

FC5 – Trade Mark Law
FINAL Mark Scheme 2019

SECTION A

Question 1

- a) In the context of remedies for trade mark infringement, explain the difference between ‘damages’ and an ‘account of profits’.
- 1 mark
- b) List four other remedies that are available to registered trade mark proprietors whose rights have been infringed.
- 2 marks
- Total: 3 marks

Answer:

- a) Damages – ordinarily reflect in monetary terms the damage caused to the claimant by the infringement due, for example, lost sales. **[0.5 mark (i)]**
Account of profits reflect the benefit accrued by the infringer **[0.5 mark (ii)]**.
- 1 mark
- b) **0.5 marks for any of the following:**
Injunction **(iii)**
Erasure, removal or obliteration of the sign. **(iv)**
Destruction in lieu of erasure, removal or obliteration of the sign. **(v)**
Delivery up **(vi)**
- [Other non-TMA remedies - such as public notices or declaratory relief - are equally allowable, as are interim orders]**
- 2 marks
- Total: 3 marks

Question 2

Section 2(2) of the Trade Marks Act 1994 states:

‘No proceedings lie to prevent or recover damages for the infringement of an unregistered trade mark as such’

Explain why the inclusion of the words ‘as such’ means that damages are still available as a remedy in passing-off proceedings.

1 mark

Answer:

The law of passing-off protects against misappropriation of goodwill, not the trade mark **[1 mark. Allow 0.5 marks for explanations relating to passing-off being a separate tort].**

Total: 1 mark

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Question 3

Compare the misrepresentation in ‘reverse passing-off’ with the misrepresentation in more common forms of passing-off.

2 marks

Answer:

Up to one mark (i) for a description of misrepresentation in reverse passing-off cases:

In reverse passing-off, the defendant causes the misrepresentation by claiming another’s product or service as his own. The product is supplied under the defendant’s own sign.

Up to one mark (ii) for a description of misrepresentation in ordinary passing-off cases, including showing (explicitly or impliedly) the correlation/contrast between the two.

In ordinary passing-off, the defendant causes the misrepresentation by claiming his product as that of another. The product is sold under the claimant’s sign.

Total: 2 marks

Question 4

Jonah owns a chain of fish and chip shops. He mounts a motion-sensitive aerosol dispenser outside his shops that sprays a perfume, formulated to replicate the smell of the sea, at passing pedestrians. Customers have learnt to realise that, on smelling the perfume, they are passing one of Jonah’s shops.

Jonah seeks to register three non-conventional signs as trade marks for “takeaway restaurant services”, described as follows:

- Sign 1: A smell, namely the smell of the sea.
- Sign 2: A smell, namely the smell of an aerosol consisting (by weight) 99.46% nitrogen, 0.5% ozone, 0.03% water and 0.01% bromine.
- Sign 3: A smell, namely the smell of the contents of the aerosol canister enclosed with this trade mark application.

[A canister of perfume is indeed mailed to the UKIPO together with the application form]

Which, if any, of these descriptions meets the requirements for representations set out in *Sieckmann v Deutsches Patent- und Markenamt*? Give reasons for your answer.

6 marks

Answer:

Sign 1 – wholly fails to be clear, precise or objective [Up to 3 x 0.5 marks (i)/(ii)(xiii)] as this encompasses a range of different smells [0.5 marks (iii)] experienced differently by different people [0.5 marks (iv)]

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Sign 2– by analogy to the situation in the *Sieckmann* case (which also involved consideration of a chemical formula) although the description is precise, it is not clear or intelligible to most people [Up to 2 x 0.5 marks(v)/(vi)], nor self-contained as the recipe requires being made up. [Up to 2 x 0.5 marks (vii)/(viii)]

Sign 3 is neither self-contained on the register [0.5 marks (ix)], easily accessible (it requires a trip to Newport) [0.5 marks(x)] nor durable [0.5 marks(xi)] as it will run out or may deteriorate [0.5 marks for either(xii)].

Total: 6 marks

Question 5

[In this question, do not discuss ‘bad faith’]

Oprah is the owner of the copyright in various clipart images, which she licenses commercially to users. The licences are non-exclusive, and as a condition of use, automatically terminate if the licensee attempts to register the image as a registered trade mark.

Ruth uses one clipart image as her business’s logo, and (in flagrant breach of the licence conditions) applies to register the logo as a UK trade mark.

- a) Explain the actions potentially available to Oprah before the UKIPO, and the grounds on which they might be based.**

3 marks

Ruth later seeks to register her logo as an EU trade mark.

- b) Explain the actions potentially available to Oprah before the EUIPO, and the grounds on which they might be based.**

2 marks

Oprah is in fact too busy to take action against Ruth, whose UK trade mark is now registered. Soon afterwards, Naomi, who is also licensed by Oprah to use her clipart images, uses an identical image to that registered by Ruth, on an identical commercial product to that protected by Ruth’s trade mark. Ruth threatens Naomi with trade mark infringement proceedings.

- c) Explain what defences or counterclaims (if any) are available to Naomi.**

2 marks

Total: 7 marks

Answer:

- a) Under section 5(4)(b) TMA, a copyright is regarded as an earlier right [1 mark(i)]. Under section 38(2)(a) the proprietor of the earlier right (here, Oprah) has the right to oppose [1 mark(ii)] or under section 47(2)(a), invalidate [1 mark(iii)] the trade mark as its use is outside the terms of the copyright licence.

3 marks

- b) Under Regulation 62(2)(c) the proprietor of the earlier right (Oprah) has the right to invalidate the trade mark as its use is infringing copyright [1 mark(iv)], Action can

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only be taken against the trade mark only once it is registered) **[1 mark(v)]**. (i.e. there is no ground of opposition).

2 marks

- c) As, under sections 5(4) only the proprietor of the earlier right (Oprah) has standing to invalidate the trade mark **[1 mark(vi)]**, the trade mark remains valid and Naomi has no defences or counterclaims available. **[1 mark(vii)]**. In particular, as consent to use the copyright does not amount to consent to use a trade mark.

2 marks

Total: 7 marks

Question 6

[In this question, do not discuss passing-off or other unregistered rights]

- a) Set out the rights the owner of an EU trade mark **application** has to oppose a later EU trade mark application on relative grounds.

1 mark

- b) Set out the rights the owner of a UK trade mark **application** (UK1) has to invalidate on relative grounds a UK registered mark (UK2) which has a later filing date than the application (UK1) but which has completed the registration process more quickly than UK1.

1 mark

- c) Set out the rights the owner of a UK trade mark **application** has to seek a remedy against the unauthorised use of the mark for which protection is being sought.

3 marks

Total: 5 marks

Answer:

- a) Article 8(2)(b) includes in the definition of an 'earlier trade mark' any application for registration has been made and which, if registered, would be an earlier trade mark **[0.5 mark(i)]**. The applicant is therefore entitled to oppose the later application under article 8(5) as the proprietor of an earlier trade mark **[0.5 mark(ii)]**.

1 mark

- b) Section 6(1) likewise classes applications as earlier rights, **[0.5 mark(iii)]** permitting invalidity actions **[0.5 mark(iv)]** under section 47(2)(a).

1 mark

- c) Section 9(3) provides for a right of the proprietor to recover damages / an account of profits **[1 mark(v)]** having effect from the date of registration (which as section 9 provides, is the date of filing of the application for registration) **[1 mark(vi)]**, provided that no infringement proceedings may be begun before the date on which the trade mark is in fact registered **[1 mark(vii)]**.

3 marks

Total: 5 marks

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Question 7

Set out the requirements in respect of the **use** of an earlier UK registered trade mark that must be fulfilled if that mark is to serve as a basis for opposing a later UK trade mark application.

(Do not discuss use of variant forms of the mark, or use of the mark on goods destined for export).

4 marks

Answer

Section 6A provides that where the registration procedure for the earlier trade mark was completed more than 5 years ago **[0.5 mark(i)]**, then in the 5 years **[0.5 mark(ii)]**, ending with the date of the application for registration **[0.5 mark(iii)]**, or (where applicable) the date of the priority claimed for that application. **[0.5 mark(iv)]**:

- a) the earlier trade mark must have been put to genuine use **[0.5 mark(v)]**, in the United Kingdom, by the proprietor or with his consent **[0.5 mark(vi)]**, in relation to the goods or services for which it is registered **[0.5 mark(vii)]**, or
- b) if the earlier trade mark has not been so used, but there are proper reasons for non- use. **[0.5 mark(viii)]**

Total: 4 marks

Question 8

With reference to the relevant case law, explain what is meant by a '*likelihood of association*' (taking care to explain how the concept differs, if at all, from a '*likelihood of confusion*').

4 marks

Answer:

Up to 4 marks for any valid points:

Sabel v Puma established that LOA was a facet of LOC and not an alternative ground of infringement. **[1 mark(i)]**. Hence it is wider than a calling to mind of the earlier mark. **[1 mark(ii)]**.

Canon v MGM teaches that there might be occasions where consumers might not actually mistake the signs **[1 mark(iii)]** but nevertheless believe that the goods and services in question come from the same undertaking **[1 mark(iv)]** or, as the case may be, from economically linked undertakings **[1 mark(v)]**.

Total: 4 marks

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Question 9

David is very short of money. He secures a loan from the bank, offering a trade mark as collateral. He later sells the trade mark to Jonathan (who records the assignment at the IPO and is duly registered as the owner of the mark). Soon afterwards, David defaults on his loan repayments.

The bank now seeks a court order to recover the trade mark from Jonathan so it can be sold to pay off David's debt.

Can the bank recover the trade mark from Jonathan? Give reasons for your answer.

3 marks

Answer:

The granting of security interest over collateral is a registrable transaction **[1 mark(i)]**.

Under section 25(2) if unregistered, the security is ineffective as against a person acquiring a conflicting interest in the registered trademark (here, Jonathan) **[1 mark(ii)]** if in ignorance of it. **[1 marks(iii)]**. Otherwise, the bank's right will have priority over that of Jonathan.

Total: 3 marks

Question 10

- a) Set out the requirements that an earlier **non-registered** trade mark or sign must fulfil if it is to be used to invalidate an EU trade mark application.

3 marks

- b) List four categories of such **non-registered** trade marks or signs that – assuming sufficient recognition amongst German consumers is demonstrated – enjoy legal protection in Germany.

2 marks

Total: 5 marks

Answer:

- a) Article 8(4) provides grounds based on a non-registered trade mark or of another sign used in the course of trade **[1 mark(i)]** of more than mere local significance **[1 mark(ii)]**, where and to the extent that, pursuant to the law of the Member State governing that sign, that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark. **[1 mark(iii)]**

[Allow 1 mark for discussing “well known marks” under the Paris Convention, as these could potentially be used as the basis for an invalidation action]

3 marks

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b) Award 0.5 marks for each of the following:

- Unregistered trade marks (recognised across Germany) **(iv)**
- Company symbols **(v)**
- Names of firms **(vi)**
- Names of works **[Allow a maximum of 1 point for two or more subcategories of work] (vii)**

2 marks

Total: 5 marks

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SECTION B

Question 11

[This question does not require knowledge of any legislation except the Trade Marks Act]

Eve is a plant breeder. She has crossed the sugar-rich Golden Delicious with the acidic Bramley to produce a new variety of apple, which she has called the ‘SWEET AND SOUR’ after her favourite takeaway meal.

Eve seeks to monopolise the plant variety rights in her new apple by registering it at the International Union for the Protection of New Varieties of Plants (‘UPOV’) – of which the UK is a party – under the full botanic name “*Malus domestica* ‘Sweet and Sour’.” All edible apples are varieties of the species *Malus domestica*.

Eve later applies to register the name SWEET AND SOUR as a UK trade mark for ‘*apples and apple trees*’.

- a) Explain all the grounds for objection that the UKIPO examiner will raise.

6 marks

Eve’s apples have in fact been a huge success on the market, and before filing for trade mark protection, Eve commissioned a survey in which supermarket shoppers were asked to name ‘*the first thing that springs to mind when they hear the term ‘SWEET AND SOUR’*’. 50% answered ‘a Chinese meal’ and 50% answer ‘it’s that new apple’.

- b) Explain whether this survey can assist in overcoming the objections you identified in part (a).

7 marks

Instead of the scenario described in (a) above, assume Eve did not in fact complete the registration of her new apple variety at UPOV.

- c) Explain whether this affects your answer to part (a).

2 marks

Eve also produces apple juice, which she sells in ‘juice boxes’, manufactured from card-foil laminate and with a small foil-sealed aperture designed to accept a straw. The boxes are moulded into a realistic three-dimensional shape of an apple using a novel laminate-moulding machine that Eve has herself invented. This shape is wholly unlike any other juice box presently on the market, all which are either cuboid (brick-shaped) or tetrahedral (pyramid-shaped). Eve seeks to register the shape of her juice box as a trade mark for “*apple juice*”.

- d) Explain whether this apple-shaped box meets the three requirements of section 3(2) of the Trade Marks Act 1994 explicitly directed at shape marks.

5 marks

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Answer:

Part (a):

Up to 6 marks for any of the following:

The mark offends against the following provisions of Section 3(1) of the Trade Marks Act **[1 mark] (i):**

(a) signs which do not satisfy the requirements of section 1(1), (i.e. capable of distinguishing the goods and services of one undertaking from those of other undertakings)

As the mark is the variety of apple itself, its varietal name cannot distinguish between two sources of that variety of apple **[1 mark] (ii)**

(b) trade marks which are devoid of any distinctive character **[1 mark] (iii),**

A mark would be interpreted as referring to the apple variety, not its source. **[1 mark(iv)]** Further or in the alternative, the words would be interpreted as being characteristics of the product, namely its taste, rather than its source **[1 mark(v)]**

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, ... or other characteristics of goods. **[1 mark (vi).]**

Again a mark would be interpreted as referring to the apple variety, not its source. **[1 mark(vii)]**. Further or in the alternative, the words would be interpreted as being characteristics of the product, namely its taste, rather than its source **[1 mark(viii)]** including – in the case of the trees – the characteristics of its fruit **[1 mark(ix)]**.

[Allow these marks where this expressed as an objection under 3(1)(d) – comprising a term common in the trade]

Finally, the mark offends the explicit protection for varietal names set out in sections 3(4C) and 3(4D) of the Act:

(4C) A trade mark is not to be registered if it-

(a) consists of **[1 mark(x)]** , or reproduces in its essential elements **[1 mark(xi)]** , an earlier plant variety denomination registered as mentioned in subsection (4D), and (b) is in respect of plant varieties **[1 mark(xii)]** of the same or closely related species.

(4D) Subsection (4C)(a) refers to registration in accordance with any-

(a) enactment or rule of law, (b) provision of EU law, or (c) international agreement to which the United Kingdom or the EU is a party, providing for the protection of plant variety rights.

6 marks

Part (b)

Up to 7 marks for any of the following:

Eve is seeking to overcome the examiner's objections by demonstrating acquired distinctiveness. **[1 mark(i)]**. Sufficient evidence would in theory overcome the objections based on section 3(1)(b) **[1 mark(ii)]** and section 3(1)(c)/(d) **[1 mark(iii)]** grounds. But they

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would not overcome the objections based on section 3(1)(a) [1 mark(iv)] or section 3(4C) [1 mark(v)].

The answers given by the participants in practice mark no contribution towards overcoming 3(1)(b) and (c) objections: half the respondents state the mark identifies Eve's apple, but without any indication as to whether they understand the term to be a trade mark or just a varietal name. [1 mark(vi)]

Furthermore the question being asked is faulty. The DOUBLEMINT case (OHIM v Wrigley) teaches that at least one of its possible meanings designates a characteristic of the goods (here, the taste) the mark is unregistrable. [1 mark(vii)] This way in which the survey question is worded provides no evidence as to any alternative understanding of the words that consumers might have. [1 mark(viii)].

The survey was targeted only at supermarket shoppers, who might be representative of the market for apples, but not of apple trees. Consequently the survey provides no assistance in overcoming the 3(1)(b) and (c) grounds in respect of 'apple trees'. [1 mark(ix)]

Candidates may also be awarded points for discussing whether 50% level of recognition is in any case sufficient. *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v. Boots- und Segelzubehör Walter Huber and Franz Attenberger* held that there is no predetermined percentage threshold. [1 mark(ix)]; Aside from the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking, factors taking into account include:

- the market share held by the mark [0.5 mark(x)];
- how intensive. [0.5 mark(xiv)], geographically widespread [0.5 mark(xiii)] and long-standing [0.5 mark(xv)] use of the mark has been;
- the amount invested by the undertaking in promoting the mark [0.5 mark(xvi)]; and
- statements from chambers of commerce and industry or other trade and professional associations. [0.5 mark(xvii)].

No such evidence has been provided and hence there is scant evidence on which to persuade the examiner that acquired distinctiveness has been achieved [1 mark (xvii)].

7 marks

Part (c)

The section 3(4)(C) objection will no longer be applicable [1 mark(i)] as it is dependent on registration. The section 3(1) objection [0.5 mark(ii)] and section 3(2) objections [0.5 mark(iii)] remain.

2 marks

Part (d)

Is the mark...

a shape ... which results from the nature of the goods themselves? No. The product here is a liquid [1 mark(ii)] and so not apple-shaped [1 mark(ii)]

a shape ... necessary to obtain a technical result? Clearly not. From a technical point of view the design is arbitrary. [1 mark(iii)].

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a shape... which gives substantial value to the goods? No. The product here is the juice. The product is not its packaging [**1 mark(iv)**], even if aesthetically attractive or technically novel. [**1 mark, permitting a wide allowance as to how this can be expressed(v)**].

5 marks

Total: 20 marks

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Question 12

Your client, Noodle Ltd, runs a Korean restaurant, licensed to serve alcohol, in the residential suburb of New Malden in south west London. It owns the following UK trade mark, which it uses as the name of its restaurant:

Mark	Trade Mark type	Filing Date	Registration Date	Services
LUCKY HORSE LONDON	words only	1/4/2010	1/8/2010	Class 43 – Provision of food and beverages

Noodle Ltd has recently been alerted to the following UK trade mark application, filed by Jackpot plc:

Mark	Trade Mark type	Filing Date	Registration Date	Services
 <p>LUCKY HOUSE <i>London</i></p>	logo	1/8/2019		Class 41 – Casinos Class 43 – Restaurants and bars

Further investigations reveal that Jackpot plc is operating an ‘Italian-American’-themed casino in London’s West End (London’s central entertainment and shopping district). Alcoholic drinks, and a range of pizzas, are offered to customers, which they can consume either at the gaming tables, or in a small bar and café area within the casino.

Advise Noodle Ltd as to whether it can successfully oppose Jackpot plc’s trade mark, giving full reasons for your answer. [Do not discuss ‘marks with a reputation’, passing-off or infringement].

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Answer:

SIMILARITY OF MARKS

Aural

Up to two marks (SOM i / ii) for any relevant points, such as:

The marks are of the same number of syllables.

Four of the five syllables are identical.

One syllable differs, but only by one vowel-sound within two identical consonants.

The one vowel-sound difference is hidden within the middle of the middle word and therefore could be easily misheard.

Visual

Up to two marks (SOM iii) / iv for any relevant points, such as:

The earlier mark is protected as a word mark, and consequently protects against the use of the mark no matter how it is presented, including the presentation shown in the application.

The marks are identical save for one letter.

The one letter difference is hidden within the middle of the middle word and therefore could be easily overlooked.

Conceptual

Up to two marks (SOM v / vi for any relevant points, such as:

The marks are similar to the extent that they describe a “lucky” object, together with what is readily identifiable as the geographical descriptor “London”.

“Horses” and “houses” would be readily recalled as very different objects, one being an animate and comparatively small, the other inanimate and large.

“Luck” and “House” are both terms that could relate to gambling and so have a particular resonance with gamblers. “Horse” is entirely arbitrary for both services.

“London” will make a low contribution to the distinctive power of the marks, being a geographical term describing the largest city in the UK (and in particular home to thousands of restaurants).

Conclusion

Up to two marks (SOM vii / viii for a relevant point, such as:

Given all three types of similarity are likely to be equally important.

The very strong aural and visual similarities are likely to outweigh the weaker conceptual similarity.

Overall, the marks are highly similar.

SIMILARITY OF THE SERVICES

Enforceability of the senior mark:

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Up to one mark (SOS i) for a relevant point, such as:

Noodle's trade mark completed registration more than five years ago. On the facts presented, it has not been used to the full extent of the registration. Consequently were it to oppose Jackpot's mark, it might only apply in respect of operating a (Korean) restaurant service.

Provision of food and beverages as part of a (Korean) restaurant service v casino services:

Up to five marks (SOS ii – vi) for any relevant points, such as:

Purpose – gambling vs subsistence. These are dissimilar.

Method of using the service:

Both involve “going out” to an establishment. Often as evening entertainment.

But otherwise once involves playing games of chance, the other eating/drinking.

Complementary? It is reasonable to expect that a casino offer drink, and possibly food, to customers.

Users – Users of casinos are likely also to use restaurants, but not necessarily vice versa.

In competition? No.

Overall, the services are weakly similar.

Provision of food as part of a (Korean) restaurant service v restaurant services.

Up to two marks (SOS vii / viii) for any relevant points, such as:

These services are identical.

Even where the senior mark limited to ‘Korean’ restaurants and the junior mark limited to pizzas or Italian food, the purpose and method of using the services would be identical, and the restaurants would remain in competition with each other. The services would therefore remain very similar.

Provision of beverages as part of a (Korean) restaurant service v bar services.

Up to one mark (SOS ix) for any relevant point, the most relevant being:

These services are identical.

AVERAGE CONSUMER

Up to two marks (AC i / ii) for a relevant point, such as:

The average restaurant consumer is the average person with no particular characteristics.

A casino customer is a gambler. He/she might possess above-average care in choosing a casino to frequent, based on the games available or minimum stakes accepted.

LIKELIHOOD OF CONFUSION

Casinos

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Up to four marks (LOC i – iv) for any relevant points, such as:

It is necessary to consider the marks as registered, rather than as used. It does not matter that the mark is in practice only being used in a suburb.

Strong similarity of the signs likely to be offset by weak similarity of the services.

The senior mark (a local business) does not benefit from enhanced distinctiveness.

The term “Lucky” is likely to have less distinctive power in the context of casinos, where it is laudatory and descriptive. Likewise the term “House” is likely to be appreciated as having a distinct, relevant, meaning, describing the establishment. The name of the Korean restaurant remains wholly arbitrary.

The Average Consumer is likely to exercise above-average care.

On balance, confusion is not likely. **[At Foundation level, a conclusion to the contrary is acceptable if consistent with the rest of the analysis]**

Credit can be given for analysis relevant to LOC elsewhere in the answer, and vice versa.

Bars

Up to two marks (LOC v /vi) for any relevant point, such as:

Strong similarity of the signs. Identity of the services.

Average consumer has no special characteristics and is likely to demonstrate average level of care.

A likelihood of confusion can almost certainly be implied.

Restaurants

Up to two marks (LOC vii / viii) for any relevant point, such as:

Strong similarity of the signs. Identity of the services.

Average consumer has no special characteristics and is likely to demonstrate average level of care.

A likelihood of confusion can almost certainly be implied.

CONCLUSION

Up to one mark (CONC i) for a conclusion consistent with the analysis above, such as:

Overall, opposition would not be successful for casino services, but would be successful for bars and restaurants.

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Question 13

You act for Giuseppe Technicolore SpA., an Italian paint manufacturing company.

Set out the option(s) that permits the following trade mark portfolio for one of the company's product lines to be consolidated, so as to minimise future administration costs.

[Assume that making full use of multinational trade mark mechanisms will achieve this cost saving. And that, in doing so, it is permissible to broaden your client's rights if this cannot be avoided: however no rights should be lost.]

For each option, explain the respective risks of each approach and the best course of action were that risk to in fact materialise.

Mark	Jurisdiction	Goods	Filing Date	Registration Date
DREAMCOAT	Germany	Paints	1/8/2009	1/8/2010
	Italy	Paints and primers for paint	1/8/2012	1/2/2013
	France	Paints	1/8/2013	1/2/2014
	Russia	Paints	1/8/2013	1/2/2014
	Ireland	Paints	1/8/2013	1/8/2014
	United States	Spray paints for automotive use	1/8/2014	1/8/2014
	South Africa	Spray paints for automotive use	1/8/2014	1/8/2018
	Australia	Spray paints for automotive use	1/8/2019	Not yet registered

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Answer:

Given the client is an Italian-incorporated company, and there being no evidence of a physical establishment outside Italy, there are three ways in which the 8 current trade marks can be consolidated into 3 or (in the long term, in the case of option 1, just 2)

Option 1:

Trade Marks	Goods	Designations	Seniorities declared under EUTMR Art 39(2)	Comments
Italy (retained to serve as basic mark) [1 mark (i)].	Paints and primers for paint			WO(EU) protection is also being sought. Hence in this mark can lapse [1 mark(ii)]. (But this will need to be 2033: 2023 is too early to avoid central attack) [1 mark (iii)]
International Trade Mark (Using Italian mark as base, as required by MP Art 3 [1 mark(vi)])	Paints and primers for paint [1 mark (v)].	European Union [0.5 marks (vi)]	For “paints”: - Germany - France - Ireland [1 mark(x)] For “paints and primers for paints”: - Italy [1 mark(xi)]	DE, FR and IE marks can be left to lapse [1 mark(xii)]
		Russia [0.5 marks (vii)]		Existing RU, US and (once granted) AU marks will be replaced under Article 4bis [1 mark(xiii)]
		United States [0.5 marks (viii)]		
		Australia [0.5 marks(ix)]		

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South Africa (retained) [1 mark xiv)] .	Spray paints for automotive use			
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Risks: Invalidation or revocation for non-use of the Italian mark **[1 mark(xv)]** could result in central attack of the Madrid Protocol application **[1 mark(xvi)]** under MP art 6(3), resulting in the additional costs of transformation **[1 mark(xvii)]** under article 9(5quies).

(In fact national practice varies on whether replaced marks actually need to be transformed. In this scenario, only the Australian designation needs to be.)

Conflict with existing trade mark in another EU territory might result in the EU mark being invalidated **[1 mark(xviii)]**. The client could consider converting the marks **[1 mark(xix)]** if (but only if) the national rights have lapsed **[1 mark(xx)]**: but if they have not yet lapsed, it just needs to use the Madrid Protocol to apply for subsequent national designations for DE, FR and IE under Article 3ter. **[1 mark(xx)]**.

If necessary, the US and AU rights can be limited if the specification is too wide **[1 mark(xxi)]** to avoid conflicts with other rights, or to satisfy (in particular) US specification wording requirements. (If fact, you can do this at the MP application stage if you wish)

Option 2 (variant on above):

As above, but with EU member states individually designated in the International Trade Mark row: **[Use mark scheme above plus the additional/alternative marks:]**

Trade Marks	Goods	Designations	Seniorities declared under EUTMR Art 39(2)	Comments
<i>International Trade Mark</i> (Using Italian mark as base)	Paints (xxiii)	Germany [0.5 mark (xxiv)] France [0.5 mark (xxv)] Ireland [0.5 mark (xxvi)] <i>Russia</i> <i>US</i> <i>Australia</i>		<i>Existing RU, US and (once granted) AU marks will be replaced under Article 4bis</i>

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The advantage of which is the risk of invalidation of the EU designation being reduced [1 mark (xxvi)] The cost of designating three EU member states might also be better value than applying for an EU mark [1 mark (xxvii)]. However this option requires the Italian mark to be maintained in perpetuity which would not be the long-term case with an EU designation. [1 mark (xxviii)].

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Option 3:

Trade Marks	Goods	Designations	Seniorities declared under EUTMR Art 39(2)	Comments
EU [1 mark(xxix)]	Paints and primers for paint [1 mark (xxix)]		For “paints”: - Germany - France - Ireland [1 mark (xxx)], For “paints and primers for paints”: - Italy [1 mark (xxxi)],	Existing DE, IT FR and IT marks can be left to lapse [1 mark (xxxii)].
International Trade Mark (Using EU mark as base [1 mark (xxxiv)])	Paints [1 mark (xxxv)].	Russia [0.5 marks (xxxvi)].		Existing RU, US and (once granted) AU marks are replaced under Article 4bis [1 mark(iixl)].
		United States [0.5 mark(xxxvii)].		
		Australia [0.5 marks (xxxviii)].		
South Africa (retained) [1 mark(ixl)].	Spray paints for automotive use			

Risks: Conflict with existing trade mark (or objection on absolute grounds) in another EU territory would invalidate the EU mark [1 mark(xi)], and result in the central attack of the Madrid Protocol mark [1 mark(xli)]. The client can convert the EU protection [1 mark(xlii)] if its national rights have lapsed [1 mark(xliii)], and transform the Madrid protection [1 mark(xliv)] (although again national practice varies about whether replaced marks actually

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need to be transformed). If necessary, the US and AU rights can be limited if the specification is too wide [1 mark(xiv)]

Total: 20 marks

Question 14

Explain what actions can be taken to remedy or mitigate against the following mistakes:

- a) **Accidentally omitting a letter 'Z' when applying for the UK trade mark NEBUCHADNEZAR, when the e-mail from your client instructed you to protect the trade mark NEBUCHADNEZZAR.**
4 marks
- b) **Submitting a fully-completed application form for a UK trade mark, but forgetting to include the fee-sheet authorising payment. You note that an application for an identical trade mark, protecting identical goods, was filed by a competitor to your client the day after the IPO received your application.**
2 marks
- c) **Failing to claim priority at the date of filing of an EU trade mark application.**
2 marks
- d) **Failing to declare seniority at the date of filing of an EU trade mark application.**
2 marks
- e) **Failing to pay a renewal fee for an EU trade mark application by the renewal date. Shortly before renewal was due, the trade mark was used as the basic registration for a Madrid Protocol filing.**
6 marks
- f) **Due to serious illness, failing to oppose an EU trade mark (for the absolute ground of being devoid of distinctive character), before the end of the opposition period.**
3 marks
- g) **In respect of a Madrid Protocol application seeking to protect four classes of goods and services, failing to pay by the specified deadline the 'supplementary fee' required for the fourth class.**
1 mark

Total: 20 marks

Answer:

a) If (and only if) the mark is still at the application stage [1 mark(i)], then under section 39(2) TMA this error of copying [1 mark(ii)] **Allow as an alternative a discussion based on "obvious mistake"** can be corrected as it does not appear to substantially affect the identity of the trade mark [1 mark(iii)]. Otherwise the application needs to be re-filed with loss of a filing date. [1 mark(iv)].

4 marks

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b) This is a deficiency under section 32(4) and will need to be remedied within the timescale set by the examiner. **[1 mark(i)]**. However, sections 33(1) provides that payment of a fee is not necessary to establish a filing date. **[1 mark(ii)]** and so priority over the later mark will be maintained as long as the fee is paid in time.

2 marks

c) Article 35(1) requires priority to be claimed on filing. **[1 mark(i)]**. If priority is to be preserved, the mark would need to be withdrawn and a new application made **[1 mark(ii)]**

2 marks

d) Article 39(2) permits the filing of seniority claims up to two months **[1 mark(i)]** from the filing date. Otherwise under Article 40(1) seniority cannot be claimed until after registration **[1 mark(ii)]**.

2 marks

e) Article 53(3) provides that although the mark lapses, renewal can be effected up to six months later. **[1 mark(i)]**. Article 104(2) provides a further *restitutio* period of up to six months (strictly, two months from the removal of the obstacle to payment **[1 mark(ii)]**) but only if all due care has been exercised. **[1 mark(iii)]**. If the mark is not renewed, and the Madrid Protocol mark has been filed within the previous five years **[1 mark(iv)]**, the Madrid protocol mark will under MP Art 6(3) be subject Central Attack **[1 mark(v)]** and to maintain the filing date will need to be transformed into local applications **[1 mark(vi)]** under MP Article 9(5quies).

6 marks

f) There is no effect from this oversight as the EUIPO does not permit opposition on absolute grounds **[1 mark(i)]**. In any case, article 104(3) provides that the opposition deadline is non-extendable even by restitution **[1 mark(ii)]**. Therefore bring invalidity proceedings once the mark is registered **[1 mark(iii)]**

3 marks

g) Article 8(3) provides that the entire application is deemed withdrawn, and so will need to be refiled. **[1 mark(i)]**

1 marks