

**THE JOINT EXAMINATION BOARD
PAPER P7**

Principles of Trade Mark Law

Tuesday 9th November 2010

3.00 – 5.00 p.m.

*Please read the following instructions carefully. **Time Allowed – 2 HOURS***

1. You should attempt **eight of Questions 1 to 9** in Part A and **five of Questions 10 to 15** in Part B.
2. Each question in Part A carries a maximum of five marks and each question in Part B carries a maximum of twelve marks. The marks awarded to each question are shown at the foot of the question. If more than the required 8 questions are answered in Part A or more than the required 5 questions are answered in Part B, only the first 8 or 5 respective answers 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 (P7), 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.
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.** 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.

This paper consists of five sheets, including this one.

PAPER P7

Principles of Trade Mark Law

Section A

1. List five defences to infringement of a UK registered trade mark set out in the UK Trade Marks Act 1994, s. 11 (Limits on effect of registered trade mark).

5 Marks

2. What criteria does Section 10(3) of the UK Trade Marks Act 1994 set for infringement of a registered trade mark where that trade mark has a reputation in the United Kingdom.

5 Marks

3. (a) How does the UK Trade Marks Act 1994, s. 1 define a trade mark?

(3 Marks)

- (b) Give two examples of different types of trade marks.

(2 Marks)

5 Marks

4. (a) What is meant by 'exhaustion of rights' in relation to supply of goods using a trade mark?

(2 Marks)

- (b) Under what circumstances can the proprietor of a Community or United Kingdom trade mark prohibit further commercialisation of the goods under the trade mark, notwithstanding an exhaustion of rights provision.

(3 Marks)

5 Marks

5. (a) Outline the requirements for a successful passing off action.

(3 Marks)

- (b) Who has the right to prevent passing off?

(2 Marks)

5 Marks

PAPER P7

Principles of Trade Mark Law

6. Who is entitled to be an Applicant for a Madrid Protocol application?

5 Marks

7. (a) Under the UK Trade Marks Act 1994, s. 24 (Assignment, &c of registered trade mark), what is required for an assignment of a registered trade mark to be effective?

(2 Marks)

- (b) Under the UK Trade Marks Act 1994, s. 25 (Registration of transactions affecting registered trade mark), who may register a transaction?

(1 Mark)

- (c) What are the benefits of the new owner registering an assignment?

(2 Marks)

5 Marks

8. In the context of a Community Trade Mark, what is meant by the term "Seniority"?

5 Marks

9. List the grounds for opposition to a UK trade mark application, based on Trade Marks Act 1994 s. 5 (Relative grounds for refusal of registration).

5 Marks

PAPER P7

Principles of Trade Mark Law

PART B

10. (a) What do you understand by the terms (i) exclusive licence; (ii) sole licence and (iii) non-exclusive licence?

(3 Marks)

(b) Under what circumstances may several exclusive licences exist for a single trade mark?

(2 Marks)

(c) What rights does an exclusive licensee have under a UK registered trade mark to bring infringement proceedings?

(4 Marks)

(d) What rights does a licensee have under a Community Trade Mark registration to bring infringement proceedings?

(3 Marks)

12 Marks

11. Under the UK Trade Marks Act 1994, s. 47 (Grounds for invalidity of registration):

(a) outline the absolute grounds under which a trade mark registration may be declared invalid; and

(b) outline any qualifications to these grounds.

12 Marks

12. (a) Explain how a UK Trade Mark Application is examined on the basis of relative rights and the notification system?

(4 Marks)

(b) (i) Who may file opposition to a United Kingdom Trade Mark application and are there any limitations to the grounds on which an opposition may be filed?

(1.5 Marks)

PAPER P7

Principles of Trade Mark Law

(b) (ii) What is the time limit for filing opposition, is the period extendable and from what date does it run?

(1.5 Marks)

(c) On what grounds may a United Kingdom Trade Mark registration be revoked?

(5 Marks)

12 Marks

13. Write notes comparing Transformation under the Madrid Protocol and Conversion under the Community Trade Mark Regulation.

12 Marks

14. Outline the tests set down in the reported cases *Sabel BV v. Puma AG* and *Cannon v Metro-Goldwyn Meyer* for comparing marks for confusing similarity and the effect of enhanced distinctiveness of a mark under consideration. Outline the tests laid down in *Windsurfing Chiemsee* regarding acquired distinctiveness.

12 Marks

15. (a) What infringing acts are prohibited under Article 9 of the Community Trade Mark Regulation?

(6 Marks)

(b) When do the proprietor's rights commence and from what date may compensation be claimed?

(2 Marks)

(c) What are the so called 'Cascade criteria' of the Community Trade Mark Regulation when deciding where to commence action for infringement of a Community Trade Mark?

(4 Marks)

12 Marks