

**THE JOINT EXAMINATION BOARD
PAPER T4**

**ADVANCED UNITED KINGDOM TRADE MARK
PRACTICE**

**Wednesday, 22nd November 2000
10.00 a.m. - 2.00 p.m.**

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

1. Check the contents of this envelope. You have, including this sheet, 16 sheets in total.
2. You should attempt question 1 (40 marks) and no more than three of the remaining four questions (20 marks each).
3. The number of marks allotted to each question is shown in brackets at the end of the question.
4. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
5. 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 (T4), the question number and your examination number. You should write only on one side of the paper using **BLACK** ink. **Do NOT staple pages together.** You should **NOT** write your name anywhere in the answers.
6. Unless specifically requested, answers are **NOT** required in letter form.
7. **NO** printed matter or other written material may be taken into the examination room.
8. Answers **MUST** be legible. If the examiners cannot read a candidate's answer then no marks will be awarded.

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This paper consists of 16 pages, including this front sheet

Question 1—Search Question.

Your clients are Insurance Holdings Limited who own several subsidiary companies involved mostly but not exclusively in the insurance business.

One of the subsidiaries, Falcon Limited, has supplied insurance for professional musicians (eg third party liability for events, musical instrument insurance and so on) under the trade mark FALCON since at least 1985 but has never registered any trade marks. They have hired an advertising company to devise a campaign to raise their profile because they have well developed plans to extend the range of insurance policies they sell to encompass other forms of insurance like personal property, buildings and contents, motor insurance, pets, personal injury and so on. Because of their long association with the music industry the advertising company has suggested that they set up a pop group with wide appeal and called by the same name (ie FALCON). With your clients' contacts in the music industry and the financial backing available your clients believe that this would be an unusual and effective way of launching the proposed extension to their existing business.

Another subsidiary has been set up to establish an insurance business on-line. Initially this will only be for motor insurance and the chosen name is EXPRESS INSURANCE DIRECT.

You have conducted a search for the following:


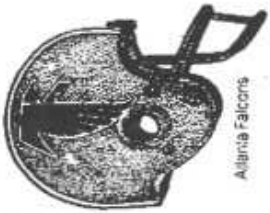

FALCON for insurance services and for musical services
EXPRESS INSURANCE DIRECT for insurance services.


Write a letter to your clients advising them as to the availability and registrability of each mark, in the United Kingdom, recommending ways of trying to overcome any potential problems which you have identified.


NB EXPRESS newspapers, DIRECT LINE insurance and AMERICAN EXPRESS are marks with a significant reputation in the United Kingdom.

(40 Marks)

SEARCH REPORT FOR THE TRADE MARK "FALCON"

Mark	Proprietor	Number	Appln Date (Date entered on the Register)	Goods/Services
	British Telecommuni- cations plc	B705777	18.03.52 (10.11.52)	Radiogramophones, radio sets (complete), television receivers and component parts, included in Class 9, of all of these goods.
	NFL Properties (UK) Ltd	1317560	31.07.87 (19.7.91)	Thermometers, hydrometers and barometers; apparatus for recording and reproducing sound or video; magnetic tapes and cassettes; magnetic and optical discs all for recording sound or video; sound recordings and video recordings; photographic and optical apparatus and instruments; screening material for filtering light; computer programs; computer games and video games; calculators; magnets; electronic amusement apparatus; eyeshades; sunglasses; spectacle cases; parts and fittings for all the aforesaid goods; all included in Class 9
	Digital Integration Ltd	2014786	21.03.95 (29.12.96)	Recorded programmes included in Class 9 for use in playing computer games.


NEWCASTLE FALCONS	The Sporting Club Ltd	2140663	31.07.97 (5.3.99)	<p>Class 9: Computer software; Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs, data processing equipment and computers, parts and fittings for all the aforesaid goods; all relating to rugby.</p> <p>Class 16: Photographs; stationery; artists' materials; instructional and teaching material (except apparatus); playing cards; Paper and cardboard and goods made of these materials, magazines and printed publications; all relating to rugby.</p> <p>Class 25: Clothing, footwear, headgear.</p> <p>Class 28: Toys, games and playthings; gymnastic and sporting articles not included in other classes; parts and fittings for all the aforesaid goods; all relating to rugby.</p> <p>Class 41: Education services, provision of training, entertainment and sporting activities all relating to rugby, and cultural activities.</p>
FALCON INSURANCE SERVICES LTD.	Bluebell Properties Limited	1348507	17.06.88 (12.4.91)	Insurance services included in Class 36.
FRIEND & FALCKE 	Friends Provident Estate Agencies Ltd	1530802	25.03.93 (25.11.94) Expired	Real estate agency services; real estate appraisal; real estate brokerage; real estate management; housing and mortgage brokerage; savings and loan agency services; investment services; buildings and contents insurance services; all provided within Greater London; all included in Class 36.
ATLANTA FALCONS	NFL Properties (UK) Ltd	2173215	27.07.98 pending	Class 25: clothing; footwear; headgear Class 41: education; providing of training; entertainment; sporting and cultural activities.


	Falken Registaturen GmbH	E810952	15.04.98 pending	Class 9: computer software, CD ROMs, DVDs; pre-recorded tapes and discs.
FALCK	Falck A/S	E493718	20.03.97 (27.8.99)	Class 9: Life saving equipment; life jackets, life, belts; protection devices for personal use against accidents; smoke detectors; emergency call devices; recorded computer programs. Class 36: insurance services.
VOLCON	Peter William Gerard Beutell	E761791	27.02.98 (29.6.99)	Class 9: computers; computer software; publications in electronic form supplied on-line from databases or from facilities provided on the Internet; music supplied on-line from databases or from facilities provided on the Internet; computer software to enable searching and graphical display of data; telecommunication apparatus. Class 35: business information services provided on-line from a computer database. Class 36: information services relating to finance and insurance. Class 42: computer rental; information provided on-line from a computer database or from the Internet.


	<p>FESA KG des Falkensteiner Erich & Co</p>	<p>E456012</p>	<p>12.03.97 (25.1.99)</p>	<p>Class 39: travel preparation, organisation and arrangement, in particular for attending live entertainment events. Class 41: Providing and arrangement of live entertainment. Class 42: hotel reservations; providing of food and drink and temporary accommodation.</p>
<p>HELKON</p>	<p>Helkon Media Filmvertrieb GmbH</p>	<p>E1289784</p>	<p>23.08.99 pending</p>	<p>Class 25: clothing. Class 35: advertising Class 41: entertainment, including film and music production.</p>



E = European Community mark

SEARCH REPORT FOR THE TRADE MARK "EXPRESS INSURANCE DIRECT"

Mark	Proprietor	Number	Appln date (Date entered on the Register)	Goods/services
EXPRESS DIRECT	Express Newspapers Limited	2043932b	08.11.95 (18.07.97)	Class 10: Surgical and medical apparatus and instruments Class 11: Apparatus for lighting and heating. Class 20: Furniture Class 28: Games and playthings, Christmas trees Class 35: advertising, business advisory services Class 39: travel arrangements Class 42: Holiday and catering services; medical services; health and beauty care; printing; design; agricultural services.
 <p>Registration of this mark shall give no right to the exclusive use, separately, of the words 'DIRECT LINE' and 'INSURANCE' and a device of a telephone hand set</p>	Direct Line Insurance plc	B1273134	01.10.86 (08.9.89)	Class 36: Insurance services; all included in Class 36. Advertised before acceptance, Section 18(1) proviso.

AMERICAN EXPRESS <i>Registration of this mark shall give no right to the exclusive use, separately, of the words 'AMERICAN' and 'EXPRESS'</i>	American Express Company	B1278820	01.10.86 (22.06.90)	Class 36: banking, brokerage, insurance, investment, money exchange, mortgage, financial management, analysis and consultancy services and real estate agency, management, leasing, appraisal and valuation services; issue of travellers' cheques; processing of payments in relation to credit or charge cards; agency funds transfer services.
DIRECT LINE INSURANCE <i>Registration of this mark shall give no right to the exclusive use of the word 'INSURANCE' and, separately, of the words 'DIRECT' and 'LINE'</i>	Direct Line Insurance plc	B1392351	24.07.89 (03.09.93)	Class 36: insurance services included in Class 36. Advertised before acceptance by reason of use and trade evidence. Section 18(1) proviso
 <i>Registration of this mark shall give no right to the exclusive use of the word 'DIRECT'.</i>	Finaxa	1488948	23.01.92 (18.06.93)	Class 35: Publication of publicity texts; dissemination of advertising matter; advisory services all relating to business management and to business organisation. Class 36: insurance services; arranging of loans; credit brokerage; financial and management planning. Class 39: vehicle breakdown recovery services; recovery of vehicles. Class 42: medical services; veterinary services; housing of animals.

LANDMARK EXPRESS <i>Registration of this mark shall give no right to the exclusive use of the word 'EXPRESS'</i>	Landmark Insurance Company Limited	1573530	28.05.94 (23.02.96)	Class 36: Insurance services; insurance services provided directly to the public and through brokers.
DIRECT LINE INSURANCE	Direct Line Insurance plc	2003155	23.11.94 (1.11.96)	Class 36: Insurance services, mortgage services, mortgage protection services, loan services, income protection services, life assurance services, disability assurance services.
	Telesure Ltd	2005475	28.11.94 (19.07.96)	Class 36: Insurance broking services available by telephone.
EXPRESS DIRECT	Express Newspapers Ltd	2043932a	8.11.95 (30.10.98)	Class 8: hand tools and implements Class 16: paper, cardboard, books, periodical publications, magazines; printed matter, photographs; pictures; instructional and teaching materials. Class 18: leather and imitations of leather, and goods made of these materials. Class 21: household and kitchen utensils Class 25: clothing, footwear and headgear Class 36: financial advisory services.

	Direct Life & Pension Services Limited	2175197b	19.08.98 (09.07.99)	Class 36: insurance services; annuity purchasing services; investment advice.
	Gebr. Hellmann GmbH & Co KG	IR 564831	16.01.91 UK designated 18.3.99	Class 36: customs brokers and insurance brokers Class 39: transport and transport brokerage for goods transported by road, by railway, by boat and/or by air.
DIRECT LINE INSURANCE	Direct Line Insurance plc	E54817	01.04.96 Pending	Class 16: Printed matter Class 36: Insurance and financial services Class 37: vehicle repair services.

E = European Community mark

IR = International Registration designating the United Kingdom

Question 2

Your client Core Radio Limited of Sunderland, a wholly owned subsidiary of Core Communications plc, intends to commence broadcasting of local radio programmes throughout northern England at the beginning of February next year.

The Company Secretary of your client filed an application in the UK in Classes 9, 38 and 41 to register the following marks as a series of three marks:

1. **CORE**

2.



3. **CORR RADIO**

The application was allocated No 2221111, given a filing date of 4 July 2000 and specified the following goods and services:

Class 9 - Electrical, electronic and telecommunications apparatus; audio cassette tapes; videos; gramophone records; radios; sound recording and reproducing apparatus, compact discs, CD ROMs, computer software and hardware; electronic publications downloadable from the Internet.

Class 38 - Telecommunications; radio broadcasting.

Class 41 - Radio entertainment; production of radio programmes.

Core Communications plc was incorporated in December 1993 and has carried on business in the UK and abroad producing, buying, selling, distributing and promoting radio and television programmes since May 1994. Core Radio Limited was incorporated in England in March 1999 and has not currently traded or provided any services. Core Communications plc does not and has never had any other subsidiary companies.

Your client has informed you that due to a typographical error the third mark in the series incorrectly appeared as CORR RADIO and should have been CORE RADIO. You have been asked to correct this error.

The Company Secretary of Core Radio Limited has sent you a copy of the Examination report for the application and asked you to advise on how they should proceed and what further information you require.

Advise your client of his options at this stage and of any action needed before responding to the Official Action.

(20 Marks)

EXAMINATION REPORT

Application No. 2221111 in Classes 9, 38 and 41 has been examined under the Trade Marks Act. References to 'section' in this report mean that section of the Act.

Series Marks (Section 41(2))

The marks do not form a series, because they do not resemble each other as to their material particulars. The objection may be overcome if two of the marks are deleted, or divided off to make separate applications. Each request to divide must be made on Form TM12, accompanied by the divisional fee, and additional application fee.

Absolute Grounds for Refusal (Section 3)

The application is not acceptable in all Classes: there is an objection under Section 3(1)(b) & (c) of the Act because the marks consist exclusively or essentially of the word "Core" being a sign which may serve in trade to designate e.g. goods and services that are the most important or that relate to the innermost or most essential part of something.

There is an objection under Section 3(3)(a) in relation to the second mark in the series in that its registration would be contrary to public policy or accepted principles of morality.

Class 09 - Relative Grounds for Refusal (Section 5)

There is an objection under Section 5(2) because there is a likelihood of confusion with the earlier marks, which are listed below and detailed at the end of this report.

[Note: E denotes a Community mark and M denotes an International mark]:

1303849 (09)	2000634 (38)	M699006 (09, 42)
E395731 (09, 16)		

There is an objection under Section 3(6) because the specification is so wide that there is some doubt about the accuracy of the statement on the application form that the applicant is using, or intends to use, the mark on all of the goods applied for. The goods should therefore be listed by name and restricted, or documents or other information supplied to show that the specification accurately describes the range of goods for which the mark is used, or proposed to be used.

Class 38 - Relative Grounds for Refusal (Section 5)

There is an objection under Section 5(2) because there is a likelihood of confusion with the earlier marks, which are listed below and detailed at the end of this report.

[Note: E denotes a Community mark and M denotes an International mark]:

1303849 (09)	2000634 (38, 41)	M699006 (09)	E395731 (09)
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Class 41 - Relative Grounds for Refusal (Section 5)

There is an objection under Section 5(2) because there is a likelihood of confusion with the earlier marks, which are listed below and detailed at the end of this report.

[Note: E denotes a Community mark and M denotes an International mark]:

2000634 (38, 41)

END OF EXAMINATION REPORT

1303849 (RGSTRD)	2000634 (RGSTRD)
1303849 13 March 1987 (09)	2000634 4 November 1994 (38, 41)
COREfast	RADIO CORE
Registration of this mark shall give no right to the exclusive use, separately of the words "Core" and "Fast".	Class 38: Radio broadcasting.
Class 9	Class 41: Production of radio programmes.
Computer software and hardware; semiconductor chips; tape drives and data back-up cartridges; telecommunications apparatus; all included in Class 9.	Core Radio (UK) Limited , 16 London Road, Bristol BS57YZ
CoreFast Products, Inc. , 3031 North Federal Highway, Boca Raton, Florida 33399, USA	Agent: Old, Short & Dunne
Agent: XYZ Associates	

(Madrid) 699006 (EXAMIND)	(OHIM) 395731 (PENDING)
699006 29 April 1998 (09, 35, 42)	395731 14 January 1997 (09, 16)
CORE	CORE COMMUNICATIONS
Class 9: Computer peripheral devices; computer	Class 9: Sound and video recordings; radio and software.
Class 35: Checking, recording and management of data.	television programmes; videos; compact discs;
Class 42: Technical advice and technical support provided to users of global computer networks.	cinematographic films; audio cassette tapes;
Bamberg Computers GmbH , 114 Brennerstraße, Bamberg, Germany D-96182	computer programs; CD ROMs; discs;
Representative: Brandt & Muller	computer software.
	Class 16: Printed publications: stationery; diaries; calendars; computer programmes in printed form.
	Core Communications plc , 81-89 East Street, Hull HU1 1RS
	Representative: Smith & Little

Question 3.

The client is a husband and wife partnership trading as ACTORWAY. They supply trained actors to teach organisers of training courses how to improve their skills of presentation. The organisers who attend such courses are typically company employees responsible for in-house training of their colleagues.

ACTORWAY was established two years ago and has been very successful on a regional level. The business now plans to expand to encompass the UK as a whole. It has been decided that by setting up a web-site under the domain name "actorway.com", the initial steps could be taken to set this in motion, both for the recruitment of actors, and publicising the business on a wider scale. They have decided on this method of making themselves known because they do not have the finances to run a direct mailing campaign other than for companies in their own region, let alone launch a national promotional campaign.

When they came to register the domain name, ACTORWAY.COM, they found that the name had already been registered by someone else, a Mr Nick Brown. Closer investigation showed that the person who had beaten them to it was actually a disgruntled former employee of theirs. The website promotes services which are identical to those offered by your clients and the copyright in the material is claimed to be owned by a company called Actorway.com Limited. Your clients asked a friend to make an enquiry with a view to possibly booking actors through the site and he was offered two actors who have been hired by your clients from time to time for the same purpose.

Advise your clients (in note form if preferred):

1. what further research is recommended;
2. what they can do to stop Mr Brown from using the domain name and company name he has chosen; and
3. in a domain name and trade mark context, what actions they should take to improve their current position.

(20 Marks)

Question 4.

Your client is Mrs Sally Tomkinson. Her mother used to own a business manufacturing and selling teddy bears. Each bear was different and had its own unique name. One of the bears was named Sally Simpson – your client's maiden name – after your client. This name was one of the few names that was registered as a trade mark.

About ten years ago the business was sold to Teddy Ltd. A search of the Companies Register discloses that a petition for winding up had been lodged in July 1998 and that the local Barclays Bank had been appointed as the Official Receiver and Liquidator.

A search of the register revealed that the mark SALLY SIMPSON is still registered. The register shows the mark in the name of Teddy Limited and the next renewal is due in 2006.

As Mrs Tomkinson is in the process of getting a divorce from her husband she wants to start her own business to get herself some financial independence. It is intended that the business will be the manufacturing and selling of soft toys. She has chosen the trading style SALLY SIMPSON as she is likely to resume use of her maiden name following the divorce.

Advise your client as to her freedom to use the mark and the options open to her.

(20 Marks)

Question 5.

Your client is the Scriveners Company, a city livery company. The Scriveners Company was established as a legal entity in 1373 and was granted a charter in 1617 by James I. It has controlled the profession of Scrivener Notary since that time. Scrivener Notaries have had the exclusive right to practise within the city of London and within a distance of three miles from the boundaries thereof. This exclusivity to practise for Scrivener Notaries has been abolished in the Access to Justice (Woolf) Act. This means that other notaries may now practise within the area formerly reserved entirely for Scrivener Notaries.

You are approached by the Clerk of the Company who expresses concern that the long-lived and high reputation of Scrivener Notaries will be usurped by others. In order to become a Scrivener Notary it has been necessary for a candidate to pass the series of special examinations administered by the Scrivener Company. The Scriveners Company continues to set and administer the examinations for the qualification of Scrivener Notaries.

Each candidate for membership of the livery of the Scriveners Company has first to become a freeman of the City of London. By virtue of their membership of the Scriveners Company, the certificate of freedom of the City of London entitles the recipient to call himself/herself "Citizen and Scrivener of London".

Although the exclusivity of Scrivener Notaries to practise within the city of London and its immediate surroundings has been revoked, a new rule has been adopted that reads as follows:-

"No notary shall describe himself as a Scrivener or a Scrivener Notary unless he holds the qualifications to practise as a Scrivener Notary from time to time prescribed by the Incorporated Company of Scriveners of London."

In the increasingly competitive world of the professions in both the United Kingdom and in Europe, your client is concerned that the value of the name SCRIVENER and SCRIVENER NOTARY will become devalued. Accordingly they are seeking guidance from you as to what action they may take to protect their name and reputation.

You have conducted a search of the register in the UK office and have established that there are no prior conflicting registrations. You consult the Oxford English Dictionary where you find the following entry:-

Scrivener

1. *A professional writer or scribe; a copyist; a clerk, a secretary.*
2. *A notary.*
3. *A person who invested money and interest for clients, and lent funds to those who wanted to raise money on security. Formerly also MONEY SCRIVENER.*

Advise your client by letter on the actions that they may be able to take in order to protect his interests in the UK, briefly outlining the procedural steps involved and any documents and evidence required. Give an indication of the problems likely to be encountered, how you might overcome these and your assessment of their chances of success.

(20 Marks)

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