

THE JOINT EXAMINATION BOARD

PAPER T1 – BASIC UNITED KINGDOM TRADE MARK LAW

Thursday, 4th November 2010

3.00 p.m. – 5.00 p.m.

*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.
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 the first answers given by you will 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 page.

Part A

1. Section 92 (1) of the Trade Marks Act 1994 lists acts, committed by a person in relation to unauthorized use of a trade mark etc. in relation to goods, which constitute an offence. What are those offences? **5 marks**
2. What are the limits on the effect of a registered trade mark, set out in Section 11 of the Trade Marks Act 1994? **5 marks**
3. Under Section 56 (protection of well known trade marks; Article 66bis) of the Trade Marks Act 1994: **5 marks**
 - a) What is a well known mark and who is entitled to its protection in the UK?
 - b) What remedy is the owner of a well known mark entitled to under this Section?
4. What are the provisions of Section 39 of the Trade Marks Act 1994 relating to withdrawal, restriction or amendment of a trade mark application? **5 marks**
5. Section 95 of Trade Marks Act 1994 sets down the provisions relating to falsely representing a trade mark as registered. What are those provisions? **5 marks**
6. Section 21 of the Trade Marks Act 1994 sets out the remedies for groundless threats of infringement proceedings. What are the remedies listed? What limitations are the remedies subject to? **5 marks**
7. Under Section 9 (Rights conferred by registered trade mark) of the Trade Marks Act 1994: **5 marks**
 - (a) What rights does the proprietor of a registered trade mark have?; and
 - (b) When do those rights have effect?; and
 - (c) What are the conditions attached to those rights?
8. List the five registrable transactions for a registered trade mark set out in Section 25 (registration of transactions affecting registered trade marks) of the Trade Marks Act 1994. **5 marks**
9. Section 47 of the Trade Marks Act 1994 deals with invalidity of a registered trade mark. **5 marks**
 - (a) On what grounds may the registration of a trade mark be declared invalid under section 47?
 - (b) In what circumstances do these grounds not apply?
 - (c) What is the effect of a successful invalidity action under section 47?

10. In what circumstances does a person infringe a registered trade mark under Section 10 (infringement of registered trade mark) of the Trade Marks Act 1994?

5 marks

Part B

11. You receive an email from Mr Cross, the Managing Director of a financial services company based in New York, called Surefoot Investment LLC. Mr Cross tells you that Surefoot Investment LLC is the registered proprietor of UK Trade Mark Registration No. 2135791 SUREFOOT in respect of the following description of services in Class 36:

12 marks

Class 36: "Financial services; investment management services; asset management; hedge fund administration"

The registration procedure was completed on 2nd May 2005.

Mr Cross has just received a letter from the UK based company, Surefoots Capital Ltd, warning him that if the UK Trade Mark Registration for SUREFOOT is not surrendered, Surefoots Capital Ltd will apply to revoke it, because it has not been used in the United Kingdom in the last 5 years.

Mr Cross is very worried that SUREFOOT is going to be revoked for non-use, because his company has not managed to secure any new clients in the UK in the last 5 years. He has a small number of UK customers who are sent brochures regarding the financial services offered by Surefoot on a regular basis and he also produces a newsletter which is sent to those same customers on a monthly basis.

Mr Cross tells you that the type of investment funds that his company offers in the UK are unregulated funds. There are legal restrictions placed on their promotion within the UK. They can only be offered to specific identified clients who are high worth or sophisticated investors. For this reason, Surefoot Investment LLC does not have a website, and it does not pay marketers to market its financial services in the UK.

Mr Cross does not understand the UK Trade Mark system, and has asked you to reply to his email outlining:

- (1) the grounds on which the registration of a trade mark may be revoked;
- (2) with reference to relevant case law, the guiding principles the Trade Marks Registry are likely to use to determine whether SUREFOOT has been used in the UK;
- (3) with brief reasons, whether you think SUREFOOT is likely to be revoked for non-use.

12. Your client, BAYBERRY Holdings Limited, applied to register the trade mark BAYBERRY in respect of "fresh fruit" in Class 31. The trade mark application was accepted for registration and published for opposition purposes on 30th April 2010.

12 marks

On 28th July 2010 BAYZBERRIES (UK) Limited filed opposition to registration of BAYBERRY in Class 31. The grounds of Opposition are, in summary, that the Opponent is the registered proprietor of an earlier UK Trade Mark Registration for BAYZBERRIES registered in respect of "frozen fruits" in Class 29. The Opponent claims BAYBERRY is similar to BAYZBERRIES and claims that the goods in Class 31 are similar to the goods for which the earlier trade mark is registered. Consequently, there is a likelihood of confusion and the application should be refused under S5(2)(b) of the UK Trade Marks Act 1994. The registration process for BAYZBERRIES was completed on 15th June 2007.

Prepare notes for a meeting with the Company Secretary of BAYBERRY Holdings Limited outlining:

- (1) with reference to relevant case law, what factors will be considered in determining the likelihood of confusion between the trade marks BAYBERRY and BAYZBERRIES (6 marks);
- (2) with reference to relevant case law, what factors will be considered in determining the similarity or otherwise of the goods covered by the respective marks (4 marks);
- (3) your opinion on the chances of success in the Opposition (2 marks).

13. Your Clients, Paulus Limited, have telephoned you with great concern because they have received a letter from a company, Dunkers Limited, who were exhibiting their goods on the stand next to Paulus Limited at the Plymouth Boat show three weeks ago.

12 marks

Paulus explain to you that they have recently launched new concept boat shoes under the trade mark BRETONS and they presented them to the market for the first time at the Plymouth Boat Show.

The boat shoes are fabricated in such a manner that they provide exceptionally good grip on boat decks without hindering forward, backward or lateral movement.

Dunkers Limited are manufacturers of lifevests for sailors under their BARRACUDA brand, which they displayed at the show.

Paulus Limited advise you that it was apparent at the show that browsers at the Dunkers stand quickly left the stand to make their way to view Paulus' new concept BRETONS shoes, leaving Dunkers' stand empty of browsers and shoppers for most of the time.

At a meeting with you, Paulus Limited gives you a copy of a letter which has been sent to one of their customers by Dunkers Limited:

"Dear Sirs

We demand that you immediately stop using the name BRETONS on your shoes because you are blatantly infringing our UK trade mark registration No. 226178 BARRACUDA which is registered in respect of lifevests for sailors. We are going to sue you for trade mark infringement and we are going to make you pay compensation for the damage that we have suffered because of your use of BRETONS which is infringement of our registered trade mark.

Yours faithfully

Dunkers Limited"

Make notes to Paulus Limited on the following:

- (i) the law in relation to groundless threats of infringement under the Trade Marks Act 1994;
- (ii) discuss whether Paulus are infringing Dunker's registration;
- (iii) what remedies are available, if any, to Paulus in respect of the infringement threats.

- 14.** You have been approached by Rod Runner, Managing Director of Jonquil Limited. He tells you that Jonquil Limited have been using their BLACKRACK trade mark for some twenty years in the United Kingdom.

12 marks

In 1990, Jonquil Limited opened their first motorcycle repair garage offering repair services for customized motorcycles and during the next five years they opened up branches in major cities in regions throughout the United Kingdom.

In 1998, Jonquil developed a high grade polishing preparation for motorcycles which was marked with the BLACKRACK trade mark and has been sold by Jonquil Limited in all their garages throughout the United Kingdom since 1998.

Rod Runner tells you that Jonquil Limited have recently become aware of launch in the United Kingdom of a range of engine oils and custom made automotive paints under the trade mark *blackrack* by Gwangdong Limited. A number of their established customers have contacted Jonquil asking for their "new engine oils and custom made automotive paints", which they say they have seen for sale in local motorcycle shops.

Jonquil Limited filed an application to register their trade mark BLACKRACK in 2002 in the United Kingdom for "motorcycle repair services" in class 37, "motorcycles" in class 12, "engine oils" in class 4, and "polishing preparations" in class 3. The mark was entered on to the United Kingdom Trade Mark Register in March 2003.

After discussing the matter with Rod, it is clear that Jonquil has only used its trade mark BLACKRACK for the repair services and the polishing preparations, but that it has established a reputation in these services and goods.

Rod asks you what Jonquil Limited can do to stop the use of *blackrack* by Gwangdong Limited.

In preparation for a meeting with Rod you conduct Register searches and note that Gwangdong Limited do not have a UK or Community trade mark application or registration for their *blackrack* trade mark.

Prepare advice to Rod in note form in respect of:

- (a) the legal basis of any actions that could be taken against Gwangdong's use of the trade mark *blackrack*;
- (b) the validity of their trade mark registration;
- (c) any other actions you would advise Jonquil to take to secure their position.

15. Your Client, John Doe, is the owner of a company, Angelwings Limited, which, for a period of twenty five years, manufactured fine wood coffins under the trade mark DIVINE REST and sold them throughout the United Kingdom in a substantial manner.

12 marks

However, four years ago John Doe's business partner, Jack Jones, co-owner of the business, died. Due to legal and financial complications surrounding Jack's death, Angelwings Limited has not manufactured or sold any coffins since Jack's demise. Indeed, John allowed the company's United Kingdom trade mark registration No. 2101006 for DIVINE REST in class 20 for "coffins" to lapse when it fell due for renewal five months ago.

John Doe has finally resolved all the legal issues and is now the sole owner of Angelwings Limited and all its intellectual property. He has reopened the business and is selling coffins again.

John Doe has just become aware of another company Coffin (Accessories) Limited which is using the trade mark DIVINE REST for "coffin handles" and "satin burial shrouds". A search of the UK Register has revealed Application No. 2944700 for DIVINE REST covering "brass handles for coffins" in class 6 and "satin burial shrouds" in class 24. The application was published for opposition purposes on 24 October 2010.

Write a letter to John Doe discussing :

- (a) the grounds on which he could oppose the application;

- (b) the actions available to him to secure his rights in the trade mark registrations;
- (c) your opinion on his chances of success.

16. Outline the opposition procedure followed by the UK Trade Marks Registry from publication of an application to final decision, including the forms required and relevant timescales. (Do not discuss Appeals from the Registry).

12 Marks