

**THE JOINT EXAMINATION BOARD**

**Paper T1 Basic United Kingdom Trade Mark Law**

**Thursday 1<sup>st</sup> November 2007**  
**Time of Examination: 3.00pm – 5.00pm**

Please read the following instructions carefully. *Time allowed – 2 hours*

1. You should attempt **EIGHT** questions from Part A and **FIVE** questions from Part B.
2. There are a maximum number of five marks allotted to each question answered in Part A and a maximum of twelve marks allotted to each question answered in Part B. If more than the required number of questions are answered in any Part, then the final question of that Part will not be marked.
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 (T1), 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 and only 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**

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.

**This paper consists of 5 pages including this page.**

**Paper T1 Basic United Kingdom Trade Mark Law****PART A**

- 1) Under the UK Trade Marks Act 1994, where a registered trade mark is granted to two or more persons jointly as co-proprietors, what rights in the trade mark is each person entitled to, and what limits are placed on those rights?
- 2) Under the UK Trade Marks Act 1994, what are the requirements for filing a Trade Mark Application?
- 3) Under Section 48 (Effect of Acquiescence) of the UK Trade Marks Act 1994, what are the provisions relating to acquiescence?
- 4) Under the UK Trade Marks Act 1994:
  - (a) In what ways can ownership of a registered Trade Mark be transferred?
  - (b) In what ways can the transfer be limited?
- 5) Under the UK Trade Marks Act 1994, what is an “earlier trade mark”?
- 6) (a) What provision is made in the UK Trade Marks Act 1994, for the exhaustion of rights conferred by a registered trade mark?  
(b) In what circumstances do the provisions not apply?
- 7) Who may claim priority under Section 35 (claim to priority of Convention application) of the UK Trade Marks Act 1994, and what is the effect of a successful claim to priority?
- 8) In the UK Trade Marks Act 1994:
  - (a) What is a collective mark?
  - (b) What is a certification mark?
- 9) According to Section 11 (limits on effect of registered trade mark) of the Trade Marks Act 1994, what are the limits on the effect of a registered trade mark?
- 10) What provisions exist in the UK Trade Marks Act 1994 for:
  - (a) disclaimers? and
  - (b) limitations?

**Part B Questions****11)**

Your client, Denise Adam, for many years operated a successful business supplying savoury pies to a football ground in her local area. Some changes have taken place in the business recently, particularly following relegation of the football team. The savoury pie business has dropped off (there being fewer attendees at home games) and Ms Adam has decided to expand her business into producing sweet fruit pies for other occasions. She has recently remarried and now goes by the name of Denise Smith.

She holds the UK Trade Mark Registration for GRANNY ADAM'S PIES covering savoury pies in Class 30. Following her marriage and the restructuring of the business she now plans to trade as "Granny Smith's Pies" after her favourite type of apple, Granny Smith's. She thinks this will be a particularly good name for her apple pies. She approaches you about altering her existing trade mark registration to accommodate the business changes.

Outline the advice you would give her

- (a) About altering the existing registration; and
- (b) Any other issues regarding trade mark protection for the new name

**12)**

With reference to appropriate case law, discuss the tests used in the United Kingdom for determining similarity of trade marks, and similarity of goods and services.

**13)**

You act for a cosmetics company called Nexus Limited. Nexus used to sell a NEXUS branded cosmetics cream containing anti-ageing properties. NEXUS is registered in respect of "Cosmetics; moisturising cream" in Class 3. NEXUS was entered on the Trade Marks Register on 30<sup>th</sup> August 1999. Six years ago a UK government embargo prevented the importation into the UK of Iranian bauxite, one of the vital ingredients in NEXUS cream. Consequently, Nexus Limited had to stop selling NEXUS cream. Nexus Limited has been researching alternatives and now believes it may have found a substitute. It has issued advertisements to all purchasers of the cream announcing the soon to be re-launched NEXUS cream. Nexus Limited has approached you as they have received a letter from a company called Braxus Limited. Braxus Limited want Nexus Limited to undertake not to oppose registration of their UK Trade Mark Application for BEXUS in respect of "moisturising cream" in Class 3. Braxus Limited has said that if an undertaking is not forthcoming within two months they will apply to revoke the trade mark registration for NEXUS.

Advise Nexus Limited.

**14)**

Westwood Guitars Ltd own the trade mark WESTWOOD which is used in respect of electric guitars. WESTWOOD guitars are sought after by musicians in the United Kingdom. A number of young musicians with superstar status own a WESTWOOD guitar, because they are good quality and have a good reputation. Westwood Guitars Limited use this to their advantage and for many years have advertised that their WESTWOOD guitars are used by young superstars. As a result many 17 – 24 year olds buy WESTWOOD guitars as they want to own the same brand of guitar as their favourite musician. WESTWOOD is registered as a United Kingdom trade mark for "guitars and parts and fittings for the aforesaid goods" in class 15 under No. 2468567 which dates from 2000.

Westwood Guitars Ltd have become aware, via a Trade Mark Watching service, of advertisement in the UK Journal of an application for WESTWOODS which covers "Guitar strings; music stands" in Class 15; and "Fruit based alcoholic drinks" in class 33.

Westwood Guitars Ltd contact you and ask you to oppose the WESTWOODS application.

- (a) List the possible grounds of opposition.
- (b) Write notes, with reasons, on whether Westwood Guitars Limited could oppose on those grounds.

**15)**

Fritz Schneider, a German National domiciled in Germany, has manufactured spice biscuits in Germany for the last twenty years under the trade mark RENDLINGER. During the last fifteen years there has been considerable promotion of the RENDLINGER biscuits throughout Europe and North America. Sales have been so great throughout Continental Europe and North America that Fritz has been told by his lawyer that his RENDLINGER trade mark qualifies as a famous or well known mark. Fritz has never registered his RENDLINGER trade mark in the United Kingdom, nor has he ever sold RENDLINGER biscuits in the United Kingdom.

On his first business trip to England, Fritz is served some spice biscuits embossed with the trade mark KRISPY RENDLINGER. Fritz is told that the biscuits are made by Dumbo Biscuits Limited and that the biscuits have been available for some time. Fritz says he wants the sale of KRISPY RENDLINGER stopped immediately in the United Kingdom.

Write notes explaining the rights Fritz has in the UK under the UK Trade Marks Act 1994 to prevent Dumbo Biscuits continuing their use of KRISPY RENDLINGER.

**16)**

COUNCIL LORDS is a well-known clothes shop which specializes in the sale of exclusive American brands. The first shop was opened in 1998 on Oxford Street in London by your client, Joe Ferrick. Since then there has been a continuous programme of expansion. There are now at least two or three COUNCIL LORDS shops in each of eleven major cities throughout the United Kingdom. The name COUNCIL LORDS is used on every shop front in the same manner, but the clothing is always branded with the name of the American trade marks. Your client does not sell any own branded COUNCIL LORDS clothing.

Joe filed an application for COUNCIL LORDS in class 25 for "Clothing; footwear; headgear" on 12 May 1999 and the application was entered on to the Register on 14 February 2000.

Joe has contacted you because Mike Brett, the manager of the Birmingham branch of COUNCIL LORDS, has sent Joe some samples of poor quality clothing bearing the trade mark COUNCIL LORDS TOO which he purchased a few days before in a local Cost Saver High Street Clothing Shop which has branches throughout the UK. Mike has assured Joe that he regularly visits the Cost Saver shop and that was the first time he has seen the COUNCIL LORDS TOO clothing.

Advise Joe on the action he can take to prevent use of COUNCIL LORDS TOO, setting out any possible problems he might face.