

THE JOINT EXAMINATION BOARD

PAPER T4

ADVANCED UNITED KINGDOM TRADE MARK PRACTICE

Tuesday, 15th November 1994

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 1 (40 marks) and no more than three of the remaining four questions (20 marks).
2. The number of marks allotted to each question is shown 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. You should write on one side of the paper only using BLACK ink. Please do NOT staple pages together. You should 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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1. You have received the following letter dated 10 November 1994 from The Coronary Corp. (a company incorporated in Delaware, USA) which is one of your clients.

A. "We have applied for a Product Licence to market in the United Kingdom a new pharmaceutical for the treatment of cardiovascular diseases. The new pharmaceutical is proposed to be sold in the form of a transdermal patch comprising a reservoir and a release-rate controlling membrane; the reservoir will contain the pharmaceutical. In use, the patch will be applied to a patient such that the membrane contacts the patient's skin; the pharmaceutical will migrate through the membrane at a desired rate and into the skin of the patient.

"We want to market the patch under the trade mark CARZIDE HEART PATCH. Please conduct a full availability search on this mark, and let us know if we can use it in the UK. If so, please register the mark. Our USA trade mark attorney has used the following specification of goods for the corresponding USA application. If possible, we should like to use this specification in the UK;

"Pharmaceutical preparations and substances, namely a pharmaceutical for treating cardiovascular disease".

"Incidentally, we are aware that E.R. Squibb & Sons, Inc market an antacid drug in tablet form under the mark CORZIDE. However, we enjoy good relations with E.R. Squibb & Sons, Inc who have agreed to consent to our use of CARZIDE HEART PATCH.

B. "We should also like to register the trade mark NUCOR which we have used continuously in the UK in relation to another of our proprietary cardiovascular drugs since obtaining the necessary Product Licence on 2 January 1993; the NUCOR product is sold in the form of an injectable solution. Please also conduct a search for this mark and obtain registration.

C. "Finally, we recently acquired a U.K. medical apparatus company which has just developed its own electrocardiograph. We should like to sell this product under the name TRIAX, although the launch is unlikely to take place until at least the end of February next year. Please also clear this mark for use and registration".

You commission the searches as instructed; the results are set out below.

Write a letter to the Coronary Corp. setting out your advice on the availability of marks for use and registration in the UK and comment on any other points raised.

(40 marks)

A "CARZIDE HEART PATCH" Search Report

Number Status Filing date	Mark	Cls.	Owner	Specification
(1) 823135 renewed reg. 18.07.61	CARSYNAL	5	Imperial Chemical Industries Ltd	Pharmaceutical preparations and substances for human use and for veterinary use; and sanitary substances and disinfectants.
(2) 1389452 registration 06.07.89	CARCYT	10	Rodapham AG	Surgical and medical apparatus and instruments; medical apparatus and implements, all for diagnostic purposes; all included in class 10.
(3) 1128604 renewed reg. 13.02.80	UCARCIDE	5	Union Carbide Ltd	Biocides.

(4) 1165930 renewed reg. 04.12.81	CORZIDE	5	E.R. Squibb & Sons, Inc.	Antacid preparation for the treatment of diseases and disorders of the stomach and upper gastrointestinal tract.
(5) 273380 renewed reg. 05.06.05	CARBOCIDE	5	Executive Internation- al S.A	A liquid disinfectant.
(6) 1054625B renewed reg. 10.11.75	BLOCAZIDE	5	Sterling Winthrop Inc.	Medicinal and pharmaceutical preparations and substances; and sanitary substances.
(7) 814822 renewed reg. 20.12.60	TRESCAZIDE	5	May & Baker Ltd	Pharmaceutical preparations for the treatment of tuberculosis and leprosy.
(8) 766747 renewed reg. 21.06.57	ARICIDE	5	Glaxo Group Ltd	Horticultural pesticides.
(9) 342402 renewed reg. 06.05.12	CAR	5	Ricqles Zan	Liquorice juice prepared for use in pharmacy.
(10) 1124329 renewed reg.	CAPOZIDE	5	E.R. Squibb & Sons Inc.	Pharmaceutical preparations for the treatment of diseases or disorders of the heart or of the blood circulatory system.

B "NUCOR" Search Report

Number Status Filing date	Mark	Cls.	Owner	Specification
(1) 1183546 renewed reg. 15.10.82	NUCORD	5	Shell Internation- al Petroleum Co. Ltd	Insecticides, larvicides, fungicides, herbicides and pesticides; preparations for killing weeds and destroying vermin.
(2) 855793 renewed reg. 28.10.63	MUCORYZA	5	Sterwin Aktienges- ellschaft	Pharmaceutical preparations and substances for the treatment of the common cold.
(3) 1417940 registration 20.03.90	IMMUCOR	1	Immucor Inc.	Immunodiagnostic agents for in-vitro diagnostic use; all for sale in kit form; all included in class 1.

(4) 1294988B registration 05.12.86	NU-CAP	5	Coe Laborator- ies Inc.	Dental cavity lining material included in class 5.
(5) 160206 renewed reg. 05.11.91	NUCOA	5	Van Den Berghs & Jurgens Ltd	Vitamin preparations for use as ingredients in prepared foods.
(6) 798722 renewed reg. 03.12.59	NANKOR	5	Dowelanco Ltd	Veterinary preparations; parasitic -ides, insecticides, miticides; and parasitocidal products for use on animals.
(7) 1120631 renewed reg. 13.09.79	INOCOR	5	Sterwin Aktienges- ellschaft	Pharmaceutical preparations and substances for use in the treatment of cardiovascular ailments.
(8) 1547854 unpublished application 16.09.93	NUCLEON	5	Scotlab Limited	Chemical preparations for medical, veterinary or pharmaceutical purposes; DNA extraction kits; forensic chemicals; acrylamide solution for DNA, and genomic DNA, for genetic diagnostic purposes; all being for use in medical or clinical laboratories, all included in class 5.
(9) 447213 renewed reg. 07.04.24	NEWCOL	5	Sterling Izal Ltd	Disinfectants.

C "TRIAX" Search Report

Number Status Filing date	Mark	Cls.	Owner	Specification
(1) 1220356 renewed reg. 08.06.84	TRI-AC	5	Ciba Geigy Plc	Medicated substances for the treatment of skin disorders.
(2) 633596 renewed reg. 17.11.44	TRIXATEC	10	NAC Corporation	Medical apparatus and parts and fittings therefor.
(3) 1445166 pending app. 10.10.90	TRIACS	42	Henderson Clinics Ltd	Provision of medical and health care services.

(4) 1036059 renewed reg. 01.10.74	TRAX	5	Zoecon Industries Inc.	Rodenticides and pesticides.
(5) 1339247 removed 24.11.93 (renewal fees not paid) 12.9.86	TIRAX	5	Hoechst AG	Pharmaceutical preparations for the treatment of heart disease.
(6) 1032247 renewed reg. 09.07.74	TRIATIX	10	Penwolt Netherlands BV	Surgical tools and implements.
(7) 1389346 renewed reg. 10.09.89	TRIAMACS	10	Piggott & Watson Ltd	Ear plugs, ear trumpets and hearing aids.
(8) 1311247 renewed reg. 12.04.85	TRIATEC	5	Wellcome Foundation	Pharmaceutical preparations and substances.

2. Your clients, Systole Ltd, wrote to you on 10 November 1994 as follows:-

"As you know, for many years we have distributed a blood pressure monitor which is made by a company called Diastole Ltd. The monitor was designed principally for hospital or clinical use by medical professionals, and was invented by a Dr. Martin Smith in 1967. The blood pressure monitor, which works according to a scientific principle elucidated by Dr. Smith, measures continuously the blood pressure of a patient. We understand that in 1967/68 an early model of the monitor was distributed by Diastole Ltd to about fifty hospital consultants in the U.K. on a trial basis.

"In 1968, Dr. Smith granted Diastole Ltd the exclusive right to manufacture the monitor and, by virtue of an agreement dated April 1969, our company was appointed by Diastole Ltd as exclusive distributors of the monitor.

"Since April 1969 the blood pressure monitor has become very well known, and has been sold by reference to the trade mark "SMITH MONITOR".

"In 1976, Dr. Smith joined our company as a consultant, and devised a new instrument which measures the instantaneous blood pressure of a patient. The new instrument was designed principally for home use e.g. by heart-attack patients to monitor daily their condition, and works on substantially the same principle as the original SMITH MONITOR. We have made and sold the home-use instrument since 1977 under the trade mark "SMITH MINI-METER"; the SMITH MINI-METER is widely available to the general public from pharmacists on prescription.

"We have just discovered that in October 1994 Diastole Ltd launched their own competing home-use blood pressure instrument which they are selling under the trade mark SMITH POCKET METER at a price which undercuts our own SMITH MINI-METER. Naturally,

we were upset by this development and have complained
Diastole Ltd.

"In reply, Diastole have said that our use of the mark SMITH MINI-METER infringes their trade mark registration no. B1064000, and have asked us to stop immediately using the mark. Diastole have also given us the prescribed six month's notice of termination of the distributorship agreement of April 1969.

"We cannot understand why Diastole Ltd have taken this position as they have known of our SMITH MINI-METER since 1977 when we offered to sell it to them for distribution overseas (which they refused). We regard the mark SMITH MINI-METER as ours, as the instrument has become well known as the industry standard in the home-use market, as has the mark SMITH MONITOR in the hospital and clinical market.

"Please advise us on our position as soon as possible."

You conduct a search and find the following active trade mark registration:

Number Filing date	Mark	Specification
B1064000 15/06/76	SMITH MONITOR	Monitors for measuring blood pressure, parts and fittings therefor; all included in class 10.
[Accepted under Section 18(1) proviso]		

Make a note of any points you would like to discuss with your client and outline the advice you would give.

(20 marks)

3. You act in trade mark matters for the National Bakeries group of companies. All the group's trade marks are in the name of National Bakeries Plc. Flour Power Ltd is a subsidiary which is 70% owned by National Bakeries Plc and 30% owned by Cereal Foods Ltd, itself a wholly-owned subsidiary of National Bakeries Plc.

Since August 1987, Flour Power Ltd has sold self-raising flour under the trade mark FLOUR POWER, and since January 1993 it has sold a range of bread and pastry products under the mark. On 10 November 1993, an application to register FLOUR POWER was filed in class 30 in the name of National Bakeries Plc. The provisions of Section 29(1)(b) of the Trade Marks Act 1938 were relied upon and Flour Power Ltd was designated as a registered user of the mark. The application was filed in respect of the following goods:

"Bread and bread products, pastry and pastry products, flour, cereal products, confectionery"

The Examination Report for this application has now been issued, and the relevant sections of it are reproduced below.

Draft a letter to your clients providing them with your opinion on the objections raised, whether they can be overcome and if so how, and what, if any, additional information you need from them to submit a full response.

(20 marks)

Examination Report

The result of the examination of Application No. 1544000 in class 30 under the Trade Marks Act 1938 (as amended) and the TM and SM Rules 1986 is as follows:

Acceptance in Part A of the Register (Section 9)

The mark does not appear to be acceptable in Part A of the Register because it consists of the non-distinctive and descriptive word FLOUR in combination with the laudatory term POWER.

Acceptance in Part B of the Register (Section 10)

The mark does not appear to be acceptable in Part B of the Register because it is not considered "capable of distinguishing" the applicant's goods from other similar goods.

Deceptiveness/Morality (Section 11)

The mark as applied for appears to be open to objection under Section 11 of the Act because it would be deceptive if used on goods which do not consist wholly or substantially wholly of flour.

Result of search for conflicting marks (Section 12)

The following registered and pending marks are considered to conflict with this application and are therefore cited under Section 12(1) and 12(3) of the Act.

898898	}	
1443300	}	Registered
1122110	}	
1553300	}	Pending

Details of cited marks

Number	Mark	Class	Owner	Goods	Filing Date
898898*	FLOUR POWER	30	Abbeylands Bakeries Ltd	Pizza bases.	01/10/73
1443300	BURGER POWER X	29	Harry's Fast Food Ltd	Hamburgers, cheeseburgers, hot dogs.	15/05/89
1122110	POWMINT	5	Multimint Ltd	Mint-flavoured medicated confectionery.	20/03/80
1553300	MEAL POWER	30	Jacobsen McCabe, Inc.	All goods in class 30.	12/02/93

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

4. Your clients, ABC Books Ltd, are the international publishers of a diverse range of non-fiction books and publications. They also produce pre-recorded video and audio tapes and computer software in CD-ROM form as part of the company's general shift towards multimedia marketing.

One of their series of books and related video and audio products has been sold since 1988 under the trade mark SOW & GROW, and covers a wide range of domestic gardening subjects. Plans to produce a television gardening programme entitled SOW & GROW are well under way. Applications to register SOW & GROW were filed on 2 March 1992 in classes 9, 16 and 41 under the Trade Marks Act 1938 (as amended). The class 9 application was registered on 1 September 1994, and the class 16 and 41 applications were advertised in the Trade Marks Journal on 19 October 1994 and 21 September 1994 respectively. A form TM10A was submitted on the class 41 application on 24 October 1994, but the Registration Certificate has not yet been issued. Details of the three marks are as follows:

Number	Class	Goods
B1555000	9	Computer software in CD-ROM form; pre-recorded audio and video tapes; all the aforesaid goods relating to gardening; all included in class 9.
B1555001	16	Books and printed publications; all relating to gardening; all included in class 16.
B1555002	41	Production of television and radio programmes relating to gardening; all included in class 41.

On 15 November 1994 you receive copies of a TM7 and Statement of Grounds submitted against application no. B1555001, and a belated extension of time request to the opposition period of application no. B1555002. Both are dated 14 November 1994. The Statement of Grounds reads as follows:

- (1) The Opponents are Uberscholl GmbH, the world's largest manufacturer of gardening tools and implements, with an annual worldwide turnover of more than £40m. Their reputation extends beyond gardening tools and implements themselves, however: in the weekly television programme "Gavin's Garden", the renowned celebrity gardener Gavin Greene uses only SOW 'N' GROW implements.
- (2) The Opponents are the registered proprietor of U.K. trade mark registration no. 864468 UBERSCHOLL SOW 'N' GROW in class 8 covering "gardening tools and implements; all included in class 8".
- (3) The Applicants' mark should be refused under Sections 9 and 10 of the Act.
- (4) In view of the Opponents' aforementioned registration, the Applicants' mark should be refused under Section 12 of the Act.
- (5) In view of the Opponents' substantial and extensive reputation in SOW & GROW, registration of the Applicants' mark would be contrary to Section 11 of the Act, and should therefore be refused.
- (6) The Opponents ask that the application in suit be refused and an award of costs be made against the Applicants.

8 November 1994

[A Register extract obtained for registration no. 864468 reveals that "SOW 'N' GROW" is the subject of a disclaimer]

Your clients wish to take all possible steps to expedite registration of their mark in classes 16 and 41. Bearing this in mind,

- (1) prepare a counterstatement in response to the above Statement of Grounds,
- and (2) write a letter to your clients advising them of the likely course of events in relation to their class 41 application, including the chances of preventing opposition being filed, and incorporating an assessment of Uberscholl GmbH's Statement of Grounds in relation to the class 16 application.

(20 marks)

5. Your clients, Goodwin Price Ltd, a British company of 20
Glenmore Street, Newbury, Berkshire, SL14 2EJ, acquired on
10 January 1994 a company called Paint World (UK) Ltd of Unit
4, Harswell Road, Kennington Industrial Estate, Abingdon, Oxon
OX14 4NN, which owns a number of trade marks, including the
following registration:

Number	Mark	Class	Specification of Goods
1006422	PASTELUX	2	Paints, lacquers, varnishes and pigments; all included in class 2.

Paint World (UK) Ltd have been using this mark for several years through an exclusive registered user agreement with Perfect Paints Ltd.

You have now received a letter dated 10 November 1994 from your clients identifying their plans in relation to the PASTELUX trade mark as follows:

- (1) They have noticed that the quality of PASTELUX products has been deteriorating steadily, and they therefore wish to terminate the agreement with Perfect Paints Ltd and license the mark on a non-exclusive basis to the financially independent DIY and gardening chain Homes and Gardens Plc, throughout England and Wales only. They are very keen to ensure that the good quality of PASTELUX products is reestablished, and they inform you that they will accordingly be watching Homes and Gardens Plc's activities very carefully. They are proposing to take 5% of the net proceeds of goods sold under the mark as a royalty in return for the granting of the licence. They say that they want to try out this licence arrangement for three years in the first instance, on the understanding that they will renew it for another three years if all goes well. Homes & Gardens plc are a British company with their registered address at 12 London Road, Twickenham, Middlesex TW4

1PP.

- (2) They also wish in the first instance to license the mark to two other financially independent companies, respectively in Scotland and Northern Ireland, with similar licence agreements as will be in place for Homes & Gardens Plc.

Write a letter of advice to your clients and prepare a draft licence agreement between Paint World (UK) Ltd and Homes & Gardens plc to accompany your letter.

(20 marks)