

Trade Mark Law FC5 (P7)

Thursday 15 October 15:00 to 17:00

INSTRUCTIONS TO CANDIDATES

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.
3. If more than the required eight questions are answered in Part A, or more than the required five questions are answered in Part B, only the first eight or five presented in each respective part will be marked.
4. The total number of marks available for this paper is 100.
5. Start each question (but not each part of each question) on a new sheet of paper.
6. Enter the question number in the appropriate box at the top of each sheet of paper.
7. Do not state your name anywhere in the answers.
8. Write clearly as examiners cannot award marks to answer scripts that cannot be read.
9. The scripts may be photocopied for marking purposes.
 - (a) Use only **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.
10. Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
11. This question paper consists of 7 sheets, including this sheet.

The following annotations will be used throughout this paper:

- **CTMR:** Commission Regulation (EC) 207/2009
- **CTM:** Community Trade Mark
- **UKTMA:** UK *Trade Marks Act 1994*
- **UKIPO:** United Kingdom Intellectual Property Office
- **OHIM:** Office for Harmonization in the Internal Market
- **Madrid Protocol:** Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

PART A

Question 1

- a) *Article 1(2) 'Community trade mark'* CTMR provides that a CTM is unitary in character. What does that mean? **3 marks**
- b) Explain by means of an example how that unitary character works in practice. **2 marks**

Total: 5 marks

Question 2

Describe the procedure for a United Kingdom (UK) trade mark application from the date of submission of the application to the date on which the examination report is issued noting all the steps to be taken by the applicant and UKIPO, any deadlines and whether the deadlines can be extended.

NB there are no marks awarded for explaining how to overcome any official objections or later stages of the application procedure.

Total: 5 marks

Question 3

Section 5 'Relative grounds for refusal of registration' UKTMA provides that a trade mark shall not be registered in the UK if it conflicts with certain earlier trade marks (*Section 5(1), (2) and (3)*), rule of law (*Section 5(4)(a)*), and earlier rights (*Section 5(4)(b)*).

- a) List the three relative grounds in *Section 5(1) and (2)* UKTMA in relation to which a new trade mark application is searched as part of the UKIPO official examination. **3 marks**
- b) What, according to *Section 5(4)(a)* UKTMA, is an example of a rule of law protecting unregistered trade marks that can be used to prevent registration of a trade mark? **0.5 marks**
- c) List three types of 'earlier rights' (**not 'earlier trade marks'**) which, according to *Section 5(4)(b)* UKTMA, can be used to prevent use or registration of a trade mark in the UK. **1.5 marks**

Total: 5 marks

Question 4

A UK trade mark application has been published for opposition purposes in which the mark consists of the words NOTTINGHAM LAWNMOWERS. Your client, a lawnmower manufacturer based in Nottingham, tells you that he is concerned but that he cannot justify the cost of opposition.

- a) **What is the other option for objecting to the trade mark at this stage?** **1 mark**
- b) **Provide an outline of the procedure, including any relevant time scales, for that option.** **4 marks**

Total: 5 marks

Question 5

- a) After publication of a CTM application, how long is allowed for third parties to file opposition according to *Article 41 'Opposition'* CTMR and can the term be extended? **1 mark**
- b) Who may file opposition according to *Article 41 'Opposition'* CTMR? **2 marks**
- c) Name two of the three essential elements required for a valid opposition according to *Article 41 'Opposition'* CTMR? **2 marks**

Total: 5 marks

Question 6

On what grounds can a CTM be revoked under the provisions of *Article 51 'Grounds for revocation'* CTMR?

Total: 5 marks

Question 7

Your client's CTM has been refused on grounds that it is descriptive in the Croatian language and your client wishes to convert the CTM into national applications in all territories except Croatia.

- a) **What is the deadline for applying for conversion?** **1 mark**
- b) **What actions must you take to convert the application within this deadline?** **1.5 marks**
- c) **What may be required by the national offices where conversion is requested and what time limit may be imposed?** **2.5 marks**

Total: 5 marks

Question 8

a) Explain the provisions relating to 'Replacement' under *Article 4bis 'Replacement of a National or Regional Registration by an International Registration'* of the Madrid Protocol.

4 marks

b) Identify an advantage of 'Replacement'.

1 mark

Total: 5 marks

Question 9

Outline the doctrine of free movement of goods with reference to *Articles 34, 35 and 36* of the Treaty on the Functioning of the European Union.

Total: 5 marks

PART B

Question 10

Your US client wishes to register a picture of a lion as a trade mark in the UK and a search of the UK trade marks register has disclosed that an application to register the identical mark was filed three months ago for the identical products in the name of an unrelated third party. The earlier trade mark is about to be published.

- a) **Briefly explain why the earlier trade mark is a problem for your client.** **1 mark**
- b) **Discuss the possible options to overcome the problem at UKIPO. (Do not discuss possible action in the courts.)** **11 marks**

Total: 12 marks

Question 11

In both parts of this question, confine your answer to the nature of the action at OHIM. There are no marks for describing the full procedure, nor for advising on possible court action or negotiation.

- a) Your Japanese client tells you that his European distributor (who is responsible for all imports into the European Union (EU) of your client's products) has applied to register your client's trade mark as a CTM. Despite the fact that he has been selling his products through the distributor for several years, your client has never got round to registering his trade mark anywhere in the EU.

Write notes on what ground of opposition your client can use at OHIM to oppose the distributor's trade mark application.

6 marks

- b) Explain the grounds on which the owner of a non-registered trade mark can oppose a CTM where the applicant is not his distributor but an unrelated third party according to *Article 8(4) 'Relative grounds for refusal'* CTMR.

6 marks

Total: 12 marks

Question 12

Your client's trade mark consists of the word MINSK, capital of the country of Belarus. The city has a population of more than two million.

He explains that his products (bikinis) have nothing to do with the city of Minsk, which has a rather cold climate and no beaches, but he liked the word because it sounds a bit like 'miniscule', which is a desirable quality for bikinis.

He tells you that his products have been sold throughout the UK for more than twenty years and are very popular but that he has not yet registered MINSK as a trade mark.

- a) **Advise your client on the principal objection which a UK trade mark application is likely to face on absolute grounds that it is a place name by reference to UKTMA and relevant case law.**

6 marks

- b) **Your client wishes to try to overcome the objection by filing evidence of acquired distinctiveness. Explain to your client the criteria established by the Court of Justice of the European Union on evidence of acquired distinctiveness.**

6 marks

Do not discuss other possible objections on absolute grounds or possible objections on relative grounds.

Total: 12 marks

Question 13

- a) What is meant by 'seniority' according to *Article 34(1) 'Claiming the seniority of a national trade mark'* CTMR?

2.5 marks

- b) What is the effect of seniority according to *Article 34(2)* CTMR?

2 marks

- c) At what three points in the life of a CTM application/registration can seniority be claimed?

1.5 marks

- d) What is the procedure for claiming seniority under the CTMR?

6 marks

Total: 12 marks

Question 14

- a) When can an application be filed under the Madrid Protocol? **3 marks**
- b) What are the four names of the types of fees payable for an application filed under the Madrid Protocol? **2 marks**
- c) Write notes on the main differences between protection provided by the CTMR and the Madrid Protocol. **7 marks**

Total: 12 marks

Question 15

- a) Discuss the provisions relating to 'transformation' under the Madrid Protocol. **6 marks**
- b) Discuss the provisions relating to 'conversion' under the CTMR. **6 marks**

Total: 12 marks