

THE JOINT EXAMINATION BOARD

PAPER T2

BASIC UNITED KINGDOM TRADE MARK PRACTICE

Tuesday, 11th November 2003

2.00pm – 5.00pm

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. Each question in Part A is worth 5 marks. Each question in Part B is worth 12 marks.
3. Where a question permits, reasons should be given for the conclusions reached.
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.**
10. This paper consists of five pages, including this page.

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Questions

Part A

1. State when the following UK trade mark registrations will next become due for renewal:
 - a) A registration resulting from a UK trade mark application filed on 26 May 2003, where the application fees were paid on 10 June 2003.
 - b) A registration resulting from a UK trade mark application filed on 10 May 1990, claiming priority from a French trade mark registration filed on 14 November 1989.
 - c) A registration resulting from the merger of three UK trade mark registrations with filing dates of 19 January, 9 February and 30 March 1982.
 - d) A registration resulting from a UK trade mark application filed on 1 October 1992, registered on 9 December 1994.

(5 marks)

2. List **five** grounds on which a UK trade mark application can be opposed. (Note that merely listing the relevant Section or Subsection Numbers of the Act (e.g. Section 200(4)(m)) will receive no marks).

(5 marks)

3. Discuss briefly the inherent registrability of **two** of the following trade marks under current UK Trade Mark Registry practice:
- HI-TEC for “audio visual apparatus”
 - MAXICOVER for “insurance services”
 - CARWATCH for “vehicle alarms”
 - ATLANTIC for “frozen fish”

(Marks will also be given for identifying the nature of any objections that may be raised by the Registry against these trade marks).

(5 marks)

4. Explain what is meant by and give **three** examples of a “Registrable Transaction” under the Trade Marks Act, 1994.

(5 marks)

5. Explain the terms “disclaimer” and “limitation” in the context of the Trade Marks Act, 1994 and their effect, if any, on the rights accorded to the proprietor of a UK trade mark registration under that Act.

(5 marks)

6. An objection has been raised to your client’s application that some of the goods claimed have been incorrectly classified on the application form. You have been informed of the correct class in the Examination Report. Write brief notes on the action you could take in response to the objection.

(5 marks)

7. List the **four** grounds on which a UK trade mark registration can be revoked under Section 46 (Revocation of registration) of the Trade Marks Act 1994.

(5 marks)

8. List **five** defences to trade mark infringement available under Section 11 (Limits on effect of a registered trade mark) and Section 12 (Exhaustion of rights conferred by registered trade mark) of the Trade Marks Act 1994. Candidates should also mention any limitations that are placed on these defences in Sections 11 and 12.

(5 marks)

9. List the procedural stages that a UK trade mark application may go through from filing up to registration, including any action that may be instigated by a third party. A detailed analysis of the individual procedures is not required.

(5 marks)

Part B

10. A client has contacted you regarding a new brand that they want to register and use in the United Kingdom. The mark is CLOUDBURST with the device of a rain cloud in respect of car accessories. Advise your client, **in the form of a letter**, on the searches and investigations they should undertake to clear the new trade mark for registration and use in the UK. Explain the reasons for each search and/or investigation you recommend.

(12 marks)

11. Your client wishes to oppose a trade mark application in the United Kingdom. List the procedural steps involved in filing an opposition and all subsequent actions that are required by both parties up to the final decision of the Trade Marks Registry. Candidates are expected to mention the official deadlines, if any, that will be set for each action and whether or not these deadlines are extendible. However, a discussion of the Appeals process is not required.

(12 marks)

12. Your client, Kids Clothes Inc., wishes to register and use the trade mark BLUE STAR for a range of children's footwear in the UK. The mark is not yet in use. A preliminary search has revealed the following earlier marks:

- (a) UK trade mark registration no. 1600000 for BLUE STAR covering "articles of clothing for women" filed on 1 May 1993 and registered on 25 October 1994 in the name of Everwear Limited.
- (b) UK trade mark application no. 2500000 for a Device of a Star covering "footwear" filed on 2 January 2003 in the name of Clothesline Limited.

Assuming that your client proceeds to file a UK trade mark application for BLUE STAR covering children's footwear, write notes on how official objections based upon these earlier marks might be avoided or overcome. Also comment on the effect these two earlier rights could have on your client's freedom to use the trade mark BLUE STAR in the UK in respect of children's footwear.

(12 marks)

13. Your client has applied to register a 3D representation of its five pointed star shaped chocolate snack at the UK Trade Marks Registry. The application has been refused on the basis that it is devoid of distinctive character. You have advised your client to submit evidence of its longstanding and substantial use of the mark in the United Kingdom. Discuss, in note form, the nature of the evidence that you might submit to the Registry.

(12 marks)

14. You have been introduced to a client with no previous experience of trade marks, whose company has just started trading in the UK. Your client has a trade mark which he wants to start using in the near future on goods that will be sold throughout the UK. Soon after that, he also intends to begin selling the trade marked goods over the internet. He has read stories in the press about traders being forced to change their trade marks because of legal actions brought by their competitors. He has also read about trade marks, such as escalator, becoming generic names. He wishes to avoid these pitfalls. Provide a checklist of what your client should do now and in the future to protect his trade mark position and internet activities, to avoid unwanted trade mark infringement actions being brought against him and to ensure that, by the correct use of his trade mark, his mark does not become generic.
- (12 marks)**

15. A colleague has given you a Notice of a revocation action with a Statement of Grounds filed by a major competitor of one of your firm's clients against one of the client's UK trade mark registrations. This Notice was received by your firm from the UK Trade Marks Registry two months ago and has not yet been reported to the client. The Notice alleges that your client's mark has not been used in the UK in respect of the registered goods during the past five years. You have not previously dealt with this client and have no previous knowledge of the mark involved. Ahead of reporting this revocation action to your client, provide an aide memoire that lists,
- The points that you will bring to the client's attention,
 - The questions that you will want the client to answer,
 - The options that are available to your client, and
 - Any other matters or actions that you think are relevant to this case or that you think should be taken by the client as a matter of urgency.

(12 marks)