

THE JOINT EXAMINATION BOARD

PAPER T1

BASIC UNITED KINGDOM TRADE MARK LAW

12th November, 1997

3.00 p.m. - 5.00 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.
9. Please put your answers in **QUESTION NUMBER ORDER** before placing in envelope provided.

THIS PAPER COMPRISES 4 PAGES (INCLUDING THIS FRONT SHEET)

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Part A

- 1 Outline the main differences between a Certification Trade Mark and a Collective Trade Mark (5 marks)**
- 2 Briefly outline the relative grounds for refusal under Section 5 of the Trade Marks Act 1994 (5 marks)**
- 3 Your client, who is in the toy field, has a defensive registration for bicycles. What is the position of his registration under the Trade Marks Act 1994 currently and in the future? (5 marks)**
- 4 Write brief notes on the filing of "Observations" after publication of an application - Section 38 of the Trade Marks Act 1994 (5 marks)**
- 5 In what circumstances may a registered Trade Mark be altered? (5 marks)**
- 6 Briefly outline the provisions relating to groundless threats of infringement proceedings under Section 21 of the Trade Marks Act 1994 (5 marks)**
- 7 Discuss the main issues arising from *Wagamama v City Centre Restaurants* [1995] FSR 713 (5 marks)**
- 8 Outline the stages of the opposition procedure under the Trade Marks Act 1994 (5 marks)**
- 9 Indicate briefly the limitations of rights in a registered Trade Mark under Section 11 (limits on effect of registered trade mark) (5 marks)**

Part B

10 Your clients would like to register the following marks

EUROCHEK	UROCHEK	EUROCHEQUE	UROCHEQUE
EURO ^C CHEK	EUROCHECK	UROCHECK	EURO-CHEQUE
URO-CHEQUE	EUROCHEKS	UROCHEKS	UROcheque

The marks are to be used in relation to perfumes, handbags and sunglasses. Searches have been conducted and no potential problems have been revealed

Your client would like to obtain registration of all of the marks in the most cost-effective manner. Write a letter to your client explaining:

- (a) the provisions of Section 41(2) of the Trade Marks Act 1994 and Rule 21 of the Trade Marks Rules 1994 (relating to series of marks);
- (b) the number of separate applications the client should file and why (12 marks)

11 You registered **PIGSTER** for your client for a new type of mountain bike, which is the subject of a patent. The patent is valid for another 15 years. Your client is delighted at all the publicity surrounding his bicycle. He sends you a newspaper clipping to prove it is successful. The article refers to pigsters throughout. In other words no reference is made to the Trade Mark **PIGSTER**, reference is to pigsters as the name of the bike and it is clear from the articles that "pigsters" is the newly-coined generic name for the bicycles. The client advises you that if people call his bicycles "pigsters" they will buy his bikes and he will become a millionaire overnight. It seems that this newspaper clipping is one of hundreds which have appeared recently as a result of the efforts of a new PR agent the client has employed. Your client's final comment is "you never know, before long my trade mark will appear in the Oxford Dictionary !" Advise your client. (12 marks)

12 Your client is the proprietor of UK registration no. 1342432 EXAMNESIA which is registered in Class 25 in respect of footwear. He has successfully sold products under his mark for over ten years in the UK

He recently noted the advertisement of the identical mark EXAMNESIA in the Trade Mark Journal. The application is proceeding in respect of suits and jackets in Class 25 and the advertisement states that the application is proceeding because of "Honest concurrent use with Registration No 1342432."

Your client cannot understand how this happened and would like to prevent the registration of the new mark. Write notes setting out your client's position, explaining honest concurrent use with reference to Road Tech

Computer Systems Limited v Unison Software (UK) Limited
[1996] FSR 805 (the ROADRUNNER case).

(12 marks)

- 13 Explain in lay terms what is meant by passing off

(12 marks)

- 14 Your client manufactures food sauces and has adopted the legend **BBQSAUCE** for its barbecue sauces. The product is very successful and has been advertised in the press and on television. Your client receives a “cease and desist” letter from a third party's solicitors accusing your client of infringement and passing off. It appears that their client has registered **BBQSAUCE** for “food sauces”. That application was allowed to proceed “advertised before acceptance” as a result of evidence of use having been filed by the applicant. The solicitors point out that this registration is in Part A of the Register and because it has been on the Register for 7 years they claim it is incontestable. They require your client to cease use immediately.

You check the Trade Marks Register and you find that **BBQSAUCE** is indeed registered for the goods stated.

Advise your client, citing any recent relevant cases. Your response should include not only your client's defences to this alleged infringement but also possible lines of attack.

(12 marks)

- 15 The Trade Mark **LANDERSON** is registered in the UK by Textiles Europe Limited for “textile materials”. **LANDERSON** is a very well-known mark for these goods.

Your client, Jones plc, is a prominent company in the field of soft furnishings. They send you a draft of an advertisement intended to be placed in a trade publication, and ask for your comments. The main part of the advertisement reads:-

“Curtains made from **LANDERSON** material”

“Come to us for your **LANDERSON** curtains”

Advise your client

(12 marks)