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SECTION A

Question 1

a) The four requirements necessary to establish a filing date for a UK trade mark application are as follows:

- a request for a trade mark; ✓½ (i)
- the name and address of the applicant; ✓½ (ii)
- a representation of the trade mark which fulfils the requirements of Section 1(1) (i.e. clear and precise and capable of distinguishing one undertaking from those of other undertakings); and ✓½ (iv)
- information identifying the goods and/or services applied for. ✓½ (iii)

2

b) The two further requirements necessary for this application to proceed to examination are:

- the application fee (including payment of any additional class fees for each additional class above one); and ✓½ (ii)
- a statement confirming that the applicant is using or has a *bona fide* intention to use the mark. ✓½ (i)

1

c) The four requirements necessary for subsequent overseas trade mark applications to claim priority from this application are:

- the application number;
- the country in which it was filed (i.e. UK);

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- the name of the applicant; and
- a copy of the priority application. ✓1 (vi)

Priority must be claimed within 6 months of filing the first application and also relate to the same mark for the same (or narrower) goods or services.

✓1 (iv)

✓1 (i)

✓1 (ii)

MARKS AWARDED: 7/7

4

7

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Question 2

The costs of obtaining trade mark protection using the Madrid Protocol are as follows:

- Basic Fee ✓½ (i)

This is payable for all international registrations and includes class fees up to three classes of goods and/or services; ✓½ (ii)

- Supplementary Fee ✓½ (iii)

This is payable for international registrations including more than three ✓½ (v) classes of goods and/or services (i.e. it is for each class above the third); ✓½ (iv)

- Complementary Fee ✓½ (vi)

This is payable to cover the designated member states; ✓½ (vii)

The supplementary and complementary fees are payable to contracting members who have elected not to receive individual fees and are the same regardless of member state. ✓½

- Individual Fee ✓½ (viii)

This is payable to member states who have elected to receive individual ✓½ (ix) fees. The amount of individual fee is set by the individual member state. ✓½ (x)

MARKS AWARDED: 5.5/6

5½

5½

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Question 3

- a) Book titles are generally regarded as unprotectable because they are descriptive and devoid of distinctive character. ✓1 (i) 1
- b) Germany ✓1 1
- c) An EU trade mark can be invalidated based on an earlier right in accordance with local law of any member state. Thus as Germany is a member of the EU this law can be used to invalidate an EU trade mark. 0

MARKS AWARDED: 2/4

2

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Question 4

The UK Trade Marks Act provides that opposition proceedings may be instigated by the proprietor of trade mark where a representative or agent seeks to register the mark without the proprietor's consent, unless the representative or agent is able to justify their actions. ✓1

Thus Cordelia may be able to argue that she has reasons for registering Regan's trade mark (for example, that she is the UK representative of Regan, Inc.)

MARKS AWARDED: 1/1

1

1

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Question 5

Helena may be able to use her unregistered trade mark as a defence against infringement.

The UK Trade Mark Act provides that continuous use of an unregistered, identical mark for the same goods and services may be used as a defence against infringement proceedings, provided that:

the use of the unregistered mark was before the earliest date of use of the registered mark; or

the use of the unregistered mark was before the filing/priority date of the registered mark;

to the extent that the unregistered trade mark is protected by any rule of law (e.g. passing off).

Thus if Helena has used the mark "Donkey" continuously from 2010 it appears that she will have a defence against infringement.

MARKS AWARDED: 2.5/3

2½

2½

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Question 6

- a) The licence should be registered at the UKIPO as it is a “registrable transaction” as defined by the UK Patents Act. Without registration the exclusive licensee is not able to bring infringement proceedings against a potential infringer. In addition, the licence is ineffective against any person acquiring a right in or under the trade mark in ignorance of it, if it is not registered within 6 months of execution or as soon as practicably possible.

The UK Trade Mark Act states that the person who is acquiring the right in or under the trade mark should register the licence. Thus, in this case, Rosalind should register the exclusive licence.

Alternatively, any person effected by the licence may also register it.

- b) The assignment should be registered within 6 months of the assignment taking place or as soon as practically possible.

The assignment must be made in writing and a fee to record the assignment must be paid.

The assignment must be signed by the assignor, or in the case of a body corporate, the fixing of a corporate seal is sufficient (except in Scotland).

3½

MARKS AWARDED: 3.5/6

1½

2

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Question 7

Six other examples of infringing use are as follows:

- 1) offering goods; ✓½ (i)
- 2) stocking goods; ✓½ (iii)
- 3) offering or supplying services; ✓½ (iv)
- 4) importing or exporting goods; ✓½ (v) ✓½ (vi)
- 5) using on business papers and in advertising; and ✓½ (viii)
- 6) using in comparative advertising in a manner that contravenes the business directive.

3

MARKS AWARDED: 3/3

3

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Question 8

✓½ (ii)

The use must be in accordance with honest practice in the course of industrial or commercial trade. ✓½ (iii)

1

MARKS AWARDED: 1/2

1

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Question 9

Portia has separate UK and EU trade marks.

The principle of exhaustion exists in relation the EU trade marks. The goods have been placed on the market in the EEA and therefore Portia's rights are said to be exhausted. Having an EUTM does not give Portia the right to prevent others from further sale of the goods that have been marked, unless the proprietor has reasons to prevent further sale (for example, if the condition of the goods has changed). It does not appear that the condition of the goods has been substantially changed and therefore Antonio can use the principle of exhaustion as a defence.

✓ 1 (iii)

✓ ½ (i)

Allow ✓ 1 (v)

The principle of exhaustion does not apply to UK trade marks and thus Portia can prevent Antonio from importing the marked goods.

MARKS AWARDED: 2.5/4

2½

2½

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Question 10

The grounds that can be raised in EU Opposition proceedings are relative grounds; grounds relating to unregistered rights according to local law (e.g. in the UK passing off) and registration without consent by an agent or representative. Allow ✓1 (i)
✓1 (iii)

These can be briefly summarised as follows:

- identical mark and identical goods or services;
- similar mark and identical goods or services, wherein there includes a likelihood of confusion between the two marks (which includes a likelihood of association);
- identical mark and similar goods or services, wherein there includes a likelihood of confusion between the two marks (which includes a likelihood of association); and
- identical mark and identical/similar/dissimilar goods or services, wherein use without due cause would be detrimental to, or take unfair advantage of, the distinctive character or repute of the earlier mark;
- unregistered mark having more than mere local significance in accordance with national law which confers the right to prevent registration of a later mark; and
- where a representative or agent seeks to register the mark without the proprietor's consent, unless the representative or agent is able to justify their actions.

3

MARKS AWARDED: 3/4

3

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SECTION B

[I have chosen to answer Questions 11, 12 and 14]

Question 11

The definition of a trade mark is defined as any mark which is capable of:

- being represented in the register which enables the registrar, competent authorities and the public to determine the clear and precise subject matter of protection afforded to the proprietor; and
- capable of distinguishing the goods/services of one undertaking from those of other undertakings.

Trade marks should also not be registered for signs which:

- are devoid of distinctive character;
- are descriptive, namely indicating the kind of goods, quality, quantity, geographical origin, or any other characteristic of the goods/services; or
- have become customary in the common language or in the *bona fide* and established practices of the trade.

a) Lardy Bread

This mark appears to fulfil the “clear and precise” requirement of Section 1(1) TMA.

However, it is arguable whether it fulfils the requirement of Section 1(2) TMA i.e. to distinguish the goods/services of one undertaking from those of other undertakings. The AWB is a trade body and therefore represents a number of

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different undertakings (suitably who bake the “Lardy Bread” as per the requirements of the PDO). Thus it not possible to use the mark “Lardy Bread” to distinguish the goods/services of, for example, one bakers from those of other bakers. ✓1 (i)

In addition, it is likely that the term “Lardy Bread” be considered to be descriptive. It describes a bread made from lard. Applying the “Doublemint” case law, the words “lardy bread” could be used by other bread makers to describe the characteristics of their bread. Thus giving a trade mark to this right would be restrictive. ✓1 (iii)

However, it is possible to overcome the descriptive objection based on filing evidence that the mark has acquired distinctiveness through the use made of it. ✓1 (vi) It may be possible to file evidence that the phrase “lardy bread” has become associated with the trade mark alone, rather than any other meaning. As “Lardy Bread” has been used by bakers in Wessex it is likely that the mark has acquired distinctiveness.

However it is not possible to overcome the objection relating to Section 1 with acquired distinctiveness. ✓1 (vii)

Furthermore, “Lardy Bread” is a PDO. The UK TMA prevents registration of a mark which is a PDO. It is therefore not possible to obtain protection for this mark. ✓1 (iv)

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

This is likely to fall foul of Section 1.

The concept of a sticky-caramelised-sugar outer coating has several issues in fulfilling the requirements as a trade mark, as follows:

- sticky – how to define sticky? This is not clear or precise (i.e. what is sticky to one person may not be to another) ; ✓1 (i)
- outer – how to define outer? This is not clear or precise (i.e. what is outer? How much cake/bread has to be covered?). ✓1 (ii)
-

The AWB may have more success trying to submit a sample of the bread. However, this is non-traditional representation will also likely fail. In order to assess the non-traditional representation, the Sieckmann criteria must be applied, which describes that the mark must be:

- clear
- objective
- durable
- precise
- intelligible
- easily accessible
- self-contained.

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Such a sample is not easily accessible (given people would have to request samples) or durable (would lose “stickiness” and/or degrade over time). ^{1 ✓(vi)}

Providing evidence of acquired distinctiveness would not assist in overcoming the Section 1 objection. ^{✓1 (xiv)}

The PDO does not appear to protect the concept of a sticky caramelised-sugar outer coating because it is necessary to meet all three conditions in order to fulfil the PDO.

5

MARKS AWARDED: 10/20

10

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Question 12

The marks in question (“DOCTOR SOOTHE” and “DR SMOOTH” are not identical but are similar. The UK TMA provides that it is possible to oppose if:

- similar marks used and identical or similar goods and services, where there exists a likelihood of confusion (including a likelihood of association);

Marks

The marks must be compared aurally, visually and conceptually.

Aurally

The “DR” and “DOCTOR” are spoken as the same word (i.e doctor). ^{✓1 (i)} “SOOTHE” and “SMOOTH” share the same vowel sound and have the same number of ^{✓1 (ii)} syllables. They are aurally very similar.

Visually

The text is very similar, and there are the same number of words. Both marks have a serpent coiled, though there is a small snake head on the client’s mark. This minor difference is unlikely to be appreciated by the average consumer who has imperfect recollection. However, “DOCTOR” and “DR” are different as are ^{✓1 (i)} “SMOOTH” and “SOOTHE”. They are visually similar because of the dominant features (i.e. the serpent coiled around a rod and the block text). ^{✓1 (ii)}

Conceptually

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Both refer to a “DOCTOR”/ “DR”. However conceptually they are different. One refers to a DOCTOR SOOTHE (medicine) and the other to a DR SMOOTH (shock absorbers). The word SOOTHE brings to mind calming, medicative properties whereas the word SMOOTH refers to motion. Allow ✓1

SOM 5

Goods or Services

Class 5: olive oil for medical use; ear medicines

Class 4: mineral oil for use in automotive shock absorbers

Class 7: automotive shock absorbers designed for the purposes of alleviating motion sickness

There is no direct overlap. Class 5 and 7 may be considered to be complementary as ear problems (goods in class 5) cause motion sickness, which the goods in class 7 also aim to alleviate. ✓1 (vi)

Class 4 and 5 are similar in that they both refer to oils (mineral oils and olive oil, respectively) but they are used for different purposes. ✓1 (iii)

SOG - 2

Likelihood of Confusion

Applying the Canon principles, a lesser degree in similarity between the goods or services may be offset by a greater similarity between the marks. ✓½ (i)

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The marks are “overall” very similar taking into account the aural, visual and conceptual components, as well as the dominant and distinctive features.

A more distinctive a mark is, the more likely it is to cause confusion on the behalf of the consumer. In addition, “DOCTOR SOOTHE” is the UK’s most-recognised ear-care brand. ✓½ (ii)

However it is necessary to consider whether the average consumer would consider that the goods come from an economically linked undertaking. A likelihood of association does not necessarily lead to a likelihood of confusion.

It is unlikely that consumers would consider the goods to come from economically linked undertakings. ✓1 (iii)
CONC ✓1 (i)
application are low.

MARKS AWARDED: 10/20

10

LOC
2

AC-0
EOM - 0
CONC - 1

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Question 14

a)

In order for a successful passing off action, there must be:

goodwill

misrepresentation

damage

TRINITY
1

In traditional passing off, a person uses an identical mark causing people to believe that the product is another's.

MISREP
✓1 (iii)

This appears to be a case of "reverse passing off", wherein a person takes another's product (left-handed screwdriver) and markets it under their own name (Trolls Ltd"). However the requirements remain the same.

Goodwill

Goodwill is "the driving force that brings in custom". In order to demonstrate goodwill, it is necessary to show that there is trade in a UK business. It is not simply sufficient to show a reputation, though Cressida's left-handed screwdriver appears to have a significant reputation. Cressida is based in Wales and already has various manufacturers licensed to use the patented technology. She therefore has an established business in the UK, with customers. It is likely that she has goodwill.

✓½ (i) ✓1 (iii) ✓1 (ii)

GW
3½

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Misrepresentation

Trolls are writing to manufacturers of left-handed screwdrivers worldwide. Although misrepresentation does not have to be deceptive, there is clear evidence that Trolls are misleading the manufacturers into believing that they are (wrongly) the holders of the patented technology and are therefore entitled to the licence fee payments. It is likely that the manufacturers believe that the goods/services belong to Troll Ltd and not Cressida. There is likely misrepresentation. ✓1 (ii)

MISREP
2

Damage

This is more difficult to assess. As there is goodwill and misrepresentation, it is likely that damage exists in some form. Trolls Ltd are writing to manufacturers who have not paid the licence fee because Cressida does not have patent protection in the relevant country or because the manufacturers are using the licence without permission. Thus “damage” is not in the form of loss sales, as they are not sales that would have been made automatically to Cressida. ✓1 (i) However the actions of Trolls Ltd may have prevented manufacturers from taking out a licence (to avoid infringement) or from renewing their licence (as they mistakenly believe it comes from Trolls Ltd). ✓1 (iii) Allow ✓1 Cressida’s reputation may also be damaged due to the threatening tone of the letters.

DAM
3

There is a strong case for passing off. ✓1

CONC
1

SUB
TOTAL
10½

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b)

The remedies available to Cressida are:

- ^{✓1 (i)} injunction (this is from legislation) to prevent Trolls Ltd from continuing to send the letters;
- ^{✓1 (iv)} damages / ^{✓1 (vii)} account of profits (this is an equitable remedy) ^{✓½ (i)} based on the damage sustained to Cressida / profits made by Trolls Ltd ;
- delivery up of any infringing articles (e.g. any articles marked as "Troll Ltd" in relation to the technology) for erasure or destruction (this is an equitable remedy).

Damages and accounts of profits are mutually exclusive. ^{✓1 (x)}

Damages are assessed based on the monetary loss calculated to Cressida taking into account loss of future business from the actions of Trolls Ltd. ^{✓1 (v)} ^{✓ vi)}

6½

MARKS AWARDED: 17/20

17

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