

THE JOINT EXAMINATION BOARD

PAPER T2

BASIC UNITED KINGDOM TRADE MARK PRACTICE

17th November, 1994

10.00 a.m. - 1.00 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. 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.

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PART A

1. Your client filed an application in June 1993 to register its trade mark. You have advised the client that the Mark is more likely to be accepted for registration under the provisions of the Trade Marks Act 1994 than it is under the 1938 Act. Do the provisions of the new Act now apply to your client's application (in November 1994) ? Must he re-file in order to take advantage of the new Act ? Are there any particular advantages or disadvantages to choosing either of these options ?

(5 marks)

2. A Limited has two trade mark registrations which fell due for renewal on 15th October 1994 and 7th November 1994, respectively. Owing to a prolonged bout of illness on the part of the company secretary, neither renewal fee was paid by the due date. What is the final date for late payment of the renewal fee in respect of each of the two registrations ? (By late payment, is meant the final date for payment of the fee subject only to the payment of an additional fee but without the need to make an application for restoration.)

(5 marks)

3. Why might the Registrar require a disclaimer in connection with an application filed in 1993 ?

In what circumstances might a disclaimer be entered on the Register in connection with an application filed in November 1994 ?

What is the effect under the Trade Marks Act 1994 of a disclaimer entered against a mark registered under the Trade Marks Act 1938 ?

(5 marks)

4. Your client's application was filed in respect of all goods in class 25 (clothing) and has met with objection on the ground that the range of goods covered by the application is unduly broad. Outline briefly what information or arguments you might put to the Registrar in trying to overcome this objection.

(5 marks)

5. In relation to one only of the following, state what objections as to registrability under the Trade Marks Act 1938 (other than those based on prior marks) might be raised and indicate briefly the actions you might take or arguments you might submit to counter such objections.

(a) WHITE LYON for chocolate confectionery

(b) MASTERSAFE for electrical equipment

(5 marks)

6. Under the Trade Marks Act 1994:

(1) Why would a client want to claim priority under the Paris Convention from an earlier application?

(2) When may he do so ?

(3) What effect does a priority claim have on the client's registration ?

(5 marks)

7. What objection might you expect the Registrar to raise in connection with an application to register FRANCOLOLA for wine ? How might you overcome such an objection

(a) under the Trade Marks Acts 1938; and

(b) under the Trade Marks Act 1994?

(5 marks)

8. Under what circumstances will consent from the proprietors of a cited registration be effective during prosecution of an application in overcoming a citation of that registration under (a) the Trade Marks Act 1938 and (b) the Trade Marks Act 1994?

(5 marks)

9. Comment briefly on the registrability of the following marks under the Trade Marks Act 1938:

(i) KA

(ii) RBD

(5 marks)

PART B

10. The client's application, filed in mid-1992, has given rise to objection under Section 12(3) of the Trade Marks Act 1938 on the basis of an earlier existing application, filed six weeks before the client's. What options does the client have in overcoming the registrar's objection? Would the situation be any different if the client's application had been filed under the Trade Marks Act, 1994 ?

(12 marks)

11. During the course of 1993, your client made applications to register the following marks:

- (a) a mark consisting of the coat of arms granted to the owner of the stately home just along the road from his factory;**
- (b) a mark to be used in relation to plants or seeds;**
- (c) a mark which consists of a distinctive device in combination with the name of the goods on which the mark is to be used.**

What requirements is the Registrar likely to impose if these marks are to be allowed to proceed to registration under the Trade Marks Act 1938?

(12 marks)

12. Under the Trade Marks Act 1938, the following notations are frequently seen in the advertised details of trade marks in the trade Marks Journal. Explain briefly what each means:

- (a) Advertised before acceptance. Section 18(1)(proviso).**
- (b) Application proceeding under Section 29(1)(b).**
- (c) Use claimed from the year 1958. Section 12(2).**

(12 marks)

13. On 1st November 1994, your client advises you that he intends to adopt and register a new trade mark and has asked you to make searches to ensure that he is free to use his chosen mark. Draft a letter to the client outlining what searches you would make and explaining briefly why. You should also give an indication of anything that your searches would not locate which might be of importance to the client.

(12 marks)

14. Write notes on the information you might expect to include in evidence of distinctiveness filed in support of an application for registration of a mark which the Registrar has indicated is somewhat descriptive of the applicant's goods.

(12 marks)

15. Outline briefly the Registrar's practice under the Trade Marks Act 1938 in relation to the registration of the names of towns and cities as trade marks. Include short comments on any differences in the way in which this practice is applied to marks used on services as opposed to marks used on goods.

(12 marks)

