AND  
INTERNATIONAL TRADE MARK LAW AND PRACTICE

Thursday 11th November 2010

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. Time Allowed – 4 HOURS*

1. You should attempt **four questions** in total.
2. The marks awarded to each question are shown at the foot of the question. Only the first FOUR ANSWERS presented will be marked.
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 state your name anywhere in the answers;
  - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
  - f. 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.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of seven pages, including this one.

**Question 1**

Your client is the proprietor of CTM Registration No. 023345678 for the mark MAXIMISER in respect of "laboratory apparatus and equipment, filters; filters for use in high performance liquid chromatography" in class 09. The mark was filed on 22 August 2004 and registered on 17 October 2005. You have just received notification that a cancellation action has been filed at OHIM against the registration on the grounds that the mark has not been used.

1. Advise your client of the procedure involved in a cancellation action at OHIM, the consequences of a successful action and any considerations or issues the client would need to address.

(8 marks)

2. The day before the deadline for responding expires, your client provides you with two invoices from purchasers in Germany and Austria. Each invoice is for 500 units. One is dated 09 January 2006 and the other 05 March 2010. With reference to decided cases, advise your client of the sufficiency of this evidence.

(10 marks)

3. Advise what might be done to strengthen their evidence /position.

(7 marks)

**25 Marks**

**Question 2 –**

Your client has filed a CTM application for the mark HIGH in respect of a line alcoholic fruit based drinks (alcopops). The following is an extract taken from a letter received from OHIM:

"Alicante, 10/11/2010

On Examination of your application it has been found that the trade mark applied for is not eligible for registration under Article 7(1)(c) CTMR.

The mark applied for consists of the word HIGH which is a term commonly understood to be a clear and direct indication of the characteristic of the goods applied for."

With reference to decided cases, advise your client as to how they might deal with this objection.

**25 Marks**

**Question 3 –**

Your client Waterwise International Limited is a Bahamas registered Company with principal offices in London. It has used the trade mark WATERWISE for several years in the UK for "Drinking water dispensing machines" and has a corresponding UK trade mark registration in class 11 which it obtained in 2003.

The UK registration stands in the name of the Bahamas Company and is a series of two trade marks as follows:

WATERwise (in black and white)

WATERwise (in colour – "water" in blue and "wise" in silver).

The business is expanding and your client requires protection throughout the European Union, Australia, Canada, China, Japan, New Zealand and USA. Furthermore, your client explains that it will also be providing "Repair, maintenance and installation services" (Class 37) under the same mark in the above territories. The client is also considering but is not committed to providing its own brand of mineral water. However, the client recalls, from its initial research, that an Australian company may be using the trade mark WISEWATER for mineral water.

Make notes for a meeting with your client on the following:

- a) The filing options available, and the advantages and disadvantages of each option including your advice on any other action / considerations relating to each option. (18 marks)
- b) What action you would recommend with regard to the Australian use and what implications this could have for your client. (5 marks)
- c) Which filing strategy you would recommend and why. (2 marks)

**Bahamas, New Zealand and Canada are not party to the Madrid Agreement or Protocol. All of the other mentioned territories are party to the Protocol.**

**25 Marks**



**Question 4 –**

You represent Webmate UK Ltd a company that operates a UK based internet dating agency. Webmate has UK and Irish trade mark registrations for WEBMATE in classes 38 and 45 and boasts membership levels making it the leading UK and Irish internet dating agency. The registrations were granted in 2001 and the business has been operating since as early as 1999.

Your client advertises extensively on prime time television and radio in the UK and has also advertised at various exhibitions throughout the EU and in related EU publications.

It has always intended to expand its business throughout the EU and has secured Member State country code domain name registrations and the .eu domain name in preparation for such expansion.

However, it transpires that an ex-director of the company who left after a disagreement one year ago has obtained registration of the CTM WEBMATE in classes 9, 38 and 45 and has filed an application to register the trade mark WEBMATES XTREME in the same classes.

Your client has always prided itself on the good reputation of its dating agency ensuring that it retains a respectable image.

Enquiries reveal that the trade mark WEBMATES XTREME is being used to target a different sector of the market and the site is rapidly gaining a reputation for its unsavoury content.

Your client is understandably distressed at the damage which the competing service is causing to the reputation of his business and he has come to you for urgent advice. There have been a number of instances of confusion and your client has received complaints from some of his existing customers.

Prepare notes for a meeting as follows: (ignore any issues relating to domain name disputes)

- a) What actions your client can take in respect of the CTM Application and Registration, the likely chances of success in any recommended actions and the consequences of success. Include reference to relevant case law and any evidence or other material you consider relevant. (21 marks)
- b) Any other steps that your client can take to improve its position. (2 marks)
- c) Any potential problems for your client's future expansion plans. (2 marks)

**25 Marks**

**Question 5 –**

Your client, G.O. Gymnasium Ltd, owns the following Community trade mark registration:

**G.O. GYM**



... G.O. for it!

Application no. 1275023 was filed on 3 March 1999 and granted registration on 17 November 1999 in respect of "*provision of gymnasium facilities*" in class 41.

Your client has traded since the late 1990s, running a chain of gymnasiums throughout the UK and Germany. G.O. Gymnasium Ltd has recently expanded its business to include out-of-town retail shops selling a variety of goods including clothing ( class 25), accessories such as towels and bags (classes 18 and 24) and gym equipment ( class 28), in particular heart rate monitors (class 9), light hand held weights, and equipment for yoga and Pilates ( class 28). It also proposes to refurbish its gymnasiums within the next 6 months to include on-site shops, and cafe bar facilities. On-line sales are to start within the next 12 months, and your client wants to develop a series of exercise programmes that can be downloaded from its website by gym members.

Your client tells you that "G.O. Gym" is always used in connection with the figure device, while it plans to use the figure device and the phrase "G.O. for it!" separately on all of its products and in its advertising. The client intends to invest a significant amount of money in a forthcoming advertising campaign starting on 1<sup>st</sup> January 2011.

Your client wishes to review its Community trade mark protection and make sure that its expanded activities are covered. You have a meeting later today with the Company Secretary of the client. For each of the elements within the trade mark above, write notes to advise on

- a) the registrability of each of the elements, any likely official objections and how you would attempt to overcome them. (22 marks)
- b) Your overall recommendations and the next steps to be taken in order to achieve the broadest protection possible (3 marks)

**25 Marks**



### Question 6 –

Your clients, DDM Ltd, are a mountaineering equipment and related accessories company operating primarily in the UK, Germany, Austria, France, Italy and Switzerland. In September this year, they acquired the trade mark portfolio owned by A41 Ltd (in administration) including

- 1) UK Registrations nos. 1222235 ALL FOR ONE and 1222236 ONE FOR ALL, both registered on 15<sup>th</sup> September 2000.
- 2) Community Trade Mark registration no. 835545 ONE FOR ALL, registered on 23<sup>rd</sup> March 2002.
- 3) International Registration no. 1575112 ALL FOR ONE designating the EU and Switzerland. This registration was based upon UK registration no. 1222235 and registered on 29<sup>th</sup> December 2006. The second statement of grant for the EU designation issued on 25<sup>th</sup> November 2007.

All the registrations cover the following goods:

*'crampons, pulleys, pitons, karabiners, expansion bolts, climbing boards'* in class 6,  
*'ice axes'* in class 8,  
*'rucksacks, day packs, sports bags'* in class 18,  
*'rope for mountaineering'* in class 22, and  
*'clothing, footwear and headgear; footwear for climbing and mountaineering; waterproof clothing; windproof clothing; thermal underwear'* in class 25.

DDM's intention is to launch a range of extreme sports and mountaineering equipment and clothing within the UK and other EU countries from March 2011 under their newly acquired trade marks. The clients have informed you that A41 Ltd used the slogan "All for one and One for all" always in combination with their parent brand "A41" on their stationery and other business papers up to December 2008.

The Company Director of DDM Ltd has emailed to you details of Community Trade Mark application no. 2007923 ONE FOR ALL filed in French by Les Trois Mousquetaires s.a.r.l. on 20<sup>th</sup> April 2010 (published for opposition purposes on September 2010) in respect of

*'toiletries and cosmetics'* in class 3,  
*'jewellery'* in class 14,  
*'handbags, purses, wallets, luggage'* in class 18 and  
*'clothing, footwear and headgear'* in class 25.

Write notes for a meeting with your client at which you will discuss:

- (a) The potential grounds, merits and chances of success in a possible opposition to Les Trois Mousquetaires' application (10 marks)
- (b) Any difficulties your clients are likely to face and measures your clients can take to improve their position (15 marks)

**25 Marks**