

THE JOINT EXAMINATION BOARD

PAPER T5

BASIC OVERSEAS TRADE MARK LAW AND PRACTICE

19th November 1998

3.00 P.m. – 5.00 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 designation 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 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.
8. **NO** writing whatsoever, including numbering of papers, is allowed prior to the commencement of the examination or after it has finished.
9. Please put your answers in **QUESTION NUMBER ORDER** before placing in the envelope provided.

THIS PAPER COMPRISES 3 PAGES (INCLUDING THIS FRONT SHEET)

PAPER-T5

PART A Candidates should attempt no more than **eight** questions

- 1) Advise your client of the requirements for and any advantages/disadvantages of claiming seniority in connection with a Community Trade Mark. (5 Marks)
- 2) What are the essential differences between the national procedures for Switzerland and Italy ? (5 Marks)
- 3) Your UK client has a UK registration and wishes to protect his mark in Hong Kong and China, advise your client. (5 Marks)
- 4) Explain briefly the concept of exhaustion of rights. (5 Marks)
- 5) Your client has filed in the UK on 1 August 1998 and requires registration in Taiwan and Thailand. Advise your client on the steps to take. (5 Marks)
- 6) Your client has filed a Community Trade Mark Application on 1 July 1997 and has recently received the Search Results from OHIM. How do these results assist your client on the decision to use immediately in France and Sweden ? (5 Marks)
- 7) Explain to your lay client the concept of claiming “convention priority” and what documents are necessary to support a convention priority claim. (5 Marks)
- 8) Your client wishes to sell a soccer educational video and provide soccer skills courses in France and Brazil. Advise your client how to protect its trade mark in both jurisdictions and outline the registration procedures for each. (5 Marks)
- 9) Your client has applied to register a trade mark in Denmark and has been advised it will be necessary to obtain consent to overcome a prior registration. The Prior Rights holder has agreed to provide the letter of consent on condition that your client provide a Prior Rights declaration. Advise your client why the Prior Rights declaration has been requested and the main provisions you would expect to find in the declaration. You are not expected to draft the declaration. (5 Marks)

PART B Candidates should attempt no more than **five** questions

- 10) Outline the bases on which an application can be filed and the relevant registration procedures for the three NAFTA countries (USA, Canada and Mexico). (12 Marks)
- 11) Your client is the registered proprietor of a trade mark in Austria, Benelux, Spain and the USA, all registered in 1994. The mark has not yet been used but your client now wishes to do so. Advise your client if it is safe to do so and what, if any, further enquiries you would recommend. Give reasons for your recommendations. (12 Marks)
- 12) Your UK client is the registered proprietor of a trade mark in the United Kingdom and now wishes to obtain protection for that mark in Scandinavia (Denmark, Norway, Sweden and Finland). Advise your client of the options available for obtaining registration and the relative advantages and disadvantages of each. (12 Marks)
- 13) Your client is the registered proprietor of a Community Trade Mark Registration for a new product and proposes to grant an exclusive licence to Company A for the use of that mark in respect of the goods covered by the registration for France, Benelux and Germany; and an exclusive licence to Company B for Spain, Italy and Greece. Your client will retain the right to the use of the trade mark in the remaining countries of the EU. Advise your clients on the implications of the proposal with specific reference to the Treaty of Rome. In addition, advise your clients where it is necessary to record the licence (12 Marks)
- 14) Your UK client filed an application in the UK four months ago and wishes to use the Madrid Protocol to obtain protection in the Netherlands, Greece, Portugal and Germany. The UK application has been opposed. Advise your client how the Madrid Protocol system operates in these circumstances and of any possible problems. (12 Marks)
- 15) Your client is contemplating opposing a CTM application, advise your client of the time scales, documentary requirements and procedures for opposition proceedings before OHIM. (12 Marks)

