

**THE JOINT EXAMINATION BOARD**  
**FOUNDATION LEVEL**  
**PAPER T1**  
**BASIC UNITED KINGDOM TRADE MARK LAW**  
**17 November 1999**  
**03.00p.m. - 05.00 p.m.**

Please read the following instructions carefully. This is a TWO 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 designations 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 any 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.

This paper consists of six pages, including this page.

**Part A**

1. Briefly explain the main differences between collective trade marks and certification trade marks.  
(5 marks)
2. How is use of one's own name a defence to an action for infringement of a registered trade mark ?  
(5 marks)
3. What are the relative grounds for refusal laid down under the Trade Marks Act, 1994 ?  
(5 marks)
4. What courses of Appeal are available subsequent to the refusal of a trade mark application by the Registrar. Comment briefly on the advantages or disadvantages of these courses of Appeal.  
(5 marks)
5. What are the definitions of "use of a sign" for infringement purposes, under the Trade Marks Act, 1994 ?  
(5 marks)
6. What remedies are available to a person alleging groundless threats of infringement ?  
(5 marks)
7. What are the grounds for obtaining a declaration of invalidity of a trade mark registration under the Trade Marks Act, 1994 ?  
(5 marks)

8. What qualifies as a registrable trade mark under the Trade Marks Act, 1994 ?  
(5 marks)
9. How does the Trade Marks Act, 1994 define an "earlier right"?  
(5 marks)
10. What remedies are available to the proprietor of a trade mark in circumstances where his UK agent or representative applies for registration of that mark ?  
(5 marks)

**Part B****Question 11**

You act for Stork Paints Limited. Your clients sell paint under the trade mark STORK, a mark which has been in use since 1970. STORK paint is the market leader.

Your clients have registered STORK as a word in plain block capitals under number 1888888 in respect of "paints", in Class 2. This registration dates from 9th March 1972.

Since the beginning of the 1990 season, your clients have sponsored the England cricket team. The trade mark STORK appears on the shirts and caps of the members of the England team (replicas of which can be purchased by the public).

Your clients have recently become aware of the trade mark STORK being used by New Clothing Limited in respect of a range of men's clothing. The mark appears on labels and as an emblem on t-shirts. You check the Register and you find that New Clothing has an application pending for STORK from 1997 in Class 25 in respect of "articles of clothing, footwear and headgear". Advise your client.

(12 marks)

**Question 12**

You are approached by Mr Donald Knight. Mr Knight is a businessman based in Manchester and he is the owner of a factory that manufactures jeanswear. Mr Knight's jeanswear has been sold under the brand name BLACKNIGHT since 1985 via various market stalls in Manchester City Centre. Mr Knight would like to expand his geographical area of business, but up to now has sold no jeanswear anywhere other than Manchester.

A batch of 20,000 jean jackets are manufactured by Mr Knight's factory but are found to be below standard as the cotton that is used for the stitching is found to be defective. Mr Knight does not want these jean jackets marketed under his BLACKNIGHT mark.

Mr Knight sells these "seconds" to a business acquaintance on the express understanding that the garments can be marketed only after all references to BLACKNIGHT have been removed.

Mr Knight has now found that the jackets in question are on sale in a factory outlet store in London. The BLACKNIGHT mark has not been removed.

BLACKNIGHT is not a registered trade mark.

Leaving aside breach of contract issues, advise Mr Knight as to how he might prevent the continuing sale of the subject jean jackets and the factors that will determine his chances of success.

(12 marks)

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Question 13

Your client, Vinega Limited is one of the few successful producers of white wines in the UK. Their wine is produced at the Llangefni Vineyard on the island of Anglesey, (Llangefni being the name of the small town in which the vineyard is located). They sell their wine under the mark LLANGEFNI. The mark is registered in the UK in respect of wines. Your clients have sold their product in the UK since 1990 and have averages sales of over 100,000 bottles per year.

Your client has sold a small amount of surplus stock of their wine to X Limited who use wine in the production of cooking sauces. Plonk Limited have acquired some of this stock from X Limited and are now selling their own bottles of the wine to which they have attached a label reading 'white wine from Llangefni Vineyard'. The wine is still of exactly the same quality as your clients product. To date, Plonk's sales have been on a very small scale.

Your client asks whether Plonk Limited are infringing their registered trade mark and how they can stop Plonk's activities. Advise.

(12 marks)

Question 14

The recent "ELVIS" Decision (rpc No 16 1999) means that "personalities" can no longer prevent the unauthorised use of their names. Discuss.

(12 marks)

Question 15

Your clients, Golden Limited, are the proprietors of the following UK registered trade marks:

No.	Mark	Class	Filing Date	Date of Registration	Goods
1157471	CITADEL	14	21.04.1962	21.08.1965	Jewellery
1242941	CITADEL	14	15.09.1972	15.10.1975	Watches, Clocks
1354728	CITADEL	14	11.05.1989	11.12.1991	Tea services of precious metal
2052194	CITADEL	14	04.06.1995	04.02.1997	Articles made of precious metal

Your client has used his CITADEL mark in relation to the goods covered by his registered mark for over 30 years and enjoys a strong reputation in the UK. He now wishes to extend his activities and use his CITADEL mark in relation to ladies clothing. A search in the UK has revealed the following registered mark owned by X Limited.

No.	Mark	Class	Filing Date	Date of Registration	Goods
1412152	CITADEL	25	14.11.1993	14.09.1994	Articles of clothing

Write a letter of advice to your client.

(12 marks)

Question 16

Your client, Opinion Limited has been using the trade mark OPINION in relation to trade mark advisory services since 1972. They have received a letter from X & Co who threaten to bring an action for infringement and passing off unless your client ceases use of the mark OPINION. They claim to have used the mark since 1979.

Further investigation reveals that X & Co are a firm of solicitors who specialise in family law, they do not have an IP department or employ IP specialists. X & Co have sought registration of the mark OPINION under UK application 1054050 in respect of 'legal advisory services'. The application was filed on 20 May 1998 and has just been advertised in the Trade Marks Journal for opposition purposes. Your clients state that they are not aware of any instances of confusion between the parties.

Advise your client.

(12 marks)