

THE JOINT EXAMINATION BOARD

PAPER T3

Advanced United Kingdom Trade Mark Law and Practice
Wednesday 12th November 2008

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. 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.

The paper consists of 11 pages including this page.

QUESTION 1

You act for Jennings & Sons Limited, a small UK based tools manufacturer. In 1994 your client launched a range of high-quality wood working tools under the mark IGUANA TOOLS (stylized, No 2099308) and in early 2000 they also began selling stepladders under the mark. The light weight and low cost of the stepladders proved popular with your client's customers and the ladders have remained part of the range ever since. Your client owns the following United Kingdom trade mark registrations:

Registration No.: 2099308
 Status: Registered
 Filing date: 18 October 1995
 Registration date: 5 July 1997
 Mark: **IGUANA TOOLS**
 Class 8: Hand tools and hand operated implements.

Registration No.: 2294632
 Status: Registered
 Filing date: 21 September 1998
 Registration date: 2 July 1999
 Mark: IGUANA
 Class 8: Hand tools and hand operated implements

Your client has received a notification letter from the UKIPO relating to a UK Trade Mark Application for the mark IGUANA, details of which are set out below:

Application No.: 2583286
 Applicant: Iguana GmbH
 Status: Pending
 Filing date: 28 June 2008
 Publication date: 15 August 2008
 Mark: IGUANA
 Class 6: Metal toolboxes; metal step ladders.
 Class 7: Power operated tools; stapling, tacking and nailing machines; pneumatic nailing and fastening tools; electric glue guns.
 Class 8: Hand tools; gardening tools; axes; tool belts; tool aprons; carpenters' aprons.

Your client has told you that they wish to oppose this application.

1. List with reasons the grounds upon which you intend to base the opposition and any information you will need to support those grounds at the time of filing the opposition **(13 marks)**
2. Briefly set out the main steps in the opposition procedure and explain what evidence it may be necessary to file later in the proceedings and the form this should take **(8 marks)**.
3. Explain to your client how the UKIPO is likely to deal with assessing awards of costs in the proposed opposition proceedings **(4 marks)**

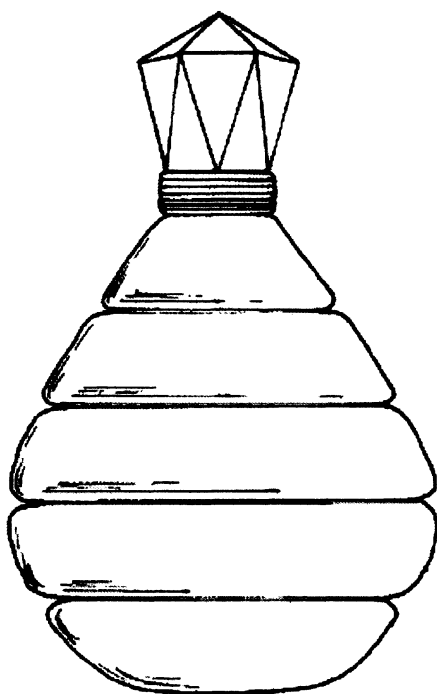
QUESTION 2

You act on behalf of Parfums St. Josephine S.A., a leading fragrance house based in Paris. Your client produces various high quality perfumes which are marketed under a number of different brands, all of which are very well-known. Your client's perfumes are heavily advertised and feature expensive packaging and presentation. Their perfumes are sold in leading department stores and other prestigious retail outlets, attracting premium prices, often £50-60 in the United Kingdom.

One of your client's fine fragrance brands is called PACIFIC DAWN. The perfume has been sold in numerous countries worldwide, including the United Kingdom, since the mid 1990s and its packaging has remained essentially unchanged in that time. Your client owns the following trade mark registrations relating to this brand:

1) UK Trade Mark Registration No. 2076211

Status: Registered
Registration date: 2 April 1995
Class 3: Perfumes, toilet waters; all included in Class 3
Mark:



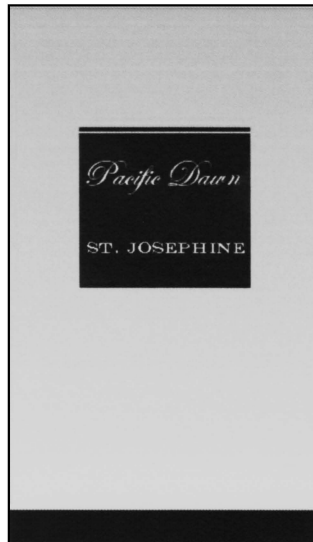
The mark consists of a three dimensional shape.

2) UK Trade Mark Registration No. 13486187

Status: Registered
Registration date: 3 January 1991
Class 3: Perfumes, toilet waters; all included in Class 3
Mark: PACIFIC DAWN

3) UK Trade Mark Registration No. 1413731

Status: Registered
Registration date: 2 September 1991
Class 3: Perfumes; toilet waters.
Mark:

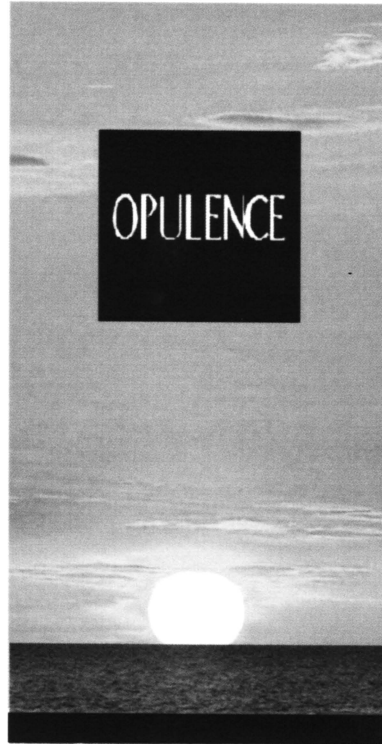


(the text on the box reads 'Pacific Dawn' and 'ST. JOSEPHINE', the background is blue and the lettering is gold).

Garcon D'Elle Limited is a UK company which manufactures 'smell-alike' perfumes. These perfumes are intended to smell like leading fine fragrances but produced using inferior ingredients and are sold in cheap packaging and bottles. Garcon D'Elle's perfumes are largely sold through 'downmarket' retail outlets; market stalls and discount stores, typically selling for £2-3. There is no advertising of the products.

When selling to retailers, Garcon D'Elle use comparison lists consisting of two columns; one listing their own perfumes and the other listing the fine fragrances which they are intended to smell like. Your client has found that the retailers frequently use these lists when selling to consumers, placing them on display when selling their goods or handing them directly to customers.

Garcon D'Elle have recently introduced a perfume called OPULENCE which is intended to smell like your client's PACIFIC DAWN perfume; the comparison table lists 'PACIFIC DAWN' as the perfume OPULENCE smells like. OPULENCE is sold in the packaging below, which your client feels is reminiscent of the packaging of their PACIFIC DAWN product; both are sold in similar shaped bottles and both have packaging which is predominantly blue:



(the text on both the bottle and the packaging reads "OPULENCE". Both the bottle and packaging are predominantly blue. The lettering on the packaging is gold)

Your client has had investigations conducted into Garcon D'Elle's activities by a firm of private investigators. The investigators' report indicates that none of the consumers of Garcon D'Elle's OPULENCE perfume believe that it is produced by, or authorised by, Parfums St. Josephine S.A. The consumers seem to appreciate that OPULENCE is a cheap imitation of PACIFIC DAWN and don't expect it to be of the same quality, even though it may smell fairly similar.

1. List with reasons the grounds that may be available to prevent Garcon D'Elle's use of the comparison lists. List with reasons any defences which may be available to Garcon D'Elle **(9 marks)**
2. List with reasons the grounds may be available to your client to prevent Garcon D'Elle's use of the OPULENCE bottle and packaging **(14 marks)**
3. What civil remedies will be available to your client if they are successful in action against Garcon D'Elle? **(2 marks)**

(Ignore any aspect of copyright or design right)

QUESTION 3

Your client, Tropical Drinks plc, is a multinational beverage company specialising in the spirits market. Your client's most successful product by some distance is its brand of premier rum, DESERT ISLAND GOLD. Annual sales in the United Kingdom regularly exceed £30 million.

Your client owns a trade mark registration for DESERT ISLAND GOLD covering "spirits" in class 33. The mark reached registration on 6 December 1980. Your client registered the domain name www.desertislandgold.com in 1998.

A few months ago, your client's managing director was booking a holiday and discovered the website www.desertislandgold.co.uk offering luxury island breaks aimed at the mature holiday maker. Concerned by this, he approached the registrant, Mr Smith of Smith's Travel Agency, offering to buy the domain name. Mr Smith wrote back saying he would only be willing to sell the domain name for an 'exceptional offer' as, he claimed, he had spent considerable time and effort developing his website. Your client checked the WHOIS database which shows that the domain name was registered by Mr Smith in 2000.

To your client's further annoyance, he has come across the website www.desert-island-gold-sucks.co.uk. That domain name was registered in 2004. The website is being operated by Cheap Drinks Limited to promote a rival rum called PIRATE'S DROP, which is being marketed at a price 30% lower than your client's product. Your client is concerned that people browsing the internet for DESERT ISLAND GOLD rum will find this website and buy the cheaper PIRATE'S DROP rum instead. Your client tried contacting Cheap Drinks Limited using the contact information on the WHOIS database, but the information appeared to have been false.

The managing director has heard about the dispute resolution procedure before Nominet and is keen to have both domain names either cancelled or transferred to Tropical Drinks plc, or, failing that, to take action against the www.desert-island-gold-sucks.co.uk site operators. He has set up a conference call with you to discuss this. In advance of the call, write notes on:

- a) the requirements for a successful complaint before Nominet (Ignore procedural aspects of filing a complaint at Nominet) **(5 marks)**
- b) the advice you will give as to the strength of your client's case in respect of desertislandgold.co.uk in proceedings before Nominet **(10 Marks)**
- c) other than proceedings before Nominet, what actions may be available to your client in respect of desertislandgold.co.uk and desert-island-gold-sucks.co.uk **(10 marks)**

QUESTION 4

Your client, N.Z. Walk World Limited, operates a single shop in Wales selling clothing, footwear and headgear for outdoor activities. The goods your client sells are manufactured in New Zealand and are marketed as being of superior quality as a result.

The words N.Z. WALK WORLD LIMITED are displayed on the sign outside your client's shop. Your client has been operating under this sign since 1997, initially selling goods with the trade mark NZ WALK WORLD on the neck labels. The shop has been moderately successful.

Since early 2003, when its first supplier went bankrupt, your client has had difficulty finding a suitable supplier from New Zealand. As a result, your client has only been selling goods which are made in China bearing trade marks other than NZ WALK WORLD on the neck labels.

Your client has a registration for the mark N.Z. WALK WORLD covering "clothing, footwear and headgear, all for outdoor activities" in class 25. The mark was applied for on 10 January 1997 and reached registration on 10 September 1997.

In October 2002 a competitor, Big Adventure Limited, which owns several stores throughout the United Kingdom, applied to the UK IP Office for revocation of your client's registration on the grounds of non-use and for a declaration of invalidity on the grounds that the mark is not sufficiently distinctive. Your client successfully defended both of these applications. Big Adventure Limited applied to the High Court for cancellation on the same grounds. Once again, your client defended the applications successfully.

Your client has discovered that Big Adventure Limited has recently started using the mark WALK WORLD in connection with a shop in Edinburgh selling a range of equipment for outdoor activities, in particular waterproofs, fleeces, hats, gloves, hiking boots and rucksacks. A search has revealed that Big Adventure Limited filed an application to register WALK WORLD on 1 October 2008 covering "retail services in the field of outdoor activities, in particular clothing, footwear, headgear, hiking equipment and camping equipment" in class 35.

Your client is concerned about the interest Big Adventure Limited is showing in the mark WALK WORLD and has contacted you for advice. Write notes in advance of a meeting with your client. Your notes should include:

- a) the points you will raise as to any actions available to your client and any defences or counterclaims which may be available to Big Adventure Limited **(12 marks)**
- b) what effect the previous cases between the parties may have on Big Adventure Limited's position **(10 marks)**
- c) what steps your client might take to improve its position **(3 marks)**

(Ignore any Trade Descriptions Act issues)

QUESTION 5

You have been asked to act on behalf of Polly & Co Ltd of Portland House, Bressenden Place, London, SW1E 5BG. Polly & Co are known for producing 'country house' style goods for fitting out gardens and specialist rooms, such as billiard rooms and music rooms.

Your clients wish to use the mark 'Sofar' in respect of a range of musical goods and garden ornaments. The key goods to be launched first, for which Polly feel that they must have the use of the mark, are grand pianos and music stands, and concrete and metal birdbaths. The project has advanced to the point where they are ready to launch next season.

A logo - showing a bird on a music box - has been designed by a friend of one of the directors, who works for a design company. Packaging and publicity material bearing the mark SOFAR and the logo have been printed.

Having discussed the matter with your clients you propose to file in class 15 for 'pianos; music stands', class 6 for 'bird baths being structures of metal', class 19 for 'non-metallic birdbaths (structures)' and class 21 'bird baths'.

A preliminary search of the register discloses a Community registration of SOFAR, details of which are given on the next page, but no other prior marks.

Investigation indicates that the registered mark has been used in the UK by the owners, Vincent SA in respect of fridges, ovens, plates and bowls, but all use ceased 2 years ago and there has been no further use of the mark.

Your clients would be happy to purchase the registration and ask whether they should offer £5000.

You are asked by Polly & Co:

1. To advise on whether their proposed use for grand pianos, music stands and birdbaths, intended to be in the UK only, would infringe the Community registration, with full analysis of the basis of any infringement action **(9 marks)**
2. To write a letter to Vincent and provide a draft assignment. The law is to be English law. In the letter you should explain the difference between full and limited title guarantee to the French company **(10 marks)**
3. To advise whether this registration will be sufficient to cover your client's initial proposed use, or whether any new applications would be needed, and any issues needing consideration **(3 marks)**
4. Whether there is anything else that the client should do to shore up their position for the use proposed? **(3 marks)**

Case details for Community Trade Mark E3533536

Mark

SOFAR

Status

UK case status:
Registered
Original language:
French
Second language:
English
Classes:
11, 20, 21

Relevant dates

Filing date:
30 October 2000
Publication date:
15 August 2001
Registration date:
12 May 2002

List of goods or services

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; air conditioning apparatus; electric kettles; gas and electric cookers; vehicle lights and vehicle air conditioning units.

Class 20: Furniture, mirrors, picture frames; articles made of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum or plastic which are not included in other classes; garden furniture; pillows and cushions.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

Names and addresses

Applicant:
VINCENT SA
Avenue de la Grande Armee 112
Chaumes-sur-Yonne 55954
France

QUESTION 6

You act for a Swiss fragrance company called Chique Fabrique, who make and sell fragrances, either directly or through licensees, across Europe including the United Kingdom under the trade marks CHIQUE FABRIQUE and ESPRIT DE SOLEIL.

The fragrances are sold in their own stores and via concessions in major retailers. ESPRIT DE SOLEIL, which is now their best selling brand, is sold either as a ready made product or as a bespoke product made specifically for the customer in store from a perfume base and fragrance concentrate by an in-store perfumer consultant.

Chique Fabrique owns the following trade marks in the United Kingdom:

UK Trade Mark Registration No. 1212345

Status: Registered
 Registration date: 1 June 1968
 Class 3: Perfumery and essential oils
 Mark: CHIQUE FABRIQUE

UK Trade Mark Registration No. 2035719

Status: Registered
 Registration date: 11 September 1997
 Class 3: The bringing together, for the benefit of others, of perfumery products and essential oils, enabling customers to conveniently view and purchase such goods in a retail store.
 Mark: CHIQUE FABRIQUE

UK Trade Mark Registration No. 1212346

Status: Registered
 Registration date: 15 August 1968
 Class 3: Perfumery and essential oils
 Mark: ESPRIT DE SOLEIL

UK Trade Mark Registration No. 2028745

Status: Registered
 Registration date: 30 May 1995
 Class 40: Custom manufacture of perfumes
 Mark: ESPRIT DE SOLEIL

In 1970 Chique Fabrique acquired a minority holding in Contemporary Perfumers Limited ("CPL"), a small privately owned company, to enter the UK fragrance market. In 1975 they granted the following licences to CPL:

1. An exclusive bare licence to make and sell fragrances under the trade mark CHIQUE FABRIQUE. The licence was for an initial period of 10 years and is renewable for further 10 year periods. It was renewed in 1985, 1995 and 2005. There is provision for termination of the licence if Chique Fabrique ceases to hold shares in CPL. The trade mark has had limited sporadic use and was last used on goods in the United Kingdom in 1998.

- An exclusive licence to make and sell fragrances under the trade mark ESPRIT DE SOLEIL, providing that all such fragrances conform to the quality standards set by the licensor from time to time. The licence was not renewed in 1995 but was replaced in 2005 by a new licence on the same terms and including a provision for termination of the licence if Chique Fabrique ceases to hold shares in CPL.

CPL have applied for and registered the following trade marks in the United Kingdom:

UK Trade Mark Registration No. 2146789

Status: Registered

Registration date: 8 May 2003

Class 3: Perfumery and essential oils

Mark: CHIQUE FABRIQUE with chemical flask device

UK Trade Mark Registration No. 2146790

Status: Registered

Registration date: 1 June 2003

Class 3: Perfumery and essential oils

Mark: ESPRIT DE SOLEIL with sun device

Chique Fabrique consented to the registration of each of these marks in a letter agreement which also provided that if Chique Fabrique ceased to hold shares in CPL, CPL would apply to cancel the registrations.

In 2008 Chique Fabrique acquired all the shares in a larger company in the United Kingdom, Radiance PLC, and plans to finance this purchase in part with the sale of its shareholding in CPL.

Radiance PLC will continue to sell its existing ranges, RADIANCE CLASSIC and RADIANCE INTIMATE but will add the ESPRIT DE SOLEIL brand to its portfolio. Chique Fabrique believes that ESPRIT DE SOLEIL will have a much better future under the Radiance brand umbrella. Chique Fabrique would like to cut all ties with CPL on completion of the sale. However, in order to secure an attractive price for its shares in CPL, Chique Fabrique will need to license CPL to continue to use the CHIQUE FABRIQUE and ESPRIT DE SOLEIL trade marks for a further 5 years. They are however concerned that CPL may not invest in maintaining the product quality, in product promotion or in packaging.

General Counsel for Chique Fabrique asks you to advise on:

- The validity of their trade mark registrations **(9 marks)**
- The validity of their existing licences **(9 marks)**
- What steps they might take to improve their position now and in future should there be any doubt about the validity of their trade mark registrations or licences and in view of the plans they are proposing to adopt **(7 marks)**