

Paper Ref	Sheet	Percentage Mark Awarded
<b>FC5</b>	<b>1 of 21</b>	<b>55%</b>

Examiner's use only

Question 1:

a)

A request for a registration of a trade mark. ✓½ (i)

A representation of the trademark ✓½ (v)

A list of goods and services for which the trademark will be used ✓½ (iii)

Information identifying the applicant ✓½ (ii)

2

b)

Application fee must be paid ✓½ (ii)

Declaration of intent to use ✓½ (i)

1

c)

The subsequent overseas trade mark applications must be made in a Paris Convention member state or a state which has a similar agreement with the UK in terms of granting priority. ✓1

The overseas application must be filed within 6 months of the filing date of the UK application. ✓1 (iv)

All of the goods and services which are listed in the overseas application must be included in the UK application. ✓½ (ii)

The application number, country of filing (i.e. the UK), and date of filing the UK application must be provided. ✓1 (vi)

Priority date of overseas applications will be the filing date of the UK application.

3½

6½

MARKS AWARDED: 6.5/7

Page sub-total

Paper Ref	Sheet
<b>FC5</b>	<b>2 of 21</b>

Examiner's  
use only

Question 2:

An application fee must be paid to WIPO. ✓½ (ii)

A designation fee must be paid for each contracting party or contracting organisation designated in the application. ✓½ (vii)

The WIPO application fee will be increased for every classification of goods and services that are listed above three. ✓½ (iv)  
✓½ (v)

Each contracting party or contracting organisation will have its own rules regarding the excess fees due relating to the number of goods and services listed.

The application can be filed at the Intellectual Property Office of a contracting party/ contracting organisation. Such an office may require an additional fee for processing the application. ✓½ (xiii)

Some contracting parties/organisations, such as Japan, require an additional registration fee in order for the right to be registered in that contracting party, organisation. ✓½ (xi)  
✓½ (xii)

The costs are calculated by adding all of the fees together.

3½

MARKS AWARDED: 3.5/6

3½

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>3 of 21</b>

Examiner's  
use only

Question 3:

a)

Book titles are not protectable as they do not fit the definition of a trade mark, that is, they cannot be used to distinguish the goods/services from one undertaking from another. A book title does not indicate the source of the book, multiple publishers can publish the same book. For a mark to classify as a trademark, it must be able to be used to identify the source of goods/services (Arsenal FC case law).

2

b)

France

0

c)

An earlier mark can be used to invalidate an EU trade mark if the earlier mark has been registered before the date of filing of the EU trade mark application. An earlier mark can be a mark protected by law throughout the EU or in any member state. Book titles would be covered as an earlier mark by virtue of this rule in the above mentioned EU country.

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2

**MARKS AWARDED: 2/4**

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>4 of 21</b>

Examiner's  
use only

Question 4:

Regan Inc. has not put the trade mark to use in the UK. Therefore, Cordelia is entitled to register the trademark, subject to the conditions of the Paris Convention.

0

**MARKS AWARDED: 0/1**

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Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>5 of 21</b>

Examiner's  
use only

Question 5:

It is a defence against infringement in infringement proceedings that the mark against which infringement proceedings are being brought consists exclusively of signs or indications of the kind, intended purpose, quality, quantity, value, geographical origin, time of production of the goods and services or any other characteristic of the goods and services. If Helena is operating in the field of selling donkey's, or donkey related goods/services, then this defence could be used as her mark consists entirely of signs and indications of the kind of goods and services she is providing. The trade mark is descriptive.

Helena can also use a prior use defence. Helena's use of the name "Donkey" will classify as an earlier mark, if it can be proved that it has been used, and continues to be used, in the course of business, prior to the date of registration of the registered trade mark. A person does not infringe a registered trade mark if their use of the mark constitutes prior use of the mark. Helena will be able to continue to trade under the mark, but cannot assign/license this right (except in the sale of the part her business or the part of the business in which the mark is used).

1

MARKS AWARDED: 1/3

1

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>6 of 21</b>

Examiner's  
use only

Question 6:

a)

Rosalind should file the registration at the UKIPO within six months of the exclusive license being granted. Rosalind will not be able to enforce any rights against a third party acquiring conflicting rights in the trade mark in good faith after the sixth months period expires if the exclusive license has not been registered. Rosalind will also not be able to bring infringement proceedings if she is not named as an exclusive licensee on the register. ✓½ (iii)

½

b)

✓½ (v)

A formal notification of assignment must be filed. The notification of assignment of the trade mark must be filed in the prescribed manner on the prescribed form. A fee must be paid. Evidence must be filed of the assignment of the right to Celia. The above must be done within 6 months of assignment, otherwise Celia will not be able to enforce any rights against a third party acquiring conflicting rights in the trade mark in good faith after the sixth months period expires if the assignment has not been registered. EUPIO must inform any exclusive licensees of the assignment of the right.

½

**MARKS AWARDED: 1/6**

1

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>7 of 21</b>

Examiner's  
use only

Question 7:

$\checkmark \frac{1}{2}$  (i)                       $\checkmark \frac{1}{2}$  (ii)                       $\checkmark \frac{1}{2}$  (v)                       $\checkmark \frac{1}{2}$  (vi)                       $\checkmark \frac{1}{2}$  (iii)  
Offering, putting on the market, importing or exporting, or stocking for such purpose, any goods or packaging to which the mark is affixed, in the UK, whilst the trade mark is in force, without the consent of the proprietor. This includes any packaging, labels, tags, security or authenticity features or devices, or other items.

It is also an infringing use to offer, put on the market, or import goods and services  $\checkmark \frac{1}{2}$  (iv) under the trade mark in the course of business for goods and services covered by the mark.

Using the trademark on company letter heads.

Using the trade mark in comparative advertising in such a way as is prohibited by EU law.

Using the trademark as a company name.

**MARKS AWARDED: 3/3**

**3**

3

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>8 of 21</b>

Examiner's  
use only

Question 8:

A trader may use their own name without infringing an existing EU trade mark if  
the use is in good faith, and is not likely to cause undue confusion to the average  
consumer.

Allow ✓ ½ (ii)

**MARKS AWARDED: 0.5/2**

½

½

Page sub-  
total



Paper Ref	Sheet
<b>FC5</b>	<b>9 of 21</b>

Examiner's  
use only

Question 9:

Principle of exhaustion of rights: EU

A trade mark proprietor cannot bring infringement proceedings against any person offering, putting on the market, using any goods which have already been put on the market in the EU by the proprietor or with the consent of the proprietor. Italy is in the EU, and the UK is effectively still in the EU under the transition agreement. Therefore, exhaustion of rights would provide Antonio with a defence against infringement of Portia's EU right for Antonio when importing the silverware.

The same applies to the UK right. As the UK provision relates to goods put on the market in the EU (not just the UK) by or with the consent of the proprietor. The fact that the goods have been imported into the UK is not relevant.

**MARKS AWARDED: 3/4**

3

3

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>10 of 21</b>

Examiner's  
use only

Question 10:

Relative grounds for refusal.

The mark is identical to an earlier trademark for identical goods, services.

or

The mark is similar to an earlier trademark for identical goods, services.

The mark is identical to an earlier trademark for similar goods, services.

The mark is similar to an earlier trademark for similar goods, services.

And there is a likelihood of association resulting in a likelihood of confusion relating to the origin of the goods/ services provided under the mark.

or

The mark is identical/similar to an earlier trade mark and has acquired such a reputation that an average consumer would be more likely to be confused about the use of the mark on other goods/services than to identify them with another undertaking.

✓1 (i)

1

1

**MARKS AWARDED: 1/4**

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>11 of 21</b>

Examiner's  
use only

Question 12:

A trade mark application can be opposed on relative grounds. Doctor Soothe was registered in 1972, as opposed to Dr Smooth which was filed in 2020, so Dr Soothe is an earlier registered trademark.

Are the marks identical?

No, the marks are not identical.

Are the goods and services identical?

No, they are not identical.

Are the marks similar?

Do the marks sound similar?

The marks have the same number of syllables, and would sound almost exactly the same when pronounced. <sup>✓1 (i)</sup> The only difference in sound is an “em” sound which is in the middle of the sound when pronounced, and this could easily be missed. <sup>✓1 (ii)</sup> The marks sound very similar.

Do the marks look similar?

Both marks contain a similar logo before the writing of the name. Despite the fact that Claudius’ mark shows a serpent coiled around a rod, and Rosencrantz mark shows a coil as part of a spring, both logos appear almost identical unless <sup>✓1 (iii)</sup> inspected more closely. Furthermore, the writing of the names “DOCTOR SOOTHE” and “DOCTOR SMOOTH” are both written in bold, black, uppercase

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>12 of 21</b>

Examiner's  
use only

✓1 (iv)  
writing. Whilst “DOCTOR SMOOTH” is slightly longer, than “DR SMOOTH”, the overall appearance of the names look very similar. ✓1 (v)  
The names taken in combination with the logos form visual impressions that are very similar.

Are the marks conceptually similar?

Both marks contain the idea of a doctor. A doctor is broadly speaking someone who provides a remedy for a problem. Strictly speaking, this would usually be used for medicine, however, common usage applies the term to other providers of remedies for problems, e.g. a “spin doctor”. ✓1 (vi)  
While “DR SMOOTH” uses an abbreviated form of doctor, conceptually the two concepts are identical. The concepts of soothing and smoothing are very similar. However, soothing is a term that would often be applied to the body, and wouldn't necessarily be applied to mechanics. However, the term “smooth” could be applied to both bodies and ✓1 (vii)  
mechanics. The concept of the snake coiled around a rod is commonplace in medicine, and is different from a coil of a spring, which relates more directly to mechanics. These logos are therefore conceptually different. The two marks appear to be fairly similar conceptually, as the names are very similar, but the logos aren't.

SOM - 7

Who is the average consumer of the goods and services related to each of the marks?

“DOCTOR SOOTHE” – Whilst olive oil is usually used for cooking, this particular oil is used particularly by people with ear infections and people who suffer from motion sickness (motion sickness is caused by inner-ear inflammation in 75% of

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>13 of 21</b>

Examiner's  
use only

cases). The average consumer will thus be a motion sickness sufferer, although wider members of the public may also use the product. AC ✓1 (i)

“DR SMOOTH” – This is particularly used by mechanics, but may also be used by motion sickness sufferers. Average consumer is likely to include motion sickness sufferers. AC ✓1 (ii)

AC - 2

Are the goods and services similar?

Prima facie, the goods and services are not similar. “DOCTOR SOOTHE” is an olive oil used in medicinal treatment for ear care. On the other hand “DR SMOOTH” is a mineral oil for use in automotive vehicles. Both are oils, but are different types of oil. ✓1 (i)

However, the average consumer is likely to be the same in both instances, i.e. the average consumer of the products sold under each trademark is likely to be someone who suffers from motion sickness. ✓½ (i)

Would an average consumer be likely to associate the goods and services provided under the DR SMOOTH mark with the goods and services of the undertaking that trades under DOCTOR SOOTHE?

Mineral oils are different to olive oils as they cannot be eaten safely. However, DOCTOR SOOTHE’s oil is not for eating but for ear care. Therefore, a user wouldn’t be eating either product. However, both could be introduced into the ear canal safely. A user may mistake one oil for the other, given the similarity of the marks. An average consumer wouldn’t necessarily be able to tell the difference between different types of oil. As established, the average consumer is likely to

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>14 of 21</b>

Examiner's  
use only

be the same for both undertakings. Therefore, they may buy the wrong oil by mistake.

Its appears that the goods and services offered are somewhat similar, in that they relate to remedies for the same problem.

Would the average consumer, even if they noticed the difference in the types of oil being offered, believe that the medicinal oil manufacturers had branched out into oils for automotive products? As both products are remedies for the same problem, i.e. motion sickness, they may well come to this conclusion. LOC ✓1 (vi)

SOG - 1½

However, someone buying a medicinal treatment is likely to exercise greater caution as they will be introducing substances into their body. They will not want to introduce the wrong substance as this could have serious consequences, so they will be very attentive to labels etc. However, if they have used the product before, they may be less likely to examine the marks in detail. ✓1 LOC (i)

The greater similarity of marks, the less similar the goods and services are required to be for a mark to be refused on relative grounds and vice versa. The marks are very similar, and so an average consumer may associate the goods and services offer under the trademark DR SMOOTH with Claudius' undertaking, creating a likelihood of confusion relating to the source of the products.

The more distinctive the mark is, the higher the likelihood of confusion when the mark is applied to goods and services for which the mark is not registered.

DOCTOR SOOTHE mark has a logo and writing, and is very distinctive, therefore, therefore an average consumer may associate the goods and services

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>15 of 21</b>

Examiner's  
use only

offer under the trademark DR SMOOTH with Claudius' undertaking, creating a likelihood of confusion relating to the source of the products. ✓1 LOC (iii)

EOM - 0  
LOC- 3

The marks are very similar and for fairly similar goods and services. It appears that there likelihood of association of the DR SMOOTH mark with the goods and services traded under the DOCTOR SOOTHE mark resulting in a likelihood of confusion as to the source of goods and services offered under each of the marks. Therefore, there is a high likelihood that Claudius will be successful in opposing Rosencrantz's application.

CONC -

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14½

MARKS AWARDED: 14.5/20

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>16 of 21</b>

Examiner's  
use only

Question 11:

The name "Lardy Bread":

Objections:

The name "Lardy Bread" does not meet the definition of a mark under section 1 as it is not capable of distinguishing the goods and services of one undertaking from another. There has been a longstanding use of the name "Lardy Bread" by bakers in the Wessex region. As many people produce Lardy Bread, the name cannot be used to determine the source of the goods. ✓1 (i)

The name "Lardy Bread" lacks distinctive character. There has been a longstanding use of the name "Lardy Bread" by bakers in the Wessex region. Many people in the Wessex area produce bread with this name so it is not distinctive. ✓1 (ii)

The name "Lardy Bread" consists exclusively of signs and indications of the kind... of goods to which it is used in relation to. "Lardy bread" is the name of a particular type of bread itself. It is therefore descriptive of the goods and services. ✓1 (iii)

The name "Lardy Bread" is has become customary in the common and language and/or bona fide and established practices of the trade. The name "Lardy Bread" is commonly known to bakers and the common public, particularly in the Wessex area. The name is therefore generic. ✓1 (iv)

The name "Lardy Bread" is limited by UK and EU law relating to protected designation of origin. Trademarks cannot be registered if their use is restricted by UK/EU law relating to protection of areas of geographical origin. As the name

Page sub-  
total



Paper Ref	Sheet
<b>FC5</b>	<b>17 of 21</b>

Examiner's  
use only

has been registered as protected term, this exclusion applies. The name also is excluded by the rules preventing protection of terms relating to traditional specialties.

5

The concept of a sticky caramelised sugar outer coating:

The coating does not meet the definition of a mark under section 1 as it is not capable of distinguishing the goods and services of one undertaking from another. There has been a longstanding making of bread with the coating by bakers in the Wessex region. As many people produce Lardy bread with the coating, the coating cannot be used to determine the source of the goods. ✓1 (viii)

It must also be recognisable to the public as a trade mark. Under Sieckmann case law, a mark must be self-contained, intelligible, durable, easily accessible, clear, objective, and precise.

The concept of a sticky caramelised sugar outer coating does not appear to be self-contained, how would this be entered into the register. It is not precise as to what the coating is applied to. It's not easily accessible, how can someone access a concept? It is not clear what the scope of protection is. Does it cover the coating applied to different confectionary? It is not precise. What classes as sticky? At what point does sugar become caramelised? Also, "sticky" is a relative term, so is not objective. If samples were to be filed, these would not be durable, and would not be accessible as a person would have to travel to the UKIPO in Newport to examine them. ✓1 (vi)

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>18 of 21</b>

Examiner's  
use only

The coating lacks distinctive character. Many people make the coating, and so it is not distinctive.

The coating is a characteristic of the mark that adds substantial value to the mark. The coating contributes to the taste of and enjoyment of Lardy Bread, and so such an objection would be raised. ✓1 (xi)

The registration of the mark would go against the UK/EU for the protection of traditional specialties.

**MARKS AWARDED: 11/20**

11

6

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>19 of 21</b>

Examiner's  
use only

Question 13:

a)

No. The earlier registered trademark has only been used on dissimilar goods to those Duncan is proposing registering. Any trademark that has been registered for specific goods and services more than five years ago must have been put to use in the five years following registration for those goods and services, for the registration to be valid for those goods and services. This is not the case in this instance. Therefore, the earlier trade mark is invalid for the goods and services for which Duncan wishes to register it, and so cannot be used to oppose Duncan's registration.

1

b)

The earlier registered trade mark could be renewed as of right up to Feb 2021, and so could still be used to oppose a new registration if it is renewed before then. However, the mark was registered more than 5 years ago and hasn't been put to use within the last 5 years (5 years since registration. 1 October 2020 is more than 5 years since 1 Sep 2019), and so is no longer valid. It therefore cannot be used to successfully oppose Duncan's registration.

1

c)

The owner deliberately allowed the earlier trade mark to lapse, therefore couldn't claim that the failure to renew it was unintentional. Therefore, the deadline for renewing the earlier trademark would have been July 2020 (6 months from renewal date). There is no possibility of restoration. The earlier trade mark was therefore no longer in force at the date of Duncan's registration, and so the

Page sub-  
total

Paper Ref	Sheet
<b>FC5</b>	<b>20 of 21</b>

<b>Examiner's use only</b>
----------------------------

owner cannot successfully oppose the registration, even if he does not want anyone else using the mark.

1

d)

If the owner has made preparations to resume use of the mark, then the mark can become valid again. However, the preparations must have been made in good faith and must have begun before the date Duncan filed his registration. The earlier registration is a similar mark for identical goods so could be used to successfully oppose Duncan's mark if the above conditions are satisfied.

0

e)

The earlier mark has been used in the UK even if only for the purposes of manufacture and export. <sup>✓1 (ii)</sup> Therefore the registration of the earlier mark is still valid <sup>✓1 (i)</sup> under the use requirements, and can be used to successfully oppose Duncan's application as it is a registration of a similar mark for identical goods and services.

2

f)

Malcolm's use of the earlier unregistered mark "dagger" classes as an earlier right, and so could in principle be used to oppose Duncan's registration. It was also used for the same goods/services as Duncan's application. However, the mark is no longer in use, and has not been used within the last 5 years, so cannot be used to successfully oppose Duncan's registration.

0

g)

Yes, the owner can successfully oppose Duncan's registration. The goods are identical and the device is similar. The representation of the mark in the

<b>Page sub-total</b>
-----------------------

Paper Ref	Sheet
<b>FC5</b>	<b>21 of 21</b>

Examiner's  
use only

registration of the earlier trade mark has not been put to use within 5 years of filing. However, a variation of the mark has been, and this is sufficient to satisfy the use requirements. ✓1 (ii)

1

h)

The logo is covered by copyright. The logo cannot be registered if it infringes copyright, as copyright classes as an earlier right under the UKTMA. Copyright still in force as the logo was created in 2010 (until 70 years after death of author). Shuttlecock can successfully oppose Duncan's registration if it infringes this right. ✓1 (i)  
However, it does not seem that copying has taken place, as the image was never lawfully downloaded. If the logo was arrived at independently, copyright will not have been infringed.

1

i)

A design right classes as an earlier right under UKTMA. Any trademark registration that infringes an earlier right cannot be registered, and so Yeti can successfully oppose Duncan's registration. ✓1 (i)

1

8

**MARKS AWARDED: 8/20**

Page sub-  
total