

THE JOINT EXAMINATION BOARD

PAPER T2

BASIC UNITED KINGDOM TRADE MARK PRACTICE

21st November, 2001

2.00 p.m – 5.00 p.m.

*Please read the following instructions carefully. Time Allowed – **THREE HOURS**.*

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 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.
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 the envelope provided.

THIS PAPER COMPRISES 5 PAGES (INCLUDING THIS FRONT SHEET

JEB Paper T2 – Basic UK Trade Mark Practice

Part A

1. Discuss the inherent registrability under the Trade Marks Act 1994 of **TWO** of the following unused marks:
 - a) 24-7 for on-line flower delivery services
 - b) RGC for computer software
 - c) ASS ADVANCED STEERING SYSTEMS for lorry steering systems
 - d) ALBERT for men's toiletries

(5 marks)

2. Your client wishes to register the trade mark GRAVAX for dietetic, invalid and infants foodstuffs and beverages in class 5. A search has revealed the following UK registrations. With consideration only to similarities between the marks and goods, advise your client, in note form, on the relevance of these marks with regard to examination of any application filed for GRAVAX for the required goods in class 5.
 - a) GRAAVAX for beer in class 32
 - b) GRAVACKS for milkshakes in Class 32
 - c) TRAVICKS for dietetic food in class 5.

(5 marks)

3. List the requirements for obtaining a filing date for a UK Application.

(5 marks)

4. List five defences to trade mark infringement available under the Trade Marks Act 1994.

(5 marks)

5. Discuss the inherent registrability under the Trade Marks Act 1994 of **TWO** of the following unused Trade Marks:
 - a) FINANCIAL MALL for a website relating to financial services
 - b) PLUS COLOUR for paints
 - c) ULTRAMOON for a soft drink
 - d) WEB SURFER for computer programs

(5 marks)

6. List the requirements for recording:
 - a) a change of name and address at the UK Trade Marks Registry
 - b) an assignment of a registered trade mark (ignoring issues of stamp duty)

(5 marks)

7. List **five** grounds for refusal on absolute grounds under the Trade Marks Act 1994 which may be raised by an Examiner in an Examination Report.

(5 marks)

8. Your client sells women's underwear via a mail order catalogue, high street shops and on-line via the Internet. Advise your client regarding the goods and services to be covered by any application filed.

(5 marks)

9. Your client's trade mark has been examined by the Trade Marks Registry and no objections have been raised. With reference to relevant time limits, what options are available to third parties to object to the acceptance of the application.

(5 marks)

10. Your client, Ferengi plc, has filed an application for the mark FERENGI under No. 2123456 for "toys" and received an examination report raising an objection based upon earlier UK registration No. 2000003 FARANDI for "toys and games" in the name of Farandi Industries, Inc. Draft a letter of consent which would be acceptable to the Trade Marks Registry.

(5 marks)

Part B

11. Your client, Fresh Flowers Limited, of Edinburgh wishes to register the trade mark RED SQUARE in respect of flower delivery services. Your client has been using this mark for over 10 years. A pre-filing search has revealed the following two marks:

REGISTRATION NO. 2020000 DEVICE OF RED SQUARE
GOODS: Flowers and plants in Class 31
PROPRIETOR: Red Square Florists of Leicester Limited
FILING DATE: 1st May 1995
REGISTRATION DATE: 1st May 1996

APPLICATION NO. 2211111 RED (word)
SERVICES: Delivery services in Class 39
PROPRIETOR: J Sainsbury plc
FILING DATE: 1st June 2000

Write notes on how objections to registration based on the above marks might be overcome. Do not discuss in detail the nature of any evidence that might be filed.

(12 marks)

12. An application for registration of a trade mark before the UK Registry has encountered an objection that it is devoid of distinctive character. Discuss, in note form, the nature of any evidence you could submit to the Registry, assuming that the mark applied for has been used extensively in the UK prior to the filing of the application for registration.

(12 marks)

13. Your client is an association, the members of which import and distribute pharmaceuticals and use a distinctive device of a bird to indicate that they are members of the association. Both the client and its members use the mark.

- a) Identify what type of application(s) they may wish to file.
- b) Explain what additional documentation your client will need to file in support of the application within nine months of filing and the information this additional documentation will have to include.
- c) Explain briefly the distinction between Collective and Certification marks under the Trade Marks Act 1994.

(12 marks)

14. Discuss the provisions for and consequences of co-ownership of a trade mark registration under the Trade Marks Act 1994.

(12 marks)

15. List the procedural steps involved in an application for revocation of a trade mark registration on the grounds of non-use.

(12 marks)

16. Your client wishes to use and register in the UK the mark CRAY with a distinctive FISH device for clothing. Advise your client in a letter of the checks and investigations you could undertake to try to clear the marks for use and registration. Explain your reasons for each investigation/check undertaken.

(12 marks)