

## THE JOINT EXAMINATION BOARD

## PAPER T6

ADVANCED COMMUNITY TRADE MARK AND INTERNATIONAL TRADE MARK  
LAW AND PRACTICE

Thursday 8 November 2007

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. Time Allowed – 4 HOURS*

1. You should attempt **four questions** in total.
2. The marks awarded to each question are shown at the foot of the question. Only the first FOUR ANSWERS presented will be marked.
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 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.

**QUESTION 1**

Your client, Noname Limited, a UK company, filed a UK application for FAFDOM on 10th May 2007 covering “leather articles” in class 18 and “articles of clothing; headgear” in class 25. You were not instructed to conduct clearance searches prior to filing. No official objections were raised during examination and the application was advertised for opposition purposes on 19th September 2007.

Your client wishes to extend its protection using their UK application as a base application claiming priority to various jurisdictions including the EU via the International Registration system.

The results of a worldwide identical search reveal an Italian registration dated 3<sup>rd</sup> July 2006 and an international registration designating Greece, Portugal, Spain and United Kingdom registered on 2nd September 2006 owned by an Italian company, Blondie Leathers S.p.A covering leather goods in class 18.

You have a meeting with the marketing manager of Noname Limited, Mr Leone. Make notes on the following –

- 1) Outline the procedures (including timescales) relating to designating the Community Trade Mark within the IR to be filed. **(13)**
- 2) the consequences and the options open to Noname of a successful opposition by Blondie in respect of Class 18 goods
  - a) in the UK **(6)**
  - b) at OHIM **(6)**

**[for the purposes of this question, assume that the prior regns are in use and ignore any issues relating to infringement]**

**QUESTION 2**

The Company Secretary of your client, Sheena Shoes Ltd (a company incorporated under the laws of England & Wales) has just sent you an email. She thinks she may have an infringement issue – a company called TGF Shoes Inc. (“TGF”) is using TOASTY TOADS, which she feels is too close to her company’s registered trade mark TOADS.

Your client’s CTM details are as follows:

Number	Mark	Class	Registration date	Specification
1234567	TOADS	25	23 February 2002	Footwear, shoes, boots, sandals, slippers, slipper-socks, socks.

You are aware that your client has not used the mark which is one of their portfolio marks intended for slippers. Pan-European launch is planned for Autumn/Winter 2008. Brief investigations by your client have revealed that TGF are currently selling in UK, Holland, Sweden and Denmark.

The Company Secretary wants you to fully brief her before the end of the day as to what actions are open to her.

**Put together a set of notes for her meeting – advising**

1. Whether there is a strong case for infringement **(5)**
2. As to options for jurisdiction **(6)**
3. What forms of relief would be available **(2)**
4. As to any other problems they might encounter **(8)**
5. Any other recommendations **(4)**

**QUESTION 3**

You have recently started exchanging work with a firm of New Zealand attorneys and they have emailed you for your opinion on how they should advise one of their clients. Their client has a New Zealand trade mark application filed on 4<sup>th</sup> June 2007 which is so far proceeding without problem. The client is based in Wellington, New Zealand but has offices in Australia and the UK. The Australian office is a serviced office which is manned on a part-time basis. The UK office is a wholly owned subsidiary.

The client wishes to extend its protection to cover the EU as quickly as possible but is concerned about a company that they have become aware of. The company has been trading in Spain and Malta under a similar mark for slightly different goods for about six months but, as far as the client is aware, do not have any applications or registrations.

Reply to the email from the New Zealand attorneys advising them of:

- (i) their client's various filing possibilities and the advantages or disadvantages associated with each (22)
- (ii) which filing strategy you would recommend and why (3)

**[New Zealand is not a Member Country of the Madrid Protocol]**

**QUESTION 4**

You act for Roses Ltd who is a UK based manufacturer of bedroom furniture. Your client supplies bedroom furniture to customers in the UK, Ireland, France and Germany. Your client has some new concepts and ideas for taking the business forward and wants your advice on how it might protect them.

1. “*Life is a bed of Roses*” is a slogan that your client has been using for about 6 years in the UK and Ireland in relation to beds and mattresses, but it is unregistered. Your client now plans to use this mark in France and Germany.
2. Your client has developed a method of impregnating mattresses with the smell of roses. Your client believes this is the next big thing in mattresses and wants to protect the smell of roses as applied to mattresses as an olfactory trade mark. Your client has supplied a picture of a rose as an example of the mark.
3. Your client wants to use the mark “Colchón” (which is Spanish for mattress) for its range of mattresses.

Make notes for a meeting at which you will advise your client on:

1. Whether he may be able to register the above marks as Community Trade Marks referring to case law where appropriate. (8)
2. In your notes, ensure that you point out any objections that may be raised against the application by the OHIM; and (9)
3. What options may be available (in outline) in progressing the applications. (8)

**QUESTION 5**

Your client, SJM Stores Ltd (SJM), imports and sells electrical goods, including “high end” Hi-Fi equipment.

SJM is proprietor of CTM No. 0012345 for MOONSHINE registered in respect of loudspeakers and compact discs in class 9. The mark was filed on 1 December 1998. It was registered on 1 June 2000.

Between 1 December 1998 and 1 June 2001 SJM sold 750 pairs of loudspeakers under the mark MOONSHINE in the UK and Ireland.

In July 2001 SJM's overseas supplier went into liquidation. SJM was unable to find an alternative supplier and so shelved the loudspeaker part of its business on 1 August 2001, with no sales taking place after that date. In July this year SJM found an alternative supplier and placed an order for 100 pairs of high quality loudspeakers bearing the mark MOON-SHYNE SPEAKERS. SJM sent out new product leaflets to its existing customer base and advertised the speakers for sale on its UK web site, but by October had only sold 2 pairs.

In 2006 your client was approached by Bad Boy Ltd to purchase your client's CTM registration for MOONSHINE. Your client declined and is now concerned by a letter received 2 weeks ago from Bad Boy Ltd's attorneys threatening to revoke the mark for non-use and requesting that the registration be assigned to Bad Boy Ltd by 1 December 2007. Following receipt of the letter threatening revocation, SJM sold 10 pairs of “MOON-SHYNE SPEAKERS” loudspeakers to a “contact” in Ireland.

Make detailed notes advising your client on:

- (1) its position in relation to Bad Boy Ltd's threatened revocation action (referring to case law where appropriate) and the strength of Bad Boy Ltd's case;  
(19)
- (2) the type of evidence it will need to produce in response to an application for revocation filed by Bad Boy, Ltd.  
(6)

**QUESTION 6**

Your client makes toiletries and launched a bar of soap in the UK in January 2007 which has proven to be very successful. More recently your client has launched the product in Belgium, Italy, France, Norway, Sweden and Germany.

Your client believes the shape and surface texture of the bar of soap is a factor in the product's success and wants to protect these features. The bar is hexagonal in shape with indentations on the top and bottom and dimples covering each side which together aid grip and give the product a very unique appearance. The distinctive brand name OASIS is embossed on the top of the bar. The client has adequate trade mark registrations for this name. The packaging is a simple box with an image of the soap bar, with brand name, on the front.

Your client is worried that its competitors will imitate the successful shape and wants you to help protect it.

Your client decides to file a CTM application for the shape of the bar without the brand name for soaps.

- a. Explain what objections on absolute grounds you anticipate will be raised by OHIM and refer to relevant case law. **(18)**
- b. explain what arguments and evidence might assist in overcoming these objections and refer to relevant case law which might be helpful. **(7)**