

THE JOINT EXAMINATION BOARD

PAPER T3

ADVANCED UNITED KINGDOM TRADE MARK LAW AND PRACTICE

Wednesday 10 November 2010

10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. **Time Allowed – 4 HOURS***

1. You should attempt **FOUR** questions.
2. The marks awarded to each question are shown at the foot of the question
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.

This paper consists of 8 pages

QUESTION 1

You act for Apostle LLC, a United States corporation. Apostle owns a trade mark registered in the United States in 2007 for the mark FRODDLE in respect of 'office chairs' and used in relation to a range of office chairs. Apostle does not hold any trade mark applications or registrations in the United Kingdom.

Apostle has conducted some brief searches of the register which disclosed the following United Kingdom Trade Mark Registration:

Mark: FRODDLE CHAIRS
Class: 20: Office chairs
Owner: Bluebottle Limited
Application date: 5 December 2009
Registration date: 4 July 2010

Your client informs you that from July 2008 Bluebottle acted as Apostle's distributor in the United Kingdom. Disagreements and arguments between Apostle and Bluebottle started in November 2009 and the relationship finally ended acrimoniously in June 2010. Apostle then decided to market the range of chairs directly rather than through a distributor.

The search results worry Apostle because it is due to exhibit its FRODDLE range at a large trade show in a few weeks. This is the largest sales event in the industry and crucial to secure orders.

Your client's watching service has also picked up a new United Kingdom Trade Mark application for the mark FROBBLES covering office furniture in Class 20, in the name of Dunkem Limited. This has not yet been published for opposition purposes, but the client asks whether there is anything it can do to prevent this mark being registered.

1. Advise your client on the actions Bluebottle could take against Apostle based on its trade mark registration. Include in your advice and comment on any defences Apostle may have to those actions. **(12 marks)**
2. What action Apostle could take against the application for FROBBLES in the name of Dunkem Limited? **(9 marks)**
3. What other steps would you recommend taking to improve Apostle's position? **(4 marks)**

25 marks

QUESTION 2

The partner to whom you report has given you two files relating to United Kingdom matters to work on:

1. The first concerns your client Acanthus Lingerie Limited's mark 'Soie de la Lune' (which they say is the French for 'silk of the moon' or 'moonsilk') for 'clothing'. They say they have been using the mark for about three and a half years, for men's pyjamas made from an advanced polymer fabric with a smooth surface texture. They are considering introducing a range of women's undergarments under the Soie de la Lune mark but this time to be made from silk. A search reveals no conflicting earlier trade marks. Draft a letter to your client giving your recommendation as to the form of any application(s) and setting out any objections which might be raised in the course of examination, and, where possible, means of overcoming such objections. **(13 marks)**

2. The second file relates to an application for the mark CORALEX for 'Class 18: cases' filed last month on his own behalf by an individual, Luigi Involtini. In seeking your firm's help Mr Involtini explained that he makes traditional handcrafted cases for violins. For the past six months or so he has been selling the cases in the United Kingdom under the name CORALEX (a word he invented, with no known meaning). He filed for 'cases' because he wanted broad protection, as he might later wish to make handcrafted cases for violas, cellos or even double basses. The application has become particularly important because he has received notification that three days after he filed it, an American company of whom he had never heard filed an application (not claiming priority) for CHORALEX in Class 15 for 'violin cases'. Upon checking the classification database you find that 'Cases adapted for musical instruments' and 'Cases for musical instruments' do indeed fall within Class 15. Make notes for a meeting with the partner on any possible problems raised by Mr Involtini's application, whether the application can be amended and other steps he could potentially take. **(12 marks)**

25 marks

QUESTION 3

You act for Marsk A/S, a Danish dairy company, producers of the FREYR brand of cheese. 'Freyr' is a Norse god, responsible for bountiful harvests. FREYR cheese was unknown outside its native Denmark until six years ago when the brand was introduced into the United Kingdom. A concerted marketing effort by Marsk A/S together with a fortuitous appearance in a popular television cookery show combined to push FREYR cheese into the top 20 best-selling brands of cheese in the UK. Your client owns the following UK trade mark registration:

Trade Mark:	FREYR
Registration No.	1111111
Registration Date:	4 September 2003
Goods:	Class 29: Dairy products

You are contacted by Ms Ahler, marketing director of Marsk A/S. Ms Ahler has become aware that the KULAK minimarket chain has recently begun stocking a mild white cheese called 'FREYR WHITE' in its stores nationwide.

Ms Ahler has drafted a letter to the head office of KULAK, indicating that Marsk A/S owns the rights in the name FREYR and that the sale of FREYR WHITE cheese in KULAK stores is illegal under trade mark law. She has asked that you send the letter on her behalf, to lend it more weight.

Ms Ahler is also keen to take action against the producer of the cheese, Runnthorpe farm in Yorkshire. You carry out an investigation which reveals that the owners of Runnthorpe farm, Mr and Mrs Whiteacre, have been selling FREYR WHITE cheese from their farm shop to local residents since the late 1970s, and the cheese has something of a following in the local area. The cheese's name was chosen as a reference to the area's Viking heritage. Last year, Mr and Mrs Whiteacre retired, leaving the running of the farm to their daughter Julie. Julie plans to expand the business, and the sale of FREYR WHITE cheese to KULAK minimarkets is her first success.

1. Advise your client on the actions available against the producer of FREYR WHITE cheese, including consideration of any defences available and an assessment of the likelihood of success. **(20 marks)**
2. Advise on the proposal to send a letter to KULAK minimarkets, mentioning any changes you would suggest. **(5 marks)**

25 marks

QUESTION 4

Your new client, Rogans, sells greetings cards, wrapping materials and novelty toys through a nationwide chain of stores. They are now considering expanding into DVDs, CDs and board games. In 2000 they began running an advertising campaign on television and on billboards, using the line "ROGANS. WE HOLD ALL THE CARDS". The campaign was very successful and they have used this line ever since in their advertising, on their shop fronts and on their carrier bags.

The client holds a United Kingdom registration for the mark ROGANS covering a broad range of goods and services in Classes 9, 16, 28 and 35.

On 1 October 2010 the client filed a United Kingdom Trade Mark application for the mark WE HOLD ALL THE CARDS covering the following goods and services:

Class 9: DVDs, compact discs.

Class 16: Greetings cards, gift wrapping materials, gift bags.

Class 28: Soft toys and playthings, board games.

Class 35: Retail services connected with the sale of DVDs, compact discs, greetings cards, gift wrapping materials, gift bags, soft toys and playthings, board games.

They have received an objection from the UK IPO as follows:

Absolute grounds for refusal (section 3)

The application is not acceptable in Classes 9, 16, 28 and 35 as there is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of the words WE HOLD ALL THE CARDS, being purely a laudatory phrase which may serve in trade to designate the kind and characteristics of the goods and services e.g. a store in which all kinds of cards are sold.

1. Advise your client on the objections and what arguments you could put forward to overcome the objections, making reference in your answer to relevant case law. **(15 marks)**

2. Your client mentions that he has heard of "acquired distinctiveness" and asks whether this might be relevant. Advise him on the law and practice in this regard, and the evidence you will require. **(10 marks)**

25 marks

QUESTION 5

You act for Werner Travel Limited ("WTL"), which has been publishing the HALCYON DAZE series of travel guides since 2002. The guides cover most major European cities and are aimed mainly at young backpackers on a budget, with an emphasis on cheap accommodation and nightlife. Since 2007 WTL has also published a bi-monthly newsletter entitled HALCYON DAZE aimed at young travellers, including features on up-and-coming destinations, tips for travelling on a limited budget etc. Whilst the guides sell in reasonable numbers and the newsletter has an adequate readership, neither is particularly well known. Your client owns the following UK trade mark registration:

Mark:	HALCYON DAZE
Owner:	Werner Travel Limited
Registration No.:	2222222
Registration Date:	3 May 2002
Goods:	Class 16: Printed matter; books; bookbinding materials; photographs; instructional and teaching materials (except apparatus).

Werner Travel Limited has for some time been meaning to create an on-line presence for its travel guides, and was intending to register the domain name www.halcyndaze.co.uk. However, on seeking to do so they have discovered that the domain name has recently been registered by a US company called Halcyon Daze Inc. The domain does not yet host a website, although there is a holding page indicating that a site is under construction.

Further investigation reveals that Halcyon Daze Inc. is a US-based on-line retailer specialising exclusively in historical books, which has been trading through the website www.halcyndaze.com since 2005. The website, which features the mark HALCYON DAZE prominently, sells historical books from numerous publishers, most of which are factual academic books. However, their range does include some specialist history-related travel guides such as *Battlefields of the Mexican-American War* and *Walking Tours of Georgian London*.

Halcyon Daze Inc's main market is North America, but they do offer delivery worldwide. Books ordered from Halcyon Daze Inc. arrive from the US in a padded envelope emblazoned with the HALCYON DAZE mark, although the mark does not appear on the books themselves.

Halcyon Daze Inc. has recently begun publishing in the United States a monthly digest of history-related articles under the HALCYON DAZE mark.

Your client is very unhappy about this 'American interloper' and wants to get the domain name www.halcyndaze.co.uk for itself, as well as stopping the US company muscling in on their trade mark.

- 1) Advise your client on the likelihood of successfully recovering the domain name www.halcyndaze.co.uk using Nominet's dispute resolution policy. **(5 marks)**
- 2) Advise on any action available against Halcyon Daze Inc's sale of books through www.halcyndaze.com, including consideration of any defences or counter-claims available. **(12 marks)**
- 3) Advise on whether WTL can prevent the launch of the HALCYON DAZE periodical in the United Kingdom. **(8 marks)**

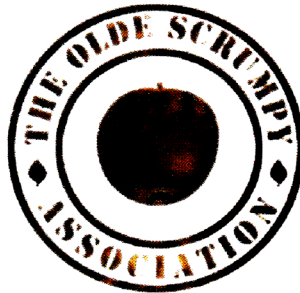
25 marks

QUESTION 6

You are approached by Mr Cotham, the owner of Huntbury Ciders Limited, a Somerset-based cider producer. Huntbury Ciders specialises in brewing *scrumpy*, a particular type of English cider, which has a loyal following in the United Kingdom.

Mr Cotham explains that although there is no precise legal definition of what scrumpy is, it is generally considered to refer to a variety of cloudy and unfiltered cider predominantly produced in the South West of England, mostly by small producers. Scrumpy typically has an alcohol content (6-8%) which is considerably higher than that of many other ciders. Whilst few cider drinkers in the UK could tell you much about how scrumpy is made, they regard it as different from other ciders (and other alcoholic beverages) and when they order scrumpy they have a particular type of drink in mind.

Huntbury Ciders prides itself on the quality of its scrumpy, which is made using only traditional cider apple varieties, grown organically. After fermentation, the scrumpy is matured in casks for at least two years, much longer than scrumpy made by many other producers. Huntbury Ciders and a number of other scrumpy producers with the same high standards have formed The Olde Scrumpy Association. Members may include the association's logo (shown below) on the labels of their scrumpy, in order to show that it meets the Association's standards.



Earlier this year D&N Beverages Limited launched a new drink in the United Kingdom under the mark *SCRUMPYSH*, which is produced at its factory on the outskirts of Belfast, Northern Ireland. The *SCRUMPYSH* product is not a scrumpy, nor does it contain scrumpy, it is a ready-mixed drink consisting of equal parts cider and lemonade (a cider shandy) with an alcohol content of 2%. *SCRUMPYSH* cider shandy sells for considerably less than the same quantity of scrumpy, owing to the lower rate of tax and the industrial scale on which it is produced. The labelling of *SCRUMPYSH* features an outline map of the South West of England together with rural scenes. Whilst the labelling does not describe *SCRUMPYSH* as a scrumpy, it is not clearly described as a cider shandy and it seems that there is some confusion as to what the product is, with many shops and supermarkets placing it on their shelves alongside scrumpys, rather than with other mixed drinks, and consumers mistakenly buying it instead of scrumpy.

Mr Cotham and other scrumpy producers are outraged by the *SCRUMPYSH* product. Whilst Mr Cotham appreciates that no single producer owns rights in the term 'scrumpy', he feels that there must be something that can be done to stop D&N Beverages devaluing the scrumpy name.

- StudentBounty.com
- 1) Advise Mr Cotham on what the The Olde Scrumpy Association can do to protect their logo, and what they would need to file in order to obtain registration. **(8 marks)**
 - 2) Explain whether there might be a remedy in law for preventing D&N Beverages' sale of SCRUMPYSH cider shandy and what it would be necessary to demonstrate through evidence in order to succeed. **(17 marks)**

Ignore any issues arising under the Trade Descriptions Act or the law governing Protected Indications of Geographical Origin