

THE JOINT EXAMINATION BOARD

BASIC UNITED KINGDOM TRADE MARK LAW – PAPER T1

7th November 2003

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 4 pages, including this page

PAPER T1

BASIC UNITED KINGDOM TRADE MARK LAW

7th November 2003

3.00 p.m. – 5.00 p.m.

PART A – Answer eight questions from Part A

1. Explain “honest concurrent use”.
(5 marks)
2. List five defences that are available to the infringement of a trade mark registered under the Trade Marks Act 1994.
(5 marks)
3. According to Section 21 of the Trade Marks Act 1994 (Remedy for groundless threats of infringement proceedings), in what circumstances might relief be sought for groundless threats of infringement? What relief is available to a person bringing such an action?
(5 marks)
4. How is infringement of a registered trade mark defined by Section 10 (Infringement of registered trade mark) of the Trade Marks Act 1994?
(5 marks)
5. What is the meaning of an “earlier trade mark” as defined in the Trade Marks Act 1994 (Section 6)?
(5 marks)
6. Once a non-exclusive licence has been recorded, what are the general provisions as to the rights of the licensee in case of third party infringement of the licensed mark?
(5 marks)
7. List five grounds for invalidating a UK trade mark registration under the Trade Marks Act 1994 (Section 47, Grounds for Invalidity of registration)?
(5 marks)
8. When does “acquiescence” arise and what are the effects of acquiescence under the Trade Marks Act 1994 (Section 48, Effect of acquiescence)?
(5 marks)
9. A person guilty of an offence under Section 92 of the Trade Marks Act 1994 is liable to imprisonment or a fine. Outline five offences under the provisions of Section 92 (unauthorised use of trade mark in relation to goods).
(5 marks)

PART B – Answer five questions from Part B

10. Kost-Kut Limited is a leading supermarket chain operating throughout the United Kingdom. Kost-Kut has filed a UK Application (No: 2777888) for the mark WHEELY WHIRLY in respect of “confectionery; chocolate; chocolates” (Class 30). The Trade Marks Office has cited a prior registration of Konfekt GmbH for WHIRLY WHEELS (No. 1222333) registered for “liquorice confectionery” as an obstacle to the progress of Kost-Kut’s application. Registration of this mark was completed on 28th May 1997.

In note form consider how Kost-Kut might overcome this objection.

(12 marks)

11. You act for Cybernet Limited. Your client provides a service in the nature of a free to use search engine which is accessed at www.holygrail.com which prominently displays HOLYGRAIL as a trade mark (“TM” appears next to the word) when the site is entered.

Cybernet has been providing services under the HOLYGRAIL mark for the past 3 years. There has been extensive advertising for this site and the service is quick and reliable. It is fair to say that the HOLYGRAIL site would be known to most users of the Internet in the UK.

HOLYGRAIL is not registered as a trade mark.

Your client reads in “PC News Weekly” that a company called Xylon Limited is intending to launch a new search engine to be accessed at www.findingthehollygrail.com.

Leaving aside Nominet dispute resolution procedures, write notes on the advice you will give to your client.

(12 marks)

12. Outline the stages of a revocation action before the UK Trade Marks Registry under Section 46(1)(a) and (b) of the Trade Marks Act 1994. Include reference to deadlines that will be imposed by the Registrar. What forms are required and what formal requirements must be met?

(12 marks)

13. Your client Partons Inc are the proprietors of UK registration 2234478 PARTONS AND DEVICE which was filed on 24 February 1997 and became registered on 26 January 1998. It is registered in class 18 in respect of “bags” and in class 25 in respect of ‘coats and gloves’.

They first used the PARTONS AND DEVICE mark in the UK in 1950 and initially enjoyed great success with their range of coats and driving gloves. In 1992 they stopped selling any products in the UK (but continued with their US operation).

In 1998 they recommenced sales of driving gloves throughout the UK with reasonable success under the mark PARTONS (word only). In December 2002 they decided to test the UK market again and placed a total of 60 coats for sale under the PARTONS AND DEVICE mark (as registered) in six stores in central Manchester. 50 coats were sold at £30 each. No bags have been sold since 1992.

Your client is concerned about the possible vulnerability of its UK trade mark registration. In note form provide your client with advice.

(12 marks)

14. Discuss the principles of the law of Passing Off. (12 marks)

15. Your client, Monkey Ltd, has been using the trade mark MONKEY in the UK for over 30 years. They started with a vehicle repair business and subsequently expanded to vehicle sales (since 1980) and vehicle cleaning preparations (since 1990). Use has been extensive throughout the UK.

The trade mark MONKEY is registered in the UK in relation to “preparations for cleaning vehicles (class 3); engine oils” (class 4), “motor vehicles” (class 12) and “vehicle repair services” (class 37). The registration was completed in January 1997.

They have become aware of the recent launch in the UK of a range of motor vehicle brake fluids under the trade mark MONKEY and seek your advice as to the action they may be able to take to bring about a discontinuance of same.

Advise your client in note form of the causes of action which may be open to them. (12 marks)