

THE JOINT EXAMINATION BOARD**Paper T1 Basic United Kingdom Trade Mark Law****Thursday 2nd November 2006****Time: 15.00 to 17.00**

Please read the following instructions carefully. *Time allowed – 2 hours*

1. You should attempt **eight** questions from Part A and **five** questions from Part B.
2. There are a maximum number of five marks allotted to each question answered in Part A and a maximum of twelve marks allotted to each question answered in Part B.
3. 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 (T1), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - (c) The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper and only within the printed margins, and do not use highlighters in your answer;
 - (d) Do not staple or join pages together in any way;
 - (e) Do not state your name anywhere in the answers;
 - (f) Write clearly, examiners cannot award marks to scripts that cannot be read;
 - (g) Reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - (a) You are found with unauthorised printed matter or other unauthorised material in the examination room;
 - (b) Your mobile phone is found to be switched on;
 - (c) You copy the work of another candidate, use an electronic aid or communicate with another candidate or with anyone outside the examination;
 - (d) You continue to write after being told to stop writing by the invigilator(s).

NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED

5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

PART A

- 1)** What are the only permitted corrections/amendments that may be made to a UK trade mark application once it has been filed?
- 2)** What are the provisions for claiming "Honest Concurrent Use" in the Trade Marks Act 1994?
- 3)** What are the Appeal routes for an applicant whose trade mark application has been refused by the UK Trade Marks Registry?
- 4)** What provisions exist in the Trade Marks Act 1994 for the registration of a series of trade marks?
- 5a)** List the absolute grounds for refusal of registration set out in Section 3(1) of the Trade Marks Act 1994.
- 5b)** What proviso exists?
- 6)** On what grounds may a UK trade mark registration be revoked under the Trade Marks Act 1994?
- 7a)** Under Section 56 of the Trade Marks Act 1994, what is a well known mark and who is entitled to its protection?
- 7b)** What remedy is the owner of a well known mark entitled to under Section 56(2) of the Trade Marks Act 1994?
- 8)** Who may claim priority under Section 35 of the Trade Marks Act 1994 and what is the effect of a successful claim to priority?

- 9a)** Under Section 21 of the Trade Marks Act 1994, what relief may be claimed in respect of 'groundless threats'?
- 9b)** There are three particular sets of circumstances outlined in Section 21 (1) of the Trade Marks Act 1994 in which infringement proceedings may be threatened but proceedings for relief in respect of 'groundless threats' may not be brought. What are they?
- 10a)** Who is entitled to apply to have a registrable transaction recorded under the provisions of Section 25 of the Trade Marks Act 1994?
- 10b)** List four of the five registrable transactions itemised in Section 25 of the Trade Marks Act 1994
- 10c)** Name two benefits of recording a registrable transaction.

PART B

- 11) Your client seeks your advice with regard to a search conducted into the availability for use and registration of the slogan THE GAMES EXPERT in respect of the retailing of computer, electronic and video games in class 35.

The report shows two potential obstacles as follows:

1. A UK registration for THE ULTIMATE GAMES EXPERIENCE covering computer software, computer games, electronic and video games and downloadable electronic publications in class 9. This trade mark also contains a dominant and distinctive lightning device. The mark is not vulnerable to challenge for non-use.
2. A UK trade mark registration for EMPEROR COMPUTER EXPERT registered under the 1938 Trade Marks Act, in class 9 for CD-Roms, CD-Rom storage cases, computer software, computer games, mouse mats. The mark disclaims exclusive rights to the words COMPUTER EXPERT alone. This mark is now vulnerable to challenge for non-use.

Write notes on the possibility of securing registration in the United Kingdom on both absolute and relative grounds, as well as freedom to use in the United Kingdom.

- 12) Outline the opposition procedure now followed by the UK Trade Marks Registry from publication of the application to final decision, including forms required and relevant timescales.
- 13) In the light of the reported case *Ansul -v- Ajax Brandbeveiliging*, explain what is meant by “genuine use” of a trade mark?

- 14) Discuss Sections 5(3) and 10(3) of the Trade Marks Act 1994 in light of reported ECJ decisions such as *Adidas AG -v- Fitnessworld Trading Ltd.*
- 15) Your client, La-Z-Bean Co, owns the trade mark LA-Z-BEAN for "coffee, coffee essence, coffee extracts; mixtures of coffee and chicory, all for use as substitutes for coffee". The mark has been used in the United Kingdom since 1938 on instant coffee, and, additionally, since 1990 on decaffeinated instant coffee.

You may assume the trade mark has acquired a reputation in respect of these goods.

Two weeks ago Laviroc SA introduced in the UK cans of L'AZBEAN carbonated drinks with a cocoa bean base.

Write notes setting out your client's case in trade mark infringement, mentioning cases if appropriate (ignore passing off and well known marks).

- 16) Your employer's major competitors are the market leaders for orange juice in the UK. They sell their juice in the well known 'Oro Oranges'. These have been on the market since about 1960. Each Oro Orange "squeezezy" container is in the shape of an orange and is coloured orange with an orange cap, with the trade mark 'Oro' embossed on it, although this embossing is not readily apparent to casual inspection. The size is dictated by the content, but each container is about the size of a real orange. Each Oro orange bears a small label round its neck bearing the legend "Oro real orange juice" and other information as to the "Best Before" date, the proprietor's name and address and so on.

Your employer is the market leader for orange juice in the USA where it markets its orange juice in plastic bottles of conventional design under the Realorange brand. Realorange is registered in the US but was refused in the UK because of its descriptive connotations. Your marketing department wants to introduce the Realorange product to the UK but does not want to do so in the conventional bottle used in the USA but wants to use what the marketing manager has

described in a written memo to you as “a close copy of the Oro squeezy orange”.

To this end he has already produced a prototype. This looks like an orange very slightly bigger than the Oro Orange and of a subtly lighter shade of orange plastic having a red cap. It also has a small label round its neck bearing the words “Realorange Natural Strength orange juice”, a bar code and similar commercial information.

The marketing manager has told you that he has already tested the “Realorange squeezy” out on some consumer groups. The Marketing Manager goes on to tell you in an email that

“Quite a few members of the test groups asked when we had gotten the franchise for Oro Orange but I guess confusion is to be expected until such time as the public get used to the idea that other people than Oro are entitled to sell orange juice in orange shaped containers. We can live with any confusion and it will be a small price to pay to break Oro’s monopoly”.

You take your problem to your head of department who asks you to prepare a briefing paper setting out the law relating to passing off briefly indicating how you think this will apply to the present case.

You are not to concern yourself with any issue of design, copyright or registered trade marks because your head of department will take care of that aspect of the problem.