

Introduction

The pass rate, at 69.4%, was lower than the previous year. The spread of marks was wider this year. The proportion of marks well below the pass mark was larger than previously.

Candidates appeared to have found this year's paper challenging. It tested some new syllabus topics and continued a move away from questions asking for the mere recital of statutory wording to requiring candidates to first identify the relevant statutory provision, and to demonstrate understanding of it. Nevertheless, most questions, particularly in Part A, still required accurate recall of statutory wording, even if the scenarios presented were not ones they might previously have met.

Generally, good answers to Part B compensated for poorer answers to Part A.

There was no evidence of candidates being pressured by time.

Candidates should ensure they are familiar with the current syllabus, which is published on the PEB website.

Sound knowledge of the syllabus case law is required for this examination. Candidates are recommended to read the actual judgments, rather than just relying on summaries, as the latter might not be comprehensive.

An important point to remember is that where a question asks for 'three' reasons, only the first three reasons will be marked. Candidates are advised to cross out weak answers if they subsequently think of answers they consider better.

Question 5 was omitted from the marking process. Accordingly, candidates' marks were adjusted upwards based on their total marks for the other questions. PEB applied processes to ensure no candidate had been disadvantaged as a result of Question 5 having been discounted.

Questions

Part A

Question number	Comments on questions
Question 1	<p>Candidates generally achieved full marks for Parts a) and b).</p> <p>This question tested candidates' ability to recognise and succinctly define some common legal terms from the syllabus, all relating to 'distinctiveness', a precise understanding of which is key to understanding trade mark law.</p> <p>Very few candidates were able to define 'enhanced distinctiveness' – or later in the paper apply the concept to a scenario. Familiarity with <i>Sabel v Puma</i> is required for this examination.</p>

Question 2	<p>This question concerned the detail of the requirements of priority claims.</p> <p>Parts c) and d) were designed to stretch candidates beyond the basics of priority. Nevertheless, most candidates successfully answered Part c), appreciating that multiple priorities are permissible (as they are with patents).</p> <p>Part d) on the withdrawal of a priority application was less well answered. Here, trade mark procedure (where publication happens very soon after application) differs significantly from patent procedure (where publication generally occurs well after the priority period, if at all). However, reciting the statutory requirements for withdrawing a priority application would have accrued half the available marks.</p>
Question 3	<p>This question on non-standard trade marks reflects IPReg's requirement that patent attorneys understand in some depth areas where trade mark law interacts with other IP areas (here, rights in surface decoration, and technical effect).</p> <p>This was the highest scoring question in Part A. Candidates not only discussed the obvious grounds for refusal (here, the requirements for representations and technical effect) but also distinctive character. Distinctiveness is inherently an issue with all non-standard trade marks.</p> <p>Almost all candidates showed awareness of the recent change to the EUTM Regulation that extended the grounds for refusal beyond 'shape' to 'other characteristics' that exhibit technical effect.</p>
Question 4	<p>Responses to this question, on the continued effect of lapsed trade marks, were disappointing. It required a summary of the permissibility of late renewal and recall of the statutory definition of an 'earlier mark' to obtain the full marks.</p> <p>Marks were also awarded to answers that recognised that 'conversion' might also be a factor.</p> <p>Some candidates proposed answers based on seniority: ultimately it was not a correct answer as seniority rights are recorded under the associated EUTM, and extend back well beyond 12 months.</p> <p>Where more than the three reasons required by the question were given, only the first three were marked. Identical concepts such as restoration of UK marks /restitutio of EU marks would be regarded as one reason.</p>

Examiner's Report 2018
FC5 – Trade Mark Law

	Where the question says that unregistered rights should not be discussed, they should not be discussed and no points are available for doing so.
Question 5	This question was omitted from the marking process.

Question 6	<p>Most candidates recognised that this question concerned 'assents', an assent being one of the four registrable transactions. In addition to testing knowledge of the statutory provisions, it assessed whether candidates understood what an 'assent' actually is.</p> <p>Some attention to detail was required, in particular a clear differentiation between an assent and a will (it being the assent, not the will, that needs to be registered at the IPO). Confusing the two resulted in a lower than average score for the question.</p>
Question 7	<p>This question combined two areas of trade mark law: revocation and the use of trade marks outside the course of trade.</p> <p>Part a) on revocation was generally answered well.</p> <p>Part b) was generally answered poorly, with candidates overlooking both the requirement that infringing use be in the course of trade, and the detail of the so-called 'dictionary' remedy, which does not extend to all written works.</p>

Part B

Question number	Comments on question
Question 8	<p>Part a) of this question explored four common areas in which goodwill might not exist (or might vest in someone other than the claimant). This topic is very frequently tested in this examination</p> <p>Parts a) and c) (no trade / overseas trade) were generally answered well.</p> <p>Parts b) and d) (advertising but no trade / ownership of collective goodwill) were not so well answered.</p> <p>Part b) was designed to test candidates' understanding the 'well known mark' provisions of the Paris Convention, by presenting four similar scenarios in which one or two variables had been changed in each. Candidates are advised, in future, to revise this section of the syllabus in more detail.</p>

<p>Question 9</p>	<p>This question reflected a new IPReg requirement that the topic of overseas trade marks, and strategies for protecting trade marks overseas, is tested in greater depth.</p> <p>This question was answered extremely well by all candidates, allowing many to score high marks.</p> <p>Additional marks were available for stating, when giving any time limit, the event from which that time limit is taken. Furthermore, with Madrid Protocol marks, candidates should be clearer about whether time limits are measured from international publication by WIPO, or from national republication of the application.</p> <p>Once again, where more than the three reasons required by the question were given, only the first three distinct reasons were marked. Weak answers should be crossed out and only what candidates consider the best three submitted.</p>
<p>Question 10</p>	<p>This applied 'relative grounds' question was very well answered all round. This year two questions addressed candidates' ability to analyse similarity of marks, and of goods.</p> <p>Nevertheless a technique that reflects IPO practice (and assists in gaining even higher marks) is to avoid reaching a simple conclusion on whether signs and goods/services <i>are</i> similar: but rather to decide whether the <i>degree</i> of similarity of each is 'minimal', 'weak', 'medium', 'strong' or 'near-identical'. These results can then be fed into the likelihood-of-confusion analysis before a final conclusion is reached.</p> <p>Most candidates could have gained additional marks by stating, very clearly, who the 'average consumer' is in each scenario. Importantly, this varies according to the goods/services at issue, particularly so for specialist goods. Consideration of the average consumers' characteristics (and especially whether they are likely to be <i>particularly</i> attentive given the nature of the goods/services), should form part of the consideration of likelihood of confusion.</p> <p>Finally, 'enhanced distinctiveness', arising from the consumer recognition of earlier mark, should also be addressed when considering likelihood of confusion, even if only to dismiss its applicability on the facts, as here.</p>
<p>Question 11</p>	<p>This question tested candidate's knowledge of a range of defences. It was moderately well answered. It generally required both the relevant statutory wording to be recited with precision, and the facts being applied to <i>each element</i> of the statutory defence to determine if the defence has been made out.</p>

	<p>More marks could often have been gained where defences are subject to the test of being within the bounds of honest practice in the trade. This requirement should be stated, noted that it is ultimately evidence-dependent, but nevertheless followed with some discussion as to whether the party has, on the facts, appeared to have acted honestly.</p> <p>Part b) required knowledge of the important new syllabus topic, where case law has intervened to tolerate commercial uses of trade marks that are ostensible infringements on the strict statutory wording. Most candidates spotted that the scenario was a lightly-disguised recasting of <i>Adam Opel v Autec</i>. Candidates who scored no marks seemed simply not to be aware of this addition to the syllabus, as the law in this area cannot be discerned merely from the wording of the legislation, but rather is an innovation of the courts.</p>
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