

THE JOINT EXAMINATION BOARD

PAPER T6

**ADVANCED COMMUNITY TRADE MARK AND INTERNATIONAL
TRADE MARK LAW AND PRACTICE PAPER**

Friday, 22nd November, 2002

10.00 a.m. – 1.00 p.m.

Please read the following instructions carefully. **Time allowed - THREE HOURS**

1. You should attempt **four** questions. All questions carry **25 marks**. If more questions than necessary are attempted, they will be marked in the order presented and the questions over the required number will be ignored.
2. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
3. Please note the following:
 - Start each question (but not necessarily each part of each question) on a fresh sheet of paper.
 - Enter the 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
4. Unless specifically requested answers are **NOT** required in letter form.
5. **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.
6. Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
7. **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 **fifteen** pages including this page.

- 1 Your clients, Minerva Ltd, have sold a range of protective clothing products including principally gloves, goggles and helmets, for many years in the UK under the trade mark MINERVA. Their main products are designed specifically for use in the construction industry although since March 2000 they have also offered a new product line in the form of winter gloves. They have not to date traded outside the UK.

Minerva Ltd are the proprietors of a UK registration with the following details:

Number	Mark	Filing date	Registration date	Specification of goods
2084464	MINERVA	4 December 1995	16 June 1996	Protective clothing, goggles, protective helmets, protective gloves. [class 9] Clothing, footwear and headgear. [class 25]

In early 2000, around the time they launched their new lines of gloves, your clients identified a medium term aim of expanding beyond the UK, as a result of which they filed an application to register MINERVA under the Madrid Protocol (MP). In fact, they have not yet commenced trading outside the UK. Details of their MP application are shown below:

Number	Mark	Filing date	Specification of goods	Home registration	Designations and status
577123	MINERVA	2 March 2000	As for UK registration	UK no. 2084464	France Registered Greece Pending examination Finland Registered Sweden Registered Germany Opposed

[Note: Germany and Greece were added as subsequent designations on 14 November 2000; all the other designations were included at the time of filing]

The German designation of the MP application has been opposed by a company called Minerva GmbH, who have just written to your clients drawing their attention to the opposition and the fact that it is based on a CTM registration, in the name of Minerva GmbH, with the following details:

Number	Mark	Filing date	Registration date	Specification of goods
1845432	MINERVA	15 September 2000	4 January 2001	Protective clothing. [class 9] Clothing, footwear, headgear. [class 25] Sports apparatus and equipment and their parts and fittings. [class 28]

Investigations reveal that Minerva GmbH have sold a range of winter and sports clothing, including gloves, anoraks and ski and cycle helmets under the trade mark MINERVA since late 1998 in Germany, France and Benelux. They also show that the company was incorporated in July 1998, and that one of the directors is a Marcus Harrison, formerly the financial controller of Minerva Ltd, who had left the UK company in April 1998 in rather acrimonious circumstances. Minerva GmbH have no other trade mark registrations or applications.

Advise your clients, in note form, on what steps they might take in relation to CTM registration no. 1845432, on the respective strengths of the trade mark positions of Minerva Ltd and Minerva GmbH, including in relation to any grounds pleaded, and on any other steps they might take.

25 marks

- 2 Your clients, Eurocell Ltd, are a new business who were incorporated in the UK in June 2002. They primarily supply industrial batteries of all types to a variety of businesses, and they also hire out industrial battery recharging apparatus and provide a maintenance service to their customers. They have also developed a sophisticated piece of software which regulates and monitors power supply to equipment within commercial and industrial environments such as factories and warehouses.

On 15 June 2002, they filed a CTM application in the following terms:

Mark	Applicant	Specification of goods and services
EUROCELL	Eurocell Ltd	<p>Batteries and battery recharging apparatus; parts and fittings for the aforesaid goods; computer software with applications relating to power regulation and supply. [Class 9]</p> <p>Servicing and maintenance of batteries and recharging apparatus for batteries. [Class 37]</p> <p>Rental of batteries and battery recharging apparatus. [Class 42]</p>

OHIM have just issued the enclosed official letter objecting to the application under Article 7. Prepare a substantive response to the Examiner arguing in detail against the objections raised, referring where appropriate to decided cases.

[Note Assume that your clients are not able to rely on evidence of acquired distinctiveness.]

25 marks

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Examination Division

**Notice of grounds for refusal of application for a Community trade mark
Issued under Article 7 of the Regulation and Rule 11(1) of the Implementing Regulation**

Alicante, 10/11/2002

Name and address of applicant or representative
Trade Mark Attorney
UNITED KINGDOM

Application No: 002214827
Your reference: TMA/3044
Trade mark: EUROCELL
Applicant: Eurocell Ltd
Unit 6, Industrial Estate
Slough, Berks SL2 4HR
UNITED KINGDOM

On examination of your application it has been found that the trade mark is not eligible for registration because it does not comply with Article 7(1)(b) and (c) to the extent that:

The trade mark consists exclusively of the term EUROCELL which describes a battery suitable for use in Europe. EURO is devoid of any distinctive character, and CELL merely directly describes the goods and services in question. The combination is therefore devoid of distinctive character and/or descriptive as far as it indicates the content and kind of the goods in class 9 and the intended purpose of the services in classes 37 and 42 (ie goods and services relating to batteries suitable for use in the European Community), and cannot be recognised as a distinctive sign by those to whom it is addressed as identifying goods and services from a particular source.

If you have any observations they should be submitted within two months of this communication failing which the application will be rejected.

Andrew McDonald

- 3 Your clients, Coates (UK)Ltd, wish to adopt the word mark PYRAMID in the UK, EU, Norway and China in respect of chewing gum. On their instructions, you have carried out appropriate availability searches of the national, International and CTM Registers. The searches have revealed the following registrations for the identical mark:

Country	Registration No.	Filing Date	Status	Specification	Proprietor
France	245678	05/05/96	Registered on 31/10/97	Confectionery	Layers, Inc
International	765432	15/12/97	Registered	Confectionery	Mackintosh SA

The International Registration is based on French Registration no. 245678 and is dated 15th December 1997. The states designated are Denmark, Norway, China and Cuba and all have been granted protection.

Further investigations reveal that French Registration no. 245678 was originally filed in the name of Mackintosh SA and was assigned to Layers, Inc on 10th March 2001. Mackintosh SA is a wholly owned subsidiary of Layers, Inc. Investigations also show that no use of the mark has been made by Layers or Mackintosh.

- A Advise your clients on their position, and the steps they could take to remove any obstacles to their proposed use and registration of PYRAMID. Assuming your clients wish to proceed with the registration of their proposed mark in relation to the goods of interest, advise them on the advantages and disadvantages of each option open to them. [20 marks]

- B Assume your clients decide to proceed to file a UK Trade Mark Application and an International Registration for PYRAMID for "chewing gum". Provide bullet points outlining the filing requirements and prosecution process for their International Registration. [5 marks]

25 marks

- 4 You represent Total Waste Carriage Plc who have applied to register TWC as a CTM in class 39 for “transportation of liquid waste in bulk”. The mark was filed on 1 June 2000 and advertised for opposition purposes on 1 April 2001. Having previously only used its full name, at the time of filing the client had made no use of the mark TWC, nor does it have any other rights of any kind in TWC in the EU beyond this application.

OHIM served the attached Notice of Opposition on 1 July 2001. There were various extensions to the cooling off period to allow settlement discussions but these failed. You made a formal request at OHIM that the opponents demonstrate that the earlier trade mark had been put to genuine use (Article 43(3)). In response, the opponents filed Documents 3 and 4. They did not file any additional material in support of their opposition.

You are now at the point where you must file your client’s Observations in Reply to the opposition. Your client has no further information to give you.

Draft Observations in Reply based on the materials before you, including references to decided cases if appropriate. Assume the Notice of Opposition is admissible and that there are no technical deficiencies.

25 marks

Attachments to this question

- Document 1 Opposition form (relevant pages only – pages 2.3 and 2.5 purposely omitted, no comment necessary).
- Document 2 Translated certificate of Benelux Registration No. 230952 (assume the copy certificate is served and acceptable and that no further information is needed as regards the registration details).
- Document 3 Statement of H Pueffer.
- Document 4 Sample Invoice.

Notice of Opposition

StudentBounty.com


This area is reserved for OHIM

For OHIM

Date of receipt

Number of pages

Opponent's /Representative's reference

Language		1	<input type="checkbox"/> ES	<input type="checkbox"/> DE	<input checked="" type="checkbox"/> EN	<input type="checkbox"/> FR	<input type="checkbox"/> IT
2 Mandatory	Opposed application	2	Application number <u>989898900003</u>				
3 Mandatory	Applicant	3	<u>Total Waste Carriage PLC</u>				
4 Optional	Date of publication	4	<u>1/4/2001</u>				
5 Indicate ID number if available; if not, complete page 2	Opponent	5	<input type="checkbox"/> given				
6 Mandatory	Name of opponent	6	<u>TMC NV</u>				
7 Mandatory: check the appropriate box	Entitlement	7	<input checked="" type="checkbox"/> proprietor <input type="checkbox"/> authorised licensee <input type="checkbox"/> person authorised under national law				
	Evidence of entitlement	8	<input checked="" type="checkbox"/> attached <input type="checkbox"/> to follow				
9 Check the box if a professional representative is appointed	Professional representative	9	<input checked="" type="checkbox"/> appointed				
10 Indicate ID number if available; if not, complete page 3	ID number of professional representative	10	<input checked="" type="checkbox"/> given				
11 Mandatory	Name	11	<u>SNR MERKENBUREAU NV</u>				
12 Check this box if OHIM is already in possession of authorisation and	Authorisation	12	<input checked="" type="checkbox"/> already on file				
13 Indicate ID number of authorisation if available	ID number of authorisation	13	<input type="checkbox"/> given				
14 Check one of these boxes if authorisation is not on file	Authorisation not on file	14	<input type="checkbox"/> attached <input type="checkbox"/> to follow				
15 For fees see current table of fees	Fees	15	Opposition fee _____ EURO				
16 Payment will automatically be deducted from current account unless one of the following boxes is checked or a specific instruction to the contrary is provided	Payment	16	<input checked="" type="checkbox"/> current account No. <u>000264</u>				
17 If payment is remitted indicate OHIM account number	Remittance to account of OHIM	17	<input type="checkbox"/> OHIM account No. <u>Banco Bilbao Vizcaya 0182-5596-009222222-90 Swill Code: BBVAESMM</u>				
18 Indicate date of remittance of payment	Date of remittance	18	_____				
	Cheque	19	<input type="checkbox"/> attached				
20 Optional	Signature	20	<u>1/6/01</u>				
21 Mandatory	Date of signing	21					
22 Indicate name of person signing	Name	22	<u>SNR MERKENBUREAU NV</u>				
23 Check as appropriate if signature is by employee representative or professional representative		23	<input type="checkbox"/> employee <input type="checkbox"/> legal practitioner <input checked="" type="checkbox"/> professional representative				
24 Total number of sheets, including attachments	Number of sheets	24	_____				

Notice of Opposition

OHIM-Form
2.2 EN

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Complete this page only when indications on page 1 are insufficient

Opponent

²⁵ Check this box if applicable and

Nature

²⁵ legal person natural person

²⁶ indicate name

Name

²⁶ TMC NV

First name/s of natural person

²⁷

Address

Street and house number or equivalent

²⁸ Van Der Valk Centre, 100 Tulipstraat

City and postal code where available

²⁹ Rotterdam r-9087654

Country

³⁰ Netherlands

³¹ If different from above, such as P.O. Box, city and postal code

Postal address

³¹

Telephone number/s

³²

Telefax number/s

³³

Electronic mail ID

³⁴

Other information

³⁵

Multiple opponents

³⁶ Where there is more than one opponent, check the box, and indicate on this page the required information for all additional opponents; if the space provided is not sufficient, use attachment instead.

Multiple opponents

³⁶

Absent any other information, the name and the address of the opponent indicated above will be used as an address for correspondence with regard to all opponents.

Economic connections

³⁷ If an employee of a legal person having economic connections with the opponent is appointed to act on behalf of the opponent, check the box and provide the necessary details (name and address of legal person having economic connections with opponent, basis of economic connections); if the space provided is not sufficient, use attachment instead.

Economic connections

³⁷

Notice of Opposition

OHIM-Form
2.4 EN

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Basis of opposition

⁵³ Check the appropriate boxes and provide the required information hereafter: if opposition is based on more than one earlier mark or sign, additional sheets (copies of this page and page 5) must be completed, if necessary, for each earlier mark or sign

Opposition is based on

- ⁵³ earlier mark (registration or application)
⁵⁴ earlier registered mark with reputation
⁵⁵ earlier well-known mark
⁵⁶ earlier non-registered mark
⁵⁷ earlier other sign used in the course of trade
⁵⁸ mark filed by an agent

Earlier mark (registration or application)

⁵⁹ Check one of these boxes

Type of mark

- ⁵⁹ Community mark national mark international registration with effect in a Member State

⁶⁰ If national mark or international registration, check the appropriate box

Member State/s

- ⁶⁰ DK DE GR ES FR IE IT AT PT FI SE GB BENELUX

⁶¹ Indicate word mark; if other type of mark, provide a representation on attachment

Representation of the mark

⁶¹ TMC (device) - SEE ATTACHED CERTIFICATE

⁶²⁻⁶⁵ Complete as appropriate: if priority is invoked, provide details on attachment

Filing date

⁶² 1/1/1992

Filing No.

⁶³ 230709

Registration date

⁶⁴ 1/1/1993 (date registration confirmed)

Registration No.

⁶⁵ 230952

⁶⁶ Copy required only when earlier mark is a national mark or international registration

Copy of registration/application

- ⁶⁶ attached to follow

⁶⁷⁻⁶⁸ Check and complete as appropriate:

Opposition is based on

- ⁶⁷ all the goods/services for which earlier mark is registered/applied for
⁶⁸ less than all the goods/services, namely:

Earlier registered mark with reputation

⁶⁹ If opposition is based on earlier registered mark with reputation, complete lines 69-72 and box 70 and check as appropriate one of the following boxes

Reputation

- ⁶⁹ in the Community in a Member State (including Benelux)

⁷⁰ Check the appropriate box

Member State

- ⁷⁰ DK DE GR ES FR IE IT AT PT FI SE GB BENELUX

⁷¹⁻⁷² Check one of the boxes and complete as appropriate: indicate only goods/services for which reputation is claimed; if the space provided is not sufficient, use attachment instead

Opposition is based on

- ⁷¹ all the goods/services for which earlier mark is registered
⁷² less than all the goods/services, namely:

Evidence of reputation

- ⁷³ attached to follow

Notice of Opposition

OHIM-Form
2.6 EN

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Extent of opposition

⁹⁰ Check one of these boxes

Opposition is directed

against all goods/services in the application

against part of goods/services in the application, namely:

⁹²

⁹² Specify goods / services against which opposition is directed; if the space provided is not sufficient, use attachment instead

Grounds of opposition

⁹³⁻⁹⁴ Check the appropriate box when opposition is based on earlier mark (registered or application) or earlier well-known mark

Opposition is based on earlier mark and

identity of marks and goods/services

likelihood of confusion

⁹⁵ Check the box when opposition is based on earlier registered mark with reputation

Opposition is based on earlier registered mark and

unfair advantage/detriment to distinctiveness or repute

⁹⁶ Check the box when opposition is based on earlier non-registered mark

Opposition is based on earlier non-registered mark and

right to prohibit use of later mark under national law

⁹⁷ Check the box when opposition is based on an earlier sign used in the course of trade

Opposition is based on earlier sign and

right to prohibit use of later mark under national law

⁹⁸ Check the box when opposition is based on mark filed by an agent

Opposition is based on mark filed by an agent and

mark was filed without authorisation of proprietor

⁹⁹ If the space provided is not sufficient, use attachment instead

Explanations of grounds

⁹⁹ Both marks consist of three letters. The first and last are the same. The middle letters M & W look the same as M is an inverted W. The goods are the same or similar or under 8(5) are dissimilar. The Opponents' mark is widely known as it is painted on the sides of all of the lorries that are out every day.

Check that form has been signed on page 1

Document 2**Certified Translation of copy of Benelux Trade Mark Register**

- 1 Registration No: B230952
- 2 Application date and number: 1/1/1992, 230709
- 3 Applicant – Trans MetroCouriers NV, B-12 The Hague
- 4
- 5 Agent – SNR Merkenbureau NV
- 6 Representation of Mark →TMC←
- 7 Services covered Class 39, “parcel delivery services”

Certified by G Van der Weiden as a true translation.

Document 3**Statement of H Pueffer**

My name is Hiram Pueffer and I am the CEO of TMC, Inc. My company has a Dutch subsidiary, TMC NV, the opponent in this case. I can confirm that we have used the company name TMC NV for our Dutch subsidiary since at least 1996 and during that time we have delivered many thousands of parcels there. We also have the trade mark TMC registered in the USA. I am sure that our Dutch customers will be familiar with our name. Herewith is a sample invoice showing the current design of the mark to prove use and reputation in the Netherlands. The Mark appears on our 200 trucks and vans that make upwards of 2000 journeys across the country everyday.

H Pueffer, 5/9/2002

Document 4

TMCouriers →[®]TM

Invoice/Faktur

Consignor: Astro Developments

Date: 5/9/2002

Details: 50 Parcels, 200kg weight, to CycloLab, Gronigen

Amount due: €1500

[End]

- 5 Your client, Smiths Limited, is the proprietor of UK Registration no. 1234567 SMUDGER [word only] in respect of fishing tackle, reels and rods in class 28. Registration was obtained following the provision of consent from Brun GmbH, a Germany company who are the proprietors of earlier UK Registration no. 1133457 for the mark SMUDGER & Device covering sporting equipment in class 28. Investigations at the time showed that Brun were a manufacturer of sporting items sold principally in Germany. As part of the consent negotiations, the parties entered a co-existence agreement limited to and concerning the UK only whereby Smiths would limit their use and registration to fishing tackle, reels and rods. In return, Brun provided consent and agreed not to use the mark in respect of Smiths' goods. Your firm was able to negotiate this settlement on Smiths' behalf as Brun had not used nor expressed any intention to use their mark on these goods.

Your client's business has grown and they are now considering expanding into Europe, although they are not sure how fast their progress will be. They inform you that it may take them several years to build up sufficient relationships with local contacts in each country. Furthermore, they inform you that they have developed a new logo and are concerned that the device element within it may be similar to the device element in Brun GmbH's UK registration.

Your client informs you that the word SMUDGER and its new device element will not be used separately.

Advise your client on the situation with Brun GmbH. Giving reasons for your answer, outline how your client can most effectively secure protection for its mark SMUDGER & Device across the EU and the rest of Europe.

25 marks

- 6 Your client, Natural Health Limited, is an English company whose main business is in the manufacture and sale of health foods.

Natural Health's core activity has traditionally been in natural dietary supplements, but sales of these have slumped following revelations that your client's main supplier of raw ingredients has been growing genetically modified crops. Your client hopes to counter this slump through a launch this spring of its new natural confectionery range, which it hopes will sell in ordinary retail outlets as well as specialist health food shops as a healthy alternative to sugary sweets. With this in mind, your client has developed a new type of mint-flavoured lozenge, which is shaped like a hexagon about the size of a ten-pence piece, and is made out of compressed popcorn of different colours. The round centre of each hexagon is hollowed out and filled with naturally sweetened grains and seeds. These are light and dark green for spearmint flavour lozenges, and light and dark blue for peppermint flavour lozenges.

Your client's principal markets of interest are the United Kingdom, France, Germany and Spain, and launch is just six months away. On your client's behalf, you filed CTM application No. 2938475 for the mark on 1st September 2002 in Class 30 for *inter alia* "confectionery and mints; cereal-based confectionery and mints." The mark is identified at box 58 of the application form as a three-dimensional mark, and accompanied by a black and white photograph of the mark (not provided here) and the following description at box 64 of the form:

"The mark consists of a hexagonal lozenge, approximately 2cm in diameter, whose centre, a circular area of diameter approximately 1cm, has been partially hollowed out, and has a "speckled" appearance resulting from grains and seeds."

You have now received the attached official letter.

Your client readily concedes that different shapes are common in the confectionery trade as a means of attracting attention and appealing to the eye. However, it argues that the range of shapes in common use is limited and that this shape is more complex than others on the market. According to your client, special manufacturing equipment is required to create the mint-flavoured hexagons and in its intensive commercial research it has found no other competitors anywhere using a similar shape, colour combination or texture for mints.

Prepare a detailed response in the form of a letter to OHIM arguing against the objection to this application, including full arguments and references to relevant case law.

25 marks

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Examination Division

**Notice of grounds for refusal of application for a Community trade mark
Issued under Article 7 of the Regulation and Rule 11(1) of the Implementing Regulation**

Alicante, 10/11/2002

Name and address of applicant or representative
Trade Mark Attorney
UNITED KINGDOM

Application No: 002938475
Your reference: TMA/3044
Trade mark: Hexagonal Shape
Applicant: Natural Health Limited

On examination of your application it has been found that the trade mark is not eligible for registration because it does not comply with Article 7(1)(a)(b) and (d) to the extent that:

It is devoid of any distinctive character as it is merely a representation of the goods. A regular consumer would perceive it in this way and would not associate this depiction of the product *prima facie* with a particular undertaking. There is nothing imaginative or fanciful in the depiction of this foodstuff to draw the consumer's attention and to make it stand out from other similar products in the market. Shape and visual appearance cannot perform any sort of trade mark function if they are commonplace, banal and ordinary. A mere representation of the goods is not capable of distinguishing the goods of one trader from those of another.

If you have any observations, they should be submitted within two months of this communication, failing which the application will be rejected.

Andrew McDonald