

THE JOINT EXAMINATION BOARD

PAPER T6

ADVANCED COMMUNITY TRADE MARK AND  
INTERNATIONAL TRADE MARK LAW AND PRACTICE

Thursday 13 November 2008

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.

**This paper consists of 12 sheets including this sheet.**

### Question 1

Your client Lowhad Agricultural College, owns a UK trade Mark Registration for the mark LAC in logo format covering a wide range of classes which protects their educational activities as well as their onsite businesses which comprise the dairy, other local produce shop, the garden centre and the tea rooms.

This term your client has launched an international course which involves exchanges with students from abroad. You have filed an International Trade Mark application on your client's behalf for LAC in logo format covering International Classes 29, 30, 31, 32, 35, 41 and 43 designating Finland, the USA and Turkey.

WIPO have issued the enclosed Notice, which has been sent to your client via the United Kingdom Intellectual Property Office. The deadline for responding is 21 November 2008.

Draft advice to your client explaining the following:

1. The objections raised.
2. The procedure for responding.
3. The implications if you do not respond.

## INTERNATIONAL (NICE) 9<sup>th</sup> EDITION CLASS HEADINGS

### Class 29

Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

### Class 30

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; ice.

### Class 31

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

### Class 32

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

### Class 35

Advertising; business management; business administration; office functions.

### Class 41

Education; providing of training; entertainment; sporting and cultural activities.

### Class 43

Services for providing food and drink; temporary accommodation.

**WORLD INTELLECTUAL  
PROPERTY ORGANISATION**

34 chemin des Colombettes, PO Box 18, CH1211 Geneva (Switzerland)  
Tel (41-22) 338 9111 Facsimile (41 22) 733 5428  
Email: [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int)

Madrid Agreement  
And  
Madrid Protocol

17 October 2008-07-20

**NOTICE CONCERNING AN INTERNATIONAL APPLICATION**

ATTENTION:

Re: International application based on  
UK Registration No. 2456678  
For the mark LAC logo  
In the name of Lowhad Agricultural College

Date of receipt of the International application  
By the Office of Origin: 16 September 2008  
By the International Bureau: 14 October 2008

Our ref: 000141  
Office ref:  
Applicant ref: LAC/TMR  
Examiner: C. Nicholas

\*\*\*\*\*

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):

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:

"foodstuffs"

The International Bureau suggests therefore the following:

Please add "include in this class"

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

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

"provision of food and drink; boarding for animals" from Class 42 to Class 43.

IRREGULARITY (IES) CONCERNING REPRODUCTION:

The International Bureau considers the reproduction of the mark to be no sufficiently clear as to the device is not clearly definable on the version of the mark received.

## Question 2

Your contact in an Australian firm of attorneys has asked for your brief comments on the following scenario:

“On behalf of our client, Wheels International Cycles Pty Ltd, we filed an application for International Registration designating the European Union. An extract from the Madrid Protocol database for this International application is **attached\***. Our client has an existing Italian registration for the same trade mark, No. RM06C000143. However, this trade mark registration is presently in the name of Fausto Chippolini & Brian Hainault. Please note, our client Brian Hainault is a director of Wheels International Cycles Pty Ltd. A printout for this trade mark is also **attached\***.

I query:

1. The benefit of claiming seniority?
2. Can we file a claim for seniority even though the owner names on the International Registration and Italian registration differ?
3. Can we file an application to claim seniority even though the International application has already been lodged?
4. The class 41 services covered by the Italian registration are broader than the class 41 services covered under the International Registration. What implication will this have on any subsequent claim to seniority?
5. The effect of a valid seniority claim?
6. The effect of allowing the Italian Registration to lapse through non-renewal?”

# STRIDENT

**Document Number**

**Trademark**

STRIDENT

**Appl No. Reg No/Status/Dates**

App no: RM06C000143'

Status: Registered

**TM Type / Description**

Category: Unknown

**Classes**

Int: 41

**Goods and Services**

**Computerised translation**

**Original text**

Int 41: TUTA LA CLASSE, EDUCAZIONE, FORMAZIONE, DIVERTIMENTO, ATTIVITA SPORTIVE E CULTURALI.

**Owner**

CHIPPOLINI FAUSTO

RM

Italy

**Owner**

HAINAULT BRIAN

RM

Italy

**Agent**

STUDIO ITALIA MARCA

VIA VELODROME 86

00121 ROMA

Italy

**Targa**

Roma

**Filing Date**

Jan 24, 2006

**Renewal Date**

Jan 24, 2016

**Source Data**

Apr 04,2007

**Copyright**

(c) Datatrust and IQS Avantiq

close window

13.11.2007 -Date of receipt of the international application by the Office of Origin

20.11.2007 -Date of receipt by the International Bureau

Status: Being Examined

(732) Wheel.s International Cycle Pty Ltd  
RMB 8036 Hyslops Road MAIN RIDGE VIC 3928 (AU).

(740) Australian Attorneys  
MELBOURNE VIC 3000 (AU).

(540) (832) CH, EM.  
STRIDENT

(511) 16 Printed matter and publications; instructional and teaching material; member cards and application forms.

25 Clothing; clothing accessories; headgear; footwear.

41 Exercise training including the provision of group treadmill classes; physical fitness.

(821) AU, 01.02.2006, 1096788.

(822) AU, 01.02.2006, 1096788.



### Question 3

Your client, Illumini Inc, a US company uses the mark ILLUMINI CLASSICS in relation to an online music download site for classical music lovers. The website was started 8 years ago and has been very successful throughout North America and parts of Europe.

Your client owns registrations for ILLUMINI and ILLUMINI CLASSICS in the US covering downloadable music in class 9. The registration dates are both 1 June 2000.

Your client filed a CTM application on 1 June 2007 for ILLUMINI CLASSICS in class 9 for downloadable music.

Your client has recently received notification of an opposition filed against the CTM application. The opponent is Illumini Arts GmbH, a German company, and the opposition is based on its registration in Germany for ILLUMINI covering downloadable music in class 9. The trade mark application was filed in May 2007. The grounds for opposition are based on Art 8(1)a, Art 8(1)b and 8(4) with reference to use in Germany since October 2006.

Your client tells you that the founder of Illumini Arts was an employee of Illumini Inc until 2006 when he left and moved to Germany. Investigations reveal that Illumini Arts own a CTM application for ILLUMINI filed in November 2007, claiming the May priority date of the corresponding German registration. The CTM application was published on 1 October 2008. The German website has an option to view in English but all prices are in Euro.

You have a meeting scheduled with your client. Prepare notes on:

1. an explanation of the basis and the merits of the opposition against your client's application (refer to appropriate case law). **(11.5 marks)**
2. the options open to your client to challenge the registration in Germany **(5 marks)**
3. the options open to your client to challenge the CTM application of Illumini Arts. **(6.5 marks)**
4. the options, if any, open to your client to challenge the other side's use of ILLUMINI **(2 marks)**

#### Question 4

MightyFine Luxury Goods Ltd, a UK company, owns a China (PRC) Registration (registration date 1 January 2000) for the word mark MIGHTYFINE in class 14 for “watches and jewellery”. They also own an International Registration based on the China (PRC) registration which designates the EU and Switzerland. The IR was filed on 5 October 2007 and was published in the CTM Bulletin on 1 March 2008.

Your client, Acme Ltd, would like to use the term MIGHTY FINE to describe its new range of expensive watches that are about to be launched in the Benelux, Ireland and Switzerland.

Your client is concerned that MightyFine Luxury Goods Ltd might challenge your client’s use in these countries and wants to meet with you tomorrow to discuss the issues.

Write notes in preparation for a meeting with the client on the:

1. Options for attacking MightyFine’s various applications and registrations **(17 marks)**
2. Possible consequences of successfully attacking MightyFine’s rights including any options which MightyFine might then have in each of the countries of interest to your client. **(3 marks)**
3. Recommended next steps for your client **(5 marks)**

**Question 5**

You have filed a CTM application for your client, Drakes Sportswear Ltd for the mark FLEX'N'MOVE covering "Articles of clothing; footwear and headgear; swimwear, swimsuits, lingerie; hosiery" in class 25.

You have received the following examination report from OHIM dated 14<sup>th</sup> October 2008. "On examination of your application it has been found that the trade mark is not eligible for registration because it does not comply with Articles 7(1)(b) and (c) to the extent that: The mark is not capable of distinguishing the goods and services of the applicant from those of other undertakings. The mark consists solely of two common words to describe the nature and characteristics of the goods claimed. Consequently, the combination of the words is descriptive and not distinctive for goods in class 25. Any Observations should be submitted within 2 months of the date of this letter, failing which the application will be rejected ."

In preparation for a meeting with the client:

**Scenario 1: Assume no use has been made of the mark so far.**

1. Make notes to advise on the basis and validity of the objections and your suggestions on how you would respond. Make reference to any case law which you deem relevant and any further materials you think are necessary to support the case. **(17 marks)**

**Scenario 2: Your client has used their mark in the UK and Ireland for a highly profitable range of swimwear and women's sports underwear since 1999. They first started sales to Germany, Malta, Spain and Austria in 2003 and the products are sold through mail order, shops and direct from their website [www.flexnmove.com](http://www.flexnmove.com) .**

2. Advise how these facts could assist their case. **(8 marks)**

**Question 6**

Your clients, Imperial (UK) Limited, sell a range of localised pain relief/antiseptic creams and gels for the treatment of various skin conditions for humans under the mark STOLAIN. The products have been sold to the public (over the counter) in the UK since 1985 and from 1989 in France, Germany and Italy, enjoying significant commercial success.

Your clients are the owners of the following registrations for the mark STOLAIN in class 5 – all of them cover “pharmaceutical and veterinary preparations; antiseptic and pain relief preparations in the form of creams , gels and in liquid form for use in the treatment of the skin; medicated preparations; dietetic substances for medical use; disinfectants; materials for dressing wounds.”

Country	Registration no.	Registration date
UK	1473829	1 <sup>st</sup> October 1984
France	358974	3 <sup>rd</sup> September 1987
Germany	6097568	15 <sup>th</sup> April 1987
Italy	7968522	5 <sup>th</sup> May 1988

Your clients have only recently filed a CTM application under no. 9676966 on 15<sup>th</sup> October 2008 for their mark covering the same list of goods as their other registrations above.

You have received a watch notice for a CTM application no. 6097865 for STOPAIN with an application date of 4<sup>th</sup> April 2007 covering “pharmaceutical, veterinary and medicinal preparations; veterinary preparations for the relief of pain in tablet, cream, gel and liquid form” in the name of Trident Veterinary Pharma S.A published on 15<sup>th</sup> September 2008 (official languages – French and German). Your initial internet investigations reveal that Trident sell a range of pain killers in tablet and liquid form (for injections) for animals.

You have a meeting planned with the Company Secretary of Imperial (UK) Ltd later today. Make notes for discussion on the following –

- Any procedural issues and further information/documents required for lodging an opposition to the STOPAIN application at OHIM (3)
- The grounds for opposition and the likelihood of success in opposition proceedings (12)
- Any further issues the client will need to consider when filing the opposition and any further information you would need to deal with these issues (7)
- Your recommended strategy (in brief) (3)

**nb. Do not consider infringement issues.**