

THE JOINT EXAMINATION BOARD

PAPER T4

ADVANCED UNITED KINGDOM TRADE MARK PRACTICE

10th November 1992

10.00 am - 2.00 pm

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

1. You should attempt question one and no more than three of the remaining four questions.
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 room.

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PAPER T4

ADVANCED UNITED KINGDOM TRADE MARK PRACTICE

10th November 1992

10.00 am - 2.00 pm

1. Your new client Jardinia Limited has written to you as follows :-

"We refer to our telephone conversation during which you suggested that we should have searches made in respect of our new product names with a view to registering them and gave us details of the steps and costs involved. We are interested in and would like, if possible, to register the following names:-

PATHFINDER	Weedkillers and herbicides
TUMBLEDOWN	Flykillers
WEEDEATER	Weedkillers

We have in fact already marketed our combined weedkiller and herbicide (under the name PATHFINDER) during the past three months in the Yorkshire television area and have advertised the product there. Next month we plan to extend sales of this product countrywide and will also extend the advertising. Furthermore, next month we have arranged to test market our TUMBLEDOWN household flykiller spray in the same television area and if that proves successful we will go nationwide. At the moment we have 20,000 aerosol cans ready for delivery to selected stockists.

We have come across a TUMBLEWEED weedkiller on the market but as our product is different we believe that we should not have problems. Our WEEDEATER product would be for treating lawns.

Please make the necessary searches and advise us how we should try to protect ourselves".

You conduct searches and the results are attached.

Write a letter advising Jardinia Limited.

When advising your client you should consider its freedom to use and register these trade marks and should in connection with registrability consider not only Section 12 objections but also those which could be raised under Sections 9, 10 and 11. For each of the marks searched, a general statement covering non-relevant marks (if any) is sufficient.

(40 marks)

PATHFINDER SEARCH REPORT page 1

Mark: PATHFINDER

Prop: REYNOLDS MEDICAL LTD

T/H No.: B1101070

Class: 10

Sched: 4

App-Dte: 05 SEP 1978

Jnl-Pge: 5291-0144

Goods:

MEDICAL INSTRUMENTS AND APPARATUS, ALL FOR DETECTION OF CARDIAC ARRHYTHMIAS IN ANALYSIS OF TAPE RECORDED PHYSIOLOGICAL SIGNALS.

Mark: PATHFINDER

Prop: KALLESTAD DIAGNOSTICS, INC

T/H No.: 1293975

Class: 01

Sched: 4

App-Dte: 28 NOV 1986

\* PENDING \*

Goods:

CHEMICAL PRODUCTS FOR USE IN INDUSTRY AND SCIENCE; DIAGNOSTIC PREPARATIONS AND SUBSTANCES, NONE BEING FOR USE IN VIVO; CHEMICAL REAGENTS; AND CHEMICAL PREPARATIONS AND SUBSTANCES FOR USE IN ANALYSES IN LABORATORIES

Mark: PATHFINDER

Prop: KALLESTAD DIAGNOSTICS, INC

T/H No.: 1293976

Class: 05

Sched: 4

App-Dte: 28 NOV 1986

\* PENDING \*

Goods:

DIAGNOSTIC PREPARATIONS AND SUBSTANCES INCLUDED IN CLASS 5

Mark: NIC PATHFINDER

Prop: NICOLET INSTRUMENT CORP.

T/H No.: B1149224

Class: 10

Sched: 4

By consent

App-Dte: 20 FEB 1981

Jnl-Pge: 5492-3017

Goods:

ELECTRONIC MEDICAL AND ELECTRONIC SURGICAL APPARATUS AND INSTRUMENTS, ALL FOR USE IN NEURODIAGNOSIS; PARTS AND FITTINGS INCLUDED IN CLASS 10 FOR ALL THE AFORESAID GOODS.

Mark: PATHMASTER

Prop: MAY & BAKER BELVEDERE LTD

T/H No.: 770354

Class: 05

Sched: 4

App-Dte: 22 OCT 1957

Jnl-Pge: 4148-0028

Goods:

DISINFECTANTS, VETERINARY PREPARATIONS, INSECTICIDES, FUNGICIDES, LARVICIDES, GERMICIDES AND PREPARATIONS FOR KILLING WEEDS AND BRUSHWOOD.

PATHFINDER SEARCH REPORT page 2

Mark: PATH

Prop: DIVERSEY LTD

T/M No.: 1064230

App-Dte: 10 JUN 1976

\* DEVICE \*

Goods:

DISINFECTANTS (OTHER THAN FOR LAYING OR ABSORBING DUST) BACTERICIDES AND GERMICIDES, STERILIZING AND SANITARY PREPARATIONS AND SUBSTANCES; MEDICATED CREAMS AND MEDICATED OINTMENTS, ALL FOR APPLICATION TO THE SKIN.

Mark: PATHCLEAR

Prop: IMPERIAL CHEMICAL INDUSTRIES PLC

T/M No.: B1167698

App-Dte: 11 JAN 1982

Class: 05

Sched: 4

Jnl-Pge: 5164-1615

Advertised before acceptance  
Section 18(1) (proviso).

Goods:

PREPARATIONS FOR KILLING WEEDS ON PATHS.

Mark: PATHFINDER

Prop: KALLESTAD DIAGNOSTICS, INC

T/M No.: 1293978

App-Dte: 28 NOV 1986

Class: 10

Sched: 4

Jnl-Pge: 5894-5891

\* PENDING \*

Goods:

SLIDES, TUBES, PLATES ALL FOR USE IN IMMUNODIAGNOSIS; MATERIALS AND ARTICLES, ALL FOR USE IN THE COLLECTION OF CLINICAL SAMPLES FOR IMMUNODIAGNOSTIC TESTING; ALL INCLUDED IN CLASS 10.

Mark: PATHGUARD

Prop: IMPERIAL CHEMICAL INDUSTRIES PLC

T/M No.: B1474378

App-Dte: 21 AUG 1991

Class: 05

Sched: 4

Jnl-Pge: 5927-4439

\* PENDING \*

Goods:

INSECTICIDES, HERBICIDES, FUNGICIDES, PESTICIDES, PREPARATIONS FOR DESTROYING VERMIN; ALL INCLUDED IN CLASS 5.

**PATH**

StudentBounty.com

Mark: TUMBLEWEED

Prop: FISONS PLC

T/M No.: B1101728

Class: 05

Sched: 4

App-Dte: 20 SEP 1978

Jnl-Pge: 5351-0686

Goods:

HERBICIDES AND PREPARATIONS FOR KILLING WEEDS.

Mark: TUMBLEBUG

Prop: FISONS PLC

T/M No.: B1123289

Class: 05

Sched: 4

App-Dte: 31 OCT 1979

Jnl-Pge: 5418-1553

Goods:

INSECTICIDES AND PREPARATIONS FOR DESTROYING THE REPRODUCTIVE SYSTEM OF INSECTS.

Mark: TUMBLEMOSS

Prop: FISONS PLC

T/M No.: B1159051

Class: 05

Sched: 4

App-Dte: 07 AUG 1981

Jnl-Pge: 5457-0654

Goods:

PREPARATIONS AND SUBSTANCES, ALL FOR THE DESTRUCTION OF FUNGI, WEEDS, MOSS AND OF SEEDS AND OF SPORES OF ALL SUCH PLANTS.

Mark: TUMBLE

Prop: FISONS PLC

T/M No.: 1184462

Class: 05

Sched: 4

App-Dte: 01 NOV 1982

Jnl-Pge: 5520-1580

Goods:

PREPARATIONS FOR KILLING WEEDS AND DESTROYING VERMIN; PESTICIDES, INSECTICIDES, FUNGICIDES AND HERBICIDES.

Mark: TUMBLEBUG

Prop: FISONS PLC

T/M No.: 1371590

Class: 05

Sched: 4

App-Dte: 26 JAN 1989

\* PENDING \*

Goods:

PHARMACEUTICAL, VETERINARY AND SANITARY SUBSTANCES; INFANTS' AND INVALIDS' FOODS; PLASTERS, MATERIALS FOR BANDAGING; MATERIAL FOR STOPPING TEETH, DENTAL WAX; DISINFECTANTS; PREPARATIONS FOR KILLING WEEDS AND DESTROYING VERMIN; ALL INCLUDED IN CLASS 5.

Mark: TOMBEL

Prop: SANDOZ LTD

T/M No.: 1071847

Class:05

Sched:4

App-Dte:10 DEC 1976

Jnl-Pge:5175-2222

Goods:

PREPARATIONS FOR KILLING WEEDS AND DESTROYING VERMIN.

Mark: DOUBLEDOWN

Prop: IMPERIAL CHEMICAL INDUSTRIES PLC

T/M No.:B1086053

Class:05

Sched:4

App-Dte:04 NOV 1977

Jnl-Pge:5227-2413

Goods:

PREPARATIONS FOR KILLING WEEDS;INSECTICIDES,FUNGICIDES AND PESTICIDES;ALL FOR USE IN AGRICULTURE AND IN HORTICULTURE.

Mark: FLYDOWN

Prop: PAN BRITANNICA INDUSTRIES LTD

T/M No.:B1035581

Class:05

Sched:4

App-Dte:20 SEP 1974

Jnl-Pge:5062-1853

Goods:

INSECTICIDES BEING FLYKILLING PREPARATIONS.

Mark: COUNTDOWN

Prop: DIVERSEY LTD

T/M No.: 1061198

Class:05

Sched:4

App-Dte:05 APR 1976

Jnl-Pge:5206-1126

Goods:

DISINFECTANTS(OTHER THAN FOR LAYING AND ABSORBING DUST),GERMICIDES;BACTERICIDES;AND SANITARY SUBSTANCES AND PREPARATIONS,ALL SOLD IN POWDER FORM. G

Mark: COOPER CRACKDOWN

Prop: THE WELLCOME FOUNDATION LTD

T/M No.:B1150984

Class:05

Sched:4

App-Dte:21 MAR 1981

Jnl-Pge:5420-1676

Goods:

VETERINARY PREPARATIONS;INSECTICIDES;PREPARATIONS FOR KILLING WEEDS AND DESTROYING VERMIN; ALL FOR USE IN AGRICULTURE AND HORTICULTURE.

Mark: SHOWDOWN

Prop: MAY & BAKER LTD

T/M No.: 1161095

Class:05

Sched:4

App-Dte:11 SEP 1981

Jnl-Pge:5437-2690

Goods:

INSECTICIDES,FUNGICIDES,ARARICIDES AND BACTERICIDES;PREPARATIONS FOR KILLING WEEDS AND DESTROYING VERMIN

Mark: WEED EATER

Prop: WHITE CONSOLIDATED INDUSTRIES INC.  
T/M No.: 1044589 Class:07 Sched:4  
App-Dte:04 APR 1975 Jnl-Pge:5158-1288

Advertised before accept  
Section 18(1) (proviso).

Goods:  
GRASS CUTTING MACHINES.

Mark: WEED EATER

Prop: WHITE CONSOLIDATED INDUSTRIES INC.  
T/M No.: 1080817 Class:07 Sched:4  
App-Dte:08 JUL 1977  
\* DEVICE \*  
Goods:  
GRASS CUTTING MACHINES.



Associated 1044589

Mark: WEED EATER

Prop: WHITE CONSOLIDATED INDUSTRIES INC.  
T/M No.:B1338520 Class:07 Sched:4  
App-Dte:15 MAR 1988 Jnl-Pge:5774-2571

Registration of this mark  
shall give no right to the  
exclusive use of the word "Wee  
Associated 1044589 and another

Goods:  
TRIMMERS,BRANCH CUTTERS,TILLERS,EDGERS AND BLOWERS;COMBINED BLOWERS AND VACUUM OPERATED  
APPARATUS;ALL INCLUDED IN CLASS 7 AND BEING ELECTRIC OR PETROLEUM POWERED.

Mark: WEEDEX

Prop: CIBA-GEIGY PLC  
T/M No.: 407281 Class:02 Sched:3  
App-Dte:26 AUG 1920 Jnl-Pge:2226-2194

Goods:  
CHEMICAL SUBSTANCES USED FOR AGRICULTURAL, HORTICULTURAL, VETERINARY, AND SANITARY PURPOSES.

Mark: WEEDEXTRA

Prop: CIBA-GEIGY LTD  
T/M No.:B 958128 Class:05 Sched:4  
App-Dte:13 APR 1970 Jnl-Pge:4945-1077  
\* LAPSED JNL:5893 \*

Goods:  
PREPARATIONS FOR KILLING WEEDS,AND HERBICIDES.

Mark: WEEDICIDE

Prop: IMPERIAL CHEMICAL INDUSTRIES LTD

T/M No.: 639590

Class:05

Sched:4

App-Dte:27 AUG 1945

Jnl-Pge:3639-0004

Goods:

WEED-KILLING PREPARATIONS.

Advertised before acceptance  
Section 18(1) (proviso).

Mark: WEEDAWAY

Prop: FISONS PLC

T/M No.: 670496

Class:05

Sched:4

App-Dte:21 JUN 1948

Jnl-Pge:3721-0683

Goods:

WEED-KILLING PREPARATIONS FOR SALE IN SCOTLAND AND THE COUNTY OF CUMBERLAND.

Mark: WEEDSWEEPER

Prop: SHELL INTERNATIONAL PETROLEUM CO LTD

T/M No.:B1139481

Class:05

Sched:4

App-Dte:28 AUG 1980

Jnl-Pge:5388-2661

\* DEVICE \*

Goods:

HERBICIDES AND PREPARATIONS FOR KILLING WEEDS.



WEEDSWEEPER

Registration of this Trade Mark shall give  
no right to the exclusive use of the word  
"Weedsweeper".

Associated 876175 and 1004607

Mark: WEEDMASTER

Prop: FISONS PLC

T/M No.:B1417232

Class:05

Sched:4

App-Dte:13 MAR 1990

Jnl-Pge:5903-7247

Goods:

HERBICIDES INCLUDED IN CLASS 5.

Mark: "BEEFEATER" LONDON DRY GIN

Prop: JAMES BURROUGH LTD

T/M No.: 318121

Class:43

Sched:3

App-Dte:11 NOV 1909

Jnl-Pge:1686-1158

\* DEVICE \*

Goods:

A GIN.





Mark: BEEFEATER

Prop: UNITED BISCUITS (UK) LTD

T/M No.: 438687

Class:42

Sched:3

App-Dte:04 JUL 1923

Jnl-Pge:2401-0761

\* DEVICE \*

Goods:

SUBSTANCES USED AS FOOD OR AS INGREDIENTS IN FOOD, BUT NOT INCLUDING PREPARATIONS FOR MAKING SOUPS, MUSTARD, SPICES, PICKLES, MAYONNAISE, SALT, PEPPER, VINEGAR, SAUCES, KETCHUPS AND CHUTNEY, CORNED BEEF, CANNED MEATS, BEVERAGES AND DRIPPING, NON-ALCOHOLIC WINES AND APPLE JUICE BISCUITS AND NOT INCLUDING ANY GOODS OF A LIKE KIND TO THESE EXCLUDED GOODS.



Associated

Mark: ODOREATERS

Prop: COMBE INTERNATIONAL LTD

T/M No.:B1046028

Class:05

Sched:4

App-Dte:05 MAY 1975

Jnl-Pge:5151-0969

Goods:

DEODORISING PREPARATIONS AND SUBSTANCES; SANITARY PREPARATIONS AND SUBSTANCES, ALL HAVING DEODORISING PROPERTIES; DEODORANTS INCORPORATED INTO PADS.

Mark: WEED SWEEP

Prop: SHELL INTERNATIONALE PETROLEUM CO LTD

T/M No.:B1131318

Class:01

Sched:4

App-Dte:31 MAR 1980

Jnl-Pge:5444-0040

\* DEVICE \*

Goods:

CHEMICAL PRODUCTS INCLUDED IN CLASS 1 FOR USE IN AGRICULTURE HORTICULTURE + FORESTRY ALL FOR INHIBITING THE GROWTH OF WEEDS NONE BEING FOR EXPORT TO AND SALE IN PUERTO RICO



WEED SWEEP

*Registration of this Trade Mark shall give no right to the exclusive use of the words "Weed Sweep".*

Associated 1004603 and another

Mark: THE WEED MAN

Prop: TURF MANAGEMENT SYSTEMS INC.

T/M No.:B1377893

Class:37

Sched:4

App-Dte:23 MAR 1989

Jnl-Pge:5818-2130

Goods:

WEED TREATMENT SERVICES INCLUDED IN CLASS 37.

Registration of this mark shall give no right to the exclusive use, separately, of the words "Weed" and "Man"

Mark: DIETOR

Prop: GAZZONI S.P.A.

T/M No.: 1312407

Class:30

Sched:4

App-Dte:08 JUN 1987

\* PENDING \*

Goods:

SUGAR-DROPS AND PASTILLES, ALIMENTARY PASTAS AND SEASONINGS; SUGAR; CAKES; BREAD; BREAD STICKS; CRACKERS AND BISCUITS; CONFECTIONERY, PASTRIES AND COOKIES, CONFETTI; ICE-CREAM; COFFEE, TEA, COCOA AND CHOCOLATE; SAUCE.

2. You receive a telephone call from Mr Ronald Biggs who is the Assistant Company Secretary of Coral Perfumes Limited of Dorien House, Elm Road, Hull HU1 3UA. Coral Perfumes Limited sell a range of perfumes, toiletries and cosmetics via a nationwide "agency" system. Most of their agents are housewives selling part-time. The company has a sizeable business based upon a rapid turnover of "low priced" items. Mr Biggs says that his Marketing Department has produced a draft of a new catalogue for nationwide distribution to its agents early next year and he has been asked by them to check that there are no problems. Mr Biggs indicates that he is rather worried since the letter "R" within-a-circle is shown alongside several of the Marks which, so far as he is aware, are not registered in the United Kingdom. He has also been asked to produce a report on "correct use" of Trade Marks for "in house" use by his company (particularly the design and marketing department). He has requested that you provide him with some notes to assist him, covering the important points. You subsequently receive a copy of the proposed catalogue which indicates that the following Marks are "registered" whereas your records show that no United Kingdom registrations exist:-

<u>Trade Mark</u>	<u>Goods</u>
SILK TOUCH	Lipsticks
Line drawing of the Bodleian Library in Oxford	Drawer liners
ANDRE BLANC*	Hair care preparations
CRASH!	Perfumes
PRINCE WILLIAM and line drawing of a small boy	Children's toothpaste
MR CLEAN	Grooming products for men
CONCEPT	Shampoo
PARISIAN WEEKEND	Perfumes

\*BLANC is a surname appearing 208 times in the relevant telephone directory.

Prepare a report for Mr Biggs (following your telephone conversation) on the following :-

- recommendations regarding the unregistered Trade Marks;
- registrability of these Marks explaining the reason for any problems you can see and how, if possible, the objections could be overcome;
- a brief note on correct Trade Mark use (for clients in general)

(20 marks)

3. You receive a telephone call from Mr Paine of your clients, Wolverhampton Lock Company Limited. He has just received a letter from the solicitors, Messrs Smedley & Grass which he is forwarding to you. He tells you that Messrs Smedley & Grass would seem to be referring to a Trade Mark VIKING belonging to his company and the fact that the Mark does not appear to have been used. Mr Paine advises you that he is certain that the Mark has not been used and in fact until he received the letter he was not aware that Wolverhampton Lock Company Limited owned the Trade Mark VIKING at all. He suggests that the Mark must have been one acquired when his company took over the business of Smethwick Safety Limited some ten years ago. Mr Paine says that now he has discovered the Mark he would quite like to use it for an intended range of security equipment being locks as well as fire and burglar alarms. He says that he could get some literature prepared very quickly. He reminds you that earlier searches you have conducted to find an acceptable name for their new range of security equipment have proved to be far from satisfactory.

You make a check of your records and locate details of an existing registration of the trade mark VIKING. A search locates the VIKRON registration which was entered on the Register some two weeks ago. Details of the Marks are as follows :-

<u>Trade Mark</u>	<u>Reg. No.</u>	<u>Goods</u>	<u>Date of Registration</u>	<u>Proprietor</u>
VIKING	981990	Locks, mechanical locks; all included in Class 6	19.12.71	Wolverhampton Lock Company Limited 121 High Street Wolverhampton WV1 6PL
VIKRON	1453393	Building materials; structures of metal for agricultural or horticultural use; pipes and tubes (none being boiler tubes or parts of machines); beams; cladding; doors; door frames; door mats; handles; knockers and bells; ducts; framework of metal for buildings; roof covering; windows and window frames; strips, sheets; cables (non-electric), wires (non-electric); ladders; posts, fences; keys, locks, bolts; safes and cash boxes; furniture fittings; bath and shower cubicles, being building structures; articles of metal hardware; vehicle number plates; swimming pool structures; parts and fittings for all the aforesaid goods; all included in Class 6	05.10.90	Bigg Buy PLC Unit 5 Hampton Ind. Estate Middlesex

You subsequently receive the copy of the letter from Messrs Smedley & Grass. The letter is as follows:-

Wolverhampton Lock Company Limited  
121 High Street  
Wolverhampton  
WV1 6PL

**Re: United Kingdom trade mark registration No. 981990  
VIKING and possible action for cancellation**

We act for Bigg Buy PLC whom we are sure you are aware have established a new chain of "do it yourself" stores throughout the United Kingdom. Our clients have sought to register the Trade Mark VIKRON which they are using in respect of a range of goods in Class 6 sold throughout their stores. A preliminary clearance search of Trade Mark records has revealed your registration of the Trade Mark VIKING and although this has not proved to be a bar to the registration of our clients' Trade Mark investigations have been carried out to see whether the Trade Mark VIKING has been used. These investigations have failed to disclose any use by you during the past five years and as a result it is thought that the registration is vulnerable to cancellation proceedings.

In order that the rights granted to our clients in the Trade Mark VIKRON would not be diminished in any way by the co-existence of the Trade Mark VIKING, our clients have instructed us to apply for rectification of the Register on the grounds of there having been no *bona fide* use of the Mark for a five year period. However, they have suggested that since it would appear that the Mark is no longer in use and has not been used for many years there may no longer be any interest in it and, if this is so, then your clients may be willing to assign the registration for a nominal consideration.

If your clients are willing to assign their registration then our clients would be prepared to meet all charges for recording the assignment.

We must ask that you let us have your reply on an urgent basis since our clients may otherwise find it necessary to proceed with an Application for Rectification.

Yours faithfully  
Smedley & Grass

Write a letter to your clients explaining their position and recommending how they should proceed.

(20 marks)

4. On 10th November 1992 your clients, Miller Products (Holdings) Limited whose subsidiary Miller Pharmaceuticals Limited is a medium sized manufacturer of various pharmaceutical products contact you to advise that their Watching Service has notified them of an advertisement in the Trade Marks Journal of an application to register the Mark PRESINAM by a small rival, Glenn Manufacturing Limited. The PRESINAM application No. 1374361 was applied for on 13th February, 1989 in Class 5 in respect of "Pharmaceutical preparations and substances". Investigations reveal that the advertisement appeared in the Trade Marks Journal of 14th October 1992 and that the trade mark PRESINAM does not appear to be in use.

Your clients' concern is based upon the fact that they own several United Kingdom registrations all of which incorporate the prefix PREZ- and in respect of which Miller Pharmaceuticals Limited is entered as a Registered User. Your clients most important Trade Mark is registration No. 804163 PREZAM which is an antiseptic cream sold since 1955 on an extensive scale. Your clients also produce a range of medicated soaps under the Trade Mark PREZAM KEEP KLEEN and other products such as antiseptic liquids and mouthwashes under Marks incorporating the PREZ- prefix namely PREZAMIN and PREZAMOL. Your clients also make some use of the word PREZ itself.

Brief detail of your clients registered marks are as follows :-

<u>Trade Mark</u>	<u>Registration No.</u>	<u>Class</u>	<u>Advertised in Trade Marks Journal No.</u>
PREZAM	804163	5	4633
PREZAM KEEP/KLEEN	987048	3	4927
PREZAMIN	1006010	5	5004
PREZAMOL	1121147	5	5340

Your clients tell you that the Trade Mark PRESINAM is very similar to the generic name PROSINAM of a fertility drug sold by Ganzel AG (a major Swiss pharmaceutical company) under the Trade Mark FERTILEX. The drug has received much press coverage in recent weeks because of possible side effects.

Draft a letter to your clients stating how they should proceed including an outline of the relevant procedures, timescales etc and other action needed. Assuming that formal Opposition proceedings follow, draft separately the Grounds of Opposition to be attached to the Form TM7. Provide a note to go with your letter on the evidence (including comments on the collection of evidence) that your clients must file should Glenn Manufacturing Limited contest the Opposition and file a Counterstatement.

(20 marks)

5. Your clients, Megabucks PLC, a British Company of Megabucks House, 111 Queen Street, London EC4V 4PD have contacted you to advise that they are now in negotiations with a Mr Luigi Rossi but no contract has yet been signed. Mr Rossi is the Chairman and major shareholder of Guiseppe Rossi Group Limited, a British Company of Mansfield Road, Luton, Bedfordshire, LU4 9RJ, which company operates a chain of Italian restaurants throughout the United Kingdom known as GUISEPPE'S. Guiseppe Rossi also retails a range of pasta and pasta-based products under the Trade Mark GUISEPPE'S which are now on sale in a number of large supermarket chains. The original business was founded some forty years ago by Mr Rossi's father, Guiseppe, who started as a sweet shop owner producing and selling a range of boiled sweets based upon a traditional and secret Italian recipe.

Megabucks PLC advise that the present proposal is to purchase Mr Rossi's GUISEPPE'S restaurant and pasta business for £2.5m. Ten percent of the total consideration is attributed to the Trade Mark. However, part of the deal is that Guiseppe Rossi will retain the sugar confectionery side of the business which, whilst not now particularly significant is of "sentimental value" to him. Guiseppe Rossi Group Limited also operates a second but much smaller chain of restaurants under the name SOPHIA'S. The Trade Mark SOPHIA'S is also used on a range of food merchandise in much the same way as the Trade Mark GUISEPPE'S. The SOPHIA'S business is not for sale. After the sale there will be no further commercial co-operation between Megabucks PLC and Mr Rossi regarding the GUISEPPE'S Mark.

You conduct a search of United Kingdom Trade Mark records and the result is attached.

- (i) Advise your clients as to what action should be taken in order to enable them to complete the purchase and
- (ii) assuming your advice is followed, draft a simple assignment document
- (iii) What action and what formalities are required to record the assignment at the Trade Marks Registry

(20 marks)



<u>Trade Mark</u>	<u>Reg. No.</u>	<u>Class</u>	<u>Goods</u>	<u>Proprietor</u>	<u>Date of Registration</u>
GUISEPPE'S	1141872	30	Pasta and prepared pasta meals	Guiseppe Rossi Limited Mansfield Road Luton, Beds	14.10.80
GUISEPPE'S (in script form)	1141873	30	Pasta, prepared meals, pizzas, spices, pasta sauces, confectionery, ice cream, frozen desserts	Guiseppe Rossi Limited Mansfield Road Luton, Beds	14.10.80
GUISEPPE'S (in script form)	1284570	42	Restaurant, cafe and bar services; all included in Class 42	Guiseppe Rossi Limited Mansfield Road Luton, Beds	01.10.86
GUISEPPE'S (in signature form)	691019	30	Non-medicated sugar confectionery	Guiseppe Rossi Limited Mansfield Road Luton, Beds	03.07.50
The four registrations are associated.					
SOPHIA'S	1252151	30	Pasta, prepared meals, pizzas, spices, pasta sauces, confectionery, ice cream, frozen desserts	Guiseppe Rossi Limited Mansfield Road Luton, Beds	14.10.85
SOPHIA'S	1284571	42	Restaurant, cafe, catering and bar services; all included in Class 42	Guiseppe Rossi Limited Mansfield Road Luton, Beds	01.10.86

