

THE JOINT EXAMINATION BOARD

PAPER T1

BASIC UNITED KINGDOM TRADE MARK LAW

7th November, 1991

10.00 a.m. - 12.00 noon

Please read the following instructions carefully. This is a TWO HOUR paper.

1. You should attempt no more than eight questions from Part A and no more than five questions from Part B.
2. The number of marks allotted to each question is placed in brackets at the end of the question.
3. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper and number it clearly in the margin. Write on one side of the paper only using BLACK ink. You must write your examination number and the designation of the Paper in the top right hand corner of each sheet. You must NOT state your name anywhere in the answers.
5. Unless specifically requested answers are NOT required in letter form.
6. NO printed matter or other written material may be taken into the examination.

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Part A

1. What are the principal factors considered when an application is proceeding under section 12(2) (honest concurrent user) of the Trade Marks Act 1938?
(5 marks)
2. What is an ANTON PILLER Order?
(5 marks)
3. Write brief notes on the subject of "associated trade marks".
(5 marks)
4. What exceptions does section 29(1) provide to the general requirements for intention to use under section 17?
(5 marks)
5. What are the principal differences between the rights obtained in a registration in Part B of the Register and one in Part A?
(5 marks)
6. List briefly the main points to be borne in mind when using a registered trade mark to avoid a later challenge that the mark has become generic.
(5 marks)
7. The words "mark" and "trade mark" have specific meanings ascribed to them in section 68 of the Trade Marks Act 1938. Ignoring any alteration to that section produced by the Trade Marks (Amendment) Act 1984, (which introduced service marks) what are the principal elements of the definitions of "mark" and "trade mark"?
(5 marks)

8. Section 8 of the Act provides, inter alia, a saving for us descriptions of goods. What is this provision and who might want to rely on it? (5 marks)
9. What is the main provision in the Trade Marks Act 1938 which safeguards the person who first uses a particular mark in the course of his business? (5 marks)

Part B

10. Your client has applied for registration of a trade mark, and has found that there is an existing registration for the same mark in respect of broadly similar goods. Your client wishes to apply for rectification of the register in respect of the existing registration and is sure that the mark has not been used at all by the registered proprietor or any licensee. The application leading to the registration was made in November, 1984, and the registration was actually entered on the register in January, 1987.
- Set out those factors which will be taken into account in considering your client's application for rectification, referring to any relevant reported case, and state what practical steps your client should take now. (12 marks)
11. Discuss the relevant sections of the Trade Marks Act 1938 (as amended) which may provide grounds for third parties to oppose an application (ignoring Certification and Defensive marks). (12 marks)
12. Your client is the proprietor of the trade mark FRELINETTES registered in Part A of the register in respect of a specification of goods reading "fresh fruit and vegetables, all included in Class 31". The trade mark is widely used by the client and extremely well-known throughout the United Kingdom in relation to the goods covered by the registration.

The client telephones you to say that a local market trader is offering for sale fresh fruit and fresh vegetables not connected with your client and is verbally exhorting potential customers to "buy your FRELINETTES here". The trade mark does not appear anywhere on the market stall, nor on any wrapping or packaging material, and naturally, the market trader does not issue receipts. The client is extremely concerned and anxious to prevent this continued misuse of its registered trade mark.

What aspects of the law relating to trade marks will assist your client and what practical steps should be taken now? (12 marks)

13. Provide a summary of the important issues of the following cases:
- a) Bismag v. Amblins (Chemists) Limited - (1940) 57 RPC 209.
 - b) Radiation Limited's application - (1930) 47 RPC 37 (RADIATION trade mark).
 - c) "Stringfellows" - [1984] RPC 501 (Oven ready chips)
 - d) York Trailer Holdings trade mark - [1984] RPC 231 (YORK trade mark)

(12 marks)

14. A foreign company owns a well-known trade mark used in connection with certain goods but has never traded in the United Kingdom, and has no UK applications or registrations relating to that trade mark. Discuss whether the foreign company has any rights which would enable it to prevent a third party in the UK from adopting the same trade mark in respect of the same goods as those to which the foreign company applies the trade mark abroad.

(12 marks)

15. Your client telephones you in a great state of agitation, having just learned that a large motorcycle manufacturer is about to launch a range of motorcycles under the trade mark ZERORACER. Your client owns a registration in Part A of the register for the mark ZERORACER in respect of "bicycles (sold complete) and parts and fittings therefor, all included in Class 12".

Discuss what rights your client has, and, at the end, indicate what practical steps should be taken now.

(12 marks)