

THE JOINT EXAMINATION BOARD

PAPER T2 – BASIC UNITED KINGDOM TRADE MARK PRACTICE

Tuesday 10th November 2009

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 **Four** pages including this instruction sheet.

Part A – Answer eight questions

1. Explain the meaning of “earlier trade mark” in the context of UK Trade Marks Act 1994 (“Trade Marks Act”). There is no need to refer to recently expired trade marks. **(5 marks)**
2. Explain the practice of the UK Intellectual Property Office in relation to shopping centres. **(5 marks)**
3. Briefly discuss inherent registrability of two of the following trade marks under the current practice of the UK Intellectual Property Office:
 - (a) THE BEATLES for “posters and figurines”
 - (b) SHAKESPEARE for “mugs”
 - (c) TAKE THAT for “live musical performances”**(5 marks)**
4. List five grounds of invalidity in accordance with the UK Trade Marks Act 1994. **(5 marks)**
5. Your client asks you to file the following as a UK trade mark application “The mark consists of the appearance of a tennis-themed restaurant, the interior of which is contained in this photograph”. Briefly explain any likely objections. **(5 marks)**
6. Describe what amendments may be made to a UK trade mark application, post-filing. **(5 marks)**
7. Your client asks you to file a trade mark application for a drawing of a cow for “children’s sleepwear”. Briefly outline the practice of the UK Intellectual Property Office in relation to such devices. **(5 marks)**
8. Your client has asked you to file a Japanese character mark, the English translation of which is “clean teeth”. The relevant goods include toothpaste and other oral care goods. Comment on the inherent registrability of this mark as a UK trade mark application. **(5 marks)**
9. Write brief notes to explain the effect of disclaiming material from a UK trade mark application. **(5 marks)**

Part B – Answer five questions

10. Your client wishes to oppose a trade mark application in the UK. List the procedural steps involved in filing an opposition and all subsequent actions that are required by both parties up to the final decision of the UK Intellectual Property Office. Candidates are expected to mention the deadlines, if any, that will be set for each action and whether or not these deadlines are extendible. Reference to the Appeals process is not required. **(12 marks)**

11. Discuss the inherent registrability of four of the following:

(a)



For building services

(b)



For ticketing information services

(c)



For foodstuffs

(d)



For pesticides and extermination of pests

(e)



For stationery

(12 marks)

12. (a) Explain what is meant by a "Registrable Transaction" under the UK Trade Marks Act 1994. **(2 marks)**
- (b) Is it necessary for a UK trade mark application to become registered before it is assigned? **(1 mark)**
- (c) In order to effectively transfer ownership of a UK trade mark registration under English law, who needs to execute the assignment? **(1 mark)**
- (d) List four items that you recommend be included in an assignment of trade marks. **(4 marks)**
- (e) Briefly explain why a licensee of a UK registered trade mark should record the licence agreement at the UK Intellectual Property Office. **(4 marks)**
13. Your client's UK trade mark application is objected to on the basis that it is insufficiently distinctive for registration. Your client has been using the mark for fifteen years as the trade mark for a shoe cleaner. Your client has asked you to meet with a representative from a large shoe care retailer who is prepared to give a statement that the mark has acquired distinctiveness. Prepare brief notes on ideal form and content of this statement. **(12 marks)**
14. Your client is the producer of a range of liquid soaps. During a meeting he shows you a three dimensional design drawing for a new soap dispenser with an extended arm to help the flow of the soap from the container to the user. Otherwise the design is very similar to standard soap dispensers on the market. Your client is keen to obtain trademark protection for the shape of the soap dispenser.
- Discuss the registrability of this shape in the context of the provisions of the UK Trade Marks Act 1994 which deal with registrability of shape marks. **(7 marks)**
- Your client asks whether he should apply to register a two dimensional picture of the soap dispenser. Write notes on whether the mark would be registrable as a trade mark. No consideration of patents, designs or copyright is required. **(5 marks)**
15. Your client has been selling motorcycle helmets and protective clothing for motorcycle riders under the mark BRAITHAIR for three years. She has not made any trade mark filings to date.
- Advise on any searches you would recommend that she carry out at this point. **(8 marks).**
- Assuming the searches are clear and that your client now applies to register BRAITHAIR, write brief notes on the optimal way to use the mark to ensure that customers recognize its status as a trade mark. **(4 marks).**