

Trade Mark Law FC5 (P7)

Thursday 20 October 2016 15:00 to 17:00

INSTRUCTIONS TO CANDIDATES

1. You should attempt **eight of questions 1 to 9** in Part A and **five of questions 10 to 15** in Part B.
2. The marks awarded to each question are shown at the foot of the question and sub-question as appropriate.
3. If more than the required eight questions are answered in Part A, or more than the required five questions are answered in Part B, only the first eight or five presented in each respective part 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 may 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 eight sheets, including this sheet.

Part A

Question 1

- a) Where can you file an application to register a European Union trade mark (EUTM), according to Article 25(1) '*Filing of applications*' of *Commission Regulation (EC) 207/2009*?

1 mark

- b) What four requirements must an application to register an EUTM contain in order to obtain a filing date, in accordance with Article 26(1) '*Conditions with which applications must comply*' of *Commission Regulation (EC) 207/2009*?

2 marks

- c) How are the application fees for EUTMs calculated, according to Article 26(2) '*Conditions with which applications must comply*' of *Commission Regulation (EC) 207/2009*? (No fee amounts are needed.)

1 mark

- d) What is the deadline for payment of application fees, under Article 27 '*Date of filing*' of *Commission Regulation (EC) 207/2009*?

1 mark

Total: 5 marks

Question 2

Section 3 '*Absolute Grounds for Refusal of Registration*' of the *UK Trade Marks Act 1994* sets out the categories of sign that shall not be registered as United Kingdom trade marks. 'Specially protected emblems' is one such category. List five others.

Do not list any of the types of specially protected emblem referred to in Sections 4, 57 or 58 of the UK Trade Marks Act 1994.

5 marks

Total: 5 marks

Question 3

- a) What legal benefit does 'consent' from the owner of an earlier registered trade mark provide to a trade mark applicant or owner, according to Sections 5(5) '*Relative grounds for refusal*' and 47(2) '*Grounds for invalidity of registration*' of the UK Trade Marks Act 1994?

2 marks

- b) Give one further reason why an applicant for registration of a trade mark might seek consent.

1 mark

- c) Suggest two reasons why the owner of an earlier registered mark might grant consent.

2 marks

Total: 5 marks

Question 4

- a) Section 10 '*Infringement of registered trade mark*' of the UK Trade Marks Act 1994 sets out the scenarios in which a sign can infringe a UK registered trade mark if used in the course of trade. One scenario is if:

a person uses a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

What are all the other scenarios, as set out in Section 10(2) and (3)?

4 marks

- b) Set out the circumstances in which a printer, who applies a registered trade mark to material intended to be used for labelling, can be treated as a party to infringement, under Section 10(5).

1 mark

Total: 5 marks

Question 5

Section 11(3) '*Limits on effect of registered trade mark*' of the UK Trade Marks Act 1994 provides a defence to infringement on the basis of an earlier right in a particular locality. Write notes on the requirements for that defence to operate.

5 marks

Question 6

List the five categories of registrable transaction, according to Section 25 '*Registration of transactions affecting registered trade mark*' of the UK Trade Marks Act 1994.

5 marks

Question 7

- a) What limit, if any, is there to the number of goods/services which may be claimed in a Madrid Protocol application, under Article 3 '*International Application*' of the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*?

1 mark

- b) Explain the difference between:

- i) a basic fee;
- ii) a supplementary fee; and
- iii) an individual fee

for the purposes of Article 8 '*Fees for International Applications and Registration*' of the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*.

3 marks

- c) The International Bureau notifies you that the fees you have paid are insufficient to cover the number of classes of good and services you have listed in your Madrid Protocol application. According to Article 8, what happens if the shortfall is not paid (or the list of good or services is reduced) before the deadline set by the International Bureau?

1 mark

Total: 5 marks

Question 8

Set out the two relative grounds on which a European Union trade mark application may be opposed without the opponent having to have an earlier registered trade mark (or earlier registered trade mark application), according to Article 8 '*Relative grounds for refusal*' of *Commission Regulation (EC) 207/2009*.

List all the requirements that need to be demonstrated for each ground.

5 marks

Question 9

What is meant by 'exhaustion of rights' as set out in Article 13 '*Exhaustion of the rights conferred by a European Union trade mark*' of *Commission Regulation (EC) 207/2009*?

5 marks

Part B

Question 10

Outline the procedure of:

- a) the United Kingdom Intellectual Property Office
- b) the European Union Intellectual Property Office

6 marks

6 marks

in relation to the official search for earlier trade marks during the examination of a trade mark application. Explain the steps in the procedure followed by each Office and the actions which the applicant needs to take.

Total: 12 marks

Question 11

- a) An application to register the word 'yes' in English as an EU trade mark would be subject to refusal under Article 7(1)(b) '*Absolute grounds for refusal*' of *Commission Regulation (EC) 207/2009* on grounds that it is devoid of any distinctive character. Your client wishes to register the word 'kyllä', which means 'yes' in the Finnish language. Write notes on likely absolute grounds for objection in relation to 'kyllä' and whether there are any provisions in Article 7 on which your client might rely.
3 marks
- b) Your client has heard that, if his application is refused, he has the option of 'conversion'. Explain the term in the context of Article 112 of *Commission Regulation (EC) 207/2009*.
2 marks
- c) Outline the procedure for conversion and identify any deadlines.
6 marks
- d) Explain whether conversion is an option in this case.
1 mark

Total: 12 marks

Question 12

In this question, ONLY address the law of passing off.

Your client is an Argentinian football player. He has never played in Europe but he was the star player for Argentina in the 2014 World Cup held in Brazil when his team reached the final. World Cup matches are watched by billions of television viewers around the world including in the UK.

Football clothing and football equipment, all bearing his name under licence, are sold on market stalls in North and South America. These products are also sold through an Argentinian website controlled by your client. The website can be viewed in the UK but it is not possible to place orders for shipping to the UK.

Your client has registered his name as a trade mark for sports clothing and sports equipment throughout North and South America, but not so far in Europe.

Your client tells you that a Welsh company has started to sell chewing gum bearing his name. He also has evidence that the Welsh company employs an actor who closely resembles him to promote the chewing gum. The actor dresses as a footballer, in a football strip in the same colour as your client's team, with your client's name printed on the shirt.

Your client says he has never endorsed any products intended for sale in the UK. Nor has he endorsed any products in North and South America except his own licensed clothing and sports equipment ranges.

- a) Outline the remedies that the law of passing off can provide your client, assuming he is able to establish a successful case.**

2 marks

- b) Discuss whether the law of passing off can in fact prevent the continued use of your client's name and image in the UK in relation to the chewing gum, given the above facts.**

9 marks

- c) Give a recommendation on what action your client should take, based on his prospects for success.**

1 mark

Total: 12 marks

Question 13

In this question, DO NOT address the law of passing off.

In 2000, your client opened a business under the name SAXON, offering lessons in microlight flying. Microlight aircraft are essentially hang-gliders with engines. In fact, many people who enjoy flying hang-gliders go on to fly microlight aircraft, and most schools offer lessons in both.

He registered the name SAXON as a trade mark in the UK in 2000 in relation to teaching microlight flying. He renewed the registration in 2010. He has been actively giving microlight flying lessons under the SAXON trade mark since 2000.

He contacts you because a watching service for his trade mark has disclosed that a Karen White has applied to register SAXONY as a trade mark in the UK in relation to teaching hang-gliding.

Your client instructs you to oppose Karen White's trade mark application, which has just been published.

- a) Advise your client of the ground of opposition which has the best chance of success and analyse the prospects for success based on the above information.**
8 marks

Your client tells you that Karen White used to be an instructor at his school and believes she has 'stolen' the name.

- b) Suggest a further possible ground of opposition, in light of the possible 'theft' of the name and discuss what your client must prove.**
4 marks

Total: 12 marks

Question 14

- a) What are the advantages of registering a trade mark as a single EU trade mark rather than registering the mark as separate national registrations in several EU territories?**

9 marks

- b) What are the disadvantages of registering a trade mark as a single EU trade mark rather than registering the mark as separate national registrations in several EU territories?**

3 marks

Total: 12 marks

Question 15

Set out precisely (including any limitations and qualifications) the grounds for revocation of a UK trade mark for non-use, described in Section 46 '*Revocation of registration*' of the UK *Trade Marks Act 1994*.

12 marks