

Foundation Certificate

FC5 Trade Mark Law

Thursday 15 October 2020

15:00 to 18:00 UK British Summer Time (GMT + 1 hour)

Total time allowed: 3 hours 30 minutes

Starting from the time when you download the question paper, you have 3 hours 30 minutes in which to:

- Print this question paper (if wished)
- Answer the questions
- Take two screen rest breaks of 5 minutes each
- Save your Answer document to your hard drive as a pdf
- Upload your answer document to the PEBX system.

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. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other pre-set formatting in the Answer document.
7. Start each question on a new page. To begin a new page, press the control key and the enter key simultaneously.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in your answers.
10. **Candidates who have been granted approval to handwrite their answers:** Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.

This question paper consists of **9 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

11. Save your Answer document to your hard drive and follow the instructions for uploading your document onto the PEBX system.

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**

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

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**
- 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**

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

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

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

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

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

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

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

SECTION A Total: 40 marks

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

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

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

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

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