

THE JOINT EXAMINATION BOARD

PAPER T4

ADVANCED UNITED KINGDOM TRADE MARK PRACTICE

16th November, 1993

10.00 a.m. - 2.00 p.m.

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

1. You should attempt question one (40 marks) and no more than three of the remaining four questions (20 marks).
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. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number, and your Examination number. Write on one side of the paper only using BLACK ink. You must NOT staple pages together. 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.
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.

The Joint Examination Board

Paper T4

Advanced United Kingdom Trade Mark Practice

16th November 1993

10.00 a.m. - 2.00 p.m.

1. In a meeting with a new client, Office Furnishings Limited ("OFL"), you have discussed the company's intention to register its trade marks. In 1986 the company acquired the assets of PEL Limited including all rights to any trade marks and since then has been selling a range of desks, chairs and bookcases under the trade mark QUORUM. It now intends to expand into office machinery, such as photocopiers, fax machines and telephones as well as other office furniture such as storage cabinets.

OFL's Marketing Director, Mr. W. Bunter, intends that the company should provide a comprehensive range of equipment and materials for use in offices. Although he is somewhat vague about what he has in mind, it is clear that he is looking to expand into office stationery and other office requisites in the medium term.

The company wishes to introduce additional trade marks to distinguish between its various price ranges. Each individual mark will be used on both the existing and the new goods. The company will then have three ranges, each differing in price and quality and each sold under a different mark.

The two new marks that the company wishes to use are LYNX and QUASAR.

You have carried out searches on all three trade marks with the results shown below.

Write a letter to Mr. Bunter:

- (a) advising on the results of the searches; and
- (b) making recommendations as to the company's immediate and future action with regard to its plans to use and register these three marks.

Note: Candidates should comment on each mark shown in the search report. The extent of the comments should depend upon the relevance of the mark in question. If the same comments apply to several marks, they may be grouped together.

(40 Marks)

TRADE MARK SEARCH REPORT

QUORUM

INFORMATION TAKEN FROM TRADE MARKS REGISTRY
OPTICS TAPES AS AT 26 OCTOBER 1993

Classes searched: 6, 7, 8, 9, 16, 19, 20 and Sched III equivalents.

Sched 4 Class 9 Registered	1,207,304	17th November 1983 Jnl 5592,2968
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QUORUM

Computers, electrical apparatus and instruments, all for the processing, storage and retrieval of data, electronic visual display apparatus for use with computers, parts and fittings included in Class 9 for all the aforesaid goods, computer programmes.
Quorum Computers Ltd

Sched 4 Class 9 Registered	1,112,341	15th September 1982 Jnl 5427,2125
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FORUM

Apparatus and instruments, all for transmitting, recording, reproducing, mixing, amplifying, modifying or generating sound or video; teaching, instructional, radio and television apparatus and instruments; automatic telephone answering machines; dictating machines; demagnetising apparatus for magnetic tapes; cinematographic and photographic films, all prepared for headphones; earphones (not being hearing aids for the deaf); microphones; electric switches; aerials; electronic valves; dry electric batteries; electric apparatus for converting alternating current to direct current; radio control apparatus; magnetic electric transducers; and parts and fittings included in Class 9 for all the aforesaid goods.
Japan Electrical Components GmbH. (Germany)

Sched 3 Class 6 Registered	285,352	23rd May 1906 Jnl 1488,1386
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LECTORUM

Machinery of all kinds and parts of machinery except agricultural machines and their parts included in Class 7.
Cookson & Co. Ltd

Sched 3 Class 8
Registered

570,699

4th August 1936
Jnl 3058,1360

SPECTRUM

Microphones and parts thereof included in Class 8; wireless receiving sets, thermionic valves and wireless loud speakers.
Continental Radio and Television Corp. (U.S.A.)

Sched 3 Class 39
Registered

245,631

28th August 1921
Jnl 2001,101

BARUM

Paper (except paper hangings), stationery, and bookbinding materials.
Barum Paper Co. Ltd

Sched 4 Class 16
Registered

1,210,722

10th February 1984
Jnl 5555,405

SPECTRUM

Paper and paper articles; printed matter; stationery; typewriters and office requisites; photographs.
Wholesale Stationery Supplies plc

Sched 4 Class 20
Registered

869,098

9th September 1964
Jnl 4555,1672

FUTURUM

Furniture and parts and fittings thereof, included in Class 20 but not including mattresses or divans or any goods of the same description as mattresses or divans.
Futurumverken Akktiebolag (Sweden)

Sched 4 Class 20
Registered

1,020,272

6th November 1973
Jnl 5021,2328

QUARTO

Furniture and parts therefore included in Class 20.
Arkana Ltd

Sched 4 Class 20
Registered

1,195,720

11th May 1983
Jnl 5519,1531

SPECTRUM

Office chairs, seating (furniture) for arenas and for auditoriums.
Hille Executive Furniture & Seating Ltd

Sched 4 Class 20
Registered

1,229,851

8th November 1986
Jnl 5594,3098

FORUM

Date claimed under International Convention 24 August 1986.

Desks.

Fehlbaum & Co (Switzerland)

Sched 4 Class 20
Registered

1,406,683

9th November 1989
Jnl 5916,2388

CORAM

Furniture, mirrors; bathroom furniture, bathroom mirrors; all included in Class 20; but not including any goods for medical or surgical use.
Coram International BV (The Netherlands)

Sched 4 Class 20
Lapsed

1,112,427

7th December 1985
Jnl 5348,514

QUORUM

Furniture.

PEL Ltd

TRADE MARK SEARCH REPORT

QUASAR

INFORMATION TAKEN FROM TRADE MARKS REGISTRY
OPTICS TAPES AS AT 26 OCTOBER 1993

Classes searched: 6, 7, 8, 9, 16, 19, 20 and Sched III equivalents.

Sched 4 Class 7 Registered	1,026,504	13th March 1974 Jnl 5036, 444
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QUASAR

Power operated tools and tools for use in power operated tools; generators included in Class 7; lawn mowers; pumps included in Class 7; engines and motors, none being for land vehicle propulsion; paper shredding machines; garbage disposal machines; machines for use in the preparation of food and drink; clothes washing machines; dish washing machines, ironing machines, pressing machines, clothes drying machines, wringing machines; hair drying machines; sewing machines; can opening machines, knife sharpening machines; floor cleaning machines, polishing machines and carpet cleaning machines, none being for domestic use; and parts and fittings included in Class 7 for all the aforesaid goods; but not including generators being parts of, or for use with, welding or cutting machines and not including engines or motors for use in welding operations.

Matsushita Electric Industrial Co Ltd (Japan)

Sched 4 Class 8 Registered	1,026,505	13th March 1974 Jnl 5038, 553
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QUASAR

Shaving instruments, hair-cutting machines (for personal use) and parts and fittings included in Class 8 for all the aforesaid goods; tin openers included in Class 8; and hand tools; but not including hand tools for use in welding or gas cutting operations.

Matsushita Electric Industrial Co Ltd (Japan)

Sched 4 Class 9
Registered

1,016,101

17th August 1973
Jnl 5033,288

QUASAR

Radio sets and radio apparatus; television transmitting apparatus and television receiving sets; sound recording and sound reproducing apparatus and instruments; electric phonographs; record players and gramophone records; tape recorders and cassettes containing tape for use therewith; and parts and fittings included in Class 9 for all the aforesaid goods; amplifiers, tuners, loudspeakers, cartridges for sound recording, tape and headphones; but not including any of the aforesaid goods for use in radio astronomy.
Hantarex SpA (Italy)

Sched 4 Class 9
Registered

1,185,760

23rd November 1982
Jnl 5525,1953

QUASAR

Computers; electronic apparatus for the input, output, processing, recordal, storage and retrieval of data; visual display apparatus and electronic print-out apparatus, all for use with the aforesaid goods; electronic control apparatus; parts and fittings included in Class 9 for all the aforesaid goods; computer programmes discs bearing or for the electronic recording of data; but not including any such goods relating to celestial bodies.
Apricot Computers Plc

Sched 4 Class 16
Registered

1,456,459

22nd February 1991
Jnl 5923,3782

QUASAR

Paper; plain paper for use in printing or with photocopiers or printers; all included in Class 16.
Empire Fine Papers Ltd

Sched 4 Class 19
Registered

1,026,512

13 March 1974
Jnl 5038,566

QUASAR

Sinks and boards, all included in Class 19; gutters and gutter pipes, none being of metal; and non-metallic building materials.
Matsushita Electric Industrial Co Ltd (Japan)

Sched 4 Class 20
Registered

1,026,331

13th March 1974
Jnl 5038,567

QUASAR

Kitchen furniture and parts thereof included in Class 20; ironing tables.
Matsushita Electric Industrial Co Ltd (Japan)

Sched 4 Class 20
Registered

1,028,331

22 April 1974
Jnl 5031,194

QUAKER MAID

Furniture, parts and fittings therefore and mirrors, all included in Class 20.
Habitat Designs Ltd

Sched 4 Class 20
Registered

1,327,291

18th November 1987
Jnl 5031,194

CURSOR

Furniture and parts and fittings therefor; all included in Class 20.
Evertaut Ltd

Sched 4 Class 20
Registered

1,380,216

13th April 1989
Jnl 5825,3196

PULSAR

Furniture and parts and fittings therefore, all included in Class 20.
Alan Cooper Plc

Sched 4 Class 20
Registered

1,437,138

22nd August 1990
Jnl 5889,5179

BLAZER

Office furniture, all included in Class 20.

Project Office Furniture Plc

TRADE MARK SEARCH REPORT

LYNX

INFORMATION TAKEN FROM TRADE MARKS REGISTRY
OPTICS TAPES AS AT 26 OCTOBER 1993

Classes searched: 6, 7, 8, 9, 16, 19, 20 and Sched III equivalents.

Sched 4 Class 6 Registered	B1,153,162	27th April 1981 Jnl 5488,2731
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LYNX

Metallic pipes (none being boiler tubes or parts of machines) for use in the drilling or servicing of, or production from, oil or gas wells; metallic pipe connections for the aforesaid pipes; fittings for the aforesaid pipes and parts and fittings for the aforesaid connections, all included in Class 6.
Hunting Oilfield Services (UK) Ltd

Sched 4 Class 6 Registered	1,218,259	9th May 1984 Jnl 5739,2597
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LINK

Use claimed from the year 1966. Section 12(2).

Metal building materials and fittings therefor; structures, frameworks and staircases; all for building; floors; workbenches; gravity and hand-operated conveyors, none being machines or vehicles; all made wholly or principally of common metal; shelving, racking, containers, locks, bolts and fireproof metal cabinets all included in class 6; but not including any such goods being linking or units or adapted for linking.
Link 51 Ltd

Sched 4 Class 16 Registered	983,926	29th November 1971 Jnl 4913,2131
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LYNX

Articles of stationery but not including paper knives, fastening pliers for office use, hand punches for office use, or any goods of the same description as any of these excluded goods.
S A Script Rhône (France)

Sched 4 Class 16
Pending

1,526,558

11th February 19
Jnl 0,0



Published material in printed and electronic form for education, training, personal study, mission development and extension studies.
Lion Publishing Plc

Sched 4 Class 20
Registered

1,055,596

25th November 1975
Jnl 5522,1747

LINK

Benches; lockers, cabinets and drawer units; bins, boxes and storage containers; partitions, racks, shelves, storage frames; and parts and fittings for all the aforesaid goods all included in Class 20.
Link 51 Ltd

Sched 4 Class 20
Registered

1,218,262

9th May 1984
Jnl 5764,1315

LINK

Office furniture, factory furniture, shop furniture, school furniture, castors, work benches, storage containers, racks, shelves; blinds, keyboards, identity plates, name plates, all made predominantly of plastics materials; display boards, sign boards; all included in Class 20.
Link 51 Ltd

Sched 4 Class 20
Pending

1,530,643

25th March 1993
Jnl 0,0

LINK-LOCK

Boxes; packaging cases; containers for transportation and storage.
Rowlinson Packaging Ltd

Sched 4 Class 42
Registered

1,334,205

4th February 1988
Jnl 5841,5630



Computer services; leasing of access time to a computer database; all relating to stock exchange quotations, to statistical information, to business opportunities appraisals, to financial business appraisals and to investments, stocks and shares; all included in Class 42.
The International Stock Exchange of the United Kingdom and the Republic of Ireland Ltd

2. During a telephone conversation with a prospective new client, Valvona Limited, you agree a date for a meeting with the Managing Director, Mrs. Linda Valvona, at which you will review her company's trade mark portfolio. You receive the following communication from Mrs. Valvona prior to your meeting:-

Dear Sirs,

I refer to our recent telephone conversation. I thought it might be helpful if I sent you a copy of our proposed new promotional literature for our product ranges. You will see that the brochure includes two new product ranges due to be launched for Christmas 1993.

By way of background, our company has been selling Sylvia, Lady Sylvia and Sylvia Valvona since 1983. Our other ranges were introduced as follows:

Valvona Finesse - 1989, Body Magic - 1991, SVL logo - 1990.

In addition, we would appreciate any comments you might have as to the correct use of our trade marks in the brochure as we have been told that this is important. We are not sure if additional measures may be advisable to protect our names and logo.

You mentioned that "Availability Searches" and registration might be advisable. Perhaps we can discuss these matters and any other relevant points at our meeting. I look forward to meeting with you.

Yours sincerely,

L. Valvona
Managing Director

Prepare short notes of the various matters to be discussed at your forthcoming meeting with Mrs. Valvona.

(20 Marks)

1993/4 - Sylvia Valvona Limited - Product Ranges

LADY SYLVIA

An exclusive range of quality ladies' clothing, with emphasis on natural fabrics, generous range of sizes and attention to detail, with a complementary range of toiletries, perfumes, cosmetics, jewellery and hair ornaments. Turn heads dressed from top to toe in Lady Sylvia.

SYLVIA



An exclusive range of quality ladies' clothing, particularly appealing to the more classic dresser, with a complementary range of cosmetics.

SYLVIA VALVONA*

A range of quality but competitively priced bedroom and bathroom linen, including sheets, duvet sets, towels and bathroom sets, in a range of 15 superb colours.

VALVONA* FINESSE

A complete range of luxury bedroom and bathroom linen including sheets, duvet sets, luxury cotton towels, and co-ordinating bathroom accessories such as soap dishes, toothbrush-holders and towel rails. Give your house a touch of luxury with Valvona Finesse.

BODY MAGIC



A range of cosmetics and toiletries made from natural ingredients and not tested on animals. Use Body Magic to make all bodies more beautiful.

Our top range of cruelty-free cosmetics, shampoos and toiletries, including a range of high quality ladies' hair ornaments.

HEAVENLY

A new range of ladies clothing due to be launched in December, with particular emphasis on leisure clothing for the young lady. Feel heavenly in our clothes!

SOUTH PACIFIC

A new range of romantic bedroom and bathroom linen due to be launched for Christmas.

*VALVONA is a surname appearing 48 times in the Rome Telephone Directory.

3. You receive the following letter from a new client, The Sutherland Society Limited:

"Dear Sirs,

We are a well known company whose business is the manufacture and sale of homeopathic medicines and remedies, including essential oils for use in aromatherapy etc., and a range of books relating to homeopathy. Our products are sold through all the large chemist stores throughout the United Kingdom and through specialist health shops. We also supply sole practitioners such as homeopathic doctors, beauty therapists etc.

Our products are sold under the name "SINCLAIR SUTHERLAND" and this name has been in use since 1985, although we have not registered it as a trade mark.

By way of background, our company was founded by, and is run by the wife and two sons of, the late Dr. Sinclair Sutherland, who developed most of the homeopathic remedies and medicines we sell. The formulae of the medicines are a closely guarded secret known only to Dr. Sinclair Sutherland's wife and the two sons.

We have just become aware that one of Dr. Sinclair Sutherland's distant relations, called John Robert Sinclair Sutherland (and abbreviated to J.R. Sinclair Sutherland, has recently started selling a range of homeopathic remedies. His products are not marked with our trade mark although they identify J.R. Sinclair Sutherland as the manufacturer. However, he has been telephoning a number of our customers and introducing himself as "Sinclair Sutherland". We in fact became aware of Mr. J. R. Sinclair Sutherland's activities when several of our customers contacted us asking if we were launching a new range of products.

We are extremely concerned by the activities of Mr. J. R. Sinclair Sutherland and should be grateful if you would advise us what steps we can and should take both to prevent further mis-use of our name and to protect our interests in the future."

As an initial step you conduct a search at the Trade Marks Registry and discover that an application has been lodged for the trade mark "SINCLAIR SUTHERLAND" by Mr. John Robert Sinclair Sutherland on 6th September 1993 in respect of "homeopathic medicines" in class 5.

- (a) Prepare a cease and desist letter to Mr. J. R. Sinclair Sutherland on your client's behalf and suggest any other steps your client could take prior to commencement of legal proceedings.
- (b) Advise your client in note form as to what action you consider should be taken with regard to the trade mark application of Mr. J. R. Sinclair Sutherland; and, in order to avoid similar problems in the future, how your client should protect its own trade mark interests.

(20 Marks)

4. You receive a letter in the following terms from another firm of agents:

Dear Sirs,

UK Trade Mark Registration No. 689402 BRUIN & Device and 689,403 Bear Device both in Class 34 in the name of your Client, Premier Tobacco Limited. Our Client: Clark Hill Plc.

We act in trade mark matters for Clark Hill Plc who brew and sell a range of beers and other alcoholic beverages. Our client also wishes to sell a range of associated products, through its own public houses and through independent retailers such as off-licences, under various trade marks they own.

One of the most successful products is a beer sold under the trade mark PETER'S PALE which incorporates a device of panda. This trade mark will appear on the new products lines which will include a ranges of smoker's articles such as lighters, ashtrays and matches.

A search of the Trade Marks Register has revealed the above two marks owned by your client, both of which include a device of a bear which has a striking resemblance to our client's panda device. Investigations in the trade show that your client's marks are not in use and have not been used for many years. We have therefore been instructed by our client to apply for cancellation of the registrations and we enclose copies of Forms TM26 and the Statements of Grounds which we have filed today at the Trade Marks Registry.

Yours faithfully

A check of your in-house records shows the following registrations owned by Premier Tobacco Limited:

689402 BRUIN & Bear device (associated with 689404)
689403 Bear device (associated with 689402)
689404 BRUIN (Word)

All are registered in respect of "all goods included in Class 34" and date from 1st April 1939.

You know from past discussions with your client that use of BRUIN & Bear device and the Bear device marks on class 34 goods ceased 10 years ago and that the only trade mark currently in use on Class 34 goods is BRUIN (word) which appears on both cigarettes and pipe tobacco sold by your client. However, your client also sells an annual "limited edition" of silver cigarette cases which are sold through specialist tobacco suppliers and high class stores. These cases, which carry a different design, are considered collectors' items. The Bear device is always inscribed somewhere on the case and part of the promotion of the

case is aimed at the purchaser finding it. Your client has never registered the device in Class 14, which covers cigarette cases and precious metals.

A search of the Register shows that Clark Hill Plc has applied to register its Panda device, both alone and in combination with the words PETER'S PALE as generally used in relation to its beer, in respect of "smokers' articles; matches; all included in Class 34". The applications were filed on the same day as the cancellation action and the fact that applications are being made is relied upon by Clark Hill in the grounds for removal.

- i) Make notes on the various matters which you will have to explain to your client, including the merits of your client's case and the points which your client will need to consider in deciding the best course of action.
- ii) Also, outline for your client the procedural aspects of this rectification action and what facts the applicants for rectification will have to establish in order to succeed.

(20 Marks)

5. Your client, Casa Mamma Bianca Limited, has informed you that, for several years run three restaurants (each both sit-down and take-away) in London under the name CASA MAMMA BIANCA, it intends to franchise two new companies, Fastapasta Limited in Glasgow and Dine'n'Dash Limited in Birmingham. The intention is that each company will operate one restaurant. If they are successful further restaurants may be authorised, provided that there are sufficient potential new customers in the territory in which the franchisee is to operate.

The companies are to use the name CASA MAMMA BIANCA with menus and decor identical to those used by your client. Initially your client will provide chefs to do the cooking but within six months of opening the franchisee companies must employ their own.

Franchise Agreements will run until 31st December 1999 with three months' notice on either side in the event of a breach.

The Franchise Agreements are currently being drafted and your client is seeking advice on what, if anything, should be done to safeguard his trade mark registrations. Apparently the solicitor advising on the Franchise Agreements has recommended recording the franchisees as registered users of your client's trade mark.

Casa Mamma Bianca Limited owns the following registrations:

CASA MAMMA BIANCA No. 1,234,567 Registration Date 14.02.81	Meat, fish, poultry and game; preserved and cooked fruits and vegetables; dairy products; eggs; edible oils and fats; preserves; prepared meals; all included in Class 29.
CASA MAMMA BIANCA No. 1,234,568 Registration Date 14.02.81	Coffee, tea, cocoa, chocolate and sugar; flour, pasta and preparations made from cereal; bread, pastry and confectionary; ices; salt, pepper, sauces and spices; prepared meals; all included in Class 30.
CASA MAMMA BIANCA No. 1,234,569 Registration Date 14.02.81	Fresh fruit and vegetables; all included in Class 31.
CASA MAMMA BIANCA No. 1,234,570 Registration Date 14.02.81	Paper and paper products; tablecloths and serviettes, all being paper; menu cards; all included in Class 16.
CASA MAMMA BIANCA No. 1,432,432 Registration Date 1.10.86	Restaurant services included in Class 42.

- (a) Draft a Registered User Agreement to serve as a model for your client to be attached as a Schedule to the main Franchise Agreement.
- (b) Make notes on the points you would raise with regard to the client as to the need to record Registered Users and on the terms and conditions included in your draft. Comment briefly on why these are necessary and the effect of a failure by either party to observe them.
- (c) Write a brief note for your client on any particular provisions which should appear in the Franchise Agreement regarding correct use and monitoring of the trade mark both in the restaurants and in any advertising.

(20 Marks)