

## THE JOINT EXAMINATION BOARD

## PAPER T3

## ADVANCED UNITED KINGDOM TRADE MARK LAW AND PRACTICE

Thursday 3rd November 2011  
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.
  - g. You must number all the pages of your answer script. Once the exam finishes, an additional 5 minutes will be allowed for you to do this.
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, number all the pages 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 9 pages

**QUESTION 1**

Your client Major General Limited is about to launch a range of portable music MP3 players in the United Kingdom. When the players are turned off and on, an animated sequence appears on the screen of the player. This consists of a visual representation of a musical note, which morphs into a cartoon soldier who salutes the user. A catchy bugle tune, composed by the client, is played over the animation. The MP3 players are all khaki green with a yellow stripe across the back. Your client has enquired about obtaining trade mark protection.

1. Your client wishes to know if there is anything they can protect by trade mark registration. Advise your client on what you would seek to register and what is likely to be accepted by the Intellectual Property Office. **(19 marks)**

2. Your client sells a range of portable music players under the following names:

LIEUTENANT 100  
LIEUTENANT 200  
LIEUTENANT 300  
LIEUTENANT 400  
LIEUTENANT 500  
LIEUTENANT 600  
LIEUTENANT 700  
LIEUTENANT MILLENNIUM

Your client wishes to register all of the above marks in the most cost-effective way. Advise your client on its options for registration, including your recommendations and an explanation of your suggested filing strategy. **(6 marks)**

**Ignore any issues relating to copyright or designs**

## QUESTION 2

You act for Summit Entertainment Limited ("Summit"), a television broadcasting company. Summit produced a television programme entitled DOWNHILL CHALLENGE, in which contestants competed to race homemade soap box racers (unpowered go-karts) over a downhill course. The programme was shown in weekly episodes between October 1996 and February 2003.

During the height of the programme's popularity, it attracted around 20% of UK television viewers at the time it was broadcast and Summit produced a popular range of DOWNHILL CHALLENGE-branded merchandise, including books, calendars, toys, a board game and clothing.

In 1995, Summit filed a UK trade mark application for DOWNHILL CHALLENGE, covering entertainment services in Class 41, together with a range of goods in Classes 16, 25 and 28. On 12 March 2005 the resulting registration fell due for renewal, but was not renewed by Summit and was consequently removed from the register.

Summit is now considering re-launching the DOWNHILL CHALLENGE programme. Their research suggests that people remember the original programme and would welcome its return to the screen. A recent poll in a popular television listings magazine placed DOWNHILL CHALLENGE in the top 50 television programmes of the last decade (at number 46). Summit now plans to produce a one-off Christmas special in order to gauge the public's appetite for a full series.

You conduct a search and identify the following UK trade mark registration:

Registration No.:	3055396
Mark:	DOWNHILL CHALLENGE
Owner:	James Munro
Registration Date:	7 October 2006
Specification:	Class 41: Entertainment; arranging and organising competitions.

Further investigation reveals that the owner, James Munro, is a soap box racing enthusiast and was a contestant in an episode of Summit's programme in 1999. When Summit ceased broadcasting the programme in 2003 Mr Munro began organising soap box racer events for fellow enthusiasts under the mark DOWNHILL EXTRAVAGANZA, charging spectators a small fee. Many of the participants at these events had been contestants on Summit's programme and the event posters frequently made reference to this with strap lines such as 'Featuring soap box racers from TV's Downhill Challenge'. In December 2006 Mr Munro dropped the DOWNHILL EXTRAVAGANZA name and began calling his events DOWNHILL CHALLENGE.

Last month your client contacted Mr Munro on an informal basis, to ask him to stop using the DOWNHILL CHALLENGE name and to surrender his trade mark registration, or assign it to Summit Entertainment Limited. Unfortunately, Mr Munro is not willing to co-operate – it seems that he wrote to Summit in August 2005, requesting their consent to his use and registration of DOWNHILL CHALLENGE in relation to soap box racing events. Despite sending a reminder, Mr Munro received no response. Mr Munro argues that your client abandoned the DOWNHILL CHALLENGE brand and he is now building it back up.

Your client is not keen on Mr Munro's activities, but they do not want to waste time on this until they know whether they will be making another series of DOWNHILL CHALLENGE.

1. Explain the risks involved in delaying taking action against Mr Munro  
**(5 marks)**
2. Advise your client on the grounds available to:
  - a. prevent Mr Munro's use of the DOWNHILL CHALLENGE mark  
**(8 marks)**
  - b. remove UK Trade Mark Registration No. 3055396 from the Register  
**(12 marks)**

### QUESTION 3

You are consulted by Mr Norris, a professional chimney sweep, based in the Birmingham area. Mr Norris has been trading under the name 'SOOTY THE SWEEP' since 1983, during which time he has built up a substantial list of customers (over 500) – mostly home owners but also businesses and some light industry. Your client spends relatively little on advertising; his business is listed in the Birmingham business directory and he periodically takes out small advertisements in the local Birmingham press during the winter months (his busiest period). However, the majority of new customers come to him on the recommendation of existing customers. Virtually all Mr Norris' customers are located in Birmingham and the surrounding suburbs.

Mr Norris is reaching retirement age and plans to sell his business in the next year or two. Whilst the sale will include his van and equipment, he explains that his most valuable assets are his customer list and trading name.

Mr Norris has just become aware of another chimney sweep, a Mr Winstanley, based in Coventry (19 miles away) who is also trading under the name SOOTY THE SWEEP. An internet search suggests that the SOOTY THE SWEEP name is not unique to Mr Norris; there are at least 10 other chimney sweeps trading under the name in the UK, but, other than Mr Winstanley, the next closest is over 100 miles away.

Mr Winstanley's chimney sweeping business, which began trading in 2009, is solely focussed on residential properties, mostly in Coventry. During the quieter summer months he is paid to appear at weddings, benefiting from the tradition that chimney sweeps bring luck at such events, and has appeared at weddings throughout the West Midlands (which includes the cities of Birmingham, Coventry and Wolverhampton). Mr Winstanley advertises his services in the Coventry business directory and the local Coventry press. In recent months he has also begun advertising in the local Birmingham press and has launched a website (at [www.sootythesweep.co.uk](http://www.sootythesweep.co.uk)) which details both his chimney cleaning and wedding appearance services, and describes his business as serving the West Midlands.

Your client is concerned that Mr Winstanley's activities will hurt his prospects for selling his business and he thus wants to put a stop to his use of the name SOOTY THE SWEEP. He's also upset that Mr Winstanley has registered the domain [www.sootythesweep.co.uk](http://www.sootythesweep.co.uk), as his children have been nagging him to set up his own website to make his business more attractive to purchasers and that was the domain name he wanted.

1. Advise your client whether he has any grounds, based on his existing unregistered rights, for preventing Mr Winstanley's use of the name 'SOOTY THE SWEEP', and his likelihood of success. **(15 marks)**
2. Advise your client whether he can recover the domain name [www.sootythesweep.co.uk](http://www.sootythesweep.co.uk) using Nominet's dispute resolution service. **(6 marks)**
3. Advise your client on whether Mr Winstanley's activities will affect the freedom of Mr Norris, and any purchaser of his business, to use the name 'SOOTY THE SWEEP'. **(4 marks)**

**QUESTION 4**

Your client Fastgrub Limited has recently filed a United Kingdom Trade Mark application for the mark CARANERRO ROLLS covering sausage rolls in Class 30. They have received an approach from Caranero Limited. Caranero have threatened to oppose the client's application on the basis of Caranero's United Kingdom Registration below:

Application date: 25 July 2007  
Registration date: 30 November 2007  
Mark: CARANERO:  
Goods: Jewellery in Class 14

Caranero have indicated that the opposition would be based on section 5(3) of the Act as follows:

S. 5(3) – the Opponent's mark has a reputation in the United Kingdom in relation to jewellery and use without due cause would take unfair advantage of, and be detrimental to, the distinctive character and repute of the Opponent's mark.

Included with Caranero's letter is a large amount of evidentiary material showing that the Opponent's CARANERO mark has been in use in the United Kingdom for over twenty years and the business has been very successful. CARANERO jewellery is sold at premium prices through Caranero Limited's shops, which are situated in the finest shopping areas in London, Edinburgh, Birmingham and Cardiff. The jewellery is advertised in upmarket publications and the brand is portrayed as the ultimate luxury gift for the discerning buyer. The word CARANERO has no meaning. Your client informs you that he chose the name CARANERRO ROLLS "because it sounds classy".

1. Explain the potential grounds of opposition mentioned by the Opponent, including what the Opponent would have to prove in order to succeed. **(15 marks)**
2. Advise on any defences or counter-arguments that might be available to your client, including in your advice your views on the likelihood of success. **(10 marks)**



### QUESTION 5

You act for a successful livestock and pet food manufacturer. One of your client's products is an edible chew for dogs which contains various additives which have a calming or soporific effect. The UK version of your client's product, which has been on sale since 1995, is called CALMING CHOO. The CALMING CHOO product was the first commercially available calming dog chew and retains an 80% share of the market. Your client invests heavily in advertising CALMING CHOO products, on television, in veterinary surgeries, on the packaging of their dog food ranges and through sponsorship of dog shows. The packaging of your client's product has always been light blue with light pink cloud motifs and these colours and images are frequently echoed in your client's advertising.

As a result of your client's extensive sales and advertising of their product, the CALMING CHOO mark and the product's blue and pink packaging are likely to be familiar to most dog owners in the UK.

Your client owns the following UK Trade Mark Registration:

Trade Mark:	CALMING CHOO
Registration No.:	2011669
Registration Date:	3 June 1995
Specification:	Class 31: Pet food; edible chews for animals.

There are now various similar products on the market, sold under brands such as DREAMY CHEW, MAGIC NIBBLES, MOON CHEW and CHILL OOT CHEWS. The manufacturers of these products are careful to avoid referring to their products as 'calming chews' for fear of upsetting your client. However, a search of the internet suggests that there is a tendency amongst some consumers to do so, e.g. *"You should try Magic Nibbles – they're a calming chew for dogs. My two love them"*

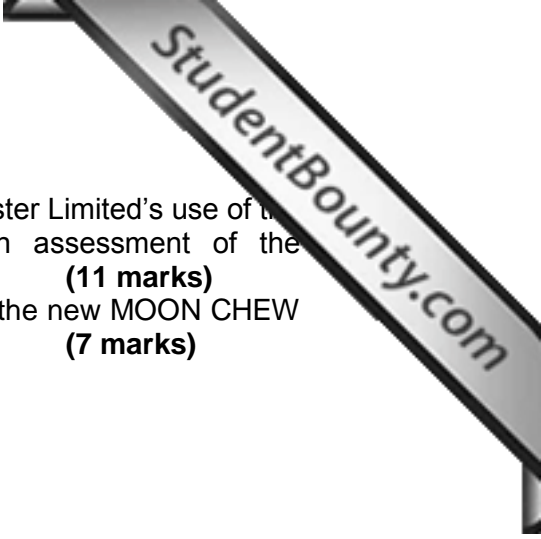
Your client has just become aware of a new soporific chew product being sold under the name CHUMBA CHEW, manufactured by Radchester Limited. The product packaging features the strap-line "The organic calming chew". Your client is concerned that consumers may take this product to be a variant or new version of their CALMING CHOO product and want to put a stop to Radchester's use of the strapline.

To add to your client's troubles, the manufacturers of MOON CHEW, one of your client's existing competitors, have recently updated their packaging. They were previously using a mid-blue colour, but have changed to a lighter blue and added clusters of light pink bubbles. The overall impression is similar to your client's packaging, particularly from a distance. Your client is unhappy about the new MOON CHEW packaging and wants to know whether there is anything they can do to put a stop to it given that they do not have any trade mark registrations covering the appearance of their product.

Your client would like to schedule a telephone call to discuss their options.

Ahead of your telephone call with the client, prepare notes on:

1. the grounds available to Radchester Limited to cancel your client's registration, and the likelihood of success. **(7 marks)**

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2. the grounds available to your client to prevent Radchester Limited's use of the strapline 'the organic calming chew', including an assessment of the likelihood of success. **(11 marks)**
  3. the grounds available to your client to stop the use of the new MOON CHEW packaging, and the likelihood of success. **(7 marks)**

**Ignore any copyright or design right issues**



**QUESTION 6****Part 1.**

You act for Luxurelle Limited, which sells a range of premium make-up items through department stores in the UK under the mark Mekon. The goods all bear the marks Luxurelle and Mekon, and many of the shades have their own names such as Red Fire and Black Night. Luxurelle have United Kingdom trade mark registrations including for Luxurelle, Mekon, Red Fire and Black Night, covering an array of make-up items in Class 3.

Your client's goods are only available through the department stores with which they have distribution agreements. As part of the agreement, Luxurelle sends the department stores tester kits that allow the department store employees to demonstrate the goods to customers. These kits include lipsticks in transparent containers marked Red Fire or Black Night and are delivered in plain white boxes with the mark Mekon and the words "For demonstration purposes only – not for resale" stamped on the box. The agreements make it clear that the marketing materials and tester kits remain the property of Luxurelle.

Your client has recently seen the lipsticks for sale on an internet auction site directed at UK consumers. The goods are described on the site as "Mekon lipstick".

Your client asks whether there is anything they can do to prevent the sales of these goods on the auction site. Advise your client on any action they could take. **(9 marks)**

**Part 2.**

Luxurelle sells its goods throughout Europe. Apart from the marks Luxurelle and Mekon, the rest of the text on the containers is different between countries as it is printed in the local language of that country. The different shades have their own local language versions which are printed on the transparent containers. In Bulgaria, the Red Fire lipstick is exactly the same as the UK lipstick, but the Black Night is a different formulation to its UK counterpart due to local laws. Your client has recently found batches of lipsticks for sale in a UK high street store (not one with whom it has a distribution agreement) which have been over-stickered with the marks Red Fire and Black Night respectively. Having bought some of these as a test purchase, the client believes that the batches were originally on sale in Bulgaria. Advise the client on whether it can take action to prevent the sale of these goods in the United Kingdom. **(12 marks)**

**Part 3.**

One of your client's competitors, Nehow, recently launched a new lipstick under the mark NEHOW FIRE. One of the colours in its range is red, and the text on the lipstick reads:

NEHOW  
FIRE  
Red

Your client asks whether in your opinion they can take action against this use. Provide your opinion with reasons. **(4 marks)**

**Ignore any issues relating to contract.**