

# Foundation Certificate

## FC5 Trade Mark Law

Thursday 17 October 2019 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 **black ink**.
  - 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 **nine sheets**, including this sheet.

## 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**

### 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**

### Question 3

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

**2 marks**

#### Question 4

Jonah owns a chain of fish and ship 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**

## 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

## 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

### 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**

### 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**

### 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**

### 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**

**SECTION A Total: 40 marks**

## 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 you hear the term 'SWEET AND SOUR'." 50% answered "A Chinese meal" and 50% answered "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**


**Total: 20 marks**

### 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                                              |
|------------------------------------------------------------------------------------|-----------------|-------------|--------------------|-------------------------------------------------------|
|  | logo            | 1/8/2019    | Not yet registered | Class 41 – Casinos<br>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].

**Total: 20 Marks**

### 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 |

**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 email 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**