

FC5 (P7) Trade Mark Law  
FINAL Mark Scheme 2017

**Half marks may be awarded where candidates have not been precise**

In this paper:

- “EUTM Regulation” means *Council regulation (EC) No 207/2009 of 26 February 2009 on the European Union Trade Mark*, as amended; and
- “UKIPO” means the UK Intellectual Property Office.

**PART A**

**Question 1**

Set out the circumstances in which the High Court of England and Wales, acting as an ‘EU Trade Mark Court’, has jurisdiction over a defendant who has infringed an EU Trade Mark but who is domiciled in the United States.

**Answer:**

**[Article numbers are not required]**

Per Article 97 of the *EUTM Regulation* -

The infringement is committed in England or Wales. **[1 mark]**

or

The defendant has an establishment in England or Wales **[1 mark]**

or,

If the defendant has no establishment in the EU **[1 mark]**, the plaintiff is domiciled **[1 mark]** or has an establishment **[1 mark]** in England or Wales.

**[Alternative marks for:]**

Or the parties agree / the defendant enters an appearance before the English court. **[1 mark or either]** subject to the Regulation 44/2001.

**Total: 5 marks**

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Question 2

(Assume all dates in this question and your answer are ordinary working weekdays – except 19–22 April 2019)

Your client, Charles, gives you an incomplete list of his trade marks that are near their renewal date:

Mark	Jurisdiction	Priority Date	Filing Date	Date of Registration	Next Renewal Date
HYDROGEN	UK	31 July 2009	31 August 2009	30 April 2010	
HELIUM	European Union	20 July 2009	20 August 2009	20 April 2010	
LITHIUM	UK				20 April 2019
BERYLIUM	MADRID PROTOCOL designating:				
	UK				10 July 2017
	France				10 July 2017

a) When is the next renewal date for HYDROGEN?

1 mark

b) When is the next renewal date for HELIUM?

1 mark

c) 19 and 22 April 2019 are Good Friday and Easter Monday. By what date must the renewal request reach the IPO to ensure LITHIUM is renewed on time?

1 mark

The BERYLIUM trade marks have expired. Charles explains he has been seriously ill and could not attend to the renewal before the deadline, but says it is important he does not lose the priority date.

d) What action should you take?

2 marks

Total: 5 marks

Answer:

- a) 31 August 2019 [1 mark]
- b) 20 August 2019. [1 mark] (Since the 2016 amendments to the Regulation, renewal deadlines are no longer rounded up to the end of each month).
- c) 23 April 2019 [1 mark]
- d) Renew as normal. [1 mark] A surcharge payment will be due. [1 Mark] (There is no need to seek *restitutio* or explain the delay).

Total: 5 marks

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Question 3

- a) Explain the benefit of registering, at the UKIPO, an exclusive licence to a trade mark that includes the right to bring infringement proceedings.

3 marks

- b) State any deadline for registering such a licence and a consequence for not meeting it.

2 marks

Total: 5 marks

Answer:

**[Knowledge of section numbers is not required]**

- a) The transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of it. **[1 mark]** In the case of this licence, without registration, the owner could grant licences to other UK manufacturers, against whom the licensee would have no remedy **OR** the owner could grant an exclusive licence covering the UK to another manufacturer, which would prevent the licensee from using the mark. **[1 mark for either.**

Secondly, the licensee will not be able to bring an action **[1 mark]**, as licensee (under section 31 - (Exclusive licensee having rights and remedies of assignee.)

**[Alternative 1 mark]** available for explaining that licensees receive notice of subsequent transactions]

- b) The licensee will not be entitled to costs in respect of any infringement of the registered trade mark occurring after the date of the licence, but before the transaction is registered. **[1 mark]**. The deadline to avoid this is 6 months from the licence date **[1 mark]** (ordinarily).

Total: 5 Marks

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**Question 4**

Your client, Hadrian's Well Ltd, sells bottled mineral waters named after Roman emperors, and has applied to register an EU Trade Mark for the wordmark NERO, for '*aerated waters*'.

The application is found not to fulfil the requirements of Article 7(1)(a), (b), (c) and (d) of the *EUTM Regulation*, as 'nero' is modern Greek for 'water'.

- a) **Explain whether evidence showing most EU citizens understand the word 'NERO' only as the name of a Roman emperor will assist your client.**

**1 mark**

Your client instructs you to abandon the EU Trade Mark application, and instead apply for separate trade marks at national intellectual property offices.

- b) **Explain the advantage of using the EUIPO's 'conversion' mechanism over making new national trade mark applications. Assume the former is the slower and more expensive option.**

**1 mark**

- c) **Explain whether the EU Trade Mark application can be converted into applications for every EU jurisdiction.**

**3 marks**

**Total: 5 marks**

**Answer:**

**[Knowledge of section numbers is not required]**

- a) An objection applies notwithstanding that the grounds of non-registrability obtain in only part of the EU **[1 mark]** and hence is no assistance (unless the survey shows the generic meaning of the word is displaced in Greece and Cyprus.)
- b) The conversion mechanism will allow Hadrian's Well to retain the priority and filing date **[1 mark for either]** of the EUTM application. **[Alternative mark available for a good explanation as to why conversion might be simpler]**
- c) The objection relates to Greece **[1 mark]** and Cyprus **[1 mark]**, and so conversion is precluded in these jurisdictions **[1 mark]**.

**Total: 5 Marks**

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**Question 5**

Emerald Ltd sells Irish whiskey throughout Europe under the name 'HIBERNIA'. HIBERNIA sells at a high price in France because it is considered a premium product due to frequent advertising on French television. Emerald needs that extra income to pay for the French advertisements.

Harry buys HIBERNIA whiskey cheaply in Germany and sells it in France.

- a) **Assuming Emerald owns an EU Trade Mark for the name HIBERNIA, protecting 'alcoholic spirits', advise Emerald whether the EU Trade Mark can be used to stop Harry.**

**4 marks**

- b) **Explain if it makes any difference if, rather than an EU Trade Mark, Emerald held separate German and French trade marks.**

**1 mark**

**Total: 5 marks**

**Answer:**

**[Knowledge of section numbers is not required]**

- a) No. Under Article 13 Emerald's rights are exhausted **[1 mark]** as the goods were put on the EEA market with Emerald's consent. **[1 mark]**  
There is no legitimate reasons to prevent further commercialisation **[1 mark]**: The quality of the goods is unaffected and differential pricing is not a justifiable reason. **[1 mark for either]**.
- b) No, save the exhaustion of rights in such instances stems from the direct application of Article 34 of the EU Treaty or Article 7 of the Trade Marks Directive (i.e the French equivalent to Section 11 of the UK Trade Marks Act) **[1 mark for either]**.

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**Question 6**

Bluebottle Ltd manufactures carbonated beverages in transparent glass bottles. Their interior surface is visibly dimpled. These dimples make the beverages more effervescent. Bluebottle wants a trade mark registration to monopolise the concept of dimples.

- a) **Give the two most likely grounds on which the UKIPO would object to a trade mark application seeking to protect ‘beverages’, comprising a representation of the dimpled interior surface of a bottle.**

**3 marks**

Bluebottle patented effervescence-inducing dimples twenty years ago, and has refused to license the invention. Surveys show that nearly the entire UK public links dimples with Bluebottle products.

- b) **Explain whether this assists in overcoming the UKIPO’s objections.**

**2 marks**

**Total: 5 marks**

**Answer**

**[Knowledge of section numbers is not required]**

- a) The dimples are necessary to obtain a technical result, contrary to section 3(2)(b) **[1 mark]**.

As the dimples have a technical effect or otherwise would not readily be appreciated as a trade mark **[1 mark for either]**, the dimples will be devoid of distinctive character contrary to section 3(1)(b) **[1 mark]**

- b) Evidence of acquired distinctiveness can overcome the section 3(1)(b) objection **[1 mark]** but not the 3(2)(a) objection **[1 mark]**.

**Total: 5 Marks**

**Question 7**

William has invented a new artificial sweetener. No details have been publicly disclosed.

William wishes to register the generic name of the chemical, expressed in standard chemical nomenclature, as a registered trade mark. No chemical of that name has existed before.

**State the three grounds for refusal within Article 7(1) of the EUTM Regulation, ‘Absolute Grounds for Refusal’, which would be raised by the EUIPO were William to apply for a trade mark, explaining the reasons why these grounds apply.**

**5 marks**

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**Answer**

**Up to five marks for any three of the following grounds and explanations: [Knowledge of section/article numbers is not required]**

The mark would offend against:

Article 7(1)(a) as the mark does not meet the requirements of Article 4, namely that the mark is incapable of distinguishing the goods or services of one undertaking from those of other undertakings. **[1 mark]** being the name of the product itself. **[1 mark]**

Article 7(1)(c), as the mark is descriptive of a characteristic of the product **[1 mark]** namely its composition. **[1 mark]**

Article 7(1)(d), as the mark consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade: **[1 mark]** chemical nomenclature being built up of standard component indications structured in a set pattern **[1 mark for this or any similar explanation]**

Article 7(1)(b). Because the mark is descriptive, **[1 mark]** it cannot be distinctive. **[1 mark]**

**Total: 5 Marks**

**Question 8**

Explain, where a trade mark comprises an unauthorised copy of a copyright drawing, the grounds for preventing the registration of:

- a) a UK trade mark application; and

**2 marks**

- b) an EU Trade Mark application.

**3 marks**

**Total: 5 marks**

**Answer:**

**[Knowledge of section/article numbers is not required]**

- a) The owner **[1 mark]** (or other person entitled to prevent the use of the work) has an earlier right by reason of section 5(4)(b), and may bring section 38 opposition proceedings. **[1 mark. Accept "right" to bring opposition proceedings as its earlier existence is inherent]**
- b) There is no provision in Article 8 for allowing a copyright owner to oppose the registration of an EU trade mark prior to registration **[1 mark]**. The owner **[1 mark]** (or other person entitled to prevent the use of the work) must pursue invalidity proceedings on Article 53(2)(c) grounds, only after the mark is registered. **[1 mark]**

**Total: 5 Marks**

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**Question 9**

- a) Explain the defence against infringement actions benefiting owners of registered trade marks, provided by section 11(1) of the *Trade Marks Act 1994*.  
**1 mark**
- b) Does section 11(1) provide a defence against the infringement of an EU Trade Mark?  
**1 mark**
- c) Can holders of EU Trade Marks benefit from a section 11(1) defence?  
**1 mark**
- d) Does section 11(1) provide a defence to a passing-off action?  
**1 mark**
- e) Is a section 11(1) defence available to the owner of a trade mark that is vulnerable to being found invalid?  
**1 mark**

**Total: 5 marks**

**Answer**

- (a) A registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered **[1 mark]**
- (b) No **[1 mark]** (EUTMs are not Trade Marks as defined in Act)
- (c) No **[1 mark]** (nor is there any equivalent provision in the EUTMR)
- (d) No **[1 mark]**
- (e) With regard to invalid trade marks, the defence applies only to transactions past and closed **[1 mark]**.

**Total: 5 Marks**



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Part B

Question 10

Camilla files a UK trade mark application for a beer bottle label. The application is accepted for publication.

Shortly before publication, Camilla needs to amend the label because the beer's alcohol content has been reduced by 2%. It is a criminal offence to indicate an incorrect alcohol content figure.

In the representation of the label as filed, the alcohol content is barely legible.

Explain:

- a) the three circumstances in which a representation of a trade mark may be amended, according to section 39(2) of the *Trade Marks Act 1994*. 3 marks
- b) whether the representation of Camilla's label can be amended. 2 marks
- c) the consequences of doing nothing, in respect to the future enforceability of the trade mark against infringers under section 10 of the Act. 4 marks
- d) the consequences of doing nothing, in respect of any counterclaim that a defendant might be able to bring against Camilla, should Camilla seek to enforce her trade mark. 3 marks

Total: 12 marks

Answer:

**[Knowledge of section numbers is not required]**

- a) Section 39(2) TMA1994 provides that an application may be amended only by correcting—
  - (i) the name or address of the applicant, **[1 mark]**
  - (ii) errors of wording or of copying, **[1 mark]** or
  - (iii) obvious mistakes **[1 mark]**,
- b) There was no error or mistake. **[1 mark]** The scenario does not meet any of these requirements and so the amendment cannot be made. **[1 mark]**.
- c) Enforceability section under 10(1) is most unlikely to be affected **[1 mark - to be awarded as long as Section 10(1) is considered, even if the opposite conclusion is reached, as candidates are not expected to know the case law interpreting the term 'identical']**.

Enforceability under section 10(2) and section 10(3) grounds would certainly not be affected. **[1 mark]**. The representation as filed would be regarded as 'similar' **[1 mark]** to an infringing sign, wherever an amended trade mark would also have been regarded as

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‘similar’. There is the additional hurdle of demonstrating a likelihood of confusion [1 mark] however this will easily be inferred.

- d) Section 46 – Revocation of Registration – is pertinent as it provides a potential counterclaim to any infringement proceedings [1 mark] .

Marks are free from the threat of revocation as long as they have been used, and ‘*use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered*’ [1 mark].

In the scenario posed, there can be no doubt that the alcohol content figure does not affect the distinctive character of the mark as a whole and so Section 46 is not a threat. [1 mark - to be awarded as long as Section 46 is considered, even if the opposite conclusion is reached, as candidates might possibly imagine the amendment to be sufficiently significant. Accept also – for up to 3 marks - an argument based on this being a “proper reason for non-use”].

Total: 12 Marks

Question 11

- a) In the context of EU trade mark law, distinguish ‘**priority**’ (Articles 29–32 of the *EUTM Regulation*) from ‘**seniority**’ (Articles 34–35 of the *EUTM Regulation*).

7 marks

- b) In the context of the Madrid Protocol, distinguish a ‘**basic application**’ (Rule 1 of the *Protocol to the Madrid Agreement*) from a ‘**priority application**’ (Rule 9(4) the *Protocol to the Madrid Agreement*).

5 marks

Total: 12 marks

Answer:

Marks may be awarded for any points that distinguish the concepts, including the following:

- a) ‘Priority’ allows a person who has filed an application for a trade mark in any State party to the Paris Convention or WTO Agreement [1 mark] a right that permits the earliest such filing date to count as the date of filing [1 mark] of an EU trade mark application for the purposes of establishing which rights take precedence [1 mark] as long as it is filed within six months if the priority filing [1 mark].

‘Seniority’ allows the proprietor of an EU trade mark [1 mark] to surrender [1 mark] the earlier EU national trade mark or allow it to lapse, but be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered [1 mark] - in particular, to still benefit from the priority and filing date [1 mark] of the national trade mark. There is no time limit of claiming seniority [1 mark].

- b) A ‘basic application’ means an application for the registration of a mark that has been filed with the Office of a Contracting Party [1 mark] such an earlier filing being a condition of

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being able to use the Madrid Protocol. **[1 mark]**. The 'basic application' must remain in force for five years **[1 mark]** to avoid central attack of the international mark. The international application can be filed at any time. **[1 mark]**

- c) The priority application is the national application that is either the basic application or which that establishes the priority date of the basic application **[1 mark]**. It may be withdrawn, cancelled or left to lapse without consequence **[1 mark]**. It must be filed within six months of the first filing **[1 mark]**

**Total: 12 Marks**

**Question 12**

**In this question, DO NOT address the law of passing off.**

Sake is an alcoholic spirit made from rice. In Japan, the biggest selling brand is KI, made by the Japanese company Midori. Midori has maintained a Japanese trade mark for KI, protecting sake, for over fifty years. Midori has no trade marks outside Japan, and does not export to the UK.

Surveys show very few people in the UK have had sake. Of those who have, most have heard of KI.

Your client, Brown Ltd, recently launched a coffee-flavoured milkshake for the UK mass market, called KI, based on the first and last sounds of the word 'coffee'. You have applied to register a UK trade mark for it, protecting '*beverages*'.

Midori wishes to stop **registration** and **use** of 'KI' by Brown. This is a shock for Brown's marketing staff, none of whom had ever heard of Midori's product.

**Advise Brown on the steps it should take (if any), giving reasons for your answer.**

**12 marks**

**Answer:**

**[Knowledge of section numbers is not required]**

Midori has the benefit of being incorporated in a Convention Country **[1 mark]**

The mark is 'well known' in the UK on the grounds that although the section of the UK public with knowledge of saké is small, most of this market recognise the brand KI **[1 mark]**.

Midori's mark is an earlier mark to that of Brown **[1 mark]**

Brown's specification is sufficiently wide as to be regarded as identical/very similar to Midori's product as '*beverages*' can encompass alcoholic beverages. **[1 mark: candidates will not be penalised for not knowing how different alcoholic beverages are classified]**

Section 5 grounds are made out giving grounds for opposition **[1 mark]**

Were Brown to limit its specification to protect only '*milkshakes*', the goods cease to become similar **[1 mark]** and confusion is unlikely to result **[1 mark]**.

The dissimilarity is likely on following grounds: **[one mark each, up to 3 marks]**

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- Midori mark enjoys enhanced distinctiveness, but only for saké.
- They are both beverages. However,
- One is a speciality product, generally not known in the UK.
- Milkshakes and saké made from different ingredients.
- The products are neither complementary
- The products are not competitive
- ...especially considering that one is a spirit, and the other non-alcoholic.
- Distribution chains are different (specialist (licensed) outlets / general distribution).

Infringement grounds are likewise not made out. **[1 mark]** on the grounds that milkshakes (the product actually being sold) and saké **[1 mark]** are dissimilar products.

**[Allow well-reasoned answers that conclude that the goods are similar, as knowledge of sectorial case law is not required at this level, as long as some attempt is made to compare the goods using Cannon v MGM principles.]**

**12 marks**

**Question 13**

Green Ltd is a Scottish garden hose manufacturer. Green recently applied for a UK trade mark for the wordmark CALEDONIA (Latin for 'Scotland') for '*garden sprinklers*'. The mark has been accepted for publication because 'CALEDONIA' strongly alludes to, but is not descriptive of, Scottish products.

You act for a drinks company, Yellow Ltd. Its lemonade, CALEDONIA, has been the second-most popular carbonated beverage in the UK for over a decade. It has maintained UK trade mark protection for CALEDONIA for '*carbonated beverages*' for over forty years. Surveys show most of the UK population would know CALEDONIA as a famous brand of carbonated drink.

**Comment on the strength of Yellow's ability to bring opposition proceedings under Section 5 of the Trade Marks Act 1994 against Green.**

**12 marks**

**Answer:**

**[Knowledge of section numbers is not required.]**

**[Full marks are awarded for a reasoned analysis of each point regardless of the conclusion, even if it contradicts established case law or the answers here. Half marks are available for a cursory analysis of each point.]**

Section 5(1) and 5(2) grounds can be dismissed, as the goods '*garden sprinklers*' and '*carbonated beverages*' are clearly dissimilar. **[1 mark]**

Section 5(3) is the remaining ground. To succeed, it is necessary to demonstrate the following:

**Identity of signs. [1 mark]**

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**The earlier trade mark has a reputation in the United Kingdom.** Here this is met [1 mark]

**Use of the later mark is without due cause.** There is no evidence of lack of cause [1 mark].

The word 'Caledonia' is chosen by a Scottish company as a reference to Scotland. [1 mark]. The word that is strongly illusory (indeed picked up by the examiner as being even potentially descriptive) to a characteristic of a the trade mark [1 mark]

Yellow must prove either: [1 mark – i.e for indicating that any one of the following, if made out, would constitute grounds for opposition]

**Use would take unfair advantage of the distinctive character of the earlier trade mark.** The name already has an illusory meaning of pertaining to Scotland, and so not very distinctive. It is unlikely that consumers would buy a sprinkler on the basis that it must, due to the identity of the name, come from the same origin as a lemonade. [1 mark].

**Use would be detrimental to the distinctive character of the earlier trade mark.** CALEDONIA lemonade enjoys huge market recognition. Nevertheless CALEDONIA's position within the drinks market - or any obvious markets a drinks manufacturer might extend the brand into - would not be affected by Green's use. [1 mark]

**Use would take unfair advantage of the repute of the earlier trade mark.** It is not realistic that consumers would buy a sprinkler based on a reputation of a lemonade with a similar name. [1 mark]

**Use would be detrimental to the repute of the earlier trade mark.** There is nothing whatsoever to indicate that the repute of the drink would be tarnished by the use of the name on a sprinkler [1 mark]

**Conclusions –** Action under the Trade Marks Act is most unlikely to succeed [1 mark]

**[Also, allow up to three points for consideration of passing off, one each for an examination of goodwill, misrepresentation and confusion against the stated facts]**

12 Marks

**Question 14**

- a) What restraint is placed by common law on a trader's freedom to assign its goodwill?  
1 mark
- b) Explain, in the context of the law of passing off and the *Trade Marks Act 1994*:
  - i) whether a registered trade mark can benefit from '*goodwill*', but not be a '*mark that has a reputation in the United Kingdom*' for the purposes of section 5(3) of the Act.  
1 mark
  - ii) whether a trade mark can be a '*mark that has a reputation in the United Kingdom*' for the purposes of section 5(3), but not benefit from '*goodwill*'.  
1 mark
  - iii) whether a trade mark can be a '*well known trade mark*' for the purposes of section 6(1) of the Act but not benefit from '*goodwill*'.  
1 mark

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- c) In the context of the law of passing off, explain what is meant by '*secondary meaning*'.  
**2 marks**
- d) Explain why, for the tort of passing off to occur, it is not always necessary for a defendant to have applied a mark to its goods or services.  
**2 marks**
- e) Charlotte can demonstrate strong goodwill for her CAESAR brand fruit juice. George, a manufacturer of household electrical appliances, has just launched a new steam iron, called THE CAESAR. Give **two** reasons why Charlotte is unlikely to be able to succeed in a passing off action against George.  
**2 marks**
- f) Explain whether a claimant can succeed in a passing off action if it cannot demonstrate the defendant has caused it actual damage.  
**2 marks**

**Total: 12 marks**

**Answer**

- a) Answers along the lines of the following are acceptable:
- Goodwill cannot be assigned except with the business assets to which that goodwill relates **or**
  - The business to which the goodwill relates must continue as a going concern under its new ownership.
- [1 mark]**
- b)
- i. Goodwill can be established with quite low use. A 'mark with a reputation' requires evidence of significant use.  
  
**[1 mark]**
- Any mark with a reputation under the TMA will necessarily enjoy goodwill, as it will have enjoyed significant use, well above that required to establish goodwill. **[Also accept: A mark has been assigned without goodwill]**  
  
**[1 mark]**
- ii. A 'well known mark' is by definition a mark well known in an overseas Convention country. 'Goodwill' requires business in the UK. Hence it is common for 'well known marks' not to have goodwill.  
  
**[1 mark]**

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- d) Through use **[1]**, an otherwise non-distinctive sign has come to indicate the goods and services of one undertaking **[1 mark]** [i.e. it is the equivalent term under the law of passing off as 'acquired distinctiveness' is under trade mark law].

**[2 marks in total]**

- e) The tort merely requires there to be a misrepresentation but does not restrict how that misrepresentation might be effected **[1 mark]**. Although this frequently arises from the use of a trade mark, there are other scenarios, such as 'reverse passing off' where a trader claims credit for another's work, a misleading "get up", or false endorsement, where a trader falsely gives the impression that their goods have been approved by a celebrity. **[1 mark for any explanation or example]**

**[2 marks in total]**

- f) In these circumstances the products are so different that can be no misrepresentation as to origin. **[1 mark]**  
There is no damage to goodwill. **[1 mark]**

**[2 marks in total]**

- g) The 'classic trinity' test requires that damage be likely **[1 mark]**, not that it have happened. The likelihood of damage needs to be proven to the standard required in a 'quia timet action' **[1 mark]**. **[Accept also for 1 point an explanation based on likelihood of damage to future commercial opportunities]**

**[2 marks in total]**

**Total: 12 marks**

**Question 15**

Kate has been selling EDINBURGH-brand wine for some years. She wants to register the name EDINBURGH as a UK trade mark for 'wine'. The wine originates from New Zealand, and is shipped to Kate in the UK for bottling and sale.

There are no vineyards in Edinburgh because:

- there is no agricultural land within Edinburgh City Council's official boundaries; and
- the city's northerly latitude means grapes can only grow in heated greenhouses, which is not commercially viable.

**Applying only the case law of *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber*, advise Kate on her chances of successful registration.**

**12 marks**

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**Answer**

**[Alternative marks are available for other answers based on the analysis set out in *Windsurfing* on the registrability of graphic indications, even if they reach a different conclusion. However, no marks are available for a discussion of how acquired distinctiveness may be evidenced]**

EDINBURGH is a descriptive term, namely a geographic name. **[1 mark]** and so prima facie unregistrable. **[1 mark]**

There is no policy reason why registration cannot in principle be achieved through acquired distinctiveness **[1 mark]**. However, this is likely to prove an insurmountable hurdle **[1 mark]**.

The law does not only prohibit the registration of geographical names solely where the names designate places which are currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future **[1 mark]** as an indication of the geographical origin of that category of goods. Here it cannot be ruled out that a vintner in or near Edinburgh is capable of entering the wine market **[1 mark]**

Consideration must be given to:

- the degree of familiarity with the geographic name. Edinburgh is one of the largest cities in the UK and the capital of Scotland. **[1 mark]**. The name EDINBURGH would certainly be familiar to consumers as the name of a geographic location **[1 mark]**
- The term EDINBURGH could easily refer to surrounding area **[1 mark]** and not the area within the City Council boundaries.
- whilst growing grapes is described as not commercially viable, it is not impossible and a grower could be conceivably find a way of doing so, **[1 mark]**.
- it is not necessary for the wine to be grown in the geographical location in order for it to be associated with it. **[1 mark]** Further processing, such as bottling, can still be carried out in Edinburgh. **[1 mark]**

**12 marks in total**