

THE JOINT EXAMINATION BOARD

PAPER T2

BASIC UNITED KINGDOM TRADE MARK PRACTICE

7th November, 1991

2.30 p.m. - 5.30 p.m.

Please read the following instructions carefully. This is a THREE 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 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 room.

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PART A

1.a) In what circumstances may the Registrar require a disclaimer before accepting an application?

b) What is the purpose of a disclaimer?

c) What effect does it have?

(5 marks)

2. List the principal pieces of information which must be included in a Statutory Declaration filed in support of a Registered User application.

(5 marks)

3. Your client company asks you to make a search at the Trade Marks Registry so that it can be "absolutely sure" that it is free to use its new mark.

Outline briefly the factors which prevent the search results from giving the client the absolute assurance it seeks.

(5 marks)

4. Your client uses its device mark in four different colour combinations on chemical products for different uses, all being for use in industry (Class 1). The device mark consists of two interlocking elements which are the same shape in all four versions of the mark, the left-hand one in all cases being of a dark tone, while the right-hand one is lighter coloured. Other variations of colour (in the same general format) are planned for the future.

Is it possible for your client to protect all the forms of the mark (including future ones) in one application, and if so, what form will that application take?

(5 marks)

5. List the main pieces of information which should appear in a Statutory Declaration providing evidence of use of a mark in support of a pending application.

(5 marks)

6. Your client's mark is a device mark which includes prominently a cross having four arms of equal length extending horizontally and vertically. Is this mark likely to give rise to any particular objection from the Registrar? If so, why, and how could the objection be overcome?

(5 marks)

7. You have applied on behalf of an Italian company to register the mark ITALIAIZZI for furniture. In an official letter issued in connection with the application, the Examiner asserts that registration would be contrary to section 11 of the Trade Marks Act 1938 in that the mark would, because of the prefix ITALIA-, be likely to deceive if used on goods not of Italian origin.

How might you try to overcome this objection on your client's behalf?

(5 marks)

8. Outline briefly the procedure for obtaining the Registrar's preliminary advice as to whether a mark meets the requirements of sections 9 and 10 of the Trade Marks Act 1938. If an application is filed subsequently to the obtaining of the advice, does the applicant gain any particular benefit from having sought the advice before filing his application?

(5 marks)

9. Your client company wishes to use the mark ELEPHANT for chocolate bars containing nuts and honey (Class 30). You carry out a trade mark search which produces [one result, namely] a prior registration for the word ELEPHANT in respect of "chewing gum and peppermint sweets, all included in Class 30" and dated 1st July, 1988.

Outline the points you would make in respect of its proposal to use the name ELEPHANT and include any checks which you would recommend it to make.

(5 marks)

PART B

10. It is common for the Registrar to raise objection under rule 21 (5) of The Trade Marks and Service Marks Rules 1986 that the specification of goods of an application is unduly broad. Give an example of the type of specification of goods which would attract such an objection, and discuss how such an objection might be overcome.

(12 marks)

11. In respect of goods, common surnames are generally considered to be unregistrable. Some surnames are acceptable, however, under the *de minimis* principle. Outline how this principle is applied by the Trade Marks Registry in relation to surnames as trade marks for goods.

(12 marks)

12. What objections (other than those based on prior registrations) might be raised against applications to register the following marks and how would you expect to be able to overcome them?

- a) PAULETTE for womens' clothing and footwear.
- b) ELLATE for detergents.
- c) NEW ORLEANS for hotel and restaurant services.
- d) WOODENHEART for shelving.

(12 marks)

13. Your client company owns registrations of several marks, all having the same prefix. At the date of registration the Registrar required all these marks to be associated with one another. None of these marks is now being used by the client except for the one which is its house mark and is used on all its products. The client has been offered a large sum of money in return for an assignment of one of the unused marks.

Can the client accept? If so, outline the procedures which must be undertaken before the assignment can be made and describe briefly any evidence which may be required.

(12 marks)

14. The following phrases are likely to be found in advertisements of trade marks in the Trade Marks Journal. What significance do they have?

- a) Date claimed under International Convention. 17th June, 1990 (France).
- b) Advertised before acceptance. Section 18(1)(proviso).
- c) Use claimed from the year 1955. Section 12(2).

(12 marks)

15. Outline briefly the way in which the Registrar deals with conflict between two pending applications.

(12 marks)