

THE JOINT EXAMINATION BOARD

PAPER T6 – ADVANCED COMMUNITY TRADE MARK AND INTERNATIONAL
TRADE MARK LAW AND PRACTICE PAPER

Thursday 10th November 2005

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. Time Allowed – **FOUR HOURS***

1. You should attempt **FOUR** questions out of the six presented.
2. 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.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (T6), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not staple or join pages together in any way;
 - e. Do not state your name anywhere in the answers;
 - f. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - g. Reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.
6. This paper consists of 13 pages including this page.

Question 1

You act for Woodward's Limited, a UK company, who produce stationery items such as pens, notepads and calendars. You have recently filed a CTM Application on their behalf with the following particulars:

Mark: PAPERCRAFT

Application No.: 003456789

Application Date: 24/06/05

Specification: **Class 16:**

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

Class 20:

Picture frames; racks and boxes made of plastics material.

Class 28:

Toys, games and playthings; ornaments and decorations for Christmas trees.

You have just received the enclosed official letter from OHIM rejecting the mark under Article 7(1)(b).

Article 7(1)(b) states:

“1. The following shall not be registered:

(b) trade marks which are devoid of any distinctive character;”

1. Write notes to your client regarding the objection raised, include your opinion regarding the merits or otherwise of the objection and suggestions as to how you could respond. Make reference to any relevant case law. For the purposes of this part of the question, assume that the trade mark has **not** been used by your client.

15 marks

2. Your client informs you that they have made use of the mark in the UK, Ireland, France and Hungary for a number of years. Advise how this could assist their case.

10 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, 03/11/2005

Name and address of applicant or representative
Trade Mark Attorneys LLP
UNITED KINGDOM

Application No: 003456789
Your reference: TMA/0008
Trade Mark: PAPERCRAFT
Applicant: Woodward's Limited
Unit 12
South Industrial Estate
Colchester
Essex CO1 2RY
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) to the extent that:

The mark consists solely of the common word PAPERCRAFT. The trade mark PAPERCRAFT is not capable of distinguishing the goods of the Applicant from those of other undertakings. It consists of the ordinary English words PAPER and CRAFT, which are descriptive of, e.g. paper goods for craft purposes. As such, the application must be considered devoid of distinctive character.

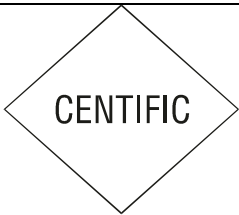
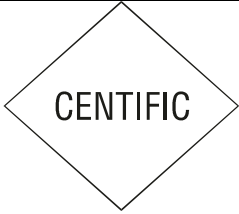
If you have any observations they should be submitted within two months of the date of this letter, failing which the application will be rejected.

Ana Maria SANTA-CRUZ

Question 2

You represent ABC Limited, a UK company which manufactures and sells a range of cosmetics under the trade mark CENTIFIC. They have sold their products in the UK on a substantial scale since February 1993 and in Italy, Belgium, Netherlands, Luxembourg and Finland since April 1995. They have plans to expand into other countries of the EU. All use is now in the plain word form of the mark. Use of the figurative form of the mark ceased in 2000.

Your client is the proprietor of a UK national trade mark registration and two Community trade mark registrations. Relevant details of these marks are as follows:

Country	Number	Mark	Class	Filing date	Registration date
UK	1555555		3	1/5/1993	13/4/1994
CTM	2222		3	1/4/1996	29/6/1997
CTM	1888888	CENTIFIC	3	29/2/2004	3/5/2005

All of the above registrations cover the following goods:

Class 3 - Cosmetics; perfumery; non-medicated toilet preparations

Your client's watch service has recently informed them of a Community trade mark application no. 2555555 for CENTIFIQUE in the name of the company Centifique S.L. of France. This application was filed on 3rd August 2004 and published for opposition purposes on 1st September 2005 and covers the following services in classes 43 and 44:

Class 43 – Arranging and providing facilities for beauty, perfumery, make-up and skin treatment demonstrations and exhibitions.

Class 44 – Provision of beauty, perfumery, make-up and skin treatment services all provided at salons, counters and advisory centres; provision of advisory services relating to the aforesaid; beautician services

You have already investigated Centifique S.L. and this revealed that the company has been active in relation to all the above class 43 and class 44 services in France since 1985. No other use of the mark CENTIFIQUE was revealed by the investigation. Centifique have a single national registration for CENTIFIQUE in France no. 12345 filed 22nd March 1988 covering all the above services.

Your client is not concerned about Centifique's activities in France, but is keen to prevent the company's activities expanding into other countries of the EU.

Make notes for a meeting with your client on the bases on which Centifique S.L.'s application could be opposed, your assessment of the likely success of any opposition, the strength of each party's position and any other relevant issues.

[Do not address issues concerning well-known marks under the Paris Convention]

25 marks

Question 3

Your client, Alsop (PTY) Limited, a South African company, informed you some months ago that they had come up with a new trade mark for which a South African national trade mark application was filed on 3rd June 2005. As a result of your discussions with your client a UK national application, also in the name of the South African company, was filed for the mark on 9th June 2005.

Your client now wishes to extend their protection for the trade mark to the following countries:

France, Germany, Ireland, Portugal, Cyprus, Malta, Japan, USA

You have already conducted full availability searches in the above territories and found a German registration for a similar mark covering similar goods, registered on 14th December 2002.

Your client has a wholly owned UK limited company based in London and a representative from that company is coming to your office tomorrow to discuss this matter with you.

Make notes for a meeting setting out the different filing strategies available to the client, giving advice and recommendations on each one, and discuss any potential problems which may arise. **(Assume the trade mark is distinctive and that there are no inherent registrability problems)**

For the purpose of answering this question, note that South Africa and Malta are not members of either the Agreement or the Protocol. All the other countries specifically mentioned are members of the Madrid Protocol. France, Germany, Portugal and Cyprus are also members of the Madrid Agreement.

25 marks

Question 4

Your client S. HIFTY (Scooters) Europe Plc has filed a Community Trade Mark application for the word mark SHIFTY PREMIER in respect of “motor cycles” in Class 12. The Application was filed on 22 March 2004 and allotted No. 004025861. The application was published for opposition purposes on 1 November 2005.

Your client also has an earlier UK national trade mark registration for SHIFTY PREMIER that also covers “motor cycles” and was filed on 13 December 1999.

They have received (today) a letter from the lawyers representing Premier Motorwerken GmbH (a German company).

The letter alleges infringement of their client’s Community Trade Mark Registration No. 002002556 PREMIER and device. They also threaten opposition to your client’s recently published Community Trade Mark Application.

A copy of the German company’s Community Trade Mark registration is attached.

Your client has been using the sign SHIFTY PREMIER in relation to “motor cycles” for a period of 10 years throughout the United Kingdom.

Your client is planning to start selling their motor cycles in France and Italy next year.

Write notes for a discussion of the following issues with your client.

1. Does Premier Motorwerken GmbH have a valid basis to oppose your client’s Community Trade Mark Application?
2. What arguments can your client use to defend the claim of infringement and/or the threatened opposition?
3. How does this affect the plans to sell in France and Italy?
4. Any practical steps that can be taken in the meantime.

25 marks

CTM-ONLINE - Detailed trade mark information



List of results

Trade mark name : PREMIER
Trade mark No : 002002556
Trade mark basis: CTM
Number of results: 1 of 1

Trade mark

Filing date: 21/7/2002
Nice Classification: 12
Trade mark: Individual
Type of mark: Figurative
Acquired distinctiveness: No
Date of last status: 19/08/2005
Status of trade mark: Registration published
Filing language: German
Second language: English

Graphic representation



List of goods and services

Nice Classification: 12
List of goods and services: Cars

Description

Description of the mark: Description is not available in this language

Owner

Name: Premier Motorwerken GmbH
ID no. 43025
Natural or legal person: Legal entity
Address: Postfach 134,
Post code: 88340
Town: München
Country: GERMANY
Correspondence address: Postfach 134, München 88340, Germany

Representative

Name: HOFFMANN · RECHTANSWALTE
ID No: 44444
Address: Arabiastrasse 6
Post code: 81925
Town: München
Country: GERMANY
Correspondence address: HOFFMANN · RECHTANSWALTE
Postfach 99 99 99-81904, München
ALEMANIA

Telephone: 00 49-12345899
Fax: 00 49-123545484
E-mail: -

Seniority

No entry for application number: 002002556

Exhibition priority

No entry for application number: 002002556

Priority

No entry for application number: 002002556.

Publication

Bulletin No. 043/2004
Date of publication 25/10/2004
Part A

Opposition

No entry for application number: 002002556.

Cancellation

No entry for application number: 002002556.

Appeals

No entry for application number: 002002556.

Recordals

No entry for application number: 002002556.

Question 5

NEWCO (Europe) Limited, a British company approaches you for advice.

Your client tells you that they wish to launch a range of footwear and headgear, sunglasses and perfume under the trade mark WANNABE throughout the European Union, United States of America, Russian Federation and Japan.

They have discovered an International Trade Mark Registration No.987190 for WANNABE covering “clothing, footwear and headgear” in Class 25 filed on 25 March 2004. The International registration is based on an Egyptian national registration dated 13 February 1975 and designates France, Germany, Italy, Portugal and the Russian Federation.

Your searches have confirmed that the Egyptian company have made no use of their trade mark in Egypt since 1996.

Advise your client as to what steps could be taken (and why) to ensure that they are properly protected in the European Union, United States of America, Russian Federation and Japan.

For the purpose of answering this question, note that Egypt is a member of the Madrid Agreement only; the EU (as a body), the US and Japan are members of the Madrid Protocol only. Canada is not a member of either the Agreement or the Protocol. All the other countries specifically mentioned are members of both the Agreement and the Protocol.

25 marks

Question 6

Your client Java Budapesti, a former state owned Hungarian company, is the leading Hungarian supplier of confectionery, chocolate and chocolate related products, and prior to the expansion of the European Union had a near monopoly in Hungary for nearly 30 years. It now wishes to take advantage of its country's membership of the EU, and especially the freer movement of goods, to export its products to other EU states.

Your client has an Hungarian national registration of JAVA that dates back to 1981 and covers "chocolates and chocolate confectionery."

Your client filed a CTM Application on 1 May 2004, details of which are as follows:

Applicant: Java Budapesti Csokoladegyar Kft

Mark: JAVA

Goods: Class 30: Chocolate; foods containing chocolate; cakes; confectionery; rolls; cookies and biscuits; muffins; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ices.

Application

No.: 003862711

You have just received the OHIM searches and have noted that the searches include an earlier identical trade mark CTM registration and an earlier identical CTM application. Both of the earlier CTM marks are in the name of Peter Botoslav (an Hungarian national) and cover the full international Class heading for Class 30.

The earlier CTM Registration was filed 1 April 1996 under No. 003328937 and registered on 15 November 1998.

The earlier CTM Application was filed on 15 December 2003 under No. 003605085 and has recently been published for opposition purposes in the Official Bulletin on 30 September 2005.

You report these earlier CTM marks to your client who is extremely concerned to learn of these earlier marks. Your client is particularly concerned that the earlier marks will prevent its continued use of their well-known Hungarian mark and that they will block their plans to expand into other EU countries. Contrary to your advice your client did not wish to conduct any EU wide searches prior to filing its CTM application.

Your initial enquiries have revealed that Peter Botoslav has never used the JAVA trade mark.

Note that the date of accession of Hungary to the European Union was 1 May 2004.

1. In brief, explain to the client the effects on a Community Trade Mark of the extension of the European Union to the new accession countries. Does it affect your client's CTM application?

3 marks

2. Advise your client what options he has and what, if any, action he can take in relation to the following
 - (a) the earlier CTM Application
 - (b) the earlier CTM Registration

22 marks

(A detailed account of opposition or other procedures before OHIM is not required).