

THE JOINT EXAMINATION BOARD

PAPER T5 – BASIC OVERSEAS TRADE MARK LAW AND PRACTICE

Wednesday, 7th November 2007

3.00 p.m. – 5.00 p.m.

*Please read the following instructions carefully. **Time Allowed – 2 HOURS***

1. You should attempt **eight** questions from Part A and **five** questions from Part B.
2. The marks awarded to each question are shown in brackets at the foot of the question.
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 (T5), 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 state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. 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.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of **4** pages including this page.

Part A (answer eight questions)

1. Write short notes on the searches on relative grounds carried out as part of the official examination of a Community Trade Mark application.
(5 marks)
2. List five differences between the Madrid Agreement and Madrid Protocol.
(5 marks)
3. Outline the provisions for cancellation on the grounds of non-use of Trade Marks in Canada. Include any non-use periods. Name one other ground on which a registered trade mark could be cancelled in Canada.
(5 marks)
4. What are the bases for filing Trade Mark applications in the USA?
(5 marks)
5. In relation to the free movement of goods from one EU country to another EU country, write short notes on the actions a parallel importer must take to overcome a threat of trade mark infringement if the goods are to be repackaged before sale in the latter country.
(5 marks)
6. Outline the national trade mark application procedure in Spain through to registration.
(5 marks)
7. Your client has filed a trade mark application in Class 12 (motor vehicles) and class 37 (motor vehicle repair services) in Germany. On examination an objection has been raised in relation to only some of the Class 37 services. What actions can your client take to overcome the objection?
(5 marks)
8. Name 5 countries that are members of both the Madrid Agreement and the Madrid Protocol.
(5 marks)
9. Name 4 countries where it is possible to obtain a defensive registration.
(5 marks)

Part B (answer five questions)

10. Compare and contrast Transformation and Conversion under the Madrid Protocol and Community Trade Mark system respectively.

(12 marks)

11. Outline the requirements for showing use of a trade mark in Mexico and the USA (a) on filing an application and (b) in order to maintain a registration in force. Include non-use periods in your answer.

(12 marks)

12. Your client files three trade mark applications for the same mark covering the same goods in Japan, New Zealand and Taiwan. The same two objections are raised in each of those countries on the basis of (i) an earlier identical mark covering identical goods and (ii) a similar mark covering similar goods. What actions can your client take in each country to try to overcome the objections?

(12 marks)

13. Your client has a real and effective commercial establishment in the UK and its corporate headquarters in France. It owns the following applications and registrations for its trade mark:

- UK application -- class 1 -- "chemical preparations" dated January 2007
- UK application -- class 3 -- "cleaning preparations" dated July 2007
- UK registration -- class 5 -- "pharmaceutical preparations" dated December 1999

- French application -- class 1 -- "chemical preparations" dated September 2007
- French application -- class 3 "cleaning preparations" dated July 2007
- French registration -- class 5 -- "pharmaceutical preparations dated December 1999

All of these applications and registrations have been filed in the name of your client. Your client now wishes to obtain coverage for its trade mark in classes 1, 3 and 5 for the same products in Australia, Germany, New Zealand, Singapore, Spain and Taiwan.

What are your client's options for filing applications? (You may assume that searches have disclosed no potential obstacles in these countries. You may also assume that the Trade Mark is inherently registrable in these countries.)

(12 marks)

14. Compare the opposition procedures of Benelux, Brazil and Denmark, including the entities that have the right to oppose, any documents required and any provisions for appeal.

(12 marks)

Part B (continued)

15. Your client, a Singapore company, has a registered trade mark for “chocolate” in Singapore. They are expanding the product range to cover chewing gum and, moreover, plan to expand sales of both “chocolate” and “chewing gum” to the UK, USA, Hong Kong, South Africa and Japan.

Write notes for your client discussing the options for obtaining trade mark registration in those countries and the advantages / disadvantages of each one.
(12 marks)

16. Write brief notes on the opposition procedure before OHIM including the possible grounds and timescales for each stage.
(12 marks)