

October 2018: Candidate Cover Sheet

Exam Paper: FC5 Trade Mark Law

Candidate No:

Venue:

At the end of the examination:

1. Count up the number of sheets you have used which you wish to be marked.
2. Use the boxes on each sheet of the answer script to number the sheets: '1 of 25', '2 of 25' etc.
3. If you have used extra sheets, please add your candidate number and the examination reference to these sheets too.
4. Do not staple the sheets, or use adhesive tape or treasury tags.
5. Write the number of sheets of paper you have put in this envelope here (do NOT include this cover sheet in your calculations).

No. of Sheets

6. Place the answer sheets that you wish to be marked in order in the white envelope provided with this sheet uppermost and the examination paper detail and your candidate details **showing through the envelope window**.
7. Seal the envelope and leave it on your desk face up.
8. Leave any spare answer script paper on your desk.
9. You may take the examination paper with you.

For examiner's use only:

	Section A							Section B				Total
	Qu 1	Qu 2	Qu 3	Qu 4	Qu 5	Qu 6	Qu 7	Qu 8	Qu 9	Qu 10	Qu 11	
Marks available	4	6	7	4	8	7	4	20	20	20	20	
Marks awarded												



Foundation Certificate

FC5 Trade Mark Law

Thursday 04 October 2018 15:00 to 18:00

INSTRUCTIONS TO CANDIDATES

1. You should attempt **ALL** questions in Section A and any **three** questions in Section B.
2. The marks for each question in Section A are shown next to the question. Each question in Section B carries **20** marks.
3. If more than the required three questions are answered in Section B only the first three presented will be marked.
4. The total number of marks available for this paper is 100.
5. Start each question (but not each part of each question) on a new sheet of paper.
6. Enter the question number in the appropriate box at the top of each sheet of paper.
7. Do not state your name anywhere in the answers.
8. Write clearly, as examiners cannot award marks to answer scripts that cannot be read.
9. The scripts will be photocopied for marking purposes.
 - a) Use only **blackink**.
 - b) Write on one side of the paper only.
 - c) Write within the printed margins.
 - d) Do not use highlighter pens on your answer script.
10. Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
11. Any candidate script removed from the examination room will not be marked.
12. This question paper consists of eight sheets, including this sheet.

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**

Question 2

- a) A US trade mark 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**

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

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

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?

8 marks

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 1994* relevant to your answer to part (a).**

2 marks

Total: 7 marks

Question 7

PASER is a registered EU trade mark for a 'conducted energy weapon', i.e. 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, which 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

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 thesis, 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

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

- a) 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
- b) 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
- c) 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

Cont...

- d) 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

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 advantages 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 the 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

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

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.</i> <i>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 are (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

Nikola runs a UK scrapyards. 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