

THE JOINT EXAMINATION BOARD
PAPER T4 ADVANCED TRADE MARK SEARCH

Tuesday 6th November 2007

Time of Examination: 10.00am – 1.00pm

*Please read the following instructions carefully. Time Allowed – **3 HOURS***

1. This paper consists of a single question for which there are **100 marks**.
2. 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 (T4), 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 state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. Reasoning should always be given where appropriate.
3. 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.
4. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of 13 pages including this page.

T4 2007 - QUESTION

You act for Wheelers of Norwich Limited, a company incorporated in England in 1985. Since 1985 your client has operated a chain of petrol stations in Norfolk, Suffolk, Cambridgeshire and Lincolnshire using the trade mark WHEELERS. Apart from selling petrol and diesel these petrol stations have provided car washing and car maintenance services and have mini shops selling engine and brake oils, brake fluid, newspapers, magazines and maps.

Since 2004, your client has sometimes used the trade mark WHEELERS in conjunction with the strap line MILES BETTER OFF. The combination WHEELERS MILES BETTER OFF has primarily been used on radio and television advertising for the petrol stations.

Your client would now like to introduce a loyalty card as shown in the image below for use at its petrol stations. Essentially, the card would allow customers to earn points from the purchase of goods and services, which could then be redeemed against products in the petrol stations. Your client's designers have created the following card.



Your client queried the need to search WHEELERS because of the use that had been made of it, but you advised otherwise and, with your client's approval, you have carried out the following searches for the marks WHEELERS, MILES BETTER OFF and Arrows logo for the following goods and services, the results of which are attached:

Class 1: Brake fluid, oils for brakes.

Class 4: Petrol, diesel fuel, oils for automobiles, oils for engines.

Class 9: Magnetic cards.

Class 16: Newspapers, magazines, maps, stationery.

Class 35: Organisation, operation and supervision of customer loyalty schemes; retail services connected with the sale of a variety of brake fluids, oils for brakes, petrol, diesel fuel, oils for automobiles, oils for engines, newspapers, magazines, maps and stationery.

Class 36: Issuing of tokens of value in relation to customer loyalty schemes.

Class 37: Car wash services, car maintenance.

Your client has also conducted a preliminary search of the Internet which has revealed that Wheelers 4U Limited has been in business selling prams, pushchairs, car safety seats for babies and children, baby walkers, bicycles, tricycles, babies disposable napkins, magazines, books, periodicals, publications, toys and games and providing repair services for prams, pushchairs, car safety seats for babies and children, baby walkers, bicycles, tricycles using the trade mark WHEELERS 4U since 1983.


Write a letter to your client advising on its freedom to use and register the trade marks WHEELERS, MILES BETTER OFF and Arrows logo in the United Kingdom for the goods and services for which the searches have been undertaken, indicating any steps which they may take to overcome potential difficulties.

[100 marks]

For the purposes of this paper candidates can choose whether to provide their answer applying the new law and rules concerning the examination of marks on relative grounds as set out in SI No. 1976 of 2007 (The Trade Marks (Relative Grounds) Order 2007 or applying the old law and rules. However, for credit to be given the whole paper must be answered under either the new or the old law and rules (ie no credit will be given to candidates who apply the new law and rules to one search or part of a search and the old law and rules to another search or part of a search).

1. WHEELERS

Trade mark No./ Dates	Trade mark	Information	Goods/services	Owner
UK 1089701 App: 19 Jan 1978 Reg: 20 Jul 1980	SKATE WHEELERS	Registration of this mark shall give no right to the exclusive use of the word "Wheelers".	Class 16: Stationery; cards; magazines; printed matter. Class 30: Non-medicated confectionery.	Swizzels Matlow Limited Carlton House, New Mills, Stockport, Cheshire SK12 3HA
UK 1413261 App: 1 Feb 1990 Reg: 25 Nov 1991 Status: Lapsed 2 Feb 2007	J.R. WHEELER	Advertised before acceptance. Section 18(1) proviso.	Class 1: Preparations, fluids and oils for the removal of oil, grease, dirt, grime and stains; chemical preparations for inhibiting rust; transmission fluid; brake fluid; all included in Class 1. Class 4: All goods included in Class 4. Class 12: Cars, vans, trailers (vehicles); parts and fittings for all the aforesaid goods; all included in Class 12. Class 16: Printed matter and printed publications; all included in Class 16. Class 37: Vehicle services station services; maintenance and repair of land vehicles; polishing of vehicles; rust proofing of vehicles; washing and cleaning of land vehicles; all included in Class 37.	J.R. Wheeler Limited Poole Dorset BH15 1US



<p>CTM 873356</p> <p>App: 10 Jul 1998 Reg: 11 Aug 1999</p>	<p>FREQUENT WHEELER</p>		<p>Class 36: Lease-purchase financing of vehicles, in particular motor vehicles, including lorries.</p> <p>Class 39: Rental of vehicles, in particular motor vehicles, including lorries.</p>	<p>Sixt Aktiengesellschaft Dr.-Carl-von-Linde-Str. 2 82049 Pullach Germany</p>
<p>CTM 1280599</p> <p>App: 15 Aug 1999 Reg: 23 Oct 2000</p>	<p>WHEELER</p>		<p>Class 1: Brake fluid, oils for brakes.</p> <p>Class 9: Glasses, sunglasses, cases for glasses, bicycle computers, helmets, in particular bicycle helmets, all these goods as far as included in class 9.</p> <p>Class 12: Bicycles and parts thereof, as far as included in class 12.</p> <p>Class 28: Sporting articles, as far as included in class 28.</p>	<p>Wheeler International Co. Ltd. 24, Sec. 5, Chung Hsiao E. Road, Taipei, Taiwan</p>
<p>CTM 1406685</p> <p>App: 1 Dec 1999 Reg: 15 Jan 2001</p>			<p>Class 9: Video game software; computer game programs; computer game cartridges, discs and cassettes; game cartridges, discs, cassettes and circuit boards containing game programs for use with hand-held or arcade video game machines with built in screens.</p> <p>Class 28: Video game machines, hand-held video game machines and coin or counter-operated arcade game machines, none being for use with television receivers; electronic games and amusement apparatus other than for use with television receivers; parts and fittings for the aforementioned goods.</p>	<p>Sega Corporation 2-12, Haneda 1-chome, 144-0043 Ohta-ku, Tokyo, Japan</p>



CTM 1608900 App: 13 Apr 2000 Reg: 30 Jul 2001	Mr. Wheel		Class 12: Wheel rim and tyres. Class 37: Repair, in particular for automobiles, mainly axle measuring and balancing.	Haweka Auswuchttechnik Horst Warkotsch GmbH Schulze-Delitzsch-Str. 21 Burgwedel 30938 Germany
UK 2247913 App: 6 Oct 2000 Reg: 25 Jan 2002	WHEEL		Class 35: Marketing services; advertising services; promotion and publicity services; business consultancy services; business planning and development; organisation of exhibitions for business or commercial purposes; advisory and information services, all relating to the aforesaid services. Class 42: Design services; creating and maintaining web sites; web site design; design of advertising material; creation, design, development, installation and maintenance of software and middle-ware; writing and programming of computer software; advisory and information services, all relating to the aforesaid services.	Wheel Limited 85 Clerkenwell Road, London EC1R 5AR
UK 2301707 App: 29 May 2002 Reg: 2 May 2003	WHEELER	Honest concurrent use with Registration No. 1349633 (5839,5315).	Class 16: Magazines, maps, books, guide books; stationery. Class 39: Cruise ship services; travel agency services relating to cruise ships and cruises. Class 41: Entertainment services provided on board cruise ships. Class 43: Bar services; all provided on board cruise ships.	Carnival Plc Carnival House, 5 Gainsford Street, London SE1 2NE

<p>UK 2376602</p> <p>App: 26 Oct 2004 Reg: 27 May 2005</p>	<p>WHEELS</p>		<p>Class 36: Financial services; insurance services; insurance brokerage, evaluation, underwriting, consultancy and information, re-insurance, financial analysis and advice; capital investments.</p>	<p>Towergate Underwriting Group Limited Towergate House, 2 County Gate, Staceys Street, Maidstone, Kent ME14 1RT</p>
<p>CTM 4932877</p> <p>App: 1 Mar 2006 Reg: 26 Mar 2007</p>	<p>LAY & WHEELER</p>		<p>Class 16: Printed matter; printed publications; books, magazines, pamphlets, newsletters and posters; instructional and teaching materials; catalogues, calendars, diaries and notebooks; promotional materials; all relating to alcoholic and non-alcoholic drinks, wines, fortified wines, sparkling wines and foodstuffs.</p> <p>Class 32: Non-alcoholic beverages; beers; mineral and aerated waters, fruit drinks and fruit juices.</p> <p>Class 33: Alcoholic beverages; wines; fortified and sparkling wines; spirits; brandies and liqueurs.</p> <p>Class 35: Retail and wholesale services, mail order and electronic shopping services, all connected with the sale of beverages including soft drinks, mineral and aerated waters, fruit drinks and fruit juices, alcoholic beverages, wines, fortified and sparkling wines, spirits, and beers, and with the sale of printed matter associated with or relating to wines and other alcoholic and non-alcoholic drinks.</p>	<p>WBI Limited c/o Griffin Chapman, 32A Crouch Street, Colchester CO3 3HH, United Kingdom</p>

<p>UK 2435091</p> <p>App: 10 Oct 2006 Published: 5 Sep 2007</p>	<p>WHEELERS 4U</p>	<p>By Consent Nos. UK 2301707</p>	<p>Class 12: Land vehicles; prams, pushchairs, car safety seats for babies and children, baby walkers, rain covers for prams, bicycles, tricycles. Class 16: Babies disposable napkins made of paper or of paper and/or cellulose; magazines, books, periodicals and publications. Class 28: Toys, games and playthings. Class 35: The bringing together, for the benefit of others, of a variety of prams, pushchairs, car safety seats for babies and children, baby walkers, rain covers for prams, bicycles, tricycles, babies disposable napkins, magazines, books, periodicals, publications, toys and games enabling customers to conveniently view and purchase those goods. Class 37: Repair and maintenance of vehicles, pushchairs, babies' strollers, prams and toys. Class 45: Personal and social services rendered by others to meet the needs of individuals.</p>	<p>Wheelers 4U Limited 164 Wood Road Wolverhampton West Midlands WV6 7LR United Kingdom</p>
<p>M911346</p> <p>Reg: 7 Dec 2006</p> <p>Priority: UK 2435091 10 Oct 2006</p> <p>Designation: EM (published by OHIM – 19 Mar 2007)</p>	<p>WHEELERS 4U</p>		<p>Class 12: Land vehicles; prams, pushchairs, car safety seats for babies and children, baby walkers, rain covers for prams, bicycles, tricycles. Class 16: Babies disposable napkins made of paper or of paper and/or cellulose; magazines, books, periodicals and publications. Class 37: Repair and maintenance of pushchairs, babies' strollers and prams.</p>	<p>Wheelers 4U Limited 164 Wood Road Wolverhampton West Midlands WV6 7LR United Kingdom</p>

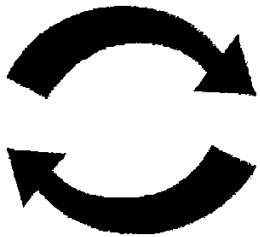

2. MILES BETTER OFF

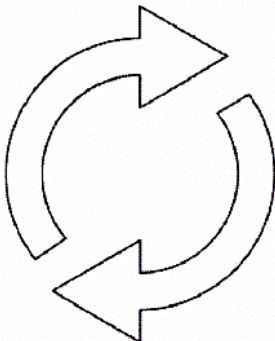
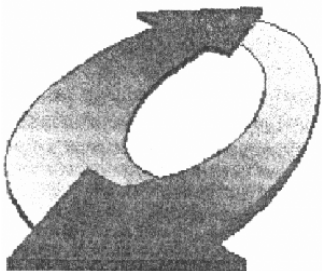

Trade mark No/ Dates	Trade mark	Information	Goods/services	Owner
UK 2306588 App: 29 Jul 2002 Reg: 3 Jan 2003		The applicant claims the colour green as an element of the first mark in the series and the colour blue as an element of the second mark in the series.	Class 16: Printed matter; books, magazines, newspapers, leaflets; printed publications. Class 36: Insurance services, insurance underwriting, insurance brokerage (including such services relating to personal accidents and injury); medical insurance. Class 42: Legal services; accident claim and injury compensation services; litigation services; consultancy, advisory and information services relating to the aforesaid.	Better Horizons Limited Empire House, 175 Piccadilly, Mayfair, London, W1J 9TB
UK 2458438 App: 14 Jun 2007 Published: 3 Aug 2007		Series of 2 marks.	Class 35: Retail services connected with motor vehicles; business, commercial and management advisory and consultancy services; advertising and promotion services provided to others; advisory, information and consultancy services relating to the aforesaid. Class 36: Financial services; insurance services; financial services relating to motor vehicles; insurance services relating to motor vehicles; financial leasing services; lease purchase services; financing services; loan services; advisory, consultancy and information services relating to the aforesaid. Class 39: Hire, rental, supplying on loan and leasing of motor vehicles; advisory, consultancy and information services relating to the aforesaid.	The Taxi Centre Limited Pavilion 5 Marchburn Drive, Glasgow Airport, Abbotsinch, Paisley, Renfrewshire, PA3 2SJ

<p>UK 2458468</p> <p>App: 13 Jun 2007 Published: 17 Aug 2007</p>	 	<p>Series of 2 marks.</p>	<p>Class 16: Printed matter, stationery, newsletters, brochures, advertising materials, point of sale and promotion materials, outdoor and in store campaign materials, magazine, journals, pamphlets and articles, pens and pencils.</p> <p>Class 39: Transport; packaging and storage of goods; travel arrangement, transportation of goods; vehicle fleet management services; hire of vehicles; warehousing; warehouse operators; distribution systems and freight forwarding.</p>	<p>Local Food Alliance Ltd Pleasure House Lane, Sutton Valence, Kent, ME17 3NW</p>
<p>UK 2286024</p> <p>App: 20 Nov 2001 Reg: 6 Dec 2002</p>	<p>TOTAL MORE MILES FOR YOUR MONEY</p>		<p>Class 4: Industrial oils and greases; lubricants; fuels (including motor spirit); liquified petroleum gases.</p> <p>Class 35: Bringing together for the benefit of others a variety of industrial oils, greases, lubricants, fuels, petroleum gases.</p> <p>Class 37: Vehicle service stations; maintenance, repair and lubrication of vehicles.</p>	<p>Total S.A. 2, Place de la Coupole, La Defense 6,92400 Courbevoie, France</p>
<p>CTM 1279249</p> <p>App: 16 Aug 1999 Reg: 12 Dec 2001</p>	<p>MILES</p>		<p>Class 9: Computer programs and computer software; magnetic cards; computer peripherals.</p> <p>Class 35: Marketing services, public relations management, organising and operating customer loyalty schemes.</p> <p>Class 38: Telecommunications; Internet and online services.</p>	<p>Consafe Infotech AB Adelgatan 9 211 22 Malmö Sweden</p>

<p>CTM 6012356</p> <p>App: 18 Jun 2007</p> <p>Status: Pending</p>	<p>BETTER OFF</p>		<p>Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; computerised financial information services; electronic banking and brokerage services; cash management services; financial services; banking services; telephone banking services; insurance services; credit services; credit card services; financial advice and information provided online from facilities provided on the Internet (including web sites); internet banking services; financial advice and information services provided by electronic means; credit agency and brokerage services; insurance services; credit recovery; debt collection and recovery services; debt factoring; advisory, consultancy and information services in connection with the above-mentioned services.</p>	<p>HBOS plc The Mound Edinburgh EH1 1YZ</p>
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3. ARROWS LOGO

Trade mark No/ Dates	Trade mark	Information	Goods/services	Owner
CTM 5409611 App: 23 Oct 2006 Published: 20 Aug 2007			Class 9: Electronic cash registers; electronic data carriers in the form of magnetically encoded cards, all being charge cards, credit cards, debit cards and identification cards. Class 35: Business administration and franchising services; promotion of goods for others through by means of offering discounted goods and services.	Retail Licensing Company 101 Convention Center Drive Las Vegas, 89109 Nevada United States
UK 1327020 App: 14 Jun 1989 Reg: 7 Jul 1991		The first mark in the series is shown on the application form in the colours blue and gold but the mark is not limited to colour.	Class 9: Radios, calculators, computer disks. Class 16: Stationery, diaries, calendars, personal organisers, wall planners, desk blotters, place mats, coasters, stickers, labels, posters, packaging and folders. Class 41: Association services for members; education and training services all relating to the Prison service. Class 42: Legal services for members of the Prison service.	H.M. Prison Service Prison Service College Newbold Revel Stretton-under-Fosse Rugby Warwickshire CV23 0TH

<p>CTM 3021300</p> <p>App: 27 Jan 2003</p> <p>Reg: 30 April 2004</p>		<p>Class 9: cards for electronic, optical or magnetic storage of data for use as membership cards; smart cards; downloadable electronic publications; pre-recorded cd's, dvd's or videos.</p> <p>Class 16: Magazines, printed publications, books; stationery.</p> <p>Class 41: Provision and operation of a membership club; educational services relating to vehicles and/or driving; provision of entertainment services relating to vehicles and/or driving and motorsport.</p>	<p>Jaguar Owners Club Haldane Building The Kelly Business Park Coventry CV 18 6DF</p>
<p>UK 2186768</p> <p>App: 21 Jan 1999</p> <p>Reg: 2 Mar 2003</p>		<p>Class 35: Retail of car parts, fittings and accessories; sweets, snacks and non-alcoholic drinks.</p> <p>Class 37: Vehicle servicing, maintenance and repair services; garage services for vehicle repair and maintenance; inspection of vehicles; arranging for the repair and recovery of vehicles; information and advisory services relating to the aforesaid services.</p>	<p>Infracar Ltd North Heath Lane Horsham West Sussex RH12 5QE</p>
<p>CTM 3886645</p> <p>App: 16 Jun 2004</p> <p>Reg: 11 Oct 2005</p>		<p>Class 4: fuels; illuminants; non-chemical additives for oils and fuels; lubricants and lubricating greases; engine oils, gear oils, automotive final drive oils; waxes.</p> <p>Class 35: the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a convenience store or vehicle service station.</p> <p>Class 37: vehicle service stations and vehicle fuelling station services.</p>	<p>Kuusakoski Oy Hyttipojankuja 2 Espoo 02780 Finland</p>