

## THE JOINT EXAMINATION BOARD

## PAPER T6

ADVANCED COMMUNITY TRADE MARK AND  
INTERNATIONAL TRADE MARK LAW AND PRACTICE

Thursday 12th November 2009

10.00 a.m. – 2.00 p.m.

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

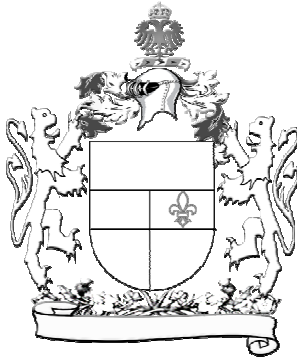
1. You should attempt **four questions** in total.
2. The marks awarded to each question are shown at the foot of the question. Only the first FOUR ANSWERS presented will be marked.
3. Please note the following:
  - a. Start each question (but not necessarily each part of each question) on a fresh sheet 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**

A new client has approached you for advice on protection of his trade marks. The client has given you the link to his website for full details of his proposed activities, which relate to the launch of a new breakfast cereal. The client tells you that he is familiar with trade marks and would prefer to use the Community Trade Mark system as he intends to sell his product throughout the European Union. The following trade marks are shown on the website:

a) GRATED GRAINS

b)



c)



Prepare detailed notes with reference to decided case law on:

- (a) the registrability of each of the three trade marks, (8 marks)
- (b) any potential objections/issues you foresee, and (9 marks)
- (c) how those obstacles might be overcome. (8 marks)

**PLEASE NOTE, YOU ARE NOT REQUIRED TO CONSIDER RELATIVE GROUNDS IMPLICATIONS FOR THIS QUESTION.**

## QUESTION 2

Your client, Big Cat Productions Ltd, operates 'vodka bars' in London, Edinburgh and Cardiff. Big Cat owns a UK registration of the silhouette of a red lion, which is used on the external signage of the bars and on the interior fixtures & fittings.

Details of the UK registration are as follows:

Goods/services	Filing date	Registration date
bars, restaurants and cafés' in Class 43	5 December 1999	17 August 2000

Your client wants to expand and plans to open a vodka bar in Berlin in **January 2010**. They also want to launch their own brand of vodka for sale in the bars, as well as in supermarkets and off-licences. Big Cat filed a CTM application on **1 June 2009** for its red lion trade mark, claiming clothing (cl.25), non-alcoholic beverages, beer (cl.32), alcoholic beverages (cl.33), bars, restaurants and cafés (cl.43) and claiming partial seniority from the UK registration.

Your client has received notification of an opposition raised by the German company Katze-Ka GmbH on the basis of the following trade marks under Articles 8(1)(b) , 8(4) (on the basis of the laws of Germany protecting an unregistered trade mark) and 8(5) as grounds of opposition:

Country	Trade mark	Goods/services	Filing date	Reg. date
Germany	RED CAT (words)	Vodka; vodka-based beverages	7 Dec 99	15 Jun 00
Germany	RED LEOPARD (words)	Vodka; vodka-based beverages	27 Oct 07	13 Jun 08
Germany	RED PUMA (words)	Vodka; vodka-based beverages	27 Oct 07	7 Mar 08
Austria	RED CAT (words)	Vodka; vodka-based beverages	7 Dec 99	21 Jul 00
Austria	RED LYNX (words)	Vodka; vodka-based beverages	3 Feb 08	
CTM *	RED CAT(words)	Vodka; vodka-based beverages	2 Jun 09	

(\*) Claims seniority from the German & Austrian registrations

Your client tells you that Katze-Ka GmbH sells vodka shots under the names RED LEOPARD, RED PUMA and RED PANTHER. Further investigation reveals that Katze-Ka sponsored the annual RED CAT International Bartenders' competition (London **2006** and **2007**) and the RED CAT European Surfing Championships in France (**August 2007**), Spain (**August 2008**) and Portugal (**August 2009**).

Prepare a memorandum advising your client on the following:

(a) the merits and strength of each of the grounds of opposition, with reference to appropriate case law, including the types of evidence required to prove their case, and

(22 marks)

(b) your recommendations, in brief, on further steps/actions your client could take to improve their position.

(3 marks)

**QUESTION 3**

Your client is the proprietor of CTM registration no. 2999606 NOVEL APPEARANCE dated **29 November 2007** in respect of:

“soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use” in class 3,  
“leather and imitations of leather; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks” in class 18, and  
“clothing, footwear, headgear” in class 25.

You have reported to your client that an application for a declaration of invalidity has been filed against the registration by one of their competitors. Your client has instructed you to contest the application.

The grounds for the application are that, under Article 51(1) CTMR, the mark was registered in breach of Article 7(1) (b) and (c) CTMR because your client’s trade mark is descriptive and non-distinctive.

Comment on the following situations:

- (a) Assuming no use has yet been made of the mark by your client, prepare observations in reply. **(10 marks)**
- (b) Your client informs you that substantial use was made of their mark prior to filing in the UK and Ireland. Advise them how this could assist their case and what you will require from them. **(9 marks)**
- (c) Your client has indicated that substantial use has been made of their mark in the UK and Ireland since filing. Advise them how this could assist their case and what you will require from them. **(6 marks)**

**QUESTION 4**

Your client, Speedrunner Sportz Limited, manufactures and sells a range of sports clothing, footwear and fitness apparatus. It has made extensive use of its mark in the UK, Ireland, Spain and Portugal for goods in classes 25 and 28 but its operations in Germany have not yet commenced. It has also expressed an interest in launching a range of toiletries under its trade mark SPEEDRUNNER but no use has been made of the mark in respect of toiletries to date.

Your client has the following registrations, each of which covers goods:

- 'toiletries, soaps' in class 3,
- 'clothing, footwear and headgear' in class 25, and
- 'fitness apparatus and equipment namely running machines' in class 28:

1. UK Trade Mark Registration No. 1552779 SPEEDRUNNER filed on **10 March 2000**
2. International Trade Mark Registration No. 98736 SPEEDRUNNER registered on **20 January 2004** and designating Germany and Spain
3. Irish Trade Mark Registration No. 88547 SPEEDRUNNER filed on 20 April 2000

Via its watching service your client has been alerted to an International Trade Mark Registration No. 99901 SPEEDYRUNNER registered on **15 February 2009** in classes 3 and 25 (designating the CTM, USA and China). The application is in the name of Sport One Limited, an Irish Company. The International Registration is based upon Irish Trade Mark Application No. 42671 filed on **10 January 2009**.

The CTM designation of Sports One Limited's International Registration was received by OHIM on **20 March 2009** and on the same date was immediately re-published.

Naturally, your client is concerned and wants to object to this application and has therefore come to you for advice.

- (a) Prepare notes for a meeting with your client on the procedures undertaken at OHIM upon receipt of a CTM designation and the procedures for filing an opposition against a CTM designation. No discussion on the grounds of opposition is required.

**(8 marks)**

- (b) Your client instructs you to file an opposition and during the course of proceedings Sport One Limited requests proof of use. Advise your client on any issues arising from this request, explaining procedures, timescales and evidence required in connection with the request for proof of use.

**(12 marks)**

- (c) Make brief notes on any next steps or further actions your client or Sport One Limited may wish to take to improve their positions.

**(5 marks)**

**Please note that UK, Ireland, USA and the European Union are all members of the Madrid Protocol. Spain, Portugal, Germany and China are members of both the Madrid Protocol and the Madrid Agreement.**

**QUESTION 5**

Your new client is a Swiss national living in London. He has acquired a small clothing manufacturing business in Algiers, Algeria. He wants to expand the business into Switzerland, the EU, USA, Canada and Australia and to extend it beyond clothing and into leather goods in class 18.

The trade mark is SAHARA LINENS and is registered in Algeria for "Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals." in class 18 and "Clothing, footwear, headgear." in class 25 since **December 2002** but has only been used on clothing.

The client wishes to use the International Registration system to obtain protection in the countries of interest.

Write notes to the client on the following issues:

- (a) Protecting your client's trade mark as an International Registration. Give reasoning for your answer mentioning any problems and solutions. (4 marks)
- (b) The options for using the International Registration route and the advantages and disadvantages of each option. For each option, mention:
  - i) the language(s) of the application,
  - ii) whether a home application or registration is required,
  - iii) the time limit each designated office would have to register or refuse the application and whether that deadline would be extendable, and
  - iv) the implications of and options in the event of central attack.(21 marks)

**Please note that Switzerland, USA, European Union and Australia are all members of the Madrid Protocol. Switzerland and Algeria are members of the Madrid Agreement. Canada is not a member of either the Madrid Protocol or the Madrid Agreement.**



**QUESTION 6**

Your client, ZAMP (Pty) Ltd, is a South African dairy products company with a wholly owned subsidiary, ZAMP (UK) Ltd in the UK. Its business is focused primarily in South Africa and the UK, with a small volume of sales in Germany, Benelux and Sweden. In September 2009, your client launched a new cheese-based snack in its home market, aimed at children, under the trade mark CHEEZE-CHAPZ, and filed an application for registration on **1 August 2009** in South Africa for dairy products and dairy-based snacks in class 29.

Your client wishes to launch the product in the European Union and North America (both the USA and Canada), and wants to ensure it has trade mark protection in place before the launch, which is scheduled for **March 2010**.

ZAMP (Pty) Ltd has carried out an initial search of the Community Trade Marks register and has found a Community registration of the mark CHEEZEE-CHAPPIE in respect of snack foods in classes 29 and 30, with a registration date of **14 October 2004**, owned by a Canadian company.

Write notes for a meeting with your client:

- (a) outline the filing options available to your client and the advantages and disadvantages associated with each, and

**(20 marks)**

- (b) which strategy you would recommend and why.

**(5 marks)**

**Please note that Sweden, USA and the European Union are all members of the Madrid Protocol. Germany and Benelux are members of both the Madrid Agreement and the Madrid Protocol. Canada and South Africa are not members of either the Madrid Protocol or the Madrid Agreement.**