

THE JOINT EXAMINATION BOARD**PAPER T3****Advanced United Kingdom Trade Mark Law and Practice****Wednesday 8th November 2006****10.00 a.m. - 2.00 p.m.**

*Please read the following instructions carefully. **Time Allowed - FOUR HOURS***

1. You should attempt **FOUR** questions. All questions carry **25 marks**. If more questions than necessary are attempted, they will be marked in the order presented and questions over the required number will be ignored.
2. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
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 (**T3**), 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 only and within the printed margins, and do not use any highlighters in your answer;
 - d. Please do not staple or join pages together in any way;
 - e. Please 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;
 - 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.

The paper consists of 16 pages including this page

QUESTION 1

A new client, Clikaway Limited, advises you that some months ago it acquired a trade mark application for the mark JUST CLICK from a third party, Masterclick Limited. Your client produces an assignment document dated 1st May 2006 and says it has received from the previous owner the enclosed Examination Report dated 12th May 2006. Your client states that Masterclick Limited used the trade mark for around 6 months prior to your acquiring the mark, but only on a small scale, for a software platform providing content management and a communications system enabling insurance companies to collaborate and share information more efficiently and effectively, using on-line interactive websites. They also provided subscription access to such services via the Internet, support services and website creation. Your client will continue this business.

The filing details for your client's application for JUST CLICK are as follows :-

Application date : 1st February 2006.

Goods/Services :-

Class 9 – Computer software; platform software for communications networks; electronic publications (downloadable).

Class 16 – Printed matter; newsletters, magazines.

Class 35 – Provision of space on websites for advertising goods and services; on-line advisory and information services relating to the sale of professional products; the bringing together for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services from a general merchandise Internet website.

Class 38 – Telecommunications of information (including web pages), computer programmes and any other data; providing user access to the Internet, extranets and intranets; providing user access to communications platforms on the Internet, extranets and intranets; telecommunications portal services.

Class 42 – Creating and maintaining websites; hosting the websites of others; Internet content subscription services; providing subscription access to platforms for communications on the Internet, extranets and intranets; computer services.

Advise your client on the following:-

- i The nature of the objections in the Examination Report with reference to case law, how you recommend responding to the Report and the steps to be taken;
- ii The assignment;
- iii The risks generally.

25 marks

Examination Report

Absolute Grounds for Refusal (Section 3)

The application is not acceptable; there is an objection under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the words "Just" and "Click" conjoined, the whole being a sign which may serve in trade to designate a characteristic of the goods and services, e.g., computer software, programmes, services that are accessed by just clicking to launch the given applications/services.

Class 9 – Relative Grounds for Refusal (Section 5)

It is likely that the mark would be confused with the earlier mark listed below. There is therefore an objection under Section 5(2) of the Act.

(1), (2)

Class 16 – Relative Grounds for Refusal (Section 5)

It is likely that the mark would be confused with the earlier mark listed below. There is therefore an objection under Section 5(2) of the Act.

(3)

Class 38 – Relative Grounds for Refusal (Section 5)

It is likely that the mark would be confused with the earlier mark listed below. There is therefore an objection under Section 5(2) of the Act.

(1)

Class 42 – Relative Grounds for Refusal (Section 5)

It is likely that the mark would be confused with the earlier mark listed below. There is therefore an objection under Section 5(2) of the Act.

(1), (2)

- (1) UK Trade Mark : JUST A CLICK AWAY [Words]
Application Date : 20th December 1998
Registration Date : 18th September 2001
Registration No. 2220000
Goods/services : Class 38 – Mobile phone communication services; rental of mobile phones; providing access to the Internet.
Use claimed : Since November 1994
Proprietor: Glaxly Limited

- (2) Community Trade Mark
Trade Mark : JUST KLIX [Words]
Application Date : 2nd July 2005 (not yet published)
Application No. 444444
Goods/services : Class 9 – Computers, computer keyboards; printers for use with computers.
Proprietor: XXX Computer Inc.

- (3) UK Trade Mark : JUST KWICK [Words]
Application Date : 20th June 2001
Registration Date : 8th December 2003
Registration No. 2333333
Goods/services : Class 16 – Magazines relating to horseracing and greyhound racing.
Proprietor: YYY Publications Limited

QUESTION 2

You have received the following letter:

9 November 2006

Dear Sir,

You may instantly recognize my name. I am a world famous children's dress designer. In 1997 I received the OBE following my designs for the christenings of a royal baby and his siblings. My designs were used for children's clothing throughout the E.U. and the U.S.A. I was selling goods up to a value of £1m. every year. Every article bore my name "Sasha Bright" and the logo I adopted - a crown above a crib. Every fashion magazine featured my designs, and magazines such as the famous Hello magazine referred to Yummy Mummies having 'Sasha Bright' children. "Sasha Bright" clothing was sold through my company XXee Ltd.

The logo was designed for me by an advertising agency and though there have never been any written agreements between us, I paid the agency £1,000 personally and have always assumed it was mine since I have used it since 1996 without objection.

In 1998 I granted a company called Cuckoo Ltd a licence to use the logo only (not my name) in their manufacture of sleepwear for adults and children and my solicitors had them sign a licence agreement, although I do not think that Cuckoo Ltd ever followed its requirements. I never owned any trade mark registrations so was not concerned.

In November 2004 I went through a traumatic personal time during which my business went bankrupt. My company XXee was put into liquidation and sold with all its goodwill by the liquidator to a U.S. conglomerate, Wrath Corp.

Wrath Corp. have now started advertising that they will bring out a range of children's clothing under the mark SASHA BRIGHT and showing a label also using my logo. I have received five telephone calls, one from a former distributor, two asking whether I have entered a new licence and two telling me how similar the new clothing is to my styles and congratulating me on the new start.

I want to stop Wrath using my name and logo on clothing which I have not designed nor even seen before. Please advise me what actions we should take, if I have any problems in stopping this use and if there is anything I can do to improve my position.

Yours faithfully

Sasha Bright

You conduct a quick online search and discover that Cuckoo Ltd registered the Crown/crib logo. The application was filed on 3rd January 2005 in respect of 'pyjamas' in class 25.

Provide a memorandum explaining the issues on which you must advise Ms Bright together with your comments.

25 marks

QUESTION 3

You act for Abbots Holdings Inc who wish to open a chain of DIY and garden centre stores in the UK both selling own label products and trading under the name ABBOTS. The searches you carried out last month reveal a UK Trade Mark Registration:

United Kingdom registration:

Registration Number: 6740788
 Status: Registered
 Application date: 21 April 1980
 Registered: 06 June 1981
 Proprietor: Smit Trading GmbH (a German company)
 Agent: Stuart & Ball

Mark: ABBOTS

Goods:

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements (other than hand-operated); incubators for eggs.

Hand tools and implements (hand-operated); cutlery; side arms; razors.

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Following instructions from your client you commissioned an investigation into the use of the mark. This shows that Smit Trading GmbH is part of the Smit group of companies, the parent of which is Smit Holdings GmbH, another German company. Smit Holdings GmbH owns a number of subsidiaries worldwide including Smit (UK) Limited based in the UK. The investigator managed to get in touch with the Managing Director of Smit (UK) Limited who explained that the company specialises in the manufacture and sale of garden tools and garden furniture. All goods are manufactured in Germany. Smit (UK) Limited is the sole UK importer of these goods acting as wholesaler supplying ABBOTS goods to UK garden centres. Though part of the same Group, each of the companies operate as a separate business and all products purchased by Smit (UK) from Smit Trading GmbH are at arms length wholesale price.

The Managing Director of Smit explained that it used to import and sell a whole range of garden tools including electrical and diesel operated lawn mowers, hedge trimmers and chain saws together with the usual garden hand tools. It also sold a range of garden furniture. However due to competition from other big chains in the UK, business has not been doing well and it stopped importing and selling any goods in the UK in December 1998. However since the beginning of this year it has purchased over £300,000 worth of ABBOTS garden power tools from its sister company in Germany. To date Smit (UK) Ltd have not made any sales to retail

outlets but proposes to hit the market at Christmas in conjunction with a large advertising campaign.

Prepare a memorandum to the in-house lawyer at Abbots Holdings Inc advising the client on the issues involved with reference to relevant case law and what tactical action you should take now.

DO NOT ADDRESS the detailed rules regarding procedure.

25 marks

QUESTION 4

You act for Bolton Financial Services Company Limited, an insurance company based in Bolton that has been trading since 1986, offering a wide range of insurance products under the name "Bolton Financial Services" throughout the UK. Your client has taken no steps to register its trade mark.

It now wants to expand its operation and provide mortgage and pension services to its customers under the name BOLTON FINANCIAL SERVICES. However, a search that you have conducted reveals two registrations both owned by the company Equix Ltd as follows:

United Kingdom Registration:

Registration Number:	2787790
Status:	Registered
Filing Date:	9 February 1990
Registration Date:	5 November 1991
Mark:	BOLTON (word mark)
Class 9:	Computer software for accounting systems.
Class 16:	Printed matter.

United Kingdom Registration

Registration Number:	5162481
Status:	Registered
Filing Date:	29 March 2002
Registration Date:	11 January 2005
Mark:	BOLTON (word mark)
Class 9:	Computer software for accounting systems.
Class 16:	Printed matter.
Class 36:	Financial services; insurance services; banking services.

Investigations have revealed that Equix Ltd only provides a software package for accounting purposes under the mark BOLTON but has been doing so for six years.

Write a memo to your client on the risks of expanding its use, the further information that you will require and what action, if any, your client should take to protect its position.

25 Marks

QUESTION 5

Your client, Devil Jeans Limited, write to you as follows.

Devil Jeans Limited
1 Romford Way
Romford
Essex
ES1 8BD

Dear Sir

My company, Devil Jeans Limited, has registered various trade marks and details are on the schedule shown below.

I have recently discovered that Mama's Limited (Mama's) which manufactures and sells children's and baby wear is using the mark I AM A LITTLE DEVIL on babies' bibs. One of my suppliers showed me the Mama's Limited catalogue and a letter from Mama's Limited trying to get them to stock these bibs. As you can see from the schedule, we have a lot of registered trade marks in Class 25 for clothing and they all include the word DEVIL. We have been selling DEVIL jeans and sweatshirts for women for over 10 years and still use all the marks on the schedule. The "I AM A LITTLE..." marks are used specifically on a range of clothing for teenagers (14-17 year old market). Our clothes are stocked by all the major department stores. I think that Mama's are trying to rip me off and I would like you to send them a stern letter explaining that if they do not stop using this mark and any other mark like DEVIL on their baby bibs I will take the matter to a solicitor and bring a court action. I also want you to mention to them that you will be writing to some of their retailers and stockists and I have obtained this list from my contact above.

This is a very urgent matter and I need to hear back from you as soon as possible.

Yours sincerely,

Harvey Smith

Advise Harvey Smith in the form of a memorandum addressing the issues, commenting on the letter before action and what you recommend in any proposed form of undertaking.

25 marks

Schedule

1. Trade Mark: I AM A LITTLE [& picture of devil]
 UK Registration No: 1534211
 Filing Date: 28 April 1993
 Registration Date: 29 April 1995
 Classes: 18 and 25

(18) Articles of leather and imitations of leather; bags; belts.

(25) Clothing, footwear and headgear.

2. Trade Mark: I AM A LITTLE DEVIL
 CTM Registration No: 3802750
 Filing Date: 30 May 2000
 Registration Date: 3 August 2002
 Classes: 18, 25 and 26

(18) Articles of leather and imitations of leather; bags; belts.

(25) Clothing, footwear and headgear.

(26) Lace and embroidery; hair ornaments; fancy goods; buckles; badges.

3. Trade Mark: I AM A DEVIL
 CTM Registration No: 1061845
 Filing Date: 28 January 1999
 Registration Date: 25 March 2001
 Classes: 18, 25 and 26

(18) Articles of leather and imitations of leather; bags; belts.

(25) Clothing, footwear and headgear.

(26) Lace and embroidery; hair ornaments; fancy goods; buckles; badges.

4. Trade Mark: DEVIL
 UK Registration No: 2271532
 Filing Date: 5 January 2000
 Registration Date: 18 March 2003
 Class: 25

(25) Clothing, footwear and headgear.

QUESTION 6

You receive the following email from your client, in-house lawyer for TOWNSCAPE Limited (Estate Agents).

"Dear Trade Mark Attorney,

I need your help. I have received a watching notice for the mark TOWNSITE and details are attached. I have also attached a list of our trade mark registrations.

I asked marketing to give me background information on TOWNSITE and it appears that they are a construction company who have been around for over 14 years but have recently gone into estate agency. The deadline for opposing is 1 December and I am minded to instruct you to oppose. But what grounds would we have? Should we write first to their attorneys? What are the downsides of opposing? I presume that you will need the usual evidence but please specify and do you think I need to carry out a survey?

We have been going for 20 years now and a lot of people recognise the mark TOWNSCAPE. We use it in block capitals. As you know, we use other marks, TOWNWEB (our Internet sales service), TOWNCLEAN (our maintenance and cleaning service) and TOWNLOAN (our mortgage service). The prefix TOWN is important to us. Presumably we can appeal if we lose the opposition or wait and cancel the mark once registered? I would like to have chapter and verse on this problem including references to any relevant case law before my meeting with the Directors in a week's time.

Kind regards,

Charlotte"

Prepare a memorandum for your client covering all the issues, including evidence and possible grounds of objection.

N.B. For the purposes of this question, assume that the client's trade mark registrations are not vulnerable to revocation on the grounds of non-use of the marks.

25 marks

Watching Notice

Trade Mark: TOWNSITE

UK Trade Mark Application No: 4521031

Filing Date: 10 March 2006

Advertisement Date: 1 September 2006

Classes: 36 and 37

Services: (36) Financial services; real estate services; information and advisory services related thereto.

(37) Building construction; repair; maintenance; information and advisory services related thereto.

Applicant: Townsite Limited

Schedule

Trade Mark: TOWNSCAPE

Classes: 35, 36 and 37

Services: (35) Business management and administration of buildings, real estate and commercial and domestic property; business project management, advertising and promotion services; auctioneering services.

(36) Real estate agency services, real estate management; real estate appraisal; financial services; financial services relating to the administration, acquisition, investment, rental, leasing and letting of properties; financial consultancy and financial brokerage services.

(37) Construction, development, maintenance, repair, cleaning, renovation, restoration, demolition, upgrading and enhancement of buildings, real estate, commercial and domestic property.

Trade Mark: TOWNCLEAN

Classes: 37

Services: (37) Construction, development, maintenance, repair, cleaning, renovation, restoration, demolition, upgrading and enhancement of buildings, real estate, commercial and domestic property.

Trade Mark: TOWNLOAN

Classes: 35 and 36

Services: (35) Business management and administration of buildings, real estate and commercial and domestic property; business project management, advertising and promotion services; auctioneering services.

(36) Real estate agency services, real estate management; real estate appraisal; financial services; financial services relating to the administration, acquisition, investment, rental, leasing and letting of properties; financial consultancy and financial brokerage services.

Trade Mark: TOWNWEB

Classes: 35 and 36

Services: (35) Business management and administration of buildings, real estate and commercial and domestic property; business project management, advertising and promotion services; auctioneering services; architectural and building design services and road surveying; consultancy and information and advisory services; computer related consultancy and advisory services for the infrastructure and computer systems consultancy, information regarding operating and maintaining computer programmes regarding information on real estate services and advisory services.

(36) Real estate agency services, real estate management; real estate appraisal; financial

services; financial services relating to
administration, acquisition, investment, rental
leasing and letting of properties; financial
consultancy and financial brokerage services.