

THE JOINT EXAMINATION BOARD
BASIC UNITED KINGDOM TRADE MARK LAW – PAPER 1

Friday, 5th November 2004

3.00 p.m – 5.00 p.m.

*Please read the following instructions carefully. **Time Allowed – TWO HOURS.***

1. You should attempt **eight** questions from Part A and **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. Please note the following:
 - Start each question (but not necessarily each part of each question) on a fresh sheet of paper.
 - Enter the Paper Number, the question number and your Examination number in the appropriate boxes at the top of each sheet of paper.
 - Write on one side of the paper only, within the printed margins using a **BLACK** pen.
 - **DO NOT** use coloured pens or highlighters within the answers – they will not photocopy.
 - **DO NOT** staple or join pages together in any way.
 - **DO 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. **ALL** mobile phones and electronic aids **must be** switched off and stored away.
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answer, no marks will be awarded.
8. **NO** writing whatsoever, including numbering of papers, is allowed prior to the commencement of the examination or after it has finished.
9. **NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED. At the end of the examination assemble your answer sheets in question number order and place in the WHITE envelope provided.**

This paper consists of five pages, including this page

PAPER T1

BASIC UNITED KINGDOM TRADE MARK LAW

Friday, 5th November 2004

3.00 p.m – 5.00 p.m.

Part A

1. What relief is available to a person who brings proceedings for groundless threats under Section 21 of the Trade Marks Act 1994?
(5 marks)
 2. How does Section 6 of the Trade Marks Act 1994 define an “earlier trade mark”?
(5 marks)
 3. Explain “honest concurrent use”.
(5 marks)
 4. What are the limits on the effect of a registered trade mark under Section 11 of the Trade Marks Act 1994?
(5 marks)
 5. What are the grounds for revocation under Section 46 of the Trade Marks Act 1994?
(5 marks)
 6. Section 32 of the Trade Marks Act 1994 lists requirements for filing an application. What are they?
(5 marks)
 7. What are the effects of acquiescence under Section 48 of the Trade Marks Act 1994?
(5 marks)
 8. Explain the provisions of Section 41(2) of the Trade Marks Act 1994 pertaining to series marks.
(5 marks)
 9. Outline the provisions of Section 4 of the Trade Marks Act 1994 (specially protected emblems).
(5 marks)
 10. Outline the provisions of Section 35 of the Trade Marks Act 1994. (Claim to priority of convention application).
(5 marks)
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Part B

11. Dr Bernard Johnson is a plastic surgeon. He is well-known as having performed cosmetic surgery on UK celebrities.

In 2001 Dr Johnson was approached to front a television programme in which members of the public could win a face-lift or other cosmetic surgery to be performed by Dr Johnson. He adopted the name “MR. NIP ‘N’ TUCKSTER” as the title of this programme, this being the name that had been given to Mr Johnson by the tabloid media.

The TV programme first aired on 25 June 2001 and was an immediate success – peak time viewing figures of 8 million+ and lots of press coverage.

In early 2004 Dr Johnson decided to publish a book called “MR. NIP ‘N’ TUCKSTER”. Just prior to publication, he found that Inglenook Books Limited owns a UK registration for NIP AND TUCKSTER for “books; printed publications” in class 16. This registration was filed on 2 December 2001. Inglenook has not thus far used its mark.

Write notes on the advice that you would give to Dr Johnson.

(12 marks)

12. Your client, Newson Beverages Limited, wants to use the trade mark ZUBRETO in the United Kingdom for a carbonated soft drink.

You conduct a search and find that a German company, Getranke GmbH, has the following registrations effective in the UK:

UK No. 1555432
SUPRETO (word)
Filed: 11 August 1984
Registered: 10 October 1985
“Non-alcoholic beverages included in Class 32”.

Madrid Protocol No. 654321
SUPRETO (word)
Filed: 15 February 1998
Registered: 21 November 1998
“Non-alcoholic beverages and preparations for making non-alcoholic beverages” in Class 32 and “Wines, spirits and liqueurs” in Class 33.

You make enquiries and you find that SUPRETO is a leading brand across continental Europe. Getranke has not however used its mark in the UK. SUPRETO is, nonetheless, well-known in the UK – UK citizens travelling to Europe could not have failed to have become aware of the SUPRETO brand.

Further enquiries reveal that Getranke has filed an application in Germany for SUPRETO (stylised word) for “non-alcoholic beverages”. This application was filed on 25 October 2004.

Write notes on the advice you would give to Newson.

(12 marks)

13. You act for Big Mountain Limited.

Your client sells instant coffee (ie coffee granules) under the trade mark BMC. This mark was first used in 1992 and use has been continuous since that year.

Your client contacts you as the following letter has been received from a firm of solicitors:

Dear Sirs,

RE: BMC Trade Mark –and- Our Client: BNC Inc

We act for BNC Inc, a US corporation.

Our client is the owner of the trade mark BNC. This mark has been used by our client in the UK since about 1985 in respect of packs of iced tea. Our client is the owner of UK Trade Mark Registration No. 1456987 BNC which is in respect of “tea; iced tea; beverages made of tea; all included in Class 30”. This registration dates from 11 June 1985.

Our client is concerned to read in this week’s “Beverages Weekly” magazine that you are intending to “expand your BMC product range to include packs of iced coffee”.

We have advised our client that the trade marks BNC and BMC are confusingly similar and that your use of BMC in respect of iced coffee will infringe our client’s registration. We therefore ask that you undertake to refrain from any use of BMC (or any mark that is similar to “BNC”) in respect of iced coffee”.

Your client wants to know whether BNC Inc has a case in respect of the proposed use on iced coffee. Your client also seeks advice with regard to its right to continue to use BMC for instant coffee. (There is no registration for this mark).

In note form advise your client.

(12 marks)

14. Your client, Rooftop Ltd, has used the mark “ROOFTOP” in relation to their nightclub/restaurant for some 18 months. They have premises in the basement of a former warehouse in Liverpool. Their turnover for the first 6 months was only £20,000 however in the subsequent 12 months it has grown to £1,000,000 and they have received rave reviews in local and national press.

They filed a UK application to register the mark ROOFTOP in relation to nightclub services and restaurant services on 20 October 2004. They now wish to open a new “ROOFTOP” venue in Manchester in 9 months time.

They have become aware of Chancer Ltd who have just started to distribute flyers in central Manchester on which appear the words “Manchester’s new venue ‘THE ROOFTOP BAR’ opening next month on the ground floor of Manchester’s tallest building”.

Your client has asked for advice on whether he can:

- i. prevent Chancer Ltd’s use of “THE ROOFTOP BAR”.
- ii. open his new Manchester venue in 9 months time.
- iii. protect his mark for the future.

Write a letter to your client.

(12 marks)

15. “GRIEVOUS ANGEL” is a well-known clothes shop which specializes in “upmarket” merchandise, designer brands in particular. The first shop opened in May 1995 on London’s fashionable Bond Street and since then there has been steady expansion to the extent that there are now two or three GRIEVOUS ANGEL shops in each of about a dozen cities across the UK. The trade mark GRIEVOUS ANGEL appears on the front of all of its shops, but there is no GRIEVOUS ANGEL own label on clothing.

Your client has a UK registered trade mark GRIEVOUS ANGEL – No. 1555666 which was filed on 4 February 1996 and entered on the Register on 17 November 1996. This registration is in Class 25 and covers “articles of clothing, footwear and headgear”.

The owner of the GRIEVOUS ANGEL shops and trade mark registration, Bettina Hansen, contacts you with a concern relating to the use of the trade mark GRIEVOUS ANGEL on a range of ladies clothes that she has seen on sale in the clothing department of a high street supermarket. She says that this use started about two weeks ago and she wants it stopped immediately.

Advise Ms Hansen.

(12 marks)

16. Outline the procedures followed before the Registrar in an application for revocation on the grounds of non-use under the Trade Marks Act 1994 (Section 46(1)(a) or (b)).

(12 marks)