

THE JOINT EXAMINATION BOARD
PAPER P7 – PRINCIPLES OF TRADE MARK LAW
Thursday 10th October 2013
3.00 p.m. – 5.00 p.m.

*Please read the following instructions carefully. **Time Allowed – 2 HOURS***

1. You should attempt **eight of questions 1 to 9** in Part A and **five of questions 10 to 15** in Part B.
2. The marks awarded to each question are shown at the foot of the question and sub-question as appropriate.
Note If more than the required 8 questions are answered in Part A or more than the required 5 questions are answered in Part B, only the first 8 or 5 presented in each respective Part 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 (P7), 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 FIVE pages including this one.

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Part A

Question 1

List five examples of signs or trade marks which can be refused registration under UK Trade Marks Act 1994, s. 3 (Absolute grounds for refusal of registration).

5 marks

Question 2

What is meant by the term “Exhaustion of Rights” as defined in Article 13 of the Community Trade Mark Regulation (CTMR)?

5 marks

Question 3

(a) What are the exclusive rights provided by a UK registered trade mark according to UK Trade Marks Act 1994 s. 9 (Rights conferred by registered trade mark)? *2 marks*

(b) When do those rights take effect? *1 mark*

(c) What is the earliest date on which infringement proceedings may be started? Is there any difference between the provisions of UK Trade Marks Act 1994 and CTMR in this respect? *2 marks*

5 marks

Question 4

In accordance with Article 9 CTMR (Rights conferred by a Community trade mark), what are the signs which the proprietor of a CTM is entitled to prevent third parties from using?

5 marks

Question 5

List five examples of “earlier trade marks” as defined in UK Trade Marks Act 1994, s. 6 (Meaning of ‘earlier trade mark’).

5 marks

Question 6

List four defences to infringement under UK Trade Marks Act 1994, s. 11 (Limits on effect of registered trade mark) and any proviso thereto.

5 marks

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Question 7

(a) In addition to assignment, list the ways in which ownership of a registered trade mark may be transferred according to UK Trade Marks Act 1994, s. 24 (Assignment, etc, of registered trade mark). *2 marks*

(b) List two types of partial assignment provided for in UK Trade Marks Act 1994, s. 24. *1 mark*

(c) What is required for an assignment or an assent of a UK registered trade mark to be effective according to UK Trade Marks Act 1994, s. 24? *2 marks*

5 marks

Question 8

Your client acquired a UK registered trade mark nine months ago and he has appointed a licensee but he tells you that he has not yet entered the assignment or the licence on the Trade Marks Register. Write brief notes on the consequences of failure to record the assignment and licence.

5 marks

Question 9

(a) What is the so-called comparative advertising defence in UK Trade Marks Act 1994, s. 10(6) (Infringement of registered trade mark)? *3 marks*

(b) Describe any limitations to that defence. *2 marks*

5 marks

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Part B

Question 10

- (a) List the essential requirements for obtaining a valid filing date under UK Trade Marks Act 1994, s. 32 (Application for registration). *2 marks*
- (b) According to UK Trade Marks Act 1994, s. 33 (Date of filing), what date is the filing date in the event that some of the above filing requirements are furnished on different days? *1 mark*
- (c) Summarise the examination procedures of UK Intellectual Property Office in relation to a new UK trade mark application. How may the applicant respond? *5 marks*
- (d) How many classes are covered by the basic application fee for a:
- (i) UK Trade Mark Application; and
 - (ii) CTM Application? *1 mark*
- (e) Summarise the circumstances in which a UK or CTM registration may be liable to revocation for non-use. *3 marks*

12 marks

Question 11

Outline the examination procedure by WIPO and designated National Offices when an application is filed under the Madrid Protocol.

12 marks

Question 12

- (a) Your client wishes to oppose a UK Trade Mark application and a CTM application, which were both published on 12th September 2013. Advise your client of the deadline for filing opposition against:
- (i) the UK application; and *1 mark*
 - (ii) the CTM application. *1 mark*
- (b) Can the deadline be extended in either case and, if so, for how long? *1 mark*
- (c) Your client wishes to oppose on both absolute and relative grounds. Advise whether that is possible and explain any differences between UK and CTM systems in relation to grounds of opposition. *2 marks*
- (d) Your client also asks about the procedure for filing Observations rather than opposition. Outline the procedure and any difference between the UK and CTM systems in relation to Observations. *7 marks*

12 marks

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Question 13

- (a) In relation to a trade mark, what is a Convention Application? *2 marks*
- (b) What is a right to priority? *2 marks*
- (c) Are there any circumstances in which the applicant can re-start the Convention Priority term for the same mark and goods? *2 marks*
- (d) When can priority be claimed under UK Trade Marks Act 1994 and what basic information is required? *2 marks*
- (e) When can priority be claimed under CTMR and what basic information is required? *2 marks*
- (f) According to Article 4 of the Paris Convention what supporting document(s) may UK IPO/OHIM require? *2 marks*

12 marks

Question 14

Outline the main differences between the Community Trade Mark and Madrid Protocol systems of registration.

12 marks

Question 15

Write notes explaining the three fundamental ingredients for a successful passing off action. *Candidates do not need to provide names of decided cases to earn marks.*

12 marks