

THE JOINT EXAMINATION BOARD

PAPER T3 – TRADE MARK LAW AND PRACTICE

Thursday 8th November 2012

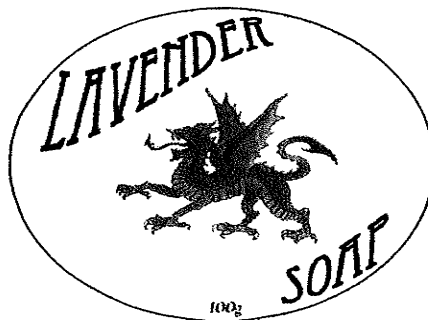
10.00 a.m. – 2.00 p.m.

*Please read the following instructions carefully. Time Allowed – **4 HOURS***

1. You should attempt **FOUR** questions. All questions carry **25 marks**.
2. The marks awarded to each question are shown at the foot of the question. If more than the required four questions are answered only the first four presented will be marked.
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 highlighters in your answer;
 - d. Do not state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. Reasoning should always be given where appropriate.
 - g. You must number all the pages of your answer script. Once the exam finishes, an additional 5 minutes will be allowed for you to do this.
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, number all the pages and put them in the WHITE envelope provided.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

QUESTION 1

You act for Bibar Limited, a leading manufacturer of personal care products. Your client has recently launched a new range of 6 luxury soaps, each with a different scent. The labelling of the range is quite simple, with the main label featuring the name of the variety and a related image. Your client's name appears on the packaging, but only in fairly small letters on the back label. The label of your client's lavender soap is shown below. Your client explains that the lavender in the soap comes from Wales and the red dragon on the label is used to indicate this connection. The labelling of their other products follows the same theme – their heather-scented soap bears a Scottish thistle for example.



Your client has been contacted by Idris Jones Limited, a traditional Welsh soap manufacturer whose products all bear a red dragon logo. Idris Jones Limited claim that your client's use of a red dragon device on soaps will result in confusion with their soaps and they intend to sue your client for trade mark infringement unless your client changes its packaging.

Idris Jones Limited is based in Chepstow in Wales, close to the English border. Their advertising makes much of the company's Welsh heritage, although in 2009 they moved their manufacturing operation to a larger site just over the border in England, a few miles from their headquarters in Chepstow.

Further investigation reveals that Idris Jones Limited has been using the same dragon logo on their soaps since 1998. Their dragon logo is registered as a UK trade mark registration:

Registration No.: 2115665



Trade Mark:

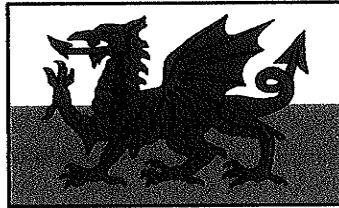
Goods: Class 3: Soaps;

Registration Date: 4 April 1998

Proprietor: Idris Jones Limited

Red dragon motifs are used on a variety of Welsh products, but no-one else besides Idris Jones Limited and your client is using red dragon motifs in relation to soap.

(The red dragon is a symbol of Wales, and a red dragon appears on the Welsh flag – image below).



Advise your client on:

1. The grounds available to Idris Jones Limited to prevent use of the packaging of your client's soaps, including consideration of any defences available. **(17 marks)**
2. Any counter-claims that could be made against Idris Jones Limited's trade mark registration, including an assessment of the likelihood of success. **(8 marks)**

Do not consider copyright or Trade Descriptions Act issues in your answer

QUESTION 2

You act for Geoffrey Duthoit, a tailor specialising in men's suits. Mr Duthoit began making suits in 1985 and went on to enjoy considerable success during the 1990s when his GEOFFREY DUTHOIT bespoke suits, which sold for £2000-£3000 each, were worn by many celebrities.

For tax reasons, in 1997 Mr Duthoit set up GDT Limited, an English company, and transferred all of his business' assets, including the business' goodwill, to the company.

In 1998 Mr Duthoit decided to exploit the fame of his bespoke suits by launching a range of off-the-peg suits, selling for £200-£300 each. At the same time, he registered the trade mark below:

Trade Mark: GEOFFREY DUTHOIT

Proprietor: GDT Limited

Registration No.: 2126876

Goods: Class 25: Clothing; men's ready-made and bespoke suits

Registration date: 15 September 1998

Between 1999 and 2002 GDT Limited produced several lines of off-the-peg (ready-made) suits, which sold in reasonable numbers. During this time Mr Duthoit, trading through GDT Limited, continued to produce bespoke suits for wealthy clients.

The off-the-peg venture ultimately proved unsuccessful and GDT Limited was forced into receivership in 2003. The company, together with all its assets including the above trade mark registration, was sold by the receiver to the *Laburnum* department store chain, which planned to launch its own range of off-the-peg suits under the GEOFFREY DUTHOIT brand.

Laburnum initially proved keen to work with Mr Duthoit and he was taken on as a consultant, advising on the design of the new suits and appearing in their advertising. Although Laburnum had no interest in producing bespoke suits themselves, they were happy for Mr Duthoit to continue to operate a business producing bespoke suits under the GEOFFREY DUTHOIT mark, since this was felt to be beneficial to the image of the brand. Laburnum granted Mr Duthoit a licence to use the GEOFFREY DUTHOIT mark. The licence was a very simple document, granting Mr Duthoit permission to use the trade mark in relation to bespoke suits in exchange for a nominal royalty (£10 per annum). The licence did not contain any provisions on quality control, and the royalty was never collected.

At the end of 2011, Laburnum decided to take the GEOFFREY DUTHOIT brand in a new direction, bringing in younger designers for the 2012 collection. They did not renew Mr Duthoit's contract as a consultant. When Laburnum's 2012 GEOFFREY DUTHOIT collection was unveiled in September 2012 Mr Duthoit was horrified – the style was very different from his own and he couldn't bear to be associated with the

range, although lots of people assumed he had designed it. He wrote an article for a fashion magazine, criticising the new range and seeking to distance himself and his bespoke suits from Laburnum's products.

When Laburnum read the article they were furious and wrote to Mr Duthoit cancelling his trade mark licence and threatening to sue him if he continued to use the GEOFFREY DUTHOIT name for suits.

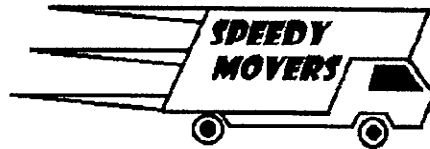
Advise Mr Duthoit on:

1. What action Laburnum could take to stop his use of the GEOFFREY DUTHOIT name and whether he has any defences available. **(13 marks)**
2. Whether there is anything Mr Duthoit can do to cancel Registration No. 2126876. **(9 marks)**
3. Whether anything can be done to prevent Laburnum using the GEOFFREY DUTHOIT name on their clothing range. **(3 marks)**


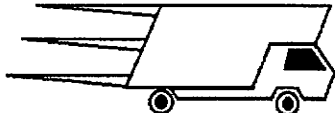
(Ignore any issues of defamation or malicious falsehood)

QUESTION 3

You act for Speedy Movers Logistics Limited, one of the UK's best known removals companies with a reputation for speed and reliability. First used in 1998, Speedy Movers' logo (shown below) is well known for removal services, and appears on all of your client's removals vehicles, staff uniforms and in its advertisements.



Your client owns the following UK Trade Mark Registrations:

Registration No.	Mark	Registration Date	Goods and Services
2132555		6 October 1999	Class 39: Transport; packaging and storage of goods; removal services
2437132		17 May 2005	Class 39: Transport; packaging and storage of goods; removal services
2332456	SPEEDY MOVERS	2 June 2003	Class 39: Removal services

Your client has recently learnt that Wlazlo sp.o.o., one of the Europe's largest haulage companies has decided to launch in the UK, offering removals services. Wlazlo have launched their new offer with an advertising campaign featuring the following advertising straplines:

1. "Be a really speedy mover with Wlazlo"
2. "Every move's a speedy move with Wlazlo"

Wlazlo have adopted a new logo for their UK business, which is shown below.



Your client is reliably informed that the advertising agency which came up with the advertising campaign and new logo for Wlazlo's removals business was instructed to get across the message that Wlazlo's service was every bit as good as Speedy Movers'.

Advise your client on:

1. The possible grounds for bringing an action to stop Wlazlo's use of the two advertising straplines, including a consideration of the chances of success. **(9 marks)**
2. The possible grounds for bringing an action to stop Wlazlo's use of the new Wlazlo logo, including a consideration of the chances of success. **(16 marks)**

(Ignore copyright issues)

QUESTION 4

Mr R Fletcher approaches you with a trade mark query as follows: "For years I have been making sauces and marinades for friends. I started selling them at the start of this year and managed to sell a few. In March 2012, I was the subject of a television documentary about entrepreneurs in their sixties and I made sure to plug my fantastic range of HOWZAT sauces and marinades. I managed to persuade the supermarket chain Tesbury's to stock the product and ever since the programme, both the HOWZAT sauces and marinades have been flying off the shelves.

On 1 October 2012, I filed a United Kingdom trade mark application as follows:

Mark: HOWZAT

Goods: Retail of cooking sauces and marinades.

Class: 35

On 8 October 2012 I realized that although I had given my address I forgot to say that the application was in my name, so I wrote to the IPO to confirm this. On 9 October 2012 I had a sudden panic that I had not given a declaration that the mark was in use in relation to the goods, so I wrote again to the IPO to confirm this. When do I pay the application fee?

I have just learned that a company called Conroy Limited have filed a United Kingdom trade mark application of their own, for the mark OWZAT! covering spices, condiments and sauces in Class 30. The application has been given a filing date of 3 October 2012. Conroy Limited have been trying to get me to sign a distribution agreement ever since the television programme in March but I have always refused. I want to oppose this application and I assume I have given myself a solid basis for opposition by filing my own application?"

Advise Mr Fletcher on:

1. Any objections to his application that the UK IPO is likely to raise, explaining the IPO's law and practice in this regard and the consequences of non-compliance. **(4 marks)**
2. His possible grounds of opposition to the OWZAT! application and the chances of success. **(13 marks)**
3. The possible grounds of opposition to the HOWZAT application that could be raised by Conroy Limited. **(8 marks)**

QUESTION 5

You act for Mr Jones. Mr Jones owns a United Kingdom trade mark registration for the mark MISTER CUPID as follows:

Mark: MISTER CUPID

Registration No. 2333445

Registration Date: 1 October 2003

Goods: Online messaging services in Class 38

Your client initially used his mark as the name of an online messaging service for students at the University of Penzance, which is in the town of Penzance in the far west of England. To promote the launch of the service in 2003, he gave away plush teddy bears to students at the university, with the mark MISTER CUPID on the bear's chest and on a label attached to the teddy bear. The messaging service did not prove successful and was discontinued in January 2005.

The teddy bear proved so popular that Mr Jones started selling bears under the mark MISTER CUPID to students at the university. The bear has attracted a cult following and continues to sell well in the university's campus shops and at its freshers' fairs.

In February 2010 your client ran a Valentine's Day party at the University of Penzance called MISTER CUPID in which he set up students on blind dates. Your client has decided to launch an online dating website for Penzance students under the MISTER CUPID mark. If this is successful he will roll out the teddy bears and dating site to universities throughout the United Kingdom. He has had searches conducted and discovered the following United Kingdom trade mark registration:

Mark: CUPID

Registration No. 2561810

Application date: 1 April 2011

Registration date: 1 December 2011

Owner: Wedwel Limited

Class 28: Toys, games and playthings.

Class 42: Providing online forums for transmissions of messages among computer users

Class 45: Planning and arranging of wedding services.

Investigations reveal that Wedwel Limited do not currently operate in the UK.

Advise your client on:

1. Whether there is any infringement risk for his use of the mark MISTER CUPID for teddy bears in Penzance and elsewhere in the UK, and for a dating website in Penzance and elsewhere in the UK. **(12 marks)**
2. Whether there is any action he could take against the registration for CUPID held by Wedwel Limited. **(13 marks)**

QUESTION 6

You are approached by an individual named Fabrizio Elano.

A company called Ogan Limited make a very successful tennis racquet. It is normal in shape but, unlike most tennis racquets, the strings on Ogan's racquet are not arranged in a check pattern but rather in an unusual series of triangles. These allow the racquet to be swung through the air more efficiently and impart greater spin on the ball. As a result, they are now used by most top tennis players in the world. Rival manufacturers have found other ways of achieving the same result with different string patterns on their racquets. Ogan own a United Kingdom trade mark registration for the triangle pattern of the strings as applied to tennis racquets as follows:

Registration No. 2429874

Registration date: 2 April 2008

Goods: Tennis racquets in Class 28

Mr Elano has recently started selling badminton racquets in which the strings are arranged in the same triangle pattern used by Ogan. The racquets feature his name Fabrizio Elano on the handle. On his packaging appears the slogan "Smash it like a tennis ball". He has received a letter from Ogan's in-house counsel demanding that he cease use of Ogan's registered trade mark or Ogan will be forced to take legal action.

1. Advise Mr Elano whether the sale of Mr. Elano's badminton racquets infringes the Ogan trade mark registration, any defences or counterclaims that might be available to Mr. Elano, and your view on the prospects of success for Ogan. **(15 marks)**
2. Advise Mr Elano on whether you consider Ogan to have a passing off case against him and discuss any defences or counterclaims that might be available to Mr. Elano, including your view on the prospects of success for Ogan. **(10 marks)**