

P7 – Principles of Trade Mark Law

Thursday 2 October 2014

3.00 p.m. – 5.00 p.m.

Time allowed – TWO hours

INSTRUCTIONS TO CANDIDATES

1. You should attempt **eight questions** in Part A and **five questions** in Part B. There are 15 questions altogether, nine in Part A and six in Part B.
2. Each question in Part A carries **5** marks, and each question in Part B carries **12** marks.
3. If more than eight questions are answered in Part A, or more than five questions are answered in Part B, only the first eight or five presented in each respective part will be marked.
4. Start each question (but not each part of each question) on a fresh sheet of paper.
5. Enter the question paper reference number (P7), the question number and your candidate number in the appropriate boxes at the top of each sheet of paper.
6. The scripts are photocopied for marking purposes.
 - a. Use **black ink**.
 - b. Write on one side of the paper only.
 - c. Write within the printed margins.
 - d. Do not use highlighter pens on your answer script.
7. Do not state your name anywhere in the answers.
8. Write clearly: examiners cannot award marks to scripts that cannot be read.
9. Reasoning should always be given where appropriate.

INFORMATION FOR CANDIDATES

1. The total number of marks for this paper is 100.
2. At the end of the examination the invigilator will instruct you to:
 - a. count the number of pages you have used;
 - b. use the boxes on each page of the answer script to number pages in the format “1 of 25, 2 of 25 etc”;
 - c. place your answer sheets in order in the white envelope, seal the envelope and leave the envelope on the desk.
3.
 - a. Do not staple the pages, or use sellotape or treasury tags.
 - b. You may take the examination paper with you.
4. This question paper consists of 7 pages in total, including this page.

Part A

Question 1

- a) What must Community trade marks be capable of in order to come within the definition of what is registrable under *CTMR Article 4 Signs of which a Community trade mark may consist?*

2 marks

- b) Provide six examples of types of marks which may be registrable within the definition.

3 marks

Total: 5 marks

Question 2

- a) Under the provisions of *CTMR Article 10 Reproduction of Community trade marks in dictionaries*, in what circumstances can the proprietor of a Community Trade Mark object to the reproduction of a registered trade mark in a dictionary?

2 marks

- b) What action must the publisher of the dictionary take if requested by the proprietor of the CTM?

3 marks

Total: 5 marks

Question 3

- a) What are the only three types of corrections permitted to a UK trade mark application under *UKTMA Section 39 (2) Withdrawal restriction or amendment of application?*

3 marks

- b) Under what conditions are these corrections permissible?

2 marks

Total: 5 marks

Question 4

- a) List the grounds for invalidity of a UK trade mark registration under *UKTMA Section 47 Grounds for invalidity of registration.*

2 marks

- b) Briefly outline three qualifications or limitations to the Grounds for Invalidity.

3 marks

Total: 5 marks

Question 5

- a) Explain what is Restitutio in integrum under *CTMR Article 81 Restitutio in integrum*.
2 marks
- b) Briefly outline the conditions for filing Restitutio in integrum (*CTMR Article 81 Restitutio in integrum*).
3 marks
- Total: 5 marks**

Question 6

- a) For what four reasons may conversion of a CTM application or registration be requested under *CTMR Article 112 Request for the application of national procedure*?
2 marks
- b) For what two reasons, according to *CTMR Article 112 Request for the application of national procedure*, may conversion **not** take place?
3 marks
- Total: 5 marks**

Question 7

- a) Describe the terms of *Article 6bis of the Paris Convention for the Protection of Industrial Property* which provides for the protection of well-known marks.
3 marks
- b) Describe the provisions in *Article 6bis* relating to time limits.
2 marks
- Total: 5 marks**

Question 8

- a) *Madrid Protocol Article 6(2), (3) and (4) Dependence and Independence of International Registration* sets out the provisions relating to the concept known colloquially as 'central attack'. Briefly explain the provisions of *Article 6(2), (3) and (4)*.
4 marks
- b) What action, if any, can the proprietor of the Madrid Protocol registration take to maintain his rights in the event of a successful central attack?
1 mark
- Total: 5 marks**

Question 9

a) Who is entitled to own a Madrid Protocol registration under *Madrid Protocol Article 2 Securing Protection through International Registration*?

2 marks

b) What is a 'basic application' or 'basic registration' under *Madrid Protocol Article 2 Securing Protection through International Registration*?

3 marks

Total: 5 marks

Part B

Question 10

- a) List six of the criteria established by the Court of Justice of the European Union (CJEU) in the case of **Sabel BV v Puma AG, Rudolf Dassler Sport (C-251/95)** for determining whether there is a likelihood of confusion between two marks.
9 marks
- b) State two of the three main criteria established by the CJEU in the case of **Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C39/97)** for determining whether the similarity between goods or services covered by two marks is, or is not, sufficient to give rise to a likelihood of confusion.
3 marks

Total: 12 marks

Question 11

- a) What is the initial registration term of the following trade mark registrations and from what date does the registration term start to run?
- i. UK (*UKTMA Section 42 Duration of registration*). **1 mark**
 - ii. CTM (*CTMR Article 46 Duration of registration*). **1 mark**
 - iii. Madrid Protocol (*Madrid Protocol Article 6 Period of Validity of International Registration*). **1 mark**
- b) For the following registrations, during what time period can renewal fees be paid and, if they are not timely paid, what grace period is permitted for late renewal?
- i. UK (*UKTMA Section 43 Renewal of registration*). **1 mark**
 - ii. CTM (*CTMR Article 47 Renewal*). **1 mark**
 - iii. Madrid Protocol (*Madrid Protocol Article 7 Renewal of International Registration*). **1 mark**
- c) UK, CTM and Madrid Protocol registrations for a mark in use have been allowed to expire through non-renewal and the grace period has also expired last month.

List any options available to a proprietor who wishes to continue protection for his mark and describe any potential difficulties with those options.

6 marks

Total: 12 marks

Question 12

- a) List the four types of legal proceedings over which the EU Community trade mark courts have exclusive jurisdiction under *CTMR Article 96 Jurisdiction over infringement and validity*.

4 marks

- b) Set out the provisions of *CTMR Article 97 International jurisdiction* that govern where in the EU actions and claims referred to in Article 96 above must be brought.

8 marks

Total: 12 marks

Question 13

Your UK client consults you about a new trade mark which he wishes to register immediately in UK, Denmark, Sweden, and Norway.

He has heard that there are different trade mark registration systems (national registrations, Community trade mark registrations and Madrid Protocol registrations) and wants your help in deciding which is/are appropriate for his situation.

Draft notes to answer the following questions that the client has raised. Confine your notes to the options for registration and do not advise about other aspects of protection such as searching or distinctiveness.

- a) Which of the systems of registration, or combinations of systems, can the client use to obtain protection in the above territories of interest?

3 marks

- b) How can the client obtain additional future protection in:

i. Territories which may join the Madrid Protocol at a future date?

1 mark

ii. Territories which may join the European Union at a future date?

1 mark

- c) Can you represent your client in relation to all national, CTM or Madrid Protocol registrations or, if not, when must your client retain a foreign attorney?

3 marks

- d) Outline a total of four advantages or disadvantages to one or more of the systems of registration.

4 marks

Total: 12 marks

Question 14

Your client has sold walking shoes continuously since the 1960s throughout the UK under the invented name RAMBLEEZ. He has never registered his trade mark.

Your client reports that a customer has just brought in a complaint about a walking shoe under the name RAMBLEASY. Research has disclosed that the shoe was not made by the client but by a company called Shoos Limited which started selling shoes under the trade mark RAMBLEASY in 2013 and filed a UK trade mark application for the mark RAMBLEASY on 10th April 2014. The application was published for opposition on 24th August 2014.

- a) Name the legal action available to your client to prevent continued sales of the RAMBLEASY product. Do **not** consider interim injunctions. **1 mark**

- b) Explain what your client must prove and, using the facts in the question, explain whether the client is likely to succeed or fail. **6 marks**

- c) Can your client prevent registration of the trade mark application? If so, on what grounds and is there any deadline? **2 marks**

- d) Apart from the actions described above, what else might your client do to improve his position generally? **3 marks**

Total: 12 marks

Question 15

Describe the standard UK opposition procedure (not the fast track opposition procedure).

Total: 12 marks