

THE JOINT EXAMINATION BOARD

PAPER T6

ADVANCED COMMUNITY TRADE MARK AND
INTERNATIONAL TRADE MARK LAW AND PRACTICE

Monday 12th November 2012

10.00 a.m. – 2.00 p.m.


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

1. You should attempt **FOUR** questions. All questions carry **25 marks**.
2. The marks awarded to each question are shown at the foot of the question. If more than the required four questions are answered only the first four 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;
 - g. You must number all the pages of your answer script. Once the exam finishes, an additional 5 minutes will be allowed for you to do this.
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, number all the pages 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 7 pages including this one.

Question 1

Your client, Mahon Casa y Alimentos SA, asks for advice on the registration of the following trade marks.

Trade mark	Product
:ALCO-JEL:	Alcohol-flavoured jelly
 <p>Product sold in a bag of the above shape. The reverse of the bag is identical to the front.</p>	Pot pourri; fragranced air fresheners
The trade mark consists of the smell of newly crushed flowers (Olfactory mark)	Pot pourri

Write notes for a meeting with your client on:

1. The inherent registrability of each mark as a Community Trade Mark, and any objections that you might anticipate from the OHIM; (15 marks)

and

2. ways in which any such objections might be overcome. (10 marks)

Note: a discussion of possible relative grounds is not required

(25 marks)

Question 2

You have just been asked to take over responsibility for the trade marks portfolio of a cosmetics and toiletries manufacturer, Faeriestuff Ltd. Faeriestuff Ltd is the proprietor of Community trade mark no. 2,007,096 for the figurative mark:

FfaerieSparkleStuff

filed on 11 June 2004 and registered on 3 January 2005 for “cosmetics; perfumes” in class 3.

Your client has sent you the following email:

“When we met last week I promised to send you details of the letter we received from OHIM. OHIM informed us that Sparkles, Inc., filed for a Declaration of Invalidity of our CTM on 28 October 2012. According to the documents we were sent by OHIM, Sparkles, Inc. have based their case on their Community trade mark registration no. 2,006,901 FAIRY SPARKLE, filed on 17 March 2004 and registered on 7 November 2004 for “glitter for cosmetics purposes; body glitter gel” in class 3. They are also alleging that we filed our CTM application in bad faith.

We do know of Sparkles, Inc., as our marketing manager recalls they wrote to us a while ago to discuss some sort of joint distribution arrangement, but the talks never got off the ground.

What should we do now about the correspondence from the OHIM?”

1. Explain the invalidation action to your client, identifying the strengths and weaknesses of its position. (16 marks)

Your client then sends a second email as follows:

“I don’t see how Sparkles, Inc. can claim that our mark is invalid when we have been using it in the UK since 2002. We even tried to register it as a UK trade mark in 2002 as well, though the application was refused because of an earlier registration belonging to someone else. We did manage to register our domain names at that time though – we own ffaeriesparklestuff.co.uk and faeriesparklestuff.com. Surely that helps us?”

2. Outline to your client how its UK use and its domain name registrations might affect its position. (9 marks)

(25 marks)

Question 3

You are contacted by the managing director of your client Ethos Ltd, a UK company. The MD thinks that it may have an infringement issue.

Brecher GmbH is using the mark KING TITAN on fishing equipment and your client feels that this is too close to its registered trade mark TITAN. Initial enquiries have revealed the use of KING TITAN started in Germany last year and has recently expanded to France and Spain.

Your client's CTM registration of TITAN in Class 28 for "Fishing equipment, rods, reels, floats", registered on 1 July 2005, is the base registration for its IR designating China (where the client manufactures its goods), USA, and Australia. The IR was filed on 1 September 2012.

Although your client is using its mark in the USA and Australia, you are aware that it has not used in the EU since late 2006 due to poor sales, but it is hoping to revive use soon in the UK only.

Prepare notes for a meeting with your client as follows:

- a) Whether there is a strong case for infringement; (4 marks)
 - b) The options for jurisdiction; (8 marks)
 - c) The forms of relief available; (5 marks)
 - d) Problems which your client may encounter and how it may address such problems. (8 marks)
- (25 marks)**

Question 4

You have been asked to advise a Canadian corporation, Armour Holdings LLC, which is looking to extend its trade mark protection in Europe.

Your client provides security services in Canada. It also provides these services via wholly owned subsidiaries in the USA, China and Australia and via a licensee in the UK. The client's mark is ARMOUR. Use commenced in Canada in January 2012 and the other territories in July 2012. Your client applied to register ARMOUR in class 45 for security services in Canada on 2 July 2012.

Your client's UK licensee has discovered that an Austrian company, Armourguard GmbH, applied to register ARMOUR as a Community Trade Mark on 12 July 2012 for security services in class 45. Further enquiries show that Armourguard GmbH have a registration of ARMOUR as a national trade mark in Austria, with an effective date of 2 February 2010. Armourguard GmbH have used the mark in both Austria and Germany since early 2010.

Your client tells you that their UK licensee is interested in expanding into Spain, Italy, France and Ireland.

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

1. The filing options open to your client, setting out the advantages and disadvantages of each; (15 marks)
2. Your recommended strategy and further steps to improve your client's position. (10 marks)

USA, Australia, China and the European Union are members of the Madrid Protocol. Canada is not a member of the Madrid Protocol or Agreement.

(25 marks)

Question 5

Your client, Brillant Limited, imports and sells high-end vintage champagne, which they re-label with their brand ÉCLAT BRILLANT.

Brillant Limited is proprietor of CTM No. 00123456 ÉCLAT BRILLANT registered in respect of wine, sparkling wine and champagne in class 33. The mark was filed on 1 December 2001 and was registered on 1 June 2002.

Between 1 December 2001 and 1 June 2002 Brillant Limited sold 750 bottles of champagne through their website www.brillant.co.uk. The sales were to specialist off-licences in the UK and Ireland.

In July 2002 Brillant Limited's French supplier went into liquidation. They were unable to find a suitable alternative supplier and so they shelved the business on 1 August 2002, with no sales taking place after that date. In July this year they found an alternative supplier and placed an order for 100 bottles of champagne. They then updated their website, sent out new product leaflets to their existing customer base and advertised the champagne for sale via social media, but by October had only sold 12 bottles to a single customer.

In 2011 your client was approached by Open Bottle Ltd to purchase your client's CTM registration for ÉCLAT BRILLANT. Your client declined and is now concerned by a letter received 2 weeks ago from Open Bottle Ltd's attorneys threatening to revoke the mark for non-use and requesting that the registration be assigned to Open Bottle Ltd by 1 December 2012. Following receipt of the letter threatening revocation, Brillant Limited sold 100 bottles of champagne via its website to a contact in Ireland.

Make detailed notes advising your client on:

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

(25 marks)

Question 6

Your client, a US corporation, Rojas Drinks, Inc., recently acquired the global trade mark portfolio of a Mexican company, Silvanito Agave SA de CV, including the following registrations in the name of the former owner's UK licensees, Piripero Drinks UK Ltd (in administration since March 2012):

- UK registration no. 1243258 EL MARISOL, registered on 15 August 2003; the registration's filing date was 20 June 2002 with a renewal date of 20 June 2012. The renewal fee has not been paid;
- CTM registration no. 278912 TEQUILA MARISOL, registered on 20 July 2007;
- International Registration no. 167775 EL MARISOL, based on UK registration no. 1243258 and designating the EU, Switzerland and Norway, registered on 30 September 2009. The second statement of grant for the EU designation was issued on 13 October 2010.

Your client has completed its acquisition but has not yet recorded the transaction at any intellectual property office.

The trade marks are all registered for:

Class 25 – clothing, headgear and footwear;

Class 33 – alcoholic beverages; tequila.

Sales of the EL MARISOL tequila range were significant for a number of years but ceased around mid 2007. Your client now intends to launch a range of flavoured tequilas in the UK from March 2013, together with a range of merchandise consisting of shot glasses, bags, sombreros, clothing and watches. They have invested significant money in preparing for launch. They also intend to have several launches across the EU soon after the UK launch.

Your client has emailed you details of CTM application no. 2225858 EL MARISELLE filed by an Irish company, Colonel Mortimer's Wines Limited, on 2 April 2012 and published for opposition purposes on 1 September 2012, covering:

Class 18 – bags

Class 21 – glassware

Class 25 – clothing, footwear and headgear

Class 33 – wines

Class 35 – retail services relating to wines.

Write notes for a telephone call with your client to discuss –

1. The potential grounds, merits and chances of success in a possible opposition; (10 marks)
2. Any difficulties your client is likely to face and measures your client can take to improve its position. (15 marks)

(25 marks)