

THE JOINT EXAMINATION BOARD**PAPER T1 Basic United Kingdom Trade Mark Law.****Thursday 5th November 2009.****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. There are six pages in this examination paper, including this explanatory sheet.
2. There are a maximum of five marks allotted to each question in Part A and a maximum of twelve marks allotted to each question in Part B. If more than the required number of questions are answered in any part then it will be the first eight answers given by you in Part A and the first five answers given by you in Part B that shall 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.

PART A

You should attempt EIGHT questions from Part A, which contains ten questions.

1. Under Section 10 of Trade Marks Act 1994, what, in particular, constitutes use of a sign, for infringement purposes?
2. By whom can an application for rectification or correction of the Register be made, and in what circumstances? To whom may any such application be made?
3. Under Section 46 of the Trade Marks Act 1994, on what grounds may a United Kingdom trade mark registration be revoked?
4. What is a certification trade mark? In accordance with the Trade Marks Act 1994, what must the regulations in support of a certification trade mark indicate?
5. What are the absolute grounds for refusal of registration, as set out in Section 3(1) of the Trade Marks Act 1994?
6. How does Section 6 of the Trade Marks Act 1994 (as amended) define an “earlier trade mark”?
7. According to Section 48 of the UK Trade Marks Act 1994:
 - a) In what circumstances does acquiescence apply; and
 - b) What effect does it have; and
 - c) What restrictions does it place on the proprietor of a later trade mark?
8.
 - a) Who may claim priority under Section 35 of the UK Trade Marks Act 1994;
 - b) For what purposes may priority be claimed; and
 - c) What is its effect?
9.
 - a) In what circumstances does Section 6A (raising of relative grounds in opposition proceedings in case of non-use) of the UK Trade Marks Act 1994 apply; and
 - b) When are the use conditions of an earlier trade mark met?

10.

- a) Under Section 28 (1) of the UK Trade Marks Act 1994 a licence to use a registered trade mark may be general or limited. To what may a limited licence apply, in particular?
- b) Under Section 28 (2), in what circumstances is a licence not effective; and
- c) Under Section 28(3) when might a licence not be binding on a successor in title to the licensor's interests?

PART B

You should attempt FIVE questions from Part B, which contains six questions.

1.

You receive a telephone call from the Managing Director of a company called Seaplane Trips Limited. He is very agitated as he has just received a letter from The Original Seaplane Company threatening to invalidate Seaplane Trips Limited's trade mark registration for SUPER CITY SEAPLANE TRIPS which was registered as a United Kingdom trade mark on 18th July 2004 in respect of "*sight-seeing tours*" in Class 39. Surprisingly, SUPER CITY SEAPLANE TRIPS was registered without any problems and no absolute grounds objections to registration of the application were raised.

Since registering SUPER CITY SEAPLANE TRIPS in July 2004, Seaplane Trips Limited's business has taken off. They are the United Kingdom's only seaplane company offering sight-seeing tours throughout the United Kingdom. Their trips are extremely popular with over 500,000 visitors per year taking a sight-seeing trip with them. The trips are popular as they are good value for money at £50.00 per person. Consequently, SUPER CITY SEAPLANE TRIPS has also appeared in numerous national newspaper and magazine articles since 2004. Last year, SUPER CITY SEAPLANE TRIPS received even more publicity as their sight-seeing tour of the city of London was the "treat" for the winning group in the BBC's "Top Employee" television programme.

A search of the United Kingdom Trade Marks Register shows that The Original Seaplane Company has a United Kingdom trade mark registration for a device mark containing the expression FABULOUS SEAPLANE TRIPS coupled with a distinctive device in respect of "*reservation services for tours*" in Class 39. The FABULOUS SEAPLANE TRIPS device was registered on 15th June 2003, but a commercial investigation shows it has never been used.

Prepare a memo for the Managing Director of Seaplane Trips Limited:

- 1) outlining all possible grounds on which The Original Seaplane Company can seek to invalidate SUPER CITY SEAPLANE TRIPS,
- 2) commenting briefly on each ground and
- 3) indicating equally briefly the likelihood of success of each ground of invalidity.

2.

A company called South Face Limited has just contacted you as it has received a letter from a company called Southern Face Limited alleging that South Face Limited's use of the sign SOUTH FACE in respect of jumpers, jackets and walking boots, and use of the company name SOUTH FACE LIMITED, is infringing Southern Face Limited's United Kingdom Trade Mark Registration for SOUTHERN FACE registered in respect of "*Articles of clothing; shoes; hats and gloves*" in Class 25. SOUTHERN FACE has an application date of 21st September 2008 and a registration date of 16th March 2009. A search of the internet shows that SOUTHERN FACE has not been used yet. The Southern Face website says that the SOUTHERN FACE clothing range is going to be launched in November 2009.

South Face Limited tells you they own a walking shop in the Lake District. The signage appearing on the shop is SOUTH FACE LIMITED. The shop began trading as SOUTH FACE LIMITED in January 2001, and the company name was registered with Companies House on 22nd January 2001. It has been using the sign SOUTH FACE on jumpers, jackets and walking boots since March 2005, but has never applied to register SOUTH FACE as a trade mark. It tells you it has never heard of Southern Face Limited.

South Face Limited would like to meet with you to discuss their options.

Prepare notes for a meeting where you will explain with reference to any relevant case law

- 1) the possible defences to trade mark infringement available to South Face Limited, and
- 2) the issues the Court is likely to consider when deciding whether the defences are applicable.

3.

You receive a telephone call from the Marketing Director of one of your clients, the large supermarket chain, TOPCO. The Marketing Director wants to register FRESH DIRECT PRODUCE in respect of "*dairy products*". She mentions that she might also use TOPCO FRESH DIRECT PRODUCE and has heard that it might be possible to file a single trade mark application for both versions of the name in order to save money. The Marketing Director tells you that there has been no use of FRESH DIRECT PRODUCE nor of TOPCO FRESH DIRECT PRODUCE.

- 1) With reference to relevant case law, write a letter to your client outlining whether you think FRESH DIRECT PRODUCE is registrable, and
- 2) Explain whether you think you can register FRESH DIRECT PRODUCE and TOPCO FRESH DIRECT PRODUCE in a single trade mark Application as a series of marks.

4.

Ten Wolves KK, a Japanese company, own a United Kingdom trade mark registration for CANDLE POD in classes 4 and 21. In class 4 the registration covers "Candles" and in class 21, the registration covers "Candle holders". The registration was entered on the UK Trade Mark Register in March 2001. Ten Wolves launched CANDLE POD candles in class 4 in the United Kingdom in May 2001, and promoted them as collectors items in the United Kingdom. Ten Wolves created 24 new collectable candles during the period 1 June 2001 to 1 June 2003, one being released for sale for each month of the two year time span. However, in August 2003, Ten Wolves abruptly stopped importing their CANDLE POD candles into the UK, and stopped marketing them in the UK because of business difficulties in Japan.

You have been approached by Ten Wolves KK, because they now have plans to launch and market a new set of collector's candles and candleholders in the United Kingdom under their CANDLE POD trade mark. However on approaching British retailers they have been told that Strictly Wax Ltd, a British company have been marketing candles and candle holders under the trade mark CANDLE POD in the United Kingdom since January 2004. Ten Wolves have ascertained that the Managing Director of Strictly Wax Ltd is one of their own former employees, who was their UK Import Manager for CANDLE POD goods during the period 2001-2003. You conduct Register searches and locate a newly filed UK application for CANDLE POD in classes 4 and 21 in the name of Strictly Wax Ltd.

Ten Wolves instruct you that they want to take action to stop Strictly Wax Ltd using and registering CANDLE POD for candles and candle holders in the United Kingdom. Prepare notes for a meeting where you will explain

- 1) the possible causes of action open to Ten Wolves, and
- 2) the issues the Court is likely to consider when deciding whether these causes of action should succeed, and
- 3) indicating (with reasons) the likelihood of success in relation to each.

5.

Durrant Boatyard Ltd have been manufacturing their luxurious FAIRSHORE boats in the United Kingdom since 1948. They have acquired a reputation in their high quality FAIRSHORE boats, but have never registered FAIRSHORE as a trade mark in the United Kingdom. However, after recent successful sales in the USA, they filed a US trade mark application on 25 June 2009 for FAIRSHORE, covering boats.

They have contacted you for advice because it has been drawn to their attention that a company called ChinChow Ltd have filed an application to register FAIRSHORE on the Trade Mark Register. Searches reveal a United Kingdom trade mark application for FAIRSHORERS for canoes in class 12 and plastic boating shoes in class 25 filed in the name of ChinChow Ltd on 27 June 2009 and advertised for opposition purposes on 25 September 2009.

Write to Durrant Boatyard Ltd advising them (1) how they might improve their position and (2) outlining possible grounds upon which they could rely in opposition against FAIRSHORERS, and (3) indicating the prospects of success.

6

Outline by reference to decided cases, the principles used in the United Kingdom to assess the likelihood of confusion, and the factors to be taken into account in this assessment. Refer to case law where appropriate.

(This is the end of Paper T1).