

**Question 1.**

a) Distinctive character refers to features of a trademark that are not descriptive and that distinguish the TM (trademark) from other marks ✓1(i), hence distinguishing the proprietor of the TM's (trademark) goods and services from those of another undertaking. ✓1(ii)

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b) Acquired distinctiveness 3 a trademark can acquire distinctive character through the use made of it, ie through use the relevant class of consumers now identify it as a mark of origin for the goods/services for which it is registered. ✓1(i)

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c) Enhanced distinctiveness:

A trademark may already have some distinctive character, but through use it may have become more distinctive enabled goods/services for which it is registered to be distinguished easier from those of other undertakings.

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**MARKS AWARDED 3/4**

**Question 2.**

a) The UK trade mark may still claim priority from the US trademark – it is still a valid claim to priority.

According to Paris Convention, priority can be claimed from an application filed in another convention country regardless of the outcome of that application (as long as other conditions ie claimed within 6m of filing the US mark, same applicant or successor in title, same mark, same goods & services. ✓1

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b) The UK trade mark application is likely to be refused, as it is devoid of any distinctive character.

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c) No, because the trademark must be identical to the trademark it claims priority from.

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Examiner's  
use only

- d) Because the UK application was not withdrawn leaving no rights outstanding including the right to claim priority

Hence, the EU application is not the first filing of the trademark, and cannot serve as the priority filing for any further TM application

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MARKS AWARDED 1/6

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### Question 3.

- a) graphical representation of mark must be "clear, precise, self-contained, objective, durable & intelligible"

Sieckman v GPTO ✓1(i)

The EU trademark will likely be objected on grounds that it is not capable of being represented graphically (needs to be precise – what colour ✓1(ii) pink, pantone number – to what part of vehicle etc) ✓1(iii) it is devoid of any distinctive character – it is too vague & descriptive ✓1(iv)

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- b) Acquired distinctiveness will not overcome the fact that it cannot be represented graphically. ✓½(ii)

It may be used in overcoming objections that it is devoid of distinctive character, but the previous objection (graph representation) would need to be overcome first. ✓½(i)

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- c) the colour now has a technical function of the trademark is now defined by features needed for a tech effect. ✓1(i)

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MARKS AWARDED 6/7

### Question 4.

- Because it is still possible to restore any expired UK Trademarks if restoration is applied for at the UK Office within 12 months of expiry ✓½(ii) (as long with evidence that there was an underlying intention to comply with missed deadline that led to expiry ✓½(iii))

- It is still possible to request Restitutio in Integrum for any expired EUTM (which would also form part of the earlier trademarks in the search) as long as the request is to the EUIPO and is within 2 months of withdrawal of obstacle to compliance and within 12 months of expiry (need evidence that despite all due care deadline was missed)
- It is still possible to re-instate International Trademarks designating the UK (ITM(UK)) within 12 months of expiry. Need to supply evidence (all due care).

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MARKS AWARDED 1/4

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**Question 5.**

- if the infringement/infringing use is in the UK
- if the trademark has not expired (as long as the trademark is in force).
- if they are a licensee, they must do so with the consent of the proprietor (who will be made party to proceedings)
- if they are an exclusive licensee, they may do so without consent of proprietor, but the proprietor will be made party to proceedings
- can only enforce against a subsequent licence in or under the mark if they have registered the licence on the trade mark register.

**Question 6.**

- a) – Record the assignment on the Trademark ✓1(iii) register
- File a request & evidence (will)
  - Should be carried out by executor of the will
  - Should be registered within 6 months of assignment or as soon as practicable thereafter. ✓1(v)
- b) If new owner brings infringement proceedings, they will not be awarded costs in the proceedings if assignment was not recorded on the trademark register within 6 months of the assignment or as soon as practicable thereafter. ✓1(ii)

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MARKS AWARDED 3/7

**Question 7.**

- a) The training booklet is a reference material and its reproduction of the trademark PASER (use as a verb “may paser him”) gives the impression that it is the generic term for the product.

Owner is concerned as one of the grounds for revocation of a trademark is that “due to the acts of inactivity of the proprietor ✓½(i) of the Trademark the trademark has become the generic name for a product for which it is registered.” ✓½(ii)

Therefore, if do not rectify the booklet – it could be used as evidence for revocation. ✓1(iii)

- b) As the training booklet is a reference work, they may request that, at the latest in the next edition, the trademark is accompanied by an indication that it is a registered trademark.

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**MARKS AWARDED 2/4**

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**Question 8.**

- a) Goodwill

Has Marie goodwill in scientific community? Is currently working as a merchant banker, which suggests not, ✓½(i) but she completed a doctorate in nuclear chemistry, although she is not currently working in that area, there would still be residual goodwill.

Misrepresentation

- “reverse misrepresentation” – Pierre is claiming another’s work as his own. ⇒ this is still a misrepresentation.

Damages

- no monetary prize
- but if she did not apply then might not be a loss
- there is a loss of opportunity perhaps, in ✓½(iii) being able to use work, or publish under her name.

Conclusion

There is goodwill, misrepresentation & possible damages – may be successful

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b) Goodwill

- £10 million on advertising Quantum the large amount invested would suggest that it has reached a lot of potential customers a large percentage of people may recognise the mark
- but the cat food has not gone on the market
- therefore, unlikely that there is goodwill ✓2(i)+(ii)

Misrepresentation

- “deliberate intent” of indential goods & indential mark. Therefore, there is misrepresentation.

Damages

- would be a loss of potential customers.

Conclusion

Action likely to be unsuccessful as there may be no goodwill.

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c) Goodwill

- There has to be goodwill in the UK
- Has to be a business in the UK ✓½(i)
  - Hertz is a German company
  - They only sell to German customers under the name Blitzen ✓½(ii)
- Therefore, there is no business in UK
  - ⇒ Therefore, there is no goodwill.

It doesn't matter that some British customers are aware of the German firm's services – Hertz has no goodwill in UK, therefore there can be

- no misrepresentation ✓½(iv)
- no damages. ✓½(iii)

Conclusion

Action will not be successful

d) Goodwill

- CIPA are established in UK
- Have goodwill – they are recognised as supplying/ it being the mark of qualified patent attorneys

Misrepresentation

- claiming to be recognised by CIPA
- claiming a false endorsement from CIPA

Damages

- may be damaging to reputation of CIPA

Conclusion

Likelihood of success

Examiner's  
use only

2½

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SUB  
TOTAL  
5½

**Question 8 part 2.**

a) Yes, because the UK office can refuse the registration as it is a well known mark in UK ✓½(ii) and France are part of Paris Conv.

Art 6 bis ✓½(i)

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b) No – not a well known mark in the UK must be in relation to goods in UK  
– not member of Paris Convention

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c) No – ✓½(ii) not a well known mark in UK ✓½(i)

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d) Yes – unitary effect of EUTM applies across union. ✓½(i)

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**MARKS AWARDED 10/20**

SUB  
TOTAL  
4½

10

**Question 9.**

a) Advantages of using Madrid Protocol

- ⇒ single application – reduces administrative burden instead of filing at each national office individually ✓
- ⇒ after registration, there is a single renewal fee to keep – to keep the international Trademark ✓
- ⇒ can add subsequent designations – if a new country joins Protocol or if business expands can file designations for new country

Advantages of filing directly at national Offices

- ⇒ no central attack – in Madrid Protocol, the international app is dependent on base registration for the first 5 years, therefore if base registration is revoked/invalidated, so too is the International Registration/Application. ✓
- ⇒ It may be more cost effective to file nationally, as Madrid Protocol has three separate fees application fee, basic fee, **one unclear word** or individual fee ✓

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b) Isaac can file a UK trademark application or an EU trademark application as the base application as he is a national of UK & domicile in EU. ✓1(i)

Advantage of filing base app with UK office

- application is in English
- quick to register.

Advantage of filling base app at EUIPO

- no statement of use required. ✓1(other)

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c) It will delay the registration

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- d) FRANCE : 2 months ✓½ from publication of app by WIPO ✓½  
 GERMANY : 3 months ✓½(PE) from ✓½(ii) the start of the month following  
 & the month in which the application was published by ✓½(IT)  
 ITALY Office (German or Italian)  
 SPAIN : 2 months ✓½ from publication of application by the Office (Spanish office). ✓½  
 USA : 30 days ✓½ from publication ✓½(xi) by USPTO (extended by 180 days) ✓½(x)

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- e) FRANCE, GERMANY, ITALY, AND SPAIN

⇒ needs to be used within 5 year ✓½(i) period immediately following registration. ✓½(ii)

USA

⇒ needs to be used/put to genuine use within 3 years ✓½(iii) of registration ✓½(iv)

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- f) A statement of genuine use or genuine intent to use with evidence. ✓

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MARKS AWARDED 14/20

**Question 11.**

- a) An exemption to infringement ✓1(i) is "the use of the trademark to indicate the intended purpose of a product (eg accessory or spare parts ✓1(iii))."

If suspension spring is indeed a spare part for Rutherford cars, then they Hooke are allowed to use the trademark "Rutherford" "if it is within the honest practices of the trade". ✓(iv)

Does the advertisement of "cheap" fall outside honest practices? ✓½(v)

Does the term "RUTHERFORD SUSPENSION SPRINGS" falsely deceive public into thinking the springs are made by RUTHERFORD? ✓1(vi)

If yes, then Hooke is infringing.

4½

b) In Opel v Autotec it was deemed that if the customer did not perceive the use of the mark to be an indicator of origin of the goods then it is not an infringement. ✓½(i)

The logo is in a painting of the car, which is in turn on a jigsaw ✓½(vi).  
Although Rutherford have registered the logo for games & playthings, it is doubtful that the consumer ✓1(ii) would understand the logo in the painting to be an indicator of origin of the jigsaw.

Therefore, it is unlikely to be successful. ✓½(vi)

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c) Importing of goods for which mark is registered under the mark is an infringement. ✓1(i)

Importing from outside the EEA

⇒ no exhaustion of rights provision. ✓1(ii)

Therefore, unlawful.

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d) While there is exhaustion of rights ✓½(i), the goods are not in same condition as those originally put on the market by RUTHERFORD. ✓½(iv)

She should remove the logo. ✓½(vii)

1½

e) Ruby is using a similar mark for similar services.

⇒ the reg mark RUTHERFORD is probably subject to a reputation (ie it is a famous car manufacturer)

⇒ The use of Ruby's mark RUTHERFORD's is taking without due cause unfair advantage of the repute of the make "RUTHERFORD". – she is not connected with the company but people would no doubt associate them

⇒ would it be detrimental to the repute of the mark? Probably not unless the repairs were particularly bad.

⇒ also a likelihood of confusion, especially associating the garage with the cars.

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**MARKS AWARDED 11/20**