

## P7 2011 Examiner's comments

The paper was intended to cover most aspects of the syllabus with straightforward questions that could be answered by simply learning the provision of the acts/regulations and the case law covered by the syllabus.

Candidates are reminded that it is extremely helpful if they can follow the instructions regarding numbering the questions and pages. Is it surprising how many candidates failed to do so. It is helpful if the questions are arranged in numerical order before numbering the pages. One candidate failed to answer the correct number of questions and a lot of time was spent looking for the 'missing' pages due to incorrect page numbering.

Question 1, well known marks, was the most unpopular question of part A with fewer than half the candidates attempting the question. In general it was poorly answered although a couple of candidates obtained full marks. Marks were awarded for making the following points: can prevent use/prevent registration of a mark well known in that country for same or similar goods, also applies where essential part is a reproduction or imitation.

Question 2, licensing agreements, very well answered by the majority of candidates. Part b) caused the most problems: several exclusive licences may exist where the licence is limited to particular goods/services or where a licence is limited to particular locality or territory.

Question 3, infringement of Community Trade Marks, popular and generally very well answered although a couple of candidates missed the point that the question was about infringing **acts** not about infringing marks/likelihood of confusion.

Question 4, observations at OHIM, a lot of candidates struggled with this question. Following the publication of the Community trade mark application, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Office written observations, explaining on which grounds under Article 7, in particular, the trade mark shall not be registered. The observations are communicated to the applicant who may comment on them. Observations may be submitted after publication and within 1 month after the Opposition period. If opposed then before end of opposition proceedings. (Candidates were not penalised for stating that the observations need to be filed by the end of the opposition period as filing observations earlier than strictly needed is perfectly acceptable in practice).

Question 5, grounds for Opposition, surprisingly few candidates gained full marks on this question. Marks were awarded for: identical mark and goods or services; mark /or goods or services only similar + confusion; registered by an agent; earlier unregistered rights; goods or services not similar but mark has reputation etc. Half a mark was deducted if the candidate stated identical mark and identical goods/ services **with** likelihood of confusion.

Question 6, duration and renewal, a straightforward question answered well by most candidates although it was alarming how many candidates thought you could pay a renewal fee at the UK-IPO without penalty up to the end of the calendar month in which the fee falls - this is only true at OHIM.

Question 7, revocation of Community Trade Marks, many candidates answered this question poorly due to use of 'woolly' terms. A rigorous answer was expected - marks were awarded for the

following points: the trade mark has not been put to **genuine** use for a **continuous** period of five years; **in the Community/in connection with the goods or services**; there are **no proper reasons** for non-use; in consequence of **acts or inactivity** of the proprietor, the trade mark has become **the common name** ("generic" was accepted although this is not really synonymous with **the common name**) ; in **consequence of the use by the proprietor** the trade mark is **liable to mislead**. Credit was given for stating that the commencement or resumption of use within a period of three months prior to filing of the application for revocation is disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application may be filed.

Question 8, doctrine of free movement of goods, some very poor answers were presented; marks were awarded for the following points: **Quantitative restrictions on imports and exports** and all **measures having equivalent effect** are prohibited **between EU Member States**. However prohibitions or restrictions on imports, exports or goods in transit **may be justified** on grounds of the protection of **industrial and commercial property** as long as such prohibitions or restrictions **do not, constitute a means of arbitrary discrimination/a disguised restriction** on trade. Credit was given for sensible comments about exhaustion of rights.

Question 9, Priority and Seniority of Community Trade Marks, this was quite a simple question but was answered worse than average. Marks were awarded as follows no matter which section (a or b) the candidate stated the information: Priority and Seniority both require same proprietor, same trade mark, some or all of the same goods or services. Right to priority can be assigned. Priority is available for earlier trade mark in any Convention country but only available in EU for Seniority. Period limited to 6 months for Priority, Seniority may be claimed later.

Question 10, this was a case law question identical to the one set last year. Those candidates that had read and memorised last year's Examiner's comments did very well, some scoring full marks. Candidates should remember the following points: marks appreciated globally; taking account of all the relevant factors; judged through the eyes of the average consumer who normally perceives a mark as a whole considering visual oral and conceptual similarity and overall impressions created by the marks bearing in mind their distinctive and dominant components; a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; there is a greater likelihood of confusion where the earlier trade mark has a greater distinctive character, either per se or because of the use that has been made of it (credit was also given for mention of reputation); mere association is not sufficient for the purposes of holding confusion; if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion.

Question 11, absolute grounds for refusal and acquired distinctiveness; in part a) simply stating that the mark was outside statutory definition did not gain a mark the candidates needed to specify what this actually means ie not a sign/not capable of distinguishing .

Marks were awarded for mentioning marks which are non-distinctive ie **devoid of any distinctive character** and marks which are descriptive ie consist **exclusively of signs or indications** which may serve, in trade, to designate characteristics of goods or services ie 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. Candidates did not obtain full marks if 'other characteristics' not mentioned even if the specific list or a subset of the list mentioned in the act was given.

Marks were awarded for mentioning signs which have become customary in current language or practices of the trade. Marking was quite lenient regarding the specific language used by the candidates although it does help the Examiner if the language used in the act can be recited.

Only some of the above grounds may be overcome by **use made of the mark before registration** which may mean the mark has **gained distinctive character**; candidates must identify which grounds may be overcome in order to gain full marks.

In part b) marks were gained for the following points: a mark will have gained distinctive character if a significant proportion of the relevant class of persons identifies goods/services as originating from a particular undertaking because of the trade mark; if a particular locality is associated with goods/services the registration will be denied without additional distinctive matter in the mark.

Question 12, Restitutio in Integrum, this was a straightforward question which could be answered directly from the act and was answered better than average as a result.

Question 13, relative grounds of refusal for UK applications, candidates gained the highest average mark on this question. Marks were lost where claiming seniority was mentioned but it was not explicitly mentioned that seniority must be to an **earlier dated** mark and must be to a **UK** registration. Not all candidates remembered that an earlier application date **or priority date** were relevant. Most candidates were aware that the opposition period expires the **day before** the 2 month anniversary of the publication. Credit was given for this point.

Question 14, Madrid Protocol applications, this was the most poorly answered question in part B. Applicants may be by a national or a party domiciled or a party having a real and effective industrial or commercial establishment in a Contracting State/Organisation and have an application or registration in that Contracting State.

A Madrid Protocol Application may be based on more than one application or registration where it is the same Mark/same ownership/same Office of Origin. Transformation is available when registration cancelled, in respect of all or some of the goods and services, at the request of the Office of origin, not at request of proprietor. May be requested in any contracting party to the extent that the International Registration had effect. The national trade mark application will have date of filing/priority/date of subsequent designation of the International registration as appropriate. Must be filed within three months of cancellation.

Question 15, Marks awarded for sensible points such as those below, there may have been others as marks were given for any valid points. Only one mark available for each point even when stated twice eg as an advantage of national and a disadvantage of CTM or vice versa.

National application cheaper if only one or few countries needed. CTM use not required through whole of EU to maintain validity. Some offices notify earlier mark owners conflicts so infringement risks are raised. Opposition more likely for CTM as may arise from any one of 27 countries. CTM don't need agents in each country. CTM don't need numerous translations. CTM only one renewal

deadline. CTM unitary right ie can't be assigned for different countries- if fails falls completely but can convert if necessary. CTM can claim seniority from earlier national right and allow that to lapse. CTM will automatically expand to new EU countries. If jurisdictional conditions met (cascade criteria) injunction under CTM has pan European effect.