

THE JOINT EXAMINATION BOARD

PAPER T5 – BASIC OVERSEAS TRADE MARK LAW AND PRACTICE

Wednesday, 12th November 2008

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 3 pages including this page.

Part A (answer eight questions)

1. In March 2008, what changes were made to the official searches conducted in respect of a Community Trade Mark or an International Registration designating the European Union? What procedures were put in place in respect of such searches? (5 marks)
2. Explain the differences in choosing the applicant for a Madrid Agreement and a Madrid Protocol international Registration. (5 marks)
3. What is a Paris Convention country? What are the benefits of being a party to this Convention? (5 marks)
4. List five European Union countries, which are also members of the Madrid Agreement, the Madrid Protocol and the Paris Convention. (5 marks)
5. Name five countries that do not allow Certification and Collective marks. (5 marks)
6. What is meant by the term "Safeguard Clause" in relation to the Madrid Agreement? (5 marks)
7. What are the differences between the national application procedures of Switzerland and Italy? (5 marks)
8. Your client wants to apply in Class 25 using the class heading in Canada, USA and Thailand. In which countries would an objection be raised by Examiner? What objection would it be and why? How would you overcome it? (5 marks)
9. At what stage is it possible to file an opposition in :
 - (a) Canada
 - (b) Benelux
 - (c) Spain
 - (d) France
 - (e) the European Union designation of an International registration? (5 marks)

Part B (answer five questions)

10. In the USA, what is meant by the following terms in relation to trade marks?
- (a) State Registrations
 - (b) Supplemental Register
 - (c) Dilution
 - (d) Federal Registrations
 - (e) Tarnishment
- (12 marks)
11. What is meant by term "seniority"? What are the procedural requirements for claiming it? (12 marks)
12. Your client has been approached by a third party who wants to take a licence to use your client's registered trade mark in Australia, Benelux, Brazil, China, Denmark, Hong Kong, Mexico and Spain. What advice would you give your client to ensure its rights are protected in those countries and why? (12 marks)
13. Outline the procedure for filing a Madrid Protocol application by a UK company designating the EU, USA and CH for a colour mark based on a UK application. Include any deadlines and state whether any fees are payable. (12 marks)
14. Your client filed a UK application for TRAFIX for "clothing" on 15 June 2008. He now tells you he wants to file the same mark in China, Hong Kong and Ireland. Provide notes on the different options for protecting his mark in those countries, including the advantages or disadvantages of the options. (12 marks)
15. What are the domicile rules for enforcement of a CTM? (12 marks)