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5 October 1993

BY FACSIMILE

Ms Karen Gillon
Option One
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Dear Ms Gillon

re "MAKE MONEY"

Thank you for your enquiry regarding the "Make Money" promotion. There are a number of different forms of protection which a promotion such as this might attract. I shall deal with each of these in turn.

Patents are probably the strongest form of protection available, although in this situation patenting a promotional game is somewhat limited. According to the Patents Act 1977, a scheme, rule or method for playing a game is not an invention and therefore not patentable. However, this restriction extends only as far as a patent or application for a patent relates to a scheme rule or method for playing a game as such, and does not exclude apparatus for playing a game. You will therefore see that both UK Patent Application No. 2132908 and No. 2,202754 are directed towards devices comprising a manually held card which has various indicia with markings covered with a removable material. The cards themselves are protected, but the game is not. This limitation would apply to any patent involving such a game.

It is only possible to infringe a patent which is either in force having been granted and all renewal fees paid, or an application for a patent which proceeds to grant. It is only possible to take action against an infringer of a patent once that patent has been granted. Back damages may be claimed in respect of infringement which occurred before the patent was granted. You have sent me a list of patents in the name of Don Marketing

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Management Ltd of which all have been withdrawn or have lapsed except for British Patent No. 2132908B and 2202754. It is evident from the abstracts which you sent us that these patents do not involve the matching of left-hand and right-hand parts of a note or other token. It is therefore not possible to infringe any of the patents which were cited in your search. However, you should be aware that although the search found no relevant patents or patent applications in the name of Don Marketing Management Ltd., it is possible that another person or company might possess a patent or patent application for cards such as the ones which you propose to use in your new promotion. Only a subject matter search would find all or most of the relevant patents relating to matching tickets. You state in your letter that an earlier promotion also involved customers collecting halves of notes and so it would seem likely that any subsequent application relating to this area would not be novel or inventive. However, there could be an earlier patent which relates to this game either which Don Marketing were not aware of, or which was licensed by Don Marketing from the proprietor of the patent. This, whilst being possible, is unlikely. From your original telephone call to me you stated that there was also an earlier promotion in the 1960s which, if I remember correctly, also involved matching left and right halves of tokens. If this is the case, then the basic idea of a game matching two halves of a token would have been disclosed and would not be patentable subsequent to that use. Developments of the idea may still be patentable providing that they meet the requirements of novelty and non-obviousness which are required for a patent to be granted.

In summary the patent position appears to be favourable to you in that no patents have been found which could be infringed by the game that you propose to run.

The trade mark position of your promotion "Make Money" also appears to be quite good. The closest registered mark that was found in the search was that of "Daily Star Make Money" which is registered for games relating to money. We note that the registration gives no right to the exclusive use of the words "Make Money" since they are not in themselves distinctive. You are therefore free to use the words "Make Money" in respect of a petrol promotion provided that you do not link this with Daily Star or any other similar words. We thought up one interesting mark, "Four Star Make Money", which would, most probably, infringe the Daily Star's trade mark registration. You would also be well advised to avoid any kind of logo incorporating

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"Make Money" which is laid out in a similar way to the Daily Star Make Money Device Trade Mark No. 1409251 owned by Express Newspapers plc. Infringement would occur if your logo for "Make Money" is at all confusingly similar to the "Make Money" logo of the Daily Star. From the point of view of trade mark infringement, any mark which has been abandoned, withdrawn, lapsed or refused cannot be infringed. There are no other marks which have been found in the search which could be infringed by your use.

There is a second, unregistered form of protection for trade marks which also extends to all forms of 'get-up' related to a product. The protection is known as "passing off" and is based on the principal that nobody has the right to represent his goods or services as the goods or services of somebody else. One person should not therefore pass off their goods as if they are the goods of somebody else. Passing off derives from common law, and therefore there is no statute governing the principals. There is also no register of rights derived from common law, particularly as passing off will protect not only trade marks but also packaging, shapes, smells and anything else which might be used by another person to pass off their goods as somebody else's. For this reason I would advise that if the mark "Make Money" is used, then it must be made as different as possible from the "Make Money" device used by the Daily Star. If you are aware of any other person who uses the mark "Make Money" or anything similar then you must be careful to avoid any confusion between the products. It is unlikely that you will have any problems relating to passing off.

It is possible to register new designs at the Designs Registry, and if you are to re-use special envelopes as were used in previous promotions, then it occurs to me that there is an outside chance that such an envelope might already have been registered as a registered design. This possibility is rendered even smaller by the fact that the rules for registering a design exclude articles primarily consisting of printed matter such as stationery goods. This would most probably exclude registration of any envelope used to contain the relevant tokens.

The final area in which you might have difficulty is copyright. Again this right is unregistered, and so is very difficult to ascertain. However, to infringe copyright, copying of the whole or a substantial part of a work must occur. A work includes an original literary musical or artistic work. If you are basing your new promotion on the earlier promotion then care must be

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taken not to infringe any copyright which belongs to Don Marketing. I assume in my advice that any rights owned by the petrol company would not be infringed by your or their use in relation to the promotion of their petrol. Copyright will, most likely, subsist in much of the material created by Don Marketing in the previous promotion and will also subsist in much of the material created for the earlier promotion in the 1960's. The owner of the copyright in those earlier promotions would probably be the agency which created the promotion, although this would be subject to any contract which existed between the promoters and the petrol company. My advice must therefore be based on the possibility that Don Marketing own copyright in their promotion. One feature of the promotion which you intend to continue is that of the name "Make Money". If the name "Make Money" was originally created by Don Marketing, then they might claim that there is copyright subsisting in that title. The Courts are loathed to accept that copyright subsists in titles, since they are not considered to embody a sufficient quantum of creative effort. The Courts tend to argue that a title must be protected by passing off rather than by copyright. Artistic copyright might however subsist in any "Make Money" logo designed by Don Marketing. In order that no infringement of copyright occurs, we would strongly advise you to make sure that no part of this artistic logo is copied thereby showing that there is no hint of imitation. You also stated to me that in the earlier promotions the tokens are given away inside envelopes. Both the envelopes and the tokens used in your promotion must be completely different in design to the ones used in the earlier promotion, thereby preventing any possible argument that the envelopes or tokens are copies of the whole or a substantial part of the envelopes or tokens used in the earlier promotion.

In summary, all literature and art work involved in your promotion should be very distinctly different from those used in the earlier promotions. All hint of copying must be excluded from your promotional material.

We hope that the information above assists you in advising your clients. If you require any more information, or clarification of any of the information given then we will be very pleased to advise you further.

We enclose our account (with confirmation copy of this letter).

Yours faithfully

H. Wright
H Wright