

**FC5 (P7) Trade Mark Law  
Question Paper – Sample Assessment Material**

In this paper:

- ‘EUTM’ means ‘European Union Trade Mark’
- ‘EUTMR’ means ‘Commission Regulation (EC) 207/2009 on the European Union Trade Mark’, as amended.
- ‘TMA 1994’ means the Trade Marks Act 1994, as amended.

**SECTION A**

**Question 1**

- a) Where can you file an application to register an EUTM, according to Article 25(1) (*‘Filing of applications’*) EUTMR? **1 mark**
- b) Applications to register an EUTM must meet what requirements in order to obtain a filing date, according to Article 26(1) (*‘Conditions with which applications must comply’*) EUTMR? **2 marks**
- c) How are application fees for EUTMs calculated, according to Article 26(2) (*‘Conditions with which applications must comply’*) EUTMR? (No fee amounts are needed.) **1 mark**

**Total: 4 marks**

**Question 2**

Section 3 (*‘Absolute grounds for refusal of registration’*) TMA 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 six others.

**Do not list any of the types of specially protected emblem referred to in Sections 4, 57 or 58 of the TMA 1994.**

**6 marks**

**FC5 (P7) Trade Mark Law**  
**Question Paper – Sample Assessment Material**

**Question 3**

- a) Explain the legal benefit 'consent' from the owner of an earlier registered trade mark provides to a trade mark applicant or owner, according to Sections 5(5) ('*Relative grounds for refusal*') and 47(2) ('*Grounds for invalidity of registration*') TMA 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**

**Question 4**

Section 10(3) ('*Infringement of registered trade mark*') TMA 1994 sets out the scenario in which a sign, if used in the course of trade, can infringe a trade mark registered for dissimilar goods and services. Set out the requirements of this section.

**2 marks**

**Question 5**

Section 11(3) ('*Limits on effect of registered trade mark*') TMA 1994 provides a defence to infringement on the basis of an earlier right protected by virtue of any rule of law in a particular locality. Write notes on the requirements for that defence to operate.

**4 marks**

**Question 6**

List two categories of registrable transaction, other than an assignment or licence, as set out in Section 25 ('*Registration of transactions affecting registered trade mark*') TMA 1994.

**2 marks**

**FC5 (P7) Trade Mark Law**  
**Question Paper – Sample Assessment Material**

**Question 7**

- a) 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 Application and Registration'*) of the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*.

**3 marks**

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

**1 mark**

**Total: 4 marks**

**Question 8**

- a) Set out the conditions under which an EUTM application may be opposed by the proprietor of a trade mark, if an agent or representative of the proprietor has applied for registration.

**2 marks**

- b) Set out the grounds on which an EUTM 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'*) *EUTMR*. **Do not address the *Paris Convention*.**

**3 marks**

**Total: 5 marks**

**Question 9**

Article 13 (*'Exhaustion of the rights conferred by an EUTM'*) *EUTMR* sets out circumstances in which, despite the ownership of an EUTM, a proprietor may not enforce his trade mark rights. Set out these circumstances.

**4 marks**

**FC5 (P7) Trade Mark Law**  
**Question Paper – Sample Assessment Material**

**Question 10**

Set out four differences between:

- a UK trade mark application; and
- an EUTM application

in respect of the official search for earlier trade marks conducted by the UKIPO and EUIPO respectively.

**4 marks**

**FC5 (P7) Trade Mark Law  
Question Paper – Sample Assessment Material**

**SECTION B**

**Question 11**

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, so far, not 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.

**Prepare a memo to the attorney leading on this case in which you:**

- a) **give two 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;**  

**11 marks**
  
- c) **explain whether the remedies under the *Paris Convention* available to your client (assuming he is able to establish a successful case) differ from those available under the law of passing off described in part (a) of this question (Argentina is a member of the *Paris Convention*);**  

**1 mark**
  
- d) **discuss whether the rights under the *Paris Convention* 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.**  

**6 marks**

**Total: 20 marks**

**FC5 (P7) Trade Mark Law  
Question Paper – Sample Assessment Material**

**Question 12**

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.

**Do not address the law of passing off when answering any part of this question.**

- a) Advise your client of the ground of opposition which has the best chance of success, giving reasons for your advice.**

**9 marks**

Your client tells you that Karen White used to be an instructor at his school and believes she has "stolen" the name.

- b) Suggest a further possible ground of opposition, in light of the possible 'theft' of the name, including what your client must prove.**

**4 marks**

Karen decides to apply for another trade mark, 'SAX', protecting 'flight training and flying lessons'.

- c) Analyse the prospects for successfully opposing this trade mark application on relative grounds.**

**7 marks**

**Total: 20 marks**

**FC5 (P7) Trade Mark Law**  
**Question Paper – Sample Assessment Material**

**Question 13**

Your client is considering protecting a first trade mark in several European countries and a second trade mark in the US, UK, Japan and China.

**Write a list for your client setting out:**

- a) **nine advantages and four disadvantages of registering a trade mark as a single EUTM rather than registering the mark as separate national registrations in several EU territories;**

**13 marks**

- b) **five advantages and two disadvantages of registering a portfolio of trade marks using the *Madrid Protocol*, rather than registering the mark as separate national registrations.**

**7 marks**

**Total: 20 marks**

**Question 14**

- a) **Set out precisely (including any limitations and qualifications) the grounds for revocation of a UK trade mark, described in Section 46 ('*Revocation of registration*') TMA 1994.**

**17 marks**

- b) **Explain the circumstance under which a court, rather than the UKIPO, would hear an invalidity case.**

**3 marks**

**Total: 20 marks**