

THE JOINT EXAMINATION BOARD

PAPER T6

ADVANCED COMMUNITY TRADE MARK AND
INTERNATIONAL TRADE MARK LAW AND PRACTICE

Monday 7th November 2011

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;
 - g. You must number all the pages of your answer script. Once the exam finishes, an additional 5 minutes will be allowed for you to do this.
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, number all the pages 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 (7) pages, including this one.

Question 1

Your client, an Italian company, Mamma Mia SpA, sells dried pasta through supermarkets and grocers throughout Europe and has done so since 2004. Mamma Mia owns CTM registration no. 010616100 for the word mark TRICOLORE TIGER. The application was filed on 1st March 2004 and registered 16th September 2005 in class 30 in respect of "pasta; sauces (condiments)".

You have received notification of an application for invalidity raised by a UK company, Ordinary Foods Ltd. Your client has never heard of this company or their products before. The grounds for the application are that, under Article 53(1) CTMR, the mark was registered in breach of Articles 8(1)(b) based on earlier rights and 8(4) on the basis of UK passing off protecting an unregistered trade mark.

The registered marks belonging to Ordinary Foods are all UK registrations with the following particulars:

Trade mark	Goods	Filing date	Reg. date
TIGER RED	Ready meals; pizza, pasta, risotto	7 December 2003	15 June 2004
TIGER GREEN	Ready meals; pizza, pasta, risotto	7 December 2003	15 June 2004
TIGER WHITE	Ready meals; pizza, pasta, risotto	7 December 2003	15 June 2004

The unregistered mark is:



Your client informs you that their initial online investigations reveal that Ordinary Foods Ltd sells microwaveable ready meals under their registered trade marks in UK, Ireland, France, Germany, Belgium and Holland. All products also bear the unregistered mark and they have an approximate annual turnover of £7 million, which has been relatively consistent for the last 10 years and advertising expenditure of roughly £750k p.a.

Further investigation reveals that Ordinary Foods Ltd has sponsored Ready Food Awards for the last 3 years and has attended various food festivals throughout the UK over that time.

Prepare a response to your client advising them on the following:

1. the merits and strength of each of the grounds of invalidation, with reference to appropriate case law; (20 marks)
2. your recommendations, in brief, on further steps/actions your client could take to improve its position. (5 marks)

25 Marks

Question 2

Your client makes beverages and has developed a new shape and design of bottle for its sports drinks which it has been selling with considerable success in the UK for 18 months. The bottle is shaped like a small exercise weight or dumbbell with a narrower middle covered in dimples to aid grip. The product appeals in particular to runners and participants in exercise classes who can easily hold the bottle which doubles as a small weight to enhance the workout. Your client tells you that the shape is quite unlike anything else in the sports drink market.

Your client wishes to file a CTM application to obtain the broadest protection possible for the bottle shape without a word mark or logo on it.

Advise your client on:

1. Any objections you anticipate an application for the bottle shape might encounter on examination; (17 marks)
2. The arguments or other suggestions you would put forward to address these objections. (8 marks)

Your answers should include detailed references to relevant case law and a summary of the principles those cases established in relation to the registrability of shapes as trade marks.

Do not discuss design or copyright issues.

25 Marks

Question 3

Your client is a Canadian national permanently living in London, England.

He has just recently acquired a watch making company in Switzerland. The watch range is branded HERITAGE and he has imminent plans to expand the business under this brand name to the EU, USA, Canada, Singapore, New Zealand and Australia. He is also intending to extend the range of products under the name HERITAGE to men's accessories covering watch straps, eyewear (such as sunglasses and spectacles), cufflinks, tie pins, executive cases and bags, stationery and pens.

The purchase of the Swiss company included a registration for the mark HERITAGE in Switzerland, registered on 1 January 2000, and a CTM application filed on 1 June 2011. Both the registration and application cover "horological and chronometric instruments, including timepieces, clocks and watches" in class 14.

Over the past few years, sales of the HERITAGE watch range in Switzerland have been limited. Sales of the watch range in the European Community stopped in 2004. The client has heard of the International Registration system and wants to use this system, if at all possible, to obtain protection in the countries of interest. He has also mentioned that he is aware of an established and well known women's fashion brand in Spain called EL HERITAGES, owned by a Spanish company.

Write notes in preparation for a meeting with the client on the following issues:

1. The filing options open to your client, setting out the advantages and disadvantages of each and including your advice on any actions/considerations relating to each. (21 marks)
2. Your recommended filing option and strategy, including any further steps you advise. (4 marks)

Switzerland, Australia, the European Union, Singapore and the USA are members of the Madrid Protocol. Switzerland is a member of the Madrid Agreement. Canada and New Zealand are not members of either.

25 Marks

Question 4

Your client Brightstar Ltd has been operating a successful business since 2003 in the UK and Ireland selling a range of carpet cleaning products. It is the market leader in this field and has a strong reputation which it is keen to protect. It has a CTM registration for BRIGHTSTAR for carpet cleaning products in Class 3, vacuum cleaners, carpet cleaning machines and apparatus in Class 7 and carpet cleaning services in Class 37.

The CTM was filed on 20 June 2002 and registered on 10 January 2004. To date your client has only sold cleaning products under its trade mark but it is now interested in offering a range of carpet cleaning machines and a call-out carpet cleaning service. The cleaning services will be provided in the UK and Ireland only, but it is intended to make the cleaning products and machines available throughout the rest of the EU. The intended launch date is February 2012.

Via its watching service your client has been alerted to a CTM application for the mark BRITE and Star device (see image below) in class 3 for 'cleaning preparations', Class 7 for 'industrial cleaning machines' and class 21 for 'sponges, brushes', in the name of a French company, Brite SA. The application was filed in February 2011 and published on 1 November 2011 and claims seniority from France, Germany and Spain dated January 1999, March 2002 and May 2003 respectively.



Your client wants to stop this application.

Advise your client on the following points:

1. The recommended grounds for opposition including the chances of success; (10 marks)
2. Any problems which you foresee and how these will affect your client's plans; (10 marks)
3. Your recommended strategy and any other proposals. (5 marks)

25 Marks

Question 5

You act for Geneva Finanz AG, a Swiss company, which produces a range of financial and book-keeping training products including software packages, downloadable courses and textbooks. Geneva Finanz also offers a range of technical and managerial training courses for finance and accounts staff.

1. Your client has asked for your advice on the registration of various trade marks as Community Trade Marks:
 - a. GENEVA FINANZ: this is the client's primary trade mark, and is already being used in relation to all of its goods and services.



Your client has recently started to use these three images on its printed materials, both in combination with the word mark and alone, as an indication of its Swiss credentials. The first image is the recognised symbol for the canton (region) of Geneva.

- c. The sound of a man yodelling, which your client uses in its team-building and motivational courses, for example, to mark the start and end of team events, as well as on its website and in TV and radio advertising.

The goods and services of interest are:

Class 9: Computer software; electronic publications (downloadable); pre-recorded storage media; CDs; DVDs.

Class 16: Instructional and teaching materials; printed publications; textbooks; worksheets; training manuals; spread sheets.

Class 41: Education and training; arranging of training, conferences and seminars; organisation of team building and motivational courses.

Write detailed notes for your client on the registrability of each trade mark, outlining the potential objections and how they might be overcome. (21 marks)

2. Your client has also enquired about registering SWISS FINANZ and GENEVA FINANZ as collective marks: attendees of your client's training courses will be able to provide their own training courses. The collective marks will be used as a badge of quality by the course providers, who will be encouraged to display the marks on their literature and websites. Briefly outline the function of a collective mark and comment on whether or not the client can register these two trade marks as collective marks. (4 marks)

25 Marks

Question 6

Your client, Roaming Productions Ltd, sells artwork, DVDs, and printed publications, all with a theme of travel and exploration. Your client owns the following registered trade mark:

Trade Mark	Territory	Filing date	Registration date	Goods/services
ROAM	CTM	17 Feb 1998	22 Dec 1998	9:photographs; CDs, videos, tapes and cassettes 16:printed publications; books, magazines

Your client tells you that ROAM is a monthly magazine aimed at ramblers and hill walkers, dating back to the early 1980s. ROAM has not been published since July 2006, although back issues have since been sold to consumers in the UK and Scandinavia. Due to financial difficulties your client did not publish the publication but, instead, continued to run its website under the domain name www.roamfree.co.uk, selling downloadable travel guides and photographs with a travel theme. You are informed that initial content for the January/February 2012 relaunch of the print edition of ROAM is being collated.

An application by 5X Media Ltd to register a CTM for the trade mark ROAMING FREE has come to your client's attention. The managing director of 5X Media Ltd is the ex-financial controller of your client. The application was filed on 4 April 2011, and was published for opposition purposes on 26 September 2011 in respect of:

Class 9: apparatus for recording, transmission or reproduction of images; pre-recorded storage media; DVDs, CDs; electronic images (downloadable).

Class 16: printed matter; photographs; pictures; books; journals; magazines; calendars; diaries; post cards; greeting cards.

Class 35: retail and online services in respect of apparatus for recording, transmission or reproduction of images, pre-recorded storage media, DVDs, CDs, electronic images (downloadable), printed matter, photographs, pictures, books, journals, magazines, calendars, diaries, post cards and greeting cards.

You have written to 5X Media's attorneys threatening opposition. 5X have responded in a letter threatening to revoke your client's registration for non-use and setting a term expiring 25th November 2011 to surrender the registration. Prepare notes to advise your client on:

1. The potential grounds for opposition, the chances of success in a possible opposition to 5X's application and any potential difficulties (in brief outline) your client may face during the proceedings; (10 marks)
2. In relation to the threatened revocation action, your client's position and the strength of 5X's case (referring to case law where appropriate); (13 marks)
3. Your overall recommendations on steps the client can take to improve its position, if any. (2 marks)

25 Marks