

FC5 (P7) – Trade Mark Law
FINAL Mark Scheme 2016

Half marks may be awarded where candidates have not been precise.

Part A

Question 1

- a) Where can you file an application to register a European Union trade mark (EUTM), according to *Article 25(1) 'Filing of applications' of Commission Regulation (EC) 207/2009*? 1 mark
- b) What four requirements must an application to register an EUTM contain in order to obtain a filing date, in accordance with *Article 26(1) 'Conditions with which applications must comply' of Commission Regulation (EC) 207/2009*? 2 marks
- c) How are the application fees for EUTMs calculated, according to *Article 26(2) 'Conditions with which applications must comply' of Commission Regulation (EC) 207/2009*? (No fee amounts are needed). 1 mark
- d) What is the deadline for payment of application fees, under *Article 27 'Date of filing' of Commission Regulation (EC) 207/2009*? 1 mark
- Total: 5 marks**

Answer

- a) At the European Union Intellectual Property Office.

ALLOW: EUIPO / OHIM / Office for Harmonization of the Internal Market

NO MARK to be awarded if the "UKIPO" or "central industrial property office of an EU Member State" is given as a second option. [This is a change introduced by Regulation 2015/2424]

1 mark

- b) **Half a mark for each of the following:**
- i. a request for registration;
 - ii. information identifying the applicant;
 - iii. a list of the goods or services in respect of which registration is requested;
 - iv. a representation of the trade mark.

ALLOW as an alternative to (iv): 'a representation, if electronic, in the correct format and size'. [A requirement introduced by Regulation 2015/2424]

2 marks

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- c) The application fee and an extra fee for each additional class above the **first**.

**N.B. this change was introduced by Regulation 2015/2424.
Do not penalize omission of references to optional ‘search fees’.**

1 mark

- d) One month from the filing date.

1 mark

Total: 5 marks

Question 2

Section 3 ‘Absolute Grounds for Refusal of Registration’ of the UK Trade Marks Act 1994 sets out the categories of sign that shall not be registered as United Kingdom trade marks. ‘Specially protected emblems’ is one such category. List five others.

Do not list any of the types of specially protected emblem referred to in sections 4, 57 or 58 of the UK Trade Marks Act 1994.

5 marks

Total: 5 marks

Answer

One mark for any of the following up to a maximum of five marks to be awarded overall:

- i. signs which do not satisfy the requirements of section 1(1).
- ii. any sign not capable of being represented graphically [**ACCEPT: ‘enabling the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor’ - Change being introduced by Regulation 2015/2436**]
- iii. any sign which is not capable of distinguishing goods or services of one undertaking from those of other undertakings
- iv. trade marks which are devoid of any distinctive character;
- v. trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; [**DO NOT PENALIZE omitted examples of characteristics from this list.**]
- vi. trade marks which consist exclusively of signs or indications which have become customary in the current language / in the bona fide and established practices of the trade; [**one mark for either, up to a maximum of one mark**]
- vii. signs which consist exclusively of a shape [or another characteristic] which results from the nature of the goods themselves; [**words in square brackets being introduced by Directive 2015/2436: do not penalise if omitted**]

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- viii. signs which consist exclusively of a shape [or another characteristic] which is necessary to obtain a technical result. **[Ditto]**
- ix. signs which consist exclusively of the shape [or another characteristic] which gives substantial value to the goods; **[Ditto]**
- x. trade marks which are contrary to public policy or to accepted principles of morality;
- xi. trade marks which are of such a nature as to deceive the public;
- xii. trade marks if or the extent their use is prohibited in the United Kingdom by any enactment or rule of law;
- xiii. trade marks if or to the extent that the application is made in bad faith.
- xiv. geographic indications **[explicit reference being introduced by Directive 2015/2436]**
- xv. traditional terms for wine **[Ditto]**
- xvi. traditional specialties guaranteed. **[Ditto]**
- xvii. plant variety denominations. **[Ditto]**

5 marks

Total: 5 marks

Question 3

- a) What legal benefit does 'consent' from the owner of an earlier registered trade mark provide to a trade mark applicant or owner, according to sections 5(5) '*Relative grounds for refusal*' and 47(2) '*Grounds for invalidity of registration*' of the UK Trade Marks Act 1994?

2 marks

- b) Give one further reason why an applicant for registration of a trade mark might seek consent.

1 mark

- c) Suggest two reasons why the owner of an earlier registered mark might grant consent.

2 marks

Total: 5 marks

Answer

- a) Legal certainty. The proprietor of the earlier trade mark or a successor in title **[0.5 mark] cannot [1 mark]** subsequently invoke Section 5 grounds in opposition or invalidity proceedings **[0.5 mark]**.

1 MARK MAXIMUM if an answer indicates that the applicant is merely provided with reassurance that the earlier rightsholder is happy, or does not intend to bring such actions.

2 marks

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- b) The owner of the junior mark will also want to eliminate the risk of infringing the earlier mark [per *section 9(1)*].

1 mark

If infringement is addressed in (a) it can be credited here.

- c) **One mark for each of the following up to a maximum of two marks to be awarded overall.**
- i. to demonstrate that he is not neglecting to police his mark (which might ultimately put it at risk of revocation);
 - ii. to avoid a revocation action on grounds of non use;
 - iii. to avoid an invalidity action of absolute grounds (if vulnerable);
 - iv. to avoid an invalidity action on relative grounds (if there are even more senior marks in the junior mark applicant's portfolio);
 - v. in order to facilitate the future expansion of the senior mark into new markets; where any further filing might conflict with the junior mark;
 - vi. as part of a more extensive coexistence arrangement for partitioning the parties' respective markets (for example, along geographic lines);
 - vii. he is offered a financial inducement.

Other reasonable answers are acceptable.

2 marks

Total: 5 marks

Question 4

- a) Section 10 '*Infringement of registered trade mark*' of the UK *Trade Marks Act 1994* sets out the scenarios in which a sign can infringe a UK registered trade mark if used in the course of trade. One scenario is if:

a person uses a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

What are all the other scenarios, as set out sections 10(2) and 10(3)?

4 marks

- b) Set out the circumstances in which a printer, who applies a registered trade mark to material intended to be used for labelling, can be treated as a party to infringement, under *Section 10(5)*.

1 mark

Total: 5 marks

Answer

- a) **ACCEPT any permutation that covers ALL the scenarios set out in subsection 10(2) and 10(3) . For example:**

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- i. Signs identical + goods/services similar + likelihood of confusion on the part of the public including a likelihood of association. **1 mark**
- ii. Signs similar + goods/services similar + likelihood of confusion on the part of the public including a likelihood of association. **1 mark**
- iii. Signs identical/similar + the registered mark has a reputation in the UK + the use without due cause + would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered mark. **2 marks**

Or

- i. Identical/similar signs + identical/similar G&S + LOC (including LOA) **[2 marks]**
- ii. Identical/similar signs + without due cause + unfair advantage to distinctive character/repute **[1 mark]**
- iii. Identical/similar signs + without due cause + detriment to distinctive character/repute **[1 mark]**

Or:

- i. Identical/similar signs + identical/similar G&S + LOC (including LOA) **[2 marks]**
- ii. Identical/similar signs + without due cause + unfair advantage/detriment to distinctive character **[1 mark]**
- iii. Identical/similar signs + without due cause + unfair advantage/detriment to repute **[1 mark]**

- b) If when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

1 mark

Total: 5 marks

Question 5

Section 11(3) 'Limits on effect of registered trade mark' of the UK Trade Marks Act 1994 provides a defence to infringement on the basis of an earlier right in a particular locality. Write notes on the requirements for that defence to operate.

5 marks

Total: 5 marks

Answer

The owner of an unregistered trade mark or other sign has a defence in the following circumstances:

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- i. the mark has been continuously used; **0.5 marks**
 - ii. in relation to goods or services; **0.5 marks**
 - iii. from the earlier of: **1 mark**
 - iv. a date prior to the first use of the trade mark in relation to those goods or services; **1 mark**
 - v. or a date prior to the registration [**accept: priority date**] of the trade mark in respect of those goods or services; **1 mark**
 - vi. to the extent that its use [in that locality] is protected by virtue of any rule of law [**accept: ‘...by the law of passing off’**]. **1 mark**
- Total: 5 marks**

Question 6

List the five categories of registrable transaction, according to *Section 25 ‘Registration of transactions affecting registered trade mark’* of the UK Trade Marks Act 1994.

5 marks

Total: 5 marks

Answer

One mark for each of the following:

- i. an assignment
- ii. a licence
- iii. a security interest
- iv. the making by personal representatives of an assent
- v. an order of a court transferring a registered trade mark.

5 marks

Total: 5 marks

Question 7

- a) What limit, if any, is there to the number of goods/services which may be claimed in a Madrid Protocol application, under *Article 3 ‘International Application’* of the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*?

1 mark

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- b) Explain the difference between:
- i. a basic fee;
 - ii. a supplementary fee, and
 - iii. an individual fee

for the purposes of *Article 8 'Fees for International Applications and Registration'* of the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*?

3 marks

- c) The International Bureau notifies you that the fees you have paid are insufficient to cover the number of classes of goods and services you have listed in your Madrid Protocol application. According to *Article 8*, what happens if the shortfall is not paid (or the list of goods or services reduced) before the deadline set by the International Bureau?

1 mark

Total: 5 marks

Answer

- a) None, so long as the goods/services are no wider than the base application or registration;

1 mark

- b) Basic Fee: Application fee payable for all Madrid Protocol applications.

Supplementary Fee: Standard Madrid Protocol class fee for each class above the third. Payable to Designated Contracting Parties that have not opted to receive Individual Fees.

Individual Fee: Fees for applying to certain Designated Contracting Parties that have opted to charge fees by this method. The structure and level of payments is set by each Designated Contracting Party.

1 marks each

- c) The whole Madrid Protocol application is deemed abandoned.

1 mark

Total: 5 marks

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Question 8

Set out the two relative grounds on which a European Union trade mark application may be opposed without the opponent having to have an earlier registered trade mark (or earlier registered trade mark application), according to *Article 8 'Relative grounds for refusal' of Commission Regulation (EC) 207/2009*. List all the requirements that need to be demonstrated for each ground.

5 marks

Total: 5 marks

Answer

- i. if an agent/representative **[0.5 mark]** of the proprietor of a trade mark applies for registration in his own name **[0.5 mark]** without the proprietor's consent **[0.5 mark]** unless the agent or representative justifies his action **[0.5 mark]**
- ii. on opposition by the proprietor **[0.5 mark]** of a non-registered sign/mark used in the course of trade **[1 mark]** of more than mere local significance **[0.5 mark]** acquired prior to the date of application/priority for registration of the EU trade mark **[0.5 mark]** and a law confers on its proprietor the right to prohibit the use **[0.5 mark]** of a subsequent trade mark

2 marks

3 marks

ACCEPT AS AN ALTERNATIVE relative grounds based on an unregistered trade mark that, at the application/priority date **[0.5 mark]** is well known in a Member State **[0.5 mark]** in the sense that the words 'well known' are used in **[Article 6bis of]** the Paris Convention **[0.5 mark]** i.e. as the mark of a trader who is a domicile/national of another Convention country **[0.5 mark]**.

[Alternative 2 marks]

DO NOT ACCEPT grounds for invalidity (e.g. copyright infringement) that cannot be raised in opposition proceedings against trade mark applications at the EUIPO.

Total: 5 marks

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Question 9

What is meant by “exhaustion of rights” as set out in *Article 13 ‘Exhaustion of the rights conferred by a European Union trade mark’ of Commission Regulation (EC) 207/2009?*

5 marks

Total: 5 marks

Answer

One mark for any of the following up to a maximum of five marks to be awarded overall:

- i. Ownership of a EUTM shall not entitle the proprietor to prohibit use of the mark in relation to goods
- ii. which have been put on the market in the EEA under that trade mark **[0.5 mark if ‘EU’ rather than ‘EEA’ is stated. Change introduced by Regulation 2015/2424]**
- iii. by the proprietor **[0.5 mark]** or with his consent **[0.5 mark]**
- iv. The proprietor’s rights are not exhausted where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods;
- v. especially where the condition of the goods is changed/impaired after they have been put on the market.

5 marks

Total: 5 marks

Part B

Question 10

Outline the procedure of:

- a) the United Kingdom Intellectual Property Office **(6 marks)** and
- b) the European Union Intellectual Property Office **(6 marks)**

in relation to the official search for earlier trade marks during the examination of a trade mark application. In doing so, explain the steps in the procedure followed by each Office and the actions which the applicant needs to take.

Total: 12 marks

Answer

One mark for any of the following up to a maximum of six marks to be awarded overall for (a) and six marks to be awarded overall for (b). Candidates are not required to know Section or Article numbers to gain the marks.

- a) UKIPO:
 - i. earlier trade marks are searched to disclose conflicting earlier trade marks under s.5(1) and 5(2);
 - ii. the Applicant is given two months to contest the citation(s)

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- iii. he is permitted only one response to the Office Action in which the citations are raised;
- iv. if the citations are not overcome, UKIPO does not refuse the application but publishes the application;
- v. UKIPO notifies the owners of any cited UK and International marks which designate the UK that the application has been published so that they have an opportunity to file opposition;
- vi. the owners of EUTMs and International Registrations which designate the EU are not notified unless they have paid to “opt in” for notifications.;

6 marks

b) EUIPO:

- i. Earlier EUTM trade mark applications and registrations are searched to disclose potentially conflicting earlier trade marks under Article 8(1).
- ii. The applicant must request, at the time of application, if he wants a copy of the search report. **[NOTE change introduced by Regulation 2015/2424];**
- iii. At the request of the applicant when filing, and on the payment of a further fee, the EUIPO can additionally request participating national IPOs to prepare a local search report. These will be transmitted back to the EUIPO.
- iv. there is no provision for arguing the citations;
- v. EUIPO does not refuse the application but publishes the application;
- vi. The EUIPO notifies the owners of any cited EUTMs that the application has been published so that they have an opportunity to file opposition.

6 marks

Total: 12 marks

Question 11

- a) An application to register the word “yes” in English as an EU trade mark would be subject to refusal under *Article 7(1)(b) ‘Absolute grounds for refusal’ of Commission Regulation (EC) 207/2009* on grounds that it is devoid of any distinctive character. Your client wishes to register the word “kyllä” which means “yes” in the Finnish language. Write notes on likely absolute grounds for objection in relation to “kyllä” and whether there are any provisions in *Article 7* on which your client might rely.

3 marks
- b) Your client has heard that, if his application is refused, he has the option of “conversion”. Explain the term in the context of *Articles 112 to 114 of Commission Regulation (EC) 207/2009*.

2 marks
- c) Outline the procedure for conversion and identify any deadlines.

6 marks
- d) Explain whether conversion is an option in this case.

1 mark

Total: 12 marks

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Answer

DO NOT PENALIZE if candidates believe/speculate that Finnish might be sufficiently widely spoken in other parts of the EU (such as Sweden or Estonia) as to give rise to absolute grounds for refusal in those jurisdictions too.

a) Marks up to a maximum of three marks overall to be awarded for good notes covering the following points:

- i. the mark lacks distinctive character in Finnish;
- ii. the objection applies notwithstanding that the grounds of non-registrability may apply only in Finland;
- iii. the objection may not apply if the trade mark has acquired distinctiveness in the part of the Community to which the grounds apply (i.e. Finland)

3 marks

b) One mark for each of the following up to a maximum of two marks to be awarded overall:

- i. the applicant for [or proprietor of] an EU trade mark may “convert” his EU trade mark into national trade mark applications;
- ii. the applications will keep the same filing date as the original EUTM;

2 marks

c) One mark for each of the following up to a maximum of six marks to be awarded overall:

- i. file application for conversion within three months of the notice of refusal;
- ii. the application for conversion is made to the EUIPO.
- iii. it is necessary to specify the Member States in which application of the procedure for registration of a national trade mark is desired.
- iv. it is also necessary to pay the conversion fee;
- v. after transmittal, the Member States examine the application against national law.
- vi. the National Offices may additionally require the following: **[1 mark for any two]:**
 - a. payment of the national application fee;
 - b. a translation in one of the official languages of the State in question of the request and of the documents accompanying it;
 - c. an address for service in the State in question;
 - d. a representation of the trade mark in the number of copies specified by the State in question;
 - e. they may impose a deadline of not less than two months.

6 marks

d) The EUTM application is convertible into a national application for any member state other than Finland.

1 mark

Total: 12 marks

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Question 12

In this question, only address the law of passing off

Your client is an Argentinian football player. He has never played in Europe but he was the star player for Argentina in the 2014 World Cup held in Brazil when his team reached the final. World Cup matches are watched by billions of television viewers around the world including in the UK.

Football clothing and football equipment, all bearing his name under licence, are sold on market stalls in North and South America. These products are also sold through an Argentinian website controlled by your client. The website can be viewed in the UK but it is not possible to place orders for shipping to the UK.

Your client has registered his name as a trade mark for sports clothing and sports equipment throughout North and South America, but not so far in Europe.

Your client tells you that a Welsh company has started to sell chewing gum bearing his name. He also has evidence that the Welsh company employs an actor who closely resembles him to promote the chewing gum. The actor dresses as a footballer, in a football strip in the same colour as your client's team, with your client's name printed on the shirt.

Your client says he has never endorsed any products intended for sale in the UK. Nor has he endorsed any products in North and South America except his own licensed clothing and sports equipment ranges.

- a) Outline the remedies that the law of passing off can provide your client, assuming he is able to establish a successful case.

2 marks

- b) Discuss whether the law of passing-off can in fact prevent the continued use of your client's name and image in the UK in relation to the chewing gum, given the above facts.

9 marks

- c) Give a recommendation on what action your client should take, based on his prospects for success.

1 marks

Total: 12 marks

Answer

- a) **One mark for each of the following up to a maximum of two marks to be awarded overall:**

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- i. the law of “passing off” can be used to protect not only against the misuse of unregistered trade marks, but also against false endorsement.
- ii. the courts can impose an injunction preventing further use of the mark by the defendant and award costs and damages;
- iii. the courts can also award damages or account of profits (**1 mark for either**)
- iv. if the offending use started recently it may be possible to obtain an immediate temporary injunction.

2 marks

b) One mark for any of the following (or other sensible points) up to a maximum within the totals for each heading, and a maximum of nine marks to be awarded overall:

GOODWILL (up to a maximum of 3 points)

- i. the client must prove goodwill i.e. that he has built up a protectable goodwill through sales of his products under his trade mark (or through receiving fees for giving endorsements) in the UK;
- ii. the client appears not to have a business in the UK, which indicates no goodwill;
- iii. he is probably very famous here because football is such a popular sport and the last World Cup was watched by so many UK television viewers, but fame or reputation does not necessarily equate with having a UK business.

MISREPRESENTATION (up to a maximum of 3 points)

- iv. the client must show that there has been a misrepresentation i.e. that the defendant’s use of the client’s name or image will lead the public to believe that the chewing gum is manufactured by (or endorsed by) the client;
- v. actual evidence of confusion is not essential but can be good evidence of a misrepresentation;
- vi. the greater the difference in the goods, the greater must be the goodwill of the claimant for the necessary connection or misrepresentation to be made; since the client’s goodwill is small (or non-existent) in the UK, the difference in the products may be fatal.
- vii. the use of a “lookalike” to promote the product nevertheless might confuse customers into thinking that he has personally endorsed the product, or at least is likely to create a connection with your client that may amount to a misrepresentation that he has consented to this campaign.

DAMAGE (up to a maximum of 2 points)

- viii. damage may be inferred if goodwill and misrepresentation are present;
- ix. if the client has no business in the UK and no business in chewing gum, there is unlikely to be much, or any damage in terms of direct loss of sales;
- x. it might be possible to show damage in the form of loss of opportunity if the client is planning to expand his business, or endorse products in the UK;
- xi. but ultimately, if there is no goodwill, there is unlikely to be damage to goodwill.

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CONCLUSION (up to a maximum of 1 point)

The prospects for success on passing off are weak/poor.

9 marks

c)

The client would be unwise to take a passing off action further / incur substantial legal fees, especially in relation to a product where he has no existing business.

1 mark

Other reasonable answers are acceptable, particularly on the recommendation.

Total: 12 marks

Question 13

In 2000, your client opened a business under the name SAXON offering lessons in microlight flying. Microlight aircraft are essentially hang gliders with engines. In fact, many people who enjoy flying hang gliders go on to fly microlight aircraft and most schools offer lessons in both.

He registered the name SAXON as a trade mark in the UK in 2000 in relation to teaching microlight flying. He renewed the registration in 2010. He has been actively giving microlight flying lessons under the SAXON trade mark since 2000.

He contacts you because a watching service for his trade mark has disclosed that a Karen White has applied to register SAXONY as a trade mark in the UK in relation to teaching hang gliding.

Your client instructs you to oppose Karen White's trade mark application, which has just been published.

- a) Advise your client of the ground of opposition which has the best chance of success and analyse the prospects for success based on the above information.

Do not address the law of passing off.

8 marks

- b) Your client tells you that Karen White used to be an instructor at his school and believes she has 'stolen' the name. Suggest a further possible ground of opposition, in light of the possible 'theft' of the name and discuss what your client must prove.

Again, do not address the law of passing off.

4 marks

Total: 12 marks

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Answer

- a) **One mark for any of the following (or other sensible points) up to a maximum within the totals for each heading, and a maximum of eight marks to be awarded overall:**

GROUNDINGS [1 Mark]

- i. the ground of opposition that has the best chance is that the client's UK registered mark and Karen White's mark are similar and the services are similar and that there exists a likelihood of confusion on the part of the public **[DO NOT PENALIZE failure to mention likelihood of association];**

SIMILARITY OF SIGNS [Up to 2 Marks]

- ii. In this case they differ by only one letter
iii. and the final letter in an English word is often the least important which indicates a visual and phonetic similarity;
iv. on the other hand, conceptually, the marks might be regarded as dissimilar (early-medieval Englishman v modern German province).

SIMILARITY OF SERVICES [Up to 3 Marks]

- v. Flying schools (i.e. the subject matter of the applications) are teaching students to fly in both cases, and using similar forms of technology.
vi. We are told that learners (i.e. the end-users of the respective services) often learn to fly both.
vii. We are told that many schools (i.e. suppliers of the respective services) teach clients to fly both;

LOC AND CONCLUSION [Up to 2 Marks]

- viii. The likelihood of confusion must be assessed globally taking account of all relevant factors.
ix. it is not essential to support this ground of opposition by evidence although evidence of confusion would be likely to be persuasive.
x. The marks are very close and the similarity of services is strong. So the conclusion overall is that there is a likelihood of confusion;

Other reasonable answers are acceptable, such as the signs not being similar (conceptual grounds dominating the comparison): or well-argued case that the services are dissimilar.

8 marks

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- b) One mark for each of the following or other sensible points up to a maximum of four points to be awarded overall:**
- i. it is possible to oppose an application on grounds of the applicant's bad faith;
 - ii. taking someone else's name can amount to bad faith;
 - iii. to be successful it is necessary to prove by evidence that the applicant's conduct fell short of acceptable commercial behaviour;
 - iv. without evidence, the allegation will not succeed.

4 marks

Total: 12 marks

Question 14

- a) What are the advantages of registering a trade mark as a single EU trade mark rather than registering the mark as separate national registrations in several EU territories?

9 marks

- b) Set out any disadvantages.

3 marks

Total: 12 marks

Answer

- a) One mark for each advantage such as the following up to a maximum of nine marks to be awarded overall. Other reasonable answers are acceptable:**
- i. the possibility of community-wide relief through a single infringement action;
 - ii. the procedure is administratively simpler than multiple national applications [by reason of the EUTM's unitary nature, simplifying filing, licensing, charging, assigning and maintaining];
 - iii. the applicant requires only one representative;
 - iv. use anywhere in the Union e.g. in a single Member State protects the EUTM throughout the whole Community against cancellation for non-use;
 - v. the fee structure is very attractive;
 - vi. provision for conversion eliminates the risk attached to the unitary nature of the EUTM [ie if there is a fatal objection to an application in one territory, the filing date is not lost in the others].
 - vii. seniority provisions enable further cost and administration savings by permitting expiry of national rights;
 - viii. the choice of languages includes English which is widely used so there seldom a need to pay translation costs;
 - ix. the scope of the registration expands automatically to include new member states which may join the EU in future.

9 marks

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b) One mark for each disadvantage such as the following up to a maximum of three marks to be awarded overall (half marks may be awarded) Other reasonable answers are acceptable:

- i. failure to meet absolute grounds/ challenge under relative grounds, valid in one jurisdiction invalidates the EU Trade Mark in its entirety.
- ii. oppositions are very common because a EUTM can be opposed by any national registered/pending/user right throughout the EU;
- iii. there are greater risk of marks being refused on absolute grounds, particularly for non-distinctiveness in other EU languages.
- iv. in the event of an objection on grounds that the mark is not distinctive, filing evidence of acquired distinctiveness can be very expensive or impossible because it is necessary to show acquired distinctiveness in every territory of the EU to which the objection applies.
- v. if the application is refused, conversion delays registration, and is expensive.

3 marks

Total: 12 marks

Question 15

Set out precisely (including any limitations and qualifications) the grounds for revocation of a UK trade mark for non-use, described in *section 46 'Revocation of registration'* of the *UK Trade Marks Act 1994*.

Total: 12 marks

Answer

- a. that within the period of five years **[0.5 mark]** following the date of completion of the registration procedure **[0.5 mark]** the mark has not been put to genuine use **[0.5 mark]** in the United Kingdom **[0.5 mark]** by the proprietor or with his consent **[0.5 mark]** in relation to the goods [or services] for which it is registered **[0.5 mark]**

3 marks
- b. Or use has been suspended for an uninterrupted period of five years,

1 mark
- c. And the mark has not commenced or resumed **[0.5 mark]** after the expiry of the five year period and before the application for revocation is made **[0.5 mark]**...

1 mark
- d. ...provided that, any such commencement or resumption of use after the expiry of the five year period **[0.5 mark]** but within the period of three months **[0.5 mark]** before the making of the application **[0.5 mark]** shall be disregarded **[0.5 mark]** unless preparations for the commencement or

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resumption began **[0.5 mark]** before the proprietor became aware that the application might be made **[0.5 mark]**

3 marks

e. There are no proper reasons for non-use.

1 mark

f. Use of a trade mark includes use in a form differing in elements **[0.5 mark]** which do not alter the distinctive character **[0.5 mark]** of the mark in the form in which it was registered

1 mark

g. Use in the United Kingdom includes affixing the trade mark to goods/packaging **[accept either]** in the United Kingdom solely for export purposes

1 mark

h. Where grounds for revocation exist in respect of only some of the goods/services for which the trade mark is registered, revocation shall relate to those goods/services only.

1 mark

Total: 12 marks