

## P7 2010 Examiner's comments

This paper should have been straightforward to pass by simply learning the sections of the Acts and case law on the syllabus. Those candidates that did so obtained the high marks they deserved.

There were no 'trick' questions. The Examiners were careful to include a description of the relevant section of the Act(s) where relevant as well as the section number to try to guide the candidates in the correct direction.

Question 1 was designed to give candidates some initial confidence. It was taken from the example paper available to candidates before the exam. The question asked for section 11 defences ie limits on effect of registered trade mark. The answer could be taken straight from the Act. It was important to remember that some of the defences are qualified by 'in accordance with honest practices'. Question 1 was attempted by every candidate. More than a third of candidates obtained full marks.

Question 2 asked for criteria for infringement of a registered trade mark where that trade mark has a reputation and again this could be answered straight from the provisions of the UK Trade Marks Act. Candidates stating the 'a mark may not be registered for...' were not penalised but are encouraged to answer the question asked. A well answered question in general, although some candidates did obtain zero marks.

Question 3 related to the definition of a trade mark and was based on the trade marks training manual. The question was well answered by every candidate with most candidates obtaining full marks. Part b) was ambiguous and candidates answering **either** a selection from words, designs/logos, letters, numerals, the shape of goods or their packaging, slogans, jingles, scent, colours **or** certification/collective marks were given credit.

Question 4 relating to exhaustion of rights was very popular and on the whole well answered. Although the expected answer was that the owner could not prevent use once the goods have been placed on the market in the Community or EEA with the owner's consent; cannot prevent further dealings and/or user does not infringe were equally acceptable.

Question 5 related to passing off and was in general well answered with only a couple of candidates failing to achieve a pass on the question. Candidates were expected to detail the trinity for proving passing off in the first part of the question and that the party able to enforce the right must be in business or trade and only the person, business or group owning the goodwill, not the person deceived.

Question 6 entitlement to be an applicant for a Madrid Protocol application was again taken straight from the example paper and generally well answered. Candidates were simply expected to detail the qualification criteria such as a national, or a domicile or having as real and effective industrial or commercial establishment in a Contracting State or Organisation. It should be remembered being a national and domicile of a contracting state are distinct.

Question 7 related to provisions for assignment of a UK registered trade mark. There was some confusion around unregistered transactions being ineffective against a person acquiring a conflicting interest in ignorance of an assignment, although most candidates recognised that there were no damages or account of profits unless an assignment is

registered within 6 months. However there seemed to some confusion between the difference between costs and damages, which are not the same. An effective assignment must be in writing and signed by the assignor.

Considering that question 8 was on the example paper it was surprising that this was the one of the most poorly answered questions in part A of the paper. Candidates are encouraged to look carefully at the similarities and differences between UK and CTM provisions, as this is a likely area for questions to arise. Answers were often muddled and confused. Triple identity is a key to seniority, with the owners of the CTM and national rights being identical for an identical mark covering the same goods/services or contained within those for which the earlier national right is registered. Many candidates forgot to mention seniority only becomes operative when the earlier right lapses or is surrendered and that seniority in essence enables the earlier rights of the national rights to live on.

Candidates could obtain full marks on question 9 by quoting straight from the Act and several candidates manage to do so. However, it was quite easy to drop marks through careless recollection. It is important to remember that identical marks and identical goods/services do not require a likelihood of confusion to be shown. Furthermore, opposition on the basis of marks with a reputation does not require a similarity between the goods/services.

Question 10 related to licensing and was not particularly popular. However, the question was broken down into subsections and it should have been possible to obtain quite a good mark. This question may have been unpopular because it asked about both UK and CTM provisions. A licensee of a UK registered mark must ask the proprietor to take action first and can only take action themselves if the proprietor refuses or fails to do so within two months. A non-exclusive licensee of a CTM must gain consent from the proprietor, although an exclusive licensee can take action if the proprietor fails to take action when requested.

Question 11 related to grounds for invalidity and was answered by every candidate. The first part of the question could simply be answered by reciting the relevant section of the Act. Candidates should however remember that use post-registration does affect the issue of invalidity (acquired distinctiveness). This question received the highest average mark of all the questions in part B.

Question 12 was the only question covering procedural matters. The question was answered very well by most candidates. A basic understanding of a small amount of the practice of examining an application by the UKIPO is needed to gain full marks in the part of the question in that the application is examined on absolute grounds and an advisory search is conducted. Candidates were expected to make it clear that the applicant has one opportunity to argue against the cited marks in the advisory search and has the option to continue with the application on the basis of notification where necessary. Candidates should be aware that only the owner of the prior relative rights can oppose an application on the basis of those rights. Absolute grounds of opposition can be raised by any party. The period of opposition is two months minus one day extendable by one month. The final part of the question can be answered by a simple recitation of the Act.

Considering that questions 13 and 14 appeared on the example paper it was surprising that there were the most poorly answered questions in part B.

Question 13 was a compare and contrast question and only a couple of candidates answered this question well. Conversion and transformation were sometimes confused.

Regarding question 14 there is very little case law on the syllabus so it is not surprising if a question arises relating to these cases. Marking was quite generous as there were quite a few points which could have been made but again only a couple of candidates managed to take advantage of this. Candidates should remember the points of global appreciation of marks, marks are perceived as a whole, overall impression of the marks taking into account their distinctive and dominant characteristics, the more distinctive the mark the more likelihood of confusion, association is not sufficient to establish confusion, a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, geographical terms should be free to all to use but that the whether the name has become or is likely to become associated with a particular industry has a bearing on the issue of distinctiveness. The guiding points of these cases can be recited in the same way as sections of the Act.

Question 15 was based on the Trade Marks Training Manual and was answered surprisingly well although several candidates did not answer all the sections of the question. The first part of the question could be answered by simply reciting the relevant part of the regulation and for the second part it was important to remember the 'cascade criteria' starting with the defendants nationality.