

Problem Set 3

1. Which of the following is eligible for filing a EUTM application?
 - (a) a French individual who operates a noncommercial website;
 - (b) a U.S. automobile manufacturer
 - (c) an appotato distributor in Tripsland (Tripsland is a member of the WTO, but not a member of the European Union. Appotato is a rare fruit that looks like a new potato, yet tastes like an apple. Appotatoes can only be grown in Mediterraneum, a small island country in the middle of Aegean Sea.)
 - (d) an Internet service provider in Europa (Europa offers comparable protection to EUTM and recognizes EUTM registration as proof of country of origin, but is not a member of the WTO, the European Union, or the Paris Convention.)

2. Eurasia Trading (“ET”) filed a trademark application in the People’s Republic of China (“PRC”) on January 1. To benefit from EUTM protection, ET filed a EUTM application with the Benelux Office on June 29 (and included the original trademark application for priority purposes). Two days later, ET’s outside counsel alerted ET that Chinese was not one of the official languages used for a EUTM application (surprise!). (ET fulfilled all the other filing requirements, including filing of the proper forms and payment of relevant application fees.) On July 2, ET filed another EUTM application in German with the EU Intellectual Property Office in Alicante, Spain. What is the date of filing for ET’s EUTM application? Would ET be able to claim priority?

3. Wine Seller® is a registered trademark in the United Kingdom. Since 1979, it has operated wine distribution businesses in Liverpool, London, Manchester, and Southampton. In 1998, Wine Seller® filed a EUTM application, claiming seniority. The EUTM application was subsequently approved. A year later, Wine Seller® decided not to renew its trademark in the United Kingdom and allowed it to lapse. Meanwhile, it noticed that a cybersquatter had registered the domain name www.wineseller.com. Wine Seller® initiated a lawsuit to “evict” the squatter. The squatter counterclaimed that Wine Seller mark was generic and/or descriptive in nature and asked the court to invalidate the mark. To Wine Seller®’s surprise, the court agreed with the squatter and invalidated the mark. Would Wine Seller® still be able to enjoy EUTM protection in Ireland despite losing the lawsuit in the United Kingdom?

4. D’accord Bar & Grill filed a EUTM application for the D’accord mark. The application was opposed by D’accord chain of fast food restaurants in France and was subsequently rejected. Would D’accord be able to amend the application by restricting the EUTM to the other 26 EU member states? Would D’accord be able to convert the trademark into national applications in France, Italy, and Ukraine? Would D’accord be able to file a EUTM application in the first place had D’accord Bar & Grill lost a trademark infringement lawsuit in France prior to its EUTM filing?

5. You are a leading expert on international trademark law. WIPO has recently invited you to a conference on international trademark system in Geneva. The representatives of France, Germany, and Spain proposed a EUTM-like framework for harmonizing the international trademark system. What would be your response if you were a member of the U.S. delegation? Would you recommend your government (or your state client) to support the framework? Would your position be different if you represent Malawi, a developing country?

6. Your client bought a domain name, www.hikitty.com, for her 3-year-old daughter, Kitty, as a birthday gift. Most recently, she received a cease-and-desist letter from a Japanese corporation. In the next few days, she received five more letters from the European, Hong Kong, Korean, Taiwanese, and U.S. licensees of Hello Kitty® products, as well as some vicious letters from Hello Kitty® fans. She's very concerned about the letters and asked you the following questions regarding the UDRP, which she has never heard of in her life. What would be your responses?

- (a) What are the three basic elements a complainant must prove to secure a domain name transfer?
- (b) Must the complainant be the holder of a valid trademark or service mark?
- (c) What are the permissible affirmative defenses under the UDRP? Are these defenses exclusive?
- (d) Who will bear the costs of the fees of the dispute resolution provider?
- (e) Who will choose the dispute resolution provider?
- (f) Can the respondent demand a three-person dispute resolution panel if the complainant *insists* on having only one panelist? If yes, who will choose and pay for the panelists? If no, which provision prevents the respondent from doing so?
- (g) How is notice served on the respondent?
- (h) Can the respondent seek a judicial determination before the UDRP proceeding? During the proceeding? And after the proceeding?
- (i) Who will prevail under the UDRP proceeding?

7. Mammajamalaluha is a famous ethnic restaurant chain headquartered in London. Its restaurants are located in 154 cities in twenty-three countries, many of which are EU member states. Most recently, the restaurant chain noticed that your client had registered the domain name www.mammajamalaluha.com and initiated an action under the UDRP. Your client claimed that she created the word "mammajamalaluha" herself and has used it in a novel she is currently working on. Upon your request, she produced computer files, handwritten drafts, and even witnesses to support her defense. Unfortunately, the dispute resolution provider is not willing to consider any of this evidence, citing that a court, rather than a dispute resolution provider, will be in a better position to evaluate the authenticity and veracity of the evidence. Your client lost the case before the UDRP panel.

To prevent the domain name transfer, you advised your client to seek a declaratory judgment from a federal court that her registration does not violate the Anticybersquatting Consumer Protection Act (ACPA). Mammajamalaluha moved to dismiss the case, citing that it had no intention of bringing any claims under the ACPA or under federal trademark and unfair competition laws. Should the court dismiss the case? If it does, would you recommend your client to appeal the case? Would your client be able to prevent the registrar from transferring her domain name while she is awaiting the determination of the appellate court? Would the answer be different if she relies on the domain name for her business?

8. Your client, www.uk.com, runs an Internet portal and provides web hosting, design, and support services for businesses and individuals who have interest in establishing domain names and email addresses ending in uk.com (e.g., ilove.uk.com). He is nonetheless concerned about his legal liability regarding his customers' abusive and predatory registration of domain names that infringe upon third-party intellectual property rights holders. He sought your counsel. What would be your advice?