

**THE JOINT EXAMINATION BOARD
PAPER T4**

ADVANCED UNITED KINGDOM TRADE MARK PRACTICE

**Wednesday, 12th November 1997
10.00 a.m. - 2.00 p.m.**

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

1. Check the contents of this envelope. You have, including this sheet, 19 sheets in total.
2. You should attempt question 1 (40 marks) and no more than three of the remaining four questions (20 marks each).
3. The number of marks allotted to each question is shown in brackets at the end of the question.
4. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
5. 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 have received a letter from a local solicitor as follows:

My clients have run a business as a public house in North London with rooms available for overnight stay for patrons (bed and breakfast only) for about ten years now. The business also has an "off licence" outlet selling take-away meals as well as beverages. The pub is called "PRIDE OF THE SHIRES". They have decided to expand the business by setting up similar enterprises with the same name throughout the Home Counties. A customer recently asked them if they were part of the famous SHIRES hotel group. They are not, but are concerned to know whether there is any likelihood that they could be prevented from using the name PRIDE OF THE SHIRES.

One of the people involved also has an interest in a separate business, concerning the manufacture, of wooden garden furniture. He has asked for advice regarding the availability and registrability of the mark ACORN. He adorns each piece of work with a tiny carved acorn and considers this to be his trade mark too. He has sold this garden furniture to individuals all over the world, for about three years now and his work is highly thought of and sought after.

You have conducted the three searches necessary. A further check reveals that Fort (UK) Ltd was dissolved in November 1996. Write a letter to the solicitor advising him accordingly. Consider only the trade mark issues in your answer.

(40 marks)

Search

	<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>
		PRIDE OF ENGLAND 29, 31	Peas; all included in Class 29.	Unilever plc	26.11.31	Registered
			Peas; all included in Class 31.			
551864		PRIDE OF THE ACRES 29	Butter; cheese; all included in Class 29.	Diary Produce Packers Ltd	13.06.34	Registered
554652		PRIDE OF THE HILLS 29	Butter; cheese; all included in Class 29.	Diary Produce Packers Ltd	10.10.34	Registered
B1029815		SHIRE INNS 29	Pre-cooked meals and foodstuffs, all included in Class 29 and prepared in the form of snacks.	Daniel Thwaites plc	21.05.74	Registered
B1121725		PRIDE OF DENMARK 29	Fruits and vegetables, all being preserved, dried or cooked; fruit preserves, vegetable preserves and pickles.	Faellesforeningen for Danmarks Brugstforeninger	03.10.79	Registered

	<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>
	THE PRIDE OF SCOTLAND	29	Smoked salmon, gravadlax; all the produce of Scotland; all included in Class 29.	Lossie Seafoods Ltd	14.03.94	Registered
B1029816	SHIRE INNS	30	Pre-cooked meals and foodstuffs all included Class 30 and prepared in the form of snacks.	Daniel Thwaites plc	21.05.74	Registered
B1121726	PRIDE OF DENMARK	30	Bread, biscuits (other than biscuits for animals), cakes, pastries, farinaceous food pastes, non-medicated confectionery, pralines, chocolates, chocolate articles, marzipan, cocoa, cocoa products for food, pastes for stuffing for pastry, cake paste, cake powder, breadcrumbs and cake substance for human consumption.	Faellesforeningen for Danmarks	03.10.79	Registered

	<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>
	SHIRE INNS	32	Alcoholic and non-alcoholic drinks and preparations for making such drinks, all included in Class 32.	Daniel Thwaites plc	21.05.74	Registered
B1190377	PRIDE OF DENMARK	32	Fruit juices and vegetable juices, all for use as beverages; non-alcoholic beverages included in Class 32.	Faellesforeningen for Danmarks Brygsforeninger	11.02.83	Registered
B1373582	SHEER PRIDE	32	Beer, ales and porter, all included in Class 32.	Fuller, Smith & Turner plc	21.02.89	Registered
B1029818	SHIRE INNS	33	Wines, spirits (beverages) and liqueurs.	Daniel Thwaites plc	21.05.74	Registered
B1121727	PRIDE OF DENMARK	33	Wines, spirits (beverages) and liqueurs.	Faellesforeningen for Danmarks Brygsforeninger	03.10.79	Registered

	<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>	
		PRIDE OF THE SHIRES	36	Investment consultancy services; investment research; fund investment; portfolio and investment management services; capital investment; provision of information in relation to currencies, stocks, equities, bonds, commodities and financial futures; all included in Class 36.	Hambros plc	22.03.90	Registered
1392799	SHIRE INNS	42	Hotel and boarding house services; reservation services for hotel accommodation; restaurant, cafe, bar and catering services; provision of conference facilities; all included in Class 42.	Daniel Thwaites plc	24.07.89	Registered	
B1399501	SHIRES	42	Public house, cafe and restaurant services; all included in Class 42.	Fort (UK) Ltd	22.12.89	Ren overdue	

	<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>
1452926	PRIDE SBEK	42	Beauty salon and and beauty treatment services; cosmetic treatment; hair- dressing and hair- dressing salon services; dietetic counselling and advisory services; tanning salon services and the provision of solarium facilities; planning and supervision of weight reduction programmes; preparation of food and drink; food cooking services; provision of saunas; advisory services relating to all the aforesaid services; all included in Class 42.	Pride Seek Ltd	20.11.90	Registered
	Bass Museum Visitor Centre & Shire Horse Stables	42	Providing facilities for exhibitions and conferences; bar and catering services; all included in Class 42.	Bass plc	16.01.91	Registered

<u>No</u>	<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>
1106482	ACCORD	20	<p>Beds included in Class 20; mattresses (other than childbirth mattresses), divan beds, couches, bedroom furniture; chairs, settees; chairs and settees, all being convertible into beds; but not including any of the aforesaid goods made from corded fabrics.</p> <p>Musical entertainment services.</p>	ABF Ltd	18.12.78	Registered
	KORN	9, 16, 25 41	<p>Audio and audio-visual musical recordings.</p> <p>Posters, souvenir programs, brochures and books.</p> <p>Articles of clothing, in particular T-shirts, sweatshirts, warm-up jackets, hats and caps.</p> <p>Musical entertainment services.</p>	The Korn Partnership	11.02.97	Advertised

	<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>
	ACCO	20	Office furniture and parts and fittings Corporation therefor included in Class 20; articles in Class 20 made of plastics materials.	Acco World	30.07.82	Registered
1214295	ACORN	20	Articles of office furniture.	Acorn Office Accessories Ltd	08.03.84	Registered
1232656	EKORNES	20	Furniture and parts and fittings therefor included in Class 20.	J E Ekornes A/S	21.12.84	Registered
1404539	ACCORD	20	Seating for use in auditoria and stadia, none being convertible into bed form; all included in Class 20.	Hille Auditorium Seating Ltd	17.11.89	Registered
1494463	ACCO	20	Office furniture; desks; cupboards; cabinets; furniture for storage; parts and fittings for all the aforesaid goods; presentation furniture, screens, consoles,	Acco World Corporation	16.03.92	Registered

	<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>
1496178	PEPPERCORN	20	Furniture; all included in Class 20.	ICI Chemicals Ltd	01.04.92	Registered
B1503481	ACORN	20	Signs, sign boards; nameplates and kickplates; finger plates, backplates; lettering; protective plates and mountings; door fittings; parts and fittings for all the aforesaid goods; all included in Class 20.	David Nameplate Company Ltd	15.06.92	Registered
1572175	ACORN SELF-STORAGE	39	Self access storage; storage, warehousing, packaging and crating services; rental of parking places; provision of vehicle parking facilities; all included in Class 39.	Acorn Self-Storage Ltd	17.04.94	Registered

<u>Mark</u>	<u>Class(es)</u>	<u>Goods/Services</u>	<u>Proprietor</u>	<u>Date</u>	<u>Status</u>
ACORNA - QUEEN OF THE UNICORNS	9, 20, 25	Pre-recorded audio and video tapes, audio and video tape cassettes, video laser discs, CD-ROM's and motion picture films all featuring comic books, live, cartoon or animated characters. Tables, chairs, beds, bedheads, cupboards and wardrobes, shelves. T-shirts, sweatshirts, sweat pants, pants, shorts, tank tops, shirts, vests, blouses, nightshirts, pyjamas, boxer shorts, under garments, infant wear, bathing suits, rain coats and rain wear, bathrobes, aprons, jackets, scarves, sweaters, wrist bands, head bands, bow ties, neck ties, belts, sneakers, shoes, shirts, socks, hats, caps, masquerade costumes and masks sold in connection therewith.	Big Entertainment Inc	27.11.96	Pending

Search SERVICE

Mark

Class(es)

Goods/Services

Proprietor

Date

Status

20

Articles of furniture.

Acorn Office Accessories Ltd

08.03.84

Registered



B1267817

20

Furniture, mirrors included in Class 20, and picture frames.

The National Trust (Enterprise) Ltd 23.05.86

Registered



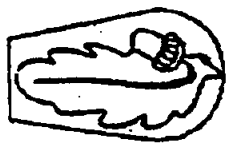
1512510

27

Wallpaper, wallpapers borders, floor coverings tapestry (being wall hangings); but not including any such goods decorated with fruits and leaves.

Wallco Ltd 01.01.1876

Registered



2111303

16

Brushes included in Class 16

Acorn Decorating Products Ltd 13.10.96

Pending



No three dimensional marks consisting of acorn devices located.

Question 2

Your client, Kensington Clothing Limited (KCL), is a manufacturer of traditional men's apparel. The company was established for over 20 years and has used its trade mark KENSINGTON throughout this period. Registration was made under the 1994 Trade Marks Act for a specification reading "*articles of outerclothing for men*".

You are approached by KCL's Managing Director for advice as he has become aware of the possible launch into the UK duty paid market of a men's aftershave and personal care range under the trade mark KENSINGTON MAN by a company of the same name, Kensington Man Limited. He explains that the product has been available in duty free outlets in UK airports for around about nine years. He is concerned that expansion into the high street market may result in confusion and consequent damage to his company's carefully nurtured image, particularly as the personal care products are directed at the mass market for younger men and the profile of the range is in contrast to the traditional image of Kensington Clothing. Furthermore, he has his own plans to introduce an aftershave under the KENSINGTON mark. A search reveals KENSINGTON MAN has not been filed as a trade mark in Class 3.

What causes of action and remedies may be open to your client and what difficulties are likely to be faced in pursuing same?

What steps can your client take to improve its position?

(20 marks)

Question 3.

Your client Big Business Aktiebolag is the proprietor in Sweden of the registered trade mark TANGERINE LADY for "handbags, purses and wallets" in Class 18 and "blouses, pullovers, cardigans" in Class 25. The registration dates from 1982 and has been used continuously in Sweden since this time for all of the goods covered by the registration. During February 1997 Big Business Aktiebolag brought out a range of dresses in Sweden under its trade mark TANGERINE LADY and filed a further application for its trade mark in Sweden for "clothing" in Class 25 on 14th June 1997. Prior to July 1997 your client had not sought registration of its trade mark anywhere other than in Sweden.

Big Business Aktiebolag has used the trade mark TANGERINE LADY in the United Kingdom for blouses since October 1990 and for handbags and ladies underwear since March 1992. The trade mark has not been used in the United Kingdom by your client for any other goods.

On 7th July 1997 you filed an application to register its trade mark TANGERINE LADY for the United Kingdom for "handbags, purses and wallets" in Class 18 and "articles of clothing and all other goods included in Class 25". You have now received an official letter from the Registry enclosing the examination report for the application as reproduced below. A six month term has been issued by the Trade Marks Registry for filing a response.

Write a letter to your client providing them with your opinion on the objections raised, whether and how they can be overcome and indicating to your client what additional information you require.

EXAMINATION REPORT

Application No. 2138000 in Classes 18 and 25 has been examined under the Trade Marks Act 1994. References to "section" in this report mean that Section of the Act.

Absolute Grounds For Refusal (Section 3)

The mark is not acceptable because there is an objection under Section 3(1)(b) and (c) of the Act because the mark consists of the words TANGERINE and LADY conjoined, the whole being devoid of any distinctive character and which may serve in trade to designate ladies' goods manufactured in Tangiers or which are tangerine coloured or in the shape or bearing representations of tangerines.

The mark is not acceptable because there is an objection under Section 3(3)(b) of the Act because the mark consists of the words TANGERINE and LADY, which are of such a nature as to deceive the public in to believing the goods are for ladies and manufactured in Tangiers or goods which are tangerine coloured, or are in the shape of or bearing representations of tangerines

Class 18 - Relative Grounds For Refusal "(Section 5)

There is an objection under Section 5(2) because there is a likelihood of confusion with the earlier marks, which are listed below and detailed at the end of this report. [Note: E denotes a Community mark and M denotes an International mark]:

E198000 (25, 28) 2137700 (18, 25)

Class 25 - Relative Grounds For Refusal (Section 5)

There is an objection under Section 5(1) because of the earlier mark listed below and detailed at the end of this report.

[Note: E denotes a Community mark and M denotes an International mark]:

1428765 (25)

There is an objection under Section 5(2) because there is a likelihood of confusion with the earlier marks, which are listed below and detailed at the end of this report. [Note: E denotes a Community mark and M denotes an International mark]:

E198000 (25, 28) 1481319 (25)

2137700 (18, 25)

Specification Of Goods

The specification for Class 25 is so wide that there appears to be some doubt about whether the applicant is using or intends to use the mark on all of the goods listed. Section 3(6) of the Act refers. The goods should therefore be restricted, or evidence put forward to show that the applicant is trading in the full range of goods claimed or has an intention to do so.

(20 marks)

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DETAILS OF CITED MARKS

REGISTRATION/ PATENT No.	TRADE MARK	Class	PROPRIETOR	DATE	GOODS
1481319 registered (by consent-B1428765)	TANZERINE	25	Tanzerine Inc.	30/1/92	Articles of ladies clothing.
B1428765 unpaid renewal	TANGERINE LADY	25	Spectacular Clothing Ltd.	7/6/90	Stockings, tights, socks leggings and footwear, all being for women and girls.
2137700 pending	TANZERINE	18 and 25	Tanzerine Inc.	27/1/97	Class 18 - Articles of leather or of imitation leather Class 25 - Articles of ladies clothing.

REGISTRATION/ PATENT No.
1481319
registered
(by consent-B1428765)

TRADE MARK
TANZERINE
SPORTSWOMAN

Class
25, & 28

PROPRIETOR
International Sports S.A.

DATE
1/4/96

GOODS
Class 25 - Articles of sports clothing.
Class 28 - Sporting articles, games, playthings and sportsbags.

1481319
registered

TANZERINE

25

Tanzerine Inc.

30/1/92

Articles of ladies clothing.

B1428765
unpaid renewal

TANGERINE LADY

25

Spectacular Clothing Ltd.

7/6/90

Stockings, tights, socks leggings and footwear, all being for women and girls.

2137700
pending

TANZERINE

18 and 25

Tanzerine Inc.

27/1/97

Class 18 - Articles of leather or of imitation leather
Class 25 - Articles of ladies clothing.

Question 4

Your client is the manufacturer of replacement body shells for motor cars. He produces a number of bespoke or reproduction body shells based on classic or traditional motor car designs. One of the body shells that he produces is a modified shell for a Mini motorcar. This shell is adapted to be a replacement for the original mini body and makes use of the original chassis tray, suspension, subframe, engine and suspension. The body shell is very slightly different from that of an ordinary mini, but in the finished car is hardly distinguishable from it. It is based on a body shell produced previously during the late 1960's. Since 1969 no body shells to this particular design have been produced. Your client decided to commence production of body shells corresponding to those produced in the 1960's in June 1995 and the first shells were produced and advertised in July 1996. Your client now has a continuing advertising campaign and is producing body shells and modifying original mini cars using these body shells at the rate of two a week.

Your client's attention has been drawn to Trade Mark Registration No. 2002390 and a copy of the entry in respect of this mark appearing in the Trade Marks Journal is attached.

Your client is concerned that Trade Mark Registration No. 2002390 will inhibit his marketing activities and he requires your advice as to the position generally, and the validity or otherwise of Trade Mark Registration No 2002390.

Draft a letter of advice to your client, giving reasons for the positions that you take

(20 marks)

N. B. Confine your answer to trademark issues only.

To assist, Section 3 of the Trade Marks Act 1994 reads as follows:-

Grounds for refusal of registration

3. Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape which results from the nature of the goods themselves,
 - (b) the shape of goods which is necessary to obtain a technical result, or
 - (c) the shape which gives substantial value to the goods.
- (3) A trade mark shall not be registered if it is—
- (a) contrary to public policy or to accepted principles of morality, or
 - (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).
- (4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.
- (5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).
- (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

CLASS 5 *continued*

2108617 28 August 1996 (05)

SATELLITE

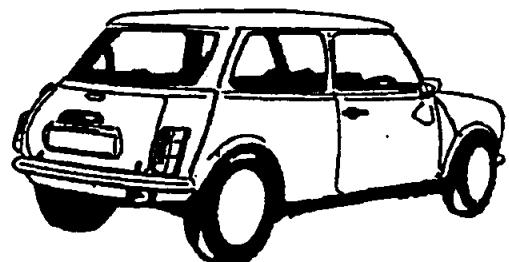
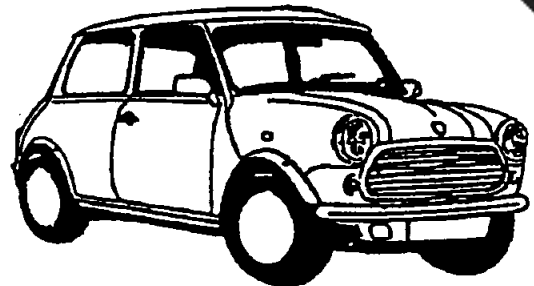
Insecticides, larvicides, fungicides, herbicides, pesticides, molluscicides, nematocides, rodenticides and preparations for killing weeds and destroying vermin.

American Cyanamid Company, 5 Giralda Farms, Madison, New Jersey 07940-0874, United States of America.

Agent: D. Young & Co., 21 New Fetter Lane, London, EC4A 1DA.

CLASS 6

2002390 17 November 1994
(06, 12, 16, 28)



The mark consists of a 3 dimensional shape.

Proceeding because of distinctiveness acquired through use.

Class 6:

Key fobs, key rings, ornaments, containers, money boxes, tins, and badges, all made wholly or principally of common metals or their alloys.

Class 12:

Motor land vehicles.

Class 16:

Stationery; office requisites (other than furniture); pens, pencils, and writing and drawing instruments; paperweights; bookends; bookmarks; erasers.

Class 28:

Toys, games and playthings; scale models sold complete or in kit form.

Rover Group Limited, International House, Bickenhill Lane, Bickenhill, Birmingham, B37 7HQ.

Agent: Philip John Cooper, Head of Trade Marks, Rover Group Limited, International House, Bickenhill Lane, Birmingham, B37 7HQ.

Question 5.

Your client Lorenzo de Ravoli is a leading Italian footballer. He has played for a number of top European sides and at International level for the past ten years.

Lorenzo has been negotiating to join a leading English premier ship club and the deal is close to reaching a conclusion. Demand for merchandise under the de Ravoli name and imagery is likely to be substantial and Lorenzo has approached you as he wishes to retain proprietorship of his own name and grant a licence to the club. Whilst the club are a little reluctant to concede to Lorenzo's request for remuneration partially based upon royalties, they have agreed to consider the matter further.

Your client requests you to prepare a trade mark licence.

Outline the points that such a document should cover. What other steps would you recommend to your client? Are there any possible limitations to your client's position of which you feel he should be aware'?

(20 marks)

