

THE JOINT EXAMINATION BOARD

PAPER T3

ADVANCED UNITED KINGDOM TRADE MARK LAW AND PRACTICE

Thursday, 21st November, 2002

10.00 a.m – 2.00 p.m.

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

1. You should attempt **FIVE** of the six questions.
2. Each question carries 20 marks.
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 nine pages, including this page

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**Question 1**

Your client applied to register a trade mark ALPHAFAST recently for metal fixings in Class 6.

During the examination procedure, the United Kingdom Trade Marks Registry raised a relative objection based upon an earlier registered trade mark No. 1505050, for the stylised word “alpha” for “screws”, which is owned by Alphabet Inc. Trade mark No. 1505050 was filed on the 1<sup>st</sup> January 1990, and the registration procedure was completed on the 2<sup>nd</sup> February 1991.

Investigations have revealed that Alphabet Ltd, the UK subsidiary of Alphabet Inc, uses the word **ALPHA** as its trade mark, but it is now in a different stylised form from the stylised word as registered, and is used in relation to “nails”. Alphabet Ltd has used the new logo only on invoices in relation to “nails”, and not on the “nails” themselves or their packaging. It has used the new logo for the last six years or so.

Advise your client as to what it might do in order to get its mark registered.

Prepare a draft of any statement of grounds necessary to accompany any TM form to be filed and settle a briefing note outlining all the issues involved, with reference to the relevant case law, including the reasons for choosing the grounds selected and for not including other possible grounds.

## Question 2

Your client is the Association of Poultry Breeders specialising in producing Colchester Redwing chickens. The Association is a body that was incorporated in 1990; and comprises most, if not all, the breeders in the United Kingdom of Colchester Redwing chickens.

The aims and objects of the Association are :-

1. To ensure the purity of the Colchester Redwing breed.
2. To promote the welfare and care of Colchester Redwing chickens.
3. Ensure that breeders observe agreed standards of :-
  - i. Animal husbandry.
  - ii. Strict breeding controls (all hatching eggs come from a controlled source where there is no cross-breeding or hybrids).
  - iii. That all birds which are sold for slaughter are properly and appropriately described as free range and organically fed.

As a result of the efforts of the Association, it has now produced a pure breed renowned for its flavour and texture. Consequently, the Association has extolled the virtues of the Colchester Redwing chicken and the conditions under which the birds are bred and maintained. Television chefs and leading London restaurants now make special mention of Colchester Redwing chicken. Accordingly the bird commands a premium price in high street butchers.

Until the Association started its efforts to control the breed, bringing up the standards of the flocks and improving the methods of egg reproduction, the breed had almost disappeared. Indeed, a similar species of chicken in Europe known as simply the Redwing was popular across Europe in the 18<sup>th</sup> and 19<sup>th</sup> Century, but because of problems with egg production, the species had disappeared. The only viable flocks that were maintained during the 19<sup>th</sup> Century and for most of the 20<sup>th</sup> Century were kept by two specialist breeders based in and around the area of Colchester. As a result of the efforts by the Association, the common term for this type of chicken is the Colchester Redwing and not Redwing.

Your client has learnt that hatching eggs of the pure strain of Colchester Redwing have been sold into Eastern Europe and birds are now being produced in Poland from these hatching eggs. However, stocks are being interbred with local stock strains of chickens. Genetically

the birds that are being produced in Poland could be described as Redwing and generally this is the bird that would have been known as the Redwing during the 18<sup>th</sup> and 19<sup>th</sup> Centuries.

Your client is concerned that once the flocks in Poland have reached a certain size, the poultry could, and would mostly likely, be sold into the United Kingdom. However, as this would undermine the market that has been created by your client, the fear is that the cost and quality would be much lower than chickens bred under the control of the Association.

You have been asked to advise the Association in the form of a memorandum on the steps the Association should be taking to protect the name Colchester Redwing and how they may be able to prevent imports into the United Kingdom of chickens/poultry described as Redwing.

### Question 3

Your client company owns a registration for BULLINGTON GARDEN SOUP CO in respect of "soup and preparations for making soup; milk beverages ; snack foods " in Class 29 and "Snack-bars; catering services; provision of snack foods" in Class 42. It has used the mark extensively in relation to "soups, sandwiches and milk products". It is also operating a number of soup stalls in airports and shopping malls.

Bullington is the name of a historic and well-known food market. In recent years its function has changed but the name is still associated with the market.

The client now informs you that the brand has been changed to BULLINGTON GARDEN FOOD CO and that it plans to extend its product range to include desserts, salads, ready meals, fruit juices and smoothies. The client also says it wishes to register this amended mark for the extended product range. A cursory search reveals a published application to register BULLINGTON GARDEN MARKET covering Classes 29, 30, 31, 32, 33, 35, 36, 37, 39 and 42. The applicant is the Bullington Garden Market Authority and the opposition term will expire in 10 days. The goods and services claimed in Classes 29 and 42 overlap with the goods covered by your client's earlier registrations for BULLINGTON GARDEN SOUP CO.

You agree with your client to oppose the application. You have obtained a copy of the Registry's file in respect of the application to register BULLINGTON GARDEN MARKET. This shows that your client's marks had been cited but subsequently waived following submissions by the applicant's attorneys that the MARKET element in the mark was sufficient to distinguish it from the cited marks. The file also includes a witness statement in which the applicant describes its activities as being the UK's leading centre for the sale and distribution of fresh and frozen fish. The applicant's website states that it was set up by the government to operate and administer the fish market and that it leases trading premises and offices to prospective tenants of the market, but the tenants operate individual businesses for selling fresh and frozen fish.

Draft the Statement of Grounds of Opposition and advise your client by letter as to the type of evidence you believe should be filed in support of the opposition.

**Question 4**

Your client, Saint Blue, S.A., a French company is a manufacturer of aero engine parts and is a competitor of Icarus Limited, the leading manufacturer of engines and spare parts for aircraft.

Icarus have supplied their unique six bladed propellers to the Ministry of Defence (MOD) in the United Kingdom for the past 15 years as well as to the aircraft industry in general. Icarus has been the sole supplier to the MOD. The six bladed feature of the propellers is well known to aero engineers and to the industry as a whole as being associated with Icarus which has always been the sole source of 6 bladed propellers.

The contract between Icarus Ltd and the MOD is to expire in 18 months time. Renewal is currently under review. Icarus have been asked to supply the propellers at a reduced cost if they wish to keep the contract. The MOD have learned about your client's ability to produce propellers more cheaply and have made an approach to it. Your client has been asked to develop its own version of the six bladed propellers at a lower cost. It will win the contract if it can fulfil this provided no obstacle exists to the exclusive supply of these goods for MOD aircraft. Your client is confident that it can develop and produce a competing product to the satisfaction of the MOD. It needs your advice about its freedom to proceed.

Icarus Ltd is the UK registered proprietor of a trade mark consisting of a two dimensional picture of a six bladed propeller. The trade mark was filed on 1<sup>st</sup> March 1996 and registered a year later in March 1997. It is registered for "engine parts for aircraft and parts and fittings thereof in class 12" and had achieved acceptance by the Registrar by reason of having acquired a distinctive character as a result of the use made of it.

Advise your client, in the form of a memorandum, on the issues (ignoring any matters of Patents or un-registered designs).

**Question 5**

Your client is a small producer of cheeses, made organically according to traditional methods. He is a member of a member of a cheese making association which is made up of small producers like himself.

One of his cheeses is made from goats milk according to a traditional method of fermentation developed 50 years ago by Mrs Felicilia Grump. Other members of the association also produce the same cheese made to the same process. All of them make the cheese on a small scale but sales are steady.

The wrapper for your client's cheese bears the legend :-

“produced in the time honoured way, faithfully in accordance with the original method of Mrs Grump”

The wrapper also bears the client's own trade mark.

Lara Dairy Foods Limited is the largest national cheese producer commanding 95% of the market in cheeses made to the methods originally published by Mrs Grump. The company was set up by Mrs Grump's grandson after her death in 1965. Mrs Grump had never produced her cheese commercially but her unique methods were published in family journals and similar publications during her lifetime.

Lara Dairy Foods applied to register MRS GRUMP in 1970. It was advertised before acceptance under Section 18(1) proviso of the Trade Marks Act, 1938 and subsequently registered. The registration is still in force.

Your client has received a complaint from Lara Dairy Foods' solicitors alleging trade mark infringement by you of their clients registered trade mark by reason that you use the words MRS GRUMP in respect of goods which have not connection with their clients.

Other members of the association who made reference by name to “Mrs Grump” in relation to the goats cheese have received similar letters.

Advise your client, in a letter, of his position and the steps you would recommend.

**Question 6**

Your client Fries BV a Dutch company own the following UK registered trade mark:

Mark: FRIES AND MORE FRIES  
No. 2155334  
App Date: 25 October 1997  
Reg Date: 24 September 1998  
Services: restaurant services

You receive notice of an application for invalidation. Your client explains that it instructed its solicitors to start infringement proceedings against another party called Fries Limited. Fries Limited has not yet replied to the solicitors' letter of claim but has applied to the Trade Marks Registry for invalidation of your client's registered trade mark.

Fries BV has a successful chain of restaurants called FRIES AND MORE FRIES throughout Europe but have not yet traded in the UK because it has been trying to find a UK franchisee for 12 years. Ist has finally found one. The prospective franchisee plans to open a first branch of FRIES AND MORE FRIES in Central London immediately and to open at least 50 branches throughout the UK within three years. The European restaurants sell very good stir fried vegetables and other dishes, and it is expected the franchisee will have a similar success in the UK.

The sections of the application for invalidity under S.47(1) read as follows:

- 1. The applicant is the owner of a protectable goodwill by virtue of its operation of a restaurant called Fries at 120 Finkle Street, Kendal. Kendal is in the heart of England's famous Lake District. It was started in 1992 and is visited by local people*



*and by thousands of tourists each year from throughout the UK and the world. The restaurant is publicised widely in travel and restaurant guides in books and on websites including through the applicant's own web site [www.fries.co.uk](http://www.fries.co.uk). The applicant will demonstrate in evidence that use of the identical name will give rise to a misrepresentation leading to damage of its goodwill.*

Your client tells you that its research has confirmed the existence of this restaurant. It has only twenty tables but is always busy and is much frequented by tourists. It specialises in fried potato as part of a varied menu.

- 2. The mark consists essentially of the word fries which is a common abbreviation for a stir fried vegetable dish, consisting typically of potato but also swede, parsnip or other vegetables. As such it is lacking in distinctive character and/or is a sign or indication which may serve, in trade, to designate characteristics of restaurant services*
  
- 3. The mark is registered in bad faith. The identical mark was originally registered under No.1919500 on 26 October 1990 for the same services by the same Fries BV. The mark was not used at all during the period of its first registration and was re-registered under No.2155334 in a spurious attempt to revalidate the rights of the proprietor.*

Your client tells you that it did have a first registration No.1919500 but it did not renew that registration because the mark had not been used and the registration was vulnerable to cancellation, it re-registered the mark in 1997.

Your client wants you to attend a meeting with its solicitors and barrister.

- a) Make notes on the strength of each of the grounds of invalidation.
- b) Give brief recommendations on how your client should proceed.