

**THE JOINT EXAMINATION BOARD**

**PAPER T2 – BASIC UNITED KINGDOM TRADE MARK PRACTICE**

**Tuesday 11<sup>th</sup> November 2008**

**2:00 p.m. to 5:00 p.m.**

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

1. You should attempt **EIGHT** of the nine questions in Part A. If more than **EIGHT** questions are answered in Part A, only the first **EIGHT** will be marked. You should attempt **FIVE** of the six questions in Part B. If more than **FIVE** questions are answered in Part B, only the first five will be marked.
2. **FIVE** marks are available for each answer in Part A of this paper. **TWELVE** marks are available for each answer in Part B of this paper.
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 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.
6. This question paper consists of **FIVE** pages including this instruction sheet.

**Part A**

1. List five grounds for opposition to a UK trade mark application with reference to the United Kingdom Trade Marks Act 1994 ("Trade Marks Act").  
(5 marks)
2. 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 14 June 1989 and registered on 4 December 1989, claiming priority from a Spanish trade mark application filed on 30 March 1989.
  - b) A registration resulting from a UK trade mark application filed on 14 September 1994 and registered on 3 May 1995.
  - c) A registration resulting from a UK trade mark application filed on 5 January 1997 and registered on 1 February 1997, claiming priority from a US trade mark application filed on 1 October 1996.
  - d) A registration resulting from the merger between one UK trade mark registration in class 25 with a filing date of 24 October 2001 and registered on 28 July 2002, claiming priority from a Community trade mark filed on 21 August 2001; and another UK trade mark registration in class 41 with a filing date of 24 December 2002, with no priority claim, registered on 10 August 2003.  
(5 marks)
3. List the requirements for obtaining a filing date for a UK trade mark application.  
(5 marks)
4. Your client wishes to put the ® symbol next to the name of her UK shop, for which she has a pending UK trade mark application. Briefly explain to her in note form the relevant provisions of the Trade Marks Act and the practice of UK IPO.  
(5 marks)
5. Explain what is meant by and give **three** examples of a "Registrable Transaction" under the Trade Marks Act.  
(5 marks)
6. Your client instructs you to file a UK trade mark application for the mark CLOTOX covering "all goods in Class 3". Write brief notes advising on any possible objections to this specification and any alternative approach which you recommend.  
(5 marks)

7. You have been asked to file a UK trade mark application for the mark GENTREK covering pharmaceutical preparations in class 5. Your client has a French trade mark application for the identical mark covering identical goods with a filing date 3 months earlier. This is her only trade mark filing for this mark. Briefly explain the advantage of claiming priority from the French mark and the formalities necessary to claim priority.  
(5 marks)
8. List five criteria which the UK IPO will take into consideration in determining similarity between goods and services.  
(5 marks)
9. Your client wishes to file a UK trade mark application for the mark CALITO covering curtains. Your searches reveal an earlier UK trade mark registration CALITO CORNERS, also covering curtains. Advise your client with reasons on whether the UK IPO is likely to consider the marks to be similar and, if so, what action the UK IPO is likely to take.  
(5 marks)

**Part B**

10. Your clients are producers of hand-made chocolates and sell their products throughout the UK. In 2002 they were interested in using the mark MOOLICIOUS for their chocolates but a trade mark search identified a UK trade mark registration for the identical mark. Your client conducted an investigation and found that there was small-scale use of MOOLICIOUS in the South West of England. They have kept an eye on the situation and now believe that there has been no use of MOOLICIOUS for some years and that the owner of the registration MOOLICIOUS switched to using BOOLICIOUS. Your clients would like to use and register MOOLICIOUS, without risk, and have now contacted you for advice.

(a) Consider briefly whether your client can revoke the trade mark registration MOOLICIOUS on grounds of non-use?

*(2 marks)*

(b) Set out the procedural requirements involved in a revocation action (you may answer this part of the question in a flow-chart if you wish).

*(10 marks)*

11. Briefly discuss the registrability of FOUR of the following trade marks under current UK IPO practice:

(a) PERKINS STRAWBERRY JAM for jam

(b) SOMERSET GOLD for cider

(c) ORL WOOLA for suits

(d) STAINLESS SUREFIT for exhausts

(e) ARTIC LEATHER for clothing

(f) MOONSILK for underwear

(g) FINANCIAL WORLD for magazines.

*(12 marks)*

12. Your client wishes to assign a UK trade mark registration to another party. List the following information in brief note form:

a) what the assignment should include *(8 marks)*

b) the UK IPO requirements for recordal of the assignment *(2 marks)*

c) the significance of recording the assignment within six months of the effective date *(2 marks)*.

13. (a) On 1 October 2007 the UK IPO's practice in relation to examination on relative grounds changed. Prepare a list or flow-chart outlining the updated process.

*(8 marks)*

(b) Briefly describe the tests which the UK IPO applies in deciding whether to cite an earlier trade mark on relative grounds during examination.

*(4 marks)*

14. A client has come to you with a business plan to launch a new range of ski-equipment. They have secured supplies of a revolutionary new type of ski upon which they wish to use the mark SKIVOLUTION. They plan to set up an English company called SKIVOLUTION Limited through which to sell the product. Advise your client on the trade mark and other searches you recommend to verify whether or not it is possible for them to proceed as planned.

*(12 marks)*

15. You are asked to advise on possible UK trade mark protection for a shade of green used by your client on the packaging for all of their well-known hair care products.

- a. Outline the current requirements for single colours to be accepted for trade mark registration in the UK.

*(6 marks)*

- b. Prepare brief notes on possible objections to an application to register the colour and make brief suggestions for attempting to overcome these.

*(6 marks)*