

Examiner's
use only**Question 1.**

- a) – damages are awarded for the act of committing the infringement and are independent of any financial value made by the defendant from the infringement. ✓1(i)
- Account of profits is an award for a proportion of the money and profit made as a result of the infringement to the claimant and holder of ✓1(ii)
- b) – order to erase, obliterate or destroy infringing signs which have been affixed to goods. ✓½(iv)
- An injunction to prevent the use of the infringing sign ✓½(iii)
- order of delivery up of the infringing goods, particularly in cases where the infringer has failed to comply with an order of erasure ✓½(vi)
- seizure of the infringing goods
- award of costs in legal proceedings.

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MARKS AWARDED 2½/3

Question 2.

- use of as such at the end of the sentence adds a qualifying term so that damages can be recovered if further qualifications are met.

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MARKS AWARDED 0/2

Question 3.

- In reverse passing off the defendant claims that the goods of the claimant are in fact his own. This leads to the public believing that the claimant's goods are in fact the goods of the defendant. ✓1(i)

- In more common forms of passing off the defendant attempts to deceive a proportion of the public that his goods are in fact the goods of the claimant. As a result the public may believe that the defendant's goods are the goods of the claimant. ✓ 1(ii)

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MARKS AWARDED 2/2

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Question 4.

- In order for a non-conventional mark to be registered it must be clear, precise, durable, easily accessible, intelligible and objective, as noted in the Sieckmann decision.

Sign 1 describes the smell as a smell of the sea. This would not qualify for protection since it is not clear ✓ ½(i) and precise ✓ ½(ii) and would not be able to be represented on the register in a manner which is clear and precise and enables the registrar, the competent authorities and members of the public to determine the scope of protection afforded to the proprietor. Furthermore, in addition to not being clear and precise, i.e. the smell of the sea does not describe any characteristic of the smell, it also is not objective since the smell of the sea would be different for each individual. ✓ ½(iv)

Sign 2 describes the smell by its chemical composition. This would not be clear, ✓ ½(v) precise ✓ ½(vi) or intelligible ✓ ½. The chemical composition does not clearly and precisely describe the smell and it would not be intelligible for the public to determine the scope of protection afforded to the proprietor

Sign 3 would not fulfill the criteria as it would not be easily accessible ✓ ½(x) or durable ✓ ½(xi). The smell of the contents of the aerosol can would not be easily accessible and it would fade over time ✓ ½(xii) and therefore would not be durable.

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MARKS AWARDED 4½/6

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Question 5.

- Oprah may oppose ✓ 1(i) the registration of the trade mark before registration on relative grounds, as she is the owner of an earlier work of copyright ✓ 1(ii) and she has not consented to its use. Oprah may also

apply for invalidity ✓1(iii) of the trade mark after registration on relative grounds for an earlier unauthorised use of copyright. Oprah may also oppose the registration on absolute grounds as the mark uses a work protected by copyright.

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- b) – Opposition would not be available at the EUIPO as a trade mark using an earlier work of copyright is not a ground for opposition. ✓1(ii)
- However, Oprah may apply for invalidation of the mark after registration on the relative ground that it incorporates an unauthorised use of a work protected by copyright. ✓1(i)
- c) – Naomi may claim that the use of the image is descriptive of the product or non distinctive.
- Naomi may counterclaim that Ruth's registration was invalid at the time of her use.
- Naomi may argue that use of the image is necessary to indicate the intended use of the product.

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MARKS AWARDED 5/7

Question 6.

- a) owner of an EU trade mark application has to oppose a later EU TM registration ✓½(ii) if it is an identical or similar mark and for identical or similar goods and/or services and there is a likelihood of confusion (including likelihood of association) on part of the public; or there is an identical/similar mark and identical/similar/disimilar goods and/or services, where the earlier mark has a reputation in the EU and the registration of the later mark would without due cause be detrimental or take unfair advantage of the distinctive character or reputation of the earlier mark. Allow ½
- b) It is possible for the owner of a mark with an earlier filing date to invalidate ✓½(ii) a mark with a later filing date as long as the earlier mark fulfills the criteria for relative grounds and the later mark did not obtain consent and Allow ½
- c) Applicant has the exclusive right in the course of trade to prevent the use of a later filed similar/identical mark and/or identical/similar goods which

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has a likelihood of confusion or a trade mark which has identical/similar mark and/or identical/similar/dissimilar goods and services where the mark would be detrimental or take unfair advantage of the distinctive character or reputation of the mark.

Additionally the applicant has the right to prevent preparatory acts such as affixing the mark to packaging, labels, tags, security or authenticity features and to prevent the import, export, stocking, offer for sale of any products with the sign attached if they will be used to infringe.

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MARKS AWARDED 2/5

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Question 7.

- The mark must have been used within a period of 5 years ✓½(ii) from registration ✓½(i) of the mark, or must have been used for a continuous period of 5 years prior to opposition of the mark.
- If the mark had not been used for a continuous period of 5 years and its use commenced prior to the opposition it must have been greater than 3 months prior to the opposition.
- Further, in order to oppose an identical/similar mark for identical/dissimilar/similar goods or services the mark must have developed a reputation in the UK through use.
- Use must have been of more than mere local significance to have a passing off right to enable objection

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MARKS AWARDED 1/4

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Question 8.

- Likelihood of association must be appreciated globally.
- The global assessment must take into account the visual, aural and conceptual similarity of the marks and must take into account the overall impression of the mark on the relevant person in relation to the dominant and distinctive features.

- It is not impossible for conceptually similar marks to create a likelihood of association the mind of the user if the earlier mark has particularly distinctive character per se or as a result of its use.
- This is known as enhanced distinctiveness - where familiarity through use of the trade mark is sufficiently great, that the relevant person would be more likely to associate a similar goods and/or services than if the mark was less distinctive.
- Likelihood of association is analogous to likelihood of confusion ✓1(ii) and the above principles where discussed in the case Sahel v Puma.

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MARKS AWARDED 1/4

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Question 9.

- The bank secured a security interest on the trade Mark. As such, the bank should have registered ✓1(i) the security interest at the IPO as soon as possible. It does not appear that the bank did this.
- Therefore, if the security interest was not registered, any person who in good faith acquired conflicting rights in the trade mark is allowed to keep those rights. ✓1(ii) Since the Bank did not register the security interest they are unable to take action against the later conflicting right acquired by Johnathan.

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MARKS AWARDED 2/3

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Question 10.

- a) - It must have been used in more than mere local significance ✓1(ii) and the right must be provided for and enforceable ✓1(iii) in the relevant national state.
- b) - signs used in local trade.

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MARKS AWARDED 2/5

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Question 11.

- a) 1) The mark is not a sign for the purpose of section 1, i.e. it is not capable of distinguishing ✓½(i) the goods or services from one undertaking from those of another. Is sweet of sour capable of denoting the origin of goods.
- 2) The mark is devoid of distinctive character sweet and sour is not distinctive ✓½(ii)
- 3) The mark consists exclusively of indications which are used in trade to denote the kind, quantity, quality, intended purpose, value, geographical origin or other characteristic. Sweet & sour is used in the trade to denote the taste of products ✓½(iv) and kind of a product ✓½(vi) which is listed in the above.
- 4) The mark consists exclusively of a shape or characteristic which results from the nature of the goods themselves. If the taste of the product is sweet and sour then it is arguable that this absolute ground applies.
- 5) Alternatively, if the goods are not sweet and sour then it is likely that the absolute ground that the mark misleads the public is likely to apply.
- 6) The Examiner will also raise an objection for the absolute ground that it is not possible to register a trade mark ✓1(vii) for plant variety rights ✓1(ix)
- 7) The Examiner may also raise an objection that the sign consists exclusively of a shape or characteristic which gives substantial value to the goods. Does the fact that the apple is sweet and sour give substantial value to the goods?
- b) Evidence of the distinctiveness may be used to overcome the majority of the ground listed in part a) i.e, points 1, 2 and 3. ✓½(ii) ✓½(iii) However, the evidence of distinctiveness is not able to overcome points 4, 5, 6 and 7 ✓½(iv) ✓½(v)

As noted in Windsurfer Chiemsee evidence for distinctiveness may include the market share of the product; intensity of use, the geographical spread of the use and the duration of the use; the marketing of the product and preparation for market; figures from the chamber of commerce

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and industry or other professional association. It is noted that general percentages or unable to provide evidence of distinctiveness. In this case this is what Eve has produced. Moreover, the survey indicates a 50:50 split between associating the term with a Chinese meal and Eve's apples. As such, it would not appear that the mark is in fact distinctive and capable of distinguishing Eve's undertaking from that of another.

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- c) The same absolute grounds would apply ✓½(ii) apart from there would be no objection to the ✓½(iii) use of sign incorporating a plant variety.

✓ 1(i)

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- d) – A shape mark will be objected to if:
- the shape is necessary to obtain a technical result;
 - the shape gives substantial value to the goods; or
 - the shape is as a result of the nature of the product itself.

As noted in *Phillips v Remington*, the average consumer is not accustomed to distinguishing the origin of goods from their shape. However, if the products are particularly distinctive and depart significantly from the norm then they may do so. But, in the interest of the public it is necessary to prevent the registration of shapes which contain essential features necessary to obtain a technical result, even if it can be shown that other shapes achieve the same technical result. The technical result achieved by the shape must only be considered in the use and not in the manufacture. Moreover, the product must be analysed as a whole and not split into smaller details. Additionally as noted in *Nestle v Cadbury* a shape mark must in isolation be capable of denoting the origin of the goods.

- In this case, the boxes are said to be moulded into the three dimensional shape of an apple which is wholly unlike any other juice box. As such, the shape would appear to be capable of being distinctive as outlined in *Phillips v Remington*. Moreover, is the shape of the product necessary to obtain a technical result? As noted, there are many different shaped juice boxes on the market, and so it could be said that the shape of the box is not necessary to obtain the technical result ✓1(iii) of enabling drinking. Although, as noted above,

the fact that other products exist which perform the same technical result does not necessarily overcome the objection.

- Moreover, as it is the use of the product which must be assessed when determining whether the shape gives a technical result and not the manufacture, it is not relevant that the shape is as a result of Eve's novel manufacturing process.

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MARKS AWARDED 9/20

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Question 12.

- Lucky Horse London may oppose the registration of Lucky House London if it can be shown that the marks are identical/similar and the goods are identical/similar and that there is a likelihood of confusion (including a likelihood of association) on the part of the public.
- As Lucky Horse London does not appear (or there is no mention) to have a reputation in the UK Lucky Horse could not oppose on the relative ground that the marks are identical/similar and the goods and/or services are identical/similar/dissimilar.
- On the face of it Lucky Horse London and Lucky House London may be considered similar and the goods and/or services may be similar since they both sell food and alcoholic beverages. ✓SOS(vii) ✓SOS(ix)
- As such, if there is a likelihood of confusion on the part of the public, then the client will be eligible to oppose the registration.
- To determine the likelihood of confusion the global appreciation of the mark must be made with regard to the visual, global and conceptual similarities and the overall impression created by the the mark from its dominant and distinctive features. ✓½loc(i)
- Visually the two marks are quite dissimilar since Lucky House London uses a more distinctive font and has the words spread across two lines. Additionally, the word House is different to Horse in the clients mark. ✓SOM(iii) The word LUCKY HOUSE is very large and the most dominant & distinctive feature of the Lucky house trade mark and this is also the part which is different to the clients mark. Moreover, a U is quite visibly different to a R. ✓SOM(iv)
- Aurally, the two marks are similar since the words Horse could easily be

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interpreted as House dependent upon the accent of the person, ✓SOM(i)

and since it must be appreciated globally it is likely that the marks are audibly similar to some ears. ✓SOM(ii)

- Conceptually the two marks are quite different since one refers to an animal ✓SOM(v) while the other refers to explicitly a house but this would be interpreted as a casino. ✓SOM(vi)
- Furthermore the lack of similarity between marks can be offset by a higher degree of similarity between goods. ✓loc(ii)
- There is a likelihood of confusion if the public believes that the goods of one undertaking are from the undertaking of another. It is not sufficient for the public to just believe that that the goods do not have the same place of production. However, it is sufficient if the public could not believe that goods of one undertaking came from another undertaking. In this case, since the casino only sells Italian-American themed food e.g. pizzas, it is likely that the public could not believe that the Korean food of the client's undertaking came from Lucky House London. However, the public could reasonably believe that the alcohol of Lucky House London came from the client's undertaking or vice versa if alcohol is allowed to leave the casino or alcohol is allowed to enter the casino. Allow ✓½loc(iiv)
- In conclusion, it would not appear that that the client could oppose Lucky House's registration since the visual and conceptual similarity of the marks is low and this is not offset by the greater similarity of the goods, i.e. Lucky House sells pizzas, whereas Lucky Horse sells Korean food. As such, there would not likely be a likelihood of confusion on the part of the public and they would not believe that the goods of Lucky Horse's undertaking could come from Lucky House's undertaking or vice versa

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MARKS AWARDED 11½/20

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Question 14.

- a) It is only possible to amend a trade mark application ✓1(i) by correcting:
- errors of wording or copying; ✓½(ii)
 - obvious mistakes;
 - the name and address of the applicant;

and only if the change does not alter the distinctive character of the trade mark.

- In this case, the applicant would have to file a request for correction of the trade mark for obvious mistakes. However, this is unlikely to be allowed as the UKIPO's manual of trademark practice uses the example of a correction of the misspelling of SELECTA for SELECTOR and notes that this is not allowed as trademarks often use misspelled words. As such, since this case is similar it is most likely that the UKIPO will not accept that the misspelling is an obvious mistake.
 - However, to apply for the correction, a form must be filed at the UKIPO.
- b) The UKIPO will issue a notification indicating that the application fees have not been paid. On issuance of the notification the applicant will have 14 days to pay the application fee without refusal of the application. ✓1(i)
The late payment of the fee will have no effect on the filing date since the payment of a fee is not required to obtain a filing date. Consequently, the application will still have an earlier filing date than the competitor's trade mark ✓1(ii)
- c) Priority must be claimed on filing of a EU trade mark application. Since this was not claimed then it is not possible to claim priority. ✓1(i) To mitigate this the applicant could continue with this application with any goods or services which are unable to claim priority from the parent application and then file a new application ✓1(ii) directed to any goods or services entitled to claim priority, with the new application claiming priority on filing by stating the country of the earlier filing, the application date and the application number (if known)
- d) Seniority of an EU trade mark can be claimed on filing, within 2 months of filing ✓1(i) or any time after registration. ✓1(ii) As such if still within the two months then it is still possible to claim seniority if the national registration has the same owner, the same mark and the same goods or services. Seniority can be requested at the EUIPO.
- e) The validity of a basic registration is linked to the validity of a Madrid protocol registration for a period of 5 years ✓1(iv) from the filing of the Madrid protocol application. As such, the expiry of the EU trade mark from failure to pay the renewal will lead to the expiry of the Madrid protocol

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application. ✓1(v) However, the EU TM application can still be renewed with the payment of an additional fee for a period of 6 months after the renewal date. ✓1(i) If it is still within the 6 month grace period then the EU TM application can be renewed with the payment of an additional fee✓. This will mean that the Madrid application will not be refused.

- If the 6 month grace period has passed then it will not be possible to renew the EU TM and the application will expire therefore causing the Madrid Protocol application to expire.
- In this case, the applicant should apply for transformation of the Madrid application ✓1(vi) within 3 months of the expiry of the EUTM (and therefore Madrid application).
- To apply for transformation the applicant must apply to the relevant national state and appoint a local representative. The effect will be that the transformed national application will not lose their filing or priority date.

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f) There is no remedy or way to mitigate the failure to oppose an EU trade mark. In any case, as absolute grounds are not a ground of application in EU Trade marks it would not have been possible to oppose the application on the absolute ground. ✓(ii) However, it is possible for any person to apply for a declaration of invalidity any time ✓1(i) after registration and a ground of invalidity in the EU is the absolute ground of the mark being devoid of distinctive character (any evidence of distinctiveness through use by the defendant may overcome this). The person should therefore after registration apply for a declaration of invalidity by submitting the statement of grounds and a fee.

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g) In the event that an incorrect fee is paid WIPO will notify the applicant. If the fee is not corrected within the set time limit the complete application will be refused. ✓1(i)

As such the applicant should await the notification from WIPO and pay the missing fee within the set time limit.

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MARKS AWARDED 14½/20