

## P7 November 2012 Examiner's Comments

Overall the standard of the papers and the level of preparation were good, and this was reflected in a higher pass rate this year than there had been in previous years.

Every candidate elected to answer the first three questions which were all straightforward and generally achieved high marks.

Question 1 simply required recitation of the Act regarding definition of a trade mark and what a mark may consist of. Minor variations were acceptable (eg *goods **and** services* instead of *goods **or** services*, *shape of **products*** instead of *shape of **goods** etc*). More than half the candidates achieved full marks and no candidate failed this question.

Question 2 again required recitation of the Act. The main stumbling block was regarding the requirement for a declaration that the mark is in use by applicant or there is a bona fide intention of use. Candidates stating that there was an honest intention to use or that there will be or has been 'bona fide use' were awarded marks.

Question 3 asked what acts constitute use of a sign in relation to infringement; again many candidates achieved full marks. The point regarding contributory infringement *if when he applied the Mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee* was where most candidates lost marks although *believes* or *suspects* were accepted for *had reason to believe*.

Question 4 asked the meaning of an earlier trade mark. Candidates needed to remember to state that the mark must have an earlier filing or priority date. There were marks available for noting that CTMs with a valid claim to seniority and well known marks under the Paris Convention could be earlier trade marks.

Question 5 was the least popular and the least well answered question in Part A. Many candidates appeared to be advising how to respond to an official action on a patent application. There were marks available for stating that the Examiner will notify the applicant and invite comments and will notify the proprietor(s) of the earlier trade mark(s) (if they have not opted out) but will not refuse the application. The Applicant has a one time opportunity to argue against the relevance of the citations, can simply indicate there is no objection to the application being notified to the proprietors of the citations/do nothing/ask to proceed to publication or may withdraw the application.

Question 6 was generally well answered. Although there were a few variations on the correct terminology, when it was clear the candidate understood the nature of the transaction (eg transfer upon death) marks were awarded.

Question 7 related to renewal fees. Still an alarming number of candidates think you can pay a UK renewal fee until the end of the calendar month in which the fee falls due. Parts b) and c) did not actually refer back to part a) but if an incorrect date from a) was used with correct reasoning in parts b) and c) then the candidate was rewarded appropriately.

Question 8 related to consequences of not registering a transaction. Many answers were confused regarding the significance of registering the transaction within 6 months (the ability to claim costs for acts committed prior to the registration), and many candidates missed the

point that it may be possible to satisfy the court that it was not practicable to register the transaction within six months.

Question 9 related to grounds of opposition to a Community trade mark. This simply required recitation of the Regulation so it was surprising that no candidate achieved full marks for this question. *Risk of confusion* was accepted for *likelihood of confusion*.

Question 10 was more practical than any previous questions that have been asked in this paper but marks were available for making sensible points and observations regarding the facts of the case and marks were awarded freely for those that did so. However, less than half the candidates chose this question and most of those that did, did not score particularly well. It was surprising how many candidates could quote the provisions regarding the effect of claiming priority when asked directly, but were unable to apply it to a practical scenario. Equally, many candidates seemed to be aware that 'passing off' rights are a ground for opposition (at least to a CTM) in part A, but that knowledge seemed to desert them when answering this particular question. Marks were available for noting that priority could be claimed from the earlier US application, thus a new UK application could predate the conflicting application, discussing passing off as a ground of opposition, considering the similarities and/or the likelihood of confusion between the respective marks and goods and coming to a reasoned conclusion regarding the likelihood of a successful opposition.

Question 11 asked for a discussion of *Sabel v Puma*. Most candidates were able to make sensible comments about the case and nearly all candidates achieved a pass with one candidate achieving full marks.

Question 12 asked for a comparison of the effects of claiming priority vs claiming seniority. Marks were available for the following points although candidates making sensible observations not included here were also rewarded. For priority, the CTM must be filed within six months after the first filing of a trade mark in a Paris Convention or WTO country but can be claimed up to 2 months after the OHIM filing date. Such subsequent applications are deemed to have the same date as the first filing. Seniority can be claimed when the owner has earlier national registrations in one or more EU territories or an International Registration having effect in one or more EU territories. It does not backdate the CTM. Seniority claims must be made within two months after filing the CTM application or any time after completion of registration. The sole purpose is to enable the owner to allow the national registrations to lapse without losing the "seniority" of the local filing dates. For both priority and seniority, the proprietor and the mark must be identical. The g/s of the mark from which priority/seniority is claimed must not be wider than the earlier mark.

Question 13 was a straightforward question asking for grounds of invalidity and revocation of a Community Trade Mark and simply required recitation of the relevant provisions.

Question 14 was a more open-ended discussion question and was generally answered quite poorly with approximately half the candidates failing to achieve a pass mark. Virtually all candidates missed the point that in transformation the national trade mark application will have date of filing/priority/date *or subsequent designation* of the International registration as appropriate. An example answer which would achieve full marks is included here:

### *Conversion*

- *Available to the extent that the Community trade mark application is refused, withdrawn, or deemed to be withdrawn or ceases to have effect.*
- *May be requested in any member state except...*
- *If revoked on the grounds of non-use: -- unless the Community trade mark has been put to use which would be considered to be genuine use under the laws of a particular Member State conversion will not be allowed.*
- *Will not be allowed if grounds for refusal of registration or grounds for revocation or invalidity apply to the Community trade mark application/registration resulting from a decision of the Office /national court*
- *The national trade mark application will have date of filing/priority/seniority of the converted CTM as appropriate.*
- *Must be filed within three months of refusal/withdrawal/cease.*

### *Transformation*

- *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 IR 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.*

Probably due to the fact the question had been asked before, Question 15 was answered by most candidates and was the highest scoring question in part B. Nearly all candidates correctly identified the Cascade principle and knew who was entitled to be an applicant for a Madrid Protocol application.