

THE JOINT EXAMINATION BOARD  
PAPER T1 Basic United Kingdom Trade Mark Law

Thursday 6<sup>th</sup> November 2008

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** from Part B.
2. There are a maximum 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 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.
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.** 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 7 pages including this one.**

**PART A**

1. Under the UK Trade Marks Act 1994:
  - (a) What is a trade mark?
  - (b) What may a trade mark consist of?
  
2. Section 3 of the UK Trade marks Act 1994 sets out absolute grounds for refusal of a registration. According to Section 3(1) what shall not be registered and in what circumstances does Section 3(1) not apply?
  
3. When an opposition under the UK Trade Marks Act 1994 is based on a trade mark which has been registered, what information must be given in respect of that registered trade mark?
  
4. Under Section 10 of the UK Trade Marks Act 1994 (Infringement of a registered trade mark) what constitutes infringement of a registered trade mark?
  
5. By whom can a registered trade mark be surrendered, and what information must be given, and to whom, for the surrender to have effect?
  
6. Under Section 76 of the Trade Marks Act 1994, where an appeal is made to the Appointed Person:
  - (a) Under what conditions may the Appointed Person refer the appeal to the High Court?
  - (b) What is the limitation of a decision issued by the Appointed Person in an appeal which the Appointed Person does not refer to the High Court?
  
7. According to Section 12 of the UK trade marks Act 1994 in what circumstances is a registered trade mark not infringed?

8. According to Section 25 of the Trade Marks Act 1994 (*registration of a transaction affecting a trade mark*):
  - (a) List three registrable transactions and
  - (b) List two benefits of recording the transaction on the register.
  
9. List the provisions of Section 43 of the Trade Marks Act 1994 (renewal of registration) relating to renewal of a registered trade mark prior to its expiry date.
  
10. What defences to trade mark infringement are provided by the Trade Marks Act 1994?

**Please continue to Part B**

**PART B**

11. You receive a telephone call from one of your clients. He has filed a UK trade mark application for the word mark HADLEY in respect of “*Leather belts; leather purses; leather key rings*” in Class 18. He has just received an examination report from the UK Intellectual Property Office telling him that his trade mark application is confusingly similar to United Kingdom trade mark registration No. 2485677 TADLEY covering the following goods in Class 18:

“Belts made of leather, handbags.”

Your client is outraged and wants to know why he has received this examination report.

**Prepare a memo for your client:**

- (1) Explaining with reference to appropriate case law the tests the Examiner has used to determine the similarity between HADLEY and TADLEY;**
  - (2) Explaining with reference to appropriate case law the tests the Examiner has used to determine the similarity between the goods;**
  - (3) Commenting on the strength or otherwise of the Examiner’s views on the similarity of the marks and goods.**
12. Customers of your client, Dibben Limited, have received the following letter from Dubious Limited:
- Dear Sirs,*
- You must immediately stop using the name DIBBEN on squash rackets as you are blatantly infringing our UK Trade Mark Registration No. 204060 DUBIOUS which is registered in respect of sports bags. We are going to sue you for trade mark infringement and take you to the cleaners for compensation for the damage we have suffered because of your infringement of our registered Trade Mark.*
- Yours Faithfully,*
- Dubious Limited*

Dubious Limited has threatened to bring an infringement action against your client before. At the time, you asked for Counsel's opinion on whether he thought DIBBEN infringed DUBIOUS. Counsel advised strongly that there was no trade mark infringement because the marks were not confusingly similar.

Your client is extremely worried by Dubious Limited's threat of trade mark infringement. Seven of his biggest customers have cancelled their orders because they do not want to be sued for infringement.

**(1) Outline for Dibben Limited the law in relation to the latest threat of infringement proceedings; and**

**(2) What action he might take.**

13. You act on behalf of a television production company specialising in reality television shows. One of the shows they produce revolves around a cooking competition where every week two contestants battle it out to see who can impress a series of celebrity chefs. The television programme is called COOK-OFF and this has been registered as a trade mark in the United Kingdom. The programme has been running for around 8 years and is extremely popular throughout the United Kingdom regularly drawing around 5 million viewers per week. Around 4 years ago your client decided COOK-OFF was not an exciting enough trade mark on its own and they began to use the strapline "COOK TO IMPRESS" alongside COOK-OFF. When the programme starts COOK TO IMPRESS appears underneath the trade mark COOK-OFF in the opening sequence. For the last 3 years it has appeared on its own on the contestants' aprons, and in the closing credits. It is the last thing viewers see as the programme finishes. Aprons are also sold to the public.

**Make notes for a meeting with your client where you will advise them whether they can register COOK TO IMPRESS as a trade mark in respect of "television programmes, cooking aprons, crockery, knives, kitchen utensils". In your notes make reference to any relevant case law to illustrate your points.**

14. You have been approached by Indian Foods Limited who use the trade mark INDIAN SPICED FOOD in the form of a logo for “mobile takeaway services”. This composite mark incorporates the words INDIAN SPICED FOOD with a highly distinctive and complex spiral design. Indian Foods Limited own a fleet of eight takeaway vans which are franchised to third parties who are allocated small geographical regions in the south of England within which they can trade.

Indian Foods Limited have just become aware of a large high class restaurant in Leeds trading under the name INDIAN SPICEY FOOD, owned by Jolly Pirates Limited. Research indicates that INDIAN SPICEY FOOD has been trading since 2002 in the Leeds area but that Jolly Pirates are planning to open three INDIAN SPICEY FOOD restaurants in the south of England.

Indian Foods Limited instruct you that they want to take action to stop Jolly Pirates Limited from taking advantage of the reputation they have built up in the INDIAN SPICED FOOD name or infringing their rights.

**Write brief notes on what action may be open to Indian Foods Limited and briefly comment on the likelihood of success.**

15. Your Client, a German company, Manchmal GmbH has been using their trade mark “NEDDYWRAPS” on horse blankets for some 20 years in the United Kingdom and Germany. Although theirs is a niche marketplace, Manchmal can be said to have built up an exclusive reputation in NEDDYWRAPS for horse blankets in both the United Kingdom and Germany where equestrian sports are of national importance. Manchmal have to date not protected their trade mark by means of registration in any territory. However, as a result of recent advice from a German trade mark attorney, Manchmal filed a trade mark application in Germany on 20 July 2008, for NEDDYWRAPS in class 18 for horse blankets.

Manchmal have come to you because one of their UK stockists has drawn Manchmal's attention to use in London of a trade mark NEDDYSNAPS, on saddles and studs for saddles, by an Italian company Mondecano S.p.A. Further investigation reveals that Mondecano are widely marketing and

promoting their NEDDYSNAPS goods in the United Kingdom. A search of the United Kingdom trade mark register discloses a United Kingdom trade mark application No. 2111345 NEDDYSNAPS in class 18 for saddles and studs for saddles in the name of Mondecano S.p.A. The NEDDYSNAPS trade mark application was filed in the United Kingdom on 25 August 2008 and was advertised for opposition purposes on 10 October 2008.

- (1) Advise Manchmal as to possible options open to them to stop Mondecano's sale of NEDDYSNAPS goods in the UK;**
  - (2) Advise them as to possible options open to them to stop Mondecano's UK trade mark application; and**
  - (3) Advise on the likelihood of success for each option you consider.**
- 16.** Outline the basis for a revocation action under Section 46(1)(a) and (b) of the Trade Marks Act 1994 (*revocation of registration on ground of non-use*) and the procedure, including reference to the relevant timescales.