

Question 1

a) At the EUIPO, or at a national office of an EU member state.

b) A request for registration.

Information identifying the applicant.

A representation of the mark.

A statement of the goods or services for which registration is sought.

c) There is an application fee and a class fee for each class after the first. (The application fee covers one class of goods/services and further class fees are required for additional classes if more than one class is required for registration).

d) One month from filing.

MARKS AWARDED 4/5

Question 2

a) Marks devoid of distinct character.

b) Marks that consist exclusively of signs or indications that serve in trade to designate the kind, quality, quantity, value, intended purpose, geographical origin, time of production of the goods or rendering of services or other characteristics of the goods or services.

c) Marks that do not fall under the definition of a trademark under Section 1(1).

d) Marks that consist exclusively of a shape that arises from the goods themselves, a shape that brings substantial value to the goods or a shape required to obtain a technical results.

e) Marks that a contrary to public policy or accepted principles of morality.

MARKS AWARDED 5/5

Question 4

a)

(i) A person uses a sign which is identical with the trademark in relation to goods or services which are similar to those for which it is registered and there exists a likelihood of confusion on the part of the public, including a likelihood of association with the trademark.

(ii) A person uses a sign which is similar to the trademark in relation to goods or services which are identical or similar to those for which it is registered and there is a likelihood of

confusion on the part of the public, which includes a likelihood of association with the trademark.

(iii) A person uses a sign which is identical or similar to the trademark, where the trademark has a reputation in the UK, and use of the sign without due cause takes unfair advantage of, or is detrimental to the distinctive character or the repute of the earlier mark.

b) If they know, or have reason to believe that such use is not authorised by the owner of the trademark.

MARKS AWARDED 5/5

Question 5

If the earlier right has been used continuously, in that locality, by the owner of the right or a processor in title, within a period of five years before the infringing act.

MARKS AWARDED 0.5/5

Question 6

- a) An assignment.
- b) Grant of a license.
- c) Grant of a security interest.
- d) Making by a personal representative of an assent.
- e) An order of court transferring the trademark.

MARKS AWARDED 5/5

Question 7

a) There is not a limit to the number of goods/services. However, the basic fee only covers the first 3 classes, and further fees must be paid if goods/services in more than 3 classes as claimed.

b) The basic fee is the basic filing fee. The supplementary fee is for classes after the 3rd, if goods or services in more than 3 classes are claimed. The individual fee is the fee that national offices may charge which may be higher than the basic and supplementary fee. There is also a complementary fee for each of the designated countries.

c) Only the number of classes for which fees have been paid are allowed. This is taken in numerical order of the listed classes, unless specified otherwise.

MARKS AWARDED 3/5

Question 8

a) On the grounds of an earlier unregistered trademark which is protected under the Paris Convention or the WTO agreement as well-known mark.

b) On the grounds that there is an earlier right. The earlier right may be a copyright EU design right or registered EU decision. The opponent must be the owner of the earlier unregistered trademark, or the owner of the earlier right.

MARKS AWARDED 2.5/5

Question 9

The owner of the trademark's rights to prevent others using the trademark is exhausted in relation to products put on the market in the EEA by the owner or with the owner's consent, under the trademark. This does not stop the owner from preventing the use of the trademark if there exist legitimate reasons, for example, if the quality of the products is changed or impaired.

MARKS AWARDED 5/5

Question 11

a) An application for registration may be refused on the grounds that it is devoid of distinctive character. An EU trademark is unitary, which means if grounds for refusal apply in just one EU member state, the mark will be refused registration. The word 'Kyllä' is likely to be refused on the grounds that it is devoid of distinctive character in Finland, which is an EU member state. If the client provides evidence that the mark has acquired distinctiveness through its use before the date of application, it may not be refused on these grounds.

c) The EUIPO will forward the request to the national offices of the countries requested, and the national offices will examine the applications. The national offices may set a deadline, of at least two months, for the applicant to pay a national application fee, file a translation of the application, provide an address for services, and provide the required number of copies of the representation.

b) He can convert his application into national applications in the EU member states, if it is refused.

c) The deadline for applying for conversion is three months from the date of the notification of refusal of the EU trademark application. The applicant must apply to the EUIPO, stating the EU member states for which conversion is requested, and must pay a conversion fee. Conversion must be requested by the same owner as the owner of the EU trademark application, for the same mark and the same goods or services.

Conversion is an option if the EU trademark application is rejected (although he has not yet filed an EU trademark application and so cannot yet apply for conversion). However, he would not be able to request conversion in Finland, because the grounds for refusal would apply.

MARKS AWARDED 11/12

Question 12

a) The remedies are an injunction, damages or account for profit.

b) For a successful passing off case, it is necessary to show goodwill, misrepresentation and damage (as decided in the JIF LEMON case). Goodwill is the attractive force of a business that brings in custom. Goodwill must be in the UK, and must exist in goods sold in the UK. This means that even if goods are coming from overseas, they must be bought by customers in the UK. The client's goods cannot be bought by customers in the UK, so the client does not have goodwill in his goods in the UK.

Misrepresentation is something liable to confuse or deceive the public. This may include use of a name, or implying that goods are licensed or endorsed by another.

Misrepresentation may confuse the public as to the origin of the goods. In this case, the Welsh company are using the client's name, and using an actor who closely resembles the client in promotions, wearing the client's kit so it is unmistakable that there is misrepresentation.

Damage can be actual damage, or the likelihood of damage and can take many forms including loss of reputation, loss of future opportunity, blurring or erosion of uniqueness or loss of sales, or damage to goodwill. There appears to be damage to reputation of the client, in the Welsh company selling goods under his name. However, overall, because the client does not have goodwill in his goods in the UK, it is unlikely passing off will prevent the use.

c) I would recommend filing a trademark application for the EU and/or UK for the goods or services you are selling (i.e. clothing). I would also propose starting to sell your goods in the

UK so you can establish a reputation. I would send a cease and desist letter to the Welsh Company.

MARKS AWARDED 10/12

Question 13

a) The relative grounds for refusal that Karen White's application has a similar trademark to the client's trademark and has been registered for identical or similar goods or services as the client's trademark, and there exists a likelihood of confusion on the part of the public, which includes a likelihood of association between the marks. In view of Canon KK v MGM, the client has a good likelihood of success because his mark is distinctive, and the goods or services are very similar. It appears that he has been selling his service for many years and therefore his mark has a reputation in the UK. It is therefore very likely that there is a likelihood of confusion.

As considered in Canon KK v MGM,

- A lesser similarity between goods/services may be offset by a greater degree of similarity between the marks and vice versa.
- Registration may be refused as, despite a lesser degree of similarity between goods/services, the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.
- A mark with a highly distinctive character enjoys a broader scope of protection than marks with lesser distinctive character.
- There is likelihood of confusion where the public could be mistaken as to the origin of the goods or services. In this situation, since the consumer of the client's services is likely to be the consumer of Karen White's services, the public could be mistaken.
- When assessing similarity between goods or services, take into account the nature of the goods/services, the end user and the method of use, and whether the services are complementary or in competition. In this case the nature, end user, method of use are very similar and the services are in competition.

b) He could oppose on the grounds that Karen White's application was applied for in bad faith. Provide evidence in the opposition procedure that the application was filed in bad faith. Likely to be successful.

MARKS AWARDED 6.5/12

Question 14

a)

- An EU trademark is unitary, which means it can be transferred as a whole across the whole EU in one assignment.
- An advantage is that genuine use is only required in one territory of the EU for the trademark to be valid and avoid revocation.
- An EU trademark application is much cheaper than several separate trademark applications.
- An EU trademark can be renewed by paying one renewal fee, which covers the whole EU which is much less administrative burden than paying renewal fees for each national registration.
- An EU trademark automatically expands to cover territories that join the EU.
- Only one representative in a member state is needed for an EU trademark application or registration, whereas for national registrations, a representative may be required in each country for each registration.
- An EU TM can be converted if it is refused, withdrawn, deemed withdrawn or expired – converted into national registrations.
- Seniority can be claimed from an earlier national registration in an EU member state, so if the earlier registration expires, the owner continues to have the same rights.
- The languages of the EUIPO are French, German, Spanish, English or Italian, and it is not necessary to file translations in many languages as it would be for several national applications.

b) If the EU TM application is refused or found invalid on grounds that apply in only one member state, then the entire application will be refused or invalidated across the whole EU. For example, if the mark is found to be devoid of distinctive character in one member state only, it will be refused/invalidated. Earlier marks registered in all EU member states are relevant to registration of the EUTM, which may result in the registration being refused on relative grounds, whereas for example for a UK trademark application, an Italian trademark (national registration) would not be an earlier trademark relevant to the registrability of the UK application.

MARKS AWARDED 11/12

Question 15

a) If the trademark has not been put to genuine use, by the owner or with his consent, in the UK, in relation to the goods or services for which it is registered, for a period of five years from registration of the trademark, and there are no proper reasons for non-use.

b) If the trademark has not been put to genuine use, by the owner or with his consent, in the UK, in relation to the goods or services for which it is registered, for a continuous period of 5 years since registration, and there are no proper reasons for non-use.

a) and b) do not apply if genuine use has commenced or recommenced prior to the application for revocation, unless the use was in the 3 month period prior to the application for revocation and the owner was aware that the application would be made.

c) If, due to acts or inactivity by the owner, the trademark has become the common name in trade for the goods or services for which it is registered.

d) If, due to use by the owner or with his consent the trademark is liable to mislead the public, in particular with regards to quality, geographical origin or value of the goods or services.

MARKS AWARDED 8/12