

Problem Set 3

1. Which of the following is eligible for filing a CTM 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 CTM and recognizes CTM 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 CTM protection, ET filed a CTM 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 CTM 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 CTM application in German with the CTM Office in Alicante, Spain. What is the date of filing for ET’s CTM 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 CTM application, claiming seniority. The CTM 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 CTM protection in Ireland despite losing the lawsuit in the United Kingdom?

4. D’accord Bar & Grill filed a CTM 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 CTM to the other 14 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 CTM application in the first place had D’accord Bar & Grill lost a trademark infringement lawsuit in France prior to its CTM 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 CTM-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 less developed country?