

THE JOINT EXAMINATION BOARD

PAPER T1

BASIC UNITED KINGDOM TRADE MARK LAW

18th November 1998

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

PART A

1. What are the definitions of an “earlier mark” under the 1994 Trade Marks Act? (5)
2. Briefly outline the stages of an action for revocation on the grounds of non-use. (5)
3. What are the tests for assessing trade mark infringement under the 1994 Act? (5)
4. What is meant by “exhaustion of rights” under the Trade Marks Act? In what circumstances can it be said that there is no exhaustion of rights? (5)
5. List five ways in which a registered trade mark can be removed from the Register? (5)
6. What do you understand by i) a “sole license”, ii) a “non-exclusive license” and iii) an “exclusive license”. (5)
7. A UK trade mark application is rejected by the Registrar. What courses or appeals are available and what are the pros and cons of these courses. (5)
8. Under the 1994 Trade Marks Act a registration can be renewed after the due date for renewal. Explain, with reference to the relevant Rules, how this can be done. (5)
9. Explain in layman’s terms the provisions of the Trade Marks Act 1994 relating to acquiescence. (5)
10. What constitutes “use of a sign” for infringement purposes under the Trade Marks Act 1994? (5)
11. What are the absolute grounds for refusal laid down in the Trade Marks Act 1994? (5)

PART B

1. You are asked to give a talk to the people who are responsible for creating new brand names for your clients company. Write notes on the advice that you would give as to the considerations that should apply in selecting a new registrable trade mark. (12)

2. Your client Napoli SpA owns a UK registration for the trade mark MAFIA for “toys; games; playthings; sporting articles”. The registration dates from 1 November 1984 and your client has been using the mark in the UK solely for a board game since January 1985.

(12)

A company called Don Corleone SpA wishes to use the mark MAFIA for golfing articles and your clients receive an offer from Don Carleone indicating that for a sum of £10,000 Don Carleone wishes to acquire the MAFIA registration insofar as “golfing articles” are concerned. Advise your client as to its position and options.

3. Brian Smith has been providing mini-cab services in and around the Littletown area for about ten years. He trades under the name of FAST CARS. Locally, FAST CARS is known to be reasonably priced, punctual and reliable. (12)

Mr Smith approaches you with a problem. Another provider of mini-cab services has set up in Littletown within the past few weeks under the name of FASTEST KARS. Mr Smith is concerned as in the last few weeks he has seen a drop in business and suspects customers are contacting FASTEST KARS by mistake. He wants to prevent the use of FASTEST KARS.

From a cursory search of the Register you know that neither FAST CARS nor FASTEST KARS are the subject of any registrations.

Write notes on Mr Smith’s position.

4. On behalf of your client you file a UK application for the mark WHIZZO in respect of “wine; spirits; liqueurs” (Class 33). Your clients specifically wants to use the mark for “wine”. (12)

The Trade Marks Registry raises an objection on the basis that there is conflict with the mark WHIZZARDO which has been registered since 1970 in respect of “non-alcoholic beverages” (Class 32). Enquiries reveal that WHIZZARDO is used for carbonated water.

Advise your client as to how it might be possible to pursue the WHIZZO application through to registration.

5. “The concept of ‘likelihood of association’ is not an alternative to that of ‘likelihood of confusion’, it simply helps to define its scope”. (12)

Discuss this statement making reference to relevant case law.

- 6.(a) What are 'registrable transactions' under the Trade Marks Act 1994? (12)
- (b) Explain to your client the potential repercussions of not applying to register a registrable transaction.