

THE JOINT EXAMINATION BOARD

PAPER T2 – Basic United Kingdom Trade Mark Practice

Tuesday 7th November 2006

2.00 p.m. – 5.00 p.m.

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

1. You should attempt **EIGHT questions in Part A** of this paper and **FIVE questions in Part B**.
2. **FIVE MARKS** are available for each answer in **Part A** of this paper, and **TWELVE MARKS** are available for each answer 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 (**T2**), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
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 - d. Do not staple or join pages together in any way;
 - e. Do not state your name anywhere in the answers;
 - f. Write clearly, as 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;
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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.**

This question paper consists of FIVE pages (including this instruction sheet).

PART A – FIVE MARKS PER ANSWER**(Answer eight questions)****Question 1**

Calculate the NEXT renewal dates for the following:

- (a) A registration resulting from a UK trade mark application filed on 4 May 1976 and registered on 14 August 1977 claiming priority from a French trade mark application filed on 12 January 1976;
- (b) A registration resulting from a UK trade mark application filed on 3 May 1993 and registered on 6 November 1994;
- (c) A registration resulting from a UK trade mark application filed on 18th July 2005, where the application fees were paid on 1st August 2005;
- (d) A registration resulting from the merger of one UK trade mark registration with a filing date of 31 March 1997 registered on 16 July 1998 and another UK trade mark registration with a filing date of 11 May 1999 registered on 19 November 1999.

Question 2

List the requirements for obtaining a filing date for a UK trade mark application.

Question 3

Explain the meaning of “earlier trade mark” in the context of the UK Trade Marks Act 1994. There is no need to refer to recently expired trade marks.

Question 4

Your client, Hoof Plc, wants to use and register the mark **TROTTER** in the UK in relation to “clothing and footwear” in class 25. They have filed a UK application for the mark which has been given Application No. 2181477. The application has been examined and the UK Trade Marks Registry have cited prior UK Trade Mark Registration No. 1743921 **TROTTERS CO** which is registered in respect of “slippers and sandals” in class 25 and stands in the name of Curly Tail Ltd.

Draft a letter of consent to be signed by Curly Tail Ltd. that would be accepted by the UK Registry in order to overcome the citation.

(Question 5 follows on the next page)

Question 5

Briefly explain why an exclusive licensee of a UK registered trade mark should record the licence agreement at the UK Trade Marks Registry.

Question 6

Briefly discuss inherent registrability of **two** of the following trade marks under current UK Trade Marks Registry practice:

- (a) **BUSINESS CONNECT** for "advertising services";
- (b) **ARCTIC** for "tents";
- (c) **CAFFE FRESCO** for "coffee".

Question 7

Outline the UK Trade Marks Registry's current practice on searching and citations in relation to an application covering "Retail services connected with the sale of clothing and footwear". You are expected to describe the search practice as amended by Practice Amendment Notice No. 7/06: "Retail Services – search of the register".

Question 8

Your client, an inventor, has produced a bath towel which can be heated in a microwave oven. No other product exists on the market which can do this. He is very pleased with the name he has chosen, **MICROWAVE HOT TOWEL**, as he says he thinks it is very unusual and therefore a good trade mark.

Explain any objections under Section 3(1) of the UK Trade Marks Act ("Absolute grounds for refusal of registration") which the examiner is likely to raise to an application for **MICROWAVE HOT TOWEL** covering towels. Comment briefly on the merit of any likely objections.

Question 9

Your client has no UK trade mark applications or registrations but wishes to put the ® symbol next to the name of his product on its package. He intends to sell his products in the UK. Briefly explain to him the relevant provisions of the UK Trade Marks Act in note form.

(Part B Questions begin on the next page)

PART B – TWELVE MARKS PER ANSWER**(Answer five questions)****Question 10**

Your client has told you that they wish to use a new trade mark in the UK for fishing rods and equipment. The mark consists of the word **FISHMAZING** together with a picture of a leaping salmon.

Write a letter of advice explaining the searches and investigations you advise they carry out in order to clear the mark for use and registration. Briefly explain the reason for each search and investigation.

(12 marks)

Question 11

Discuss the inherent registrability and acceptable forms of graphic representation for a trade mark application in the UK in respect of:

- (a) The smell of roses for clothing; (6 marks)
- (b) The colour blue for cricket bats. (6 marks)

Question 12

Your client is a manufacturer of soft drinks. They are considering using one of the following slogans to accompany all of their future advertising, and they have asked for your advice on the chances of successfully registering both as UK national trade marks for soft drinks:

- (a) **OPEN, POUR – ENJOY LIFE ONCE MORE;**
- (b) **TAKE A DRINK, IT'S AMAZING.**

Comment on the inherent registrability of each of the slogans and advise your client on the nature of any possible objections they may face in relation to each one should they apply for registration (*you should ignore relative grounds*):

(8 marks)

Write brief notes to advise your client on how best to use the slogan to recognise its status as a trade mark.

(4 marks)

(Question 13 follows on the next page)

Question 13

Your client sells fish through major UK supermarkets. In the 1990s they were interested in using the mark **WAVE FRESH** for these products but were blocked by an earlier UK trade mark registration for the identical mark. Your client made some enquiries and found that the mark was in use on a small scale in the UK. Since then they have continued to monitor the market and they now believe that there has been no use of the mark for some years. They would still like to use the mark themselves and they have now approached you for advice.

- (a) List the requirements for revoking a mark based on non-use; and
(4 marks)
- (b) Set out the procedural steps involved in a revocation action (*you may answer this part of the question in the form of a flow-chart if you wish*).
(8 marks)

Question 14

On behalf of your client Francesca Furniture Ltd, you filed a UK trade mark application to register the trade mark **FUN FRANKIE** in respect of "children's furniture". The mark is not yet in use in the UK. You have now received the first official action from the UK Trade Marks Registry and find that the following earlier trade marks have been cited:

- (a) UK Trade Mark Registration No. 1457000 for **FUN FRANKIE** covering "office furniture" filed on 10th March 1995 and entered on the register on 17th January 1996 in the name of Frank's Office Supplies Ltd;
- (b) UK Trade Mark Application No. 2791001 for **FRANKIE** covering "furniture" filed on 20th February 2006, in the name of Fowl Furniture (UK) Ltd.

What steps would you recommend in order to try to overcome these objections?
(12 marks)

Question 15

Your client has applied to register a 3D representation of its banana shaped bottle for fruit flavoured drinks at the UK Trade Marks Registry. The application has been refused on the grounds that it is devoid of distinctive character. You have advised your client to submit evidence of their longstanding and substantial use of the mark in the UK. Discuss, in note form, the nature of the evidence that you might submit to the Registry.

(12 marks)

(End of questions)

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