

**THE JOINT EXAMINATION BOARD**

**PAPER T1**

**BASIC UNITED KINGDOM TRADE MARK LAW**

**16th November, 1995**

**2.00 p.m. - 4.00 p.m.**

Please read the following instructions carefully. This is a TWO HOUR paper.

1. You should attempt no more than eight questions from Part A and no more than five questions from Part B.
2. The number of marks allotted to each question is placed in brackets at the end of the question.
3. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number, and your Examination number. Write on one side of the paper only using BLACK ink. You must NOT staple pages together. You must NOT state your name anywhere in the answers.
5. Unless specifically requested answers are NOT required in letter form.
6. NO printed matter or other written material may be taken into the examination room.
7. Answers MUST be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
8. NO writing whatsoever, including numbering of papers, is allowed prior to the commencement of the examination or after it has finished.

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PART A

1. Write brief notes on Third Party Observations on publication of an application, under the Trade Marks Act 1994.  
(5 marks)
2. Your client, who is in the toothpaste field, has a defensive registration for "toothbrushes" in Class 21. What is the position of this registration under the Trade Marks Act 1994?  
(5 marks)
3. Your client has a Part B registration under the Trade Marks Act 1938 which is five years old. At the time of registration, you advised the client that the mark should be re-registered on the basis of use for Part A registration in due course. What is your advice today and why?  
(5 marks)
4. Your clients wish to register the trade mark **SATISFACTION GUARANTEED** (words) for second-hand cars because they have heard that "anything can be registered under the new Act". What is your advice and why?  
(5 marks)
5. How is a "trade mark" defined in the Trade Marks Act 1994?  
(5 marks)

6. Your client, a famous pop star, wishes to register her name as a trade mark for various consumer goods. She does not trade at all. Will this invalidate proposed applications and if so, why?

(5 marks)

7. Your client registered the trade mark SUPABORE in respect of electric hammers and drills. Use of the trade mark on the goods has been so substantial that now, everyone refers to electric hammers and drills as SUPABORES. Is your client right to be delighted? Advise.

(5 marks)

8. Write brief answers to the following:-

(1) Your client's registration has been on the register for four years and nine months. The trade mark has not been used to date but your client is making preparations to do so now. Will this foil an attack for non-use?

Would your answer to (1) be different if the trade mark being used is similar but not identical to the registered trade mark and why?

(5 marks)

9. What provisions are there for famous marks under the Trade Marks Act 1994 and can a proprietor's conduct endanger those rights?

(5 marks)

**PART B**

10. Your large US film company client wishes to use its new trade mark in the United Kingdom on videos and associated goods. The film from which the trade mark has been taken is a box office success in the USA and is due for release in the United Kingdom in the next few months. Your client filed its first application in the USA five and a half months ago.

There is a problem. Your trade mark search at the Trade Marks Registry revealed a pending application for an identical trade mark for identical goods filed several months ago. Your client advises you that the applicants are "cowboys" and are trying to cash in on your client's success, and that they have not yet used the trade mark.

Restricting your answer to any possible action before the Trade Marks Registry, advise your client.

(12 marks)

11. Your client has been using the trade mark **BUNNY** on clothing for women for the past twenty years in Northern Ireland only. Your client now wishes to register the trade mark. You search the register and find a registration for **BUNNY** for exactly the same goods dated 1985. Investigations reveal that the registered trade mark is in use in mainland Britain and you also establish that it has not been used prior to 1985. Advise your client.

(12 marks)

12. Your client registered the trade mark **BEAUTYHOUSE** in 1961 on the basis of use in respect of "periodical publications". The registration is in force. Five and a half years ago your client ceased publication for various reasons. Your client now wishes to relaunch **BEAUTYHOUSE** magazine in six months' time and is very concerned that there could be problems with third parties which could wreck the relaunch. Advise your client.

(12 marks)

13. Your client's parent company registered the trade mark **HEREWARD** (word) in Class 12 in respect of "vehicles, motor land vehicles and parts and fittings therefor". The trade mark has been in substantial use for many years but the parent company has never used the trade mark and all use has been by your client.

Your client now wishes to extend use to "fire" (classified in Class 9). Your client has heard that use should be recorded as a registered user under 1938 Trade Marks Act and wonders whether recordal should be effected now.

Advise your client if:-

- (1) it needs to be recorded as a licensee and
- (2) it has adequate protection in the present registration to cover fire engines.

(12 marks)

14. Your client Optimax Limited registered the trade mark **FLAMEGARD** in Part B of the register some years ago. The trade mark is registered in Class 2 for paints etc and in Class 17 for insulating paint. There are two lines of product on sale: one is a domestic line with fire retardant properties and the other is for industrial use as a heat insulating product. The products are sold in white cans with devices of wavy flames in red thereon encircling the trade mark **FLAMEGARD** which is in black. Your client's product is very well-known in both the domestic and industrial field and has been advertised and promoted extensively.

Last week, your client sent you a just-published advertisement for fire doors under the trade mark **FLAMEGARD** by a company called F. Limited. This is a completely new product and F. Limited is a newly-registered company. Your client advises you that the adoption of **FLAMEGARD** for fire doors must be more than a coincidence because the trade mark is portrayed in the exact same way as that of your client's with the same colours etc. Advise your client, ignoring any question of copyright.

(12 marks)

15. You hear from your client after many years that you registered the trade mark PORKY on its behalf for "hair care preparations" in Class 3 four years ago. The client has not used its trade mark yet but intends doing so very soon.

Your client now tells you that a perfume company commenced using the identical trade mark in mid-October 1994 on "perfumes and body lotions". Use by this other company was very low-key and the goods seem to have been sold only in Selfridges. No advertising has taken place. As your client is in the hair care field only, it was not that concerned at the time.

Now, this perfume company is going nationwide, not only with "perfumes and body lotions" but also the exact goods of interest to your client "hair care preparations". Advise your client.

(12 marks)