

Question 1

- a) Distinctive character relates to the mark being able to distinguish the goods and services from one undertaking from those of other undertakings, ✓1(ii) i.e. the relative people (the consumers) are able to identify a product or service as originating from a particular company, Distinctive character therefor indicates origin. ✓1(i) 2
- b) If, through use of the trademark, the trademark has acquired distinctive character, i.e. the use made by the proprietor or with his consent allows the consumer to identify the origin of a product or service ✓1 1
- c) A mark that is widely known as a mark of a particular company/trader, i.e. the mark has a large amount of distinctive character and reputation to the relevant consumer (e.g. apple's logo for computers). 0

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MARKS AWARDED 3/4**Question 2**

- a) There is no consequence for the UK trademark application. The right to claim priority from an application is achieved if the application is sufficient to acquire a filing date, regardless of the outcome of the application. Therefore, the fact that the US application was refused will have impact on the UK application. ✓1 1
- b) The UK trade mark application will be refused as descriptive marks are not registrable under the UK Trademark Act 1994 (Absolute grounds) regardless of the priority date, evidence of acquired distinctiveness will not help. 0
- c) Yes, a trademark application can have more than one priority date. The deadline to claim priority is 6 months from the filing date of the priority application, therefore if multiple trademark applications ✓1(i) are filed prior to the 6 month priority period, a trademark application filed 6 months from the filing date of the first application can claim priority from all the applications if the mark is the same and the applicant is the same. This may occur if you have applications for the same sign but for different goods and services ✓1(ii) and in the priority-claiming application

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you wish to register the sign for all the goods and services in a single application. The effective dates of the particular goods and services might be different, but you can claim priority from both/all applications.

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- d) The UK trademark was not withdrawn leaving no rights outstanding. Furthermore, to effectively “reset the priority clock”, the subsequent application must be filed in the same convention country, the UK and EU applications are not the same convention country. Was the UK application published? If so, you cannot claim priority.

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MARKS AWARDED 3/6**Question 3**

- a) The likely objection is that the trademark contravenes Article 4 EUTM as, while colours are listed as an example of a trademark, any trademark must be capable of distinguishing the goods and services of one undertaking from those of other undertakings and be capable of representation on the EU trademark register in a manner that allows the public and competent authorities to clearly and precisely obtain the subject matter afforded protection to its proprietor. The Sieckmann criteria can be used to assess this ground, i.e. if the mark:

- clear
- precise
- self-contained
- easily accessible
- intelligible
- durable, and
- objective

to the competent authorities and the public, then it can be registered.

✓ 1(i)

A description of the term “the colour pink”, is not clear, precise, intelligible, durable or objective. Therefore, the application will be refused as it cannot be represented on the register. ✓ 1(ii)

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- b) For the representation objection, no as evidence of acquired distinctiveness can only be helpful to overcome Article 71(b), (c), (d) - type objections. Therefore, objection will still stand. ✓ ½(ii)

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- c) The colour fuchsia pink is necessary to obtain a technical result as improved safety is a technical result achieved by the fuchsia pink colour, therefore the application can be refused on the grounds that the mark consists of the shape, or another characteristic, that is necessary to obtain a technical result as the colour fuchsia pink is “another characteristic”.
 ✓1(i) These objections cannot be overcome with evidence of acquired distinctiveness, so the overwhelming familiarity will have no effect on the refusal of the application. ✓1(ii)

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MARKS AWARDED 4.5/7

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Question 4

1. In case the proprietor applies for restoration of the expired mark, in which case the mark will become registered and citeable. Can apply 6 months ✓1(i) from removal of the mark from the register and so the deadline to apply for restoration. may be during the 12 mo period. ✓½(ii)
2. If the national mark has formed the basis of a seniority claim in an EU trademark application, and has asked to be recorded as such, but has lapsed.
3. If the national mark has been replaced by an international registration and has been asked to be recorded as such, but has lapsed.

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MARKS AWARDED 1.5/4

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Question 5

If the terms of the licence permit the bringing of legal proceedings.

If the licence is an exclusive licence-

If the proprietor of the registered trademark has not brought proceedings, the licensee of his own volition may bring infringement proceedings. The proprietor will be informed and may be made a party to the proceedings, but will not be awarded costs in the event that the infringement proceedings are successful.

An exclusive licence excludes the actions of the patent proprietor. Any licence (exclusive or non-exclusive) will need to be in writing, signed by or on behalf of the granter and registered at the UK IPO to have effect.

Question 6

- a) The daughter ✓1(iv) needs to register ✓1(iii) the bequeath at the UKIPO as she is now the successor in title of the UK trademark. Any person who has gained an interest in the trademark can apply to have the transaction registered. The request needs to be made in writing and signed by or on behalf of the trade mark owner, as the registered owner has died, I would suggest the daughter files the request for registering the transaction and files a copy of her father's will as evidence. The registration can be done at anytime, but should occur as soon as possible otherwise in infringement proceedings the court will not award costs for infringing acts occurring prior to her father's death unless the transfer was recorded within 6 months of her father's death (or when she acquired the rights) or it was not practicable to record the transfer within 6 months, as soon as it became practicable to so. ✓1(v)

Trademark can be transferred by assignment, testamentary disposition, ✓1(ii) but needs to be recorded at UKIPO.

The daughter could also get her father's representative to sign on his behalf and the file evidence.

- b) The daughters rights will be ineffective against a third party who acquired rights in the trademark and registered the rights prior to the daughter. ✓1(i) If her father granted someone else an exclusive licence, which was registered prior to the change in ownership, the daughter cannot enforce her rights in the trademark.

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MARKS AWARDED 5/7

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Question 7

- a) The description relates to the intended purpose of the goods to which the trademark is registered. Any person could apply to the EUIPO for declaration of invalidity on the absolute ground that the trade mark consists exclusively of signs or indications that serve in trade to designate the kind, quality, quantity, intended purpose, geographical origin, value, the time of production or of the rendering of the goods, or other characteristic of the goods or services, Any successful invalidation will result in the registered trademark never having effect. The validity could also be put at issue on the basis of a counterclaim in infringement

proceedings. Opposition period has expired, so no oppositions can be filed- it could also indicate that the term is generic and therefore not be serving as a registered trademark ✓ ½(ii)

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- b) Can file evidence of acquired distinctiveness if, through use, the mark "PASER" has acquired distinctive character, i.e. that the public would associate the word "PASER" with the owner's product regardless or whether the term is printed in the manual. The client could also request that, the publisher indicates that the term is a registered trademark, at the latest in the next edition of the published training booklet.

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MARKS AWARDED ½/4

Question 8

- a) Goodwill: Mary has no UK business, ✓ 1(i) she may be an expert in nuclear chemistry, but she has been working a merchant banker. Therefore, Marie has no goodwill. ✓ 1(ii)

MISREPRESENTATION: Pierre has clearly made a misrepresentation as he has passed of Marie's thesis and the work within it as his own. Therefore, there is misrepresentation.

DAMAGE: As Marie has no goodwill in the UK, there is unlikely to be damage to the goodwill, even though the money Pierre acquired could be deemed a "loss of opportunity". ✓ 1(iii)

SUMMARY: Any passing off action is likely to fail.

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- b) Goodwill: Erwin could have goodwill as they they have invested a significant amount of money on a marketing campaign in the UK. An actual business is not required, if a significant amount of the public recognise the product as belonging to Erwin (i.e. goodwill has acquired through use via the marketing. Erwin has goodwill, provide evidence of public's perception.

MISREPRESENTATION: there is clearly misrepresentation as we are told that Bohr are deliberately deceiving customers.

DAMAGE: Damage can be inferred through loss of sales or a tarnished reputation. If Bohr's activities put a substandard product on the market, which causes a loss of sales, or is likely to, and tarnishes, the goodwill built up through the marketing campaign then there will be damage and

a successful passing off. If there is no damage to the goodwill, or no likely damage then the passing off action will fail. ✓1(iii)

SUMMARY: It depends on the likelihood of damage occurring, I believe Erwin's sales and profits will suffer so there is a likelihood of damage. Therefore, a passing off action will succeed.

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- c) GOODWILL: Goodwill for services can only be established if the service is available in the UK. ✓½(i) We are told that UK individuals are aware of Hertz GmbH, but can they actually purchase his services? If not, there is no goodwill and any passing off action will fail. ✓½(ii)

MISREPRESENTATION: There is misrepresentation as UK customers are concerned.

DAMAGE: No indication of damage other than the confusion on the part of the public, ✓½(iv) but as Hertz GmbH does not provide his services to the UK, he has no goodwill in the UK and so there can be no damage to goodwill. ✓1(iii)

SUMMARY: Passing off action will fail

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- d) Goodwill: CIPA is a UK company and so could benefit from goodwill. Whether CIPA is a UK business is questionable, although CIPA, through use, will have built up a reputation as providing patent attorneys for hire. ✓1(i)

MISREPRESENTATION: Albert is falsely labelling himself as a chartered Patent Attorney, which gives the impression that his professional activities are endorsed by CIPA so there is misrepresentation

DAMAGE: If it is likely that the misrepresentation will result in actual chartered patent attorneys refraining from registering with CIPA, then there is a likelihood of damage and passing off would be successful. CIPA will need to show that damage i.e. tarnished reputation or loss of profit has occurred. ✓1(iii)

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SUBTOTAL

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PART 2

- a) France does not recognise unregistered trademarks and so can only rely on Art 6bis of Paris Convention. As the mark will not be well known to the competent authorities concerned in the country where registration is sought (the UK) that it is a well known mark in France as it is only known in the UK. Therefore, any action will fail as use has only occurred in the UK.
- b) France is a member of the Paris Convention, as is the UK, therefore Jersey not being a member of the Paris Convention is irrelevant. ✓½(ii) The mark is well known in the UK as ✓1(i) belonging to the owner of the trademark, therefore the UKIPO will know that the protection conferred in France is already given to somebody else, Therefore, any action under Art 6bis PC will be effective.
- c) The mark is not well known in the UK ✓1(i) as belonging to another person in France. Therefore, any action under Art 6bis PC will likely fail. ✓1(ii)
- d) If the well known mark was “well known” prior to the filing (or priority) date of the EU trademark it can be cited in EU opposition ✓1(ii) or invalidity proceedings. It would likely be successful as France is a EU country and therefore of the application is refused due to the mark being well known in France, which is clearly the case, the EU trademark application will be refused throughout the entire EU. ✓1(i)

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SUBTOTAL

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MARKS AWARDED 14/20

Question 9

- a) Madrid Protocol
 1. Strategically simpler – the applicant files a request at the office of origin for an international registration which is forwarded to WIPO, only one representative needed. ✓
 2. Opportunity for replacement, allows for financial savings as national marks are automatically replaced, therefore can allow these marks to lapse
 3. Renewal fees are streamlined, so simpler. ✓

National protection

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|---|----|
| <p>1. Do not need to “qualify” to file a national registration, anyone can file, unlike the Madrid Protocol. ✓</p> <p>2. No provision for central attack as there is in the Madrid protocol. ✓</p> <p>3. Avoids expensive costs of transformation, which may be incurred if there is a successful central attack on the basic application.</p> | 4 |
| <p>b) A UK trademark application as he is a resident of the UK or an EU trademark application as the UK is a Member State of the EU. ✓1(i)
UK advantage: Less likely to subject to successful central attack as absolute grounds will only be assessed in the UK, ✓1(ii) also cheaper than EU trademark application.
EU advantage: can obtain protection in the whole of the EU, therefore the only supplementary and complementary (or individual) fees payable will be for the USA in the international application ✓1(iii)</p> | 3 |
| <p>c) Extending the timeframe to examine the international application to 18 months will increase the timeframe for registration. ✓1(i)</p> | 1 |
| <p>d) FRANCE – 2 months ✓½(i) from when WIPO publishes the application ✓½(ii)
Germany – 3 months ✓½(iii) beginning on the first day of the month after WIPO publishes the international application.
Italy – 3 months ✓½(v) beginning on the first day of the month after WIPO publishes the international application. ✓½(vi)
Spain – 3 months from publication of the application. ✓½(viii)
USA – 30 days ✓½ after WIPO publishes ✓½(xi) the international application (extendable up to 180 ✓½(x) days post publication)</p> | 4½ |
| <p>e) France, Germany, Italy and Spain are all 5 years, ✓½(i) in the USA, it is 3 years. ✓½(iii)</p> | 1 |
| <p>f) Intent to use or proof of use. ✓1</p> | 1 |

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MARKS AWARDED 14½/20

Question 10

a) Likelihood of confusion – signs

Similarity of signs must be assessed on a global level, assessing the visual, aural and conceptual similarities of each sign.

Visual: the marks are visually very similar as they differ by an apostrophe and the letter S. This could give the impression that the sign belongs or is endorsed by the earlier trademark. Very little difference. ✓1SOM

Aural: the marks sound very similar and give the impression that the marks are designating the goods to the same origin or that they belong to Einstein.

Conceptual: conceptually the marks are similar as they both relate to the scientist Albert Einstein and no other difference could be inferred by this. ✓1SOM

SUMMARY – there is a likelihood of confusion on the part of the public regarding the similarity of the signs.

Likelihood of confusion – goods + services

Wine and wine glasses are very similar and are used in conjunction with each other as wine ✓1SOG is usually drunk in wine glasses. When assessing likelihood of confusion it is necessary to consider the reputation of the earlier mark. As use has been small, there is no indication that the earlier mark has enhanced distinctive character. ✓1LOC One must also consider the end user of the goods. In this case, the end user will be the same person as both goods are used by the same end-user. ✓SOG We should also consider whether the goods will be in direct competition with one another. which is unlikely as the sales of one will likely positively affect the other. ✓SOG Both wine and wine glasses have been around for a long time and go hand-in-hand with each other.

SUMMARY – the goods covered by the earlier trade mark and the sign are similar and there will be a likelihood of confusion.

CONCLUSION: use without due cause of the sign would infringe the earlier trademark as the sign is similar to the of the earlier trademark and the goods and services in respect of which the sign is used are similar to those of which the earlier trademark is registered and there will be a likelihood

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of confusion on the part of the public, which will likely include the likelihood of associating the sign with the earlier trademark. ✓½CONC

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- b) Goods are identical so LOC . The proprietor of the earlier trademark could attempt to oppose on the grounds that the sign in the trade mark application is similar to that of the earlier trade mark and is applied to be registered for goods and services identical ✓SOG to that for which the earlier trade mark is registered.

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The proprietor will need to show that there is a likelihood of confusion on the part of the public that they will associate the good as originating from the proprietor.

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Visually the signs are very dissimilar as the arrangement of letters are totally different. ✓SOM Aurally the signs are very different as the number of syllables is different and the sounding of both words are different.

✓1SOM

Conceptually the signs are similar as both words refer to animals that look fairly similar ✓SOM and could be perceived (and often are) by the public to be one or the other (i.e. confuse crocodiles and alligators). ✓1SOM

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The reputation of the earlier trade mark will need to be assessed, as trade marks that are very distinctive can produce a likelihood of confusion with signs that conceptually similar. In the present case, the earlier trade mark is only being used on a small scale and therefore is unlikely to have a reputation and benefit from enhanced distinctive character, ✓1LOC this could be fatal to the opposition. The proprietor could provide evidence of confusion showing that the public perceive the image of an alligator as being associated with boat engines made by the proprietor, With out such evidence, the visual and aural differences between the two marks will likely result in the likelihood of confusion between the two marks being minimal.

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SUMMARY: the opposition will likely fail as given the small use of the product, there can be little reputation in the earlier TM to allow the public to associate the two words based on the concept of crocodiles and alligators being conceptually similar animals. **CONC** ✓½

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MARKS AWARDED 13/20