

THE JOINT EXAMINATION BOARD

FOUNDATION LEVEL

PAPER T1

BASIC UNITED KINGDOM TRADE MARK LAW

22nd November 2000

03.00 p.m. – 05.00 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 designations 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 any 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.

This paper consists of 4 pages, including this one.

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PART A

1. Under what circumstances can a trade mark registration be renewed subsequent to the expiry of the renewal date and what steps need to be taken. (5 marks)
2. Under the provisions of the Trade Marks Act 1994, how can a proprietor/licensee of a registered trade mark obtain assistance from the Commissioners of Customs and Excise and what penalty will they apply? (5 marks)
3. How does the Trade Marks Act 1994 define an “earlier trade mark”? (5 marks)
4. What are the defences under Section 11 of the Trade Marks Act 1994 to an allegation of infringement? (5 marks)
5. Why is it important to register a registrable transaction? (5 marks)
6. What are the grounds for revocation of a trade mark registration? (5 marks)
7. In what circumstances is acquiescence deemed to have arisen under the Trade Marks Act 1994 and what are the consequences of such acquiescence? (5 marks)
8. Explain the concept of “exhaustion of rights”. (5 marks)
9. Explain the provisions of Section 95 of the Trade Marks Act 1994 which relate to the false representation of a trade mark as registered. (5 marks)
10. What are the grounds for invalidity of a registration under Section 47 of the Trade Marks Act 1994? (5 marks)

PART B

1. You are contacted by two businessmen - Mr Raj Singh and Mr Ahmed Patel. Singh and Patel each run separate clothing companies.

Singh and Patel are friends and they have decided to embark upon a joint venture. Their intention is to import unbranded clothing articles from China, to label those goods at their UK factories and to then market the goods through shops across the country. The intention is to use the trade mark SINTEL for these clothes.

Singh and Patel want you to advise as to the steps that they should take in connection with the proposed use and possible protection of SINTEL.

What do you need to tell your clients? (12 marks)

2. Your client, Wannabe Limited, has been granted by Top Pops Inc an exclusive licence to use the trade mark MAJESTIC in respect of all the goods for which that mark has been registered in the United Kingdom - "phonographic recordings; discs; tapes; cassettes" (Class 9). This licence was recorded as soon as registration was granted. For the past 5 years Wannabe has been using MAJESTIC as a label on music CDs featuring jazz artists. These CDs are aimed at a niche market and whilst sales have been modest in comparison to the music industry in general, the MAJESTIC label is well-known to jazz connoisseurs.

Wannabe finds that a company called At Your Pleasure Limited has recently started using the trade mark MAJESTY in respect of sheet music. At Your Pleasure is producing sheet music for a wide variety of genres under the MAJESTY mark.

Wannabe would like to prevent the use of MAJESTY by At Your Pleasure. Write notes on the factors that need to be considered. (12 marks)

3. MR BLADE is a trade mark that has been used in respect of a mobile knife-sharpening business by Thomas McMurray, a sole trader. Mr McMurray is well-known in the Fife area of Scotland where he visits local restaurants, sandwich bars and suchlike in order to sharpen knives. Mr McMurray is well known by his customers to provide a reliable service at a reasonable price. He has been trading for about 10 years. "MR BLADE" is emblazoned upon his van and appears also on invoices, letter headed paper and his business card. Mr McMurray has not bothered to register his mark.

A company called Tools-Rite Limited has filed a United Kingdom trade mark application (No: 2999999) for the mark BLADES in respect of "repair and maintenance of tools". The application has been accepted by the Trade Marks Registry and has been advertised in last weeks Trade Marks Journal.

Mr McMurray becomes aware of the application for BLADES. On his own initiative he has already been in touch with Tools-Rite and he has found that there has been no prior use of BLADES by that company. Mr McMurray contacts you, seeking advice as to whether the registration of BLADES will pose any problems to him and what he should do. Advise Mr McMurray. (12 marks)

4. Your client, Bill Dodger, has been selling clothing bearing the trade mark ORBIT for about a year. He has now been informed that the identical mark was registered by a third party in 1995 in Class 25 in respect of "articles of clothing". He is particularly concerned as he has been told that he could be sent to prison as a result of his use.

Write a letter advising your client. (12 marks)

5. Your client, Coffin Ltd, is the proprietor of UK registration number 1130659 COFFIN which is registered in Class 34 in respect of "tobacco products". The application was filed on 01.09.82 and the mark was registered on 10.06.85.

They have received a letter from Coughing Ltd who wish to use and register the mark COUGHING in relation to cigarettes. They threaten to attack your clients registered mark unless they consent to that use/registration.

Your client informs you that they have not sold cigarettes in either the UK or Europe, but have only undertaken manufacturing in the UK for export to the Far East owing to a European Regulation which came into force in December 1992 which limited the tar yield per cigarette to 12 milligrams. They say that their factory did not have the technological capability to meet this requirement without 'seriously compromising on taste'.

Advise your client as to their best course of action. (12 marks)

6. To what extent are trade marks which have been registered or used outside the UK taken into account in proceedings before the UK Trade Marks Registry? (12 marks)