

THE JOINT EXAMINATION BOARD

PAPER T4

ADVANCED UNITED KINGDOM TRADE MARK PRACTICE

Tuesday, 14th November 1995

10.00 a.m. - 2.00 p.m.

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

1. You should attempt question **1** (40 marks) and no more than **three** of the remaining four questions (20 marks each).
2. The number of marks allotted to each question is shown 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 (T4), the question number and your examination number. You should write only on one side of the paper using **BLACK** ink. Please do **NOT** staple pages together. You should **NOT** write your name anywhere in the answers.
6. Unless specifically requested, answers are **NOT** required in letter form.
7. **NO** printed matter or other written material may be taken into the examination room.
8. Answers **MUST** be legible. If the examiners cannot read a candidate's answer then no marks will be awarded.

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1. You act for the Maestro group of companies which makes a wide range of office and shop furniture and equipment. Your clients products are sold throughout the United Kingdom by independent retailers which specialise exclusively in the office and shop fittings market, including high street shops as well as out-of-town hypermarkets.

In a letter dated 6 November 1995 your clients give you the following instructions:-

- A. "We have designed a new range of office furniture comprising pine-finish desks, shelving, bookcases and filing cabinets which we want to market under the trade mark ASPECT. Please will you carry out a clearance search in the usual way and let us know as soon as possible if we are free to use and register this name. Incidentally, there is a US company called Aspect Telecommunications which makes a range of office telephone equipment. Although the ASPECT equipment of that company is virtually unknown in this country, it is extremely well known in North America, and in fact a UK distributor was appointed by them at the beginning of 1993 to promote their products over here. Our products are quite different from Aspect's, but we would nevertheless appreciate your advice as to whether their use of the name is likely to be a problem for us.
- B. "In addition, on carrying out a review of the group's trade mark position it has come to our attention that we have not registered the name KONCEPT, even though we have made extensive use of this mark since 1 September 1988 in relation to a range of full-height office partitions in a finished form, which can be fixed in place by builders to make semi-permanent rooms in open-plan office areas. We would be grateful if you would kindly let us know what is our legal position in relation to this trade mark and whether we can still register it.
- C. "Lastly, one of our equipment companies has developed a new electrically operated actuator for use with automatic shop doors. The device includes an infra-red sensor that detects when a person is in the vicinity of the door and a controller which can be connected to the door opening/closing mechanism. Apparently the clever part of our new device is that the sensor is more "discerning" than previous sensors and only triggers the door when someone is actually heading towards the door, rather than simply when someone is moving in the area of the door. Marketing want to adopt the name REFLEX for this new system, so please

search and advise on this trade mark as well. Also we would appreciate your brief advice if there are any other steps we should be taking to protect this

You carry out full availability searches on the marks ASPECT, KONCEPT and REFLEX; the results are set out below. Write a letter to your clients advising them on the availability of these marks for use and registration in the UK, and also addressing the other points raised in their letter. Give reasons for your conclusions.

(40 marks)

A. "ASPECT" Search Report

Number Status Date	Mark	Class	Owner	Specification
1209139 Renewed registration 15 December 1983	ASPECT	9	Microft Technology Limited	Electrical and electronic apparatus and instruments, all for the input, storage, processing and transmission of data; computers.
1525721 Unpublished application 3 February 1993	ASPECT CALLCENTER	9	Aspect Telecommunications Inc.	Telecommunications installations; call management and call monitoring apparatus; computer hardware and computer software.
1525722 Unpublished application 3 February 1993	ASPECT	9	Aspect Telecommunications Inc.	ditto
972004 Renewed registration 8 March 1971	PERSPECTIVE	20	Asprey Plc.	Antique and reproduction furniture; picture frames; jewel cases not of precious metal or coated therewith; hampers.
756434 - Defensive Renewed registration 8 August 1956	ASPRO	20	Roche Nicholas Limited	Corks; stoppers and closures, all for containers.
1472041 Registration 31 July 1991	ASPENS	20	W. McLroy Swindon	Sleeping bags, pillows, cushions, bean bags, Moses baskets, high chairs and baby nests.
B1353245 Registration 2 August 1988	ELECT	20	Open Plan Limited	Office furniture; screens; partitioning and storage units.

1240361 Renewed registration 23 April 1985	ASPIRATIONS	20	Grattan Limited	Furniture; mirrors, boxes, baskets and planters; protective covers for clothes, trouser hangers; shelving for wardrobes, racks for shoes or belts.
1301257 Registration 18 February 1987	SPECTRA	20	Hygena Limited	Plate racks; vegetable racks; saucepan stands; spice racks.
1195720 Registration 11 May 1983	SPECTRA	20	Hille Executive Furniture Limited	Office chairs; seating (furniture) for arenas and for auditoriums.

B. "KONCEPT" Search Report

Number Status Date	Mark	Class	Owner	Specification
1097677 Renewed registration 24 June 1978	THE CONCEPT FOLIO	20	Art Leather manufacturing Co. Inc.	Picture frames and mirrors included in Class 20.
B1105655 Renewed registration 1 December 1978	CONCEPT FOR COMFORT	20	Silentnight Limited	Beds; sofa-beds; mattresses; pillows.
1391640 Registration 31 July 1989	CONCERTO	6	Concerto Safety Barriers Limited	Fences, barriers, rails, post stiles and gates; parts and fittings for all the aforesaid goods; all being made of metal.
B784258 Renewed registration 21 November 1958	CONCEPT	19	Myers Timber Building Products Limited	Hardwood, plywood, chipboard and particle-board; timber for building; sawn timber; preserved wood.
B1506366 Registration 13 July 1992	TOTAL CONCEPT	20	Century Office Supplies Limited	Free-standing office screens and parts and fittings therefor.

Number Status Date	Mark	Class	Owner	Specification
1302011 Renewed registration 25 February 1987	SEPTRE	20	AJ Produkter i Hyltebruk AB	Office and factory furniture; trolleys; tables; stands; containers; chairs; racks; cabinets; cupboards; shelves; workbenches; doors; parts and fittings for all the aforesaid goods.
1559301 Unpublished application 15 January 1994	KEMCON	19	Erwin Muller GmbH	Concrete; concrete compositions; sprayable concrete compositions.
B942039 Renewed registration 1 May 1969	CONCEPT	19	Myers Building Products Limited	Doors; door frames; windows; window frames; mouldings; parts and fittings for all the above goods.
1124318 Renewed registration 21 November 1979	JONCAP	20	Possum Controls Limited	Furniture; chairs, tables, desks, beds, beanbags, cushions, play furniture; articles of wood or plastics; parts and fittings for the aforesaid goods.

C. "REFLEX" Search Report

Number Status Date	Mark	Class	Owner	Specification
1468942 Registration 29 June 1991	REFLEKS	9	Scientific Measuring Limited	Ultrasonic measuring apparatus and instruments; parts and fittings for all the aforesaid goods.
2006130 Unpublished application 30 December 1994	REFLEX	9 & 37	Greenshire NV	9: Security apparatus and equipment; closed circuit television equipment; security cameras and monitors. 37: Installation, repair and maintenance of security apparatus and equipment.
B1389129 Registration 3 July 1989	REELAFLEX	9	Metreel (Nottingham) Limited	Flexible electric cables; parts and fittings therefor.

Number Status Date	Mark	Class	Owner	Specification
1567630 Registration 3 March 1995	PYROFLEX	9	Lawrence Pie	Temperature sensors, apparatus for detecting temperature changes.
1237239 Renewed registration 6 March 1985	DEFLEX	6	P. Schulte-Stemmerk GmbH	Glazing and sealing profiles, all for window or doors; all made wholly or principally of common metal.
B1262084 Renewed registration 7 March 1986	FLEXER	6	Airax SA	Springs; pistons, cylinders, damping apparatus and door openers, all being pneumatic; shock absorbers.
B1218368 Renewed registration 10 May 1984	SEEFLEX	9	Seetru Limited	Liquid level reflex gauges.
1464333 Registration 16 May 1991	SEEPLEX	9	Christopher Hall	Electronic video multiplexer.

2. The principal business of your clients, Faversham Breweries Limited of 31
Lane, Faversham, Kent ME10 4AA, is as manufacturers and merchants of re
Your clients' beers are sold throughout the U.K. under the mark SELDON COLLY.

In 1950, Faversham Breweries acquired the business and trade marks of a Maidstone distillery, Thomas M^oGillivray & Sons, who made and sold in the South-East since 1876 a well known range of spirits and liqueurs, including cherry brandy and sloe gin, which were all sold under the M^oGILLIVRAY'S mark. Details of the trade mark registrations assigned to your clients as a result of this acquisition are set out below; the assignments were duly recorded in the Registry. Over the years your clients have gradually phased out production of all the spirits and liqueurs products, with the exception of cherry brandy which continues to be sold, albeit on a small scale, under the mark. Although your clients' business in M^oGILLIVRAY'S cherry brandy is very much a side-line next to their beers, it always turns a modest profit each year, and consequently your clients consider it to be a valuable "niche" product. In fact at a recent meeting, your clients advised you that they have plans for expanding production of M^oGILLIVRAY'S cherry brandy for nationwide distribution and export.

Yesterday, 13 November 1995, you received the following fax from Faversham Breweries:-

"About a month ago we received a letter from James McGillivray & Sons of Castle Industrial Estate, Edinburgh EH15 7GU who make and sell a brand of scotch whisky under the mark M^oGILLIVRAY'S. Apparently they now wish to sell vodka and gin under the M^oGILLIVRAY'S brand, and as they only have the trade mark M^oGILLIVRAY'S registered in respect of scotch whisky they have expressed an interest in acquiring our registrations of this mark. We discussed this matter at our Board Meeting last week, and it was proposed that we would sell to M^oGillivrays all our registrations of the mark, except those which cover cherry brandy. We would naturally want to make sure that following the transfer, M^oGillivrays could not use the registrations against our use of the mark on cherry brandy.

"Please prepare a draft assignment for our review. For your information we propose to ask M^oGillivrays for the sum of £90,000 in consideration for the registrations. M^oGillivrays have said that they would prefer the assignment to include the goodwill of the business under the marks. Please let us know what this means, and advise as to whether the sale should be with or without the 'goodwill'."

Your records show that, on registration, all of your clients' M^oGILLIVRAY'S marks were associated with one another.

THOMAS M'GILLIVRAY & SONS'S TRADE MARK REGISTRATIONS				
Number	Mark	Class	Date	Specification
7383	M'GILLIVRAY'S (word and device)	43 Sched. III	29 June 1876	Spirits, not including whisky.
546685	INVICTAMINT M'GILLIVRAY'S (word and device)	43 Sched. III	1 December 1933	Crème de menthe.
B546686	M'GILLIVRAY'S GINGER BRANDY (word and device)	43 Sched. III	1 December 1933	Ginger brandy, but not including ginger brandy for sale in Wales, Scotland and Northern Ireland.
B546687	M'GILLIVRAY'S SLOE GIN (word and device)	43 Sched. III	1 December 1933	Sloe gin, but not including sloe gin for sale in Wales, Scotland and Northern Ireland.
550771	M'GILLIVRAY'S (word only)	43 Sched. III	30 April 1934	Cherry brandy (being a liqueur) but not including cherry brandy for sale in Northern Ireland.
606970	M'GILLIVRAY'S CHERRY BRANDY (word and device)	33	25 May 1939	Cherry brandy (being a liqueur) but not including cherry brandy for sale in Northern Ireland.
799766	M'GILLIVRAY'S MORELLA CHERRY BRANDY	33	31 December 1959	Cherry brandy.

Make notes setting out your advice on the goodwill point raised by your clients, and also on their proposals. Give reasons in support of your advice. Explain the procedure under the Trade Marks Act 1994 for registering an Assignment, and draft a suitable Assignment for your clients.

(20 marks)

3. You act on behalf of Bonanza Pty. Ltd., an Australian company, whose business outside Australia is conducted through a network of Franchisees. Your client publishes magazines which are distributed free of charge to students; your client's business is the sale of advertising space in these magazines. Bonanza Pty. Ltd. also prepare trial sample packs of its customers' new products which are distributed to students in the same way as the magazines. Your client's business activities are carried out under two unregistered trade marks which appear on the magazines and sample packs, and also on your client's paperwork - letterhead, invoices, mock-ups and sales literature - ; these trade marks are the word mark BONANZA and a SHIP logo.

Your client's UK Franchisee was appointed ten years ago under a Franchise Agreement which your client tells you contained detailed instructions on how the business was to be carried out, copies of the BONANZA and SHIP trade marks, billing methods etc., so as to ensure uniformity with your client's other Franchisees in other countries. This Agreement is apparently about to expire, and whilst the Franchisee has operated continuously throughout the term, the business has not been very successful recently, and your client would like to appoint a new Franchisee.

You learn from your client that although the Franchise Agreement provided for Quality Control of the Franchisee's activities, your client has not exercised this control for at least the last seven years. Furthermore the UK business has been carried out solely in the name of the Franchisee, with no marking on the magazines, sample packs or paperwork to indicate any connection with your client.

On 4th January 1995 you filed on behalf on Bonanza Pty. Ltd. two Trade Mark Applications for registration of the BONANZA and SHIP logo trade marks in the UK; each of the applications was filed in respect of printed matter in Class 16 and advertising services; placing, dissemination, and distribution of advertisements and distribution of samples in Class 35.

You have just received the Examination Reports issued on your client's Applications in which the Registry has cited two earlier Applications for the identical marks and for the same goods and services; the cited Applications were filed on 10th November 1994 in the name of your client's UK Franchisee and are still pending.

In a letter, report the contents of the Examination Reports, and advise your client of its trade mark position, addressing in particular whether your client can prevent its existing Franchisee from obtaining Registrations for the BONANZA and SHIP logo trade marks, whether your client can prevent the Franchisee from using the trade marks, and whether your client is free to use the trade marks through a new Franchisee in the UK, noting what additional information, if any, you need. Let your client have your recommendations as to what steps it might take next and why.

(20 marks)

4. Your clients, Vikram Group Plc of 173 Brompton Road, London SW3 4JJ, the trade mark VIKRAM in the United Kingdom and abroad for decades in relation to designer clothing and accessories for women. As a result of your clients' use of the mark and the high profile market position of their goods, VIKRAM has become an internationally famous trade mark. During the last ten years your clients have actively sought to diversify their business activities, and in particular now apply the VIKRAM brand in the UK to "top of the range" leather luggage, costume jewellery and perfume. Vikram Group Plc have been diligent in registering their trade marks, and details of their registrations of VIKRAM in the UK are set out below. As part of the ongoing policy of diversification, your clients have recently started to use and register VIKRAM abroad in relation to an exclusive range of stainless steel, non-electric pressure cookers of the kind which are used on hotplates; your clients tell you that they would like to introduce these goods onto the UK market in the next couple of years.

You bring to your clients' attention the following entry in the Trade Marks Journal which was published on 1st November 1995:-

2001700 7 November 1994 (11)

VIKRAM

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Vikram Products BV, Willemstraat 43, Den Haag, The Netherlands.

Enquiries reveal that in the UK Vikram Products BV have used the trade mark VIKRAM since September 1994 and that such use has only been in relation to lighting apparatus for industrial premises.

Schedule of VIKRAM Registrations in the UK in name of Vikram Group Plc

<u>Number</u>	<u>Mark</u>	<u>Date</u>	<u>Specification</u>
740300	VIKRAM	1 March 1956	Articles of clothing included in Class 25.
1053920	VIKRAM	23 October 1975	Footwear; shoes, boots and sandals; belts; headgear and hats; all being goods in Class 25.
1300101	VIKRAM	10 January 1987	Travelling bags and cases; trunks; suitcases; hat boxes; handbags; purses; all made wholly or substantially of leather; all included in Class 18.
1361000	VIKRAM	30 November 1988	Jewellery and costume jewellery; all included in Class 14.
1515432	VIKRAM	14 October 1992	Perfumery and toilet water; soap; talcum powder; all included in Class 3.

Your task is to draft a Notice of Opposition to Application No. 2001700, and in your draft Notice to discuss and assess each of the grounds raised in the draft Notice, giving an indication of your clients' chances of success under each ground. You should also discuss whether your clients are free to use their mark in the UK in relation to the pressure cookers as proposed, and what further steps your clients might consider taking.

(20 marks)

5. You act for Television Communications Limited who carry on business as sole agents in buying, selling, distributing and promoting sales of television and radio programmes in the sports entertainment field; your clients act between programme in the UK and abroad and broadcasters such as the BBC, independent broadcasting networks and satellite and cable companies. Since November 1991 your clients have used the trade mark FUTUR SPORTS INTERNATIONAL in relation to the sale, acquisition and distribution of sports and sports-related television programmes. Your clients also have plans eventually to use the mark on posters and postcards of famous sporting personalities in the way of merchandising.

On 6th February 1995 you filed on behalf of your clients Trade Mark Application No. 2005007 for the mark FUTUR SPORTS INTERNATIONAL in respect of the following goods and services, namely:-

Class 16:	Posters and postcards.
Class 35:	Promotional and marketing services; sales promotion; buying and procurement of goods on behalf of businesses; sales and acquisition of programmes.
Class 41:	Entertainment services; distribution of television programmes.

You have now received an official letter from the Registry enclosing the Examination Report on this Application; the Report is reproduced below.

In a letter, report the official letter to your clients, providing them with your opinion on the objections raised, whether and how they can be overcome and what additional information you require from your clients to prepare and file a full response.

(20 marks)

EXAMINATION REPORT

The result of the examination of Application No. 2005007 in Classes 16, 35 and 41 under the Trade Marks Act 1994 is as follows.

ACCEPTABILITY (Section 3.1)

The mark is not acceptable because there is an objection under Section 3(1)(b) of the Act because the mark consists of the phonetic equivalent of the word FUTURE and the words SPORTS and INTERNATIONAL, being devoid of any distinctive character in relation for example to promotional and marketing services relating to international sports provided by a forward-looking or innovative business.

ACCEPTABILITY (Section 3.3)

The mark is not acceptable because there is an objection under Section 3(3)(b) of the Act because the mark contains the word SPORTS being of such a nature as to deceive the public as to the nature of the services, for example the mark would be deceptive if used in relation to promotional services which are not related to sports. A more limited specification of goods may enable this objection to be waived.

RESULT OF SEARCH FOR CONFLICTING MARKS (Section 5)

The following earlier mark No. 884433 is considered to conflict with items in Classes 35 and 41 of your application and is therefore cited under Section 5 of the Act.

The following earlier mark No. 1244466 is considered to conflict with items in Class 41 of your application and is therefore cited under Section 5 of the Act.

The following earlier mark No. 2000636 is considered to conflict with items in Class 41 of your application and is therefore cited under Section 5 of the Act.

No. 884433	-	Registered
No.1244466	}	Pending
No. 2000636		

Further details of these marks can be found below.

Your attention is drawn to the fact that any citation raised under Section 5 may be overcome by filing the consent of the proprietor of the cited mark(s).

Section 5 may be overcome by dividing off into separate applications the goods/services which conflict with those of the cited mark. The Section 5 objection may then be waived against the current application. Each request to divide must be accompanied by a Form TM12, together with the relevant divisional fee.

SPECIFICATION OF SERVICES

The specification for Class 41 is so wide that there appears to be some doubt about the applicant's intention to use the mark on the services listed. This objection is in respect of "entertainment services". Section 3(6) of the Act refers. The range of services should

therefore be restricted, or evidence put forward to show that the applicant is trading in the full range of services specified in the specification with a bona fide intention to do so.

It is the Registrar's view that the Class 35 specification should be reworded to read as below. Please note that it is in the applicant's interest to ensure that the proposed amendment covers the range of services required:

Promotional and marketing services; sales promotion; buying and procurement of goods on behalf of businesses; acquisition of programmes on behalf of businesses.

END OF EXAMINATION REPORT

DETAILS OF CITED MARKS

Number	Mark	Class	Proprietor	Filing Date	Goods/Services
884433*	FUTURE	9	Computeroptics Corporation	27/01/1983	Computer software; audio and video recordings; computers; optical apparatus and instruments; magnetic tapes; parts and fittings for all the aforesaid goods; all included in Class 9.
1244466 Pending	INTERSPORTS	41	The Sports Council	27/07/1989	Sports entertainment services; sporting activities.
2000636 Pending	SPORTS OF THE FUTURE	41	TV Network, Inc.	21/11/1994	All services in Class 41.
* Advertised before acceptance under Section 18(1) proviso					