

FC5 – Trade Mark Law  
FINAL Mark Scheme 2018

Half marks may be awarded for imprecise answers. There is no requirement to quote section or article numbers.

SECTION A

Question 1

Explain the following trade mark law terminology:

- a) Distinctive character. 2 marks
- b) Acquired distinctiveness. 1 mark
- c) Enhanced distinctiveness. 1 mark
- Total: 4 marks**

**Answer:**

Satisfactory answers include:

- a) The ability of a sign to be perceived by customers to be a trade mark **[1 mark, for any explanation covering more than ‘capability to distinguish’ or descriptiveness<sup>(i)</sup>]** used to differentiate the goods and services of one undertaking from those of others **[1 mark<sup>(ii)</sup>]**. (s3(1)(b) TMA) 2 marks
- b) The ability of a sign to be perceived by customers to be a trade mark, as a result of the use of the sign being of sufficient magnitude such as to have displaced any other significance or meaning **[1 mark]**. (s3(1) TMA) 1 mark
- c) The familiarity, though use, of a trade mark amongst its customers being sufficiently great that, upon seeing an identical or similar sign on similar or identical goods, those customers are more likely to be confused than would be the case with a sign with which they were not familiar **[1 mark]** (per *Sabel v Puma*). 1 mark
- Total: 4 marks**

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Question 2

- a) A US trademark application is rejected by the USPTO. What is the consequence for a UK trade mark application claiming priority from it? Give a reason for your answer.  
**1 mark**
- b) What is the consequence for a UK trade mark application if there is irrefutable evidence that the trade mark was descriptive on the priority date? Give a reason for your answer.  
**1 mark**
- c) Explain whether a trade mark application can ever have more than one priority date.  
**2 marks**
- d) A UK trade mark application is filed and withdrawn, and an otherwise identical EU trade mark application is filed. Explain why, in practice, the EU trade mark application cannot serve as the priority filing for any further trade mark application.  
**2 marks**

**Total: 6 marks**

Answer:

- a) There is no consequence: priority is established regardless of the fate of the priority application **[1 mark]**  
**1 mark**
- b) There is no consequence: the mark is assessed at the filing date **[0.5 mark <sup>(i)</sup> Allow if expressed in terms of an opportunity to acquire distinctiveness between priority and filing and priority is retained [0.5 mark <sup>(ii)</sup>]**  
**1 mark**
- c) It can. Multiple first trade mark applications, **[1 mark <sup>(i)</sup>]** covering different goods and services **[1 mark <sup>(ii)</sup>]** may have been filed during the previous 6 months (including the filing at issue).  
**2 marks**

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- d) A first filing will be ignored for the purposes of establishing priority if it is withdrawn without having been laid open to public inspection [1 mark <sup>(i)</sup>]. In practice, the UK application is published immediately [1 mark <sup>(ii)</sup>] and so will serve as the priority filing. [Note, the UK and EU being different jurisdictions does not itself give rise to loss of priority]

2 marks

Total: 6 marks

**Question 3**

Maxwell Ltd manufactures diggers and bulldozers. All its products are painted fuchsia pink.

- a) Explain the likely objection(s) to an EU trade mark, comprising only the description '*the colour pink, applied to construction vehicles*', for '*construction vehicles*'.

4 marks

There is overwhelmingly strong evidence to show that, throughout every state of the EU, distributors and buyers of construction vehicles understand fuchsia pink paint to indicate Maxwell products and only Maxwell products.

- b) Does this assist in overcoming the objection(s) in part (a) above?

1 mark

Maxwell started using fuchsia pink paint after its research department found that the brain's visual cortex was particularly alert to moving objects painted this colour. Maxwell subsequently adopted the colour in order to improve the safety of workers on construction sites.

- c) Explain whether this fact raises any potential grounds for objection beyond those specified in part (a), assuming again that there is overwhelming familiarity with Maxwell's fuchsia pink branding.

2 marks

Total: 7 marks

**Answer**

- a) A description per se is a legitimate representation under Article 4. However the description is not clear/precise/objective and so does not meet the requirement of Article 4 [1 mark <sup>(i)</sup>] in two ways:

'Pink' – What shade? [1 mark <sup>(ii)</sup>]

'Applied' – Where precisely? [1 mark <sup>(iii)</sup>]

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Secondly, colour would be regarded as non-distinctive under Article 7(1)(b) as customers would not ordinarily regard colour as a sign indicating origin **[1 mark<sup>(iv)</sup>]**.

**4 marks**

b) This could assist in overcoming the distinctiveness objection on grounds of acquired distinctiveness **[0.5 mark<sup>(i)</sup>]**, but not the validity of the representation **[0.5 mark<sup>(ii)</sup>]**.

**1 mark**

c) The colour pink is here ‘another characteristic’, of goods which is necessary to obtain a technical result and consequently is objectionable under Article 7(e)(ii) grounds **[1 mark<sup>(i)</sup>]**. Acquired distinctiveness cannot overcome an Article 7(e)(ii) objection **[1 mark<sup>(ii)</sup>]**

**2 marks**

**Total: 7 marks**

**Question 4**

Give three reasons why expired trade marks, whose registrations have expired in the last 12 months, are nevertheless still listed in UK search reports. **Do not discuss unregistered rights.**

**4 marks**

**Total: 4 marks**

**Answer:**

**Up to 4 marks for any three of the following.**

The application may be renewed late as of right in the first 6 months **[1 mark<sup>(i)</sup>]** or restored in the second six months **[0.5 mark<sup>(ii)</sup>]**.with due cause **[0.5 mark<sup>(iii)</sup>]**.

Section 6(3) provides that an expired trade mark continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry **[1 mark<sup>(iv)</sup>]** unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry **[1 mark<sup>(v)</sup>]**

An EU trade mark which has expired may nevertheless be converted into a UK trade mark. **[1 mark<sup>(vi)</sup>]** under Articles 112-114 ETMR. Such a request will not be recorded for potentially some months. **[1 mark<sup>(vii)</sup>]** even if just the 3 month application deadline is stated]

**Total: 4 marks**

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**Question 5**

When is a licensee of a United Kingdom registered trade mark permitted to bring legal proceedings in respect of an infringement of that trade mark?

**Total: 8 marks**

**Note: Question 5 was discounted because it assessed knowledge beyond the syllabus requirements. Processes were applied to ensure that no candidate was disadvantaged.' It should not be attempted if using this paper for revision. “**

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Question 6

The owner of a UK trade mark dies, bequeathing it to his daughter.

- a) Set out what now needs to be done, by whom, and by when, to implement the owner's will. [Do not discuss probate procedure.]

5 marks

- b) Set out the consequences of not meeting the requirements of the Trade Marks Act relevant to your answer to part (a).

2 marks

Total: 7 marks

Answer:

a)

Section 25(2)(d) provides that the making by personal representatives of an assent in relation to a registered trade mark is a registrable transaction. Hence:

- the PR [1 mark <sup>(i)</sup>] needs to make the assent in favour of the daughter [1 mark <sup>(ii)</sup>] (There is no fixed time limit for this).
- This assent needs to be registered [1 mark <sup>(iii)</sup>] (see note below) by an interested party (usually the daughter) [1 mark <sup>(iv)</sup>] within six months of the assent [1 mark <sup>(v)</sup>].

Note: An answer specifying that the PR's ownership of the intellectual property needs to be registered as a precondition of registering the onward assent to the daughter will not receive this mark.

5 marks

b)

Sections 25(3)(a) and 25(4) provide that

- 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 <sup>(i)</sup>] and
- where the mark is infringed before the transaction is registered, in proceedings for such an infringement, the court will not award costs [1 mark <sup>(ii)</sup>]

2 marks

Total: 7 marks

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Question 7

PASER is a registered EU trade mark for a ‘conducted energy weapon’; that is, a gun-like device that administers electric shocks to targets.

You act for the County Police Authority. It has developed a training booklet for internal use by its officers, that states:

*‘If the suspect becomes violent, a trained officer may paser him/her if no other restraint technique is effective.’*

The owner of the trade mark PASER comes across the booklet, and writes to demand that the word ‘paser’ be changed to ‘fire a conducted energy weapon’.

a) Explain why the owner is so concerned about the training booklet.

2 marks

b) Explain what remedies (if any) are available to the trade mark owner.

2 marks

Total: 4 marks

Answer

a) A trade mark can potentially be revoked [0.5 mark <sup>(i)</sup>] [per article 58 (1)(b)] if, in consequence of acts or inactivity of the proprietor [0.5 mark <sup>(ii)</sup>], it has become the common name in the trade for a product for which it is registered [0.5 mark <sup>(iii)</sup>]. Writing to the Police to explain that PASER is not a generic name can be used in evidence to demonstrate that any use was not the result of inactivity by the proprietor [0.5 mark <sup>(iii)</sup>].

2 marks

b) There is no remedy. Use is not in the ‘course of trade’ (a requirement of article 9(2)) [1 mark <sup>(i)</sup>] and there is no other remedy, as the use is not in a dictionary, encyclopaedia or similar reference work, that would afford a right of correction in the next edition under Article 12 [1 mark <sup>(ii)</sup>].

2 marks

Total: 4 marks

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SECTION B

Question 8

Part 1: Explain briefly the likelihoods of success of Marie, Erwin Ltd, Hertz GmbH and CIPA in a passing off action against the alleged wrongdoer in each scenario:

- a) Marie has a doctorate in nuclear chemistry, but since leaving university has been employed as a merchant banker. Pierre acquires a copy of Marie's doctoral theses, republishes it in a scientific journal falsely claiming it to be his own work, and subsequently receives a monetary prize for its brilliance.

**3 marks**

- b) Erwin Ltd has invested £10 million on advertising QUANTUM, a new cat food due to go on the market next month. Last week, Bohr Plc started selling its own cat food, also called QUANTUM, with the deliberate intent of inducing customers into believing it is Erwin's product.

**3 marks**

- c) Hertz GmbH, a German electricity company, sells electricity to German consumers under the name BLITZEN. A UK company, Faraday Ltd, has recently started selling electricity to British consumers, also under the BLITZEN brand. Some British consumers are aware of the German firm's services and wrongly assume the companies are linked.

**3 marks**

- d) CIPA (the representative body of Chartered Patent Attorneys) wishes to take action against Albert, an individual falsely claiming to be a 'Chartered Patent Attorney'.

**3 marks**



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**Part 2: Explain briefly whether it is possible to rely on the Paris Convention provisions benefiting ‘well-known marks’ in the following scenarios:**

- i) A French owner of an unregistered mark wishes to oppose a United Kingdom trade mark application. The mark has only ever been used in the United Kingdom, on the owner’s imported goods, and is well-known only to British consumers.

**2 marks**

- ii) A Jersey-incorporated owner of a registered French trade mark wishes to oppose a United Kingdom trade mark application. The mark has only ever been used in France, on goods made in the owner’s French factory. The mark is well-known to British consumers, from their holidays in France. Jersey is not a member of the Paris Convention.

**2 marks**

- iii) A French owner of a registered French trade mark wishes to oppose a United Kingdom trade mark application. The mark has only ever been used in France, where it is well-known. It is wholly unfamiliar to British consumers.

**2 marks**

- iv) A French owner of a registered French trade mark wishes to oppose a European Union Trade Mark application. The mark has only ever been used in France, where it is well-known. It is also well-known to other European consumers, from their holidays in France.

**2 marks**

**Total: 20 marks**

**Answer**

Part 1:

These actions are all unlikely to succeed:

- a) Marie is not carrying out any business [**1 mark**<sup>(i)</sup>] and so does not benefit from goodwill [**1 mark**<sup>(ii)</sup>]. Likewise the misrepresentation would not cause damage to any goodwill, there being none [**1 mark**<sup>(iii)</sup>]. **0.5 mark if expressed as the industries being too remote.]**

**3 marks**

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- b) Advertising alone is insufficient to create goodwill **[0.5 mark<sup>(i)</sup>]**. Goodwill requires trade by customers who have had the opportunity to sample the owner's product **[0.5 mark<sup>(ii)</sup> for any similar explanation]**. The misrepresentation would not cause any damage to the goodwill, as there is no goodwill **[0.5 mark<sup>(iv)</sup>]**. However, if Erwin is already in the business of producing cat (or pet) foods under other brands, it is likely to enjoy goodwill. **[1 mark<sup>(iii)</sup>]**. In such a case, there is clear damage to goodwill by reason of foreseeable diversion of trade **[0.5 mark<sup>(v)</sup>]** and so only in this case would passing off be made out.

3 marks

- c) Goodwill is jurisdictional, requiring customers who are purchasing services in the UK **[0.5 mark<sup>(i)</sup>]**. Knowledge of a service, but no sales in the UK, is insufficient to generate goodwill **[0.5 mark<sup>(ii)</sup>]**. Likewise there can be no damage to any goodwill **[1 mark<sup>(iii)</sup> Allow 0.5 mark for an explanation of damage occurring by reason of the UK market being closed off from future expansion]** nor any indication that consumer behaviour has changed because of the misrepresentation **[1 mark<sup>(iv)</sup>]**.

3 marks

- d) Goodwill exists in CIPA's business as a representative body **[1 mark<sup>(i)</sup>]**. Patent attorneys, collectively, benefit from goodwill in their legal businesses **[1 mark<sup>(ii)</sup>]**. However it is difficult to see how CIPA benefits from the latter goodwill: the misrepresentation would cause damage to the patent attorney collective profession's goodwill, not that of CIPA **[1 mark<sup>(iii)</sup>]** (applying *Chocosuisse*). **[Allow 0.5 mark for an argument that CIPA's goodwill might be damaged due to attorney subscriptions being threatened should they leave CIPA as a result of the dilution of the title]**.

3 marks

Part 2

- i) Yes. The owner is established in a Convention country **[0.5 mark<sup>(i)</sup>]**, and the mark is well known in the United Kingdom **[0.5 mark<sup>(ii)</sup>]**. There is no requirement that the mark be registered **[1 mark<sup>(iii)</sup>]**.
- ii) Yes. The mark is well-known in the United Kingdom **[1 mark<sup>(i)</sup>]**. The owner has a real and effective industrial or commercial establishment in a Convention country **[1 mark<sup>(ii)</sup>]**. This is all that is required.

2 marks

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**2 marks**

- iii) No. The marks is not well known in the United Kingdom [**1 mark<sup>(i)</sup>**] and therefore not entitled to protection as a ‘well-known mark’ in the United Kingdom [**1 mark<sup>(ii)</sup>**].

**2 marks**

- iv) Yes. The mark is well known in at least one ‘Member State’ of the EU [**0.5 mark<sup>(i)</sup>**] other than France [**0.5 mark<sup>(ii)</sup>**]. **Grounds for refusal in one member state is sufficient for the entire EUTM to be refused [1 mark<sup>(iii)</sup>**

**2 marks**

**Total: 20 marks**

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**Question 9**

Isaac is a British national who operates only from a premises in the UK. He is seeking trade mark protection in UK, France, Germany, Italy, Spain, and the USA.

- a) **Set out three advantage of obtaining (where possible) the required protection through a Madrid Protocol application, and three advantages of obtaining the required protection through filing directly at the national intellectual property offices.**

**6 marks**

- b) **Set out the two options that are potentially available to Isaac as a ‘Basic Application’ for the purposes of filing a Madrid Protocol application, and give one advantage of each option.**

**3 marks**

Isaac opts to use the Madrid Protocol, designating France, Germany, Italy, Spain and USA.

- c) **Explain how the making in 2003 by the USA Government, of a ‘*Declaration under Article 5(2)(b) and (c) of the Protocol*’, will affect the timescale for registration of the USA designation.**

**2 marks**

- d) **Set out precisely, for each of the designated jurisdictions listed, the period during which an opponent can commence opposition proceedings.**

**6 marks**

- e) **Set out how long, in each of the designated jurisdictions listed, Isaac has to put the mark to genuine use before it becomes vulnerable to revocation.**

**2 marks**

- f) **To designate the USA, Isaac is required to file at his Office of Origin what additional document?**

**1 mark**

**Total: 20 marks**

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Answer

a) **1 mark for any appropriate answer including:**

- MP filing avoid the cost/requirement for local attorneys
- MP filing avoid the cost/requirement for translations
- Renewals involve just one form.
- Direct filings avoid the risk of central attack.
- Direct filings can be assigned to nationals of any jurisdiction.
- Direct filings might be cheaper as they avoid WIPO fees

**(An explanation is needed to obtain any points for stating that filing is “cheaper”)**

**6 marks**

- b) An EU Trade Mark application or a UK trade mark application [**1 mark**<sup>(i)</sup>]. The EU Trade Mark brings an additional risk of ‘central attack’ in light of the greater potential for refusal or cancellation on absolute or relative grounds [**1 mark**<sup>(ii)</sup>]. A UK trade mark involves the additional expense of obtaining duplicate UK protection if an EU trade mark is designated [**1 mark**<sup>(iii)</sup>] – **Other valid answers are acceptable**.

**3 marks**

- c) The USA has declared that the time limit to notify a refusal of protection shall be 18 months [**1 mark**<sup>(i)</sup>] and that, where a refusal of protection results from an opposition to the granting of protection, such refusal may be notified after the expiry of the 18–month time limit [**1 mark**<sup>(ii)</sup>].

**2 marks**

- d)
- France – Two months [**0.5 mark**<sup>(i)</sup>] from publication [in the WIPO Gazette] [**0.5 mark**<sup>(ii)</sup>].
- Germany – Three months [**0.5 mark**<sup>(iii)</sup>] ] from the first day of the month after publication [in the WIPO Gazette] [**0.5 mark**<sup>(iv)</sup>].
- Italy – Three months [**0.5 mark**<sup>(v)</sup>] from the first day of the month after publication [in the WIPO Gazette] [**0.5 mark**<sup>(vi)</sup>].
- Spain – Two months [**0.5 mark**<sup>(vii)</sup>] from publication [in the Spanish Official Gazette] [**0.5 mark**<sup>(viii)</sup>].
- USA -30 days [**0.5 mark**] (extendable with cause [**0.5 mark**<sup>(ix)</sup>] up to 180 days) [**0.5 mark**<sup>(x)</sup>] from publication [in the US Official Gazette] [**0.5 mark**<sup>(xi)</sup>].

**6 marks**

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- e) France, Germany, Italy, Spain – five years [0.5 mark <sup>(i)</sup>] from grant [0.5 mark <sup>(iii)</sup>].  
USA – Three years [0.5 mark <sup>(iii)</sup>] from grant [0.5 mark <sup>(iv)</sup>].

**2 marks**

- g) A declaration of intent to use the mark, for the USA.

**1 mark**

**Total: 20 marks**

**Question 10**

**Full marks can be obtained from this question regardless of the ultimate conclusions reached.**

- a) Explain in a note to your supervising attorney whether the sign below, if used in the UK, infringes the earlier UK registered trade mark. (Assume no defences or counterclaims are available, and that the earlier mark has been used on a small scale.)

Earlier Trade Mark	EINSTEIN	Wine	(Class 33)
Sign	EINSTEIN'S	Wine glasses	(Class 21)

**10 marks**

- b) Explain in a note to your supervising attorney whether the UK trade mark application below can be opposed by the owner of the earlier registered trade mark. (Assume the earlier trade mark is valid and being used on a small scale).

Earlier Trade Mark	CROCODILE	Boat engines	(Class 12)
Trade Mark Application	ALLIGATOR	Boat engines	(Class 12)

**10 marks**

**Total: 20 marks**

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**Answer:**

**1 mark to be awarded for each valid point made, up to the maximum indicated for each step heading.**

Similarity of Marks [2 mark]

Very similar aurally, visually and conceptually (almost identical) differing by only one letter.

Conceptual similarity would probably predominate in this case.

Apostrophe-s would be recognised by as merely indicating the possessive.

Similarity of goods [3 marks]

Complementary products.

Glasses could potentially be promotional items.

Made of different materials (grapes / glass)

Difference distribution networks. Homeware shops and supermarket aisles for glasses; wine shops/wine aisles/ pubs and restaurants for wine.

Average Consumer [1 mark]

In both cases, the average domestic consumer, and retail distributors (general and specialist)

Likelihood of Confusion [3 marks]

Greater the similarity of the marks offsets greater difference in goods.

Here, near-similarity of marks means that LOC very much depends on the perception of the similarity of the goods.

No enhanced distinctiveness

Wine is chosen with care. But based on taste.

Glasses chosen with some care. But for design, capacity etc.

Unimportant that wine and wine glasses come from the same source.

You do not use a particular glass for a particular brand of wine.

There are a very large number of wine brands and so coincidence of names might be expected.

Conclusion [1 mark]

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Any reasonable conclusion that follows from the analysis and comes down on one side or the other **[0.5 mark<sup>(i)</sup>]** but highlights risk **[0.5 mark<sup>(ii)</sup>]**. This question was based on a precedent that decided that there would very likely be no infringement in this case.

**10 marks**

b)

Similarity of Marks **[4 mark]**

Wholly dissimilar aurally and visually:

Words are about the same length

But with different syllables

Words are made up of wholly different letters.

Conceptually very similar (both *crocodilia*)

Most people would be unable to distinguish the conceptual difference.

Similarity of goods **[1 mark]**

Identical

Average Consumer **[1 mark]**

Boat owners, and commercial buyers in marine industries.

Likelihood of Confusion **[3 marks]**

Here, identity of goods means that LOC is driven by perception of the sign.

No enhanced distinctiveness

Buyers likely to be expert and careful.

Buyers might be hastier when seeking to buy spare parts, but even still exercise a degree of care in ensuring the part is correct.

Buyers are unlikely to have the opportunity to compare the goods side by side.

Conclusion **[1 mark]**

Any reasonable conclusion that follows from the analysis and comes down on one side or the other **[0.5 mark<sup>(i)</sup>]** but highlights risk **[0.5 mark<sup>(ii)</sup>]**. The exam-setter would advise his clients in this scenario that there would most likely not be grounds for successful opposition in this case.

**10 marks**


**Total: 20 marks**



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Question 11

Rutherford Motor Company Inc is a famous car manufacturer. It owns the following Madrid Protocol trade marks designating the UK:

Mark	Type	Goods
RUTHERFORD	Wordmark	<i>Class 12: Land vehicles, and parts and fitting therefor.</i>
	Logo	<i>Class 12: Land vehicles, and parts and fitting therefor. Class 28: Games and playthings.</i>

Hooke Ltd is a manufacturer of car suspension springs. It markets one model of spring in the UK with advertising headed:

'CHEAP RUTHERFORD SUSPENSION SPRINGS!'

the springs being (only) suitable for Rutherford cars.

- a) **Make notes on the advice you can give Rutherford as to whether Hooke is committing an infringement of the Trade Marks Act 1994.**

**6 marks**

Archimedes Ltd is a UK toy manufacturer, and sells a jigsaw featuring a painting of a Rutherford car. Rutherford's logo (above) can be clearly seen in the painting, reproduced both on the jigsaw and on the jigsaw box.

- b) **Can Rutherford take action against Archimedes? Give reasons for your answer.**

**3 marks**

Rutherford has stopped the supply of its Model 104 cambelts to EU stockists. It does however continue to supply them to the Indian market, branded under the RUTHERFORD logo. Without access to these particular cambelts, owners of pre-1990 Rutherford cars are unable to keep them running as there is no alternative source of supply.

- c) **Explain whether it is lawful under the Trade Marks Act 1994 for Jayant, a trader, to import Rutherford-branded cambelts from India to the UK.**

**2 marks**

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Nikola runs a UK scrap yard. She recovers parts from scrapped Rutherford cars (which are embossed with the Rutherford logo above) and sells them to the public.

d) **Is Nikola acting lawfully? If not, what can she do to ensure she acts lawfully?**

**4 marks**

Ruby Rutherford is a motor mechanic in London. She is not connected with the Rutherford Motor Company. She wishes to establish a repair garage business to be called 'RUTHERFORD'S'.

e) **Assuming there is precedent that *repair garage services and land vehicles* are 'similar', explain whether Ruby will be acting lawfully.**

**5 marks**

**Total: 20 Marks**

**Answer:**

- a) Use in the course of trade of a mark on goods listed in the specification ordinarily amounts to an infringement without the requirement to prove confusion **[1 mark<sup>(i)</sup>]**. However Hooke has a defence if it can demonstrate that a registered trade mark is not infringed by the use of the trade mark where it is:
- necessary **[1 mark<sup>(ii)</sup>]** to indicate
  - the intended purpose of a product (in particular, a spare parts) **[1 mark<sup>(iii)</sup>]**.
  - provided the use is in accordance with honest practices in industrial or commercial matters **[1 mark<sup>(iv)</sup>]**.

In this case, the onus is on Hook to demonstrate that use is in line with honest practices **[1 mark<sup>(v)</sup>]**. The wording used does however appear to be apt to confuse, with other more precise options for expressing the compatibility of its springs being available **[1 mark<sup>(vi)</sup>]**, and consequently Hooke is likely to be infringing.

**6 marks**

- b) The case of *Arsenal v Reed / Adam Opel v Autec* provides that a trade mark infringement only occurs if the use cause prejudice to the main function of a trade mark, namely to act as an indicator of origin **[1 mark<sup>(i)</sup>]**. **No need to name a precedent**. There is no firm rule/the rule is fact dependent **[0.5 mark<sup>(ii)</sup>]**: however if the logo is part of the car (e.g. a bonnet badge) **[1 mark<sup>(iii)</sup>]** it would be difficult to argue that this would cause such prejudice **[0.5 mark<sup>(iv)</sup>]**.

**3 marks**

- c) The importation of a product protected by a trade mark constitutes an infringement **[1 mark<sup>(i)</sup>]**. There is no rule of international exhaustion that could serve as a defence, nor any defence of necessity **[1 mark<sup>(ii)</sup> for any consideration and discounting of an exception]**.

**2 marks**

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- d) Rutherford's rights are prima facie exhausted by the cars having been put on sale in the EU **[1 mark<sup>(i)</sup>]**. However, this not apply where there exist legitimate reasons **[0.5 mark<sup>(ii)</sup>]** for the proprietor to oppose further dealings in the goods, in particular, where the condition of the goods has been changed or impaired after they have been put on the market **[0.5 mark<sup>(iii)</sup>]**. Recovered parts are likely to have suffered some degree of wear **[0.5 mark<sup>(iv)</sup>]**, but this is not likely to be sufficient to constitute a legitimate reason **[0.5 mark<sup>(v)</sup>]** as long as the history of the parts is made clear to consumers **[0.5 mark<sup>(vi)</sup>]**. Alternatively, Nikola may obliterate the trade marks **[0.5 mark<sup>(vii)</sup>]**.

**4 marks**

- e) Section 11(2) provides that a registered trade mark is not infringed by—
- the use by a person of his own name **[1 mark<sup>(i)</sup>]**
  - provided the use is in accordance with honest practices in industrial or commercial matters **[1 mark<sup>(iii)</sup>]**.

Whether this qualification is met will depend on whether the business is incorporated (as there is a potentially a wide choice of name), how the mark will be perceived by users, some justification as to why her first name or initials are not being used, how other businesses in this field brand themselves, and generally whether Ruby is taking advantage of the coincidence. **[up to 3 marks for three good points<sup>(iii)</sup>]**.

**5 marks**

**Total: 20 marks**