

THE JOINT EXAMINATION BOARD

BASIC UNITED KINGDOM TRADE MARK LAW – PAPER T1

15th November, 2002

3.00 p.m – 5.00 p.m.

Please read the following instructions carefully. *Time Allowed – TWO 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. Please note the following:
 - Start each question (but not necessarily each part of each question) on a fresh sheet of paper.
 - Enter the Paper Number, the question number and your Examination number in the appropriate boxes at the top of each sheet of paper.
 - Write on one side of the paper only, within the printed margins using a **BLACK** pen.
 - **DO NOT** use coloured pens or highlighters within the answers – they will not photocopy.
 - **DO NOT** staple or join pages together in any way.
 - **DO 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. **ALL** mobile phones and electronic aids **must be** switched off and stored away.
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. **NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.** At the end of the examination assemble your answer sheets in question number order and place in the **WHITE envelope provided.**

This paper consists of six pages, including this page

PAPER T1

BASIC UNITED KINGDOM TRADE MARK LAW

15th November, 2002

3.00 p.m – 5.00 p.m.

Part A

1. What are the grounds for revocation of a registered trade mark as defined in the Trade Marks Act 1994?

(5 marks)

2. With regard to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark:
 - i) Who is entitled to protection?
 - ii) What protection is afforded by this right?

(5 marks)

3. What relief is available under the Trade Marks Act 1994 to a person who is subjected to a groundless threat of trade mark infringement?

(5 marks)

4. List five registrable transactions as defined in the Trade Marks Act 1994.

(5 marks)

5. How does Section 10(3) of the Trade Marks Act 1994 define the basis upon which a registered trade mark may be infringed?

(5 marks)

6. Section 5 of the Trade Marks Act 1994 stipulates the circumstances in which an application might be refused on the basis of conflict with an earlier trade mark. What are they?

(5 marks)

7. Briefly explain the provisions relating to the registration of a series of trade marks under the 1994 Trade Marks Act and the potential benefits thereof.
(5 marks)
 8. Explain the procedure for the renewal of a UK trade mark registration. What are the circumstances in which renewal may be made out of time?
(5 marks)
 9. What are the limits on the effect of a registered trademark under section 11 of the Trade Marks Act 1994?
(5 marks)
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Part B

1. The Holmes family has manufactured and sold quality furniture for more than 100 years. The trade mark HOLMES has become extremely well-known and is the subject of trade mark registration No: 12758 (UK) in respect of "furniture" (Class 20), filed in 1908 and which remains in force. The registration is owned by Holmes (Furniture) Limited.

Gerald Holmes is a member of the Holmes family and he was formerly a director of Holmes (Furniture) Limited. He left that company last year in an acrimonious manner.

Gerald Holmes has incorporated a new company called GH Furniture Limited and he has opened a shop on Bond Street in London. The signage above this new shop reads "GH FURNITURE LIMITED TRADING AS GERALD HOLMES".

Discuss the grounds upon which Holmes (Furniture) might object to this signage and the defences that might be available to GH Furniture.

(12 marks)

2. Your client, Raycraft Toys Limited, is the owner of the trade mark HUG-ME-BABIES which is used in respect of toy dolls. This is a very successful product line with about 20% market share of toy dolls aimed at girls between the ages of 5 and 10. HUG-ME-BABIES is registered in respect of "toys, games and playthings" (Class 28) under No: 2111111 (UK) which dates from 1999.

Through a watching service, Raycraft become aware of the advertisement in the UK Trade Marks Journal of an application for the mark HUG-ME-BABY which covers "women's clothing" in Class 25 and "cigarettes" in Class 34.

You are asked by Raycraft to advise as to the possibility of opposing this application.

List the grounds upon which an opposition might be based and identify the factors which may impact upon their chances of success.

(12 marks)

3. In October 1993 Teknotek Limited first used the trade mark TEKNOTEK in respect of video cassette tapes. The mark has been in continuous use since that date and use has been nationwide. TEKNOTEK has not, however, been registered.

Roy Scott is the new company secretary at Teknotek and he is amazed to find that his company's main brand is unregistered. Mr Scott asks you to conduct enquiries with a view to ascertaining whether TEKNOTEK might now be registered.

Searches of relevant registers and also of rights at common law reveal that there is only one mark of potential concern – Williams Ltd has a UK registration for the mark TECKNOTEX in respect of "audio cassette tapes" (Class 9). This registration dates from 2 February 1989 and you have found that Williams has used its mark continuously throughout the UK since June 1992.

Write notes on the advice you will give Mr Scott with regard to his company's freedom to i) continue to use and ii) register the trade mark TEKNOTEK?

(12 marks)

4. Your client, Snail Limited, is the proprietor of UK registration 1142675 which consists of the word EFFECTS and the device of a snail shown below:



EFFECTS

The mark is registered in respect of household paint in class 2. The application was filed in 1992 and was registered the following year. The registration is subject to a disclaimer reading "registration of this mark shall give no right to the exclusive use of the word EFFECTS".

Snail Limited sold household paint bearing the mark as registered between 1994 and 1996 but then stopped using the "snail device". Since 1996 they have used the mark EFFECTS alone in relation to the products and since 1996 turnover in goods bearing the mark has averaged £750,000 per year.

Your clients watching service has revealed UK application 2216145 filed on 1 March 2000 which consists of the mark "FX". The application has been filed in Class 2 in respect of "paints" and it has recently been advertised in the Trade Marks Journal. Investigation reveals that the applicants have not yet commenced use of the mark FX.

Your client is worried that FX Limited may start to use the mark FX and they seek your advice.

Write notes on the advice you would give your client on its position.

(12 marks)

5. Your client, Peepo Ltd, is the proprietor of UK registration 1242701 PEEPO registered in class 25 in respect of "clothing for children and infants". The application was filed in 1984 and was registered in 1986. Peepo Ltd has sold babies clothing continuously since 1985 and turnover in goods bearing the mark has averaged £1 million per year.

Your client has just become aware of use of the mark PO-PO's by a competitor, Popo Ltd. Popo Ltd have used the mark since October 2002 in relation to a range of clothing goods aimed at the baby market. Investigation reveals that Popo Ltd are the proprietors of UK registration 2242412 PO-PO which is registered in Class 25 for "articles of clothing". The application was filed in 1996 and was registered in 1998.

Your client would like to prevent Popo Ltd using the mark PO-PO's.

Write notes on the advice you would give your client.

(12 marks)

6. Outline the requirements for a successful action for passing-off and the evidence which might be filed in support of such an action.

(12 marks)