

Examiner's  
use only**Question 1**

- a) damages are awarded against any damage/loss a business has suffered as a result of TM(trademark) infringement ✓½(i)

Account of profits is profits made by the infringer as a result of the use of the TM during infringement which can be paid to the TM owner or other person entitled. ✓½(ii)

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- b) – Injunction ✓½(iii)

– Seizure of infringing goods

– Destruction of the infringing mark on any relevant goods for what the TM is registered for ✓½(iv)

– Order for delivery up of any goods with infringing mark ✓½(vi)

1½

2½

MARKS AWARDED 2½/3

**Question 2**

as such

law of passing off not governed by UKTMA but works alongside it and governed by common law.

- Unreg. TM includes marks which can be protected by a passing off action.

✓1

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MARKS AWARDED 1/1

**Question 3**

- Misrepresentation is deceit as to the origin of goods/services (ie: leading public to falsely believe that goods/services are from a different origin to what they really are. ✓1(ii)

– Reverse passing off is pretending someone else's work to be your own ✓1(i)

Whereas common misrepresentation is leading to the deceit of the public that your goods /services (probably made by you) are from a different business/undertaking in the hope to benefit from that businesses goodwill that is attached to those goods/services.

2

MARKS AWARDED 2/2

2

#### Question 4

Requirements for representations as set out in Sieckmann;

1. Clear
2. Objective
3. Inherent
4. Precise
5. Sufficient
6. Exact.
7. Distinctive

Sign 1; smell of the sea not objective; ✓½(i) each person would interpret this differently. ✓½(iv)

↳ not registerably under Sieckmann criteria.

Sign 2; seems to meet the above requirements.

so sign 2 sufficient representation.

→ consider also including a specimen.

↳ although, again, it would be difficult for public to look at register and readily understand ✓½(v) what the following chemicals smelled like.

Sign 3; smell not able to be represented in a clear and precise manner on the register (ie. 3rd parties such as public would not be able to look on the register or determine what the TM was (ie. what it smelled like) **Allow**

↳ what is the protection afforded to by the proprietor. ✓½

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MARKS AWARDED 2/6

2

**Question 5**

a) Uses image as a business logo

Consider bringing a passing off action

↳ needs to be goodwill attached to her business (ie. needs to have customers in the UK) and also needs to show misrepresentation and likelihood of damage (actual or potential)

– Oprah could oppose registration of the UKTM based on passing off law. A UK trade mark shall not be registered if the owner of an earlier right used the mark in the UK, in the course of business before the filing/priority date of the mark being applied for and the earlier right owner is entitled to prevent the later registration by virtue of a right given under UK law (ie. law of passing off).

• Bring opposition proceedings based on relative grounds (earlier right).

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b) – Before EUIPO can apply to invalidate ✓1(v) the EUTM (ie. grounds of invalidity) based on the earlier existing copyright ✓1(iv) Oprah owns in the logo.

– Or oppose the marks registration on this relative ground.

– Can bring this ground in EU only.

• EUTM shall not be registered by virtue that an earlier right if (for example an earlier copyright) its registration would contravene that earlier right

↳ and the earlier right holder (ie. Oprah as the copyright holder) is permitted under the law of that right to prohibit its use as a trademark in the EU.

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c) Naomi uses logo on product covered by 'Ruths TM'.

• Naomi would be infringing Ruth's rights under the TM as Naomi is using an identical mark for identical goods / services.

However, Naomi can counterclaim that Ruth's Trade mark is invalid by virtue of Oprah's earlier copyright right.

• Naomi is the licensee of the copyrighted logo and so she can bring this ground of invalidity if the terms of her license allow.

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**MARKS AWARDED 2/7**

**Question 6**

- a) Has the right to prevent the use of the trademark covered by the application for those goods /services it has been applied for – prevent the use by a 3rd party  
↳ but can only oppose the later EUTM application once the owners earlier mark has registered.
- b) For UK trademarks, the registration date = filing date once the mark is registered  
∴ has the right to invalidate on the grounds that UK1 owner has a trademark with an earlier filing date than UK2.
- c) UK TM application owner has the right to prevent use of a mark by a 3rd party who do  
affixes TM to goods /packaging thereof  
offers /exposes goods or services under the mark,  
Stocks goods for such purposes or puts on the mark  
imports /exports into the UK for commercial purpose.  
Uses TM in course of trade  
business.

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**MARKS AWARDED 0/5**

**Question 7**

UK use requirements.

- Mark must have been put to genuine use ✓½(v), in the UK, if the mark is more than 5 yrs old (ie. it has been registered more than 5 yrs previous to the application for opposition) ✓½(ii) by the proprietor or with his consent ✓½(vi) for the goods / services which it is registered ✓½(vii) for  
↳ (must have been genuinely used in the 5yrs immediately preceeding the application for opposition).
- Unless there are proper reasons for non-use ✓½(viii)
- If mark has not been registered for 5yrs or is an application then do not need to show genuine use. Allow ½(i)

- Overall, mark must meet the use requirements in order to be used as basis for an opposition  
↳ ie. not vulnerable to revocation on grounds of non-use.

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MARKS AWARDED 3/4

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**Question 8**

- relevant case law; Sabel v. Puma and Canon v. Cannon case (Canon v. MGM)

likelihood of association is would the relevant public consider the two marks in question to be from an economically linked undertaking ✓1(v) in some way, taking into account the mark itself and the goods / services to which it relates.

- likelihood of association (LoA) is more than likelihood of confusion (LoC) and LoA can be used to further LoC.
- Confusion could occur between the two marks, but under the case law LoC must occur with LoA ✓1(i), as so identical marks could lead to no LoA if the goods / services were so different the relevant consumer would not assume goods / services under the mark came from the same origin.
- Purpose of a TM is to identify origin of goods/services.

2

MARKS AWARDED 2/4

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**Question 9**

- A trademark can be used as a security (fixed or floating)
  - ↳ a trademark can be dealt with as any other form of property.
- Was Jonathan a bona fide purchaser of property of value in good faith.
- The mark was assigned to Jonathan and he (assumably) ✓1(iii) did not know that the mark was being used as a security
  - ↳ was the grant of the mark as a security put on the registered
  - ↳ the grant of a security interest should be recorded ✓1(i) in order to to enforceable against a 3rd party who acquired a right under the mark in good faith for considerable value ✓1(ii)
  - ↳ security interest not registered then bank cannot recover TM from Jonathan.

3

**MARKS AWARDED 3/3**

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**Question 10**

- a) Earlier unreg. TM must have been - used continuously
- in the course of business ✓1(i)
  - must be of more than mere local significance ✓1(ii)
  - must have been used prior to the earlier of use or filing/priority date of the EUTM application you are trying to invalidate
  - and must have been used for the goods/services of the EUTM you are trying to invalidate
  - and the owner of the earlier right is entitled to prohibit use of the later mark by virtue of national law of EU member state/EU. ✓1(iii)
- b) • Business names ✓½(vi)
- Domain names.
  - Names used in course of trade
  - Personal names/addresses.

3½

**MARKS AWARDED 3½/5**

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**Question 12**

- Marks = similar
  - goods /services (g/s) = similar
- ∴ Noodle could oppose Jackpots application for registration on the grounds of similar mark for similar g/s and there exists a likelihood of confusion (LoC) including likelihood of association between the two marks.
- When assessing similarity of marks, need to consider visual, phonetic and conceptual similarities.

MARKS

## Visually – similar

- both 3 words long, 1st and last word identical with middle word differing by one letter ✓1SOM (iii)
- length of words identical
- Jackpot's mark is stylised and lucky horse London not.
  - ↳ but word mark only could cover stylisations which cover the logo of Jacpots stylisation. ✓SOM (iv)

## Aurally - similar

- 1st and 3rd word identical so sound identical.
- aural similarities ∴ determined by 2nd words only Horse v. house. ✓SOM(i)
  - ↳ both one syllabul
    - both begin and end the same. but small change in middle ✓ SOM (ii)
    - ↳ overall very similar.

## Conceptually similar –

- 'lucky house' often a term used to refer to gambling establishments. ✓1SOM (v)
  - London, a city location.
  - It is primarily the use of the word 'lucky' that infers gambling could take place so 'lucky horse' could equally refer to such an establishment. (gambling).
- ⇒ overall LoC possible in respect of marks. ✓½SOM(vii)

Goods / Services (g/s)

- Both marks cover g/s of class 43
  - ↳ although just because marks are registered for services of the same class does not necessarily mean g/s are similar.

SOM  
5½

- But, in this case food and beverages and restaurants and bars would be a similar g/s. ✓ SOS (vii)
  - The relevant consumer of food/drinks and restaurants and bars could be similar ✓ AC ½
    - ↳ but restaurants/bars → over 18's only
    - food / beverages → more family friendly ✓ SOS (viii)
    - ✓ SOS (ix)
  - Noodle's restaurant also licensed to serve alcohol so the presence of 'bar / alcohol' is probably not determining factor on similarity of services.
  - Noodle runs a restaurant and Jackpots mark is for a restaurant
    - ↳ but Noodle can only bring opposition based on an earlier right based on their registered TM.
  - Noodle sells Korean food  
Jackpot sells Italian /American food
    - ↳ likely relevant consumer would be different here.

Could this difference in the relevant consumer offset the similarity of the marks? Potentially.
  - Both businesses in London – similar location but London very big
    - ↳ people in South west will not necessarily be familiar with restaurants in central London
    - ↳ different location = different consumers. ✓ ½ LOC (iii)
- Overall, differences in relevant consumers as dictated by the g/s offered offsets the similarity of the marks and so unlikely to be LoC. ✓ LOC (i)
- Also, Noodle's restaurant in a residential suburb
    - ↳ so unlikely to be enhanced distinctiveness of the mark.
  - Don't know how long Jackpot have been operating (but only just applied for TM so assume not very long
    - ↳ again assume no enhanced distinctiveness here. ✓ LOC (ii)
  - Noodle's mark has a earlier filing date from Jackpots mark (2010v. 2019) therefore it would be possible that Noodle could oppose on the basis of their earlier mark

AC  
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SOS  
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LOC  
2½



but, overall as LoC between the two marks unlikely, as determined by the g/s wouldn't recommend opposing Jackpot's mark and incur expensive legal fees. ✓CONC ½

12

MARKS AWARDED 12/20

CONC  
½**Question 13**

- Consider filing an international application under the Madrid protocol(MP)
- MP allows for savings when filing an international application when compared to several national rights.
- Use MP and then make use of replacement mechanism. Germany, Italy, France, Ireland ✓1(xii) all part of EU and so could be encompassed by an EU TM application / EU designation ✓½(vi)
- Ireland and South Africa are not G20 countries which are part of MP  
↳ however, Ireland can be covered by a EUTM  
↳ assume South Africa not part of MP → a separate national application will need to be filed for this alongside an international application. ✓1(xiv)
- Need a basic application. IT company so basic application can be Italian registration → filed via Italian IPO ✓1(vi)  
or EUTM app./reg. → filed via EUIPO ✓1(vi)
- Could file an EUTM application, covering DE/IT/FR ✓1(xxxiv)/IE  
↳ do this to encompass IE. EUTM app over 4 national apps offers cost savings.
- DE has earliest filing date and covers broadest goods (ie. paint).
- EUTM covers broader jurisdiction and so greater chance
- File EUTM app. claiming priority from Australian TM app.  
Actually too late to claim priority from any of the TMs  
↳ past 6mo window.
- File EUTM app. for 'DREAMCOAT', covering paints.  
↳ claim seniority from DE/IT/FR/IE ✓1(xxx) + ✓1(xxxi) applications on filing EUTM, filing + 2months or after registration.  
↳ claim to seniority allows you to let DE/IT/FR/IE applications to lapse but maintain the earlier filing date of these applications as if they had continued to be in force. ✓1(xxxii)  
↳ save on renewal fees and simplify administration.

- Wait for EUTM to register and use EUTM as basic registration for MP.
- EUTM as base reg. leads to greater risk of central attack ✓1(xxxiv) from IT base reg. due to greater chance of opposition in one of many EU countries. ✓1(xl)
- But waiting for EUTM to register mitigates some risk over potential opposition when compared to a EUTM application.
- MP international application dependant on basic reg. for first 5 years and in that first 5 yrs is susceptible to central attack.
- File request for international app. via office of origin (EUIPO in this case)
- Need to pay – base fee
  - \* – Supplementary fee (per class > 3)
  - \* – Complementary fee (per contracting state)
- \* Some countries may have opted for individual fee in place of supplementary / complementary fee.
- Assume paints /spray paints / primers all in same **one unclear word** class (Assume 'paints' covers spray paints, primers).
- File international app. covering Russia ✓½(xxxvi), US ✓½(xxxvii), Australia. ✓½(xxxviii) (cannot designate office of origin country – EU).
- For Russia, US, Australia replacement will automatically take place (ie. the International reg. with RU/US/AU will be considered to replace the earlier national registrations)
  - ↳ can allow RU/US/AU national reg. to lapse ✓1(ixl) + ✓1(xiii)
  - ↳ save on renewal fees and simplify administration.
- Keep South African reg. running alongside Int. registration. ✓1(ixl)
- Overall. International, MP, registration covering
 

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graph TD
    EU --> DE
    EU --> IT
    EU --> FR
    EU --> IE
    subgraph Group
        RU
        US
        AU
        SA[+ South Africa]
    end
            
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- Renewal fee for international reg. due every 10yrs from registration.
- Central attack via EUTM in first 5 yrs can mitigate risk with transformation back into the national rights of non-EU countries (ie. AU/US/RU can be transformed back to national rights). ✓1(xvii)

- EUTM attacked can convert back to national rights (within 3mo of notice that EU TM revoked ect.)  
↳ but can only convert back to countries where objection does not apply. ✓(xix)

EUTM application could be filed claiming priority from the AU application.

- AU paris convention contracting state and within 6month priority window. (claim priority up to 1-Feb-2020)

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16

MARKS AWARDED 16/20

#### Question 14

- a) Can only amend a UK TM for the following (allowable amendments).
- obvious mistakes
  - errors in copying
  - change /update applicant name /address.

as long as the above amendment does not broaden the goods / services or alter the overall impression of the TM.

- Could argue error was a error of copying ✓1(ii) but as the amendment would alter the the overall impression given by the TM → not an allowable amendment. ✓1(iii)
- Amendment is not an amendment to applicant name/address and is not an obvious mistake (appears to be a made up word so not obvious what word should be).

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- b) – Possible to pay fee for UKTM application within 14 days (or by deadline set by UKIPO) of the filing date. ✓1(i)
- If pay fee by above deadline then will maintain the filing date of the application (being that of the day before the competitors mark). ✓1(ii)
  - Requirements for FD. – applicant name/address
    - indication of Goods/services
    - request for UKTM
    - representation of the mark.

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- c) Priority must be claimed on filing of the EUTM ✓1(i)  
No remedy available. ✓½(ii)

1½

- d) Can declare seniority filing date of EUTM + 2 month ✓1(i).  
or after registration of EUTM. ✓1(ii)
- e) Missed renewal fee  
↳ pay within 6months of missed renewal deadline + surcharge (no reason required) ✓1(i)
- Missed 6month grace period deadline then can apply for restitutio in integram within 6month of the end of grace period (ie. 12month from missed renewal fee) and within 2mo of removal of cause of non-compliance (ie. notification of loss of rights in respect of missed renewal fee).
  - for restitutio ✓1(ii)  
need to show that in spite of all due care required by circumstances renewal fee deadline missed. ✓1(iii)  
↳ apply for restitutio in writing to EUIPO  
→ set out grounds for restitutio  
→ evidence of why deadline missed  
→ pay resitutio fee  
→ complete omitted act (ie. pay renewal fee + surcharge).
  - EUTM used as basic application ∴ Madrid application susceptible to central attack. ✓1(v)
  - Transform TMs of contracting states designated by International reg. back to national rights ✓1(vi) (within 3months of the loss of rights notification to EUIPO → ie. day after renewal grace period ended.
- f) • Missed opposition deadline - no remedy available irrelevant that due to illness.  
→ cannot oppose ✓1(i)
- Could file third party observations on this ground before the final decision of the opposition division (assuming another party opposed).
  - Can't oppose EUTM on absolute ground anyway. ✓1(ii)
  - Could file for declaration of invalidity at EUIPO based on the absolute ground. ✓1(iii)  
→ no deadline for doingso.

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Examiner's  
use only

- g) Missed deadline, application deemed abandoned for the fourth class only.  
↳ assumed specified deadline = invitation to comply.

15½

**MARKS AWARDED 15½/20**