

THE JOINT EXAMINATION BOARD

PAPER T2 – Basic UK Trade Mark Practice

Tuesday 8th November 2005

2.00 p.m. – 5.00 p.m.

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

1. You should attempt **EIGHT questions in Part A** of this paper and **FIVE questions in Part B**.
2. **FIVE MARKS** are available for each answer in **Part A** of this paper, and **TWELVE MARKS** are available for each answer in **Part B**.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (**T2**), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not staple or join pages together in any way;
 - e. Do not state your name anywhere in the answers;
 - f. Write clearly – examiners cannot award marks to scripts that cannot be read;
 - g. Reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s).

NO WRITING OF ANY KIND IS 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 put them in the WHITE envelope provided. **Any answer script taken out of the examination room will not be marked.**

This question paper consists of SEVEN pages (including this instruction sheet)

PART A – FIVE MARKS PER ANSWER**Question 1**

Calculate the next renewal dates for the following registrations, which are all currently in force:

- a. A registration resulting from a UK trade mark application filed on 13 May 1989 and registered on 4 November 1990, claiming priority from a French trade mark application filed on 31 March 1989.
- b. A registration resulting from a UK trade mark application filed on 1 November 1994, and registered on 2 August 1995.
- c. A registration resulting from a UK trade mark application filed on 27 May 1963, claiming priority from a US trade mark application filed on 23 December 1962, registered on 2 January 1965.
- d. A registration resulting from the merger between one UK trade mark registration in Class 18 with a filing date of 22 October 2000, claiming priority from a Community Trade Mark filed on 20 August 2000, registered on 17 June 2001, and another UK trade mark registration in Class 25 with a filing date of 23 December 2001, with no priority claim, registered on 11 August 2002.

Question 2

What is meant by “co-ownership” of a registered trade mark under Section 23 of the Trade Marks Act 1994, and what effects does this have as between the co-owners? *(You do not need to deal with infringement aspects.)*

Question 3

List five ways in which an application filed under the UK Trade Marks Act 1994 may be amended.

Question 4

Explain what is meant by “offensive” trade marks, and outline the UK Trade Marks Registry’s practice in relation to them.

(Question 5 follows on the next page)

Question 5

Comment on the registrability of **TWO** of the following four marks (*for the purposes of this question you should assume that the marks are as yet unused*):

- a. **SILKPOINT** in respect of “scarves”
- b. **SUREFIT STAINLESS** in respect of “exhausts for cars”
- c. **LUCKY CAT LITTER** in respect of “agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables, seeds, natural plants and flowers; foodstuffs for animals; malt; cat litter.”
- d. **SWISSTEC** in respect of “watches”

Question 6

Your client is the owner of a UK trade mark registration covering various services in Class 42, dating from 1998. Following the adoption of the Eighth Edition of the Nice Classification, some of the services in your client’s registration now belong in Class 43. Summarise the UK Trade Marks Registry’s practice in relation to re-classification in these circumstances.

Question 7

Explain the terms “**disclaimer**” and “**limitation**” as they apply to trade marks in the UK, and give an example of each explaining the circumstances in which each is used.

(Question 8 follows on the next page)

Question 8

- (a) To obtain a filing date for a new trade mark application in the UK, is it necessary to specify the numbers of the classes in which you require protection?
- (b) To obtain a UK trade mark registration, is it necessary to specify the numbers of the classes in which you require protection?
- (c) Would the UK Trade Marks Registry accept for registration an application that quotes the Class Heading* to describe the goods or services for which you require protection?
- (d) If your UK trade mark registration uses the Class Heading* to describe your goods or services, does this mean that your protection extends to everything in that class?
- (e) If you apply in a single class, but describe goods that fall in more than one class, what is likely to be the UK Trade Marks Registry's response?

** Note: "Class Heading" means the general indications of the goods and services which belong in principle to each Class, as set out at the beginning of the Nice Classification.*

Question 9

- (a) Explain, briefly, what is meant by "sole", "exclusive" and "non-exclusive" trade mark licences.
- (b) List four things a trade mark licence should contain.

(Part B Questions begin on the next page)

PART B – TWELVE MARKS PER ANSWER**Question 10**

- (a) Your client has created a new trade mark which you have cleared for use in the UK. Provide a list of recommendations to your client as to why they should file an application to register the mark. (5 marks)
- (b) Your client has followed your advice and obtained registration of the trade mark. Provide a list of points on the correct usage of the trade mark, using examples where necessary to illustrate your advice. (7 marks)

Question 11

Your client wishes to use and register in the UK their new brand **DOGGYTASTIC**, together with a cartoon device of a dog with a bone, in respect of animal foodstuffs.

What checks and searches would you consider necessary in order to clear the mark for use and registration? Give reasons for each recommendation.

Question 12

List, in note form, the procedural steps involved in opposition proceedings under the UK Trade Marks Act, and the steps required by both parties, up to and including the final decision of the Trade Marks Registry. In doing so, indicate the deadlines involved, and state whether such deadlines are extendable. *(You should make it clear whether use of an official form is compulsory at each stage, but it is not essential to quote the form number.)*

(Question 13 follows on the next page)

Question 13

Your client has a UK trade mark registration obtained in 2002 for “Chocolate decorations for Christmas trees” featuring a stylised representation of his personal name, and he has started to use it in a slightly modified way. The owner of an earlier UK trade mark registration covering “Easter eggs” has written to you claiming that your client’s use is infringing his mark. Your client is worried that he will be prevented from using his mark.

You have checked the details of the third party’s mark and conclude that, although not identical, it is indeed sufficiently similar to your client’s mark to be a concern.

Advise your client of his available options. *(There is no need to advise on “passing off” or on the legal remedies he may face if the third party decides to sue.)*

Question 14

UK trade mark applications routinely face objections on the grounds of lack of inherent distinctiveness. Explain why each of the following types of mark might be objected to (*you should assume in each case that the mark has not yet acquired distinctiveness through use*):

- a. Marks starting with “e-” or “i-”, for use on computer software
- b. Marks consisting of a single colour
- c. Marks consisting of a smell
- d. Marks consisting of a surname
- e. Marks consisting of a geographical name
- f. Marks consisting of a single numeral

(Question 15 follows on the next page)

Question 15

Your client makes a range of ceramic animal characters as garden ornaments and sells them under the name “**The NUTWOOD Range**”. He commenced trading in 1990, supplying just 20 or 30 items a month to his local garden centre. His products were immediately very popular and his business began to expand. In 1996 he read a newspaper article about trade marks and decided he should register his own. He contacted the Patent Office, obtained an application form, and completed it himself, obtaining a registration for the words “**The NUTWOOD Range**” in respect of “Ceramic animal characters (garden ornaments)”. He now supplies to garden centres throughout the South of England. Your client is planning even further expansion and this year commenced advertising his products in the national press and gardening magazines, and on the Internet, for sale by mail order.

Your client has now contacted you to say that he has received a “letter before action” from The Garden Plastics Company. This is a new company based in Yorkshire that commenced trading in 2003 and claims to be the owner of the trade mark **NUTWOOD** dating from 2003 for “Garden ornaments made of plastic”. The company also recently acquired (by purchase from a third party) another registration of the mark **NUTWOOD**, dating from 1975 and covering “Garden tools”. **NUTWOOD** garden tools have been continuously on sale in the UK since 1976.

The Garden Plastics Company accuses your client of infringing both of these trade marks and demands that he stops using the name “**The NUTWOOD Range**” immediately.

Your client is outraged that The Garden Plastics Company is “attempting to steal his fame and reputation” in this way and asks what he should do. You have checked the Trade Marks Registry’s database and discover that The Garden Plastics Company is indeed the owner of two registrations of **NUTWOOD**, as they have claimed.

In note form, set out the advice you will give your client, and the reasons why.

(End of questions)