

THE JOINT EXAMINATION BOARD

PAPER T1

BASIC UNITED KINGDOM TRADE MARK LAW

16th November 2001

3.00 p.m. – 5.00 p.m.

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

1. You should attempt eight questions from Part A and 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 conclusion 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 answers no marks will be awarded.
8. **NO** writing whatsoever, including numbering of pages, 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 the envelope provided.

THIS PAPER COMPRISES 5 PAGES (INCLUDING THIS FRONT SHEET)

JEB Paper T1 – Basic UK Trade Mark Law

Part A

1. How does the 1994 Trade Marks Act define a “trade mark”?

(5 marks)

2. (a) In what circumstances can an aggrieved party bring proceedings to prevent groundless threats of infringement?
(b) What are the exceptions?
(c) What relief is available?

(5 marks)

3. Section 11 defines the limits on the effect of a registered trade mark. What are they?

(5 marks)

4. How does the 1994 Trade Marks Act define an “earlier trade mark”?

(5 marks)

5. In what ways might a registered trade mark be removed from the Register?

(5 marks)

6. What are the absolute grounds for refusal of registration under the Trade Marks Act?

(5 marks)

7. Briefly outline the main differences between a Certification Mark and a Collective Mark.

(5 marks)

8. Define “earlier trade mark” under the Trade Marks Act 1994.

(5 marks)

9. Write brief notes on the concept of “division”.

(5 marks)

Part B

10. Merton Drinks Limited brew real ales. SUMMABREEZ has been a best-selling line for Merton for about 15 years – it is extensively advertised on ITV1 and annual turnover is in excess of £4 million.

Merton has a registration for SUMMABREEZ (word) in respect of “beers” in Class 32. This registration dates from 1997.

The managing director of Merton has noticed in the August edition of “Real Ale Monthly” the following short article:

“Daventry Limited has announced plans to launch a winter ale under the brand name WINTABREEZ. Sales are due to commence in November in time for the busy Christmas period “.

The managing director of Merton calls you in an anxious state. He wants to prevent any use of WINTABREEZ by Daventry.

You search the register and find that Daventry has a recent registration in January 2001 for WINTABREEZ in respect of “beer” in Class 32.

Make notes on the points that you will need to consider in order to advise Merton.

(12 marks)

11. Ron Noakes is a locksmith and has been trading since 1992. His business is small but relatively successful – he is well known in and around Eltham to provide a quick service at reasonable prices and his work is of a high standard.

Mr Noakes advertises his services in the local press: “Ron Noakes trading as QUICKFIT LOCKS”.

In this week’s local newspaper there is an advertisement for a competitor: “New to Eltham. QWIKFITTER SECURITIES. For locks and burglar alarms”.

Mr Noakes contacts you as he would like to prevent this third party use of “QWIKFITTER”.

Write notes on the advice you would provide to Mr Noakes.

(12 marks)

12. You act for Dr Rufus Rafinelli. Your client has developed a herbal remedy for the treatment of eczema and has been selling such goods for about 30 years.

Your client has a UK trade mark registration for the mark RAFINELLI in respect of “herbal remedies” in Class 5.

Herb Cure Limited also sells a herbal remedy for the treatment of eczema. This product is marketed under the trade mark HERBCURE and the packaging of the product of Herb

Cure bears the wording "a herbal remedy prepared according to the original directions of Dr Rafinelli".

Further enquiries reveal that companies other than Herb Cure are also selling products of the same nature and making reference to their goods being prepared in accordance with those of Dr Rafinelli. It transpires that Dr Rafinelli has previously encouraged the use of his name by Herb Cure.

Dr Rafinelli would now like to prevent Herb Cure's use of his name. Discuss the factors that are likely to have a bearing upon his chances of success.

(12 marks)

13. Your client Baddebt Ltd is the proprietor of UK registration number 1456789 SEVENTH HEAVEN which is registered in respect of "articles of clothing" in Class 25. The application was filed on 14th July 1995 and entered on the Register on 14th July 1996. He has been selling clothing products for females for four years but you discover that his mark has been used in the form 7th HEAVEN. His products are sold through outlets in Devon and Cornwall and he has achieved a turnover of £100,000 each year. He tells you that many orders are made on the telephone. A third party, Grovel Ltd, has asked him to consent to their use/registration of the mark HEAVEN 7 in relation to children's clothing. They propose to manufacture the product in the UK but export it to Scandinavia.

Your client asks you how he should respond to Grovel Ltd. Advise.

(12 marks)

14. Write a letter to your client explaining in layman's terms the provisions relating to the renewal, removal and restoration of a trade mark under the Trade Marks Act 1994.

(12 marks)

15. Your client Down At Heel Ltd has been selling mens socks in the UK since 1994. Their turnover has been £20,000 per year. They tell you that their products are sold directly to the trade in plain unmarked packaging but that when talking to potential customers the products are referred to as PREMIER socks. They have just received a cease and desist letter from Darn Ltd who allege trade mark infringement and passing off at common law. Darn Ltd are the registered proprietors of UK trade mark registration number 1356767 PREMIER which is registered in class 25 in respect of "footwear". The application was filed in 1995 and registered in 1997. Investigation reveals that Darn Ltd have sold ladies shoes under the mark PREMIER since 1985. They appear to enjoy a strong reputation in the mark in the UK.

Advise your client on their position.

(12 marks)

16. Your client, Ian Fringing, has been selling alcoholic beverages bearing his name for 6 months. He has set up a limited company called Ian Fringing Articles Ltd and asks you to apply to register the mark FRINGING through the Community Trade Mark system.

A pre-filing search has revealed a UK registration for FRINGE covering alcoholic beverages registered in December 2000.

Your client has been advised that the following would not amount to infringement of the UK registrations:

His use of his name Ian Fringing

His use of the company name Ian Fringing Articles Ltd

His use of the mark FRINGING, (provided that he obtains a Community trade mark registration)

Advise your client in note form.

(12 marks)