

THE JOINT EXAMINATION BOARD

PAPER T5

BASIC OVERSEAS TRADE MARK LAW AND PROCEDURE

Thursday 21ST November 2002

3.00pm – 5.00pm

Please read the following instructions carefully. Time allowed – **TWO HOURS**

1. You should attempt **8** questions from Part A and **5** questions from Part B. There are 15 questions altogether, 9 in Part A and 6 in Part B.
2. The marks attributed to the questions are shown – questions in Part A carry 5 marks and those in Part B, 12 marks. Questions answered in excess of eight in part A and five in part B will not be marked.
3. Where a question permits, reasons should be given for the conclusions reached.
4. Please note the following:
 - Start each question (but not necessarily each part of each question) on a fresh sheet of paper.
 - Enter the appropriate Paper Number, the question number and your Examination number in the appropriate boxes at the top of each sheet of paper.
 - Write on one side of the paper only, within the printed margins using a **BLACK** pen.
 - **DO NOT** use coloured pens or highlighters within the answers – they will not photocopy
 - **DO NOT** staple or join pages together in any way
 - **DO 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. **ALL** mobile phones and electronic aids **must be** switched off and stored away.
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
8. **NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED. At the end of the examination, assemble your answer sheets in question number order and place in the WHITE envelope provided.**

This paper consists of 4 pages, including this page.

PART A

1. Who is entitled to file a Community Trade Mark application?
(5 marks)

2. Name 5 OECD countries where no examination on relative grounds is carried out.
(5 marks)

3. Outline the requirements for renewal of a trade mark registration in Taiwan.
(5 marks)

4. In the context of opposition proceedings, outline the practice on language and translation requirements before OHIM.
(5 marks)

5. What are the non-use provisions in Brazil, Mexico, Hong Kong, Singapore and China?
(5 marks)

6. What is a Prior Rights Declaration, and what provisions would you expect it to include ?
(5 marks)

7. Who may file observations concerning the registration of a CTM, what is the procedure, and how does OHIM deal with them?
(5 marks)

8. Your client has learnt of a conflicting Madrid Protocol registration. It is based on a Benelux national application and extends to Germany, Greece, China and Japan. Your client wishes to object on the basis of his prior registrations in these countries. What options are open to him? Mention any time limits that your client will face.

(5 marks)

9. Outline the provisions for transformation of an International Registration under the Madrid Protocol.

(5 marks)

PART B

10. Outline the requirements for maintenance and renewal of trade mark registrations in the USA and Canada, including non-use periods.

(12 marks)

11. Outline the changes to the trade mark law in Spain, which came into effect on 31 July 2002.

(12 marks)

12. (a) Outline briefly the concept of 'exhaustion of rights'.
(b) What is meant by the term 'international exhaustion' ?
(c) In this context, what is 'specific subject matter' ?

(12 marks)

13. What are the main sources of law which govern the protection of trade marks in the member states of the EU and how do they apply ?

(A detailed discussion of the national laws of each individual member state is not required.)

(12 marks)

14. Set out the conditions and procedure for obtaining protection for a trade mark under the Madrid Protocol.

(12 marks)

15. You carried out clearance searches for your client's new trade mark in Hong Kong, China, Malaysia and Singapore and, having found no obstacles, filed applications to register the mark in all of these countries. Your client has been making preparations to commence marketing in each country and has his distributor network set up. He has just heard that the same product is already being sold in Singapore by another company (based in Hong Kong) under a very similar name. Singapore is an important part of your client's plans. What enquiries would you now make, and how would you advise your client to proceed?

(12 marks)