

THE JOINT EXAMINATION BOARD
PAPER T4
ADVANCED TRADE MARK SEARCH

Tuesday 7th November 2006

10.00 a.m. – 1.00 p.m.

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

1. This paper consists of a single question for which there are **100** marks
2. Please note the following:
 - a. Enter the Paper Number (T4) and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - b. 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 highlighters in your answer;
 - c. Do not staple or join pages together in any way;
 - d. Do not state your name anywhere in the answers;
 - e. Write clearly, as examiners cannot award marks to scripts that cannot be read;
 - f. Reasoning should always be given where appropriate.
3. 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.**
4. **At the end of the examination assemble your answer sheets in order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

This paper consists of 12 pages including this page.

Your client is Togo Telecom, a Société anonyme of Paris, France. 1999 Togo Telecom has used as a logo the trade mark TOGO TELECOM in France, Germany and the United Kingdom for the provision of low cost telephone calls from mobile and touch-tone telephones by way of a prepaid account and encoded cards. This business has been extremely successful with a significant and increasing number of customers having been obtained in all of these countries since 1999.

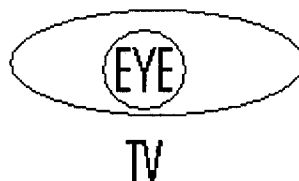
In January 2002 Togo Telecom entered into a manufacturing agreement with a Germany company, Schmidt Telecom AG of Dusseldorf, to produce for it a mobile telephone, cases for mobile telephones, stands for mobile telephones and telephone apparatus for cars bearing its trade mark TOGO TELECOM. Unfortunately for Togo Telecom these goods failed to meet the required quality standards and the manufacturing agreement with this German company was terminated in October 2003. After October 2003 these goods were manufactured for Togo Telecom in China. Despite the initial problems, sales of these goods have been significant in the United Kingdom since January 2002.

In March 2005 your client launched a broadband telecommunications service in the United Kingdom and started selling in the United Kingdom high capacity broadband telecommunications apparatus using its trade mark TOGO TELECOM.

Your client has already applied for registration of its TOGO TELECOM Logo as a Community Trade Mark. This is application number 4992367. It has been used continuously in this form since 1999.

Togo Telecom now wishes to use and register the word TOGO (ie not in a logo form and without the word Telecom) and intends to open retail stores in the United Kingdom for the sale of its telecommunications and telephone apparatus.

In December 2005 your client launched a new telephone incorporating a camera and commenced providing a data and image transfer service using the logo EYE TV in the form shown below.



The client is also currently intending to launch a new telephone handset using the trade mark MIA.

You have carried out searches against the following marks, the results of which are attached:

1. TOGO –

Class 9 – Mobile telephones, cases for mobile telephones, stands for mobile telephones, telephone apparatus for cars, encoded telephone cards, broadband telecommunications apparatus.

Class 35 – Retail services connected with the sale of telecommunications and telephone apparatus.

Class 38 – Telecommunications services, telephone communication services, transfer of data and images by telephone.

2. EYE TV (logo as shown above) –

Class 9 – Telephones incorporating cameras.

Class 38 – Telephone communication services, data and image transfer services.

3. MIA –

Class 9 – Telephone handsets.

A search of the Internet reveals that Togo is a country on Africa's west coast.

Write a letter to your client advising on its freedom to use and register the above three trade marks in United Kingdom for the goods and services for which the searches have been undertaken and indicating any steps which they may take to overcome potential difficulties.

[100 marks]

No/ Dates	Trade mark	Information	Goods/services	Owner
8895 App: 1 October 1986 Reg: 8 November 1991		Use claimed from the year 1980 Section 12(2). A Debuture in favour of Grandbank, N.A. (the "Collateral Agent") dated 2 August 1998. The Debuture contains a fixed charge over the trade mark, and prohibits the Registered Proprietor from inter alia doing the following without the consent of the Collateral Agent: i) Change the specification referred to or permit any disclaimer, condition, restriction, memorandum or other thing to be entered on the registration which will be to materially adversely affect the value of the trade mark; ii) Assign, sever, dispose of or otherwise part with control of its trade mark or grant any licence to any person to use the same in any manner which will materially adversely affect the value of the trade mark.	Class 9: Tapes, audio and video cassettes, video films. Class 35: Arrangement and production of radio and TV programs as commercials; publication and editing of advertising texts; services of a franchiser, namely assistance with business management as well as sales promotion; merchandising of copyrights and industrial rights for third parties. Class 38: Telecommunications; planning, arrangement, production and broadcast of radio and TV programs; transmission and forwarding of TV programs.	ENT Brandt GmbH & Co KG Richard-Byrd-Strasse 23, Cologne D-50961 Germany

UK 2148833 App: 23 August 1996 Reg: 7 May 1999 Unpaid renewal	TEGO			Class 9: Mounting and wiring equipment for electrical installations or automation components; signalling units, cabling and connectors; telecommunications apparatus and instruments, cabling for telecommunications apparatus and instruments.	SCA Electric Industries SAS 99 Boulevard Franklin Roosevelt 92500 Rueil-Malmaison France
CTM 4918843 App: 20 February 2006 Priority: 78\714793, 16 September 2005, USA. Pending	TUGO			Class 9: Headphones that incorporate a MP3 player; cases for headphones, audio and telecommunications equipment.	CSFD Corporation North Port Washington Road 8529 Milwaukee, 53227 Wisconsin United States
UK 2235388 App: 8 June 2000 Reg: 22 June 2001	 	The applicant claims the colours gold, white, green and grey, as an element of the first mark in the series.		Class 9: Control apparatus and instruments, all for the control of electrical apparatus and installations; electrical switch gear and electric switches; security apparatus and instruments; electrical circuit apparatus and instruments; electrical control panels; parts and fittings for all the aforesaid goods. Class 11: Apparatus and instruments, all for lighting, heating and ventilating; parts and fittings for all the aforesaid goods.	Delmatic Ltd 117 Cleveland Street London W1P 5PN
CTM 3108628 App: 28 March 2003 Pending	Togo Direct			Class 9: Apparatus for recording, transmission or reproduction of sound or images; prepaid calling cards. Class 35: Advertising. Class 38: Telecommunication.	Vectone Ltd 58 Marsh Wall London E14 9TP

UK 2328780 App: 4 April 2003 Reg: 23 January 2004	3toGo		Class 9: Telecommunications equipment; mobile telephones, stands for telephones, telephone ear pieces; point of sale hardware and software providing electronic top-up pre-payment of air time on pre-pay mobile phones; operating system programs; parts and fittings for all the aforesaid goods. Class 38: Telecommunications services; provision of an electronic mobile telephone top-up system; electronic and telecommunication transmission services; electronic mail services; providing user access to the Internet (service providers); providing telecommunications connections to the Internet or databases; teletext services; all the aforesaid services also provided on-line from a computer data base or from the Internet.	Palmerston Ltd 2nd Floor Sixty Circular Road Douglas Isle of Man
UK 2409077 App: 15 December 2005 Reg: 23 June 2006	Step Outside With Togo & Nogo		Class 9: CDs, DVDs, videos, electronic publications, all relating to road safety. Class 41: Education services relating to road safety.	Manchester City Council P O Box 532 Town Hall Albert Square Manchester M60 2LA
CTM 4992367 App: 2 April 2006 Priority: 27 November 2005, France 873765 Pending		Colours claimed: Red, green, black.	Class 9: Mobile telephones, cases for mobile telephones, stands for telephones, telephone earpieces; facsimile, telex, telephone, telegram, data acquisition installations, apparatus and instruments; point of sale hardware and software providing electronic top-up pre-payment of air time on pre-pay mobile phones; operating system programs. Class 16: Printed publications; instruction manuals for mobile telephones; vouchers. Class 38: Telecommunications.	Togo Telecom (Société anonyme) Immeuble Colisée IV 115 Rue Fructidor F-78926 Paris Cedex 17 France

M887648 Reg: 23 March 2006 Originating country and registration: DE (Germany) – 16 December 2005 - 30562749.4/07 Priority: 16 December 2005 Designations and status: EM – Community (Grant of protection subject to opposition – 31 August 2006. Advertised 4 September 2006.) GB – United Kingdom (Notice of partial refusal – 2 October 2006. Pending.)		Colours claimed: Red, green, black.	Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for token operated apparatus; telephones; computers; sunglasses. Class 18: Bags, luggage. Class 35: Advertising and publicity; commercial business management; commercial administration; office work. Class 38: Telecommunications.	Schmidt Telecom AG Bennigsenplatz 237 40499 Dusseldorf Germany
CTM 1011642 App: 9 December 1998 Reg: 12 September 2000	TO-GO		Class 34: Cigarette papers; tobacco.	John Player & Sons Ltd South Circular Road Dublin 8 Ireland
CTM 1083385 App: 22 February 1999 Reg: 12 September 2000	GOTO.COM		Class 42: Providing access by means of an electronic communication network to information and data; electronic navigation, directory and referral services.	Go2 Systems, Inc 18400 Von Karman Avenue, Suite 320 Irvine, California 92612 United States of America

2. EYE TV LOGO

Trade mark No/ Dates	Trade mark	Information	Goods/services	Owner
UK 2118267A App: 11 December 1996 Reg: 2 September 1999	ITV	Registered on the basis of acquired distinctiveness.	Class 9: Audio, video and audio-visual recordings; cinematographic films; cine films; magnetic and optical disks, computer programmes; apparatus for the recording, reproduction or transmission of sound; televisions, television signal receivers, aerials; parts and fittings for all the aforesaid goods. Class 38: Television broadcasting services; cable television broadcasting services; satellite television broadcasting services; transmission of television programmes; subscription television broadcasting services; videotext and teletext services; transmission of data and images; information and advisory services relating to all the foregoing services. Class 41: Production, presentation, syndication and networking of television programmes.	ITV Network Ltd 200 Gray's Inn Road London WC1X 8HF
UK 2173257 App: 27 July 1998 Reg: 2 October 1999			Class 9: Communications apparatus and instruments; computer software including software enabling searching of data; data processing equipment and computers, software to enable remote access to audio/visual presentations. Class 38: Telecommunication of information (including web pages), computer programs and any other data; electronic mail services; provision of telecommunications access and links to computer databases, databanks and on the Internet; provisions of live, pre-recorded or	Marchcom Co UK Ltd The Ideas Building 179 London Bridge Studios Kingston-upon-Thames Surrey KT2 6PW

			stored presentations/ briefings via cable, Internet or telephone line. Class 42: Compilation of databases and databanks; providing access to and leasing access time to computer networks.	
UK 2125489 App: 16 February 1999 Reg: 17 November 2001			Class 9: Apparatus and instruments for recording, transmission or reproduction of sound, images or encoded data; electronic publications (downloadable) provided on-line from computer databases or the Internet; electrically, magnetically and optically recorded data for computers; sound, video and data recordings	Living Eye TV Plc 3 Grosvenor Square London SW1 4BB
UK 2333740 App: 2 June 2003 Reg: 5 December 2003	EYE-T		Class 9: Computers; computer apparatus and instruments; modems.	Christina Tsai Unit 19 & 20, Trafford Park, Manchester, M17 P1A
UK 3861341 App: 26 May 2004 Reg: 27 September 2005	EYE		Class 9: Computer hardware; computer and video game apparatus; computer game consoles; computer and video games; computer video game programmes; computer software; computer peripherals; audio and video tapes; cassettes; magnetic data media; compact discs; video discs; DVDs; audio and video recordings; cinematographic films; electronic apparatus and instruments all for use in computer and video gaming; optical apparatus and instruments for use in gaming; cameras; films; audio and video apparatus; sunglasses; spectacles; sunglasses and spectacles frames; parts and accessories for all the aforesaid goods. Class 28: Toys, games and playthings; hand-held electronic games.	Sony Computer Entertainment Europe Limited 30 Golden Square, London, W1F 9LD

CTM 4373891 App: 5 April 2005 Pending	TV EYE		Class 38: Broadcasting; communications and telecommunications; broadcasting and transmission of television, radio, cable, satellite and internet programmes; telecommunication of information (including web pages), computer programs and any other data.	Living Eye TV Plc 3 Grosvenor Square London SW1 4BB
UK 2434461 App: 20 June 2006 Pending	 MAGIC EYE		Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images.	Mind the Doors Limited Gordley Industrial Estate, Lancashire M43 5PT
CTM 4741556 App: 1 January 2006 Advertised: 4 October 2006	EYE		Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus. Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.	Eyecam A.G. Furterstrasse 44, Cologne 4461 Germany

3. MIA

Trade mark No/ Dates	Trade mark	Information	Goods/services	Owner
UK 2199153 App: 4 January 1999 Advertised: 13 March 2001 Opposed	MYA ANG		Class 9: Computer hardware and computer games software; sunglasses; mobile phones and covers therefor. Class 42: Computer hardware and software consultancy services; computer software design services; computer software application management services; graphic design services.	Mya Ang Limited 3200 Daresbury Park, Daresbury, Warrington, Cheshire, WA4 4BU
UK 2129474 App: 10 April 1997 Reg: 24 May 2000	MIA		Class 9: Computer and video games; computer and video game programs.	Psygnosis Limited Napier Court, Stephenson Park, Liverpool, L13 1HD
CTM 515304 App: 10 April 1997 Reg: 14 December 2001	MIA		Class 9: Apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, sound recording discs; computer and video games.	Psygnosis Limited Napier Court, Stephenson Park, Liverpool, L13 1HD
M822435 Reg: 2 February 2001			Class 38: Telecommunications services; messaging, text and SMS services. Class 43: Restaurant, café and bar services and information services therefor.	Missing In Action GmbH 16/1, Giselherstrasse, D- 8000 MUNCHEN 40 Germany
UK 2132006 App: 26 September 2003 Reg: 20 January 2005	MEAR	Registered on the basis of acquired distinctiveness.	Class 35: Sale of mobile phones, parts, fittings and accessories therefor. Class 38: Telecommunications services, by fixed and mobile phone; messaging, text, fax and SMS services.	Mobilio UK Ltd. 12 Dean Street, London W1 4GT

UK 2216897 App: 17 September 2006 Pending	M1A FONES		Class 9: Mobile phones, covers, cases, batteries, leads, chargers and ringtones therefor. Class 35: Sale of mobile phones, parts, fittings and accessories therefor and ringtones. Class 38: Mobile communications services; sms and text messaging services.	M1A Fones Limited London Gateway Estate Junction M1A Staples Corner London NW16 2PJ
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