

THE JOINT EXAMINATION BOARD

PAPER T5 – BASIC OVERSEAS TRADE MARK LAW AND PRACTICE

Wednesday, 11th November 2009

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 end of the question. If more than the required number of questions are answered in either Part, only the first eight answers presented in Part A and the first five presented in Part B 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 (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. What is the effect of filing an application in the US claiming all goods in a class when you intend to use the mark only on some of those goods? (5 marks)
2. Outline the practice on language and translation requirements before OHIM in the context of opposition proceedings. (5 marks)
3. Write brief notes on "central attack" including an explanation of its consequences. (5 marks)
4. Your client has filed an application for registration of its trade mark in the UK on 1st July 2009. It now wants to protect the trade mark in France and Germany. List the applications you could file to protect the trade mark in France and Germany and any recommendations you would make. (5 marks)
5. Is it possible to file oppositions in South Africa, Mexico, Benelux, Hong Kong & Ireland and if so what is the opposition term following publication? (5 marks)
6. What is meant by "restitutio in integrum" under Community Trade Mark Law, what is its purpose and what are the time limits for applying? (5 marks)
7. What does Article 3 (equal treatment) of the Paris Convention say? (5 marks)
8. Can a letter of consent be used to overcome an objection based on a prior registration in Australia, Japan and Thailand? Would the objection be automatically withdrawn on the provision of a letter of consent? (5 marks)
9. In each of the following five countries, will relative grounds on the basis of prior rights be raised as objections by the Trade Marks Office to national trade mark applications?
 - (a) China
 - (b) Denmark
 - (c) Italy
 - (d) New Zealand
 - (e) Singapore(5 marks)

Part B (answer five questions)

10. Write out in note form the bases of a Canadian opposition and provide a brief outline of the opposition procedure including any deadlines, upto the initial decision in the opposition. No discussion of any appeal is required. (12 marks)
11. Your client has a Community Trade Mark Registration filed on 1 April 1996 and registered on 5 June 1998 in respect of "cosmetics" in class 3 and "make up bags" in class 21. Your client is currently selling a lipstick under the trade mark in the United Kingdom. Your client sold make up bags up to July 2000, but only in the UK. Your client has now been approached by another company who has a registration of the identical trade mark for "bags for toiletries" in class 21 in Germany. The registration is dated 30 November 1970. Enquiries reveal that they are currently selling a makeup bag under the trade mark in Germany and Austria.
- Advice your client on: (a) the validity of their community trade mark and (b) any other recommendations you would make to your client.
- No discussion of trade mark infringement is required. (12 marks)
12. What is a prior rights declaration? In what circumstances would you expect to encounter one? What provisions would you expect it to contain? (12 marks)
13. Compare and contrast the protection given to trade marks under the Madrid Protocol and the Community Trade Mark Registration. (12 marks)
14. Write notes on "exhaustion" and "international exhaustion" in the context of parallel imports within the EU. (12 marks)
15. Write brief notes on whether it is possible, desirable or essential to record licences in Brazil, Japan and Singapore. Discuss in brief whether use by the licensee protects a registration from cancellation on the grounds of non-use in those countries? (12 marks)