

**JOINT EXAMINATION BOARD
PAPER T6
ADVANCED COMMUNITY TRADE MARK AND INTERNATIONAL
TRADE MARK LAW & PRACTICE PAPER**

**Thursday 13th November 2003
10. 00 a.m. – 2.00 p.m.**

Please read the following instructions carefully. Time Allowed – FOUR 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 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 of any kind 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 answers 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, place your answer in the WHITE envelope provided.**

The paper consists of 11 pages including this page.

Question 1

Your clients, ABC Limited, are a business incorporated in the UK. Primarily they supply sports clothing, sports equipment and energy drinks.

On 8th June 2003, they filed a CTM application in the following terms:

Mark	Applicant	Specification of goods and services
THE PRINCIPLE OF STYLE	ABC Limited	Clothing, footwear, headgear. [Class 25] Sports equipment and apparatus. [Class 28] Carbonated and non-carbonated drinks. [Class 32]

- (a) OHIM has just issued the enclosed official letter objecting to the application under Article 7(1)(b) and (c) (Absolute grounds for refusal). Write a letter of advice to your clients explaining the objections and expressing your view on their strengths, identifying any arguments you would make and any relevant case law, as well as your view on the likely outcome.

[Note For part (a) of the question assume that your clients are not able to rely on evidence of acquired distinctiveness.]

(15 marks)

- (b) Assume now that your clients ABC Limited have used the mark THE PRINCIPLE OF STYLE in the UK and Ireland since November 1998 with their distinctive house mark ABERAN in the form:

ABERAN
THE PRINCIPLE OF STYLE

They have a registration in the UK for their house mark. Prepare notes to form the basis of advice to your clients on filing evidence of acquired distinctiveness as a way of overcoming the objections raised by OHIM. Give your assessment of the likelihood of success and advise on any problems which may be encountered, referring, where appropriate, to relevant case law.

(10 marks)

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

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, 31/10/2003

Name and address of applicant or representative

Trade Mark Attorney
UNITED KINGDOM

Application No: 003333333
Your reference: TMA/3055
Trade Mark: THE PRINCIPLE OF STYLE
Applicant: ABC Limited
20-26 Smith Street
Reading, Berks RG3 4IT
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 of the word combination THE PRINCIPLE OF STYLE, a combination which designates a characteristic of the goods concerned and is devoid of distinctive character.

Slogans which generally have an advertising function and refer to characteristics of the goods or services or of the manufacture or distribution, must, in order to be able to serve as trade marks, possess an additional element of originality. The mark THE PRINCIPLE OF STYLE possesses no such additional element; it has an advertising function and is purely descriptive in relation to the goods concerned. The persons targeted would thus understand the mark applied for as a reference to the kind and the quality of the goods concerned and not as a mark referring to the origin of the goods.

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

Maria Sanchez

Question 2

Your client is The British Association of European Meat Distributors, a UK based association.

Your client uses a distinctive device incorporating its name in relation to the promotion of its members' interests and activities. Your client's association members are suppliers of meat and meat products and use the mark to indicate to their customers that they are members of the association.

Your client's membership and activities have expanded in recent years and its members are now active throughout the EU (with the exception of Finland and Greece - but there are medium term plans to enter these countries).

Your client is the proprietor of a recent UK Trade Mark Registration No. 2345678 filed on 1st June 2003, with the following details:-

Mark	Specification of services
THE BRITISH ASSOCIATION OF EUROPEAN MEAT DISTRIBUTORS & Device	41 Arranging and conducting meetings and conferences; attending meetings and conferences on behalf of association members; providing information and advice relating to the contents and issues raised at the aforementioned meetings and conferences.
	45 Professional association services; services rendered by an association to its own members; representing association members before committees and pan-European bodies and representing association members before government bodies.

Your client wants to protect its trade mark for its use and its members' use in the territories in which it and its members operate using the Community Trade Mark System.

Write a letter advising your client of the filing options available to it. Advise on which option(s) you would recommend and why, referring to the goods/services to be covered. With regard to protection of your client's members' use of the mark, explain the form the application should take, the goods/services to be covered and any special requirements for filing and during prosecution of the application.

[Do not discuss filing nationally or via the Madrid System]

(25 marks)


Question 3

You act for Aladdin Ltd., an English carpet manufacturer.

Last month, your client launched a new range of carpets under the brand name TIGER in the U.K., Ireland, Germany and Spain. On the labels and in advertising, the word TIGER appears to the right of a Tiger Logo as illustrated below.



This morning, your client received by registered post a letter from lawyers acting for Odo de Bayeux S.A. The letter states that Odo has been using the trade mark LE TIGRE for decorative wall tapestries and door mats in France since 1996. The letter threatens trade mark infringement proceedings in respect of your client's new launch, and identifies the following CTMs:

<p>CTM 87654 1st April 1996</p> <p style="text-align: center;">LE TIGRE</p> <p>Published: 4th March 1997 Registered: 10th August 1997 Class 24: Wall hangings (of textile) Class 27: Carpets, rugs, mats and matting; wall hangings (non-textile) Odo de Bayeux S.A., Rue de Bataille, Caen, France (the words "le tigre" mean "the tiger" in French)</p>	<p>CTM 87655 1st April 1996</p> <p style="text-align: center;"></p> <p>Published: 4th March 1997 Registered: 10th August 1997 Class 24: Wall hangings (of textile) Class 27: Carpets, rugs, mats and matting; wall hangings (non-textile) Odo de Bayeux S.A., Rue de Bataille, Caen, France</p>
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Your client did not seek advice prior to launch. However, in 1988 it had obtained U.K. and German registrations for the word mark TIGER in Class 27 for "*carpets and rugs.*" Searches at that time for the word mark TIGER and the Tiger logo had revealed no relevant prior rights.

Your client tells you that TIGER carpets were sold in the U.K. and Germany from 1988 until 1991, when they were phased out due to poor sales. Remaining stock was sold more successfully in Poland and Hungary, and sales continue there. The Tiger Logo had always been used with your client's TIGER brand and was an original design created specifically for this brand within your client's company.

Your client says it had known about Odo's LE TIGRE wall tapestries and door mats, but considered those activities to be quite different from its own. However, it had never

encountered any use of the Tiger Device by Odo, and believes that logo to have been copied from its own.

Identify and assess the possible case against your client. Identify and assess any action your client could take to challenge Odo's CTMs and the forum in which such actions could be brought. What is your overall advice?

Confine your answer to trade mark issues.

(25 marks)

Question 4

Your California-based client, Cal-Ware Inc., has developed a software system which blocks unsolicited mass commercial e-mails, commonly known as "spam."

It plans to launch the product under the trade mark CENTURION in the U.S.A., Canada, U.K., Germany, France and Spain in about one year. U.S. and Canadian searches were conducted, and no relevant obstacles were found. U.S. and Canadian filings were made, and on 2nd February 2003 you acted on instructions of your client to file a CTM application for CENTURION for "computer software" in Class 9 in the name of Cal-Ware Inc.

Post-filing availability searches revealed the following registered CTM:

CTM 654321 CENTURIO Filed: 7 th July 1996, Int'l Priority: 5 th April 1996 Published: 10 th March 1997, Registered: 20 th September 1997 Class 9: Computers and computer software Caballo Oscuro S.L. , 2300 Calle Principal, Madrid, España

Investigations reveal that CENTURIO had been used for anti-virus software, which worked by blocking emails that carried viruses. The software was sold on a small scale in Spain and Portugal in the mid-1990s. However, production ceased in early 1998 after a series of crippling financial problems struck Caballo, from which it has never entirely recovered. Caballo occasionally provides after-sales advice and service relating to CENTURIO software to customers in Spain who telephone the Caballo product help-line. However, this service has not been advertised since production stopped, and calls are dwindling because the software has become outmoded.

Cal-Ware are committed to launch not only in the countries you were aware of, but also in Finland, Latvia, Lithuania, the Ukraine, Bulgaria and China.

With reference to case law where appropriate, give your views on your client's position and on what action you recommend in light of the information you have. If you are advising legal action, identify any applicable grounds, their merits, forum and procedure.

(25 marks)

Question 5

You have gained a new client, Brooms Limited, whose business is in running a chain of supermarkets. Their previous agents have filed an International Registration designating 15 countries under the Madrid Protocol for the mark BROOMS (stylised). The base UK Registration was filed on 19th July 1999.

As one would expect, the specification covers a large range of goods and services. WIPO have queried a number of terms and have issued an official letter. On receiving the file from the previous agents you find the attached Notice from WIPO which has been sent via the UK Trade Mark Registry. The deadline for responding is 21 November 2003.

Write notes to form the basis of advice to your client as to how you would address each irregularity, setting out the procedure and the consequences if you do not.

(25 marks)

**WORLD INTELLECTUAL
PROPERTY ORGANIZATION**

34, chemin des Colombettes, PO Box 18, CH.1211Geneva (Switzerland)
WIPO postal cheques account no. 12-5000-8 Geneva
Int'l Bank Account Number (IBAN): Credit Suisse Bank, Geneva
Tel (41-22) 338 9111 Facsimile (41 22) 733 5428
E-mail: intreg.mail@wipo.int

Madrid Agreement
and
Madrid Protocol

17 October 2003

NOTICE CONCERNING AN INTERNATIONAL APPLICATION

ATTENTION:

Re: International application based on
UK registration no. 2134567
for the mark BROOMS (stylised)
in the name of Brooms Limited

Date of receipt of the international application
by the office of origin: 20 September 2003
by the International Bureau: 10 October 2003

Our ref: 000134
Office ref:
Applicant ref: A.N. Other TM
Examiner: P. Smith

We acknowledge receipt of the above mentioned international application.

The examination of this application has revealed the irregularities which are listed hereafter:

**IRREGULARITY(IES) CONCERNING THE INDICATION OF GOODS AND SERVICES
(RULE 13)**

1. The International Bureau considers that the following term(s) of the list of goods and/or services is/are too vague for the purposes of classification:

"stock control and monitoring"

The International Bureau suggests therefore the following:

Please add "included in this class".

IRREGULARITY(IES) CONCERNING THE CLASSIFICATION OF GOODS AND SERVICES (Rule 12)

1. The International Bureau considers that the goods and/or services listed in the international application are not grouped in the appropriate classes of the International Classification of Goods and Services. The International Bureau proposes therefore to transfer the following terms:

"provision of food and drink" from class 42 to class 43.

IRREGULARITY(IES) CONCERNING REPRODUCTION:

1. The International Bureau considers the reproduction of the mark to be not sufficiently clear as the outline of the device is not clearly definable on the version of the mark received.

IRREGULARITY(IES) CONCERNING DESIGNATED STATES:

1. Egypt is not a party to the Madrid Protocol.

Question 6

You have been advising a German company, Lift GmbH, about their trade mark portfolio. As a result of various take-overs, mergers and expansion of the firm, their portfolio has become disorganised with registrations for their mark LIFT being held in different names throughout the European Union.

They have already agreed that all of the registrations should be transferred to their wholly-owned UK subsidiary holding company, Lift (Holdings) Limited. Lift GmbH want to file a CTM Application for the plain word mark LIFT in the name of Lift (Holdings) Limited so that they do not have to keep renewing the national registrations.

The details of the registrations in the portfolio are as follows:

Proprietor	Mark	Country	Registration No.
Lift España SL	LIFT	Spain	756894
Lift España SL	LIFT	Greece	32165498
Lift France SA	LIFT	International Registration Covering Italy, Germany, Austria and Egypt	755555
Lift France SA	LIFT	France	71415
Lift GmbH	LIFT (stylised)	CTM	2600006

All of the proprietors are wholly-owned subsidiaries of Lift GmbH.

Advise your client about how to reorganise its portfolio, including specific reference to the procedure for and the advantages and disadvantages of claiming seniority.

(You are not required to go into detail regarding assignment in national countries)

(25 marks)