

THE JOINT EXAMINATION BOARD

PAPER P7 – Principles of Trade Mark Law

Thursday 8th November 2012

3.00 p.m. – 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. The marks awarded to each question are shown at the foot of the question and sub-question where applicable. If more than the required number of questions are answered only the first 8 presented in Part A or the first 5 presented in Part B 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.
 - 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.

THIS PAPER CONSISTS OF FIVE SHEETS INCLUDING THIS PAGE.

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PART A

1(a) How does the UK Trade Marks Act 1994 s. 1 (Trade Marks) define a trade mark? *2 marks*

1(b) List six examples of what a trade mark may consist of. *3 marks*
5 marks

2. According to the Trade Marks Act 1994 s. 32 (Application for Registration), what are the necessary contents of an application to register a trade mark in the United Kingdom?
5 marks

3. What acts constitute use of a sign for the purposes of the Trade Marks Act 1994 s. 10 (Infringement of Registered Trade Mark)?
5 marks

4. How does the Trade Marks Act 1994 s. 6 (Meaning of 'earlier trade mark') define an earlier trade mark?
5 marks

5. In the official search of a UK trade mark application, the Examiner has found earlier UK national trade marks of potential relevance.
(a) What actions will the Examiner take? *2.5 marks*
(b) What actions, if any, may the applicant take? *2.5 marks*
5 marks

6. List the types of transactions that may be registered under the Trade Marks Act 1994 s. 25 (Registration of transactions affecting registered trade mark).
5 marks

7(a) A UK trade mark application was filed on 2 January 2003 and the mark was registered on 3 June 2004. **On what date is the first renewal fee due?** Explain the basis of your calculation. *2 marks*

7(b) In relation to the due date for renewal of a UK trade mark registration, when may the renewal fee be paid without additional fees? *1 mark*

7(c) What period is prescribed for late payment of a renewal fee on a UK trade mark registration? What are the consequences if the fee is not paid? (*Do not discuss restoration.*) *2 marks*
5 marks

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8 According to the Trade Marks Act 1994 s. 25 (Registration of Transactions Affecting Registered Trade Mark), what are the adverse effects of not registering a transaction?

5 marks

9. List the grounds of opposition to a Community Trade Mark application.

5 marks

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PART B

10. Durrant Boatyard Ltd have been manufacturing FAIRSHORE boats in the United Kingdom since 1960. They have acquired a reputation in their high quality FAIRSHORE boats, but have never registered FAIRSHORE as a trade mark in the United Kingdom. However, after recent successful sales in the USA, they filed a US trade mark application on 8 June 2012 for FAIRSHORE, covering boats.

They have contacted you for advice because it has been drawn to their attention that a company called Pirates of Penzance Ltd have filed an application to register FAIRSHORERS. Register searches reveal a United Kingdom trade mark application for FAIRSHORERS for canoes in class 12 and plastic boating shoes in class 25 filed in the name of Pirates of Penzance Ltd on 27 June 2012 and advertised for opposition purposes on 1 November 2012.

Write to Durrant Boatyard Ltd:

- (a) advising them how they might improve their position; 2 marks
- (b) outlining possible grounds upon which they could rely in opposition against FAIRSHORERS; and 7 marks
- (c) indicating the prospects of success. 3 marks
- 12 marks**

11. Outline the tests set down in the reported cases *Sabel BV v. Puma AG* and *Canon v. Metro-Goldwyn Meyer* for comparing marks for confusing similarity and the effect of enhanced distinctiveness of a mark under consideration. 12 marks

12. In relation to a Community Trade Mark, list the requirements for claiming:
(i) priority, and
(ii) seniority
of an earlier mark.
Summarise the effects of such claims. 12 marks

13. List the grounds for:
(i) revocation, and
(ii) invalidity
of a Community Trade Mark.
Summarise any qualifications or limitations on particular grounds. 12 marks

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14. Write notes comparing Transformation under the Madrid Protocol and Conversion under the Community Trade Mark Regulation. **12 marks**

15.(a) List the order of preference between Community Trade Mark Courts, according to the Community Trade Mark Regulation Article 97 (International Jurisdiction) (the "Cascade Principle"). *7 marks*

15.(b) Who is entitled to be an Applicant for a Madrid Protocol application? *5 marks*

12 marks