

THE JOINT EXAMINATION BOARD

PAPER T4

ADVANCED UNITED KINGDOM TRADE MARK PRACTICE

17 November 1999

10.00 a.m. - 02.00 p.m

Please read the following instructions carefully. Time Allowed - four hours

1. You must attempt Question 1 (40 marks) and no more than three of the remaining four questions (20 marks each).
2. The number of marks allotted to each question is shown in brackets at the end of each question.
3. Where a question permits, reasons should be given for the conclusions reached.
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.
8. **NO** writing whatsoever, including number of papers, is allowed prior to the commencement of the examination or after it has finished.
9. **At the end of the examination please double check that you have fully complied with instruction 4 and assemble your answer sheets in question number order to hand in.**

This paper consists of **fifteen** pages including this page.

Question 1

Your client is a marketing consultant acting on behalf of the Federation of Independent Retailers (F.I.R). The Federation, as the name suggests, represents the interests of small traders, mainly small grocers, corner shops, newsagents and the like, and has done so since 1976. F.I.R acts as an industry pressure group as well as providing business advisory, information and training services to its members.

With the onward march of the large supermarket chains, its members are being increasingly squeezed on price. In the process, the members are experiencing a steady decline in business in terms of volume and turnover. In trying to find a solution to this trend, F.I.R have called in the consultant who has developed two separate strategies as follows: -

- (1). Focusing on its members unique selling point of being central to the communities they serve, F.I.R is looking at an incentive scheme (similar to major retailers loyalty cards) to try and encourage customers to conduct a greater percentage of their shopping in the smaller local high street shops making up its membership. Customers will earn points for each £1 spent in the shops redeemable against a catalogue of goods and services. As an added bonus the name adopted will serve as a more cohesive branding for its many diverse members so as to give the comfort of being part of a larger organisation, thereby generating a greater sense of customer loyalty for all the independent retailers concerned. The favoured name is FARE MILES.
- (2). F.I.R has distributed a magazine, entitled FIR, to its members, and paid for out of membership subscriptions, since early 1992. Following an editorial overhaul earlier in the year, the magazine now has been extensively revamped to cover, not only retailing news, but also reviews on products and services and other general interest topics such as travel, pub and restaurant reviews; recipes, etc. The new look magazine has met very favourable reaction from members. In consequence, the Federation and their consultant now believe that the magazine should be released to the general public, both as a means of earning further revenue whilst highlighting the need for local shops as an essential part of community life. It is even anticipated that extracts from the magazine will feature on a new web site, which the consultant has recommended be set up with the same branding.

Trademark searches have now been conducted and the results are to be found in the attached papers. Write a letter to your client (the consultant), including any reasons for your conclusions, on the following trademark points: -

- a) The freedom to use and register "FARE MILES" for an incentive (loyalty card) scheme.
- b) The freedom to use and register the word "FIR" for all types of publication.




Ignore any issues concerning collective or certification marks

Please note that throughout the search report the prefix E denotes a CTM and M an International Mark.

(40 Marks)




Mark	Number	Proprietor / Country	Goods / Services	Status	Date
FARMER GILES FOODS	1,131,577	Farmer Giles Foods (Aylesbury) Limited	Puddings included in class 30; cakes and pastries, pies and sauces	Registered	8.4.80
CAREMILES	2,163,965	Mr Dean Saunders	CLASS 16. Vouchers for 'monetary' donation to charity(ies) or courses. CLASS 35. Advertising; organisation, operation and supervision of sales and promotional incentive schemes designed to fundraise for charity(ies) or courses	Advertised Before Acceptance Pending	14.4.98
BEER MILES	2,167,107	Philip Adams, Roger Edward Cawdron, Michael John Robert Lorenz and Alan John Fuller	CLASS 35 : Advertising, marketing and promotional services; organisation, management and administration of promotional and business incentive schemes; sales promotion; organising loyalty card schemes, competitions, and prize draws for advertising, marketing or promotional purposes. CLASS 42 The provision of food and drink.	Registered	8.1.98
FAREDEALZ	2,140,657	Travel Incentives Ltd	CLASS 35. Advertising customer loyalty concepts in conjunction with retailers, transport and leisure industry operators; operation and supervision of sales and promotional incentive schemes. CLASS 39. Transportation of people over land; travel arrangements.	Advertised 6.10.99	31.7.97
MUNCH MILES	2,046,832	Outdoor Promotions Limited	Class 35 Advertising and marketing services; preparation, publication and distribution of advertising and promotional matter; advertising, organisation, operation and supervision of sales, promotional and incentive schemes; advisory and consultancy services relating to all the aforesaid services.	Registered	2.8.93


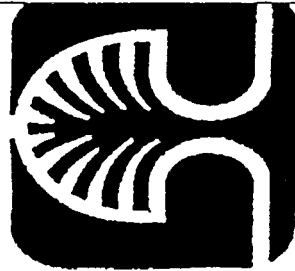
PUB MILES	1,578,199	Marketing In Action Limited	Class 35 Advertising, marketing and promotional services; organization, management and administration of promotional and business incentive schemes; all included in class 35.	Registered	13.7.94
DINING MILES	1,574,385	Gut Busters Limited	Class 35 Advertising agency services; marketing and promotional services; organisation, operation and supervision of promotional activities; savings card services.	Registered	3.6.94
AIR MILES	1,273,555	Air Miles International Holdings N.V.	Class 16: Vouchers, all for travel by air, and for holidays including travel by air to and from the destination; all included in class 16. Class 18 Leather, imitation leather; articles made from the aforesaid materials; luggage; travel bags, trunks, suitcases, vanity cases, briefcases, handbags, purses and wallets; walking sticks; umbrellas and parasols; all included in class 18. Class 25 Articles of outer clothing for men, women and children; all included in class 25. Class 35 Advertising; organisation, operation and supervision of sales and promotional incentive schemes; all included in class 35	Registered Registered Users	12.12.96
FAR SMILES	M 852,010	Lufthansa Holidays Gmbh.	Class 16: Brochures, booklets, travellers cheques, posters, photographs. Class 36: Travel insurance, credit card services, personal financial services. Class 39: . Transportation of people by land and by air; travel arrangements.	Advertised in UK TMJ 25.8.99	16.2.99


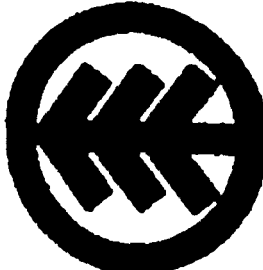
<u>MARK</u>	<u>NUMBER</u>	<u>PROPRIETOR</u>	<u>CLASS</u>	<u>GOODS/SERVICES</u>	<u>STATUS</u>	<u>DATE</u>
 	2,199,116	TTL Chiltern Ltd	1,9,16, 19,20	Class 1: Chemical products used in industry. Class 9: Instruments for testing furniture; parts and fittings for furniture, materials used in the manufacture of furniture, and furnishings; electronic publications and information stored in digital media; measuring instruments for use in the furniture and woodworking industries but not including tape measures. Class 16: Printed publications. Class 19: Wood for building construction and for making furniture; wood veneers. Class 20: Wooden furniture and parts and fittings therefor; furniture, mirrors (looking glasses), picture frames; parts and fittings included in Class 20 for the aforesaid goods..	Pending. The applicant claims the colour purple for the second mark in the series only, as an element of the mark.	3.6.99
infer	M8,707,873	Infercor AS (Norway)	9, 42	Class 9: Apparatus for recording, transmission or reproducing of sound or images; electronic publications; magnetic data carriers, recording discs; data processing equipment and computers. Class 42: Computer programming.	Pending.	18.2.99
	1,265,899	Original Animal Skins Inc. (USA)	16	Paper, paper articles cardboard and cardboard articles, all included in Class 16 printed matter, newspapers, periodical publications, books; photographs; stationery, adhesive materials (stationery); artists' materials (other than colours or varnish); paintbrushes; but not including any such goods relating to fur or skins.	Registered	29.04.86

<u>MARK</u>	<u>NUMBER</u>	<u>PROPRIETOR</u>	<u>CLASS</u>	<u>GOODS/SERVICES</u>	<u>STATUS</u>	<u>DATE</u>
FIRFILM	1,321,830	Firmenich S.A. (Switzerland)	16	Plastics materials for packaging, all in the form of film; magazines and periodical publications; all included in Class 16.	Registered Date claimed under International Convention 27 May 1987.	18.9.87
FERBY	1,520,628	Johann Froeseheis LYRA-Bleistift-Fabrik GmbH & Co (Germany)	16	Paper, card, cardboard; printed matter; writing instruments; artists' materials; goods for use in modelling; coloured pencils and crayons; office requisites; instructional and teaching materials; blackboards and drawing apparatus for use therewith; playing cards; printers' type; printing blocks; all included in Class 16.	Registered	4.12.92
OFIRS	B1,546,008	Amerada Hess Ltd	16	Printed matter and publications; books, pamphlets, manuals, magazines, periodicals and newsletters; instructional and teaching materials; all included in Class 16.	Registered To be associated with No. B1546007 and another.	27.8.93
FIRE	1,572,122	World League Euro Marks B.V. (Netherlands)	16	Printed matter, books, printed publications; pictures, posters, photographs; calendars; instructional and teaching materials; all relating to American football; paper articles; cardboard articles; labels; pencil sharpeners, binders and files, all being articles of stationery; ordinary playing cards; decalcomanias, writing implements, rubber erasers, notepads, drawing rulers; office requisites; artist's materials; all included in Class 16.	Registered	12.5.94

FIRO	2,010,919	Consulting Psychologists Press, Inc (USA)	16, 41, 42	Class 16: Printed matter, printed publications, periodicals, brochures, books, manuals, journals, reports, booklets and posters all relating to psychological testing. Class 41: Education and training of people in administration and interpretation of psychological tests. Class 42: organising, arranging and conducting psychological tests and reporting of results.	Pending.	2.2.95
FIRO	2,126,711	Will Schutz Associates (USA)	16, 41	Class 16: Printed matter; printed publications; periodicals; brochures; books; manuals; journals; reports; booklets and posters. Class 41: Education and training of people in administration and interpretation of psychological tests; organising, arranging and conducting of colloquia, conferences, congresses, seminars and symposia; publication of books and texts.	Pending.	14.3.97

MARK	NUMBER	PROPRIETOR / COUNTRY	CLASS	GOODS / SERVICES	STATUS	DATE
	B1,444,322	UPM-Kymmene OYJ (Finland)	16	Paperboard, paper and goods made from these materials; self-adhesive labels all being printed matter; stickers; all included in Class 16.	Registered.	16.10.90
	831,780	Spar Food Distributors Ltd (England)	16	Paper, paper articles and cardboard articles, all included in Class 16; printed matter, newspapers, periodical publications, books; none relating to trees, book-binding materials, cardboard, photographs, stationery and adhesive materials (stationery).	Registered. Registered Users.	9.3.62
	E153,486	The Timberland Co. (USA)	16	Appointment books, address books and chequebooks in Class 16.	Registered.	1.4.96

MARK	NUMBER	PROPRIETOR / COUNTRY	CLASS	GOODS / SERVICES	STATUS	DATE
	E196,915	Ranpack Corporation. (USA)	16	Paper products; paper designed for conversion into a packing material, as by wadding or shaping; packing materials made of paper, including cushioning materials composed of compressed paper; shock-absorbing materials made of paper; animal bedding made of paper; cat litter made of paper; periodical publications relating to the treatment of paper; absorbent materials made of paper; stock roll tape; confetti.	Registered.	1.4.96
	E205,567	Learning Tree International Inc. (USA).	16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks; printed educational matter; course notes, brochures.	Registered. Seniorities claimed Benelux: 408 871 01/05/1985 Germany: 1 089 525 05/14/1985 United Kingdom: 1 237 841 01/10/ 1985 United Kingdom: 1 281 202 03/04/1986	1.4.96

MARK	NUMBER	PROPRIETOR / COUNTRY	CLASS	GOODS / SERVICES	STATUS	DATE
	E210, 211	C.A.R.I.P. S.A. (France)	16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; publications; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printer's type; printing blocks; adding machine rolls; adhesive tapes; binding; books; pads; note books; note pads; spiral bound note books; spiral bound note pads; envelopes; boxfiles; all in International Class 16	Applied for Advertised Colours claimed : Green & Brown	1.4.96 17.9.99
	E319, 467	Boise Cascade Corporation. (USA)	16	Paper; paper products; office requisites; stationery; adding machine paper; binders; clipboards; correction fluid; duplicating supplies; envelopes; file folders; hanging folders; index cards; insertable tab indexes; memo sheets; message pads; message books; paper pads; paper; bond paper; computer paper; copier paper; laser paper; writing paper; pencils; pens; recycles paper products; sheet protectors; notebooks; tablets; books; forms; labels; books; stationery; paper bags; all types of paper and cardboard products; boxes; cards; magazines; desk accessories; mats;	Applied for Pending	1.7.96

Question 2.

Mrs Smith has complained to you that about a year ago she asked the local chemist to develop and print a photographic film for her. The film went astray and she never got to see the photographs. She was particularly disappointed because they contained pictures of her baby daughter's first birthday party. No-one else at the party took any photographs so she could not obtain pictures from anywhere and the moment was lost.

Sometime later, she was therefore amazed to see packets of disposable nappies being sold at her local supermarket as an own brand product (this is a well-known chain of supermarkets), and bearing a picture of Mrs Smith's daughter at that party.

You have conducted a trade mark search and located UK Trade Mark Application No 2030741, consisting of the same picture that is used on the packaging of the nappies, in the name of said supermarket, filed on 8 February 1999 for, *inter alia*, disposable nappies. The mark is due to be advertised on 24 November 1999.

- (1) Write notes advising your client
 - (a) on the action she may take, explaining the procedures involved; and
 - (b) commenting on any alternative action open to her
- (2) Draft any necessary documents to support the initial step in the action you have recommended.

(20 marks)

Question 3

Your client, Plush Ltd, is the market leading producer of feminine hygienic products and incontinence pads. Recently your client developed a revolutionary new super absorbent material. The research and development took 5 years and cost £20,000,000. The final product has a proprietary three-part construction and includes the new material (which is the subject of a pending patent application).

Your clients first launched this product in its lucrative North American market 3 months ago, with a huge advertising campaign using the mark MILLENIUM SORBZ 3. The product is now being sold in all the remaining countries where Plush Ltd. trade and should be in the UK and Europe for 1st January 2000.

The company intends not only to increase its market leadership by providing a superior performing product but also to re-coup its R&D costs by selling the product at a premium and in packs of 7 (formerly 10).

Mirror Image plc. is a national retailer, who has brought out an imitative product heralded as "For the new millennium LOCK 3", which it sells in packs of 7 at a cheaper price. MIRROR IMAGE plc.'s supplier PAPERCHEAP Ltd. also sells the same product under its own label as TRI-LOCK.


The PAPERCHEAP product concerned does not feature the proprietary material but does look similar; and in particular the colours (for both MIRROR IMAGE plc. & PAPERCHEAP) are similar to those used by the client. An experienced partner in your practice has already advised that although the designs are similar there is no design infringement.

After spending such vast sums of money on the product development and launch your clients will not accept that there is nothing they can do, to the point where they've considered buying any mark with prior rights in the word LOCK which might help thwart their competitors plans. A search of the UK and US registers reveals the marks attached.

Your clients ask for advice in writing as to what they can do against either of the products / companies concerned together (only on the basis of Trade Marks and / or Passing-Off) with a suggested plan of action showing the approximate timing of the various actions. You must also give your professional recommendation as to any potential dangers that the suggested course of action may entail.

Prepare a memo of advice to your client giving reasons for the advice that you give.

(20 Marks)

<u>MARK</u>	<u>NUMBER</u>	<u>PROPRIETOR/ COUNTRY</u>	<u>GOODS/SERVICES</u>	<u>STATUS</u>	<u>DATE</u>
MILLENNIUM SORBZ 3	GB 2,001,829	PLUSH LTD. DOUGLAS, ISLE OF MAN.	Feminine hygiene products included in Class 5.	Registered.	3.6.96
MILLENNIUM SORBZ 3	US 75/841,877	PLUSH LTD. DOUGLAS, ISLE OF MAN.	Feminine hygiene products.	Pending.	3.8.99
	US 75/841,876	PLUSH LTD. DOUGLAS, ISLE OF MAN.	Feminine hygiene products.	Pending. Colours claimed are Red, Blue & Yellow in the Pantones ® as shown on the form of application.	3.8.99
LOCK 3	GB 2,201,866	MIRROR IMAGE PLC. LEEDS, ENGLAND.	Sanitary towels, tampons, napkins and pads; all for feminine hygiene and all included in Class 5.	Pending.	2.7.99
TRI-LOCK	GB 2,243,111	PAPERCHEAP LTD. ABERDEEN, SCOTLAND.	All goods in Class 5.	Pending.	7.7.99
LOCK	E2,000,914	MEDIBIZ S.A PARIS, FRANCE.	Pharmaceutical, veterinary, sanitary and hygiene goods in International Class 5.	Registered.	4.4.97
LOX	B1,07,425	ARDAL GAS LTD. POOLE, ENGLAND.	Gases for medical purposes; lotions for pharmaceutical purposes; surgical dressings.	Registered. Registered Users.	10.1.55
LOCK	GB 758,245	GARDENEERS LTD. LONDON, ENGLAND.	Herbicides, fungicides and preparations for destroying vermin.	Registered. Unpaid Renewal.	5.3.50
LOCKS	GB 2,244,762	VETCARE GMBH. DRESDEN, GERMANY.	All goods in International Class 5.	Pending. International Convention Priority claim of 27.4.99 (Germany).	10.10.99

Question 4

Your clients have recently asked you to take over a trade mark application which they filed themselves. They do not own any other registered trade marks or applications.

The application was filed on 3 June 1999 for the mark PHOTOCABIN in Class 9 for the following specification of goods:

"Photograph booths to enable people to have a photograph taken, processed and printed while they wait. The booths will be situated in shopping centres and other public places. The photographs will be suitable for use in passports."

The application has been examined and the following objections have been raised:

-Section 3(b) and (c) in that the mark is devoid of any distinctive character and is descriptive of the goods specified.

-Section 5:

No. 1 222666

PHOTOCABIN

Class 9: optical apparatus and instruments and parts and fittings therefor

A UK national registration filed 6 June 1986 and registered about a year later

IR 666 777

FOTOBIN

Class 1: unprocessed photographic film

Class 16: photographs, photograph albums, photograph frames of card or cardboard, greetings cards

An International Registration based on a German Registration filed 16 March 1994 and extended to the UK on 20 November 1997

Your clients had requested a Hearing before appointing you and want you to attend the Hearing on their behalf. In the meantime, you have learned that within the last month a competitor has commenced use of the mark FOTOKABIN for photographs.

Plan your arguments and outline any research you need to do first.

Explain to your clients the reasoning behind this and what you hope to achieve. Include in your explanation any recommendations you may have to improve their position.

(20 Marks)

Question 5

Your clients is Miczel Limited, who is the proprietor of UK Trade Mark Registration No 1829102 for the mark MICZEL, which is registered in respect of the following goods:

"Electrical apparatus and instruments; calculating machines; parts and fittings for all the aforesaid goods; all included in Class 9.

The registration was entered on the register on 4 November 1983. Your client currently trades in "consumables" for office equipment (e.g. toner cartridges, ribbons for typewriters, diskettes, batteries for lap top computers, etc), having stopped selling electric typewriters, word processors, calculators, photocopiers and other electrical and electronic office equipment in December 1994.

Your client has received the attached letter and you are required to advise them on the matter.

*The Managing Director
Miczel Limited
3 High Street
Old Town
Midshire*

2 November 1999

Dear Sir

*UK TRADE MARK REGISTRATION NO 1829102
"MICZEL" IN CLASS 9*

Our clients, Bizzco Ltd, have applied to register the mark MLXCEL in Class 9 in respect of computer hardware, firmware and software, and computer programs under Trade Mark Application No 2457839. The application has been examined and the Examiner has cited your Registration No 1829102 against the application. He will waive the citation if you will consent to the registration of the mark MLXCEL. We are aware of your clients' sales of toner cartridges but our initial, somewhat limited research has not located any other use of the mark MICZEL. Our clients' goods are aimed at computer-aided design, specifically for engineers, architects and draughtsmen and so we believe that there is unlikely to be any conflict between the two marks. Our clients have not yet used their mark.

We are currently working to an official deadline of 23 December 1999 and so would appreciate an early response from you. Our clients are prepared to meet your reasonable costs, if you agree to give us the required letter of consent.

Yours faithfully

Draft a suitable letter of consent and an undertaking; also advise your client on the pros and cons of giving or refusing an undertaking.
(20 Marks)