

THE JOINT EXAMINATION BOARD

PAPER T3

Advanced United Kingdom Trade Mark Law and Practice

Wednesday 9th November 2005

10.00 a.m. – 2.00 p.m.

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

1. You should attempt **FOUR** questions. All questions carry **25 marks**. If more questions than necessary are attempted, they will be marked in the order presented and questions over the required number will be ignored.
2. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
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 (**T3**), 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. Please do not staple or join pages together in any way;
 - e. Please do not state your name anywhere in the answers;
 - f. Please write clearly, it is difficult for examiners to 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.**
5. **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.

The paper consists of 11 pages including this page

1. You act on behalf of Cool Fashions Limited, a manufacturer and retailer of menswear since the 1970's. In January 1999, your client decided to launch a new range of menswear, specifically off the peg suits, jackets and blazers. The name chosen for this range of clothing was CITYBOY. In order to promote this new range, your client commissioned a series of advertisements. These advertisements appeared in national fashion magazines, the local and national press and on bill boards across the country. Each of these adverts used the slogan, "CITYBOY, THE IMAGE OF SUCCESS". The campaign has been so successful that the CITYBOY range, which now includes accessories such as belts, tie pins, cuff links and ties, is now sold in specialist outlets in major department stores in London, Manchester, Glasgow and Bristol. These outlets are managed by your client. Your client continues to promote the CITYBOY range, and continues to use its slogan prominently in all these advertisements. Indeed, your client believes that, whilst it has only ever used the slogan as "CITYBOY, THE IMAGE OF SUCCESS", the phrase "THE IMAGE OF SUCCESS" is now synonymous with the CITYBOY range and, ultimately, your client.

Your client secured the following trade mark registrations through your firm, namely: -

- 1) UK Registration No. 2555501
THE IMAGE OF SUCCESS
Class 25:
Clothing; footwear; headgear
Date of filing: 19 November 1999
Date of Registration: 25 July 2000
- 2) UK Registration No. 2555500
CITYBOY
Class 25:
Clothing; footwear; headgear
Date of filing: 19 November 1999
Date of Registration: 20 July 2000

In October of this year, you have received notification from the Trade Marks Registry that your client's UK Trade Mark Registration No. 2555501 has received an application for revocation by Yuppie Clothing Limited. The Application for revocation is attached.

Write a memorandum to your client outlining:-

- (i) Advice on the steps you propose to take.

- (ii) Evidence and further information that you will need from your client.
- (iii) Advice to your client on the consequences of success or failure in the action.
- (iv) What other actions you would recommend to strengthen your client's position.

You are expected to make reference in this memorandum to relevant case law

(25 marks)

**Form TM26(N)****Official fee £200 due with this form**

Application to revoke a registration or a protected international trade mark (UK) for the reasons of non-use

**The Patent Office
Trade Marks Registry**
Cardiff Road,
Newport
South Wales
NP10 8QQ

Please refer to notes for guidance on completing this form.

1.	Trade mark number	Number(s) 2555501	(Lowest) Class 25
2.	Full name of registered proprietor	Cool Fashions Limited	
3.	Full name, address (including postcode) of the applicant for revocation	Yuppie Clothing Limited 1 Silk Street London UK	
4.	Name and address (including postcode) of the agent (if any)		
5.	Are you basing your application on Section 46(1)(a), 46(1)(b), or both?	46(1)(a)	
6.	If you are basing your application on Section 46(1)(b), within what 5-year period do you say the mark was not used?		
7.	From what date do you want revocation to take effect?	1 September 2005	
8.	Declaration	I declare that to the best of my knowledge there is no action concerning the registration pending the courts. I believe that the facts stated in the attached statement of case are true.	
	Your signature		
	Your name in BLOCK CAPITALS	YUPPIE CLOTHING LIMITED	
	Date	1 October 2005	
9.	Name and daytime phone number of the person we should contact in case of query.		
	Your reference		
	Number of sheets attached to this form.	This is sheet 1 of 2	

Note You must attach a statement of your reasons for making this application.

TM26(N)

TRADE MARKS ACT 1994

IN THE MATTER OF UK
Trade Mark Registration
No. 2555501 THE IMAGE
OF SUCCESS in class 25
in the name of Cool
Fashions Limited
-and-
Application for revocation
thereof by Yuppie
Clothing Limited

STATEMENT OF CASE

1. The Applicant for revocation asks that UK Registration No. 2555501 ("the Registration") be revoked in accordance with Section 46(1)(a) of the Trade Marks Act 1994 since, within the period of five years following the date of completion of the registration procedure, the trade mark that is the subject of the registration has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods for which it is registered, and there are no proper reasons for non-use.
2. The Applicant asks for revocation of the registration in its entirety by virtue of Section 46(1)(a) of the Trade Marks Act 1994 or, in the alternative, in part of by virtue of Section 46(5) of the Trade Marks Act 1994, and an award of costs to be made in its favour. The Applicant asks for revocation of the registration from 1 September 2005.

Yuppie Clothing Limited
1 October 2005

2. You have a meeting with a potential new client from a company called Sythe Limited who make specialist computer software for creating DVDs. The Managing Director provides you with a copy of his trade mark registration no. 1801510 for SYTHE in Class 9 for computer software. The registration was due for renewal on 20 December 2004 and was being handled by their trade mark attorneys Lionel Hutz LLP. The Managing Director received a letter informing him that the renewal was due. He emailed the formalities assistant at Lionel Hutz LLP requesting specific information on the cost. A secretary in the formalities department of Lionel Hutz LLP telephoned the Managing Director in response to the email informing him that the assistant dealing with this matter had left Lionel Hutz LLP and somebody would contact him with the information he had requested. The Managing Director informs you that he recalls the first telephone call but heard nothing more from Lionel Hutz LLP and was reminded of the matter a few weeks ago when he came across the earlier reminder and his email. On checking the Register you discover that the registration no. 1801510 was not renewed.

Furthermore, you discover that an application was filed for CYTHE (stylised) in Classes 9 and 42 for computer software for designing websites and computer services under trade mark application no. 2247895 on 3 January 2005 and the mark was advertised on 5 November 2005. The application has been filed in the name of a firm of design consultants who had provided your client with draft artwork for its website but the artwork was not deemed suitable.

Prepare a memorandum detailing the points you will wish to discuss at the meeting.

(25 marks)

3. Your client Rod Simmons is the lead singer in the rock music band Drive Shaft. Your client explains to you that he started his band 3 years ago and they have decided to seek advice as to the protection of their band name. They are due to appear in a concert to be held in Hyde Park in January 2006 and the concert will be televised worldwide. In the last 3 years they have been playing at small venues and did not see the need for any kind of protection.

His band has also been using a logo which consists of a burning guitar but there have been variations on that design over the last 3 years. The fans are keen to buy memorabilia and some local traders have been selling T shirts, key rings, mouse mats and caps at the various venues and Rod now wants this stopped since he is negotiating licences for the same and similar merchandising products and wishes to extend to souvenir programmes, pins, sweatshirts, stickers and mugs. CDs have been distributed under Rod's own recording company Minted Records.

Rod is also aware of a derogatory website which has been set up using the domain name www.driveshafterarubbish.com. The band does not have a domain name registration.

Advise the client on:-

- (i) How best to protect the trade mark.
- (ii) Steps that can be taken against local traders.
- (iii) What action can be taken against the website.

(25 marks)

4. Your client, Covermagic Plc, has recently applied to register the following mark in the United Kingdom :-

Mark : MORE THAN JUST COSY

Application Date : 25th July 2005

Goods : Class 24 - Bed linen, bedspreads; duvets, duvet covers; quilts; cushions covers.

You have received the attached examination report for your client's application.

Your client advises that its mark is nearly always used with its house mark COVERMAGIC, as "COVERMAGIC ... More than just cosy". Your client's subsidiary company, Covermagic UK Limited, has been using the slogan for around 6 years in relation to its duvets and duvet covers and believes its slogan to be unique. Its use has been widespread in the UK and COVERMAGIC duvets and duvet covers have a significant reputation and are now second only to the brand leader in the market. Covermagic UK Limited has more recently started to use the slogan for its range of complementary bed linen.

Advise your client on the nature of the objection and possible ways of overcoming the objection, making reference to specific case law.

Assuming that you may not be successful with arguments, advise your client on what further steps could be taken to secure registration of its slogan, and what further information you would need from your client.

(25 marks)

EXAMINATION REPORT**Absolute Grounds for Refusal (Section 3)**

The application is not acceptable; there is an objection under Sections 3(1)(b) and 3(1)(c) of the Act because the mark consists exclusively of the words MORE THAN JUST COSY, being a sign which indicates the kind, quality and intended purpose of the goods and is devoid of distinctive character because other traders may legitimately wish to use the sign in the promotion of their goods, e.g., goods which are above expectations for warmth and snugness.

5. Your client is Tintas S.p.A., a well-known Italian motor manufacturer. Around five years ago it produced a new car in its luxury range called the TORREO. Sales in Italy and Continental Europe of the TORREO model have been substantial for the executive car market and the TORREO is now the best selling executive car in Italy. Last year the TORREO won the award for "Best Executive Car" in the German Motor Industry Awards.

Your client has just recently started to plan its launch of the TORREO model in the United Kingdom and advertisements preceding its launch have been made in 3 or 4 of the top motor magazines in the UK for the last three months. Your client's TORREO car is also promoted on its website at www.tintasmotors.com, although orders for the vehicle cannot be taken over the Internet. The car will be sold in the UK by your client's newly-formed subsidiary company, Tintas Autos Limited, which company is to be the exclusive licensee for the United Kingdom. Tintas Autos Limited has reported 200 advanced orders for the TORREO car, mostly to existing customers.

The trade mark TORREO is registered in the United Kingdom with the following details :-

Mark : TORREO [Word]

Application Date : 20th September 2000

Registration Date : 1st February 2001

Goods : Class 12 - Motor cars, lorries, repair trucks; parts and fittings for motor vehicles; tyres; upholstery for vehicles.

Proprietor : Tintas S.p.A.

Your client has recently come to learn that one of its major competitors, a UK motor manufacturer called Simpa Motors, is planning to launch a new model in the UK called the TARREA. This model is going to be a mid-range family saloon and your client has come to you for advice on whether it can do anything to stop the use of the name TARREA in the UK. A search of the Trade Marks Register reveals that Simpa has already applied to register its mark in the UK, as follows :-

Mark : TARREA [Word]

Application Date : 10th June 2005

Advertised : 1st November 2005

Goods : Class 12 - Automobiles and parts and fittings therefor.

Advise your client on possible grounds of opposition, and the merits of each ground, to the TARREA mark and what other actions your client could take to safeguard its position.

(25 marks)

6. You act on behalf of the Celtic Language Association, a registered charity mainly concerned with promoting the Celtic language both worldwide and particularly within Wales and Scotland. Your client is supported by voluntary contributions from the public including testamentary gifts as well as some membership subscription. The membership stands at about 2,000 people. The value of such donations is in the order of £10million per year. As a result, your client is able to sponsor events focusing on the Celtic language, to organize research and to provide certain other educational services. Your client engages in its fundraising on both a local and a national level. Some of the local branches of the Celtic Language Association which cover the activities go under the guise or style of e.g. the Cardiff Celtic Language Society.

A year ago, two individuals Mr Glenn and Mr Dower became disenchanted with the way in which the Celtic Language Association was being run and appeared on a television programme criticising your client. As a result, Mr Glenn and Mr Dower were expelled from the Celtic Language Association. Mr Glenn and Mr Dower then set up the Celtic Language Foundation as a company limited by guarantee but without charitable status. Your client has recently learnt of the name adopted by Mr Glenn and Mr Dower and believes that he has at least one e-mail which shows a donation being misdirected to the Celtic Language Foundation.

Your client explained that whilst they themselves are a charity and do not make a profit, they work in association with a small company which sells T-shirts, language tapes, and which assists in the organization of musical and other entertainment events. It produces no other goods. This associate, Sharp Limited, owns a Community Trade Mark registration for the word CELTIC registered in Class 25 in respect of clothing, footwear and headwear and in Class 9 in respect of sound and audio and visual recording apparatus; tapes, disks, records for recording and playing sound and visual images; computers and computer software and parts and fitting for all such goods. The mark was registered in 1998.

There is a particular concern because the Celtic Language Foundation are starting to produce traditional bardic robes under the label CELTIC and are organizing a festival of traditional druidic song and dance under the mark TRUE CELTIC LANGUAGE.

You are asked to advise your client what causes of action are open to them and what are the strengths and weaknesses of their case. You are not expected to comment on the law relating to registered charities.

(25 marks)