



CITMA Paralegal Course Exam 2023

28th April 2023

10:00-12:00

Section A

Question 1

You work in private practice for a firm of Trade Mark Attorneys in Belfast.

A local business requires your help protecting their trade mark in the United Kingdom. They have two variants of their trade mark that they believe are very close.

- a) The two variants of a trade mark could potentially be a series. Explain what a series of marks is **(1 mark)**
- b) After discussions, we understand the trade mark application needs to be filed in three classes. What would be the official fee due for filing this application under the 'regular' filing route? **(1 mark)**

The UK application is then filed today, 28 April 2023.

- c) This will be the company's first filing and they have indicated they may have interests in expanding to the Republic of Ireland or the wider European Union. Your firm has an office in Dublin that could help with this. What deadline should you monitor so that any Irish or EU applications could backdate to the filing date of the UK application **(1 mark)** and what is the deadline any such applications must be filed by? **(1 mark)**
- d) If they were to file in the EU covering both variants of the mark, what would the total official fees be? **(1 mark)**
- e) During examination of the UK application, the Examiner raises some queries concerning the specification in an examination report. What is the period of time in which to respond? **(1 mark)**
- f) The UK application goes forward to registration. When will it fall due for renewal? **(1 mark)**

Question 2

Benelux and OAPI along with the European Union trade mark are types of unitary trade mark rights that cover all of their member states.

- a) Name the three members of Benelux **(1 mark)**
- b) Name three members of OAPI **(1 mark)**
- c) Name three member states of the European Union **(1 mark)**

Question 3

You work in private practice and have been approached by client looking to launch a new car brand in the next year.

- a) Set down four reasons why trade mark searching is recommended before launching a new brand? **(4 marks)**
- b) There are, however, some limitations to trade mark searches. Name four limitations. **(4 marks)**

Question 4

India is an example of a country that examines trade marks to check for any prior rights.

- a) Under what grounds is this examination conducted? **(1 mark)**
- b) If the Examiner raises any prior rights as being in conflict with an application, what are these referred to? **(1 mark)**
- c) Provide four options you could explore to overcome such a prior right **(4 marks)**

Question 5

You work in-house for an international hotel company. You are about to open new five star hotels in the Cook Islands and Maldives. You are aware that neither of these countries has trade mark legislation. What could be published in these countries **(1 mark)**? Explain what such a publication does **(1 mark)**

Question 6

You represent Pommes de Somerset, a rapidly growing cider producer from Somerset in the United Kingdom. With international demand for cider growing, they are now looking to expand their trade mark portfolio outside of the UK, although they are yet to use anywhere outside of the UK. They already have their main trade mark registered in the United Kingdom. This registered in 2015.

They are particularly looking at trade mark protection in Australia, Germany, Japan, New Zealand, Saudi Arabia, the United Arab Emirates and the United States of America.

- a) You are aware that many of these countries are members of the Madrid Protocol. What two criteria would our client need to fit to file under this system? **(2 marks)**
- b) If filing nationally, in which country is the term of registration calculated from the Hijri (lunar) calendar and, as this is shorter than the Gregorian calendar, you are likely going to need to pay extra careful attention to the renewal date should your database look to calculate this automatically? **(1 mark)**
- c) In which of the countries are they not allowed to register their trade mark for alcoholic beverages such as cider? **(1 mark)**

- d) If an International trade mark is filed designating the available countries, explain the process from the issuing of a Provisional Refusal by one of the designated country's Trade Marks Office to the filing of a response to the Provisional Refusal. **(4 marks)**
- e) If we elected to cover the United States through a national filing there instead of designating the United States in an International application, under what basis or bases could we file this application? **(2 marks)**

Question 7

You work in private practice and have recently taken over the trade mark portfolio of an established company that has been in business for over 100 years.

You note that they own a number of UK registrations from 1950 for the same mark in three classes. You also note that they own a number of national registrations in EU member states from around the same time, as well as EU registrations, many from when the EU trade mark was introduced on 1 April 1996.

- a) What are the requirements the UK registrations would need to meet to be merged together? **(6 marks)**
- b) How long before a renewal date does the UKIPO ask that merger requests be made so as to ensure they can be timely processed? **(1 mark)**
- c) Explain the 'Triple Identity' requirement with respect to claiming seniority from the national registrations in EU member states against an EU registration? **(3 marks)**

Question 8

You work for in a specialist renewals team helping maintain the trade mark portfolio a financial company, Nouveau Rich Limited. They have a global portfolio of rights across a large number of countries.

- a) Name three territories in which some form of Declaration or Affidavit around a trade mark's use must be filed in order to maintain trade mark registrations, this being independent and at a separate time of any renewal. **(3 marks)**
- b) In order to renew a registration in Gibraltar, where must a base registration have first been renewed? **(1 mark)**

Question 10

You work in private practice for a London-based firm of solicitors and your firm have recently taken over a trade mark portfolio after your client acquired another business. During the due diligence performed prior to acquisition, a conflicting third party UK trade mark came up that had not been opposed.

This mark is now registered. Your client has enquired about a possible invalidation.

- a) Can invalidation be filed against a registered trade mark? **(1 mark)**
- b) What grounds (absolute and/or relative) are available for an invalidation action and, depending on these, does your client have standing to file for invalidation? **(2 marks)**
- c) In the event an invalidation is successful, what becomes of the status of the original application? **(1 mark)**

Question 11

You work in-house for an automotive company and your development team have come to you with the designs for two new models of tractor.

In the United Kingdom, you are aware that a Registered Design protects the overall look and feel of a product. The 'look' includes the appearance, shape, configuration and decoration.

- a) What are the requirements for a design to have in order to be validly registered and enforceable in the UK? **(2 marks)**
- b) With respect to your answer a), what period of grace is allowed for a design to be in the public domain but for this not to affect its validity? **(1 mark)**
- c) If you obtained a registration for any of the designs, how long would they be initially registered for? **(1 mark)**
- d) You will look to secure protection elsewhere in good time. With interests in securing protection in Australia, Canada, China, the European Union, Japan and the United States, could you use the Hague System to cover all of these? Provide a short reason for your answer. **(1 mark)**
- e) Name two "dependent" jurisdictions in which a UK Registered Design can be locally registered? **(1 mark)**