THE JOINT EXAMINATION BOARD

PAPER T2

UK TRADE MARK PRACTICE

Tuesday 9th November 2004

2.00pm to 5.00pm

Please read the following instructions carefully. ***Time Allowed – THREE 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 conclusion reached, such reasons should be given.

4   Please note the following:

    a.   Start each question (but not necessarily each part of each question) on a fresh sheet of paper.

    b.   Enter the Paper Number, the question number and your Examination number in the appropriate boxes at the top of each sheet of paper

    c.   Write on one side of the paper only, within the printed margins using a **BLACK** pen.

    d.   **DO NOT** use coloured pens or highlighters within the answers – they will not photocopy.

    e.   **DO NOT** staple or join pages together in any way

    f.   **DO NOT** state your name anywhere in the answers

5   **Unless specifically requested answers are <u>NOT</u> required in letterform.**

6   **<u>NO</u>** printed matter or other written material may be taken into the examination room.

7   **<u>ALL</u>** mobile phones and electronic equipment **must be** switched off and stored away.

8   Answers **<u>MUST</u>** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.

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.**

10 This paper consists of five (5) pages, including this page.

PART A (Answer eight questions)

1. Calculate the next renewal dates for the following:

   a. a registration resulting from a UK trade mark application filed on 2 November 2000, claiming priority from a Hong Kong trade mark application filed on 2 May 2000.

   b. a registration resulting from a UK trade mark application filed on 30 September 1994, with no priority claim, and registered on 15 June 1995

   c. a registration resulting from a UK trade mark application filed on 11 October 1968, claiming priority from a French trade mark application filed on 21 August 1968, registered on 17 September 1969.

   d. a registration resulting from the merger between one UK registration in Class 9 with a filing date of 17 June 2002, and another UK registration in Class 38 filed on 9 August 2002, both claiming priority from a US trade mark application covering Classes 9 and 38 and filed on 22 February 2002.

   (5 marks)

2. Discuss briefly the inherent registrability of two of the following trade marks under current UK Trade Mark Registry practice, assuming they are new, unused marks:

   a. the colour pink for "beautician services";

   b. SNOWDON for "hiking boots" ;

   c. I - TUTOR for "education services";

   d. SAY CHEESE! for "photograph albums".

   (5 marks)

3. Explain what is meant by a "series mark". List the ways in which you would attempt to overcome an objection from the Trade Mark Registry on the basis that a trade mark application does not constitute a series.

   (5 marks)

4. List five grounds on which a UK trade mark registration may be declared invalid under the Trade Marks Act 1994.

   (5 marks)

5. List the elements which are required to be present in a UK trade mark application for it to be accorded a filing date.

   (5 marks)

6. What is the Trade Mark Registry practice on the acceptance of "retail services" within the specification of a trade mark application?

   (5 marks)

7. Section 5 of the Trade Marks Act 1994 (which relates to relative ground refusal) distinguishes between "earlier trade marks" and "earlier rights". Identify the various "earlier rights" which can form the basis for refusal of a trade mark application on relative grounds and state which, if any, will be cited by the Trade Mark Registry on examination.

    (5 marks)

8. a. List 3 examples of how a registration may be part assigned.

    b. Is it necessary for a trade mark application to become registered before being assigned?

    c. A client advises that on 6 June 2004 he orally assigned a registration to a friend of the family. Is it an effective transaction?

    (5 marks)

9. a. At what stage in the process of a third party's trade mark application is it first possible to object to the Trade Mark Registry?

    b. What method would be used to make that objection?

    c. What other method(s) are available to object to such a trade mark application, and at what stage in proceedings can it/they take place?

    d. When a mark has been registered, by what method can objections to that registration be taken?

    e. At what stage(s) in the life of a registration can those objections take place?

    (5 marks)

PART B (Answer five questions)

10. Your client is an exclusive licensee under a trade mark registration. Write a letter to your client explaining the advantages of his recording the licence agreement at the Trade Mark Registry.

(12 marks)

11. Your client has filed a trade mark application for "clothing; footwear; headgear" in Class 25. On examination of the trade mark application, an earlier registration has been raised as an objection under section 5 of the Trade Marks Act 1994. The earlier mark has been registered for "clothing".

Your client has used his mark on a significant scale for at least five years in the UK in respect of "clothing". You have advised your client to attempt to overcome the objection on the "basis of honest concurrent use".

   a.   Outline the information which must be included in the evidence to be filed at the Trade Mark Registry, at the same time explaining why this information will be necessary.

   b.   Will the Trade Mark Registry refuse your client's trade mark application if the proprietor of the earlier mark files opposition?

(12 marks)

12. Your client believes that following a successful bid, the Olympic Games will be staged in London in 2012. In readiness to capitalise on this possibility, he has designed a distinctive Device and wishes to file an trade mark application to register the Device in respect of a wide range of merchandise.

The Device is a cartoon of Her Majesty Queen Elizabeth waving a Union Jack, in conjunction with the internationally recognised Olympic Symbol.

List and provide reasons for any anticipated objections from the Trade Mark Registry on their examination of the trade mark application.

(12 marks)

13. Your client wishes to assign a trade mark registration to another party. List the following information in brief note form:

   a.   what the assignment should include; and

   b.   the Trade Mark Registry requirements for recordal.

(12 marks)

14. Your client has received a request for consent. She is new to the trade mark world. Explain briefly what "providing consent" means, include any drawbacks to agreeing or refusing consent. Draft a letter of consent on the basis that the identical marks "POINTY BIRDS" are involved. Your client's UK National registration is numbered

626,578, the new trade mark application is 2,344,432. Your client's mark c̶
Clothing, footwear and headgear. The new trade mark application covers me̶
clothing.

(12 marks)

15. a.   In a trade mark opposition, what deadlines are not extendable under the current rules?

   b.   How long is the cooling off period in the UK Trade Mark Registry and on which form is it requested?

   c.   Who can apply for a cooling off period?

   d.   What is the procedure for ending a cooling off period (including time limits for filing the Form TM8 Notice of Defence & Counterstatement)?

   e.   What is necessary in the Statement of Grounds for a Preliminary Indication (PI) to be issued?

   f.   When a PI is issued, what options do you have as a result of the PI?

   g.   How would you seek an extension of time to file evidence?

   h.   If the Trade Mark Registry's Hearing Officer issues a decision against you, what are the two immediate routes of appeal, and what is/are the deadlines for each?

(12 marks)