

THE JOINT EXAMINATION BOARD

PAPER TS

BASIC OVERSEAS TRADE MARK LAW AND PRACTICE

8th November, 1991

10.00 a.m. - 12.00 noon

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 and number it clearly in the margin. Write on one side of the paper only using BLACK ink. You must write your examination number and the designation of the Paper in the top right hand corner of each sheet. 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.

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## Paper T5

## BASIC OVERSEAS TRADE MARK LAW AND PRACTICE

November, 1991

1. Your client wants to assign one of their trade marks without any goodwill in the following countries:

Austria  
Germany  
Greece  
South Africa  
Switzerland

In which, if any, of these countries would that cause problems?  
(5 marks)

2. Your client wants to register its trade mark in respect of cosmetics (Class 3), sunglasses (Class 9), and beachwear (Class 25) in the following countries. How many applications must it file in:

Australia  
Benelux  
Denmark  
Spain  
Turkey

(5 marks)

3. What are the pre-conditions for applying to register a trade mark in USA?

(5 marks)

4. In which of the following countries are official searches made to establish whether an application conflicts with existing registrations:

Canada  
France  
New Zealand  
South Africa  
Sweden

(5 marks)

5. In which of the following countries is use of a trade mark necessary for its registration:

Australia  
Canada  
Japan  
South Africa  
USA

(5 marks)

6. A search reveals registrations in the following countries of a mark or marks almost identical to that of your client. Your client instructs you to file applications for its mark despite this, as they assure you that they know the prior registrant will not file opposition. Will there, in your opinion, be other problems in achieving registration?

Denmark  
Ireland  
France  
Germany  
Greece

(5 marks)

7. Your client, Harry Smith, wants to register his surname as a trade mark in the countries set out below. Ignoring the possibility of confusingly similar marks, in which countries, and why, would you expect to encounter difficulties?

Benelux  
Canada  
Germany  
Italy  
South Africa

(5 marks)

8. What special requirements are there for renewal of a trade mark registration in Japan and USA?

(5 marks)

9. Can service marks be registered in the following countries?

Australia  
Canada  
Ireland  
Japan  
Portugal

(5 marks)

#### PART B

10. Your US client filed an application to register a trade mark in USA three months ago, and now wants to register the mark widely in other countries. Discuss any advantages and disadvantages of claiming convention priority.
- (12 marks)
11. Your UK client wishes to obtain an International Registration of their trade mark to cover the whole of the EC. Can you see any difficulties about achieving this, and can you suggest ways of overcoming any problems.
- (12 marks)
12. Your client registered a trade mark six years ago in the countries listed below, but have not so far used the mark anywhere. It now intends to start use next week in these

countries. What action, if any, would you recommend your client to take in respect of each country?

Benelux  
Denmark  
France  
Japan

(12 marks)

13. Your client is about to launch a product throughout the EC. They consider that the carrying out of searches prior to filing is a waste of money. What advice would you give the client?

(12 marks)

14. The applications you have filed in:

Germany  
Greece  
Portugal  
Spain

have been advertised and attracted no oppositions during the period allowed in each country. Is it safe to assume registration will follow almost immediately in each country? Give reasons if not.

(12 marks)

15. It has come to your UK client's notice that a trade mark similar to its own has been applied for, and it wants to object. The applicant is a French company which has obtained a home registration and is applying for an International Registration extended to:

Benelux  
Germany  
Italy  
Portugal  
Spain

How should your client proceed?

(12 marks)