

**THE JOINT EXAMINATION BOARD
PAPER T4**

ADVANCED UNITED KINGDOM TRADE MARK PRACTICE

**Wednesday 20th November 1996
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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THE JOINT EXAMINATION BOARD**PAPER T4****ADVANCED UNITED KINGDOM TRADE MARK PRACTICE****Question 1**

You act for South East Queens Hospital for Alzheimer's Disease Limited, known internally as SEQUAL, which is the licensing and fund raising arm of a hospital which specialises in the prevention, treatment and research of Alzheimer's Disease. On 6th November 1996, your clients wrote the following letter to you:

Dear Sir,

You are aware that for a number of years we have been using the names of nursery rhyme characters on products sold in the Hospital shop and in approved outlets outside the Hospital. About 2½ years ago during the Summer of 1994, we introduced the brand YANKEE DOODLE on various confectionery products which have an American theme, such as American chocolate and ice cream. It has turned out to be one of our most popular and consequently most important brands. It has come to the attention of one of our licensees that the U.K. company Cagney Foods Limited is marketing a medicated candy bar under the trade mark YANKEE DOODLE and, in fact, further enquiries have shown that the YANKEE DOODLE candy bar has been on the U.K. market for many years. We also know that H. J. Heinz used to have an interest in the trade mark YANKEE DOODLE but that they dropped the mark some three years ago. We are sure that Cagney Foods Limited cannot prevent us from continuing to use YANKEE DOODLE because we are a charity. Would you please confirm that this is the case? Also, we would like to register the trade mark YANKEE DOODLE for confectionery foodstuffs in class 30. Would you please conduct a search to check that there are no problems with this.

We are about to extend our licensing activities into the financial sector. We wish to use the name SEQUAL on credit cards. This will be a promotion with credit card companies which will issue their own credit cards bearing our name SEQUAL, as well as the trade marks of the credit card companies. The customer will know that a SEQUAL credit card means that the credit card company has made a donation to our Hospital when the card was issued and that a small percentage of every sale made using the card will go to the Hospital. Would you please conduct a search for SEQUAL and let us know if we are free to use the name for financial services. As we are a charity and we will not ourselves be issuing the credit cards. In very brief terms, would you advise that we register the trade mark and, if so, for which services?

Finally, we would like to use and register SEQS, which takes the first three letters of SEQUAL, to promote the Hospital's research business into the different effects of Alzheimer's Disease on men and women and to promote related merchandising activities. However, we do have a concern about this because we are aware of the multi-national retailing group SEQ Kabushiki Kaisha based in Japan which is very well known both abroad and in this country for the sort of goods normally sold in its department stores such as household containers, clothing, furniture, etc. There have been many SEQ stores throughout the United Kingdom for about the last 10 years or so. Would you please conduct a search for the trade mark SEQS and let us know whether SEQ Kabushiki Kaisha have grounds to prevent our proposed use of SEQS.

We look forward to hearing from you.

Yours faithfully,

You conduct full availability searches of the marks YANKEE DOODLE, SEQUAL and SEQS and the results are b
Write a letter to your clients advising them on the availability of the marks for use and registration in the United
Kingdom and addressing any other points raised by your clients. Give reasons for your conclusions.

(You may assume that the relevant Madrid Protocol and Community Trade Mark Registers have been searched.)

40 marks

YANKEE DOODLE Search Report

Mark	Number	Proprietor	Class	Goods/ Services	Status	Before	Date
YANKEE DOODLE	1537634	Cagney Foods, Inc.	5	Infants' and invalids' foods and dietetic foods; medicated confectionery; medicated beverages.	Registered [Advertised Acceptance Section 12(2).]	05/06/1993	
YANKEE DOODLE	2005229	Cagney Foods, Inc.	42	Restaurants, cafe and bar services; ice cream parlour services	An unpublished application.	23/12/1994	
YANKEE NOODLE	969999	H. J. Heinz Co. Ltd.	30	Noodles; pasta; spaghetti; macaroni; prepared snacks containing all the aforesaid goods.	Renewed registration	13/01/1971	
YANKEE DOODLE	1030556	H.J. Heinz Co. Ltd.	30	Ice cream, ice cream confections, water ices and frozen confections.	Renewed registration	06/06/1974	
DODDLE	1227406	Unimerchants Ltd	30	Cereals, pulses, spices, flour mixes.	Renewed registration	19/09/1984	
SWANKY YANKEE	2003589	Golden Fare Group Limited	30	Coffee, mixtures of coffee essences and coffee extracts.	Registered	22/11/1994	
MANKY POODLE	1129562	RHM Foods Limited	30	All goods in class 30.	Renewed Registration	29/02/1980	
AMERICAN DOODLE FROM YANKEE LAND	2005990	Panda Beverages, Inc.	32	Fruit Juices	Unpublished application	17/12/1994	
YANKEE DOODLE DANDY	2007733	Panda Beverages, Inc.	29	Preserves, jams and marmalades.	Unpublished application	14/01/1995	
YANKEE DOODLE	859221	Walls Limited	30	Confectionery, biscuits and ices Non alcoholic drinks and preparations for making all the aforesaid goods. Ice cream confectionery.	Lapsed registration	22/1/1964	

SEQUAL Search Report

Mark	Number	Proprietor	Class	Goods/Services	Status	Date
CEKAL	1273039	Financial Life of Scotland Plc	36	Insurance and financial services.	Renewed Registration	01/10/1986
SEQUELLE	1305083	Lasag AG	9	Computer software for use in accountancy.	Renewed registration	23/03/1987
SEQUEL	1047699	Hawker Siddeley Engineering Ltd	9	Electrical and electronic apparatus for measuring, signalling and checking (supervision)	Renewed registration	06/06/1975
EQUAL	1555029	The BST Group Plc	36	Banking services.	Registered (Advertised before acceptance. Section 18(1) proviso)	27/11/1993
SEQUA	1165545	ESTS B.V.	9	Encoded and magnetic cards, all for use in personnel access control	Renewed registration	27/11/1981
SEQUA	1165546	ESTS B.V.	16	Identity cards made of plastic; security cards.	Renewed Registration	27/11/1981
SEQUOIA	1165723	Microdata UK	9	Computers and computer programs.	Renewed registration	01/12/1981

SEQS Search Report

Mark	Number	Proprietor	Class	Goods/Services	Status	Date
S.E.K.	2021522	Sek AB	42	Research and development of gene therapy scientific and medical research.	Unpublished application	09/05/1995
SECK	1309029	Takata Co., Ltd	42	Hospital and health clinic services.	Renewed registration	05/05/1987
SIKH	1474214	Raj & Raj International Limited	42	Convalescent home services; retirement home services.	Registered	17/08/1991
CEC	1539808	Ian John Smith	10	Surgical and medical apparatus and instruments; parts and fittings for all the aforesaid goods.	Registered	07/06/1993
SEQUS	1438040	National Association for Cancer Research Ltd	42	Cancer research services.	Registered	17/08/1990
SEQES	1462933	National Association for Cancer Research Ltd	42	Hospital services; counselling services.	Registered	29/04/1991
SEQAS	1494532	National Association for Cancer Research Ltd	42	Cancer research services.	Registered	17/03/1992

Question 2

At the beginning of April of this year your client, Functional Foods Limited, launched a low fat margarine. Its composition has a positive effect on consumers health. Specifically, its unique fish oil base results in a lower cholesterol level with resultant benefits for the heart.

Your client has chosen to market the product in a manner which reflects its key selling points. They have used a fish shaped tub and prior to launch you filed an application for design registration on your client's behalf which is now registered. The product was introduced with a significant advertising campaign on national television and in the press, and initial sales have been encouraging.

However, shortly after the product launch your client received a letter from trade mark attorneys acting for First Design Limited. This letter draws attention to a trade mark application filed on the 1st July 1996 under No 2104499 to protect the three dimensional features of a fish shaped container for a specification covering "edible oils and edible fats in class 29". The mark will imminently be advertised in the Trade Marks Journal. Investigations into First Design show them to be a design and advertising consultancy. A search of the Register also reveals a later application by First Design for the fish shaped tub in Class 20 covering plastic containers. The freedom to use the container shape is of over riding importance to your client. Your client instructs you to file opposition.

Draft a statement of grounds to accompany a notice of opposition. Prepare a letter to your client attaching the statement of grounds and discussing briefly the merits of your client's case and advising on what other steps might be taken.

(20 Marks)

Question 3.

Your client, World Wide Brands Limited, has since early 1992 manufactured and sold a range of hair shampoos and conditioners by reference to the trade mark NATURES WAY.

The product is sold in an aesthetically appealing container incorporating a flower shaped cap. The surface of the container is coloured yellow.

Your client has been using the colour yellow on hair shampoos and conditioners for in excess of 15 years. Your client also informs you that they have plans to expand into other hair care products under the Trade Mark NATURES WAY

Sales of goods within the range have been significant and have been supported by a high profile promotional campaign, including peak time television advertising. Your client approaches you for advice upon becoming aware of the launch by a leading supermarket chain, Lo-Price, of a hair care range which includes shampoos and conditioners, sold in a container resembling that used by your client for its NATURES WAY range. It also incorporates a cap in the shape of a flower, which again somewhat resembles your client's own flower shaped closure. The surface of the product is coloured yellow, albeit a somewhat different shade from that used by World Wide Brands. The goods are affixed prominently with the trade mark BIOLIFE and underneath the legend "the low price hair care range, for healthy hair natures way".

The trade mark BIOLIFE and the aforesaid legend are also affixed to other products in the range, namely a styling gel and mousse. The styling gel and mousse are sold in different containers.

Your client advises you that it has no registered design protection. The trade mark NATURES WAY is however registered, although it was necessary for your client to demonstrate prior use to secure registration and the specification is restricted to "hair shampoos and conditioners".

Your client wishes to bring about a discontinuance of the sale of hair care products by Lo-Price under the format described above.

What causes of action are available to your client now and what action can your clients take to improve their position in the future? In note form, discuss these points and comment on any difficulties that may arise.

(20 Marks)

Question 4

Your client, Jane Smith, of Beagle Farm, Under Hill, Warwickshire, has established a loosely knit group of traders who each have a farm shop. Jane Smith's farm shop trades under the name BEAGLE FARM. The shops sell farm produce in particular: fruit, vegetables, eggs, dairy foods and meats. Some also sell such items as seed potatoes, tomato seedlings and seeds for customers to grow their own produce. The shops each bear the same mark, i.e. the device of a beagle's head with the word EAGER over the top and the words TO PLEASE underneath. However, the name BEAGLE FARM is used only in relation to Jane Smith's farm shop.

Each shop is independently owned, but the traders work together to form a kind of co-operative. The group has been trading in this way for about twenty years and traders have been joining and leaving it from time to time. There are currently about thirty shops spread all over the Midlands. Each has adopted the same colour scheme of shades of green and has similar trade dress and get up.

The group is ostensibly democratically run, and your client chairs the meetings of the farm shop owners. However, she has considerable influence over the decision making of the group and usually has the final say in any dispute, especially when this involves a potential new member of the group.

Another local farmer, Joe Brown, has recently set up a garden centre at a site about five miles from your clients' shop and on the same A class road. Mr Brown sells plants, seeds, bulbs, trees and the like, garden ornaments and tools, garden sheds and everything needed to set up and stock a garden pond. He trades under the name BEAGLES chosen because of the historical link of the site with a local pack of hounds used for fox hunting. He also uses a device of a pack of hounds. Each department of his garden centre is got up in a different shade of green.

Jane Smith is becoming increasingly annoyed by comments from her customers, from which it is obvious that they have assumed that Mr Brown's business is connected with the co-operative.

In a letter, advise your client as to how she can protect the trade mark(s), what can be done about Mr Brown's activities and how successful such action is likely to be if your advice is followed.

(20 Marks)

Question 5

Your clients Cheetah UK Limited are the proprietors of the trade mark CHEETAH which they have used for about four years in relation to a lap top computer although they have not registered the mark. A few months ago the Lafarge Formula 1 motor racing team bought several of these computers from your clients and now use these to assist with the development of their racing cars. Lafarge has agreed to endorse your clients' product.

On the basis of this your clients have recently advertised in the National Daily newspaper along the following lines of the accompanying advertisement.

Your clients have subsequently received a letter from Cheetah plc in terms of the attached:

You may assume that the mark CHEETAH is well known internationally for high quality cars produced and sold by Cheetah plc, and that their cheetah device is also well known in the UK.

Write a letter to your clients advising them of the steps they should now take, the merits of their case, and the problems which may arise. Include a draft response to Cheetah plc.

(20 Marks)

ADVERTISEMENT

Lap Times Count!

That is why Lafarge Formula 1 chose the Cheetah in their search for excellence when race tuning their vehicles.

The most advanced computer available, the CHEETAH offers an unbeatable combination of speed, versatility and upgradability - it is a Formula 1 Grand Prix world beater!

CHEETAH - IT suppliers for Lafarge Formula 1 team

The promotion goes on to extol the virtues of the CHEETAH ZJ600 in detail and finishes with the statement:

"In addition to the excellent performance, the comprehensive multi-media features combined with the excellent display features provide the ideal presentation tool".

David Collins, Production Manager
Lafarge Formula Grand Prix Racing Team



Letter from CHEETAH plc

Dear Sirs

TRADE MARK : CHEETAH and others

We are the proprietors of the following Registered Trade Marks, inter alia

No. : CHEETAH : Class 12 : motor vehicles
filed in October 1923 and in force.

No. : CHEETAH device : Class 12 : motor vehicles
filed in October 1923 and in force.



No. : CHEETAH : Class 42 : engineering design and
consultancy services for internal combustion
engines, and vehicles filed in October 1986 and
in force.

No. : CHEETAH device : Class 42 : engineering design
and consultancy services for internal combustion
engines, and vehicles filed in October 1986 and in
force.



No. : CHEETAH : Class 35 : promotion and advertising
services, filed October 1986 and in force.

No. : CHEETAH device : Class 35 : promotion and
advertising services, filed October 1986 and
in force.



The trade marks CHEETAH, and the device of a cheetah are famous marks throughout the world having been used and promoted on a very substantial scale.

Your advertisement in the National Daily newspaper headed 'Lap Times Count' has come to our attention. Your use of the word and device marks CHEETAH, infringes our registered marks detailed above and/or constitutes passing off, both of which are actionable in the High Court. The lines used in your device mark emulate those in our device mark and add to the likelihood of confusion and deception and/or the risk of association between our respective businesses.

We insist that you immediately cease and desist use of the marks CHEETAH, and the device of a car, in relation to lap top computers, and give us an undertaking that

- (i) you will not henceforth use or seek to register these trade marks for any goods or services;
- (ii) you will immediately withdraw all promotional or advertising material bearing these marks from public circulation;
- (iii) you will immediately change the name of your company to one which does not include the word CHEETAH or anything confusingly similar thereto;
- (iv) you will deliver up, obliterate or destroy (under oath) all references to these marks on or in connection with your products and/or services; and
- (v) you will supply us with a list of all your customers so that we can ensure that they do not associate your company with ours in any way.

Unless we receive your agreement in principle within ten days of the date of this letter, we shall proceed with legal action for infringement and passing off without further notice to you.

Furthermore, we believe that your advertisement does not meet the guidelines of the Advertising Standards Authority in that the superlatives claimed cannot be substantiated. We have referred the advertisement to the ASA accordingly.

Yours faithfully

Cheetah plc

