

Question 1

a) EUIPO, Benelux office, or office of member states of the European Union.

b)

- 1) Representation of the trademark.
- 2) Request for registration of trademark.
- 3) Information to identify the applicant.
- 4) Indication of goods and services in respect of the registration.

d) 1 month from filing date.

MARKS AWARDED 3/5

Question 2

Absolute grounds of refusal include:

- 1) Filing the application in bad faith.
- 2) The trademark is contrary to public morality or public policy.
- 3) The trademark is prohibited by a rule of law in the UK or a provision of EU community law.
- 4) The trademark is not capable of being graphically represented or not capable of distinguishing the goods or services of one undertaking from another.
- 5) The trademark is devoid of distinctive character.

MARKS AWARDED 5/5

Question 4

a) Section 10 (2) states that a sign can infringe a UK registered trademark where a person uses a sign which is identical or similar with the registered trademark for goods and services which are similar to those in relation to the registered trademark or where a person uses a sign which is similar to the registered trademark for goods and services which are identical or similar. In relation to the registered trademark, where there is a likelihood of confusion, associated with likelihood of association between the origin of the goods and services by reference to the marks.

b) The printer infringes a registered trademark if he applies the trademark to material intended for labelling goods without the consent of the proprietor, knowing or having reasonable grounds to believe that this constituted infringement.

MARKS AWARDED 3/5

Question 5

Use of a sign can be protected under the law of passing off, in relation to a particular locality. The sign must be continuously used in the course of trade from a date prior to the use of the latter trademark or registration of the latter trademark.

Use in the course of trade in a particular locality by the proprietor of the sign or the predecessor in title must be prior to the latter trademark.

The law of passing off protects the use of the sign in relation to the locality where it was used in the course of trade.

MARKS AWARDED 3.5/5

Question 6

Five categories of registrable transactions include:

- i. Assignment of the trademark and all rights in or under it.
- ii. Grant of a license.
- iii. Grant of a security interest and all rights in or under it.
- iv. Making of an assent by the proprietor's representative and all rights in or under it.
- v. An order by court to transfer the trademark and all rights in or under it.

MARKS AWARDED 5/5

Question 7

a) There is no limit to the number of goods and services claimed in a Madrid Protocol application.

b)

- i. A basic fee is a fee in respect of the basic application.
- ii. A supplementary fee covers 3 classes of goods and services in the application.
- iii. Individual fee relates to designation fee for each territory designated in the application.

c) If fees are not sufficient the goods and services not covered by the fee are deleted from the application.

MARKS AWARDED 3/5

Question 8

- i) A designation for geographical origin applied before the priority or filing date at the trademark application, which, under union law or national law, of member states, prohibits the use of the designation.
- ii) A sign of more than mere local significance within a particular locality, due to the use of that sign in the course of trade is protected by union law or law of member states.

MARKS AWARDED 2/5

Question 9

Where goods have been placed on the market in the European Economic Area, by the proprietor, or with his consent, he cannot enforce rights conferred by the registered trademark on those goods after being placed on the market, unless the quality of those goods has deteriorated or is of poor quality.

MARKS AWARDED 4/5

Question 10

- a) The Registrar searches for earlier UK trademarks and international registrations designating the UK. If earlier marks are discovered, the Registrar informs the applicant and gives the application a specified time to make representation, or amend the application. If the Registrar is not satisfied that the application overcomes the relative grounds for refusal, he will notify the proprietors of the marks identified in the search to give them an opportunity to oppose the application. EU trademarks are not searched. The Registrar does not refuse the application based on relative grounds for refusal unless it is opposed.
- b) The EUIPO carries out a search of EUTMs and international registrations designating the EU. On request by the applicant, the EUIPO also searches earlier national trademarks of EU member states.

The EUIPO cites any earlier conflicting marks in a report and informs the applicant of those conflicting marks. The applicant is given an opportunity to make representations or amend the application to overcome any relative grounds for refusal.

The EUIPO, if not satisfied that the applicant has not overcome the relative grounds for refusal, will inform the proprietors of the EU trademark and international registrations

designating the EU, of the application, to give them an opportunity to oppose the application. The EUIPO will not refuse the application unless it is opposed.

MARKS AWARDED 5.5/12

Question 12

a) Remedies include damages, account of profits, injunctions to prohibit the commercial activities of the Welsh company in relation to selling of chewing gum bearing his name, and any other remedies in relation to personal property under UK law.

b) In order to demonstrate that passing off has occurred, the following criteria must be met:

- i. Goodwill and reputation in the footballer's name.
- ii. Misrepresentation of the footballer's name by the Welsh company and
- iii. Damage, or likelihood of damage.

Goodwill is regarded as an attractive force that brings in custom. The footballer is famous and has a reputation across the world, which has been acquired through playing football. Therefore, the footballer has acquired goodwill and reputation by reference to his name.

The Welsh company has adopted the footballer's name and has employed an actor to dress as the footballer. This is clearly for the purpose of deceiving the public into thinking that the footballer has endorsed the products. Therefore, this may lead the public into thinking that the chewing gum originates from the footballer's undertaking.

It is not necessary to show that damage has taken place. The likelihood of damage is enough to prove misrepresentation. Damage includes damage to reputation or sales. The footballer's reputation is likely to be damaged.

Therefore, it is possible to prevent the use of the footballer's name and image in UK, based on the law of passing off.

c) The client should inform the Welsh company of his intention to initiate a passing off action.

MARKS AWARDED 6/12

Question 13

a) It is best to oppose Karen White's mark based on Section 10 (2). The latter mark is similar to the client's earlier mark. In addition, handgliding is a service that is similar to the goods of the client's earlier mark, which included microlight aircraft handgliders. The client can argue that there is a likelihood of confusion, associated with likelihood of association between the two marks and the goods/services in respect of the marks.

b) It is possible to file an opposition on the grounds of bad faith. The onus is on the client to show that Karen White 'stole' his name.

MARKS AWARDED 2/12

Question 14

a) Advantages include:

- i. It is possible to claim seniority in respect of an earlier national registration in an EU member state. It is therefore cheaper to maintain the national registration.
- ii. It is possible to convert the EU trademark into national registration in the event of an invalidity action.
- iii. It is possible to achieve pan-European protection and seek pan-European relief in relation to infringement proceedings.
- iv. It is administratively more convenient to file a single application for protection across the EU than file applications in individual national territories.
- v. The official languages of the EUIPO include English, French, Italian, Spanish and Dutch. It is possible to file in any of those languages for an EU trademark. Filing in individual offices may require translation of the application into the official language of each member state.
- vi. It is cheaper to file an application for an EU trademark than file individual national applications over all EU member states.
- vii. It is not necessary to appoint a representative before the EUIPO if the applicant is based in the EU.
- viii. Designation automatically covers member states which have joined after the date of filing of the application.
- ix. It is not necessary to state that the trademark is put to genuine use or the applicant intends to put the mark to a genuine bona fide use.

b) Disadvantages include:

- i. Where an opposition or objection arises in one part of the EU, the entire application may be refused or declared invalid due to the unitary effect of the EU trademark.
- ii. The official language of the office does not cover all languages of the member states of the EU.
- iii. An EU trademark registration may not be converted into a national registration where that member state does not consider the EU trademark to have been put to genuine use in the EU, or if there are grounds of invalidity revised.

MARKS AWARDED 10.5/12

Question 15

a) A UK trademark can be revoked on the following grounds:

- i. If within a period of 5 years from the completion of registration procedure, the registered trademark was not put to genuine use in the UK, or if use was suspended for a continuous period of five years.
- ii. Use of the mark within a period of 3 months before an application for revocation is filed is not accepted as genuine use.

Use of the trademark is defined as use of the sign in a form that differs in elements which does not alter the distinctive character of the trademark in the form it was registered. Use also includes affixing the sign to goods or packaging for export from the UK.

ii) If through activity or inactivity of the proprietor the mark becomes customary in the field of trade in question.

iii) If through use of the trademark by the proprietor the mark is misleading of the nature, quality or geographic origin of the goods or services.

MARKS AWARDED 6/12