

THE JOINT EXAMINATION BOARD

PAPER T5

BASIC OVERSEAS TRADE-MARK LAW AND PRACTICE

22 November 2001

3.00 p.m. - 5.00 p.m.

Please read the following instructions carefully. this is a TWO HOUR paper.

1. You should attempt **eight** questions from Part A and **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 them in the envelope provided.

This paper consists of FOUR pages, including this page.

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22nd November 2001

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PART A

Question 1

Outline the procedures for a USA trade mark application from publication of the application to issue of the registration.

(5 marks)

Question 2

Write brief notes on 'central attack'.

(5 marks)

Question 3

Explain the effect of Article 6 *quinquies* of the Paris Convention (the so-called 'telle quelle' provision).

(5 marks)

Question 4

What changes have taken place in the trade mark law of Brazil since January 2000 ?

(5 marks)

Question 5

Name TEN countries outside the EU which are members of the Madrid Protocol.

(5 marks)

Question 6

Write brief notes on the decision on retail services of the OHIM Third Board of Appeal in GIACOMELLI Sport S.p.A.'s application.

(5 marks)

Question 7

Briefly outline the provisions for cancellation of a trade mark on the grounds of non-use in Canada.

(5 marks)

Question 8

Write brief notes on the protection of well-known marks generally under the Paris Convention.
(5 marks)

Question 9

Write short notes on examination of trade mark applications on relative grounds at OHIM.
(5 marks)

PART B

Question 10

List the stages, procedures and any time limits involved in opposition proceedings before OHIM.
(12 marks)

Question 11

Your client wishes to launch a new product in most countries of the EU, as well as Switzerland, Norway and two Baltic states, Lithuania and Estonia. Three months ago, you filed a UK trade mark application on his behalf for the product involved, but the application has not yet been examined. At the time of the UK filing, your client did not explain that he planned to market the product outside the UK, so your clearance searches covered only prior rights in or affecting the UK.

Outline the advice you would now give your client and the steps you would advise him to take.
(12 marks)

Question 12

Compare and contrast the protection given to trade marks under the Madrid Protocol and the Community Trade Mark Regulation. What are the advantages and defects of the two systems.
(12 marks)

Question 13

Your client filed a UK trade mark application four months ago. He now wishes to protect the mark in Australia, Taiwan and USA.

The mark is in use in the UK but your client is not intending to put the mark into use for another four years in these remaining countries. your client has instructed you to file national applications in the countries in question. What warnings would you give arising from his plans to delay use of the mark abroad ?

(12 marks)

Question 14

Set out the requirements for maintenance, renewal and restoration of registered trade marks in Portugal and Spain, including non-use periods.

(12 marks)

Question 15

Explain what is meant by 'seniority' in relation to a CTM application and the procedural requirements for claiming it. How does the OHIM deal with such claims at the present time?

(12 marks)