

FC5 – Trade Mark Law
FINAL Mark Scheme 2020

SECTION A

Question 1

- a) List the four requirements necessary to establish a filing date for a UK trade mark application. **2 marks**
- b) List the two further requirements necessary for this application to proceed to examination. **1 mark**
- c) List the four requirements necessary for subsequent overseas trade mark applications to claim priority from this application. **4 marks**

Total: 7 marks

Answer

- a) *Section 32(2) TMA requires that the application shall contain:*
- (5) *a request for registration of a trade mark, [0.5 mark (i)]*
 - (ii) *the name and address of the applicant, [0.5 mark (ii)]*
 - (iii) *a statement of the goods or services in relation to which it is sought to register the trade mark, [0.5 mark (iii)] and*
 - (iv) *a representation of the trade mark [0.5 mark (iv)]*
- 2 marks**
- b) *Section 32(2) requires a statement that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used. [0.5 mark (i) – precise wording not required]*
- Section 32(4) requires the payment of the application fee [0.5 mark (ii)] (and such class fees as may be appropriate)*
- 1 mark**
- c) *Article 4 of the Paris Convention requires that:*
- (i) *the UK filing must be the first filing [1 mark (i)]*
 - (ii) *the UK filling must be for the same subject matter as the subsequent filings [1 mark (ii)]*
 - (iii) *the subsequent filings to be made by the applicant or a successor in title to the UK filing [1 mark (iii)]*
 - (iv) *the UK filing must not have been made more than six months earlier than the subsequent filings. [1 mark (iv)]*

Alternative (additional) marks are being made available for candidates who discussed the procedure for claiming priority in subsequent applications:

Under Article 4 of the Paris Convention, the applicant must provide:

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- (v) a declaration of priority **[1 mark (v)]**
- (vi) particulars of the priority application **[1 mark (vi)]**
- (vii) a copy, if required, and certified if necessary, of the priority application **[1 mark (vii)]**
- (viii) the overseas jurisdiction must be a member of the Paris Convention/WTO **[1 mark (viii)]**

Up to 4 marks

Total: 7 marks

Question 2

Using the correct terminology, explain how the costs of obtaining trade mark protection using the Madrid Protocol are calculated.

[Do not discuss ‘subsequent designations’.]

6 marks

Answer

Article 8(2) of the Madrid Protocol provides that the fee comprises the total of:

- (i) a basic fee. **[0.5 mark (i)]** payable (to the International Bureau) by all applicants **[0.5 mark (ii)]**
- (ii) a supplementary fee **[0.5 mark (iii)]** for each class of the International Classification **[0.5 mark (iv)]**, beyond three **[0.5 mark (v)]**
- (iii) a complementary fee **[0.5 mark (vi)]** for each contracting party to which the applicant seeks to extend protection **[0.5 mark (vii)]**
- (iv) an individual fee **[0.5 mark (viii)]** in place of the supplementary and complimentary **[0.5 mark (ix)]** fees, set by the contracting party (where they so declare) **[0.5 mark (x)]**. A second-part individual fee on successful extension **[0.5 mark (xi)]** may be payable in some states (such as Japan) **[0.5 mark (xii)]**.

An additional half mark up to the maximum total is available for referencing:

*The handling fee of the Office of Origin **[0.5 mark (xiii)]***

Total: 6 marks

Question 3

- a) Explain why book titles are generally regarded as unprotectable as a registered trade mark (to the extent they purport to protect Class 9: electronic books, and Class 16: printed books).

2 marks

- b) Name the one EU jurisdiction which has a specific unregistered right protecting the titles of publications such as books.

1 mark

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- c) Set out the condition under which the right described in part b), above, might serve as an earlier right for the purposes of invalidating an EU trade mark.

1 mark

Total: 4 marks

Answer:

- a) *A trade mark is required to have distinctive character, and not describe a characteristic of the goods at issue. [1 mark (i)] A book title is indicative of the work that forms the content of the book, not of the unique source of origin of the book. (Were this not the case, a trade mark would be particularly problematic once copyright in the book has expired, and the work becomes free for any publisher to reproduce). [up to 1 mark (ii) for an explanation, however expressed]*

2 marks

- b) *Germany*

1 mark

- c) *Article 8(4) provides that the use in Germany must be of more than local significance.*

1 mark

Total: 4 marks

Question 4

Cordelia, a UK representative of Regan, Inc., an American company, seeks to register Regan's trade mark in the UK, in her own name, without Regan's consent.

Regan instigates opposition proceedings.

What defence does the *Trade Marks Act 1994* provide Cordelia in this situation?

1 mark

Answer

Section 5(6) TMA provides that the application is to be refused unless Cordelia (the agent) justifies her action.

1 mark

Question 5

In 2019, Demetrius applies for, and is granted, a UK registered trade mark for the word 'DONKEY'. Helena has used the name 'DONKEY' on identical goods since 2010.

Demetrius instigates infringement proceedings.

Set out the requirements of the defence potentially available to Helena.

[Do not discuss counterclaims for revocation, or absolute grounds.]

3 marks

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Answer

0.5 marks are available for up to six of the following points:

Section 11(3) provides that a registered trade mark is not infringed by the use in the course of trade in a particular locality [0.5 mark (i)] of an earlier right which applies only in that locality.

For this purpose an ‘earlier right’ means an unregistered trade mark or other sign continuously used [0.5 mark (ii)] in relation to goods or services [0.5 mark (iii)] by Helena or a predecessor in title of hers [0.5 mark (iv)] from a date prior to whichever is the earlier of [0.5 mark (v)]—

(a) the use of the first-mentioned trade mark in relation to those goods or services [0.5 mark (vi)] by Helena or a predecessor in title of hers, or

(b) the registration of the first-mentioned trade mark in respect of those goods or services [0.5 mark (vii)] by Helena or a predecessor in title of hers;

and an earlier right shall be regarded as applying in a locality if, or to the extent that, its use in that locality is protected by virtue of any rule of law (in particular, the law of passing off). [0.5 mark (viii)]

3 marks

Question 6

Orlando grants an exclusive licence to Rosalind to use his UK registered trade mark.

- a) **Explain why the licence should be registered at the IPO, and who should undertake this registration.**

2 marks

The exclusive licence is duly registered. Orlando now wishes to assign the trade mark to Celia.

- b) **Explain what paperwork (and/or online forms) need to be completed in order to do this, together with any statutory formalities for their execution.** [Form numbers and precise fees are not required.]

4 marks

Total: 6 marks

Answer

Half marks for relevant points including:

- a) *Section 25(3) provides that until an application has been made for registration of the prescribed particulars of a registrable transaction:*

the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark [0.5 mark (i)] in ignorance of it [0.5 mark (ii)], and

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a person claiming to be a licensee by virtue of the transaction does not have the protection of section 30 or 31 (rights and remedies of licensee in relation to infringement) [0.5 mark (iii)].

The licence needs to be registered by a person claiming to be entitled to an interest in or under a registered trade mark (i.e. either Orlando or Rosalind) [0.5 mark (iv)].

2 marks

- b) *The assignment document needs to be prepared [0.5 mark (i)]. Section 24(3) provides that an assignment of a registered trade mark is not effective unless it is in writing [0.5 mark (ii)] and signed [0.5 mark (iii)] by or on behalf of the assignor [0.5 mark (iv)].*

Section 28(3) provides that unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest. [0.5 mark (v)] and consequently there is no formality required in these circumstances for any party to assign or register the licence [0.5 mark (vi)].

Section 25 (2) (a) provides that an assignment of a registered trade mark is a registerable transaction [0.5 mark (vii)], and so needs to be registered by a person claiming to be entitled to an interest in or under a registered trade mark by virtue of the assignment [0.5 mark (viii)] i.e. either Orlando or Celia.

The registration needs to be evidenced with a copy of the application if not signed by both parties [0.5 mark (ix)], and a registration fee paid [0.5 mark (x)].

4 marks

Question 7

Section 10(4) Trade Marks Act 1994 states that 'affixing' a sign 'to goods or the packaging thereof' constitutes an infringing use of a trade mark. List six other stated examples of infringing use.

3 marks

Answer

Any six of the following:

- a) *offering or exposing goods for sale [0.5 mark (i)],*
- b) *puts them on the market [0.5 mark (ii)]*
- c) *stocking [0.5 mark (iii)] them for the above purposes*
- d) *offering or supplying [0.5 mark (iv)] services under the sign;*
- e) *importing [0.5 mark (v)] or exporting [0.5 mark (vi)] goods under the sign;*
- f) *using the sign as a trade or company name [0.5 mark (vii)] or part thereof;*
- g) *using the sign on business papers [0.5 mark (viii)] and in advertising [0.5 mark (ix)]*

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- h) *using the sign in comparative advertising in a manner that is contrary to the Business Protection from Misleading Marketing Regulations 2008. [0.5 mark (x) No need to get the name of the Regulations precisely correct]*

3 marks

Question 8

Under what conditions may a trader operating in the European Union lawfully use their own name without infringing an existing EU trade mark for the same name and area of business?

2 marks

Answer

Article 14(1)(a) EUTMR provides that:

The trader has to be a natural person. [1 mark (i)]

The use must be in accordance with honest practices [0.5 mark (ii)] in industrial or commercial matters [0.5 mark (iii)]

2 marks

Question 9

Portia is the owner of separate EU and UK trade marks, each for the word 'GOBBO', protecting Class 14: gold and silverware.

Antonio buys Portia's GOBBO-branded silverware in Italy and imports it into the UK for onward sale to UK jewellery stores. Portia instigates High Court infringement proceedings.

Explain whether the principle of exhaustion provides Antonio with a defence. Address both of Portia's trade marks in your answer.

4 marks

Answer

Section 11(1) TMA and Article 15(1) EUTMR provide that a trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market in the European Economic Area [0.5 mark (i)] under that trade mark by the proprietor [here, Portia]. [0.5 mark (ii)]. Consequently, the import and sale infringes neither the EU [1 mark (iii)] nor UK trade marks [1 mark (iv)]. Unless there are legitimate reasons for Portia to oppose such sale, for example if quality is impaired. [1 mark (v)]

4 marks

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Question 10

Unlike the position in the UK, the *EU Trade Mark Regulation* restricts the grounds on which opposition actions can be based, instead requiring that certain grounds be raised in post-registration invalidity proceedings.

Briefly outline the full range of grounds that can be raised in EU opposition proceedings.

4 marks

Answer

1 mark for the first four grounds given in the candidate's answer. Grounds must be described comprehensively and accurately to achieve the full mark.

EU oppositions can only be based on a limited number of relative grounds, that is:

- *earlier EU trade marks, (i)*
- *national trade marks effective in the EU (including well-known marks) (ii)*
- *national unregistered rights, (iii)*

or

- *the registration of principals' marks by agents, (iv) or*
- *actions based on designations of origin/geographic indications.(v)*

4 marks

SECTION A Total: 40 marks

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SECTION B

Question 11

'Lardy Bread' is a traditional bread from Wessex in south-west England. It is made from a dough made with lard (pig fat) and sultanas, and loaves are characterised by a sticky outer coating made of caramelised sugar. Both the dough and the coating are unique features of Lardy Bread, neither feature being used in any other type of bread, alone or in combination. You act for the Association of Wessex Bakers (the 'AWB'), a trade body. The AWB has successfully lobbied the UK Government to have Lardy Bread recognised as a Protected Designation of Origin ('PDO'). This prohibits, by law, the name 'Lardy Bread' from being used on any bread or cake anywhere in the UK or EU unless (1) baked within the four specified counties of Wessex, (2) made with the traditional ingredients referenced above and (3) exhibiting the traditional sticky coating.

The AWB seeks your advice on whether it can enhance the protection of authentic Lardy Bread by registering two trade marks:

- a) the name 'Lardy Bread';

and secondly:

- b) the concept of a sticky caramelised-sugar outer coating.

Both to protect Class 30: breads and cakes.

Set out ALL the objections that the UKIPO would raise with these applications (with reasons) by applying the fundamental requirements of Sections 1 and 3 TMA 1994, namely, the definition of a trade mark, representation requirements, inherent and acquired distinctiveness, and other exclusions from registrability.

In doing so, address the longstanding use of the name 'Lardy Bread' by bakers in Wessex, on bread exhibiting the sticky coating. Also address whether the legal oligopoly (exclusive right) enjoyed by bakers in Wessex under the PDO affects the registrability of these trade marks.

[Do not discuss 'Certification' or 'Collective' marks.]

10 marks for analysing each trade mark

Total: 20 marks

Answer

a) 'Lardy Bread' name

Up to 10 marks are available for good points:

Section 1/Section 3(1)(a) TMA -- the name is that of a generic product made by multiple undertakings (bakers) and therefore inherently unable to distinguish to goods and services of one undertaking from those of other undertakings. [1 mark (i) - with a half mark for identifying legal ground and half mark for giving reasons]

Section 3(1)(b) –the name would be perceived as the name of the product and not that of a specific undertaking's product. Indeed it is quite clear that a large number of different

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undertakings (bakers) all produce the same product under that name. [1 mark (ii) – 0.5 marks for discussing merely whether ‘lardy’ is an adjective for ‘containing lard’ in this and each other 3(1) ground]

Section 3(1)(c) – the name is descriptive of a characteristic of a bread in particular its ingredients [1 mark (iii)]

Section 3(1)(d) – the name has been commonly used in the trade for a type of bread [1 mark (iv)]

Section 3(4A) explicitly prohibits the registration of PDOs. [1 mark (v)]

Longstanding use gives rise to a need to consider the availability of acquired distinctiveness [1 mark (vi)] which is theoretically possible in respect of Section 3(1)(b) to (d) [1 mark (vii)]. but not possible in respect of objections under other subsections The objections under section 3(1)(a) and, in particular, section 3(4A) are therefore fatal to any application regardless of the extent of the use [1 mark (viii)].

Even then, longstanding use is not itself sufficient to overcome distinctness objections. [1 mark (ix)] Only if customers are educated to recognise the sign as that of a single undertaking will the objection fall away – here that is not the case. [1 mark (x)] Indeed, longstanding use alone is insufficient to demonstrate acquired distinctiveness: a range of Windsurfing criteria must be taken into account [1 mark (xi)].

The existence of a legal oligopoly also does not provide assistance per se. [1 mark (xii)]. The fundamental problem remains that the PDO is indicative of a product from any number of undertakings meeting the qualifying requirements [1 mark (xiii)].

No evidence has been presented as to the acquired distinctiveness of the word for ‘cakes’ [1 mark (xiv)] however, the same objections are likely to apply [1 mark (xv)] and registration might also potentially attract an objection for being misleading. [1 mark (xvi)].

10 marks

b) Sticky Coating

Up to 10 marks are available for good points:

Section (1)(a) requires the trade mark to be depicted in a manner that is clear and precise – with further elaboration set out in Sieckmann. [1 mark (i)]. Representing the coating in an acceptable format is almost certainly impossible.

A graphic representation will not be able to accommodate the amorphous shape [1 mark (ii)] or sticky texture [1 mark (iii)] of the coating.

A written description likewise will fail to give a certainty, particular as to the texture [1 mark (iv)]

A recipe would need to be made-up, and is therefore not self-contained [1 mark (v)]

Samples are not permissible (as being neither accessible, self contained nor durable. [1 mark (vi)]

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Section 3(1)(b) – the depiction would be perceived as a feature of the product [1 mark (vii)] and even were it to do so, it would not indicate the goods of a specific undertaking. [1 mark (viii)].

Section 3(1)(c) – any depiction is descriptive of a characteristic feature of a bread [1 mark (ix)]

Section 3(1)(d) – the coating has been commonly used as a feature of a bread [1 mark (x)]

Section 3(2)(a) – the coating is a characteristic of the goods themselves [1 mark (xi)].

Section 3(2)(b) – the coating is a characteristic necessary to obtain a technical result – a sticky crust being a technical result in the baking industry [1 mark (xii)].

Section 3(2)(c) – the coating is a characteristic giving substantial value – as well as the visual signal, the sticky coating has the value-adding property of providing taste or texture [1 mark (xiii)].

Evidence of longstanding use helps out only with section 3(1)(c-d) grounds and not with the objections presented by sections 3(1)(a) and (2) [1 mark (xiv)] and even then does not address to problem of multiple use by different undertakings [1 mark (xv)].

There is no evidenced use of the sign in connection with ‘cakes’ where sticky coatings are more common (e.g. on Danish pastries) [1 mark (xvi)]

The PDO has no benefit, as it is the name, not the sticky coating, that is protected. [1 mark (xvii)]


10 marks

Total: 20 marks


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Question 12

Your client, Claudius, owns the following trade mark:

Mark	Goods Protected	Registration Date
	Class 5: olive oil for medical use; ear medicines.	1/1/1972

Claudius has spotted the following trade mark application by Rosencrantz, currently being advertised for opposition purposes:

Mark	Goods Protected	Filing Date
	Class 4: mineral oil for use in automotive shock absorbers. Class 7: automotive shock absorbers designed for the purposes of alleviating motion sickness.	1/6/2020

Claudius also explains:

- DOCTOR SOOTHE is the UK's most-recognised ear-care brand.
- Expert evidence demonstrates that motion sickness, in 75% of cases, is caused by inner-ear inflammation, which DOCTOR SOOTHE ear medicine treats.
- Olive oil is most commonly used for culinary purposes, but in purified form is used to loosen ear wax.
- Mineral oils are toxic if eaten, but have no adverse health effect (or benefit) if accidentally introduced into the ear canal.
- A serpent coiled around a rod is a commonplace symbol of medicine.

Advise Claudius of his prospects of successfully opposing Rosencrantz's application.

[Do not discuss passing off, copyright, or protection for 'marks with a reputation' under *Section 5(3) TMA*.]

20 marks

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Answer

Note: The marking scheme sets maxima to ensure balanced discussion of all the issues. Strong answers on some issues to offset weaknesses discussing other issues, as long as the overall score is capped at 20 marks.

ENFORCEABILITY OF THE EARLIER MARK

The earlier mark was registered a long time ago and so is potentially unenforceable. We must check unknowns: is it actually being used for olive oil? And is it still used substantially in the form presented? [1 mark (i)]

We shall assume yes to both in order to continue with the analysis:

Total for enforceability discussion: 1 mark

SIMILARITY OF MARKS

A maximum of eight marks are available within the limits set out below:

Aural

(Up to 2 marks, (i) – (ii))

The letters DR are likely to be pronounced, and thus heard as, ‘DOCTOR’

That being so, two of the three syllables are identical.

One syllable differs, but only by one very similar consonant sound (the ‘M’).

Visual

(Up to 3 marks, (iii) – (v))

Both marks are presented in monochrome, in letterbox format, comprising a stylised device to the left and two words to the right, and the word elements are in identical typefaces.

The devices both comprise a sinusoidal coil about a rod.

The visual presentation of the first word is very different in each case.

Whilst visually the first words are different, the second words are each of six letters, with the same initial letter, and shared run of four letters.

Conceptual

(Up to 2 marks, (vi) – (vii))

The word elements of both marks present the conceptual image of a doctor plus an arbitrary, yet descriptive, word.

‘Smooth’ and ‘soothe’ both have the similar conceptual meaning of flattening or making less rough.

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The devices depict signs relevant to the respective goods, potentially reinforcing the differences between the marks.

Conclusion

(Up to 1 mark (viii))

All three types of similarity are likely to be equally important,

Words are generally regarded in trade mark law as contributing more to the distinguishing power of a mark. However, device marks are very much designed for visual recognition.

Overall, the marks are highly similar.

Maximum for SOM discussion: 8 marks

SIMILARITY OF THE GOODS

Up to eight marks for relevant points (one mark each, with more basic points indicated) attracting half marks:

Medicine v Shock Absorbers

Nature, characteristics and composition, method of use – medicines are entirely different to metal mechanical parts. [0.5 mark] (i)

Use / purpose– ordinarily no commonality, but here there is a connection in that both are being supplied to alleviate a physiological problem. And possibly the same problem. (ii)

Users – the general public, albeit the car owner vs the patient. (In fact, the mechanic might be a more relevant end-users here, as shock absorbers are supplied as part of a service, and so the brand is of less interest to the motorist). (iii)

Common manufacturer? – No: entirely different. [0.5 mark] (iv)

Common distribution channels (wholesale or retail)? Entirely different: garages v pharmacies (possibly supermarkets) (v)

Competition / complimentary – Not in completion. Ordinarily not complimentary, although a complimentary use is indicated in the current case. (vi)

Olive oil v mineral oil

Nature, characteristics and composition – both are given the name oils, but very different in origin and chemical composition (i)

Users – The end user in the mineral oil here is likely to be the car mechanic, not the ultimate car- owner. (ii)

Uses / purpose– no commonality [0.5 mark] (iii)

Common manufacturer? – No: entirely different [0.5 mark] (iv)

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Common distribution channels (wholesale or retail) - entirely different: garages v pharmacies [0.5 mark] (v)

Competition / complimentary – Not in competition or complimentary. [0.5 mark] (vi)

Overall, there is a weak similarity in the first case (medicine v shock absorbers), and absolutely no similarity in the second case (olive v mineral oils). [1 mark] (vii)

Total maximum for SOG discussion: 8 marks

AVERAGE CONSUMER

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

Shock absorbers would be bought by the motorist, although indirectly as a product provided as a service through a garage. The specialist garage mechanic might be a more representative AC.

Only the very advanced home mechanic is likely to require this mineral oil: the AC for mineral oil is likely to be the specialist garage mechanic.

Medicines and treatments would be bought by the ordinary consumer, albeit one who is unwell. Also by medical service providers.

Total maximum for AC discussion: 2 mark

LIKELIHOOD OF CONFUSION

Up to three marks, (i) – (iii), for a relevant point, such as:

At least one product line appears to enjoy enhanced distinctiveness in its field

Strong similarity of the marks can potentially counteract the weak similarity of the goods.

In all cases, users are likely to choose products with both deliberation and care.

Purchases are likely only to be made on the advice from pharmacist / mechanic.

No real opportunity of confusion: at best there is ‘association’

It is unrealistic to suggest one manufacturer has branched out into the others’ field.

Total maximum for LOC discussion: 3 marks

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CONCLUSION

One point, (i), available for a clear, actionable, conclusion, that is consistent with the analysis. For example:

On balance, despite the similarity of the signs, confusion is not likely in either instances and so any action is unlikely to be successful.

Total for conclusion: 1 mark

Total: 20 marks

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Question 13

On 1 September 2020, your client, Duncan, applied to register two UK trade marks:

- the word 'DAGGER';
- a graphic device (called 'THE LOGO' in this question).

No priority was claimed. The marks were published on 1 October 2020.

Duncan has meanwhile investigated other peoples' rights in, and usage of, similar marks. The results are described below.

For each case, advise whether the right's owner can successfully oppose the registration of Duncan's trade mark. Assume that references to 'similar' mean that confusion is inevitable if used on identical goods.

- a) A trade mark similar to DAGGER was registered in January 2012 for both identical goods and dissimilar goods, but all in the same Nice class. It has only ever been used on the dissimilar goods (and does not enjoy a 'reputation' even for these).
2 marks
- b) A trade mark similar to DAGGER was registered in August 2010 for identical goods, but expired in August 2020. It was last used on 15 September 2015.
2 marks
- c) A trade mark similar to DAGGER was registered in January 2010 for identical goods, and expired in January 2020 following a deliberate decision of the owner not to renew it. It was last used in 2019. The owner nevertheless has indicated that he does not want anyone else using the name.
1 mark
- d) A trade mark similar to DAGGER was registered in 2011 for identical goods but was last used in 2014. The owner has recently made preparations to resume use of the name.
2 marks
- e) A trade mark similar to DAGGER was registered in the UK in 2012 for identical goods, but it has only been used on items manufactured for export from the UK. No promotional material has ever been supplied to UK consumers.
2 marks
- f) Malcolm was using the word DAGGER, on identical goods, extensively, between 1972 and 2014. Malcolm's sign was never registered.
5 marks
- g) A trade mark for a device similar to THE LOGO was registered in 2011 for identical goods, but in practice a variation of the device has been used by the owner since then.
2 marks

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h) Investigations reveal that THE LOGO is in fact a piece of clip art, copyright in which is owned by a commercial picture database, Shuttlecock, Inc. The clip art was created in 2010 but soon afterwards was removed from Shuttlecock's website. The clip art was never lawfully downloaded and there is no record of it ever having been used commercially. No one knows how Duncan's graphic designers found a copy.

2 marks

i) Some clip art similar to THE LOGO was registered in 2009 as a UK registered design by another commercial picture database, Yeti Images, Inc. The design remains in force and visible on the UK IPO Registered Designs database, but there is no evidence of it having ever been used commercially. There is no doubt any commercial use by Duncan of THE LOGO would infringe Yeti Images' registered design.

2 marks

Total: 20 marks

Answer

a) *Section 6A TMA provides that the trade mark can only be used in opposition proceedings if it has been used in the five years prior to the filing date [1 mark (i)]. Subsection 6A(1) provides that where an earlier trade mark satisfies the use conditions in respect of only some of the goods for which it is registered, it shall be treated as if it were registered only in respect of those goods. [1 mark (ii)] The mark therefore cannot serve as an earlier right.*

2 marks

b) *We are still in the six month grace period for renewals set out in section 43(3) TMA. [1 mark (i)]. The mark meets the five year use requirement of section 6A (which is measured backwards from the filing date) so is valid earlier right [1 mark (ii)], if renewed.*

2 marks

c) *The mark will not be able to be restored. [1 mark (i)]. (Section 6(3) no longer affords marks protection in the 12 months after renewal, and so the mark, even though it meets the use requirement of section 6A, cannot serve as a valid earlier right.)*

1 mark

d) *The mark does not meet the requirements of section 6A. [1 mark (i)]. In particular, commencing preparations for the resumed use of the mark are not (unlike in invalidity actions) a relevant factor [1 mark, however expressed (ii)]*

2 marks

e) *The mark meets the requirements of section 6A. [1 mark (i)] as subsection 4(a) provides that use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purpose. [1 mark (ii)]*

2 marks

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f) Section 5(4)(a) provides that the sign protected against use by the law passing off can serve as a valid earlier right. **[1 mark (i)]**. Section 6A does not apply in passing-off cases **[1 mark (ii)]**. However, if the product line has been discontinued, it is very possible that goodwill has been 'abandoned' taking away the grounds on which to base a passing-off action **[1 mark (iii)]**. It is doubtful too whether a mark that has not been used for so long still has the power to induce a misrepresentation **[1 mark (iv)]**, or that the goodwill will be damaged. **[1 mark (v)]**.

5 marks

g) The mark meets the requirements of section 6A. **[1 mark (i)]** if (and only if - as subsection 4(a) provides) that it differs in elements which do not alter the distinctive character of the mark in the form in which it was registered. **[1 mark (ii)]** i.e. similarity is not enough.

2 marks

h) Section 5(4)(b) provides that the sign protected against use by copyright law can serve as a valid right for opposition purposes. **[1 mark (i)]**. Section 6A (i.e. requiring use) does not apply **[1 mark (ii)]**.

2 marks

i) Section 5(4)(b) provides that the sign protected against use by Registered Design law can serve as a valid right for opposition purposes. **[1 mark (i)]**. Section 6A does not apply in these cases **[1 mark (ii)]**.

2 marks

Total 20 Marks

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FINAL Mark Scheme 2020**

Question 14

Your firm acts for Cressida, a Welsh inventor.

Cressida has patented a 'left-handed screwdriver' which, using a system of internal ratchets and gears, permits screws to be tightened using an *anticlockwise* wrist motion and vice versa. Cressida's invention has become a tremendous success with left-handed people, who have hitherto struggled to use traditional screwdrivers.

Cressida learns that Trolls Ltd, an English company, is writing to manufacturers of left-handed screwdrivers worldwide, stating that it (Trolls) owns the worldwide IPR in the technology. Trolls demands payments for damages, and future royalties, from the manufacturers. Some of these manufacturers are licensed by Cressida (and have already paid Cressida a licence fee) and others are not (having been manufacturing the screwdrivers without Cressida's permission, or because Cressida did not patent the technology in the countries concerned). Manufacturers have simply been paying Trolls without conducting due diligence on Trolls' rights, out of fear of the costs of litigation.

Trolls has no commercial connection with Cressida.

Your firm is considering various legal measures to take, and you have been tasked with considering whether the law of **passing off** can assist.

- a) **Outline a case for a passing off action, and assess its strength.** [Do not consider any other law.]

13 marks

- b) **State the remedies available to Cressida if such an action is successful, including the source of law (legislation or otherwise) for these remedies, and the principles by which any monetary award would be calculated.**

7 marks

Total: 20 marks

Answer

- a) *In order to successfully make out a claim for passing-off, the classic trinity of goodwill, misrepresentation and damage must be proven: [1 mark (i)]*

Goodwill

Up to 4 points for a precise identification of the goodwill owned by Cressida and associated issues. For example:

Cressida is clearly operating in business (namely IP licensing) [1 mark (i)] which is attracting trade and so undoubtable benefits from goodwill. [1 mark (ii)]

Whilst manufacturing is worldwide, the licensing is apparently being conducted from the jurisdiction of England and Wales, [1 mark (iii)] and therefore goodwill is within the jurisdiction of England and Wales. [1 mark (iv)]

Misrepresentation

Up to 4 points for a precise identification of the misrepresentation perpetrated by Trolls and associated issues. For example:

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Assuming there are no parallel right that Trolls actually owns [1 mark (i)], Trolls would appear to be making a clear misrepresentation that it owns the rights when it does not. [1 mark (ii)]. In fact this is a case of reverse passing off, where the misrepresentation comes from the claiming credit for others work rather than pretending to be that person. [1 mark (iii)]. The jurisdiction in which the misrepresentation is made is not important [1 mark (iv)]. A misrepresentation affecting Cressida might however be difficult to make out with respect to jurisdictions in which Cressida owns no rights [1 mark (v)].

Damage

Up to 4 points for a precise identification of the nature of the damage suffered by Cressida and associated issues. For example:

The position with licensees who are paying additional royalties to the fees already paid to Cressida is not straightforward [1 mark for analysis to this effect (i)]: however, the concept of damage, for the purposes of law of passing off, includes diversion and will probably apply to the circumstances here [1 mark (ii)]

Licensees who have not paid Cressida, but who, are doing in settlement of their IP obligations, [1 mark (iii)] are clearly having their fees - properly due to from Cressida and diverted to Trolls [1 mark (iv)] -, Other manufacturers may pull out of manufacture altogether [1 mark (v)] and so causing Cressida damage within the scope of passing off law. Damages affecting Cressida might however be difficult to make out with respect to jurisdictions in which Cressida owns no rights [1 mark (vi)].

Conclusion

Any actionable conclusion consistent with the analysis above [1 mark (i)]

13 marks

b) Remedies

Up to 7 marks for good points relevant to the remedies available to Cressida. For example:

The remedies available are those provided for at common law and through the equitable jurisdiction of the courts [1 mark (i)] (i.e. not under the Trade Marks Act), namely: (Equitable) right of injunction [1 mark (ii)] to engage in further acts causing misrepresentation [1 mark (iii)]

Damages. [1 mark (iv)] to compensate Cressida for lost income diverted from Cressida to Trolls [as a result of licensees believing that this satisfied the IPR issues with the technology [1 mark (v)]

(Equitable) right to an account of profits. [1 mark (vi)] covering the profits made by Trolls, from the misrepresentation, including that on money made in addition to fees paid to Cressida, and any monies which will not have been paid to Cressida [1 mark (vii)] An election of account-of-profits precludes a claim also to damages. [1 mark (viii)]

Other remedies: (Equitable) right of delivery up of the instruments of deception (promotional material etc.) by which the misrepresentation is being conducted OR declaration of infringement OR Costs. [1 mark (x)]

**7 marks
Total: 20 marks**